

sect. 54 (2) of the new Act enabling the Board of Trade to modify, as regards any class or description of articles, the requirements as to marking may meet some of these difficulties, but, subject to any special regulations which may be issued under this section, the following rules represent the law as it now stands on the subject:—

(1) The marks may be put on by making the same in or upon the material itself, or, where this is not practicable, by attaching thereto a label with the marks upon it (*q*).
 (2) The article sold is alone the thing to be marked (*r*).
 (3) If the article is sold in long strips, each strip must be marked; if it be sold in small pieces (even though the pieces be used only as samples) each piece must be marked (*s*).
 (4) The mark must be on that part of the article to which the design is applied, and not on any part of it which is not registered, unless the two are so attached as to be practically inseparable parts of the same article (*t*).

The cases cited as illustrative of the above rules are—

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

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

(*q*) *Blank v. Footman* (1888), 5 R. P. C. 653. This was expressly provided by sect. 4 of the Act of 1842.

(*r*) *Fielding v. Hawley* (1883), 48 L. T. N. S. 639; *De la Branchardière v. Elvery* (1849), 18 L. J. Ex. 381.

(*s*) *Heywood v. Potter* (1855), 22 L. J. Q. B. 133; *Hothersull v. Moore* (1892), 9 R. P. C. 27; *Ingram v. Edwards* (1904), 21 R. P. C. 463.

(*t*) *In re Morton's Design* (1899), 17 R. P. C. 117; *Lea & Perrins v. Price* (1904), 22 R. P. C. 122.

(*u*) But see Farwell, J., in *Re Morton's Design*, *supra*, on this case, and *Lea & Perrins v. Price*, *supra*.

Heywood v. Potter (v). The designs in question were applicable to paper-hangings, and the plaintiff had sold unmarked patterns. The ordinary custom was to sell paper-hanging in pieces of twelve yards each, and the plaintiff had caused the proper mark to be placed upon each piece of twelve yards, but not upon the patterns which had been cut off from the twelve yards pieces. The patterns were sold. Lord Campbell, C.J., and Wightman, J., considered that the plaintiff had not complied with the Act as regards marking; Coleridge, J., was of a contrary opinion, though he admitted that the patterns were articles of manufacture within the literal sense of the Act, and that the Designs Acts are to be construed strictly (x). The view of the majority of the Court agrees with the judgment in *Fielding v. Hawley* (y), where Field, J., said: "If a manufacturer takes a large piece and cuts it up into smaller pieces as samples or otherwise, then of course each must be marked." Under the present Act this would be so only if the samples were sold.

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

(v) (1855) 22 L. J. Q. B. 133.

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

(y) *Supra*.

(z) (1888) 5 R. P. C. 653.

sell small pieces, whether for patterns or for use, he must mark each small pattern in some manner in which those things can be conveniently marked, as, for instance, by tying on a label or by printing something on the packet in which it is. But he is not bound to mark any thing but that which he sells."

Hothersall v. Moore (a) was a case relating to a design for dusters. The dusters were made up into pieces which could be cut up into twelve dusters, and a gummed label, having upon it the proper mark, was attached to each piece. As it was proved that the piece was intended to be cut up into twelve dusters, Bristowe, V.-C., came to the conclusion that there were twelve articles in each piece and not one, and that the marking was defective. There might be some difficulty in following the decision so far, for the registration was of the piece, the goods were sold by the piece, and the piece was marked. It might, therefore, well be argued that the article sold had the mark upon it. But it seems that the piece was made with the intention that it should be cut into twelve pieces and so sold, and the Court found as a fact that the proprietor himself was actually cutting up these pieces into individual dusters, and was having them hemmed and prepared for sale. The decision amounted to a finding of fact that the so-called pieces were in reality twelve articles.

In *Re Morton's Design* (b) the design was for the shank of a cuff link, and the mark was put on the link and not on the shank itself, and this was held to be insufficient within the section, Farwell, J., saying: "You really have a double misleading if you put your stamp of registration on that part of the article which you sell which is not registered. You not only do not represent to the public that the portion which is registered is protected, but you invite the public to believe that that which is not protected is protected. There is no doubt some little difficulty, because I feel, to some extent, the force of the case referred to against this contention (*Fielding v. Hawley*), but that was under a different Act; and I think probably the distinction turns on the wording of the Act of Parliament."

In *Ingram and Kemp v. Edwards* (c) the plaintiffs had registered two designs for gas brackets and pendants, and claimed against the defendants, as manufacturers, for alleged infringements of the designs. The defendants denied infringement, and pleaded anticipation and defective marking, the regis-

(a) (1892) 9 R. P. C. 27.

(b) (1895) 12 R. P. C. 283.

(c) (1904) 21 R. P. C. 463. For illustration of the design herein showing mode of marking, see Appendix F., Sheet 4, p. 426.

tration mark being on the cup attached to the bracket, which was not a novel part of the design. The jury found infringement of the design for the pendant but not of the bracket, and that the bracket "would not have been a complete article without the cup"; and judgment was given for the plaintiffs accordingly, with an injunction.

Lea and Perrins v. Price (d). In 1902 the plaintiffs registered a design in Class 1 for a lamp head to be attached to arc gas lamps, the design being for shape and configuration. The registration mark had not been affixed to the lamp head, but to a metal ring at the base of the glass globe which was fitted into it, which was common to the trade and formed no part of the registered design, and it was admitted that the plaintiffs' lamp head might be made up without this ring by using a different globe. Held, that the mark prescribed by sect. 31 was intended to show what part of the article it was that was protected, and that the marking applied by the plaintiffs failed therefore to comply with these requirements and the copyright had ceased.

In directing the jury Channell, J., said: "So far as the question of marking is a question of law for me, I am going to hold that it is not sufficient to mark the ring. The marking of the ring might very possibly do where the design was claimed for the whole article, or where the design was claimed for the pattern of the ring; but when you are claiming only for the pattern of the head, which is a different part, nobody would understand, by your putting the mark on the ring, that you intended to claim the registration of the design of the head."

The jury were unable to agree on the other points submitted, and on this Channell, J., gave judgment for the defendants.

§ 139. If the requisite mark is properly applied the addition of other marks which do not strictly refer to the portion of the article on which they appear will not affect the validity of the marking, or deprive the owner of the benefit of the registration, on the ground of misrepresentation.

In *Harper v. Wright and Butler (e)* the defendants contended that the plaintiffs had sold their stoves with registration

(d) (1904) 22 R. P. C. 122. For illustration of the design herein showing mode of marking, see Appendix F., Sheet 6, p. 428.

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

marks referring to other designs not applicable to the stoves, and that this was calculated to mislead and deprived the plaintiffs of their remedy.

In concurring with the other judges in dismissing this contention, Rigby, L.J., said: "Even if he put a reference to the register upon a thing which it was impossible to suppose that he thought to be covered by that registration, it may be provided for (I have not referred to the Act) in some way by penalties or otherwise; but the Act does not say that, even in a strong case like this, he should forfeit his protection for the design actually registered, and I cannot find that we have—even if we wish to introduce any such clause—any jurisdiction to do so" (*f*).

(*f*) See also the judgment of Lord Herschell, C., in the same case as to excessive claim generally; and see *Re Bayer's Design* (1906), 23 R. P. C. 553, per Warrington, J., on the same point, confirmed by Vaughan Williams, L.J., in the Court of Appeal (1907), 24 R. P. C. 65.

CHAPTER IX.

STATUTORY COPYRIGHT AND ITS INFRINGEMENT.

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

- § 140. Effect of Registration—Term of Original Copyright and Conditions for Renewals.
- § 141. Statutory Provisions as to Infringement.
- § 142. Differences in position of Manufacturers and Vendors of Pirated Designs—*Smith v. Lewis, Roberts & Co.*; *Brittain v. Kennedy*.
- § 143. Position under the old and repealed Acts and Act of 1907.
- § 144. Notice required to affect a Vendor.
- § 145. Liability of Agent as Infringer.
- § 146. Rights of Buyers from a Licensee—*Cooper v. Stephens*.
- § 147. Classes of Infringements—None unless Sale intended.
- § 148. Imitation of Design—*Barran v. Lomas*; *Thom v. Sydall*.
- § 149. Obvious Imitation—*Harper v. Wright and Butler*.
- § 150. Fraudulent Imitation—*Grafton v. Watson*; *Sherwood v. Decorative Art Tile Co.*
- § 151. Infringement a question of Fact—Test of the Eye—State of Knowledge—Star-chain Case (*Holdsworth v. McCrea*)—Lace Cases (*Barran v. Lomas*; *Birkin v. Pratt*; *Oliver v. Thornley*)—Kitchen-range Door (*Walker v. Hecla Foundry Co.*)—Light-house (*Staples v. Warwick*).
- § 152. Attempts to Imitate without Infringing—*Nevill v. Bennett*; *Holden v. Hopkinson*.
- § 153. Intention Immaterial.
- § 154. Imitation of Purpose or Utility no Infringement.
- § 155. Novelty and Infringement.

§ 140. The registered proprietor has “the exclusive right to apply the design to any article in any class in which the design is registered” (a). And this extends to “any article of manufacture and any substance artificial or natural, or partly artificial and partly natural” (b). During the existence of the copyright, therefore, the registered proprietor is entitled to the statutory remedies for every infringement of his rights.

(a) (1907) Sect. 93, definition of “Copyright.”

(b) *Ibid.*, definition of “Article.”

The statutory copyright is given (*c*) (1) for an absolute term of five years from the date of registration; (2) for a second period of five years from the expiration of the original term if, within the prescribed time (*i.e.*, one week at least) before such expiration, application for an extension is made to the Comptroller and the prescribed fee (1*l.*) paid (*d*); (3) for a third period of five years from the expiration of the second term if, within the prescribed time (*i.e.*, not less than six, nor more than twelve, months) before such expiration, application for an extension is made to the Comptroller and the Comptroller allows the extension subject to payment of the prescribed fee (1*l.* 10*s.*) (*e*). Upon an extension of the term of copyright, it is to be advertised in the official Journal.

§ 141. To determine what is infringement, reference must be made to the terms of the Act, which run as follows (*f*):—

During the existence of copyright in any design it shall not be lawful for any person—

- (a) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
- (b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article.

§ 142. These provisions make a very considerable dis-

(*c*) (1907) Sect. 53. See notes to this section, *post*, p. 229.

(*d*) See Rules of 1908, Nos. 37 and 38, as to the time and manner of application and the fees payable, and Form 8 in Appendix B., *post*, p. 378.

(*e*) This second extension will only be granted subject to the provisions of the new Rules Nos. 39 and 40. See Forms 9, 10 in Appendix L, *post*, p. 379.

(*f*) (1907) Sect. 60 (1).

inction between infringers dependant upon whether they be manufacturers of the article or merely vendors. In the former case innocence or want of knowledge is not an excuse, in the latter case it is.

§ 143. Under the Act of 1842 it was forbidden to publish, sell, or expose for sale, “after having received, either verbally or in writing, or otherwise from any source other than the proprietor of such design, knowledge that his consent had not been given, or after having been served with a written notice, signed by such proprietor or his agent to the same effect” (*g*).

In *Norton v. Nicholls (h)*, it was decided under this that a notice from the proprietor was not sufficient unless it expressly stated that the proprietor of the design had not given his consent to the application of the design, and whether the proprietor intended to sue in respect of the application of the design to an article of manufacture, or for the sale of such article with the design applied; and it was held that the notice should have specified the real claim intended to be made.

Under the Act of 1883 and the present Act an express notice is not required; it is sufficient to constitute a piracy by a vendor if the vendor can be in any way shown to be aware that the proprietor has not given his consent to the use of the design in question. But the case just mentioned is valuable as an example of the kind of knowledge that must be proved to exist.

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

(*g*) 5 & 6 Vict. c. 100, s. 7.

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

(*i*) *Smith v. Lewis, Roberts & Co.* (1888), 5 R. P. C. 611, 614.

In *Smith v. Lewis, Roberts & Co.* (h), the facts were these: On 17th May, 1887, the plaintiff's solicitors wrote to the defendants, "Mr. Robert Smith informs us that it has come to his knowledge that you have in your warehouse exposed for sale, and have been in the habit of selling, Leno canvas striped goods, the patterns of which have been registered by our client. On his behalf we have to request you, within seven days from this date, to supply us with a full statement showing the quantity of goods which you have sold, the quantity you have in stock and the name of the manufacturer. If this information is not given within the time mentioned, our instructions are to commence an action against you forthwith." Some of the goods were sold for the defendant on 21st May, he being then away from business, but on his return he stopped the sale; it was, however, not till 6th June, after the commencement of the action, when an inspection of the designs claimed on took place, that the defendant became convinced that he had been dealing in goods of the plaintiff's registered design, and he at once returned the goods to the manufacturers. Bristowe, V.-C., found for the defendant, on the ground that the notice was too vague, as it did not contain any pattern of the design, nor state any detail of what was claimed. He said: "In this case the retail dealer is selling goods for a considerable period of time, and he had no claim made against him on the ground that the goods were registered goods at all. In order to bring the case within the Act of Parliament, I think it must be necessarily shown that the retail dealer knew at the time of the exposition for sale that the design applied to the goods exposed for sale was applied without the consent of the registered proprietor. Now, surely it is necessary that the person giving the first notice should give such a notice, if it is in writing at all, as to be intelligible to the person charged, so that he may know what is alleged against him. . . . He must have the particular thing explained to him which it is claimed has the right of registration."

Brittain v. Kennedy (i) was a somewhat similar case, which arose under the Sculpture Copyright Act, 1814 (54 Geo. III. c. 56). The plaintiff was the owner of copyright under the Act in a brass model bust, and sued the defendant for infringement by "exposing for sale" a specimen which he had shown to a wholesale importer for toys, asking for orders to supply him with model busts of the same character. On behalf of the

(h) *Supra*. The case of *Wittmann v. Oppenheim, contra* (1884), 27 Ch. Div. 260, was referred to and distinguished.

(i) (1902) 19 Times L. R. 122.

defendant it was contended that there was no "sale" or "exposure for sale" within sect. 3 of the Act, and that the Court would not grant an injunction under sect. 1, where only a single instance of an infringement of a right was proved and there was no threat to repeat it, or where damages were an adequate remedy.

Wright, J., in giving judgment for the defendant, said it appeared to him that the evidence did not amount to any overt act under sect. 3. There was not the slightest evidence that the defendant made any other attempt to sell beyond showing the sample and asking for orders, or that he knew that the copy was an infringement. It was clear that the defendant had not "caused to be exposed." The only model which had been proved to have been shown was a sample, and the words "exposed for sale" referred to the exposure of particular articles; therefore sect. 3 did not apply. Under sect. 1 all the defendant did was to make a single offer to manufacture articles for sale, and after being warned he desisted. It was not a case in which an injunction could be properly granted.

§ 144. The result seems to be that a vendor who has not actually applied the design to goods, but who is a mere seller of such goods, will not be liable to the penalties for piracy unless it can be shown that he was publishing or selling with knowledge of the facts; and knowledge will not be imputed to him on the strength of the receipt of a complaint unless it clearly specifies the design alleged to be infringed. On the other hand, there is no statutory requirement of a written notice, and a seller will certainly not be allowed to escape, even if he received no direct notice at all, if the Court is of opinion that he had other knowledge that the goods he is selling are infringements of a registered design.

The above observations apply only to the statutory right, and the right to restrain further infringements under the equitable jurisdiction of the Courts will not be affected by these considerations (*k*).

§ 145. A person acting as agent for another may be liable as an infringer for publishing or exposing for sale

(*k*) *Wittmann v. Oppenheim* (1884), L. R. 27 Ch. D. 260. As to the cases in which an injunction will be granted, see *post*, § 162 *et seq.*

goods to which the design has been applied, if he is aware that the proprietor has not given his consent (*l*). And the new Act introduces a special provision making persons who “do anything with a view to enable the design to be so applied” liable to the penalties for infringement; this provision meets the case of a person preparing dies or moulds of a registered design in this country for manufacturing abroad, which, under the old Act, was held not to be an infringement (*m*).

§ 146. If the proprietor grants a license to make goods to which the registered design has been applied, vendees from the licensee do not infringe if they in turn sell the articles, though they know that the registered proprietor has not given his consent to their so doing. The licence involves consent to sale by vendees of the licensee (*n*). But this will not be extended so as to cover any user of the registered design which was not contemplated by the license.

In *Cooper v. Stephens* (*o*) the plaintiffs were designers of designs for carriages and were the registered owners of the copyright under the Act 5 & 6 Vict. c. 42, in the catalogues in which they published their designs. Their course of business usually consisted in supplying copies of their designs to coach-builders, ready printed on sheets for inclusion in their catalogues for advertising purposes. But if the coach-builders desired to print these designs themselves, they sold electros of their designs to the coach-builders for this purpose. Having sold electros of two of their designs in this way to L., the latter afterwards allowed the defendants to use them for printing advertisements in their own business.

Held, that there was no assignment of the copyright in the two designs to L., but only a limited license for use in his own business, and that L. had no power, by disposing of the electros, to authorise the defendants to make use of them in another business, and so affect the plaintiffs' copyright. In

(*l*) *Muet v. Couston*, 33 Beav. 578; *Upmann v. Elkan*, 7 Ch. 130; *Nobel's Explosives Co. v. Jones* (1880), 17 Ch. D. 721, 742 (affd. 8 App. Cas. 4).

(*m*) *Potter v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218. See the concluding words of sect. 53, sub-sect. (a), which are new.

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

(*o*) (1895) 77 L. T. 390.

giving judgment, Romer, J., said: "The effect of the sale of the blocks to Lilley was, in my judgment, to authorise him personally to print therefrom and use the copies for the purposes of his advertisement and trade. It did not authorise anyone else to print or publish copies and, in my judgment, certainly did not enable Lilley to authorise the defendants, as against the plaintiffs, to print and publish the two drawings in question. Lilley, in fact, had a license from the plaintiffs, which was not assignable by him. The defendants try to make out that the sale of the blocks had the effect of conferring on Lilley the copyright in the blocks, and not merely a license to use them. But I cannot see how that is established. The copyright was previously existing in the plaintiffs, and the sale of the blocks could not have had the effect of an assignment of copyright; and, indeed, I am satisfied that the meaning and intent of the transaction, as between the plaintiffs and Lilley, was that the sale of the blocks should authorise Lilley personally to print therefrom for the purposes of his advertisement and trade, and should confer no other rights upon him, and have no other operation or effect."

In *Marshall v. Bull* (*p*) the plaintiffs were wholesale mantle makers, and having published a catalogue of their designs for the winter season 1898, supplied and sold to E. & W., who were their customers, nine electro blocks of the illustrations for reproduction in their catalogue. E. & W. disposed of them to P. & Sons, who printed the catalogue for another customer containing the same designs. The plaintiffs thereupon registered their catalogue under the Copyright Act, 1842, and claimed an injunction and delivery up of the blocks. In giving judgment, Byrne, J., said another point taken was that the purchasers of the blocks might use them as they pleased. That depended entirely upon the bargain made when the sale took place; and it did not appear to him that, in point of law, under circumstances such as the present, the bargain was to be construed otherwise than as a licence to use for a particular purpose, merely because, in order to allow that licence of user to be made use of, a block, or means of copying, was supplied to the person to whom the licence was granted. The plaintiffs were entitled to an injunction and delivery up of the blocks.

§ 147. The section points to six classes of infringement, all subject to the general condition imported by the words "for the purposes of sale," and they are: (a) application of the design; (b) application of any fraudulent imitation of the design; (c) application of

(*p*) (1900) 16 T. L. R. 501; and on appeal, 17 T. L. R. 684.

any obvious imitation of the design (*q*); (d) causing any of the three preceding acts to be done; (e) doing anything with a view to enable any of such acts to be done; and (f) knowingly publishing or exposing any article to which the design has been improperly applied.

The Act forming a complete code as to actions for infringement(*r*), it follows that unless the application of the design falls in one of these classes, there is no infringement within the statute. Hence there seems to be nothing to prevent an imitation of a design unless the purpose for which the imitation is made be the sale of the article to which the design is applied.

But where the design is applied to goods for purposes of sale, it does not matter that they are not intended to be sold until after the term of copyright protection has expired, and goods so manufactured will be ordered to be given up to the owner of the copyright for destruction(*r*). And the Courts will sometimes interfere by way of injunction on the ground of breach of a right of property, even where no sale is threatened or intended.

§ 148. “Imitation” is a word used in different senses. Taken in the sense of an actual copying of the design, every imitation is undoubtedly an infringement. But there may be a fair imitation where the original design is used as a basis, but it is accompanied by original work of such character and extent as to create a new design, so that the old design and the new design are different substantially, and in such a case there is no infringement.

In *Thom v. Sydall* (*s*) it was said by Wickens, V.-C., that the mere fact that defendants had worked upon the plaintiff’s

(*q*) This was a new provision in the Act of 1883; “obvious” imitation was not mentioned in the old Act, 5 & 6 Vict. c. 100, s. 7.

(*r*) *Woolley v. Broad* (1892), 9 R. P. C. 208.

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

design constituted no cause to show that patterns registered by sample had been infringed by the defendants.

In *Barran v. Lomas* (t), Jossel, M.R., said that a fair imitation of an original kind is not an infringement.

§ 149. An “obvious imitation” is such an imitation as would strike the eye in such a way as to produce the impression (which may be corrected, if need be, by expert evidence) of having been clearly taken from the original design (u). To test this, the designs need not be put side by side (though that is one element of comparison); it is permissible to look first at one and then at the other, *i.e.*, to consider what would be the effect supposing they were seen at different times, or to look at them both a little distance off. If, then, they seem the same, so much so that from memory they are indistinguishable, there is an obvious imitation and therefore an infringement.

So there is an obvious imitation if when the designs are used on dress or on furniture, they would, without minute inspection, be taken to be identical. If, on the other hand, on inspection the designs are found to be identical, there would not be an “obvious imitation” but an actual copy (x).

In *Harper v. Wright & Butler* (y), the plaintiff’s designs showed an upright stove, hexagonal, with an ornamental window of cathedral type, with tracery above and below, and with a cover of special form with a knob. The defendants’ stove was similar in general characteristics, but the window, although of cathedral type, was of a different style, and the tracery was not the same. Kekewich, J., at the trial held, without going into the defendants’ case, that there was no infringement, as, though the defendants might have imitated the plaintiff’s general idea, they had not taken his registered design. On the hearing of the appeal the de-

(t) (1880) 28 W. R. 973.

(u) Per Chitty, J., in *Grafton v. Watson* (1884), 50 L. T. N. S. 420.

(x) *Grafton v. Watson*, *supra*; and see *Sherwood v. Decorative Tile Co.* (1887), 4 R. P. C. 207.

(y) (1895) 12 R. P. C. 283. See the observations of Kekewich, J., in *Hanfstaengl v. W. H. Smith & Sons* (1905), 21 T. L. R. 291, in which the previous decisions on what are “copies or colourable imitations” are discussed.

defendants' case was gone into to save a reference back to the Court below; and the Court then held that the defendants had infringed, as they had copied the plaintiff's designs with immaterial differences.

In giving judgment, Horschell, L.C., said: "Here the two designs have been placed side by side, the eye has been left to judge, and the impression produced upon all the members of the Court has been this, that the one design is an obvious imitation of the other; that in all their essential features they are alike, and that in those essential features they differ, both of them, from anything that has been previously known. Now, better proof than that, that the one design is an obvious imitation of the other, it seems to me, it would be impossible to give. On what ground do the defendants say that the one is not an obvious imitation of the other? They point to the different details—the different parts of the design—and they show in each of the designs differences of detail. They undoubtedly show that, but, to my mind, that has no bearing upon the question whether the one is or is not an obvious imitation of the other. You may produce precisely the same design in all its essential features, though you make differences in all, or almost all, its details.

"The defendants employ a designer, and after putting him in possession of the plaintiff's stove, instructions are given to him to make an original design for a similar article. What was the meaning of giving him the plaintiff's stove, and telling him to make a similar article? Why, it was to be similar in its essential features in that which made it attractive to the public, and in that which made it a good article of commerce; but it was to be original in design, that is to say, although producing a similar article which would appear to the public to be alike, they were to be able to point to originality in all its details. A clearer direction to a designer to make an obvious imitation, it seems to me, it would be difficult to find. I can entertain no doubt, therefore, that in this case one of these stoves is an obvious imitation of the other. I think the learned judge in the Court below erred in considering too much the details as essentials of the design—the designs may be the same, although the details largely differ. The truth is that the defendants took all the essential elements of the plaintiff's design" (z).

A. L. Smith, L.J., said: "If I went into a shop and saw the plaintiff's stove, this cathedral stove, and ordered it, and they

(z) In the recent case of *Hutchisons Ltd. v. St. Mungo Manufacturing Co.* (1907), 24 R. P. C. 265, it was held that a design for a golf ball which, though similar in its details to a registered design, would always be readily distinguished from it from all points of view, did not infringe.

sent me home the defendants', I should not have had the slightest idea that I had not got what I had ordered. At a distance, they are entirely similar. One is an obvious imitation of the other. But there is this, I agree: that if they are brought into close proximity, and the tracery and so on is pointed out to us—when the two are together—of course, one can see a dissimilarity between them; but it is such a dissimilarity that, in my judgment, if they were not together, no one could carry it in his head, and, therefore, to say that one is not an infringement of the other is to say what, in my judgment, in the face of the facts in this case, is not, in reality, the truth."

Rigby, L.J., said: "We have simply got to trust to the eye, and looking at the two stoves I am not only satisfied that one is an imitation of the other, but I feel satisfied, quite independently of the evidence—though that, of course, assists the conclusion—that the design of the defendants' would never have come into existence if it had not been for the design of the plaintiff's."

§ 150. A "fraudulent imitation" is imitation with knowledge that the pattern is a registered design, and without any sufficient invention on the part of the imitator (a).

In *Barran v. Lomas* (b), Jessel, M.R., said: "Fraudulent imitation is imitation with knowledge—conscious imitation—the man who imitates having the design before him, and knowingly and wilfully imitating, and his imitation not being sufficiently original to be protected as a fair imitation."

In *Grafton v. Watson* (bb), where the plaintiffs registered a design producing on calico a particular effect familiar in silk velvet, and the defendant prepared a design which in general arrangement resembled the plaintiffs', and produced a similar effect though there were variations in detail (e.g., where the plaintiffs' design had acorns and sprays the defendant's substituted mangosteens and sprays closely resembling the plaintiffs' in contour), it was held by Chitty, J., that the resemblance being so close as to make it impossible to distinguish the one from the other by memory alone, and there being coincidences between the two designs which would have been strange but for the fact that the defendant's designer had had the plaintiffs' before him, the defendant's design was an obvious imitation. On the defendant's appeal against the injunction, Cotton, L.J., said: "These designs obviously

(a) Cotton, L.J., in *Grafton v. Watson*, on appeal (1884), 51 L. T. N. S. 141.

(b) (1880) 28 W. R. 973.

(bb) *Supra*.

were seen by the defendants before they gave instructions for preparing their designs; and it is remarkable that, though there is undoubtedly a certain dissimilarity, yet to the eye there is, as is admitted, such a general similarity as to produce the appearance of imitation, when you hold it at a certain distance. Undoubtedly there are differences, but when one looks at the designs one sees that the places where the light ground is covered with the dark colour in the intervals of what is called the dominant ornament, they are very much the same both in those patterns of the plaintiffs', which are said to be imitated by the defendants, and in the defendants' patterns; and the subordinate arrangement, although entirely old, is so arranged with reference to the dominant as in substance to produce something like a similarity, and that I think upon the evidence is a *prima facie* case on behalf of the plaintiffs that it is fraudulent. Fraudulent imitation, to my mind, must mean this: if a man, knowing that the pattern is a registered design, goes and imitates it, and does that without any sufficient invention on his own part, that would be a fraudulent imitation, if in fact it is an imitation. There may be an imitation which is unconscious, that is to say, not an imitation in the sense of copying—a producing of the same effects without knowing of the registered design; but when the registered design is known, then, if there is imitation, the burden of proving that the registered design was not copied is, to my mind, thrown on the person who produces the pattern like that which is imitated."

In *Sherwood v. Decorative Tile Co. (c)*, Manisty, J., said: "The conclusion I have arrived at is that it is not an obvious imitation. If so, it resolves itself into the single remaining question whether it is a 'fraudulent' imitation. It may not be easy—I do not say it is impossible—to define in words exactly what is meant by a fraudulent imitation. I think the word was introduced for the very purpose of meeting the case of an imitation—not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. For instance, having before your mind and before your eye the design of another, and introducing into your design some differences in order, if possible, to avoid coming within the Act of Parliament. . . ." Adopting as part of his judgment the words used by Cotton, L.J., in the previously-quoted case, he added: "Where you find these minor differences alluded to by the Lord Justice, and find what he points out, and which really exist in this case, then there is a *prima facie* case"; and he found that the defendants' design, though not an obvious imitation, was a fraudulent one and should be restrained.

§ 151. Infringement is a question of fact and is a matter to be left to the jury (*cc*). Though witnesses may be examined, and should be heard if desired by the parties (*d*), the point is one to be determined by the eye (*e*). It is necessary to prove, not that the imitating article is identical in all respects with the registered article, but that it is to all appearance the same.

The rule is, however, subject to the qualification that the state of knowledge in the particular trade must be taken into account in deciding whether any variations are so substantial as to exclude the charge of infringement.

In *Holdsworth v. McCrea* (*f*), Lord Westbury said that, "In the case of those things as to which the merit of the invention lies in the drawing or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of identity of the two things; whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure and ascertains whether they are or are not the same." He added that when a pattern is registered as a whole, anything which is a facsimile is an infringement, anything which produces it in its integrity; but that which is different in shape or form, or in the relative positions of the different parts—which is not a reproduction of it—would not be an infringement. The question whether there was any difference in the effect was to be left to the jury.

Dealing with the same case on a subsequent application for damages, Lord Hatherley said (*g*) that what was meant by these words was 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

(*cc*) As in *Chard v. Cory* (1892), 9 R. P. C. 423; *Gordon & Munro v. Patrick* (1894), 12 R. P. C. 22; *Ingram & Kemp v. Edwards* (1904), 21 R. P. C. 463.

(*d*) In *Mitchell v. Henry* (1880), 15 Ch. D. 181, Jessel, M.R., using his own eyes, declined the assistance of outside evidence, but was overruled on that point by the Court of Appeal, who declared the evidence admissible and heard it. But see *Gordon & Munro v. Patrick*, *supra*.

(*e*) *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380; *Grafton v. Watson* (1884), 50 L. T. N. S. 420; 51 L. T. N. S. 141; *Hecla Foundry Co. v. Walker* (1889), 6 R. P. C. 554; *Hothersall v. Moore* (1892), 9 R. P. C. 27; *Demartial v. Booth* (1892), 9 R. P. C. 499; *Harper v. Wright & Butler* (1895), 12 R. P. C. 483.

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

(*g*) (1870) 6 Ch. 418.

from what is old; but if he chooses to put it in that way, it will not be protected against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner and have the same effect, or nearly the same effect, then, of course, the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of their piracy.”

In *Barran v. Lomas* (*h*), Jessel, M.R., said: “It is a fair observation to make that when you come to try a case of piracy the first point to be considered is whether the similarity or dissimilarity strikes the eye,” and he held that the production of an article containing an alteration which does not substantially change the design is still an infringement; thus, if one register lace worked in the shape of animals and trees with dots between, another designer cannot escape the penalties of infringement if he vend the same design, though with the omission of the dots. But in *Grafton v. Watson*, Chitty, J., said: “‘Obvious’ does not mean that which is obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or a jury with the assistance of experts—persons conversant with the particular trade” (*i*).

So in *Birkin v. Pratt* (*j*), where competing patterns for lace were concerned, Romer, J., held, after hearing expert evidence, that there was no infringement, the difference between the two patterns being so considerable that the one could not be mistaken for the other.

But in *Oliver v. Thoruley* (*k*), the same judge granted an injunction to restrain a competing lace design which varied in several particulars from the plaintiff’s design, “the essential features being taken, and the differences, which were differences in detail, not preventing the two designs from being essentially the same.”

In *Walker v. Hecla Foundry Co.* (*l*), a further qualifi-

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

(*i*) (1884) 50 L. T. N. S. 422. See *Werner Motors v. Gamuge’s, Ltd.* (1903), 21 R. P. C. 137, as to the nature and extent of the expert evidence which may be admitted. In *Gordon & Munro v. Patrick*, *supra*, Cave, J., in directing the jury, said: “It seems to me that no evidence can affect the matter; it is for a plain common-sense man to say, when he looks at these things, whether they are substantially the same or substantially different.”

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

(*k*) (1896) 13 R. P. C. 391. For illustrations of the designs in this case, see Appendix F., Sheet 11, p. 433.

(*l*) (1887) 5 R. P. C. 365; and in the House of Lords (1889), 6 R. P. C. 554.

ation—state of previous knowledge—was added. There the design in question was one for a door for a convertible kitchen-range—a rectangular door with a moulding cast on the top of it. The alleged infringement was a rectangular door surrounded by a moulding, and except that the moulding had a different section from the moulding of the former door, if the doors were represented in a drawing there would be nothing to distinguish the designs; but there was a difference when the doors were looked at in section. It was decided that there was an infringement, and on appeal this was confirmed by the Court of Appeal and again by the House of Lords, where Lord Herschell said: “In such a case (where the protection is granted for the shape and for that alone) the only question is whether the shape of what is impeached is the same, or whether the one is an obvious imitation of the other, without reference to whether it does or does not accomplish the same useful end. . . . It seems to me, therefore, that the eye must be the judge in such a case, and that the question must be determined by placing the designs side by side and asking whether they are the same, or whether the one is an obvious imitation of the other. I ought, perhaps, to qualify this by saying that, as a design to be registered must, by sect. 47, be a ‘new or original design, not previously published in the United Kingdom,’ one may be entitled to take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial. Applying the test which I have laid down, I have come to the conclusion that there has been a violation of the respondents’ rights.”

This qualification was applied in *Walker v. Scott (m)*, where the plaintiff had registered a tin oil-can for cyclists, rounded at the edges, and the defendant sold an oil-can similar to the plaintiff’s save that the edges were sharp. It was decided that since the only novelty in the plaintiff’s can was the rounded edges, and as the defendant had not copied these, there had been no piracy.

In *Staples v. Warwick (n)*, S. registered a design consisting of a *conical tower* in the form of a lighthouse, with a spiral slide round it, the design being intended to be applied to a means of popular amusement called a “Helter-Skelter.” An interlocutory injunction was obtained against W. for an alleged infringement, and W. afterwards made alterations in

(m) (1892) 9 R. P. C. 482.

(n) (1906) 23 R. P. C. 609. For illustrations of the designs in this case, see Appendix F., Sheet 3, p. 425.

his tower, making the top castellated. A conical tower with slide round it was old for the purpose. The plaintiff contended that the defendant's tower as altered was still an infringement of his registered design, and obtained an order to commit for breach of the injunction. It was held, by the Court of Appeal, that the defendant's tower as altered had not the only novel feature of the plaintiff's design, viz., the lighthouse, and did not infringe the plaintiff's design, and the appeal was allowed.

In giving judgment, Collins, M.R., said: "Now we come to the question of infringement, which is simply a question of fact upon which one has to be guided by the eye; and when I look at the form, instead of finding a lighthouse I find apparently an ancient machicolated tower, which might be taken from some mediæval fortress, the very last object of which could be to light anybody, and not designed apparently to serve any such purpose at all. Therefore, looking at it as a juryman, I say the essence of the plaintiff's design is a lighthouse, and that is absolutely wanting in the defendant's. Therefore I cannot say that they correspond so exactly as for the defendant's to be an obvious imitation, and an imitation of that part which gives a special peculiarity and originality to the protected design. I find that the two differ in the most essential part, and therefore I am not going to suggest that the appellant has subjected himself to imprisonment by producing a design or executing or building a tower which is not, in point of fact, an obvious imitation of the plaintiff's. For these reasons, I think this appeal must be allowed."

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

In *Nevill v. Bennett* (*r*), the plaintiffs were owners of a registered design to be printed or woven on textile goods, and brought an action for infringement, which was denied by the defendants. It was said that all the defendants had done was

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

(*r*) (1898) 15 R. P. C. 413.

to take the plaintiffs' effect, and there were a number of alleged anticipations which could be developed to produce the same effect.

In giving judgment, Hall, V.-C., said: "The question is, in this case, whether the defendants have taken the plaintiffs' combination or whether they have merely copied the effect. Looking at what was done, that they had the plaintiffs' design before them, that the intention was to imitate as far as they safely could, that the same effect has been produced (one of the defendants himself said, 'ours could not have been produced if the plaintiffs' had not been before the designer'), and that, to the eyes of skilled men and to my own judgment, they have essentially reproduced the plaintiffs' combination, I am of opinion that the defendants have gone inside the line to the extent that they have produced an infringement of the combination, which was the essence of the plaintiffs' design."

Holden v. Hodgkinson Bros. (s) was an action for infringement of a registered design for tombstones. The plaintiff's design showed a stone 2 ft. 5 in. in height, having on either side an octagonal pinnacle supported by a black porcelain pillar with moulded bases and caps and three black studs; while the defendants' stone was 1 ft. 6 $\frac{3}{4}$ in. higher, there was a pinnacle on each side of the head-piece supported by a black porcelain pillar, but these were oblong two-sided pinnacles instead of being octagonal. Held, on the trial, that there was no infringement, and that though the defendants might have imitated the plaintiff's general idea, they had not taken his registered design.

In giving judgment, Lawrence, A. T., said: "I quite agree that mere differences of detail will not make the plaintiff fail at all because his design is for the shape and configuration. But to my mind the shape and configuration of these two stones is, from my point of view of art, or beauty, or design, quite different. The relations of one set of lines to the other are all, to my eye, quite different. . . . The two designs seem to me to make totally different looking objects. . . . It is quite possible the plaintiff may be right in supposing that the defendants made their tombstone from an idea suggested by seeing the tombstone of the plaintiff, but it is not sufficient to say that. He must be able to say that the defendants have made something which is an obvious imitation of it."

§ 153. If there be an infringement, *bonâ fide* intention not to infringe will not protect (*t*), though fraudulent

(s) (1904) 22 R. P. C. 10. For illustrations of the designs in this case, see Appendix F., Sheet 2, p. 424.

(t) Lord Shand in *Walker v. Hecla Foundry Co.* (1888), 5 R. P. C. 365, 367; *Mitchell v. Henry* (1880), 15 Ch. Div. 181.

imitation will in such case be rebutted. The question of infringement depends upon what a man does, not on what he intends (*u*). The sale of a single article without permission is sufficient to found the action (*x*).

§ 154. The Act does not apply to the things to which a design is applied, but only to the design itself as so applied (*y*), and an imitation of the “utility” contained in a new shape or pattern is no infringement unless the design itself is copied.

In *Gillard v. Worrall* (*z*), the plaintiff was owner of a registered design for gas jets for bakers’ ovens, and alleged infringement against the defendants, which they denied.

In giving judgment, Hall, V.-C., said: “It is said that the plaintiff’s design has many advantages, that it has the advantage of being out of the way when tins are being put into the oven and being arranged and pushed about inside the oven. I am not trying a patent action, an action of utility; the action is one for infringement of design, and although upon inspection of that design it is evident that advantages follow, and those advantages are not to be overlooked . . . I am of opinion that this is not a new or original design. But even if it is a new and original design, looking at it not as a patent and not as a contrivance for economising the tube required or anything of that sort . . . looking at it as a design, looking at what the plaintiff has done and what he holds out, it seems to me there is a marked difference between the two, to judge by the eye . . . and the defendant’s is not an infringement.”

§ 155. So far as similarity or identity of designs is concerned, the question of novelty (apart from questions of priority) and the question of infringement raise almost precisely the same kind of considerations, and the decisions dealt with in the chapter on “Novelty” may be referred to here (*a*). Hence an action for infringement

(*u*) *Stead’s Patent* (1847), 2 W. P. C. 123, 156.

(*x*) *Cole v. Saqui* (1888), 5 R. P. C. 491, 493.

(*y*) Per Lindley, L.J., in *Clarke v. Saxe (Re Clarke’s Design)* (1896), 13 R. P. C. 351.

(*z*) (1904) 22 R. P. C. 76. For illustrations of the designs in this case, see Appendix F., Sheet 1, p. 423. See the observations as to “utility” as an element in deciding as to novelty or infringement in § 42, *ante*.

(*a*) See Chap. III., “Novelty,” *ante*, p. 30 *et seq.*

is often met with a motion to expunge from the register for want of novelty the design alleged to have been infringed, and much of the evidence and arguments will apply to action and motion alike (*b*).

In *Re Bayer's Design* (*c*), the difference between the two proceedings was put by Fletcher Moulton, L.J., in the following terms:—"In an action for infringement of a design the counsel for the plaintiff is in the dilemma that if he puts too narrow an interpretation on his claim the defendant is not an infringer, but if he puts too broad an interpretation on his claim it may be held invalid. But when the application is to strike the design off the register the counsel for the respondent is in no such difficulty. It is to his interest to represent the claim as narrow as possible, narrow even to the limit of absolute worthlessness; because, if by any interpretation, however narrow, he can bring it within the limit of a valid registration, he succeeds in the litigation, and when he has succeeded he then may use his design as a valid design, and the exact limit of interpretation by which alone he succeeded in supporting its validity can be known to but few of the public. It is therefore a very different claim when used offensively from what it is when used defensively."

(*b*) *E.g.*, *Le May v. Welch* (1884), 28 Ch. Div. 24; *Clarke v. Saxe* (*In re Clarke's Design*) (1896), 13 R. P. C. 351; *Morton v. Emanuel* (*Re Morton's Design*) (1899), 17 R. P. C. 117; *Rollason v. Heath* (*Re Rollason's Design*) (1897), 14 R. P. C. 893-909.

(*c*) (1907) 24 R. P. C. at p. 75.

CHAPTER X.

REMEDIES FOR INFRINGEMENT.

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

- § 156. The Statutory Penalties.
- § 157. Separate Penalty incurred for each offence—*Ex parte Beule* ; *Rivett v. Grimshaw*.
- § 158. Award of Lump Sum for Penalties.
- § 159. Principles of Assessment—*Saunders v. Wiel*.
- § 160. Alternative Remedy by way of Damages.
- § 161. Assessment of Damages—*Davenport v. Rylands* ; *British Motors v. Taylor*.
- § 162. Equitable Relief granted in addition to Remedy under Statute.
- § 163. Intention to Infringe sufficient for Injunction.
- § 164. Grounds on which Injunction granted—*Geary v. Norton* ; *Procter v. Bayley* ; *Werner Motors v. Gamage's*.
- § 165. Considerations affecting Applications for Interlocutory Injunction—*Mitchell v. Henry* ; *Knowles v. Bennett*.
- § 166. Plaintiff's conduct affecting Right to Relief.
- § 167. Delivery up of Pirated Articles—*Hole v. Bradbury* ; *Boosey v. Whight* ; *Knowles v. Bennett*.
- § 168. Certificates of Validity.—Costs.

§ 156. The Act provides (*a*) that any person who infringes shall “be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt. . . . Provided that the total sum in respect of any one design recoverable as a simple contract debt shall not exceed one hundred pounds.”

The power to determine the amount of the penalty rests with the Court, save that a maximum is fixed.

Before the Act of 1888, which introduced this limitation (*aa*), Manisty, J., had a case before him, *Sherwood v. Decorative*

(*a*) Act of 1907, sect. 60 (2).

(*aa*) Sect. 7 (2).

Art Tile Co. (b), in which the infringers had sold 100 tiles, wrongful imitations of the plaintiff's designs, and he fixed the penalty at 50%, saying that it could not have been meant by the Legislature that on a sale of 100 tiles the penalty should be 5,000%.

§ 157. The Act provides that the sum forfeited in respect of any one design shall not exceed 100%; but it is submitted that this does not mean more than that the amount shall not exceed 100% in respect of each design, the infringement of which the accused is found guilty of in the one action, and does not import a license to pirate generally, subject to the liability to pay the maximum penalty.

The old Act of 1842 had an express provision to this effect—"but the aggregate amount of penalties for offences in respect of any one design committed by any one person *up to the time at which any of the proceedings herein mentioned shall be instituted*, shall not exceed the sum of 100%." (*bb*); and under the Copyright Act of George III. (*c*) it was decided, in respect of books, that two penalties might be recovered for infringement on the same day, if the facts of sale were independent and distinct (*cc*).

So in *Rivett v. Grimshaw (d)*, which was an action for infringement of a registered design of a bassinette, evidence was given of the exposure of one copy on the 10th June and sale of another on the 14th October following, and on the direction of the judge the jury awarded the full penalty of 100%, being 50% for each offence.

In *Ex parte Beale (e)*, where the words of the statute (*f*) were "such person for every such offence shall forfeit to the proprietor of the copyright a sum not exceeding 10%," Blackburn, J., said: "It is quite clear that this imposes a penalty for every copy sold; a different construction would result in an absurdity and defeat the intention of the Legislature. The penalty is imposed also for importation, and it

(b) (1887) 4 R. P. C. 207.

(c) 15 Geo. III. c. 53.

(d) (1894) 11 R. P. C. 351.

(e) (1868) L. R. 3 Q. B. 395.

E.

(bb) Sect. 8.

(cc) *Brooke v. Milliken* (1789), 3 T. R. 509.

(f) 25 & 26 Vict. c. 68, s. 6.

would be monstrous that if a man had consigned from abroad a cargo of imitations the utmost penalty that could be imposed on him would be the sum of 10%. It would be well worth his while to run the risk of paying that small sum and to import and distribute for sale elsewhere a quantity worth many thousands.”

§ 158. The statute does not prescribe any minimum penalty, but the sum awarded in respect of each offence should be one which is recognizable and would form the proper subject of execution; though where there are a large number a lump sum may be given to cover the whole (*g*).

In *Hildesheimer v. Faulkner, Ltd.* (*h*), it was laid down that the Court is not bound in an action to recover penalties to award for each offence the sum of one farthing. It may award a sum which, if divided by the number of offences, will give for each offence something which is not recognised as a coin of the realm. Collins, L.J., in giving judgment, said: “The action was brought not in respect of one infringement, but in respect of a million; there was one judgment and one sum recovered, though it was assessed with reference to each offence. There was no question of levying more than one sum, and there was no necessity for the purpose of levying execution to assess any particular sum in respect of each offence. The only reason for fixing a farthing as the minimum of damages was because execution cannot be issued for less. . . . *Ex parte Beale* could not be overruled now, even if it were not, as he thought it was, a right decision; but the Court was not bound to fix a penalty at a farthing, for it was not limited by the standard of coinage existing from time to time.”

§ 159. Where the piracy results from accident or mistake, or where there are no aggravating circumstances, the penalty will be light.

In *Saunders v. Wiel* (No. 2) (*i*), Cave, J., said: “The next question is what sum of money ought I to give by way of judgment. This is a penalty. That has been decided in this very case (*k*). It is an action for a penalty, and the maximum sum is 50% for each occasion. Now a penalty is punishment, and punishment is to be awarded in proportion to what it is that the offender has done, and no doubt if he has done it

(*g*) See, e.g., *Ellis v. Marshall* (1895), 64 L. J. Q. B. 775.

(*h*) [1901] 2 Ch. 552, followed in *Nicholls v. Parker*, 18 T. L. R. 459.

(*i*) (1892) 9 R. P. C. 467, 470.

(*k*) *Saunders v. Wiel* (No. 1), 9 R. P. C. 459.

under circumstances of aggravation the punishment ought to be heavier. If he has done it under circumstances of mitigation, the punishment ought to be lighter, and in one of the cases which has been already decided on this statute, the Court has drawn attention to that circumstance, and said that where the piracy results from accident or from mistake, then the judge may reduce the penalty: the judge has the power of reducing the penalty to a merely nominal one, and in that way of not confounding the innocent with the guilty. In this case no circumstances of aggravation have been brought before me at all. I am left by both parties entirely in the dark as to how I should limit this penalty. . . . Under the circumstances, I think I must give a nominal penalty which, if further piracy goes on, would, of course, be a very good ground for increasing it in a subsequent case. Two cases have been proved. I do not know that there are any more, and in respect of those two cases I think it is sufficient if I give the nominal penalty of 20s. in each case, making 40s. altogether.”

§ 160. The penalty provided by the statute may not be sufficient to recoup the proprietor for the damage done to him by the infringement, and the Act therefore provides him with an alternative remedy in the shape of an action for damages. It is enacted by the same section of the Act (sect. 60 (2) of 1907) as follows:—

“Or if the proprietor elects to bring an action for the recovery of damages for such contravention and for an injunction against the repetition thereof, he (the infringer) shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly.”

§ 161. The plaintiff may be called upon to elect whether he proceeds for penalties or for damages under the section (1), and he cannot pursue both remedies together. Where the proceedings are for damages, the damages suffered must be proved; but if a case of infringement is made out an inquiry as to the amount of the damages to be awarded may be ordered.

Apart from special circumstances, the basis on which

(1) *Saunders v. Wiel* (No. 1) (1892), 9 R. P. C. 459.

damages are to be awarded will be the profit which the proprietor of the design would have made if he had granted a license for sale of, or himself sold, the copies improperly made and issued by the infringer.

In *Pike v. Nicholas* (*m*), which was a literary copyright case, James, V.-C., said: "The defendant is to account for every copy of his book sold as if it had been a copy of the plaintiff's, and to pay to the plaintiff the profit which he would have received from the sale of so many additional copies"; but this, of course, will only apply in designs cases, where the two articles may be said strictly to compete.

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

In *British Motor Syndicate v. Taylor* (*o*) the owners of a patent for an invention of a starting apparatus for motor gas engines having commenced an action for infringement of the patent, an order was made in chambers by consent for an inquiry as to damages. The defendants contended that the damages should be assessed at 3*l.* 10*s.* per starter, being the royalty of 3*l.* usually required by the plaintiffs, together with 10*s.* for the average profit of manufacture. The plaintiffs alleged that the royalty of 3*l.* was only charged to licensees who guaranteed a yearly minimum, and that no user had been charged less than 10*l.* The master assessed the damages at 218*l.*, being 8*l.* for each of the twenty-seven starters, and the defendants thereupon applied to vary his certificate.

Held, that the defendants were liable in respect of each of the twenty-seven articles, and that the damages must be assessed at 5*l.* per article. In giving judgment Stirling, J., said:

(*m*) (1870) L. R. 5 Ch. 260.

(*n*) (1865) L. R. 1 Eq. 302, 308. And see *United Horseshoe and Nail Co. v. Stewart* (1888), 5 R. P. C. 260; *American Braided Wire Co. v. Thompson* (1890), 7 R. P. C. 47.

(*o*) (1900) 17 R. P. C. 189.

“The remaining question is as to the amount of damages. The principles on which these are to be assessed were much discussed in the recent case of the *Pneumatic Tyre Co., Ltd. v. Puncture Proof Pneumatic Tyre Co., Ltd.* (oo). There the Lord Chief Justice, in giving judgment, says this: ‘I will first consider what is the true principle upon which, in such a case, the damage is to be assessed. No doubt the defendants are to be treated as wrong-doers. They have done something which they are not entitled to do; but before the plaintiffs are entitled to recover, even as against a wrong-doer, they have to prove damage to themselves. All that can be said in the case of a man who is a wrong-doer is, that when the damages come to be considered, juries and Courts, where they are performing the functions of juries, deal with them, and commonly and usually deal with them, with a more or less liberal hand; but still the question that must be proposed to a jury or to a judge is, what is the damage which, in such a case as this, the plaintiffs have sustained? It seems to me that, applying that principle to the facts of this case, the plaintiffs are entitled to be compensated for the injury that they have suffered by reason of what the defendants have done, and wrongfully done; and in such a case as this, or a case somewhat like this, the damages would be properly divisible under these two heads: what injury has been done to the plaintiffs by reason of their article being shoved out of the market, or, to use the expression, I think, of Lord Watson, “shouldered” out of the market; to what extent has their trade been injured? And if the case were one in which the infringing articles were put forward under circumstances in which it might affect the reputation and character of the plaintiffs’ business, that would also, in my opinion, be a proper subject to be considered. It has been said that the principle ought to be the principle of what the defendants would have had to pay for permission to do the thing which, unauthorised and wrongfully, they did. In cases where there is a commercial known standard of license for the manufacture of a particular article—and particularly in the case where the patentee is not himself a manufacturer, but makes his profit simply by the granting of licenses—the measure of damage may, in such cases, be the cost of the license. It may be, but I think, upon an examination of all these cases, it will be found that, underlying the measure of damage, there is the assumption that if it had not been that the particular defendant manufactured the particular things, then that those particular things would have been manufactured by the plaintiff or his licensees. . . .’ I think that, having regard to the prices actually paid by the defendants themselves, the amount suggested by them is too little; and remembering that I am dealing with wrongdoers and entitled to fix the damages on a liberal scale,

I have come to the conclusion that the amount to be assessed for each article ought to be 5/." On appeal (*p*) Lord Alverstone, C.J., said: "I see no materials upon which we can properly come to the conclusion that the learned judge, adopting, as in my opinion he has rightly adopted, the true principle, namely, of what the defendants would have had to pay for the permission to do that which they wrongfully did, which is the test he lays down, was wrong in assessing the figure at 5/."

In *Ingram & Kemp v. Edwards* (*pp*), where infringement was found of a design for gas pendants, Wills, J., in directing the jury, said: "What are the damages up to the present time? The sales of the pendants amount to fifteen guineas . . . on that sale the plaintiffs are entitled to the profit which the defendants have made, which would be five guineas. You are urged to give something more. I cannot quite see that. The sale of the very small number of these things is not likely to have damaged the plaintiffs in any other way. Nor, as far as I know, has it ever been held that because the imitating article is an inferior looking article, therefore if it is supposed to be the original one it would damage it in that way. I never heard of there being damages for a sort of libel on the respectability and honour of the original design. If you think that what I have suggested ought to be increased by what I may call general damages, then you will increase them. It is not a case in which, so far as I can see, there is anything like evil conduct which would make one incline to swell the damages beyond what is quite reasonable."

§ 162. As the right of ownership in a design exists apart from the statute (*q*), though methods by which it is to be protected are named in the statute, the proprietor is not excluded from other remedies, which are provided by the general equitable jurisdiction of the Courts. Thus, an account of profits may be ordered in lieu of the statutory damages, and if the legal right cannot be made otherwise effectual the Court will, in the exercise of its discretion, grant an injunction restraining either an actual or intended infringement (*r*). The principles

(*p*) (1900) 17 R. P. C. 723.

(*pp*) (1904) 21 R. P. C. 463.

(*q*) See observation on this question, *ante*, p. 53 *et seq.* But see *Woolley v. Broad* (1892), 9 R. P. C. 208.

(*r*) *Wilkins v. Aikin*, 17 Ves. 425. The statutory remedy does not prevent the granting of an injunction as additional relief. *Cooper v. Whittingham* (1880), 15 Ch. Div. 501; and see *Hole v. Bradbury*, 12 Ch. D. 886.

on which an account of profits will be ordered are the same as in patent cases, and full discovery will be ordered, in a proper case, in aid of this form of relief.

In *Saccharin Corporation v. Chemicals and Drugs Co.* (s), which was an action for infringement of patent, judgment was entered for the plaintiffs and an account of profits ordered. The defendants were willing to allow the plaintiffs, for the purpose of ascertaining such profits, inspection of the books, but with the names and addresses of customers sealed up. The plaintiffs claimed the right to inspection without such sealing up, and, on the refusal of the judge (Cozens-Hardy, J.) to order it, appealed, alleging that the disclosure was necessary to enable them to investigate the amount of profits. On the appeal it was held that the plaintiffs had the right to the disclosure of the names and addresses, and the appeal was allowed.

In giving judgment, Alverstone, M.R., said: "In nothing that I shall say do I wish to throw any doubt on the distinction between a patentee who elects to take an account of profits and a patentee who takes an inquiry as to damages. As was pointed out in the House of Lords in *Nicholson v. Betts* (ss), and to my knowledge it has been recognised for many years, the patentee who elects to take profits stands in the shoes of the infringer, and condones, so to speak, his wrong, and is entitled only to those profits. It is not disputed that, in the case of an inquiry as to damages, there is no right to cover up the names. That was decided in *Murray v. Clayton* (t) in the year 1872, and it has been followed in the *Braided Wire Case* and in more than one other case. The same principle was applied in the case of the *Leather Cloth Co. v. Hirschfeld* (tt), where, although it is quite true that the form of the inquiry was as to damages, the actual inquiry was as to the number of articles which the defendant had disposed of, and the objection was taken as to the names of the customers being disclosed. But I think that, upon principle, the rule laid down in *Murray v. Clayton*, was the right rule; and that when you are dealing with the case of a wrong-doer you must not be very astute to prevent him from giving full discovery, because some consequences may flow from the fact that discovery has been occasioned by his own wrongful act."

§ 163. In determining whether an injunction should be granted, the Court acts upon the general principles

(s) (1900) 17 R. P. C. 612.

(t) (1872) L. R. 15 Eq. 110.

(ss) L. R. 4 H. L. 22.

(tt) 1 H. & M. 295.

applicable to the granting of injunctions. Thus, if a design has been infringed there is a *prima facie* right to an injunction (*t*), the reason being that it is to be presumed that the infringer intends to go on infringing. Also, if there has been no actual infringement, but an intention to infringe is shown, an injunction will be granted (*u*); and it is not necessary to show that damage has been caused by the piracy to the proprietor (*x*).

§ 164. The proprietor is entitled to an injunction restraining not only sale, but manufacture of articles to which the design is applied with intent to sell at the expiration of the copyright (*y*). So an injunction has been granted in a patent case though the patent was about to expire in a few days, the object being to prevent the manufacture of pirated goods with a view to throwing them on the market the moment the patent should expire (*z*).

If the person who infringes undertakes not to repeat his infringement, or if there is reason to suppose on any other ground that the defendant will not infringe in future, the Court will or will not make an order for injunction, according to the other circumstances of the case.

In *Geary v. Norton* (*a*), an injunction was given against tradesmen selling articles which infringed the plaintiff's design, though the defendants promised to commit no infringement in future. In *Millington v. Fox* (*b*), the defendant innocently used the plaintiff's trade mark, and did not intend to use it again, but the Court granted an injunction.

(*t*) *Proctor v. Bayley* (1889), L. R. 42 Ch. Div. 390.

(*u*) Per Jessel, M.R., in *Cooper v. Whittingham* (1880), 15 Ch. D. 501.

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

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

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

(*a*) (1838) 1 De G. & Sm. 9.

(*b*) (1838) 1 De G. & Sm. 9. And see *Losh v. Hague* (1837), 1 W. P. C. 200.

In *Proctor v. Bayley* (c), these two last-named cases were explained by Cotton, L.J., who said that the injunctions were granted because there was some reason to fear at the date of the filing of the bills that the plaintiffs were not safe, and that "where a patent is infringed the patentee has a *prima facie* right to an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so"; but in the case before him he came to the conclusion that though the defendants had infringed the patent, the plaintiff was not justified in believing that they had any intention to infringe again, and that with proper inquiry he might have known this; and upon this finding an injunction was refused. Fry, L.J., added that a "foolish attempt to justify a past act does not raise any presumption that they intend to repeat it."

In *Werner Motors v. Gamage's, Ltd.* (d), the plaintiffs registered a design "for the pattern as shown of a motor-cycle frame," and in August, 1902, commenced this action for alleged infringement by sales made by the defendants. The defendants denied infringement, and alleged that the sales made by them before action were without knowledge of the registration, and although they had made a few sales after action they had never threatened to do any wrongful act. It was held by Byrne, J., that the fact of the registration was unknown to the defendants before action and their acts until then were protected as far as penalties and damages were concerned, but that, having regard to the subsequent sales and the position taken up by the defendants on the motion and subsequently, the plaintiffs were entitled to the injunction.

In giving judgment for the plaintiffs, Byrne, J., said: "The defendants have not themselves applied the design, and their acts, so far as penalty or damages are concerned, appear to be protected up to the date of the service of the writ. This, however, will not protect them against an injunction unless they can bring themselves within the exception from the general rule mentioned in *Proctor v. Bayley*. I have no doubt at all but that the defendants were threatening and intending at and after the date of the service of the writ to sell machines to which the registered design had been applied. If on service of the writ they had written and said that they had been in ignorance of the registration, and that they did not mean to sell any more machines, or if on the motion they had offered an undertaking not to sell any more, the matter would have stood on an entirely different footing. . . ."

(c) (1889) 42 Ch. Div. 390, 400.

(d) (1903) 21 R. P. C. 137; and on appeal, *Ibid.* 621. See *Britain v. Kennedy* (1902), 19 T. L. R. 122.

§ 165. When an interlocutory injunction is asked for, and a *prima facie* case is made out by the proprietor of the design, the Court will either grant the injunction or will order the application to stand over until the trial. If the former course be adopted, the plaintiff will be required to give the usual undertaking as to damages; if the latter, the defendant will be ordered to keep an account. The balance of convenience determines what ought to be done (*e*). “It must be seen what way the rights of the parties may best be protected and the least loss to any party caused” (*f*).

An injunction has this advantage, that it may have an effect in preventing third parties infringing. But where there is grave doubt as to the title (*g*), or where there is a serious conflict as to the originality of the design (*h*), or where the plaintiff has delayed his application, the Court will not willingly interfere by way of interlocutory injunction.

In *Mitchell v. Henry* (*i*), the plaintiffs alleged that the defendants had imitated their trade mark, and the Court of Appeal, finding that there was a serious conflict of evidence, refused an interlocutory injunction, but ordered the defendant to keep an account. James, L.J., said: “Then with regard to the balance of convenience and inconvenience, it seems to me by far the most convenient course that no injunction should be granted, and that the motion should stand over to the hearing, the defendants undertaking to keep an account. The plaintiffs can protect themselves, as they have to a great extent already done, by circular. Moreover, the pendency of these proceedings will be perfectly well known. Every large purchaser in Bradford or elsewhere will know of them, and will know that he will incur liability if he makes himself a party to any continued infringement of the plaintiffs’ rights, should those rights be established at the hearing. If that should be the result of the action, the defendants who under-

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

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

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

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

(*i*) (1880) L. R. 15 Ch. Div. 181.

take to keep an account will be liable to pay to the plaintiffs every farthing of the profits they make by the sale of goods by which the plaintiffs' mark is infringed, and will find themselves in this position, that they will have been using a trade mark which they will be prevented from using afterwards, and so will lose all the reputation they have been acquiring in the meantime. Then, again, the plaintiffs will be relieved from the necessity of giving an undertaking to abide by any order as to damages if the defendants should prove successful at the hearing. Therefore, on the balance of convenience and inconvenience, and having regard to the fact that the decision of the Master of the Rolls was in favour of the defendants, which ought not to be overlooked on an interlocutory application, I am of opinion that the better way will be to let the motion stand till the hearing, the defendants keeping an account."

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

In *Knowles v. Bennett* (*l*), the plaintiffs, the owners of a registered design for shawls, which were sold in Eastern markets, discovered that B. & Sons were printing and B. was shipping to the same markets shawls which were infringements of the registered design, and issued a writ and gave notice of motion for an injunction to restrain the defendants from infringing and to stay the delivery of goods already shipped. On the hearing of the motion an injunction was granted till the trial of the action, which was subsequently settled, the defendants consenting to an order making the injunction perpetual and requiring the delivery of the infringing goods. Robinson, V.-C., held, on the question of balance of convenience and inconvenience in granting the injunction, that the fact that the alleged infringing goods were being sold at a lower price was a material consideration, for, said the Vice-Chancellor, "it is difficult to say what the exact loss might be which the plaintiffs might sustain if the injunction were not granted. They might be supplanted in a trade which they had to a certain extent established in the East by the sale of goods of a cheaper class—the result might possibly be that the plaintiffs' trade might be taken away from them."

(*k*) (1884) 50 L. T. N. S. 420; and, on appeal, 51 L. T. N. S. 141.

(*l*) (1895) 12 R. P. C. 137.

§ 166. Misrepresentation of his right may deprive the proprietor of a design of the equitable relief by injunction, but it must be directly connected with the registration, and a mere excess of claim or misdescription, if *bonâ fide*, will not affect his rights (*m*).

In *Sen Sen v. Britten* (*n*), the plaintiffs had, since 1896, imported into the United Kingdom and sold cachous in distinctive boxes and packets with the mark "Sen Sen" on them and the words "Trade mark" below, and they brought this action against B. to restrain him from passing off his goods as the plaintiffs', and moved for an interlocutory injunction. In addition to other defences, it was contended for the defendant that since the words "Sen Sen" were not registered as a trade mark, the plaintiffs were making a misrepresentation that disentitled them to relief.

Stirling, J., after referring to sect. 105 of the Act, said: "Of course, if the plaintiffs are brought within the terms of that section they must be denied relief, and I go further and say, that without committing an offence under this section the plaintiffs might undoubtedly be guilty of such misrepresentation as not to entitle them to relief in a court of equity. . . . But the offence consists not in applying to any article sold a trade mark, but in representing that that trade mark is registered. The contrast is very strong between what is enacted in that respect and what is enacted with respect to a patent. If he represents that any article sold is a patented article when no patent has been granted, then he commits an offence; but it is not said if he represents that he has a trade mark and that trade mark is not registered then he commits an offence."

§ 167. There is no express provision for delivery-up of pirated articles, and there is probably no such right at common law (*o*), but this further remedy is part of the relief included in the equitable jurisdiction of the Courts, and will now be granted in every proper case in addition to the statutory remedies.

Thus, in the case of *McCrea v. Holdsworth* (*p*), Knight-

(*m*) *Harper v. Wright & Butler* (1895), 12 R. P. C. 483; *In re Bayer's Design* (1906), 23 R. P. C. 553; and on appeal, per Vaughan Williams, L.J., 24 R. P. C. at p. 70.

(*n*) (1879) 16 R. P. C. 137.

(*o*) *Colburn v. Simons* (1843), 12 L. J. Ch. 388.

(*p*) (1848) 2 De G. & Sm. 497.

Bruce, L.J., ordered the delivery-up of the infringing articles to the plaintiff for destruction.

In *Hole v. Bradbury* (q), Fry, J., said that the Court could, under its general jurisdiction, order the delivery-up for destruction of all the articles manufactured contrary to the plaintiff's copyright. In making the order, the judge did not proceed under the Copyright Act, which gives this power, but under the general equitable jurisdiction of the Court, and the decision is therefore clearly applicable to infringements of designs.

In *Boosey v. Whight* (r) the plaintiff, having partially succeeded in an action for the infringement of his copyright (in this case the words of direction as to time and expression in sheets of music reproduced on perforated rolls forming part of a mechanical instrument), it was held that he was entitled to an order for delivery-up; but it was laid down that where the infringing parts can be severed the order will be for the delivery-up of such parts of the defendant's article as constitute an infringement of the copyright.

In *Knowles v. Bennett* (s), where goods infringing a registered design had been shipped for Eastern markets and a perpetual injunction had been granted against the defendants, the owner of the ships on which the goods had been shipped appearing and asking for the direction of the Court, Robinson, V.-C., held that they could not be ordered to deliver up the goods to the plaintiffs, but directed that they might be added as defendants with a view to his making an order restraining them from parting with the possession of the goods except to the plaintiffs.

§ 168. An addition to the old remedies is introduced by sect. 61 of the new Act, which declares that the provisions of the Act with regard to certificates of validity of a patent shall apply in the case of registered designs in like manner as they apply in the case of a patent. The provisions referred to are contained in sect. 35, which provides as follows:—

“In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and if the Court so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final

(q) L. R. 12 Ch. Div. 886.

(r) (1889) 81 L. T. N. S. 265.

(s) (1895) 12 R. P. C. 137.

order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges and expenses as between solicitor and client.”

The effect of this is to give the registered proprietor a right to a full indemnity for his costs and expenses when his copyright has once been challenged and established. And he may be entitled to the certificate of validity if it has been challenged, even though the defendant does not appear at the trial to support his objections (*t*). But where the Court has pronounced no decision upon validity or invalidity a certificate will not be granted (*u*).

The question of copyright being a separate issue to that of infringement, the registered proprietor may be entitled to a certificate of validity if he succeeds on that issue, even though he may fail in his action on the ground of non-infringement (*x*). The practice as to granting certificates of validity already established in connection with patents will be followed in all these cases (*y*).

(*t*) *Welsbach Incandescent Co. v. Krumm*, 18 R. P. C. 211; *Brookes v. Lycett*, 20 R. P. C. 392; *Soulastream, Ltd. v. Davey* (1907), 24 R. P. C. 763.

(*u*) *New Inverted Incandescent Gas Lamp Co. v. Cope and Timmins* (1906), 23 R. P. C. 103; *Same v. Globe Light Co.* (1906), *Ibid.*, p. 157.

(*x*) *Morrison v. Asplin*, 21 R. P. C. 557. And see *Hardtmuth v. Baker*, 22 R. P. C. 66.

(*y*) For the practice generally, see *Acetylene Illuminating Co. v. Midland Acetylene Syndicate*, 17 R. P. C. 534, and the notes to sect. 61, *post*, p. 251.

CHAPTER XI.

THE ACTION FOR INFRINGEMENT.

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

- § 169. Remedy now in High Court—Jurisdiction of County Courts—*Bow v. Hart.*
- § 170. Jurisdiction in Scotch and Irish Cases—*Bayer v. Connell.*
- § 171. Plaintiff's choice of Tribunal—Powers to Consolidate.
- § 172. Parties—Who may sue—Licensees or Assignees—*Woolley v. Broad.*
- § 173. Mortgagors and Equitable Owners—*Petty v. Taylor.*
- § 174. Proceedings by Unregistered Owners.
- § 175. Parties liable as Defendants—Agents and Principals—Several Infringers.
- § 176. The Writ—Notice before Issue—Indorsement of Claim.
- § 177. Pleadings—Necessary Allegations in Statement of Claim.
- § 178. Defences to the Action—Estoppel of Licensee.
- § 179. Particulars of Breaches and Objections—Application to Expunge.
- § 180. Amendment of Particulars.—*Woolley v. Broad.*
- § 181. Sufficiency of Particulars—Allegation of Common Knowledge.
- § 182. Inspection and taking of Samples—Enforcing Order.
- § 183. Notice of Motion or Summons for Inspection—Affidavit in support.
- § 184. When Inspection refused—Disclosure of Trade Secrets.
- § 185. Discovery of Documents and Interrogatories.
- § 186. Limitations to Plaintiffs' and Defendants' Rights of Discovery.
- § 187. Discovery in Actions for Penalties—*Titus Astle v. Mansfield.*
- § 188. Extended right of Defendant to Interrogate.
- § 189. Method of Trial—Right to Jury.
- § 190. Issues for Judge and Jury.
- § 191. Decision of Preliminary Questions of Law.
- § 192. Costs—New Statutory Provisions—Certificate of Validity.
- § 193. Costs of distinct Issues—*Winfield v. Snow*; *Blank v. Footman.*
- § 194. Costs on Higher Scale in certain Cases.
- § 195. Order when Defendant submits to Injunction—Illustrative Cases—*Cooper v. Whittingham*; *American Tobacco Co. v. Guest*, etc.

It is proposed in this chapter to deal with those particulars only in which actions for the infringement of

designs differ from other actions. The rules for an action of this class must be taken to be the same as those of any other action save where otherwise stated.

§ 169. By sect. 92 (1) of the Act “the Court” is defined as meaning (subject to the special provisions for Scotland, Ireland, and the Isle of Man) the High Court of Justice in England. The proper Court, then, for all proceedings in England would be the High Court, and this includes, by statute (53 & 54 Vict. c. 35) the Court of Chancery of the County Palatine of Lancaster so far as regards persons and property within its jurisdiction; but there is no such jurisdiction in the County Courts (*a*) except by consent (*b*).

In *Bow v. Hart* Vaughan Williams, L.J., in giving the considered judgment of the Court of Appeal, after referring to the argument based on the definition clause of the Act, said: “Then it is said that the jurisdiction is given by the Judicature Act, 1873, which gives, by sect. 24, to the High Court, whether in the King’s Bench Division or the Chancery Division, all the power and authority exercised by the Chancery Division; and it is said that the County Court, having the jurisdiction to entertain a personal action, where the debt, demand, or damage is not more than 50*l.*, can, by sect. 56 of the Act of 1888, entertain the present action and grant an injunction to restrain the defendant from infringing the plaintiff’s trade mark. I cannot agree. Such an action would not have been a personal action within the meaning of that word in sect. 58 of the Act of 1846 (*bb*), nor do I think that it comes within the meaning of the same word in sect. 56 of the Act of 1888. I think,

(*a*) *Bow v. Hart* (1905), 21 T. L. R. 251. And see the judgment of Kay, L.J., in *Reg. v. The County Court Judge of Halifax* (1891), 8 R. P. C. 338. In *Morton v. Emanuel (Re Morton’s Design)* (1899), 17 R. P. C. 117, the action was commenced in the Birmingham County Court, but on notice of motion being given in Chancery to expunge the registration, the action was stayed by order pending this motion. The case of *Moody v. Tree*, 9 R. P. C. 333, was tried in the County Court, but without the question of jurisdiction being raised.

(*b*) County Courts Act, 1888, s. 61. The consent must be in writing, and no evidence of title will arise on the judgment even as between the parties. As to claims for penalties only, see *infra*.

(*bb*) 9 & 10 Vict. c. 95.

therefore, that the County Court judge had no jurisdiction, and rightly refused to make any order in this action; and it follows that the decision of the King's Bench Division must be reversed. 'This is the judgment of the Court, and the appeal will be allowed, with costs.'

Under the older Acts the penalties might be recovered before justices of the peace or a police magistrate. It is now provided that the registered proprietor may recover "such sum as a simple contract debt" (*c*). In cases where no question of title is raised, and the claim does not exceed 100*l.* (*cc*), it may still be open to question whether the proceedings cannot be taken in the County Court as for a "simple contract debt."

§ 170. In Scotland and Ireland and the Isle of Man the jurisdiction of the Courts in any proceedings relating to designs is preserved, and the special jurisdiction conferred on "the Court," as defined by the Act, does not affect such proceedings (*d*). But these provisions only give a concurrent jurisdiction, and do not exclude proceedings in the High Court, even where the proprietor is resident in Scotland or Ireland (*e*).

The concurrent jurisdiction conferred by the Act on the Scotch and Irish Courts does not extend to proceedings for expunging entries from the register which is kept at the Patents Office in England, and all applications for rectification fall within the exclusive jurisdiction of "the Court," as defined by the Act (*f*).

In *Bayer v. Connell*, where the defendants met a claim for infringement by a cross motion in the Irish Chancery to

(*c*) (1907) Sect. 60 (2).

(*cc*) County Courts Act, 1903 (3 Edw. VII. c. 42).

(*d*) Sects. 94 and 95.

(*e*) *Re King & Co.'s Trade Mark* (1892), 9 R. P. C. 350.

(*f*) *Bayer v. Connell Bros.* (1897), 14 R. P. C. 275. But see *Cowie Bros. v. Herbert* (1896), 14 R. P. C. 436; and observations at p. 108, *ante*.

expunge the plaintiff's registration, the Master of the Rolls, referring to the provisions of the section (sect. 111 of 1883) which reserved the jurisdiction of the Irish Courts, said: "This is a very peculiar section. Usually, where a concurrent or co-ordinate jurisdiction is conferred upon the Courts in London and Dublin, 'the Court' is defined as meaning, in England, the High Court of Justice in England, and in Ireland the High Court of Justice in Ireland; and, if the defendant's contention in the present case is correct, sect. 117 (defining 'the Court' under the Act), taken in connection with sect. 111, must mean simply that. But the language of sect. 111 precludes that construction. Some distinction is plainly meant to be drawn between the special jurisdiction conferred by the Act and a jurisdiction not so conferred. . . . 'Required' (the word used in sect. 111) is an ambiguous expression, and may be 'necessitated.' The alteration or rectification is not spoken of as 'directed by' or 'ordered by' the Court, but 'required in pursuance of' an Irish order or decree. In the case of patents this would, no doubt, be strictly correct in any view. In the case of trade marks it would be strictly accurate if, in the course and exercise of its general jurisdiction, an Irish Court decided some question affecting the right to the registration; if, for instance, the ownership of the trade mark was decided to have been wrongly registered, on the ground of fraud or the like. The present action is itself an appeal to this general jurisdiction. In such a case the rectification of the register would be 'required in pursuance of' the decree in order to make the register correct, though it would not be 'required' in the sense of being ordered by the judgment."

§ 171. Design actions are not assigned to any particular division of the High Court, and the plaintiff is therefore free to choose. The Act provides (*g*) for certain cases being referred to a selected judge of the High Court whose decisions shall be final, but this does not apply to ordinary actions for infringement nor to motions to rectify, etc.

Should the plaintiff desire to try his action locally at the assizes, or should he desire a trial by jury, the King's Bench Division will be chosen. In other cases, and especially where an application to rectify

(*g*) (1907) Sect. 92 (2).

the register is to be made in connection with the same matter, the Chancery Division will be found the more convenient.

Where there are cross actions or motions, the powers of the Court to consolidate and transfer can be used to bring the whole matter to an issue (*h*). There are now no rules as to local venue, and the place of trial is determined as in other actions (*i*).

§ 172. The plaintiff, or one of the plaintiffs, in any proceedings for infringement must be a registered proprietor, and generally if any person other than the registered proprietor be made plaintiff, the action fails as regards him (*k*), subject to the exercise of the powers of amendment possessed by the Court (*l*).

The meaning of "proprietor" is to be found in sect. 93 of the Act (*m*), and from this it appears that, in addition to the original author, a licensee, assignee, or partial assignee from him may all be regarded as proprietors.

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

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

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

(*k*) *Woolley v. Broad* (1892), 9 R. P. C. 208. But see *Heap v. Hartley* (1889), 6 R. P. C. 495, where a distinction was raised in favour of licensees in cases of infringement with notice of an exclusive license. And see *Tuck v. Canton* (1882), 51 L. J. Q. B. 363, a copyright case.

(*l*) R. S. C. Ord. XVI. rr. 1—13.

(*m*) And see *ante*, Chap. VII., "Proprietor."

whatever damages he may have suffered. The hardship on D. is not so great as may at first glance appear. He would have to pay such damage to each party as each had suffered in respect of his limited interest; and if the suits were for penalties, the *maximum* amount would be 100*l.* (*n*), the exact amount being in the discretion of the Court. Moreover, application could be made to consolidate the actions (*o*), or to hear them together, or to treat one as a test action (*p*).

§ 173. Under the patents part of the old Act it was decided that an owner who had mortgaged by assignment could sue without joining his mortgagee (*q*), but that a licensee of a patentee could not sue without joining the patentee (*r*). A licensee of the proprietor of a design, however, being himself a proprietor, as defined by sect. 93 of the Act, can sue alone (*s*); in *Woolley v. Broad* (*t*) he was not allowed to do so, but in that case he was a mere licensee for sale and had no right to apply the design, and he had not been registered as proprietor.

The register does not contain notice of any trust, express, implied, or constructive (*u*), but equitable assignments may be registered, and if the registered proprietor is only a bare trustee he should be added as plaintiff. If, however, the wrong person is entered as proprietor on the register, this does not constitute him a trustee for the persons legally entitled, and the action may fail through

(*n*) (1907) Sect. 60 (2).

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

(*p*) *Amos v. Chadwick* (1878), L. R. 9 Ch. D. 459.

(*q*) *Van Gelder v. Sowerby* (1890), 7 R. P. C. 41.

(*r*) *Heap v. Hartley*, *supra*.

(*s*) See *Jewitt v. Eckhardt*, 8 Ch. D. 404.

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

(*u*) (1883) Sect. 85; (1907) Sect. 66; and see *ante*, Chap. VI., p. 94.

the defect in registration, even though these persons be co-plaintiffs in the action.

In *Petty & Sons v. Taylor* (x), drawings contained in a trade catalogue were made by T. and W. for a limited company, who paid for and used them. The drawings were made by T. and W. by the direction of the managing director of the company, who himself prepared the letterpress of the catalogue. The managing director, and not the company, was registered as proprietor of the copyright under the Fine Arts Copyright Act, 1862, s. 4, and as proprietor of the copyright in the catalogue under the Copyright Act, 1842, s. 13. There was no entry of any agreement in writing vesting the copyright in him. Upon an action being brought by the company and the managing director, as co-plaintiffs, for alleged infringement of the copyright, it was held, that the director had acted as representative of the company and not in his personal character, and as agent of and not as trustee for the company, and that he was not the proprietor of the copyrights under either Act, and that the registrations were therefore bad.

In giving judgment, Kekewich, J., said: "The action is brought by Mr. W. P. and P. & Sons, Ltd., as co-plaintiffs, and it is, in my opinion, the fact that P. & Sons, Ltd., are the proprietors, but they are not registered. Now, it seems to me decided, and it is perfectly clear, if I may venture to say so, with respect to a judgment of a learned Lord Justice, even without decision, that you cannot make a combination of two persons neither of whom is entitled to sue, and so make a person who is entitled to sue. In the case of the *London Printing and Publishing Alliance v. Cox* (xx), Fry, L.J., puts it in this way: 'I have no doubt whatever that a trustee in whom a copyright is vested may be registered as the owner, and may sue in that character; but it is impossible for one person to be the owner and another person to be on the register and for those two persons successfully to sue.' . . . If the thing was done for W. P. in his own personal character, he never purported to give directions, or to pay a bill, or in any way throughout to do anything of any kind connected with this business except in his character of representative of the incorporated company P. & Sons, Ltd. Then it is said he is trustee for the company. It is more easy sometimes to say that a man is a trustee than to explain how he is a trustee, or why, and this is an instance. In one sense he is a trustee for the company. I have no doubt that, if he can properly be held to be the proprietor of this copyright, he is a trustee

(x) (1896) 75 L. T. N. S. 545.

(xx) [1891] 3 Ch. 291.

of his proprietorship for the company. He cannot set up his own title against his principals, and in that sense he is a trustee, but he is not a trustee in the sense that any legal ownership ever became vested in him. Copyright is a thing known to the law as capable of assignment, capable of acquisition by proper ways, different, of course, from those connected with real estate, but still a property to be acquired in a particular way, and there is nothing to show here that W. P. ever acquired anything at all. He acted simply as the agent of others, namely, the incorporated company. . . . W. P. never assigned, and, in my judgment, for a very good reason—there was nothing for him to assign. He did not acquire the copyright for himself; he acquired it merely as an agent. The result is, in my opinion, W. P. has been wrongly entered as proprietor of this copyright, and on that ground the registration of the Art copyright fails. . . . The distinction between trustee and nominee is one which I have already noticed in giving judgment. I have only to say here, it seems to me, a trustee may be registered and can sue with or without the concurrence of the *cestui que trust*. A nominee, it seems to me, cannot be properly registered, and, if registered, cannot sue, notwithstanding that the person by whom he has been nominated, on whose behalf he purports to have a copyright, is a plaintiff.”

§ 174. Relief other than that specially provided by the Act may in some cases be given, even to an unregistered proprietor (*y*). Thus, it has been decided under the Copyright Act, 1842, that books could be ordered to be delivered up to the registered proprietor, though he was not registered until after the commencement of the action (*z*). And in a trade mark case an assignee of the registered proprietor was allowed to bring an action in his own name, without having registered the assignment (*a*).

§ 175. The defendant must be the infringer; if the

(*y*) Per Jessel, M.R., in *Cooper v. Whittingham* (1880), L. R. 15 Ch. D. 501; and see observations in Chap. VII., *ante*.

(*z*) *Isaacs v. Fiddemann* (1880), 42 L. T. N. S. 395; *Hole v. Bradbury* (1879), L. R. 12 Ch. D. 886.

(*a*) *Ihlee v. Henshaw* (1886), L. R. 31 Ch. D. 323; and see *Magnolia Metal Co. v. Atlas Co.* (1897), 14 R. P. C. 389.

infringer be an agent, his principal (*b*) will be liable also, though the agent will not escape (*c*).

In *Betts v. De Vitro* (*d*) directors were declared personally liable for the infringement of a patent by a workman.

In *Tonge v. Ward* (*e*) a principal was made liable for the infringement of the agent, though ignorant of what his agent was doing.

The patent cases throw light upon this point, though they do not always apply as to the facts which constitute a person an infringer, *e.g.*, user may be an infringement in patent cases, in design cases there is generally infringement only if there be application of the design to any article for the purposes of sale, or sale with knowledge of such application (*f*).

Where there is an extensive course of infringement by various persons, the proprietor of the design may either proceed by separate actions against each, or, and this is the better course, select that case which he thinks the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction, writing at the same time to all the other infringers who are *in simili casu*, with notice of the proceedings, and inviting them to concur in the decision in the pending case as determining any claim against them. In the absence of such concurrence proceedings might properly be taken against the other infringers, and this should be done forthwith to avoid any objection on the ground of delay (*g*).

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

(*c*) And see *Nobel Explosives Co. v. Jones & Co.* (1880), 17 Ch. Div. 721, and (on appeal) 8 App. Cas. 4.

(*d*) (1868) 3 Ch. 429.

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

(*f*) For the full treatment of this subject, see Chap. X. on "Infringement."

(*g*) Per Wood, V.-C., in *Bovill v. Crate* (1885), L. R. 1 Eq. 391. And see Edmunds on Patents.

§ 176. When a cause of action has arisen, it is not necessary to give notice before issuing the writ; and, as speed is often very desirable in matters relating to the infringement of copyright in designs, immediate issue of a writ will often be justifiable (*h*). But when it is intended to proceed against an infringer for publishing or exposing for sale a substance to which a protected design has been applied, “knowing that the same has been so applied without the consent of the registered proprietor,” notice should, if possible, be given before issue of the writ in view of the defence of *bonâ fide* want of knowledge. The new Act contemplates (*i*) proceedings without direct notice from the proprietor where the infringer has had knowledge of the copyright from some other source.

The writ should be indorsed with claim for an injunction if one be required; and if time be of importance, leave to serve the notice of motion with the writ should be asked for. Damages or penalties (but not both) should be claimed, and if delivery up or an account of profits is required, this also should be asked for (*j*).

§ 177. On the question of pleadings the provisions of Orders xix. to xxv. of the Supreme Court Rules apply. The Forms in the Appendices to the Rules do not contain any form strictly applicable to actions for the infringement of designs; but in Appendix C. forms are given of a Statement of claim for relief from infringement of a patent and copyright respectively, and in Appendix D. will be found the forms of Defence corresponding to these. The forms of pleading intended to

(*h*) See *Upmann v. Elkun* (1871), 5 R. P. C. 131; *Upmann v. Forester* (1883), L. R. 24 C. D. 231, and decisions below in § 195 as to “Costs.”

(*i*) See sect. 54 (1 b).

(*j*) For forms of Writ, see Appendix B., *post*, p. 390.

apply to actions in relation to designs may be deduced from these (*k*).

It will be enough to say in this place that the Statement of claim should in general contain allegations—

(1) That the plaintiff is the registered proprietor of a duly registered design.

(2) That the defendant has infringed his right (a) by applying the design or an obvious or fraudulent imitation of it to an article for the purposes of sale; or (b) by publishing or exposing for sale an article to which the design or an obvious or fraudulent imitation of it has been applied; or (c) by doing some act with a view to enable the design to be so applied.

(3) That the consent of the proprietor has not been obtained; and if the action be for publishing or exposing for sale only, then

(4) That the defendant knew that the consent of the proprietor had not been obtained (*l*).

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

The plaintiff must state clearly the nature of his claim and whether he is proceeding for a penalty or damages. If there is any doubt about this, the defendant may, by an application in chambers, require the plaintiff to elect under which part of the section (1907, sect. 60) (*n*) he will proceed; and if he declines to make an election he will be deemed to be proceeding for penalties.

(*k*) Forms of Statement of Claim are given in Appendix B., *post*, pp. 390—392; forms of Defence, *post*, pp. 393, 394.

(*l*) *Woolley v. Broad* (1892), 9 R. P. C. 209, 212.

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

(*n*) *Saunders v. Wiel* (No. 1) (1892), 9 R. P. C. 459.

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

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

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

(1) No infringement (p). This defence involves that the alleged imitation is in substance different to the design registered by the plaintiff.

(2) That the infringement (if any) took place abroad. This is really the same as a denial of any infringement, as infringement consists in the production for purposes of sale of the article in this country or the sale here of articles so produced (q). But if the article be made abroad and be imported for sale, there would be an infringement (r). If the sale and delivery both take place abroad there is no infringement (s), and this is so even

(o) For procedure on Applications to expunge or rectify, see *ante*, p. 108 *et seq.* Application may now be made to the Comptroller for cancellation on the ground of non-manufacture in the United Kingdom, but as this is also a ground of statutory defence, such an application would probably not be entertained during the pendency of an action. See sect. 58, and notes thereon, *post*, p. 238.

(p) See *ante*, Chap. VIII., “Infringement.”

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

(r) See, e.g., *Nobel Explosives Co. v. Jones* (1880), 17 C. D. 721; 8 App. Cas. 4; *British Motors v. Taylor* (1900), 16 R. P. C. 189; and on appeal, *Ibid.* 723.

(s) *Badische Anilin und Soda Fabrik v. Johnson* (1897), 14 R. P. C. 719.

though the contract for sale be made in this country, if it is for articles made abroad and delivered there (*t*).

(3) That the design is not proper subject-matter for registration within the meaning of the Act (*u*).

(4) That the design is not new and original (*x*).

(5) Prior publication (*y*). Particulars should generally be given; but if common knowledge is relied on it should be expressly pleaded, and in such cases particulars of prior publication or user need not be furnished (*z*).

(6) That the design was never properly registered. Under the old Acts it was held that it was no defence to an action for infringement that the design was registered in the wrong class (*a*); but, having regard to the provisions of sect. 49 (2) of the Act of 1907, it is doubtful whether this decision can now apply (*b*). It is certainly a good defence to show that the design was not registered in the class or classes of goods to which the alleged infringer's goods belong (*c*).

(7) That articles to which the design has been applied are not properly marked (*d*).

(8) That the plaintiff is not a registered proprietor (*e*).

(9) That the defendant did not apply the design, and sold the articles without knowledge of the plaintiff's rights.

(*t*) *Saccharin Corporation v. Reitmeyer* (1900), 17 R. P. C. 601; *Badische Anilin und Soda Fabrik v. Hickson* (1905), 22 R. P. C. 63, and on appeal, *Ibid.* 575.

(*u*) See *ante*, Chap. II., "Design."

(*x*) See *ante*, Chap. III., "Novelty."

(*y*) See *ante*, Chap. IV., "Publication."

(*z*) *Holliday v. Heppenstall* (1889), 6 R. P. C. 320.

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

(*b*) See *Hothersall v. Moore* (1892), 9 R. P. C. 27. See also sect. 57 of the Act.

(*c*) *Re Reul and Greswell's Design* (1889), 6 R. P. C. 471. See also *Re Clarke's Design* (1896), 13 R. P. C. 351.

(*d*) See *ante*, Chap. VIII, on "Marking."

(*e*) See *ante*, Chap. VII. on "Proprietor," and *ante*, §§ 172, 173.

(10) *Res judicata*. But it must be noted that (subject to the provisions of the new Act as to certificates of validity which, by sect. 61, now apply to designs) a decision does not determine the validity or invalidity of the design or its registration except as between the parties to the action (*f*).

(11) *Leave and license*. A license to one to manufacture an article with the design applied to it is a license to his vendees to sell it (*g*). But the publication of a book of designs by the owner of the copyright does not license the purchaser of the book to apply the designs to articles for the purpose of sale (*h*). And a license by one of two joint owners will furnish no defence (*i*), though any one of the co-owners may maintain an action for infringement (*k*).

(12) *Lapse of the copyright*. The registered proprietor is entitled to copyright during five years from the date of registration with optional extensions up to fifteen years (*l*), and it would be a defence that the alleged infringement was committed after the lapse of the copyright (*m*).

(13) *Manufacture wholly or mainly abroad*. Sect. 54 of the Act of 1883 provided for the cesser of the copyright in a design in another case, viz., “if a registered design is used in manufacture in any foreign country,

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

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

(*h*) *De la Branchardière v. Elvery* (1849), 18 L. J. Ex. 381; *Cooper v. Stephen* (1895), 77 L. T. N. S. 390; *Marshall v. Bull* (1900), 16 T. L. R. 501.

(*i*) *Powell v. Head* (1879), L. R. 12 Ch. Div. 686. But see *Wedekind v. General Electric Co.* (1897), 14 R. P. C. 190.

(*k*) *Lauri v. Renad*, [1892] 3 Ch. 402.

(*l*) (1907) Sect. 53. Sect. 57 of the Act enables any person interested to obtain information as to the continuance or cesser of the copyright.

(*m*) As to attempts to get the advantage of copyright after expiration of the term by claiming the trade name of a design, see *Cheavin v. Walker* (1877), L. R. 5 Ch. Div. 850.

and is not used in this country within six months of its registration in this country"; and this would still apply in respect of designs registered more than six months before the coming into operation of the 1907 Act, notwithstanding the retrospective provisions of the Act.

This provision has now been superseded by sect. 58 (2) of the new Act, which enables the objection of use of the design for manufacture wholly or mainly abroad to be raised *at any time* as a special ground of defence to an action for infringement, though there is no cesser of the copyright.

(14) The Statute of Limitations. There is no provision in the present Act that proceedings for infringement must be instituted within any given period; but the Statute of Limitations applies as in ordinary cases (*n*).

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

§ 179. There are no special statutory provisions relating either to particulars of breaches or to particulars of objections in cases of designs infringements, as there are in actions relating to the infringement of patents (*p*). But under the general rules particulars may be ordered (*q*). If the particulars be given, and they go beyond the

(*n*) See *Re Burge* (1887), 57 L. T. N. S. 364. The Designs Act, 1842, limited the time to twelve months from the commission of the offence (sect. 12).

(*o*) See *Crossley v. Dixon* (1863), 32 L. J. Ch. 617. And see Edmunds on Patents, 269 *et seq.*, where the exceptions may be found stated.

(*p*) Now Court Rules dealing with this subject have been prepared by Mr. Justice Parker, the selected judge under the 1907 Act, which are to constitute a new Order numbered LIIIA., to which reference should be made.

(*q*) R. S. C. Ord. XIX. r. 7. See notes to the rule in the Annual Practice. For forms of Particulars, see Appendix of Forms, B., *post*, p. 396.

defence or claim, as the case may be, the party giving the particulars is bound by his pleading (*r*).

On applications to expunge or rectify the register, particulars cannot be required from the respondents of the points on which they rely in support of the registration, but it is for the applicant to make out his case. Interrogatories may, however, be allowed.

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

In *Re Bayer's Design* (*t*) the ground of the application for particulars was that the respondent had not filed any affidavits giving particulars of the grounds on which he proposed to support the registration, and that it was necessary to define the issues; but Warrington, J., refused the application, adding: "He will say he relies on the design being in accordance with the requirements of the Act, and that the onus is on the applicants to make out their case. I will, however, give you leave to interrogate."

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

(*r*) *Macnamara v. Hulse* (1842), 2 W. P. C. 128, n.

(*s*) (1879) L. R. 12 Ch. Div. 826.

(*t*) (1906) 23 R. P. C. 553.

the first particulars to the delivery of the amended particulars (*u*).

Even in patent actions, however, this rule, though all but invariably followed, is not binding on the Court (*x*). And with regard to designs, the Court of Appeal has expressly stated that the discretion of the Court is unfettered (*y*).

In *Morris, Wilson & Co. v. Coventry Machinists' Co.* (*z*), North, J., declared that he would adopt this practice in designs cases, adding, "What reason is there why the same course of practice should not be followed where the action is one for infringement of a registered design as that settled and adopted in the case of the infringement of a patent? No reason has been suggested that seems to me to be a good one. . . . It seems to me that the practice which would be followed if this were a patent action should also be followed, though it is not an action on infringement of a patent, but a registered design."

In *Woolley v. Broad* the action was ready for trial at assizes to be held at Nottingham, and about a week before the date of the assizes the defendant discovered certain facts and gave information of them to the plaintiff. The plaintiff objecting to evidence of these, the defendant took out a summons for leave to give further particulars, and the judge at the assizes, to whom the summons was referred, gave leave unconditionally; on appeal, his decision was affirmed by the Divisional Court and ultimately by the Court of Appeal.

In *Rivett v. Grimshaw* (*a*), another case at assizes, the defendants gave notice only six days before the trial of their intention to adduce evidence of prior publication of two additional alleged anticipations, and objection being raised by the plaintiffs, Day, J., held that sufficient notice had been given.

§ 181. Such particulars should be given as with the pleadings give the opposite party a fair idea of the case

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

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

(*y*) *Woolley v. Broad* (1892), 9 R. P. C. 429; *Wilson v. Wilson* (1899), 16 R. P. C. 315.

(*z*) (1891) 8 R. P. C. 353.

(*a*) (1894) 11 R. P. C. 351.

intended to be made against him (*b*). Particulars of want of novelty or of prior publication must be drawn with greater detail and accuracy than particulars of infringement (*b*). In cases where common knowledge is alleged, particulars of prior publication or user cannot be insisted on (*c*).

Infringements may be fairly presumed to be within an infringer's knowledge, but particulars may also be ordered of these as in patent cases, where particulars of alleged breaches are usually given.

§ 182. Under the Rules of the Supreme Court, 1883, Ord. L., the widest powers of ordering an inspection are conferred on the various divisions of the High Court. The only practical limit to the discretion of the Court in designs, as in patent cases (*d*), is the necessity of the information claimed for the purposes of the trial (*e*).

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

Samples may now be taken, observations made, and preliminary experiments conducted (*f*) where necessary for the purposes of the trial.

An application for inspection may be made either by plaintiff or defendant, and in exceptional cases will be granted *ex parte* (*g*). It may be made against a defendant at any time during the progress of an action, even before the delivery of claim (*h*); and, on the other

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

(*c*) *Holliday v. Heppenstall* (1889), 6 R. P. C. 320.

(*d*) For the practice as to patent cases, which applies generally to designs, see *Edmunds on Patents*.

(*e*) R. S. C. Ord. XXXI. r. 20.

(*f*) Ord. L. r. 3; cp. *Badische Anilin, &c. v. Levinstein*, L. R. 24 Ch. D. 146; *Germ Milling Co. v. Robinson* (1886), 3 R. P. C. 11.

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

(*h*) See R. S. C. Ord. L. r. 6; *Drake v. Muntz Metal Co.* (1886), 3 R. P. C. 43.

hand the express terms of Ord. L. r. 6, leave no doubt that an adverse order for inspection may also be made against the plaintiff (*i*). But more suspicion will not justify inspection against a defendant (*i*), nor will the Court order a roving inspection (*k*); nor will it make an order where the inspection might be injurious, and is not really essential for preparing for the trial of the action, and the right depends on a question which has yet to be determined (*l*).

Under Ord. L. r. 3, the Court may now authorise any person for the purpose of inspection to enter any land or building in the possession of any party. Obedience to an order for inspection may, therefore, be asserted forcibly, and not simply as before by process of contempt (*m*). The power to do this may be usefully employed in cases arising under the new provisions of sect. 60 (1a), which make it an infringement "to do anything with a view to enable the design to be applied."

§ 183. The application, if in the Chancery Division, should be made by motion to the Court, and the ordinary notice of motion should be given (*n*). In the King's Bench Division the application is by summons to a judge in chambers (*o*).

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

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

(*i*) *Germ Milling Co. v. Robinson*, *supra*; *Cheetham v. Oldham* (1888), 5 R. P. C. at p. 623; *Sidebottom v. Fielden* (1891), 8 R. P. C. 266.

(*k*) *Cheetham v. Oldham*, *supra*.

(*l*) *MacDougal v. Partington* (1890), 7 R. P. C. 472.

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

(*n*) *Habershon v. Gill*, W. N. (1875) 231.

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

(*p*) *Patent Type Founding Co. v. Walter* (1860), 29 L. J. Ex. 207.

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

2. That the defendant has probably infringed.

Prima facie evidence of infringement will be sufficient (*r*); and if the *prima facie* evidence is satisfactory, an order for inspection will be made, almost as of course (*s*).

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

§ 184. The Court will not grant an order for the inspection of a machine upon a mere statement “that the machine used by the defendants is the same for which the plaintiff has obtained a patent”; and the same rule applies to inspection of alleged infringements of registered designs. The affidavit ought, at least, to state that there is such a machine (or design), and that the plaintiff has reason to believe it is an infringement (*u*), and should set forth the grounds of such belief (*x*); and inspection will be refused where, in the opinion of the Court—(a) there is no case to try at the hearing (*y*), or (b) the effect of an order would be to oppress the defendant, or make him disclose more than was necessary for the purposes of the cause (*z*).

An objection that an order for inspection would lead to the disclosure of trade secrets will not generally prevail if the case for inspection is otherwise satisfactory (*a*). The Court will, however, protect the defendant from an

(*q*) *Meadows v. Kirkman* (1860), 29 L. J. Exch. 205.

(*r*) *Shaw v. Bank of England* (1852), 22 L. J. Ex. 26; *Cheetham v. Oldham* (1888), 5 R. P. C. 617.

(*s*) *Singer Manufacturing Co. v. Wilson* (1865), 13 W. R. 560.

(*t*) *Piggott v. Anglo-American Telegraph Co.* (1868), 19 L. T. N. S. 46.

(*u*) *Shaw v. Bank of England*, *supra*.

(*x*) *Germ Milling Co. v. Robinson* (1884), 1 R. P. C. 217.

(*y*) *Piggott v. Anglo-American Telegraph Co.*, *ubi supra*.

(*z*) *Singer Manufacturing Co. v. Wilson*, *supra*; *Cheetham v. Oldham*, *supra*.

(*a*) *Renard v. Levinstein* (1864—65), per Wood, V.-C., 10 L. T. N. S. 95; *Cheetham v. Oldham*, *supra*.

improper disclosure; and where the party against whom inspection is ordered avers that it might disclose trade secrets, precautions may be taken by having the inspection made by some independent person, who will be required to report to the Court (*b*).

The order for inspection (*c*) usually specifies the number of inspections allowed, the names of the inspectors, and the notice to which the person against whom the order is made shall be entitled (*d*).

§ 185. The existing law as to discovery is contained in Ord. xxxi. of the Rules of the Supreme Court, 1883, as altered by the Rules of November, 1893, as to which reference should be made to the text and notes in the Annual Practice.

The chief provisions of the Order, so far as relate to actions of infringement, are as follows:—

The plaintiff or defendant in a designs action may, by leave of the Court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties (*e*). Interrogatories which do not relate to any matters in question will be deemed irrelevant, notwithstanding that they might have been admitted on cross-examination (*f*).

On an application for leave to deliver interrogatories, the particular interrogatory proposed to be delivered must be submitted to the Court or judge. In deciding upon such an application, the Court or judge will take into account any offer which may be made by the party sought to be interrogated, to deliver particulars, or to make admissions, or to produce documents relating to

(*b*) *Plating Co. v. Farguharson* (1883), Griff. P. C. 187.

(*c*) For form of order for inspection, see Appendix B., *post*, p. 397.

(*d*) *Heathfield v. Braby*, cited Seton, 561. But see *Germ Milling Co. v. Robinson*, *supra*.

(*e*) Ord. XXXI. r. 1.

(*f*) *Ibid*.

the matters in question, or any of them, and leave will be given as to such only of the interrogatories submitted as the Court or judge shall consider necessary either for disposing fairly of the cause or matter or for saving costs (*h*).

§ 186. The Court or a judge has the same power to prevent premature discovery as to prevent premature inspection (*i*). But where an order for discovery is made against a defendant he must answer, technically and categorically, every question which can assist the plaintiff in making out his title to relief (*k*).

The following illustrations will show at once the application and the limits of this rule:—

In *De la Rue v. Dickinson* (*l*), Wood, V.-C., said that a defendant denying infringement must answer everything tending to show the fact of infringement, but not questions which assume that infringement has taken place, and answers to which will be obtained at the hearing if infringement be then established.

In *Moore v. Craven* (*m*), it was laid down that, although, when discovery is a matter of indifference to the defendant, the Court does not weigh in golden scales the question of materiality or immateriality, still, when the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other it is bound to protect the defendant against undue inquisition into his affairs.

In *Daw v. Eley* (*n*), it was held that a plaintiff has no right

(*h*) Ord. XXXI. r. 2. In *Re Bayer's Design* (1906), 23 R. P. C. 553, an order for particulars was refused against the respondent, but interrogatories were allowed.

(*i*) Ord. XXXI. r. 20.

(*k*) *Swinburne v. Nelson* (1852—53), per Romilly, M.R., 22 L. J. Ch. 331; *Elmer v. Creasy* (1873), L. R. 9 Ch. 69.

(*l*) (1857) 3 K. & J. 398; *Lister v. Norton* (1885), 2 R. P. C. 68; *Lea v. Saxby* (1875), 32 L. T. N. S. 731.

(*m*) (1870) L. R. 7 Ch. 94, 96 n.

(*n*) (1865) 1 Eq. 38. But see *Lister v. Norton*, *supra*.

to inquire by interrogatories into the defendant's case, or to ask for the names of the witnesses whom he intends to produce, or the names of persons to whom he has sold articles similar to the articles alleged to be an infringement (o).

A corporation or company may be interrogated through any of its members or officers; but no person so interrogated can be compelled to answer as to matters of which he has obtained information in any other capacity than that of such member or officer (p).

Reports and letters obtained from their officers by a company which had been warned, but not threatened, with actual litigation, in respect of an alleged infringement of a patent, have been held not to be privileged from production (q).

§ 187. When an action for infringement of a design is brought claiming penalties under sect. 60 (2), the defendant cannot be compelled to answer interrogatories (r). It has been suggested that the law is the same if the action is brought for damages (s); but this seems to be contrary to the principle on which interrogatories are refused in penal actions, for the election of the plaintiff to proceed for damages excludes any liability to penal consequences under the Act.

This rule applies though other relief is claimed in the action, if the penalty claim is the substantial one or the information asked for would assist it.

In *Titus Astle, Ltd. v. Mansfield* (t) the registered proprietors of a design commenced an action for infringement, claiming

(o) As to administering interrogatories to a plaintiff, see *Hoffmann v. Postill* (1869), L. R. 4 Ch. 673; *Edison, &c. Co. v. Holland* (1888), 5 R. P. C. 213; *Morris v. Edwards* (1890), 15 App. Cas. 309.

(p) *Welsbach Co. v. New Sunlight Co.* (1900), 17 R. P. C. 401.

(q) *Westinghouse v. Midland Rail. Co.* (1883), 48 L. T. N. S. 98, 462; and cp. *Haslam Co. v. Hall* (1888), 5 R. P. C. 1.

(r) *Saunders v. Wiel* (1892), 9 R. P. C. 459.

(s) *Ibid.*, per Day, J., at p. 460, but the Court of Appeal refused to express any opinion on the point. Cf. *Adams v. Batley* (1887), L. R. 18 Q. B. D. 625.

(t) (1905) 22 R. P. C. 356.

an injunction, damages, or alternatively *penalties* and delivery up, and subsequently under an order elected to claim penalties and not damages, and amended their claim accordingly. The defendant denied infringement, and alleged the invalidity of the design. The plaintiffs then applied for leave to deliver interrogatories, some of them relating to the acts complained of and others to the issue of novelty. Held, that the action was substantially an action to recover penalties, and leave to deliver interrogatories refused.

In giving judgment, Swinfen Eady, J., after referring to the fact that there was no allegation in the statement of claim that there were any infringing goods in the possession or control of the defendant, or that he threatened or intended to continue the use of the design, said: "I look upon this action as substantially an action for penalties, although in form it also claims an injunction. The answer to these interrogatories might certainly assist in making the defendant liable for the penalties to recover which the action is brought; and, having regard not only to *Saunders v. Wiel*, but also to *Merborough v. Whitwood Urban District Council (u)*, I look upon it substantially as an action for penalties in which the interrogatories ought not to be delivered."

§ 188. In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies, that he who is bound to answer must answer fully. There is, however, this difference: A plaintiff is not entitled to discovery of the defendant's case, whereas a defendant may ask any question tending to destroy the plaintiff's claim (v).

§ 189. On the question of method of trial there is no rule specially applicable to design actions, and the provisions of sect. 92 (1) of the new Act for referring certain appeals and petitions to a selected judge of the High Court do not affect ordinary cases of infringement or motions to expunge entries, etc. The parties to an action of infringement are therefore

(u) (1897) 2 Q. B. 11.

(v) *Hoffmann v. Postill* (1869), L. R. 4 Ch. 673. See *Rylands v. Ashley* (1890), 7 R. P. C. 175.

placed as litigants in any other action as regards right to a jury.

In *The Patent Marine Inventions Co. v. Chadburn* (x), Lord Selborne, in speaking of trial of patent cases by jury, said: "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence, in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge."

These remarks are applicable to design cases, though their force is somewhat lessened. Often the sole question to be determined is whether the one design is an imitation of the other, a matter to be settled by reference to the eye. In view of the considerable divergence of opinion which frequently manifests itself in imitation cases, many may prefer to take the decision of the twelve in preference to that of one, who must act as judge as well as jury. The opinion of the judge applying the test of the eye to an alleged infringement will sometimes be overruled by a Court of Appeal: thus in *Harper v. Wright & Butler* (y), the judge held, without going into the defendant's case, that there was no infringement, but on the hearing of the appeal the defendant's case was gone into to save a reference back to the Court below, and the appeal judges then held that the defendant had infringed.

(x) (1873) L. R. 16 Eq. 447.

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

There is no absolute right to a jury, but on application the Court will often order a trial by jury (*z*), and this may be done even in cases commenced in the Chancery Division, where there are issues of fact to be decided (*a*). The onus is on the party applying for trial by jury to show that the action is one which ought to be so tried (*b*).

§ 190. Where the case is tried by a judge and jury it is for the judge to say whether the requirements of the statute as to registration and otherwise have been complied with; but the question whether the registered proprietor has taken "all proper steps to ensure marking" is a question for the jury (*c*). So, of course, are the questions of novelty, as well as infringement (*d*).

§ 191. If the pleadings raise questions of law in the nature of a demurrer, these questions may be ordered to be decided as a preliminary before entering into any of the issues of fact (*e*). In such cases all allegations in the pleadings will be taken as admitted for the purpose of the argument, but this will, of course, be without prejudice to the subsequent trial of the issues of fact (*f*).

§ 192. Subject to the special provisions contained in the new Act (*g*), by which, after a certificate of validity has been granted, solicitor and client costs may be awarded to a registered proprietor in any subsequent action for infringement of his rights (these provisions

(*z*) R. S. C. Ord. XXXVI. rr. 4—6.

(*a*) *Jenkins v. Bushby*, [1891] 1 Ch. 484; *Sugg v. Silber*, L. R. 1 Q. B. D. 302.

(*b*) *Cook v. Ingram*, L. R. 35 Ch. D. 117.

(*c*) *Johnson v. Bailey* (1894), 11 R. P. C. 21.

(*d*) *McCrea v. Holdsworth* (No. 2) (1866), L. R. 1 Q. B. 264.

(*e*) See, e.g., *Woolley v. Broad* (No. 1) (1892), 9 R. P. C. 208.

(*f*) Ord. XXV. rr. 1—3.

(*g*) Act of 1907, sect. 35.

being extended to designs by sect. 61), the ordinary rules as to costs will apply (*h*). When any action, cause, matter or issue is tried with a jury, the costs follow the event, unless the judge for good cause otherwise orders (*i*). In other cases the costs are awarded in the discretion of the Court (*k*).

Generally whether the action be on contract or in tort, a judge of the High Court may certify that there was sufficient reason for bringing the action in the High Court, or may otherwise by order allow costs on the High Court scale (*l*); and in one case where the validity of the design was attacked, but only 20% was awarded, application was made for such a certificate, which was granted by the Court (*m*). But as, apparently, all actions for infringement should now properly be brought in the High Court, it is submitted that there is no occasion for such a certificate, and the costs (subject, of course, to the judge's discretion in a proper case) will always be on the High Court scale, whatever amount may be recovered (*n*).

§ 193. When there are distinct issues to be decided, the costs of each may be dealt with separately, and the costs of any issue awarded to the generally unsuccessful party, if the Court thinks fit.

In *Winfield v. Snow* (*o*) one of the pleas was "prior publication," and this was decided favourably to the defendant. The judge gave the general costs of the action and of the issue disposed of to the defendant, reserving the costs of the other issues.

(*h*) R. S. C. Ord. LXV.

(*i*) Ord. LXV. r. 1.

(*k*) *Ibid.* See *Sherwood v. Decorative Tile Co.* (1887), 4 R. P. C. 207, where only two-thirds of the costs were allowed on the ground of the inclusion of improper evidence.

(*l*) The County Courts Act (51 & 52 Vict. c. 43), s. 116.

(*m*) *Chard v. Cory* (1892), 9 R. P. C. 423.

(*n*) See *ante*, p. 176 *et seq.*

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

In *Blank v. Footman & Co.* (*p*) the defendant raised several defences, and upon one of them, which practically decided the action (prior publication), the judge found for the defendant, on another (marking) for the plaintiff; other defences were simply pleaded and were not argued out. Kekewich, J., said: "The defendant is entitled to put his back against the wall and to fight from every available point of advantage. I think that it would be extremely hard on defendants if as a rule they were told at the end of the trial, 'You have beaten the plaintiff, but because you have raised some points on which you have not succeeded you shall not have all the costs of the action.' And it is obvious that it might lead to lengthening trials if counsel understood that unless they fought out every point the clients would not be allowed their costs even in a successful case. On the other hand, it is a useful rule that where there is a distinct issue on which the generally successful party has failed and that issue has really no immediate connection with those upon which the party has succeeded, then he ought not to have the costs of that issue which presumptively ought never to have been raised. As regards the fifth and sixth defences, though perhaps they might as well have been left out, still they were fair points to raise, and on the principle I have mentioned I do not think that the defendants ought to be mulcted in costs, because succeeding on the whole they have not succeeded on them. But as regards the marking, that issue has been argued out, and there has been evidence directed to it, and I have held distinctly in favour of the plaintiff on that point. I think that the plaintiff ought to have the costs of that issue as against the general costs of the action."

Birkin v. Pratt (*q*) was an action for infringement of a registered design for lace, and it was held at the trial that there was no infringement, the differences between the two patterns being so considerable that the one could not be mistaken for the other. The defendants further alleged that the plaintiffs' design was not novel or original; but this was not proved at the trial, and the costs of this issue were, therefore, given to the plaintiffs, though the defendants were awarded the general costs of the action.

In *Pearson v. Wilkinson* (*r*) the plaintiff was the owner of registered designs for the bodies of perambulators, and brought an action against W. & Co. for infringement of the shape and pattern; the defendants thereupon moving to expunge on the ground of anticipation and want of title. It was established at the trial that the pattern was old and had

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

(*q*) (1895) 12 R. P. C. 371.

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

not been infringed, but that the shape of the sides and top of the body was now for porambulators and had been taken.

The motion was dismissed with costs on the ground that the designs were novel. In the action an injunction was awarded, but without costs, plaintiff having failed to prove infringement in regard to pattern as alleged.

In giving judgment Kekewich, J., said: "Though I hold the plaintiffs to be entitled to an injunction on the matter of shape, I hold them to have failed as regards pattern, and my way of dealing with the costs of the action is that I give them no costs."

In *Demartial v. Booth* (s), where the plaintiff moved for an injunction, and defendant moved to rectify the register, and both motions failed, each was dismissed with costs.

In *Cooper v. Symington* (t) the plaintiffs moved for an injunction, but failed to obtain it, for the reason that their invention was not subject-matter for registration as a design; the defendants denied infringing, but could not sustain this defence, and the motion for an injunction was refused without costs; but the motion of the defendants to rectify the register was allowed with costs.

§ 194. Costs on the higher scale may be allowed in a fit case (u); but on application for an interlocutory injunction costs on the higher scale will not ordinarily be allowed, though the points raised be important (x). The costs of a motion, unless by agreement it is treated as the trial of the action, will usually be reserved; though if it is clear that the whole question is before the Court, and that the party defeated on the motion cannot succeed at the trial, costs will be given (y).

§ 195. If the defendant offers to submit to an injunction or promises no longer to infringe, it will depend upon circumstances whether he will be ordered to pay the costs incurred subsequently to his submission. The real point for determination is, whether the plaintiff

(s) *Demartial v. Booth* (1892), 9 R. P. C. 499.

(t) (1893) 10 R. P. C. 264.

(u) R. S. C. Ord. LXV. r. 9. See *Dunlop v. Wapshare Tube Co.* (1900), 17 R. P. C. 433.

(x) *Grafton v. Watson* (1884), 51 L. T. N. S. 141.

(y) *Walker v. Scott* (1892), 9 R. P. C. 482.

must go on with his proceedings to secure his rights or whether he is already sufficiently protected by the surrender of his opponent. This is practically the same question as arises when the acts of the defendant are claimed to have disentitled the plaintiff to an injunction (z). The plaintiff is generally entitled to go on if there be any doubt, at any rate until he has obtained his injunction (a), but the Court will use its discretion on the facts of each case.

The following cases are illustrative of these rules:—

Cooper v. Whittingham (b). The defendants were sued for infringement under the Copyright Act, 1842, and an injunction was asked for to restrain a sale; they pleaded that when they received the copies they at once recognised the piracy, and determined not to sell. Jessel, M.R., however, ordered them to pay the costs of the motion, saying: "As I understand the law as to costs it is this, that where the plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of costs—the Court has no discretion, and cannot take away the plaintiff's right to costs."

Upmann v. Forester (c). The defendant (a china merchant) purchased abroad, for his own private use, some cigars, which were consigned to him at the docks; they bore a spurious brand, purporting to be that of the plaintiffs. When plaintiffs issued their writ and served a notice of motion for an injunction, the defendant stated to them that he had no intention of selling the cigars, offered all relief asked for by the writ, and, when the motion came on, agreed to an undertaking in the terms of the writ. Chitty, J., decided that the defendant must pay the costs, but added: "The result of my decision, however, will not be, as the defendant has suggested, that every purchaser of a small parcel of spurious goods incurs a liability to pay the costs of an action in the Chancery Division for infringing a patent or trade mark. I cannot pass over the fact that there is in the present case a large consignment of

(z) See *Proctor v. Baily* (1889), 42 Ch. Div. 390; *Upmann v. Elkan* (1871), 7 Ch. 130; *Millington v. Fox* (1838), 3 My. & Cr. 338.

(a) *Colbourne v. Simons* (1843), 12 L. J. Ch. 338; *Nunn v. Albrquerque* (1865), 34 Beav. 595; *Geary v. Norton* (1846), 1 De G. & Sm. 9.

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

(c) (1883) L. R. 24 Ch. Div. 231. And see *Grace v. Newman*, 19 Eq. 623; 44 L. J. Ch. 298.

goods—5,000 cigars is rather a large order for personal consumption—and the plaintiffs were justified in suspecting that so large a consignment was intended for distribution.”

Wittmann v. Oppenheim (*d*). This was an action to restrain infringement of copyright in a registered design, and plaintiffs moved for an injunction. Defendant stated that he sold the lamps complained of innocently, and that he received no notice that he was infringing until issue of the writ. Pearson, J., ordered the defendant to pay the costs. He said: “I should be very willing to make no order as to costs, but, looking at the decision in *Upmann v. Forester* (*e*), and to the rule there stated by Chitty, J., with which I entirely agree, I am afraid I have no choice. It is said that the plaintiffs issued their writ without notice to the defendant, and that the defendant, as soon as he had notice of the plaintiff’s title, did his best to undo what he had done. But, at the same time, I cannot say that the plaintiffs were wrong in issuing their writ without notice, and after that the only offer which the defendant could properly make was to submit to an injunction and to pay the costs.”

American Tobacco Co. v. Guest (*f*). In this case the owner of a registered trade mark moved for an injunction to restrain infringement. The defendant, who had at one time made purchases from the plaintiff, bought a few articles from another firm, believing them to be the plaintiff’s, and he offered to abide by any order made by the Court. Stirling, J., granted the injunction, but refused the plaintiff his costs. He said (referring to *Upmann v. Forester*) (*g*): “In that case, there being that large amount of goods, Mr. Justice Chitty made an order for payment of the costs. Here there are only 500 cigarettes, valued at 17s. 6d., and I think that under those circumstances I am justified in excepting, as I think Mr. Justice Chitty would have excepted, this case from the operation of the rule which he laid down in *Upmann v. Forester*, by saying that there ought to be no costs.”

In *Lyon v. Mayor, &c. of Newcastle-upon-Tyne* (*h*) plaintiff discovered that the Corporation of Newcastle were in possession of a machine made in infringement of his patent; the

(*d*) (1884) 27 Ch. Div. 260. But as the defendant was merely the vendor, *semble* he ought not to have been put under an injunction, in the absence of knowledge that the plaintiff’s design was registered. See sect. 58 (b) of the Act of 1883, also sect. 7 of the Act of 1842. And see *Smith v. Lewis, Roberts & Co.* (1888), 5 R. P. C. 611, 617.

(*e*) *Supra*.

(*f*) (1892) 9 R. P. C. 218.

(*g*) *Supra*.

(*h*) (1894) 11 R. P. C. 218.

town clerk stated to the plaintiff that the Corporation did not dispute the patent, had never used the machine, and did not intend to use it, and undertook not to use it. The plaintiff's solicitors would not accept this nor any other undertaking, and moved for an injunction. On the undertaking being given to the Court, the motion was dismissed with costs.

Jan v. Grossmann (i). This was an action for infringement of a registered design for powder puffs. The defendant admitted that he had purchased three powder puffs infringing the design, one of which he had sold to an unknown customer, and another to the plaintiff, on which occasion he first was informed that the puffs were an infringement. The defendant then at once promised to sell no more, and removed the third puff from his shop window, but the defendant declined to give a formal undertaking demanded by the plaintiff's solicitor not to sell any more. The plaintiff then commenced an action, and, on admissions in the defence, took out a summons for judgment under Ord. XXXII. r. 6, contending that, as the defendant admitted that he had still an infringing article in his possession, he ought to have given the undertaking, and that the plaintiff was therefore entitled to an injunction.

In giving his judgment dismissing the action with costs as a useless and trumpery action, Kekewich, J., after referring to *Smith v. Lewis, Roberts & Co.*, said: "The defendant has really been guilty of no offence under the statute, looking at it in the most technical way. He never has sold, offered for sale, or threatened to sell or offer for sale, any of these puffs since he knew they were an infringement of a registered design."

In *Hanfstaengl v. W. H. Smith & Sons (k)*, however, which was an action for infringement of copyright in a valuable painting, the same judge, while awarding nominal damages, allowed the plaintiff his full costs, adding: "There is no occasion to grant an injunction, as the infringement was promptly suppressed; but I adopt the plaintiff's argument that, if he desires to protect his copyright, he is bound to take action even in a case which is, on the face of it, of a trumpery character, or run the risk of encouraging more serious infringements."

(i) (1895) 12 R. P. C. 537.

(k) (1905) 21 T. L. R. 291. And see *Werner Motors v. Gamage's* (1904), 21 R. P. C. 137.

CHAPTER XII.

OFFENCES UNDER THE ACT AND OTHER PROCEEDINGS.

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

- § 196. Making False Entries or Copies a Misdemeanour.
- § 197. Fines for False Descriptions—*Reg. v. Wallis; Sen Sen v. Britten.*
- § 198. Misrepresentation by use of Registration Marks.
- § 199. Unauthorized use of Royal Arms.
- § 200. Prosecution of Offences in Scotland and Ireland.
- § 201. Offences Abroad under Foreign Jurisdiction Acts.
- § 202. Action for Threats of Legal Proceedings.
- § 203. Circulars and Warning Letters—Burden of Proof.
- § 204. Institution of Proceedings—Dissolution of Injunction.
- § 205. Damages and Costs in Threats Actions or Common Law Proceedings.

THE Act of 1883 created various new offences which were punishable by criminal process, and these provisions are maintained and extended by the new Act.

§ 196. Any person who makes or causes to be made a false entry in the register kept under the Act, or a writing falsely purporting to be a copy of an entry in the register, or who produces or tenders in evidence any such writing, knowing it to be false, is guilty of a misdemeanour (*a*).

It is specially provided that the punishment for a misdemeanour under the Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding 100*l.*, at the discretion of the Court (*b*).

§ 197. If any person falsely describes any design applied to any article sold by him as registered, he is liable, on summary conviction, to a fine not exceeding 5*l.* for every offence (*c*).

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

(*b*) (1907) Sect. 96 (2).

(*c*) (1907) Sect. 89 (2).

The fine is “for every offence,” and this involves a separate fine for each copy sold (*d*). The offence is equally committed whether the registration mark is used before registration has been effected (*e*) or after the period of copyright protection has expired (*f*). The burden is on the defendant in such a case to justify the use of the mark, and he may do this by showing there is no misrepresentation in fact (*g*).

The following cases are illustrative:—

In *Reg. v. Wallis* (*e*) the defendant was selling a lamp as a patented article when no patent had been granted for it, although a provisional specification had been filed to which caveats had been entered, and it was held that the burden was on the defendant to prove the patent under which he justified the use of the word “patent”; that he was not entitled to use that term because a provisional specification had been filed; and that, not having justified his use of the term, a fine must be imposed under the section.

In *Leather Cloth Co. v. American Leather Cloth Co.* (*h*) Lord Kingsdown said: “If a trade mark represents an article as protected by a patent when, in fact, it is not so protected, it seems to me that such a statement *prima facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to relief in a Court of equity against any one who pirated it. . . . If the word ‘patent’ be not so used as to indicate the co-existing protection of a patent, but merely as part of the designation of an article known in the market by that term, nobody is meant to be deceived or is deceived. A patent may have expired and be known to have expired fifty years ago, and yet the name ‘patent’ may have become attached to the article and be used in the trade as designating it; but if the trade mark represents

(*d*) *Reg. v. Crampton* (1886), 3 R. P. C. 367, where the full fine of 5*l.* was imposed on one summons, the application for twelve other summonses in respect of other sales to the same prosecutors being withdrawn. Cf. *Ex parte Beale* (1868), L. R. 3 Q. B. 387, and the other cases cited on penalties claims, *ante*, p. 161 *et seq.*

(*e*) *Reg. v. Wallis* (1886), 3 R. P. C. 1; *Reg. v. Crampton*, *supra*.

(*f*) Sect. 89 (4). And see *Chevin v. Walker* (1877), L. R. 5 Ch. Div. 850.

(*g*) *Sen Sen Co. v. Britten* (1899), 16 R. P. C. 137; *Marshall v. Ross* (1869), L. R. 8 Eq. 637.

(*h*) 11 H. L. C. 543.

the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection never existed or has ceased to exist."

In *Cheavin v. Walker* (*i*) the label containing the description of the plaintiff's filters as patented (the patent having, in fact, lapsed) was surmounted by a medallion containing the Royal Arms, with the words "By Her Majesty's Royal Letters Patent," and it was held that this constituted a false representation, which disentitled the plaintiff to relief, although apparently (per Baggallay, L.J.) there would have been no misrepresentation in the use of the description, including the word "patent," by itself, without the medallion and added words. In giving judgment Jessel, M.R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be used so as to mean that which was a patent but is not so now. In other words, you may state, in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark."

In *Sen-Sen Co. v. Britten* (*j*), the plaintiff had for several years imported and sold cachous in distinctive packets, with the mark "Sen-Sen" on them, and the words "trade mark" below, but the mark was not registered. Held, that the plaintiffs had not made such a misrepresentation as to deprive them of the right to an injunction, and that the use of the words "trade mark" do not necessarily represent that it is registered.

§ 198. The statute further provides (*k*) that a person is to be deemed to represent that the design applied to an article is a registered design if he sells the article with the word "registered," or any word expressing or implying that there is a subsisting copyright in the design, stamped on or otherwise applied to it.

Registration dates from the day on which the application is handed in to the Comptroller's Office (*l*), but the registration is not complete until the sealing of the certificate of registration by the Comptroller; and on the analogy of patents it would not be safe or proper to

(*i*) (1877) L. R. 5 Ch. Div. 850.

(*k*) (1907) Sect. 89 (3).

(*j*) (1899) 16 R. P. C. 137.

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

issue articles with the registration mark affixed until the certificate has been obtained (*m*).

The old Acts (*n*) contained express provisions prohibiting the use of the registration marks either before registration of the design or “after the copyright of such design shall have expired,” and these latter words, which were omitted from the statute of 1883, have now been re-enacted (*o*); but the penalty was only imposed on persons unlawfully applying the registration marks or selling articles with knowledge of such unlawful application, and it is submitted that the present section would have only the same effect, so that a *bonâ fide* sale after expiry of the copyright would be exempted (*p*).

§ 199. Any person who, without Royal authority, uses, in connection with any business or profession, the Royal Arms or arms resembling them in such a manner as to be calculated to deceive, by leading other persons to believe that he is duly authorised to use the arms, is made liable, on summary conviction, to a fine not exceeding 20*l.* (*q*).

§ 200. In Scotland offences may be prosecuted in the Sheriff Court (*r*); in Ireland, in the Courts prescribed by the Summary Jurisdiction Acts (*s*); and in the Isle of Man, in the manner in which offences punishable on summary conviction may be prosecuted (*t*).

§ 201. Under the provisions of the Foreign Jurisdiction Acts various Orders in Council have been issued,

(*m*) *Reg. v. Wallis* (1886), 3 R. P. C. 1.

(*n*) (1842) Sect. 11; (1843) Sect. 4.

(*o*) (1907) Sect. 89 (4).

(*p*) See *Cheavin v. Walker and Sen-Sen Co. v. Britten*, *supra*.

(*q*) (1907) Sect. 90 (2).

(*r*) (1907) Sect. 94 (2).

(*s*) The Act of 1883 contained a special provision (sect. 117) to this effect, but this is not repeated in the present Act.

(*t*) (1907) Sect. 96 (3).

extending to certain parts of Africa (*u*), to Morocco (*x*), to Persia, its coast and islands (*y*), and to the Somali Coast (*z*), the penalties for offences under the 1883 Act, in the same way as if such offences had been committed in the United Kingdom or a British possession.

The Foreign Jurisdiction Act, 1890 (*a*), repealed all the previous Acts extending from 1843 to 1878, and consolidated their provisions; but all the Orders in Council made under the old Acts were preserved in force, and were declared to have the same effect as if made under the new Act (*b*). These Orders in Council continue in force under the 1907 Act, notwithstanding the repeal (for other purposes) of the Act of 1883, to which they applied (*c*).

§ 202. The Act of 1907 creates a new action in the nature of malicious libel for the protection of persons interested in designs who are subjected to groundless threats of legal proceedings. It is declared (*d*) that the provisions of the Act with regard to the remedy in cases of groundless threats of proceedings by a patentee shall apply in the case of registered designs in the same manner as they apply in the case of patents. The provisions referred to are contained in sect. 36 of the Act, which enacts—

Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may

(*u*) Order of 15th October, 1889.

(*x*) Order of 28th November, 1889.

(*y*) Order of 13th December, 1889.

(*z*) *Ibid.*

(*a*) 53 & 54 Vict. c. 37, s. 18.

(*b*) *Ibid.* sect. 118 (1)

(*c*) (1907) Sect. 98 (1), proviso.

(*d*) Act of 1907, sect. 61.

recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats :

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

§ 203. This enactment continues the old law applying to patents (*f*), and under this it was held that a circular may be a threat sufficient to support proceedings under the section, though addressed to no one in particular (*g*). Where, however, the circular amounts only to a general warning, and no threat is held out, an action under the section cannot be maintained (*h*). The plaintiff must prove that he is not in fact infringing; and the Court has in any case a discretion as to granting an injunction (*i*).

§ 204. The proviso exempts any person making the threats if he with due diligence commences and prosecutes an action for infringement, and it has been held under this that an owner is not bound to start actions against every person whom he threatens, but it is sufficient if he has brought one *bonâ fide* action against any alleged infringer. If he undertakes to prosecute proceedings for the alleged infringement with due diligence an injunction will not usually be granted (*k*). And an injunction already granted may in some cases be dissolved on the action for infringement being brought (*l*). The proceedings must, however, be *bonâ fide* and prosecuted with due diligence, or an injunction against the continuance

(*f*) Act of 1883, sect. 32. See the notes to sect. 98 (1), *post*.

(*g*) *Johnson v. Edge* (1891), 9 R. P. C. 142.

(*h*) *Bishop v. Inman* (1900), 17 R. P. C. 479. And see *Crowther v. United Flexible Co.* (1905), 22 R. P. C. 549.

(*i*) *Walker v. Clarke* (1887), 4 R. P. C. 111.

(*k*) *Mackie v. Laundry Supply Co.* (1891), 9 R. P. C. 465.

(*l*) *Engels v. Hubert Syndicate* (1902), 19 R. P. C. 201.

of threats or advertisements will be granted, notwithstanding their institution (*m*).

§ 205 Damages representing the solicitor and client costs incurred in defending proceedings which were not *bonâ fide* and have not been prosecuted with due diligence may be granted in such cases (*n*).

In addition to the remedies under the statute, damages may be claimed at common law for injurious statements affecting the plaintiff's right to sell his goods; and on such a claim the fact that an action for infringement has been brought would be no answer if there is substantial evidence of actual *mala fides* (*o*).

(*m*) *Challender v. Royle* (1887), 4 R. P. C. 363; *Haskell Golf Ball Co. v. Hutchison and Main* (1904), 21 R. P. C. 497. But see the recent case of *Craig v. Dowding* (1907), reported in L. J. N. C. (1907) p. 654; and on appeal, *Ibid.* (1908) p. 39.

(*n*) *Bishop v. Inman* (1900), 17 R. P. C. 479; *Craig v. Dowding*, *supra*. See also *Kurtz v. Spence* (1888), 5 R. P. C. 161; and *Lycett v. Brooks* (1904), 21 R. P. C. 656.

(*o*) *Sugg v. Bray*, 2 R. P. C. 223. But see *Reid v. Thomson* (1905), 22 R. P. C. 376.

PART II.

 THE
PATENTS & DESIGNS ACT, 1907,
 AND THE REPEALED
PATENTS, DESIGNS & TRADE MARKS ACTS, 1883 to 1888
(So far as they relate to Designs),
Compared and Noted.

(The text of the Act of 1907 is set out in large type. The corresponding sections in the repealed Acts are printed in italics, and the notes in smaller type.)

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Sections 1 to 48.

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- 65. Fees.

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SCHEDULES.

PATENTS AND DESIGNS ACT, 1907.

(7 EDW. VII. CH. 29.)

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks.

[28th August 1907.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

PART I.—PATENTS.

(Sects. 1—48 relate exclusively to patents except sects. 27, 39 and 35, 36, which are incorporated in the law of designs by sects. 58 and 61 respectively, and are set out in full under those sections, *post*, pp. 239, 241, and 250, 251.)

PART II.—DESIGNS.

Registration of Designs.

49.—(1.) The comptroller¹ may, on the application made in the prescribed form and manner² of any person³ claiming⁴ to be the proprietor⁵ of any new or original⁶ design not previously published⁷ in the United Kingdom,⁸ register⁹ the design under this Part of this Act.

Application
for registra-
tion of
designs.

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(2.) The same design may be registered in more than one class,¹⁰ and, in case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(3.) The comptroller may, if he thinks fit, refuse to register¹¹ any design presented to him for registration, but any person aggrieved by any such refusal may appeal¹² to the Board of Trade, and the Board¹³ shall, after hearing the applicant and the comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(4.) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time¹⁴ shall be deemed to be abandoned.¹⁵

(5.) A design when registered shall be registered as of the date of the application¹⁶ for registration.

[Act of 1883,
sect. 47.]

47.—(1.) *The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.*

(2.) *The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.*

(3.) *The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.*

(4.) *The same design may be registered in more than one class.*

(5.) *In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.*

(6.) *The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.*

(7.) *The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.*

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48.—(1.) *On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs, or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.* [Act of 1883, sect. 48.]

(2.) *The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.*

¹ *The comptroller.*—An official appointed under the Act of 1883 (sects. 82 and 83), and continued by this Act (sects. 62 (2) and 63), with, so far as designs are concerned, similar powers and duties to the former Registrar of designs (5 & 6 Vict. c. 100, s. 14; 6 & 7 Vict. c. 65, s. 7).

His full title is the Comptroller-General of Patents, Designs and Trade Marks (Act of 1907, sect. 3 (1)), and he acts under the superintendence and direction of the Board of Trade. (See sect. 62 (2), *post*.) The Registrar of Designs and Trade Marks is appointed by the Board to act for the Comptroller-General in all matters relating to designs. (See sect. 87.)

² *Application in the prescribed form.*—See definition of “prescribed” in sect. 93, *post*. The Act provides (sect. 86) for the issue of general rules (a) for regulating the practice of registration; (b) for classifying goods; (c) for making drawings and other instruments. The provisions as to drawings, &c. to be supplied, and as to other particulars to be included in the application, are now comprised in Rules 13—30, *post*, p. 295 *et seq*.

The former provisions were contained in the Act itself, sect. 47 (2) and (3), above, and sect. 48, as set out above.

In the Schedule to the 1883 Act, Sched. E., which contained the form of application in which the section prescribed that the application was to be made, nothing was said about the design being applicable for one matter or the other; all that the applicant was required to state was the nature of the design. In the Rules the form was accompanied by a note which interpreted the “nature of the design” as including such matters as “whether applicable to pattern, shape, or configuration”; but it was held that this did not import a condition which would limit the effect of the design when registered, and, there being no such condition, the person registering was not limited to some part or to some effect of his design: *Re Rollason's Design* (1898), 15 R. P. C. at p. 446.

An application must now be made in Form 2 or (for a set) Form 3

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or (for lace) Forms 4 or 5 (Rules of 1908, Rules 14, 15), and must be signed by the applicant or his agent (Rule 13).

The form must be stamped with the proper fee (Rule 3 and sect. 65). The fees are set out in 1st Schedule to the Rules (*post*, p. 318). Properly stamped forms can be obtained through any Money Order Office in the United Kingdom. (See Instructions to Persons who wish to Register, *post*, p. 406.)

An application may be amended (Rule 63). See form for correction of clerical error, Form 17, *post*, p. 382. (See also sect. 70, *post*.)

Power is given to the Comptroller to dispense with the signature to an application, and to make other relaxations of the Rules upon good cause shown (Rule 62).

The applicant must state in the form of application the class in which the design is to be registered, and the article or articles to which it is to be applied, and where required by the Comptroller he must also state for what purpose the article to which the design is to be applied is used, and further endorse on the application a brief statement of the novelty he claims for his design (Rules 18, 19).

The description of a design for the register must be of the exact form in which it is intended to sell it, for no portion of the design claimed can be rejected and protection be still retained for the rest: *semble*, Wills, J., *Smout v. Slaymaker* (1890), 7 R. P. C. 90.

But there may be a registration of a design as a whole ("for the totality") which will be good though some of the parts—*e.g.*, shape or configuration—could not be supported alone. (Per Lord Herschell in *Harper v. Wright and Butler* (1895), 12 R. P. C. at p. 490.) And a registration will not be invalidated because the applicant for the design has sold as registered something which is not covered by the registered design: per Warrington, J., *In re Bayer's Design* (1906), 23 R. P. C. 553.

³ *Any person*.—This clearly includes a foreigner: *Guiterman's Design* (1886), 55 L. J. Ch. 309. There was an express enactment in the Act of 1861 (24 & 25 Vict. c. 73, s. 1) that the privileges of the Designs Acts should extend to any proprietor, whether a British subject or not. The rights of a foreigner registered under the Act of 1883 were subject to the provision in sect. 54 that he manufactured in this country within six months; and sect. 58 of the present Act provides that the registration may be cancelled *at any time* if the design is manufactured exclusively or mainly outside the United Kingdom.

Where an applicant lives abroad he must furnish the Comptroller with an address for service in the United Kingdom, and until he does so the Comptroller need not proceed with the examination of his application. And where a registered proprietor lives out of the United Kingdom and has not furnished such address for service, the Comptroller need not send to him any notice which under the Rules he is required to send (Rule 11).

"Person" includes a body corporate, and the singular includes the plural (52 & 53 Vict. c. 63, s. 1, *post*, p. 371), so that joint owners may register; and an application may be signed by any member of a firm or partnership on its behalf, or by a director or other officer on behalf of a body corporate (Rule 8).

⁴ *Claiming.*—It is no part of the Comptroller's duty to adjudicate on the rights of rival claimants to the proprietorship of a design. Each claimant may register the design, and their respective rights can be settled by an application to the Court to expunge under sect. 72.

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The Comptroller has, however, power to refuse to register any design presented to him for registration (see note ¹¹ on sub-sect. 3, *infra*); and the Act contemplates that such refusal may be made on the ground of identity of the design sought to be registered with a design already on the register. (See the proviso in sect. 56.) For other grounds of refusal, see sect. 75 and notes thereon, *infra*.

⁵ *Proprietor.*—For the definition of "proprietor," see sect. 93 and notes thereon, *infra*.

⁶ *New or original.*—These qualifying words in the disjunctive form appear in the Act of 1843 (designs for articles of utility), but the corresponding words in the earlier Act of 1842 (ornamental designs) are *new and original*. The same form was used in sect. 61 of the 1883 Act, and appears in the definition of "proprietor" in the present Act (see sect. 93, *infra*), so that the decisions as to novelty or originality under the previous Acts will still apply. (See Chap. III. on "Novelty," *ante*.)

A distinction between "new" and "original" was drawn in *Sherwood v. Decorative Art Tile Co.* (1887), 4 R. P. C. 207; and the point was also discussed in the subsequent cases of *Re Clarke's Design* (1896), 13 R. P. C. 351, and *Re Rollason's Design* (1897), 14 R. P. C. 909.

The novelty required by the Act is not novelty in the idea, but novelty in the design, that is, novelty in the way in which the idea is to be rendered applicable to some special subject-matter: *Saunders v. Wiel* (1893), 10 R. P. C. 29; see also *Harrison v. Taylor* (1859), 29 L. J. Ex. 3; *Thom v. Sydall* (1872), 26 L. T. N. S. 15. So that the mere fact that what is applied to an article of manufacture is common property does not render the design as thus applied bad for want of novelty: *Ibid.*; and see *Pearson v. Wilkinson* (1906), 23 R. P. C. 738.

The Act contains special provisions as to registrations of designs in new classes not being invalidated by reason of previous registrations in other classes. (See sect. 50 and note thereon, *post*.)

The useful purpose which the shape or configuration of the design is intended to serve is not to be considered so far as subject-matter is concerned: *Walker v. Hecla Foundry Co.* (1887), 5 R. P. C. 71, 365, and in the House of Lords (1889), 6 R. P. C. 554; *Windover v. Smith* (1863), 32 L. J. Ch. 561; *Sherwood's Design* (1892), 9 R. P. C. 268; *Moody v. Tree* (1892), 9 R. P. C. 233.

Nor are the novelty of the means or instruments by which the design is produced: *Plackett's Design* (1892), 9 R. P. C. 436.

But the utility of a design may be some evidence of originality: *Tyler v. Sharpe* (1893), 11 R. P. C. 351; *Harper v. Wright and Butler* (1895), 12 R. P. C. 483; *Nevill v. Bennett* (1898), 15 R. P. C. 412.

The pattern, shape, configuration or ornament are alone to be con-

Sect. 49. sidered: *Walker v. Hecla Foundry Co.*, *supra*; *Rogers v. Driver* (1850), 16 Q. B. 102.

A design may also be the subject of a patent: *Werner Motors v. Gamage's* (1904), 21 R. P. C. 137, 621. But there is no complete analogy between patents and designs in the matter of novelty: *Harrison v. Taylor* (1859), 29 L. J. Ex. 3; *Moody v. Tree* (1892), 9 R. P. C. 233; *Lazarus v. Charles*, 16 Eq. 117. The combination of two old patterns in the same manner as that in which other patterns have been previously combined, may, if the application is new, form a new and original design: *Ibid.*; *Saunders v. Wiel*, *supra*; *Thom v. Sydall*, *supra*.

But articles manufactured with only a slight alteration in form from articles already on the market will not be considered new or original (*Lazarus v. Charles*, *supra*; *Le May v. Welch* (1884), 28 Ch. D. 24; *Re Clarke's Design* (1896), 13 R. P. C. 351), although a high standard of originality is not expected: *Walker v. Falkirk Iron Co.* (1887), 4 R. P. C. 391; *Harper v. Wright and Butler*, *supra*; *Re Rollason's Design* (1897), 14 R. P. C. 909.

A design must be either substantially new or substantially original, having regard to the subject-matter to which it is to be applied: *Le May v. Welch*, *supra*; *Smith v. Hope* (1889), 6 R. P. C. 201. "Subject-matter" in this connection means purpose to which it is to be applied: *Re Bach's Design* (1889), 6 R. P. C. 376.

So that it follows that a design which has been registered in one class is not new or original when applied to articles of analogous character and registered in another class: *Read and Greswell's Design* (1889), 6 R. P. C. 471; *Re Clarke's Design*, *supra*. But see the new provisions in sect. 50, *infra*, as to the rights of registered proprietors to secure protection for the application of the design in other classes.

A difference in material does not constitute novelty. But an old design may be new or original for the purposes of the Act if it is applied to a different kind of article: *Walker v. Falkirk Iron Co.* (1887), 4 R. P. C. 390.

The application of the same thing to the same purpose, although in an enlarged size, is not new and original: *Windover v. Smith* (1863), 32 L. J. Ch. 561. But an alteration of the proportions of an old design may produce a new design: *Harrison v. Taylor* (1859), *supra*; *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380; *Re Rollason's Design* (1897), *supra*.

And a new and original combination formed by simultaneously applying old and known designs, previously used separately, to the same article is a new and original design: *Reg. v. Firmin* (1851), 3 H. & N. 304; *Harrison v. Taylor* (1859), *supra*; *Sherwood v. Decorative Art Tile Co.* (1887), 4 R. P. C. 211; *Heinrichs v. Bastendorff*, 10 R. P. C. 160; *Nevill v. Bennett* (1898), 15 R. P. C. 812.

Whether a design is novel or original is a question of fact: *Harrison v. Taylor*, *supra*; *Re Bayer's Design* (1906), 23 R. P. C. 553.

In considering whether one design is an anticipation of another, as in considering whether one design is an infringement of another—for the rules which guide the Court are similar in both cases (*Le May v. Welch* (1884), *supra*)—the eye alone is the judge of the identity of the two things: *Holdsworth v. McCrea* (1867), L. R. 2

H. L. 380; *Walker v. Hocla Foundry Co.* (1889), 6 R. P. C. 554; *Gordon v. Patrick Munro & Co.* (1894), 12 R. P. C. 22; *Ingram v. Edwards* (1904), 21 R. P. C. 463. Sect. 49.

The test is not merely to look at the two designs side by side, but consideration should be given to what would be the effect supposing they were seen at different times or supposing they were looked at a little distance off: *Grafton v. Watson* (1884), 50 L. T. 420.

In deciding this question of fact, viz., whether one design is an anticipation of another, the Court may have the assistance of experts—persons conversant with the particular trade: *Grafton v. Watson* (1884), 50 L. T. 420; *Cooper v. Symington*, 10 R. P. C. 264; *Birkin v. Pratt* (1895), 12 R. P. C. 371; *Werner Motors v. Gamage's* (1903), 21 R. P. C. 137.

¹ *Not previously published.*—See Chap. IV. on “Publication,” *ante*. For the purpose of seeing whether there has been any prior publication the design is treated as original, and, under the old Acts, it was held that the question to be determined was whether the particular design had, prior to registration, been disclosed to any person not in a confidential relation to the proprietor: *Blank v. Footman* (1888), 5 R. P. C. 653; *Winfield v. Snow* (1891), 8 R. P. C. 15. The question was, is it a fair conclusion from the evidence that some member or members of the general public in the United Kingdom, under no obligation to secrecy arising from good faith or confidence, knew of the design prior to the registration? See *Humpherson v. Syer* (1887), 4 R. P. C. 414; *Hunt v. Stevens* (1878), W. N. 79; *Westley Richards v. Perkes* (1893), 10 R. P. C. 181.

Showing a design to an expert or friend to get advice was not publication: see *Nevill v. Bennett* (1898), 15 R. P. C. 412; *Heinrichs v. Bastendorff* (1893), 10 R. P. C. 160. But if the person who was consulted confidentially changed his character from that of adviser to that of buyer, the character of the communication changed and was no longer confidential: *Winfield v. Snow, supra*.

The present Act contains express provisions 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 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, shall not be deemed a publication sufficient to invalidate a subsequent registration; and as regards textile designs (but those only) there is a special provision that the acceptance of a first and confidential order for such goods shall not be deemed publication. (See sect. 55 and notes thereon, *post*.)

Disclosure of the design to persons who are engaged to work out or manufacture the design is not publication. (See the definition of “proprietor” in sect. 93, *infra*, and *Blank v. Footman, supra*.)

Under the old Acts it was doubted whether the condition, that the design should be registered before publication, was not limited to publication of the design after it had been embodied and introduced into some fabric: *DalGLISH v. Jarvie* (1850), 20 L. J. Ch. 475; cf. *De la Branchardière v. Elvery* (1849), 4 Ex. 381.

Following the analogy of patent cases, the publication of the design in any picture or book, or the use or sale or public exhibition of an article to which the design has been applied, will be publication within

Sect. 49. the meaning of this section. This will generally be a question of fact: *Stead v. Williams* (1843), 2 W. P. O. 126.

For the effect of publication in foreign books see *Lang v. Gisborne* (1862), 31 L. J. Ch. 769; *Harris v. Rothwell* (1886), 4 R. P. O. 225; and *United Telephone Co. v. Harrison* (1883), 21 Ch. Div. 720.

As to publication in libraries, see *Plimpton v. Malcolmson* (1876), 3 Ch. D. 531; *Plimpton v. Spiller* (1877), 6 Ch. D. 412; *Otto v. Steel* (1885), 3 R. P. O. 109; and *Harris v. Rothwell, supra*.

The question whether registration is publication was raised in *Read and Greswell's Design* (1889), 6 R. P. O. 473, but not decided. The point is an open one, but it is submitted that it is not; registered designs are kept secret (sect. 56), thus differing from trade marks, registration in which is publication. (See also *Dalglish v. Jarvie, supra*.) The Act also contains express provisions for the application of registered designs to goods in other classes without invalidation on the ground of the previous registration. (See sect. 50 (a), *infra*.)

For publication at exhibitions, see sect. 59 and notes thereto, *post*.

⁸ *United Kingdom*.—Prior publication abroad is no anticipation, the right secured by registration being limited to this country: *Potter v. Braco de Prata Co.* (1891), 8 R. P. O. 218. As to protection of foreign designs under international arrangements, see sect. 91 and notes thereon, *post*; and the International Convention and notes thereon, *post*, p. 321.

⁹ *Register*.—As to particulars to be entered in the register, see sect. 52. For effect of registration, see sect. 53 (1). As to the procedure after filing of the application, see Rules 31—34 and 69.

¹⁰ *More than one class*.—Power is given to the Board of Trade to make general rules for (*inter alia*) classifying goods for the purpose of designs. (See sect. 86 (1) (b).) The various classes are given in the 3rd schedule, *ante*, p. 29; and see Rule 6.

It is important for proprietors to register the design in every class of goods to which they may wish to apply it; for, though no other person would be able to make a valid registration for similar goods in any other class (*Read and Greswell's Design* (1889), 6 R. P. O. 471; and *Re Clarke's Design, supra*), a registered design is only protected from infringement in the class in which it is registered; and if the proprietor of a design registered in one class applies it to goods which fall within another class, the registration does not protect him for such goods: *Hothersall v. Moore* (1892), 9 R. P. O. 27, 38. (See also sect. 60.) Under the new Act a registration for goods in another class may be made at any time without being invalidated on the ground of the previous registration (sect. 50).

A design may be registered to be applied to a single article in a class or to a set of articles in a class; the term "set" includes any number of articles ordinarily on sale together, or intended to be used together, all bearing the same design, with or without modifications, not sufficient to alter the character of the design (Rule 5). The fees payable vary in different classes. (Schedule I., *post*, p. 318.) In cases of doubt the Comptroller must decide as to the class (Rule 6).

¹¹ *May refuse to register.*—Before exercising this power the Comptroller must give the applicant an opportunity of being heard personally or by his agent, if he desires to be so heard (sect. 73 and Rules 32 *et seq.*). Power is given to the Comptroller to cancel the registration of a design on the written request of the proprietor, and also to correct any clerical error in the representation of a design or in the name or address of the proprietor, or in any other matter which is entered on the register (sect. 70 (b) and (c)). He is also given power to correct irregularities in procedure, and to enlarge the times proscribed in the Rules, upon terms, as he thinks fit. (See Rules 63 and 64.)

The only direction given to the Comptroller as to what designs he shall or shall not register is contained in sect. 75, which empowers him to refuse any design which, in his opinion, is contrary to law or morality. But sect. 56 (1) of the Act (*post*, p. 236) contemplates a design being refused on the ground of identity with a design already on the register.

Under the corresponding section in the trade marks portion of the 1883 Act (sect. 62 (4)), it was held that the discretion of the Comptroller was limited by the sections which specified what trade marks should not be registered (sects. 69, 72, 73). (See *Eno v. Dunn* (1890), 7 R. P. C. 3—11.) There is, however, no provision (as in the case of trade marks) for notice to the public of an application to register a design, and no opportunity is given for any opposition by the public to the registration. The Comptroller, therefore, is given a wide discretion in the matter, and he can apparently refuse the application on any reasonable grounds, subject to appeal to the Board of Trade, whose decision is final. (See *per Lindley, L.J.*, in *Re Clarke's Design* (1896), 13 R. P. C. at p. 357.)

¹² *Appeal.*—See Rules 89—94 and sect. 87, *infra*.

Under sect. 11 of the 1883 Act, by which an appeal to the law officer from the Comptroller in the case of an opposition to the granting of a patent was given, it was decided that there was no appeal to the Court. Under sect. 62, the corresponding section with reference to trade marks, the appeal was decided by the Court if the Board of Trade referred the matter; but it was held, in a case where the Board of Trade refused to refer, that the Court had no power to deal with an application refused by the Comptroller: *In re Trade Mark "Normal"* (1887), 4 R. P. C. 123. Therefore it would seem that, under the present provisions, there is no appeal from a decision of the Board of Trade.

There being no provision as to costs, the applicant will in any event have to pay his own.

¹³ *Board of Trade.*—All proceedings under this Act by and before the Board of Trade are regulated by sect. 87, and Rules 89—94.

¹⁴ *Prescribed time.*—This means prescribed by the general Rules (sect. 93). The time prescribed is twelve months from the date of application, at the expiration of which time the Comptroller will give notice to the applicant or his agent. (See Rule 35.)

¹⁵ *Deemed to be abandoned.*—This is a new provision. As to the effect of abandonment, see sect. 69, *infra*.

¹⁶ *Registered . . . as of the date of application.*—This is also a new provision, introduced by the Amendment Act of 1907, s. 29. Under

Sect. 49. the old Rule (Rules of 1890, No. 20), the registration dated from "the day upon which the application was received" by the Comptroller, and the present provision in the Act itself is probably intended to have the same effect.

Registration
of designs in
new classes.

50. Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused,¹ nor shall the registration thereof be invalidated—

- (a) on the ground of the design not being a new and original design, by reason only² that it was so previously registered; or
- (b) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods³ of any class in which it was so previously registered.

¹ *Shall not be refused.*—The whole of this section is new, and was introduced by the Amendment Act, 1907, s. 33. Under the old Act it was held that a design already on the register might be registered in another class for an article applied to a different purpose, but not for an article merely of a different material; *e.g.*, for lamp shades, either of linen or china: *Re Bach's Design* (1889), 6 R. P. C. 376; and see *Re Clarke's Design* (1896), 13 R. P. C. 351, and *Re Read and Greswell's Design* (1889), 6 R. P. C. 471.

The Comptroller has the power (expressly recognised by sect. 6 of the Act of 1888) to refuse to register any design on the ground of identity with a design already registered, and this is continued by sect. 56 (1) of the present Act (*post*, p. 236); but the exercise of this power is now made subject to the right of the proprietor of a design already on the register to register it in other classes, and by this means practically to secure a new and extended copyright for the design. This limitation of the Comptroller's power of refusal to register on the ground of identity does not, however, apply in the case of persons other than a registered proprietor.

² *By reason only.*—The exemption is restricted to the two cases stated in (a) and (b), viz., previous registration of the design in another class and the application of the design to goods in that class, and it is limited to the proprietor of the original design. But as regards all other cases and persons, the old authorities as to invalidity on the ground of prior publication or want of novelty will still apply. (*See ante*, p. 46 *et seq.*)

³ *Applied to goods.*—This exemption only covers the application to goods in any class in which the design has been previously registered, and the application to any goods not in that class (which is open

to third persons as well as the original proprietor) will, of course, invalidate. (See *Re Read and Groswell's Design*, *supra*.)

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51.—(1.) The comptroller shall grant a certificate¹ of registration to the proprietor of the design when registered.²

Certificate of registration.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies³ of the certificate.

(*This repeats sect. 49 of the 1883 Act.*)

¹ *Certificate.*—For form of certificate, see Form D. O., No. 1, *post*, p. 377. The certificate is *prima facie* evidence of the entry on the register and the contents thereof (sect. 79). It is supplied in the first instance without an extra fee. It will be sent when the Comptroller “accepts” the application (Rule 31). But according to the practice of the Comptroller’s Office, if a date of registration merely has been secured by an application accompanied by a single sketch, no certificate will be issued until three exact drawings, photographs or specimens have been sent in substitution for the sketch. (See Instructions, *post*, p. 406.) If the application is not completed by delivery of the drawings, &c. within the prescribed time, it is deemed to be abandoned, and no certificate can then be issued (sect. 49 (4)). (See also sect. 54 (1) (a) and Rule 35.)

² *When registered.*—The entry is not made in the register until the certificate of registration is sealed, but registration dates from the day on which the application is received by the Comptroller. (See sect. 49 (5).)

³ *Copies.*—A copy will be given if application be made on a properly stamped request. (Form No. 27, *post*, p. 389.) The fee is one shilling.

52.—(1.) There shall be kept at the Patent Office a book called the Register of Designs¹ wherein shall be entered the names² and addresses of proprietors³ of registered designs, notifications of assignments⁴ and of transmissions⁵ of registered designs, and such other matters⁶ as may be prescribed.

Register of designs.

(2.) The register of designs existing⁷ at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

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(3.) The register of designs shall be *prima facie* evidence of any matters¹ by this Act directed or authorised to be entered therein.

(*Sub-sects. 1 and 3 repeat sect. 55, and sub-sect. 2 repeats sect. 114 (2) of the 1883 Act.*)

¹ *Register of designs.*—See sect. 71 and Rules 43 to 49. The register is open to the inspection of the public, subject to the regulations (sect. 67 and Rule 69, *post*).

Entries in the register may be corrected (sect. 70) and expunged or rectified (sect. 72). A separate register is kept at the Manchester office for goods in Classes 13, 14 and 15 (Rules 85, 86).

² *Names.*—The person whose name is on the register as proprietor of a design is the legal owner of that design (sect. 71); no notice of any trust can be entered in the register (sect. 66); but any equities in respect of any design can be enforced in like manner as in respect of any other personal property (sect. 71). (And see *Stewart v. Casey* (1892), 9 R. P. C. 9.)

³ *Proprietors.*—See the definition in sect. 93 and notes thereon, *post*, p. 278 *et seq.* A partial assignee or a licensee may be a proprietor: *Jewitt v. Eckhardt, infra.* In any case, whether licensees and partial assignees are “proprietors” or not, they can have their names put on the register (sect. 71 (2)), and may become thereby “registered proprietors” for the purposes of the Act.

⁴ *Assignments.*—See sect. 71, *post*, and notes thereon, and Rules 43—48. No transfer can be registered before the design is registered, nor can any licensee or partial assignee register before the author or sole proprietor of the design. This was a decision, given with some doubt by Jessel, M.R., upon the words of sects. 3, 5 and 6 of the Act of 1842, which in substance correspond with sects. 52 (1), 53 (1), and the definitions of “copyright” and “proprietor” in sect. 93, of the present Act. (See also *Jewitt v. Eckhardt* (1878), 8 Ch. D. 404.) But it is submitted that a person, who has obtained an unregistered design by assignment or otherwise, is not prevented from applying, under sect. 49, as a “person claiming to be proprietor,” to register the design. Whether an assignment of an unregistered design is publication is another question. (See sect. 49, note⁷, *ante*, p. 224.)

Sect. 6 of the Act of 1842, which is the corresponding section to this, contained the words “any writing . . . shall operate as an effectual transfer”; but there is no similar provision anywhere in this Act or in the Rules. It is doubtful, therefore, whether the decision (*Jewitt v. Eckhardt*, under the old Act) that an assignment or license must be in writing is any longer law. (See *Woolley v. Broad* (1892), 9 R. P. C. 208, and the cases on this in Chap. VIII. on “Proprietors,” §§ 122—124, *ante*.)

⁵ *Transmissions.*—A design is transmitted and devolves like any other personal property. (See sect. 71 (1).)

Any one or more of the co-proprietors may assign his interest without the concurrence of the others, and the right to restrain infringe-

ment will attach to all such partial interests: *Lauri v. Ronald*, [1892] 3 Ch. 402. Sect. 53.

⁶ *Such other matters.*—The date of application must be entered on the register, and the registration runs from that date (sect. 49 (5)).

⁷ *Register of designs existing.*—The old register of designs was regulated by sect. 87 of the Act of 1883, corresponding with sect. 71 of the present Act. As regards designs for goods in Classes 13, 14 and 15, a duplicate of the entries of such designs registered under the old Act in which there is subsisting copyright is to be kept at the Manchester office (Rule 85).

⁸ *Evidence.*—Sealed copies of entries in the register are received in evidence without any further proof or production of the registers (sect. 79).

Copyright in registered Designs.

53.—(1.) When a design is registered,¹ the registered proprietor² of the design shall, subject to the provisions of this Act, have copyright³ in the design during five years⁴ from the date of registration.⁵ Copyright on registration.

(2.) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller shall⁶ on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3.) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller may, subject to any rules under this Act,⁷ on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

(Sub-sect. 1 repeats sect. 50 (1) of the Act of 1883; sub-sects. 2 and 3 are new.)

¹ *When a design is registered.*—The statutory copyright in designs depends on due registration; but, as in the case of books, paintings, etc., there is a right of property in an unpublished design which will receive protection from the Courts (see *ante*, §§ 56 to 59), and regis-

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tration really only affects the *remedies* given to the proprietor of the copyright against infringers.

Under the old Designs Acts a distinction was made between useful and ornamental designs, but by the Act of 1883, which is followed by this Act, all designs were put on the same footing. (See sects. 49, 50 and 51 and the notes thereon, *ante*.)

² *Proprietor*.—For definition, see sect. 93 and notes thereon, *post*. As to partial assignees or licensees, see note ³ to sect. 52, *ante*, p. 228.

³ *Copyright*.—For definition, see sect. 93 and notes thereon, *post*.

Copyright in designs is of statutory creation; but it may be doubted whether the recital in the preamble of the first Designs Act of 1787 (27 Geo. III. c. 38), as to there being then no property in designs, meant anything more than the similar recital as to copyright in the first Art Copyright Act of 1862 (25 & 26 Vict. c. 68), which has been explained as referring only to statutory copyright, and as “not being intended to abolish the common law principles as to unpublished works.” (See Scrutton on Copyright (1903), p. 161 *et seq.*)

⁴ *Five years*.—Under the old Designs Acts varying terms of protection in the different classes were granted, the longest of which was three years, though the Board of Trade had power to extend this term by another three years in the case of ornamental designs. (5 & 6 Vict. c. 100, s. 3; 6 & 7 Vict. c. 65, s. 2; 13 & 14 Vict. c. 104, s. 9.) By the Act of 1883, one fixed term of five years was adopted for all designs; but the present Act reverts, with some modifications, to the old method of extensions, which are partly optional at the instance of the proprietor (sub-sect. 2), and partly within the discretion of the Comptroller (sub-sect. 3).

⁵ *The date of registration*.—Registration is deemed to date from the date on which the Comptroller received the application (sect. 49 (5)).

⁶ *The Comptroller shall*.—This provision, which is new, gives an absolute right to an extension of five years beyond the first term of copyright, the only conditions being (a) that application shall be made within the prescribed time before the expiration of the first term of five years; (b) that it shall be made in the manner prescribed by the Rules (see sect. 93, definition of “prescribed”); and (c) that the prescribed fee shall be paid (see sect. 65, *post*). As to the time and manner of the respective applications for the first and second extensions, see Rules 37—41, and Forms 8, 9 and 10, *post*, p. 378.

It would appear that application for the extension may be made by any person entitled as proprietor, which term includes partial assignees and licensees (see note ³ to sect. 52, *ante*, p. 228), and presumably any extension will enure for the benefit of all the proprietors.

⁷ *The Comptroller may, subject to any Rules*.—The provisions for the second extension of the term gives a discretion to the Comptroller, and this discretionary power will practically be regulated by sect. 73, which gives an applicant the right of being heard in support of his application, and Rules 55—58, dealing with the exercise of discretionary powers, though apparently there will be no right of appeal as in the case of an original registration. (See sect. 49 (3), *supra*.)

54. ... (1.) Before delivery on sale¹ of any² articles to which a registered design has been applied,³ the proprietor⁴ shall—

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Requirements before
delivery on
sale.

(a) (if exact representations or specimens were not furnished on the application for registration⁵), 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 erase⁶ his name from the register, and thereupon the copyright in the design shall cease; and

(b) cause each such article⁷ to be marked with the prescribed mark,⁸ or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages⁹ 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,¹⁰ or unless he shows that the infringement took place after the person guilty thereof knew or had received notice¹¹ of the existence of the copyright in the design.

(2.) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense¹² with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions¹³ as they think fit.

50.—(2.) *Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact* [Act of 1883, sect. 50 (2).]

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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.

[Act of 1883,
sect. 51.]

51. *Before delivery on sale of any articles 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.*

The corresponding sections of the Acts of 1842 and 1843 (5 & 6 Vict. c. 100, s. 4, and 6 & 7 Vict. c. 65, s. 3) provided that no person should be entitled to the benefit of the Acts unless every article published by him to which a registered design was applied bore the prescribed mark; but this did not involve forfeiture of the copyright, as in the 1883 Act, and the present provisions are somewhat of a reversion to the old position, the penalty of forfeiture for non-marking being abolished.

¹ *Delivery on sale.*—See Chap. VIII. on “Marking,” and cases cited therein (*ante*, p. 129), and Rule 68, *post*. The proprietor of the design must mark every article that he delivers on sale; no liability under this section will attach to him if the person to whom he sells takes off the mark and sells again: *Sarazin v. Hamel* (1863), 32 L. J. Ch. 380. Nor will the proprietor suffer if by process of time or manufacture the mark becomes illegible: *Fielding v. Hawley* (1883), 48 L. T. N. S. 639; but see *Johnson v. Bailey* (1893), 11 R. P. C. 21. Under the old Acts it was held that the proprietor of a design registered in this country must put the prescribed marks on articles sold abroad, even though they were manufactured abroad; and the reasoning on which the decision was founded appears equally applicable to the present Act: *Sarazin v. Hamel, ubi supra*; cf. *Potter v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

Articles need only be marked before “delivery on sale,” and not before “publication,” as under the old Acts. It is submitted, therefore, that patterns, provided they are not sold, do not require to be marked: cf. *Heywood v. Potter* (1853), 22 L. J. Q. B. 133.

If goods are delivered on sale and the design is applied to them, they must be marked though unfinished, and this apparently though the finishing will destroy the mark: *Woolley v. Broad* (1892), 9 R. P. C. 429. But this will, of course, now be subject to the provisions of sub-sect. 2 of this section, which will enable exemption to be made in appropriate cases.

² *Any.*—The words of the old statutes were “every article shall bear . . .;” and it was decided that these terms must be interpreted strictly, and that a failure to mark even one article was fatal to the copyright: *Pierce v. Worth* (1868), 18 L. T. N. S. 710; *Hunt v. Stevens*,

W. N. (1878) 79. The words of this section must be interpreted equally strictly, and a single instance proved against the proprietor will be sufficient to deprive him of his right to penalties or damages unless he is helped by the saving clauses.

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³ *Articles to which a registered design applied.*—To print a copy of a design in a book is not to apply the design to an article of manufacture: 5 & 6 Vict. c. 100, s. 4. So that diagrams and copies of designs need not bear the registration marks: *De la Branchardière v. Elvery* (1849), 4 Ex. 380.

Under sect. 58 of the 1883 Act (see sect. 60, *infra*) it was held that preparing rollers or dies to print a registered design was not an application of such design to an article within the section: *Potter v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

⁴ *Proprietor* (see Chapter VII. on “Proprietor” and cases cited therein, *ante*, p. 115).—Under the corresponding sections of the old Acts, the penalty for the non-performance of the conditions of copyright fell only on the person who neglected to comply with them: “No person shall have the benefit of this Act, unless every article published by him hath thereon” (5 & 6 Vict. c. 100, s. 4.)

If the decision in *Jewitt v. Eckhardt*, 8 Ch. D. 404, be correct, namely, that every assignee, whether absolute or limited, and every licensee is a proprietor to the extent of his interest (see sect. 93, definition of “proprietor,” and notes thereon), such limited proprietor might be held to be within the words “the proprietor of the design,” for the singular includes the plural, and the failure of a limited proprietor to mark might cause loss of the right to sue for penalties or damages.

The better opinion seems, however, to be that the proprietor of the full copyright can claim protection under the proviso if he can show that he has taken reasonable steps to secure marking by the persons claiming under him (per Charles, J., in *Wedekind v. General Electric Co.* (1897), 14 R. P. C. 190).

⁵ *On the application for registration.*—It is assumed throughout this sub-section that a design is registered from the time an application, accompanied by a single sketch, is received by the Comptroller. (See sect. 49 (5) and the Instructions issued by the office, *post*, p. 406.)

⁶ *May erase.*—The exercise of this power is discretionary, and would depend on the circumstances. Any owner affected by an adverse decision has a right of being heard before the Comptroller (Rules 55—58); and this right is also preserved by sect. 73 of the Act. But whether there is any right of appeal to the Board of Trade in such a case, *query*.

⁷ *Each such article.*—These words include every piece of an article bearing a registered design, whether that piece be large or small (*e.g.* a pattern), if sold or intended to be sold separately: *Blank v. Footman* (1888), 5 R. P. C. 653. The fact that the article is capable of separation into parts does not make it necessary to place the mark on each, if all the parts together constitute but one complete article: *Fielding v. Hawley* (1883), 48 L. T. N. S. 639; *Ingram and Kemp v. Edwards* (1904), 21 R. P. C. 463. But *aliter* if each part constitutes a separate article: *Hothersall v. Moore* (1892), 9 R. P. C. 27; *Lea and Perrins v. Price* (1904), 22 R. P. C. 122.

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Articles which, though manufactured in the piece (*e.g.* in pieces containing a dozen articles), properly fall within Class 14 (handkerchiefs and shawls), are not sufficiently marked by having the proscribed mark on each piece, and not on each article: per *Bristowe, V.-O., Mothersall v. Moore* (1892), 9 R. P. C. pp. 27, 39.

⁸ *Marked with the proscribed mark.*—Each article must be marked in some convenient manner; it is not necessary to put the mark on the article itself, but tying on a label or printing on the packet in which it is sold is sufficient: *Blank v. Footman, ubi supra*.

The object of this provision as to marking is that the public should be warned against copying designs that are registered: *Sarazin v. Hamel, ubi supra*.

But the mark must be affixed or attached to that part of the article to which the registered design applies, and not to some part which is not copyright: *In re Morton's Design* (1899), 17 R. P. C. 117.

It is no objection that marks are also attached or impressed which do not apply to the design for which protection is claimed: *Harper v. Wright and Butler* (1895), 12 R. P. C. 483.

As to the marks to be put on the different classes of goods, see Rule 68, *post*, p. 309.

⁹ *Not entitled to recover.*—Under the old law the copyright was forfeited by non-marking even of a single copy, but this hardship was abolished by the Amendment Act of 1907 (sect. 32 (1)), which is incorporated by this section. The alteration is a vital one, and it approximates the conditions of designs copyright to those affecting works of art. (See 25 & 26 Vict. c. 68, s. 4.)

¹⁰ *Unless the proprietor shows that he took proper steps.*—This exception was first introduced by the Act of 1883.

Where the plaintiff ordered his manufacturers to affix the proper mark, but they by some blunder affixed the mark of another design, the registration of which had expired, but which contained the important letters Rd., it was held that the plaintiff was protected by this provision: *Wittman v. Oppenheim* (1884), 27 Ch. D. 260.

But whether the proprietor would be protected if he gave orders to his manufacturer to put on the proper mark, and the manufacturer omitted to put on any mark at all, is doubtful. A *bonâ fide* mistake in the number of the registration mark impressed will be excused under this proviso: *In re Rollason's Design* (1887), 14 R. P. C. 893—909.

Woolley v. Broad (1892), 9 R. P. C. 429, and *Johnson v. Bailey* (1894), 11 R. P. C. 21, are examples of cases in which the proviso has been decided to be inapplicable.

¹¹ *After the person guilty thereof knew.*—This is a new provision, introduced by the present Act, and it affects considerably the arrangements for strict marking which prevailed under the old Acts. Even intentional non-marking, which may become common under the new Act, will not deprive a proprietor of his rights or substantially affect his remedies, as both penalties and damages will become recoverable in respect of subsequent dealings with infringing goods as soon as the necessary notice has been given under this section. (See sect. 60 and notes thereon, *post*.)

The only protection to an intending producer of a design, apart from his general knowledge of other productions in the particular trade, which appears to be presumed, is the right given to him to require the Comptroller to search and inform him whether his design has been anticipated by any antecedent registration (see sect. 57 and notes thereon, *post*, and Rules 59, 60); but this is not absolute, as the Comptroller's certificate will not prevent an action for infringement, nor is it admissible as evidence on the defendant's behalf: *Smith v. Hope*, 6 R. P. C. 204.

¹² *Dispense with . . . any of the requirements.*—This seems to contemplate the abolition of marking altogether in respect of certain classes of goods, *e.g.*, lace or possibly textile fabrics, but it will have to be done by general rules under the Act, and no discretionary power of exemption is vested in the Comptroller. The Rules of 1908 do not contain any such exemption, but the requirements as to marking are modified in the case of lace and goods in Classes 13, 14 and 15.

¹³ *Subject to such conditions.*—These conditions are set out in the Rules. (See Rule 68, and notes thereon, *post*.)

55. 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, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication¹ of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently² to the disclosure or acceptance.

Effect of disclosure on copyright.

¹ *Shall not be deemed to be a publication.*—This is an entirely new provision introduced by the Amendment Act, 1907 (sect. 31 (2)), as an addition to sect. 50 of the old Act. It provides for three cases of publication which were already partly covered by judicial authority but now receive statutory exemption:—

(a) Disclosure by the proprietor to a person in circumstances creating a confidential relation (*bona fides*): *Blank v. Footman* (1888), 5 R. P. C. 653; *Nevill v. Bennett* (1898), 15 R. P. C. 412.

(b) Disclosure by any other person in breach of good faith: *Humpherson v. Syer* (1887), 4 R. P. C. 407.

(c) Acceptance of a confidential order. Hitherto offer on sale and acceptance of orders before registration have always been regarded as publication invalidating the copyright. (See *Winfield v. Snow* (1891), 8 R. P. C. 15.) The limitation of this exemption to textile fabrics seems rather arbitrary, and the effect is to leave the old law on this point applicable to all other classes of goods.

² *If registration is obtained subsequently.*—A similar exemption is given

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to patentees by sect. 41 (2), but the requirement that legal protection shall be obtained as soon as publication comes to the knowledge of the proprietor is not repeated in the case of designs. No public notice is required before the granting of an application for registration, and no opportunity given for opposition by parties interested; so that it may be possible, under this provision, to effect registration even after an infringement arising from a confidential disclosure, etc. and to recover penalties or damages for any subsequent dealing with goods antecedently produced. (See note ¹¹ to sect. 54, *ante*.)

Inspection of registered designs.

56.—(1.) During the existence of copyright in a design, or such shorter period not being less than two years¹ from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in writing by him, or a person authorised by the comptroller or by the Court,² and furnishing such information as may enable the comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground of identity³ with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2.) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.⁴

(3.) Different periods may be prescribed⁵ under this section for different classes of goods.

[Act of 1883,
sect. 52.]

52.—(1.) *During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the*

design, nor except in the presence of the Comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof. Sect. 56.

Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered. [Act of 1888, sect. 6.]

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

¹ *Such shorter period as may be prescribed.*—This is a new provision introduced by sect. 34 of the Amendment Act, 1907. The ground for prohibition of inspection of registered designs being that reasonable time should be allowed to originators of new designs to secure the benefit of the novelties introduced by them, without running the risk of outside competition, and the term of copyright having been extended from five to an optional fifteen years, it was necessary to provide some such limitation as this, which has been amplified by the new Rules. (See Rule 69 and note ⁵ below.)

² *By the Court.*—The power given to the Court to make an order for inspection of a design of which the copyright is still in existence was first introduced by the Act of 1883.

³ *On the ground of identity.*—These words indicate a special ground for exercise of the Comptroller's discretionary powers not specifically mentioned in the sections relating to refusal of registration. But actual identity does not appear to be absolutely necessary to justify exercise of the discretionary powers, and an obvious copy may suffice. (See sect. 49 (3), *ante*, and sect. 75, *post*.)

⁴ *Prescribed fee.*—See 1st Schedule to the Rules, *post*, p. 318. As to the regulations for inspection, see sect. 67 and notes thereon, *post*, and Rules 60, 61.

⁵ *Different periods may be prescribed.*—The object of the prohibition being to prevent unfair competition, the periods of exclusion from inspection may vary in different trades. The Rules of 1908 provide the minimum period of two years for all classes, except Classes 13, 14 and 15 (textile goods), for which the period is five years.

57. On the request¹ of any person furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee,² the comptroller shall inform such person whether the registration still exists in respect of the design,³ and if so, in respect of what classes of goods, and shall state the date Information as to existence of copyright.

Sect. 57. of registration, and the name and address of the registered proprietor.

(This section is substantially the same as sect. 53 of the 1883 Act.)

¹ *Request.*—See Rule 59 and Forms 19, 20, *post*, pp. 383—4.

² *Prescribed fee.*—See 1st Schedule to the Rules, *post*, p. 318.

³ *Comptroller shall inform.*—The Comptroller is also authorised by Rule 60 to inform any person whether a particular design produced by that person, and to be applied to goods in any particular class, is or is not identical or an obvious imitation of any registered design applied to such goods of which the copyright is still existing. But the information given is not evidence: *Smith v. Hope*, 6 R. P. C. 204; nor, it is submitted, would any reply given to an inquiry under this section be.

Cancellation
of registration
of designs
used wholly
or mainly
abroad.

58.—(1.) At any time after the registration of a design any person may apply to the comptroller¹ for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom,² and where such an application is made the provisions of this Act with respect to the revocation of patents³ worked outside the United Kingdom (including those relating to costs⁴) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the comptroller.⁵

(2.) Such ground as aforesaid shall be available by way of a defence⁶ to an action for infringement of the copyright in the design.

[Act of 1883,
sect. 54.]

54. *If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.*

¹ *Any person may apply to the Comptroller.*—This is a new provision, introduced by sect. 35 of the Amendment Act, 1907, and it goes much further than the original Bill (which gave a period of one year before an application for cancellation could be made), and further than the similar provision as to patents (which gives four years from the date of the patent, sect. 27 (1)). It is to be observed that the application can be made “at any time,” and that the right to apply for cancellation is not restricted to “persons aggrieved,” as in the similar provision relating to applications for rectification of the register (sect. 72 (1)), and it is open, therefore, to any outsider at any time to make the

application. The draft Bill restricted these applications to "persons interested," but these words were left out in committee, and the only protection against vexatious use of the opportunity thus given to harass proprietors of designs seems to be in the provision of sect. 39 (1), which gives power to the Comptroller to order security or award costs to any party; a power which may, of course, be exercised against an applicant, notwithstanding that some order under the section may be made. (See Note ⁴, *post*, p. 241.)

The provision also extends, apparently, to existing registered designs, any of which may, at any time, be called in question by any person. (See sect. 98 (2), and notes thereon.) The new Rules provide a code of procedure on applications for cancellation under this section (Rules 70—75). The form of application (Form No. 23, *post*, p. 385) is required to have a 1*l.* stamp impressed on it.

² *Used for manufacture exclusively or mainly outside the United Kingdom.*—This provision introduces a new principle into the law affecting designs, and requires that the manufacture of the article to which the design is applied must be mainly within the United Kingdom. Difficulties may arise under this section in respect of British designs used for manufactures in foreign countries, where the output may be out of all proportion to the home manufacture; and these difficulties are increased in the case of foreign designs, for the use of which, in the United Kingdom, licenses or assignments of the British rights may have been obtained by an English manufacturer.

It is assumed that in all these cases the Comptroller will have regard mainly to the intention of the Act, and if the supply of goods for the English market is not manufactured exclusively or mainly outside the United Kingdom (or, *query*, if the design is applied here even though the goods bearing it may be manufactured abroad), he will reject any application for cancellation. (See note ³ below.)

The provisions as to marking as a condition of preserving the remedies against infringements apply even though the goods to which the design is applied may be manufactured abroad; and (apart from any international rights) there is no remedy in this country for foreign infringements: *Potter v. Braco de Prata, Ltd.* (1891), 8 R. P. C. 216.

³ *The provisions with respect to the revocation of patents worked outside.*—These provisions are contained in Sect. 27 of the Act, which runs as follows:—

(1.) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2.) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provi-

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Revocation
of patents
worked out-
side the
United
Kingdom.

Sect. 58. sions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(a) forthwith; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3.) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4.) Any decision of the comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

It is to be observed that sub-sect. 2 of this incorporated section introduces an important exception to the general words of the principal section "used for manufacture exclusively or mainly outside the United Kingdom," for if the proprietor of the design proves that the design is used for manufacture "to an adequate extent in the United Kingdom or gives satisfactory reasons" why the design is not so used, no order for cancellation may be made.

The words used in this exception are very vague, and give the Comptroller the widest possible discretion in dealing with different classes of designs. He must have regard to all the facts in each particular

case. Some idea of the considerations which he may be called on to take into account may be derived from the decisions under the German provisions for compulsory working of patents (Patent Act of 1891, s. 11), which authorise revocation after three years "if the patentee omits to utilise the invention in Germany to an adequate extent, or if he omits at least to do everything that is requisite to secure such utilisation." The Supreme Court of Appeal has held on this that "since the Patent Office has full discretion in matters of revocation, it may have regard also to the fact that the cost of production in Germany would have been much higher than that abroad; it may also take into consideration other disproportionate difficulties with which the development of a new industry in Germany has to contend; and such considerations as these, in conjunction with others, may justify the Patent Office in refusing the revocation." Sect. 58.

⁴ *Including those relating to costs.*—This refers to Sect. 39 of the Act, which is to the following effect:—

(1.) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court. Sect. 39.
Costs and
security for
costs.

(2.) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

As to requiring security for costs from foreign firms or companies "carrying on business" in the United Kingdom, see Rules of the Supreme Court, Ord. XLVIII. r. 1.

⁵ *No appeal from the decision of the Comptroller.*—A large distinction is made by these words between patents and designs; but it is to be observed that under sect. 74, in any cases of doubt or difficulty, the Comptroller may apply to a law officer for directions in the matter, and this power will probably be used in the event of any important

Sect. 58. legal question arising on the consideration of applications for cancellation, on which no appeal to the Court is given by the Act.

^o *Shall be available by way of a defence.*—This introduces a new ground of defence, which will presumably become common form in actions for infringement. But the Court will, it is assumed, take into account all the considerations which could have been placed before the Comptroller under sect. 27, sub-sect. 2, on an application for cancellation, and if no such application has been made before action, an attempted defence on this ground alone will, in ordinary circumstances, not be of much worth.

No power is given to the Court itself to order cancellation or to make a conditional order under clause (a) of the sub-section, and there can, therefore, be no counterclaim on the grounds stated in the section.

Industrial and International Exhibitions.

Provisions as
to exhibitions.

59.—(1.) The exhibition at an industrial or international exhibition certified as such by the Board of Trade,¹ or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

- (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 so²; and
- (b) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2.) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition³ of giving notice to the comptroller of his intention to exhibit, and shall be so

relieved either absolutely or upon such terms and conditions as may be stated in the Order. Sect. 59.

(Sub-sect. 1 of this section repeats sect. 57 of the Act of 1883. Sub-sect. 2 incorporates the provisions of sect. 3 of the 1886 Act.)

¹ *Certified by the Board of Trade.*—A list of exhibitions certified under this section is kept at the Patent Office.

² *Prescribed notice.*—As to the requirements to be complied with on giving notice, see Rule 76, and Form No. 24, *post*, p. 386.

³ *Relieved from the conditions.*—The Order in Council usually issued grants temporary protection to designs, or articles to which a design is applied, which may be exhibited at any of these international exhibitions, relieved from the conditions as to notice of intention to exhibit, set out in sect. 59 (1) (a).

Legal Proceedings.

60.—(1.) During the existence of copyright¹ in any design it shall not be lawful for any person— Piracy of registered design.

(a) For the purposes of sale² to apply or cause to be applied³ to any article in any class of goods⁴ in which the design is registered the design or any fraudulent or obvious imitation thereof,⁵ except with the license or written consent⁶ of the registered proprietor,⁷ or to do anything with a view to enable the design to be so applied;⁸ or

(b) Knowing⁹ that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent¹⁰ of the registered proprietor to publish or expose or cause to be published or exposed¹¹ for sale that article.

(2.) If any person acts in contravention of this section he shall be liable for every contravention¹² to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt,¹³ or if the proprietor elects¹⁴ to bring an action for the recovery of damages¹⁵ for such contravention, and for

Sect. 60. an injunction against the repetition thereof,¹⁰ he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

[Act of 1883,
sect. 58.]

58. *During the existence of copyright in any design—*

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

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

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by an action in any Court of competent jurisdiction: Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.

[Act of 1888,
sect. 7.]

[Act of 1883,
sect. 59.]

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

¹ *The existence of copyright.*—This depends for the purposes of the statute— Sect. 60.

- (1) On the alleged design being a design within the meaning of this Act (sect. 93 (definition of "Design")).
- (2) On due registration of the design (sect. 53).
- (3) On the design being, at the date of application for registration, new or original (sect. 49 (1)).
- (4) On the design not having been published before registration (sect. 49 (1)).

Under the previous statutes there were two further conditions on which the existence of the copyright depended, viz. :—

- (a) On the articles to which the design was applied being properly marked before delivery on sale (Act of 1883, s. 51);
- (b) On the design, if used in manufacture abroad, being also used on articles manufactured in this country within six months of registration (Act of 1883, s. 54);

but the new Act removes these conditions and makes (a) a ground for withholding any remedy though the copyright subsists, and (b) a ground for an application to cancel the registration, or of defence to any action for infringement.

In any action for the infringement of a design, if the defendant can show that the plaintiff has failed to comply with any one of these conditions, the action may be dismissed. But the Court may, under its general equitable jurisdiction, restrain an intended infringement even of an unregistered design on other than the strictly legal grounds. (See Chap. X. on "Remedies for Infringement," §§ 162—165, *ante*.)

A distinction is drawn by the sub-sects. (a) and (b) between the manufacturers of articles of registered design for purposes of sale, and all other persons who publish or expose such articles: the former are liable for every infringement, however innocently made, but the latter only if they know that the consent of the proprietor of the design has not been given: see *Smith v. Lewis, Roberts & Co.* (1881), 5 R. P. C. 611.

² *For purposes of sale.*—It was held by Knight-Bruce, V.-C., in *McRae v. Holdsworth* (1848), 2 De G. & Sm. 496, that manufacturing a registered design, with the intention of selling after the period of protection had expired, was piracy within the meaning of the corresponding words of the Act of 1842, s. 7. (Cf. patent cases: *Crossley v. Beverley* (1829), 1 Web. P. C. 119; *Crossley v. Derby Gas Co.*, 4 L. J. Ch. 25.)

These words, which govern the whole clause, make it unnecessary to prove an actual selling. See *Minter v. Williams*, 4 A. & E. 257, a patent case decided in 1835, in which it was held that exposure for sale is not the same as selling, although it might be an infringement as a user of the patent. And see observations of Alverstone, C.J., on this case in *British Motors Syndicate v. Taylor* (1900), 17 R. P. C. at p. 729.

³ *Apply or cause to be applied.*—The effect of these words is to make liable, not only the actual manufacturer, but also the person who employed him to manufacture the pirated design: *Mallett v. Howitt* (1879), W. N. 107. In every case in which it can be made out that the actual infringer was the agent for that purpose of another person,

Sect. 60. that other person is also liable: *Sykes v. Howarth* (1879), 12 Ch. D. 882.

In a case of a manufacturer it is immaterial how the defendant arrived at the production of the infringing design, whether by independent invention or by copying the registered design: *Saunders v. Wiel* (No. 2) (1893), 9 R. P. C. 467; *Mallett v. Howitt, supra*; *Smout v. Slaymaker* (1890), 7 R. P. C. 90.

The unauthorised application of a registered design abroad by a British subject is not unlawful under this provision of the Act: *Potter v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218; though it was apparently under the old Act of 1861 (24 & 25 Vict. c. 73), s. 1; and it may become so as regards any person doing anything within the jurisdiction "to enable the design to be so applied" under the wording of the new provision added at the end of this clause (see sect. 93, definition of "Copyright"); and the delivery of such goods to a buyer in England, under a contract for sale not completed outside the jurisdiction, would be an infringement. Per Lord Herschell in *Badische Anilin und Soda Fabrik v. Johnson* (1897), 14 R. P. C. 919. (See *British Motors Syndicate v. Taylor* (1900), 17 R. P. C. 189, and *Badische Anilin und Soda Fabrik v. Hickson* (1905), 22 R. P. C. 575.)

⁴ *In any class of goods.*—The application of a registered design to dies or rollers for the purpose of reproducing from them the registered design is not an application of the design in the class in which it is registered, so as to constitute an infringement: *Potter v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

The protection extends to all articles in the class in which the design has been registered, and a design which may be lawfully used for other classes of goods may not be applied to any such articles so long as the copyright exists: *Pearson v. Wilkinson* (1906), 23 R. P. C. 738.

If the proprietor of a design registered in one class applies it to goods in another class, the registration does not protect the application to such goods: *Hothersall v. Moore* (1892), 9 R. P. C. 27.

⁵ *The design or any fraudulent or obvious imitation.*—As to the test of infringement generally, see sect. 49, note ⁶, "new or original," and Chap. IX. on "Infringement," *ante*.

The word "obvious" was introduced for the first time by the Act of 1883, and there is a distinction between this and actual copying or "fraudulent" imitation. (See *Sherwood v. Decorative Art Tile Co.* (1887), 4 R. P. C. 207.)

Imitation is not entirely forbidden by the Act; *e.g.*, fair imitation—that is to say, the application of an original idea in such a way as to create a new and original design—is not prohibited: *Barran v. Lomas* (1880), 28 W. R. 973; *Thom v. Sydall* (1872), 56 L. T. N. S. 15. (See judgment of Cotton, L.J., in *Grafton v. Watson* (1884), 51 L. T. 141; *Saunders v. Wiel* (No. 2) (1892), 9 R. P. C. 467; and for recent cases of what has been considered "fair use," see *Holden v. Hodgkinson* (1904), 22 R. P. C. 102, and *Staples v. Warwick* (1906), 23 R. P. C. 609.)

The Act prohibits the use of anything which is substantially the same design. Although there may be variations, there is infringement if the Court is of opinion that the design itself has been applied. (Cf. *Hanfstaengl v. W. H. Smith & Son* (1905), 21 T. L. R. 291.)

“Fraudulent imitation” is imitation with knowledge; conscious imitation, the man having the design before him, and knowingly and wilfully imitating, and not producing anything sufficiently original to be protected as a fair imitation: per Jessel, M.R., in *Barran v. Lomas* (1880), 28 W. R. 973.

Doliberate imitation, if the result is, in fact, the production of an imitation of the design, is fraudulent imitation: *Grafton v. Watson* (C. A.), 51 L. T. 141.

Fraudulent imitation means, not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud: *Sherwood v. Decorative Art Tile Co.* (1887), 4 R. P. C. 207.

Obvious imitation does not mean exact copy: *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380, as interpreted in *McCrea v. Holdsworth* (1871), L. R. 6 Ch. App. 418; *Hecla Foundry Co. v. Walker* (1889), 6 R. P. C. 554.

Nor does obvious imitation mean obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or a jury with the assistance of experts—persons conversant with the particular trade: *Grafton v. Watson* (1884), 50 L. T. 420, confirmed 51 L. T. 141, following the principle laid down in *Mitchell v. Henry*, 15 Ch. D. 181. See also *Werner Motors v. Gamage's* (1903), 21 R. P. C. 137. But in an ordinary case, where expert evidence cannot assist, the decision will be left entirely to the jury. In *Gordon and Munro v. Patrick* (1894), 12 R. P. C. 22, Cave, J., in directing the jury, said: “It seems to me that no evidence can affect the matter . . . it is for a plain, commonsense man to say, when he looks at these things, whether they are substantially the same or substantially different.” (See also *Ingram and Kemp v. Edwards* (1904), 21 R. P. C. 463.)

The eye must be the judge whether the one article is an obvious imitation of the other. But there should be also taken in account, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial, the state of knowledge at the time of registration and in what respect the design was new and original: *Hecla Foundry Co. v. Walker* (1889), 6 R. P. C. 544; *Re Clarke's Design* (1896), 13 R. P. C. 351; *Gillard v. Worrall* (1904), 21 R. P. C. 76.

The test is not merely to look at the two designs side by side; but consideration should also be given to what would be the effect supposing they were seen at different times, or supposing they were looked at a little distance off: *Grafton v. Watson, supra*, *Nevill v. Bennett* (1898), 15 R. P. C. 412; *Harper v. Wright and Butler* (1895), 12 R. P. C. 485.

The purpose of the design must not be considered in deciding as to subject-matter; but its usefulness, when applied to articles of utility, may be taken into account in considering the question of infringement: *Tyler v. Sharpe* (1893), 14 R. P. C. 35; *Gillard v. Worrall* (1904), *supra*. And see Chap. III. on “Novelty,” *ante*, p. 30.

⁶ *License or written consent.*—A license to use a patent may be verbal: *Crossley v. Dixon* (1863), 10 H. of L. Cas. 293. And it is submitted that on the same grounds a parol license to use a design may be sufficient. (See *ante*, § 122, and cases there cited.)

A licensee can be registered as proprietor, and Rules 45, 47 and 62

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contemplate registration without the production of any written document. Under the old law it was held that a licensee could not sue for damages unless the license was in writing (*Jewitt v. Eckhardt*, L. R. 8 C. D. 404), but the wording of the present section is different. (See, however, *Woolley v. Broad* (1892), 9 R. P. C. 208.)

The peculiar position of the word "written" in this section makes the requirement of a writing in all cases still more uncertain. (See *Griffiths v. Hughes* (1892), L. R. 3 Ch. 105, a decision on a somewhat similarly worded phrase in the Trustee Act, 1888.)

The introduction of the words "written consent" leads to the inference that if the license is not a valid agreement, but only in that case, then to be of any effect as a defence under this section, the consent of the proprietor must be in writing.

⁷ *Registered proprietor.*—As to what persons are included under the term proprietor, see sect. 93 (Definition of "Proprietor") and sect. 52, and the notes thereon, *ante*.

In an action for penalties for infringement of dramatic copyright, it was held that the license of one of two proprietors, not being in any sense agent for the other, was not a legal license: *Powell v. Head* (1879), 12 Ch. D. 686; but see *Lauri v. Renad* (1892), L. R. 3 Ch. 492, and *Wedekind v. General Electric Co.* (1897), 14 R. P. C. 190.

A proprietor who is not registered cannot proceed under this section. (See *Woolley v. Broad* (1892), 9 R. P. C. 208.)

But a proprietor, *e.g.*, an assignee who has not registered his assignment, might be able to obtain relief other than that given by these sections under the ordinary jurisdiction of the Courts: *Ihlee v. Henshaw* (1886), 31 Ch. D. 323; *Cooper v. Whittingham* (1880), 15 Ch. D. 501; *Hole v. Bradbury*, 12 Ch. D. 806. (See *ante*, Chap. X. "Remedies for Infringement," § 162.)

⁸ *Or to do anything with a view to enable.*—This is a new provision introduced by sect. 36 (1) of the Amendment Act, 1907, and it will meet many cases not covered by the wording of the old Acts. (See note ³, *supra*.)

⁹ *Knowing that the design has been applied.*—Under the Act of 1842, proof of knowledge from some source other than the proprietor, or express written notice from the proprietor, was required: *Norton v. Nicholls* (1859), 28 L. J. Q. B. 225.

It was held under the Act of 1883, which contained similar words, that a letter before action, informing a retail dealer that he had registered designs on sale, but which did not specify what those designs were, was insufficient to render him liable: *Smith v. Lewis Roberts & Co.* (1888), 5 R. P. C. 611. So an immediate submission and withdrawal of the infringing articles on the giving of notice will deprive the proprietor of the design of any right of action which he might otherwise have had against a mere seller, unless there are special circumstances which would justify the granting of an injunction: *Jan v. Grossman* (1895), 12 R. P. C. 537; and see *Brittain v. Kennedy* (1902), 19 T. L. R. 122.

¹⁰ *Without the consent*—The publication of a book of registered designs was said not to be a license to persons to copy the designs for purposes of sale: *De la Branchardière v. Elvery* (1849), 18 L. J. Ex.

381; 4 Ex. 380. Nor is the sale of blocks for a specific purpose equivalent to the grant of a license to any third person who may acquire the blocks: *Cooper v. Stephens* (1895), 77 L. T. N. S. 390; *Marshall v. Bull* (1900), 16 T. L. R. 501.

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¹¹ *Cause to be published or exposed.*—These words were introduced by sect. 36 (2) of the Amendment Act, 1907, and enable the provider of infringing goods to be proceeded against as well as the mere seller. (See note ³, *supra*.)

¹² *Shall be liable on every contravention.*—The words in the old section were “shall forfeit,” but the effect is the same, and proceedings under this part of the section will be regarded as of a penal character, so that interrogatories cannot be allowed: *Saunders v. Wiel* (No. 1) (1892), 9 R. P. C. 459.

The sum recovered under this part of the section is a penalty. A penalty is a punishment, and punishment is to be awarded with due regard to what the offender has actually done. The penalty should be heavier or lighter as there may be circumstances of aggravation or mitigation: *Saunders v. Wiel* (No. 2) (1892), 9 R. P. C. 467. (See also *Sherwood v. Decorative Art Tile Co.*, 4 R. P. C. 207; *Rivett v. Grimshaw* (1894), 11 R. P. C. 351.)

The sale of each copy is a separate offence: *Ex parte Beale* (1868), L. R. 3 Q. B. 387. But the Court is not bound, in awarding penalties, to award for each offence even the minimum sum of one farthing; it may award a lump sum, not exceeding in the one action the maximum penalty fixed by the Act: *Hildesheimer v. Faulkners, Ltd.* (1901), 17 T. L. R. 737.

¹³ *As a simple contract debt.*—The proceedings should ordinarily be taken in the High Court; and no jurisdiction is conferred on County Courts to deal with infringements under the Act. But *query* whether claims for mere penalties not exceeding 100*l.*, in which no question of title is raised, may not be brought in the County Courts as simple contract debts: *Bow v. Hart*, 21 T. L. R. 281, and notes thereon, *ante* § 169. As to the practice generally in actions for infringement, see *ante*, Chap. XI.; as to costs, §§ 192, 193; and as to other proceedings, §§ 160—168.

¹⁴ *If the proprietor elects.*—A plaintiff may be compelled to state whether, in bringing an action for infringement, he is proceeding for a penalty or for damages, and he cannot have both remedies: *Saunders v. Wiel*, 9 R. P. C. 459. The plaintiff should follow the wording of the section in his pleadings: *Woolley v. Broad*, 9 R. P. C. 210—212.

¹⁵ *Damages.*—The measure of damages is ordinarily the profit which the plaintiff would have made through the sale of so many additional copies of his own article to which the design is applied as the defendant has sold copies of his infringement: *Pike v. Nicholas* (1869), 38 L. J. Ch. 529. But where licenses have been granted or the articles do not compete other considerations may apply: *Ingram v. Edwards* (1904), 21 R. P. C. 463; *British Motors Syndicate v. Taylor* (1900), 17 R. P. C. 189; and *Saccharin Co. v. Chemicals and Drugs Co.* (1900), 17 R. P. C. 612. And cases cited *ante*, § 161.

¹⁶ *And for an injunction.*—These words were introduced by sect. 36 (3) of the Amendment Act, 1907; but they only express the existing practice under the general equitable jurisdiction of the Courts.

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An injunction may sometimes be granted where no damages or other relief would be awarded. (See *ante*, §§ 162, 163.)

Application of certain provisions of the Act as to patents to designs.

61. The provisions of this Act¹ with regard to certificates of the validity² of a patent, and to the remedy in case of groundless threats of legal proceedings³ by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents,⁴ with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design⁵ for references to the patentee, and of references to the design for references to the invention.

¹ *The provisions of this Act shall apply.*—This is an entirely new provision in favour of designs introduced by sect. 37 of the Amendment Act, 1907, and it affords a much-needed extension of the law hitherto obtaining only in the case of patents. The incorporated sections are:—
(a) **Sect. 35** and (b) **Sect. 36** of the Act:—

Sect. 35.
Certificate of validity questioned and costs thereon.

(a) In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and, if the Court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Sect. 36.
Remedy in case of groundless threats of legal proceedings.

(b) Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats:

Provided that this section shall not apply if the person

making such threats with due diligence commences and prosecutes an action for infringement of his patent. Sect. 61.

² *With regard to certificates of validity.*—For detailed consideration of the subject, see Chap. X. “Remedies for Infringement,” ante, § 168.

A certificate may be granted, even though the plaintiff fails in his action on the ground of non-infringement: *Morrison v. Asplin* (1904), 21 R. P. C. 557; and see *Hardtmuth v. Baker* (1904), 22 R. P. C. 66. Where the validity of the plaintiff's patent was challenged on the pleadings, a certificate was granted, though the defendant did not appear at the trial: *Welsbach Incandescent Gas Co. v. Krumm* (1900), 18 R. P. C. 211. But where the Court has pronounced no decision upon validity or invalidity, a certificate will not be granted: *New Inverted Incandescent Gas Lamp Co. v. Timmins* (1906), 23 R. P. C. 103; *Same v. Globe Light Co.* (1906), *Ibid.* 157.

³ *In case of groundless threats of legal proceedings.*—A circular may be a threat, though addressed to no one in particular: *Johnson v. Edge* (1891), 9 R. P. C. 142. But see *Bishop v. Inman* (1900), 17 R. P. C. 479, where the question whether a circular amounted to a threat or only to a general warning was discussed. And see *Crowther v. United Flexible Tubing Co.* (1905), 22 R. P. C. 549.

The plaintiff must prove that he is not, in fact, infringing, and the Court has, in any case, a discretion as to granting the injunction: *Walker v. Clarke* (1887), 4 R. P. C. 111. If the defendant undertakes to take and pursue proceedings for the alleged infringement with due diligence an injunction will not usually be granted: *Mackie v. Laundry Supply Co.* (1891), 9 R. P. C. 465. And an injunction already granted may, in some cases, be dissolved on the action for infringement being brought: *Engels v. Hubert Syndicate* (1902), 19 R. P. C. 201.

⁴ *As they apply in case of patents.*—For the practice as to granting certificates of validity in patent cases, see *Acetylene Illuminating Co. v. Midland Acetylene Syndicate* (1900), 17 R. P. C. 534. As to the granting of injunctions on the ground of failure to proceed with due diligence after threatening circulars or advertisements, see Chap. XII. §§ 202—205; *Challender v. Royle* (1887), 4 R. P. C. 363, and *Haskell Golf Ball Co. v. Hutchison and Main* (1904), 21 R. P. C. 497. As to the effect of the proviso to the section, see the recent case of *Craig v. Dowding* (noted L. J. N. C. 1908, p. 39), in which it was held by the Court of Appeal (reversing Kekewich, J.) that even admissions of alleged anticipation by the patentee's agent afforded no ground for impugning an action for infringement brought after the institution of a threats action, and discontinued after delivery of defence, and that as the effect of the proviso was to take away the statutory right of action where a *bond fide* action was brought, the threats action must be dismissed.

Damages representing the solicitor and client costs incurred in defending proceedings may be granted in a proper case: *Bishop v. Inman*, *supra*, and *Craig v. Dowding*, *supra*.

⁵ *References to the proprietor of a design.*—For definition of “proprietor,” see sect. 93 and notes thereon. As to the granting of a certificate of validity to a part proprietor, *query*.

Sect. 62.

PART III.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office,
5 Edw. 7,
c. 16.

62.—(1.) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.¹

(2.) The Patent Office shall be under the immediate control of the comptroller,² who shall act under the superintendence and direction³ of the Board of Trade.

(3.) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4.) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere,⁴ and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.⁵

(*Sub-sects. 1, 2 and 3 of this section repeat substantially sect. 82 of the 1883 Act. Sub-sect. 4 is new.*)

¹ *The Patent Office.*—The former “Great Seal Patent Office” is still under the name of the “Patent Office,” the building in which the official patent business is carried on.

² *The Comptroller-General.*—The Comptroller has the general superintendence of the Patent Office under the Board of Trade. The Registrar of Designs and Trade Marks acts for him in all matters relating to designs.

³ *Who shall act under, etc.*—The Comptroller is further enabled by sect. 74 to apply to either of the law officers for directions in any case of doubt or difficulty.

⁴ *Branch offices for designs.*—This is a new provision, introduced by sect. 38 of the Amendment Act of 1907. The Rules relating to the establishment of a branch office for designs for goods in Classes 13, 14 and 15 (which is the only branch office established under the Rules of 1908) are Nos. 80—88.

⁵ *Being sent to or done at any branch office.*—The new Rules 81, 82 and 88 deal with this. The powers of local officers are regulated by the sub-sect. 3 to this section.

63.—(1.) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller,¹ and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks. Sect. 63.

Officers and clerks.

(2.) The salaries² of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

(This section repeats sect. 83 of the 1883 Act.)

¹ *Appointment of Comptroller.*—Sir H. Leader Lack was appointed Comptroller-General on the Act of 1883 coming into force, and he was succeeded in the office by the present Comptroller, C. N. Dalton, C.B. The Designs department is superintended by the Registrar of Designs and Trade Marks.

² *The Salaries.*—Particulars of the salaries of such officers and clerks are required to be laid annually before Parliament. (Sect. 76.)

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence. Seal of Patent Office.

(This section repeats sect. 84 of the 1883 Act.)

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade,¹ so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act² shall not exceed those specified in that Schedule. Fees.

(This section repeats substantially sect. 56 of the 1883 Act.)

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¹ *Fees prescribed by the Board of Trade.*—See Rule 3, and the Schedule of Fees, *post*, p. 318.

² *Matters in First Schedule to this Act.*—These relate only to instruments for obtaining patents and renewals thereof.

*Provisions as to Registers and other Documents in
Patent Office.*

Trust not to
be entered in
registers.

66. There shall not be entered in any register kept under this Act,¹ or be receivable by the comptroller, any notice of any trust² expressed implied or constructive.

(This section repeats sect. 85 of the 1883 Act.)

¹ *Any register kept under this Act.*—As to entries in the register of designs, see sect. 52, and generally on this subject, Chap. V. on “The Register,” *ante*.

² *Notice of any trust.*—See the proviso to sect. 71 (1), *infra*, and the provisions as to entries of mortgagees’ and other interests in sect. 71 (2).

As a matter of fact, many deeds which are now filed in the Comptroller’s Office contain declarations of trust in favour of other parties. But in the notification of the deed in the register itself, no notice is taken of the trust.

As regards patents, it has been decided that an equitable assignment of a patent, or share in it, may be put upon the register, and the practice is now extended to designs by sect. 71 (2): *Stewart v. Casey* (1892), 9 R. P. C. 9. And see *Haslett v. Hutchinson* (1891), 8 R. P. C. 457.

Inspection of
and extracts
from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed¹; and certified copies,² sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.³

(This section repeats sect. 88 of the 1883 Act.)

¹ *As may be prescribed.*—See sect. 52 and Rule 61. The times when inspection may take place are notified by a placard posted at the Patent Office.

² *And certified copies.*—See sect. 78 and Rule 67.

³ *Prescribed fee.*—The fee for a copy is 4*d.* per folio, but not less than 1*s.* in all. A certified copy is necessary when it is proposed to put a copy in evidence: *Kekewich, J., in Haslett v. Hutchinson* (1891), 8 R. P. C. 457. An additional fee of 1*s.* is charged for certifying; see Schedule of Fees, *post*, p. 319.

68. (*Refers to patents.*)**Sect. 68.****69.**—(1.) (*Refers to patents.*)

(2.) Where an application for a design has been abandoned¹ or refused² the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection³ or be published by the comptroller.

Where application abandoned, &c.

¹ *Application for design abandoned.*—The whole of this sub-section is now, and was introduced as an addition to sect. 47 of the 1883 Act (which related to applications for registration) by sect. 29 of the Amendment Act, 1907. The reference to abandonment of an application for a design is to sect. 49 (4), as to which see *ante*, p. 218.

² *Or refused.*—The Comptroller has a general power to refuse registration under sect. 49 (3), as to which see *ante*, p. 218; and sect. 75 provides for refusal of designs which are contrary to law or morality. (See also sect. 56 (*ante*, p. 236) as to refusal of registration on the ground of identity with a design already on the register.)

³ *Open to public inspection.*—The provisions as to inspection of designs are contained in sect. 56 (*ante*, p. 236) and Rule 61.

70. The comptroller may, on request in writing¹ accompanied by the prescribed fee,²

Power for comptroller to correct clerical errors.

- (a) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification;
- (b) cancel the registration of a design either wholly or in respect of any particular goods³ in connexion with which the design is registered:
- (c) correct any clerical error⁴ in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

91. *The comptroller may, on request in writing accompanied by the prescribed fee—* [Act of 1883, sect. 91.]

- (a) *Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or*
- (b) *Correct any clerical error in the name, style, or address of*

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the registered proprietor of a patent, design, or trade mark.

(c) [*This sub-section relates only to trade marks.*]

[Act of 1888,
sect. 24.]

(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the trade mark to be registered.

¹ *Request in writing.*—The altered form of this section was introduced by sect. 41 of the Amendment Act, 1907. As to the persons to make the application and the evidence to be provided, see Rules 51—54; and as to the form of request, see Forms 17, 18, *post*, p. 382.

² *Prescribed fee.*—See First Schedule to the Rules, fees Nos. 14, 15, *post*, p. 319.

³ *Cancel in respect of any particular goods.*—A mark (and, *semble*, a design) cannot properly be registered for goods in which the applicant does not deal, and does not intend to deal: *Re Batt's Trade Mark* (1899), 16 R. P. C. 411. But the procedure provided by this section is open only to persons whose names appear on the register as registered proprietors or by a trustee in bankruptcy, liquidator or other person entitled to act in the name of a registered proprietor. (See Rules 53, 54.)

Any application for cancellation by third parties must be made under the expunging provisions (sect. 72, *post*).

⁴ *Correct any clerical error on the . . . register of designs.*—The new wording of this provision apparently excludes applicants for registration who were covered by the old Acts. Power is, however, given to amend any document or drawing or correct any irregularity in procedure generally by Rule 63.

Entry of
assignments
and trans-
missions in
registers.

71.—(1.) Where a person becomes entitled by assignment,¹ transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction,² register him as the proprietor of a patent or design.

(2.) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest³ in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner⁴ in the register of patents or designs, as the case may be.

(3.) The person registered as the proprietor of a patent or design shall, subject to the provisions of this

Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the patent or design⁶ and to give effectual receipts for any consideration for any such assignment, license, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.⁶

(*Sub-sects. (1) and (3) of this section repeat substantially sect. 87 of the 1883 Act; sub-sect. (2) is new.*)

¹ *Assignment, etc.*—As to assignments and licenses generally, see Chap. VII. on “Proprietor,” *ante*, and sect. 52 and Rules 43—48.

For form of assignment, see *post*, p. 403, and Forms 11, 12 and 13 to the Rules.

The stamp on registration of an assignment where the registered proprietor joins in the request is the same as for an original registration, but where the application is made by the assignee alone there is a fixed fee of 10s. (See Schedule of Fees, *post*, p. 319.)

Whether assignments should be in writing, see *Jewitt v. Eckhardt* (1878), 8 Ch. D. 404, and the cases cited in Chap. VII. on “The Proprietor,” § 122—4, and notes to sect. 52, *ante*.

An assignee can, of course, take no greater right by an assignment than was vested in his assignor; and where the title of the person on the register is defective, it should be varied under the provisions of sect. 72 (sect. 90 of the old Act), and not by way of assignment to the person really entitled: *In re Grocott's Design* (1899), 17 R. P. C. 139.

² *Proof of title to his satisfaction.*—The Rules 45—48 and 62 seem to contemplate proof of title otherwise than by written assignment. Where there is a change, not of ownership but of the name of the owners, the Comptroller may act under this section without requiring any order of the Court. But see *In re Pneumatic Tyre Co.'s Design* (1894), 11 R. P. C. 636.

³ *Entitled as mortgagee or otherwise.*—This is a new provision introduced by sect. 39 of the Amendment Act, 1907. It is subject, of course, to the provision as to the entry of trusts in sect. 66, as to which see *ante*, p. 254. A licensee is entitled to registration as a proprietor. (See *Jewitt v. Eckhardt*, *supra*, and sect. 93, definition of “Proprietor.”)

⁴ *In the prescribed manner.*—As to the steps to be taken and particulars required to secure registration, see Rules 43—45, and as to goods in the Manchester Classes, Rule 85.

⁵ *Absolutely to assign . . . or otherwise deal.*—Whether this would operate so as to place a design which had been assigned but not registered in the name of the new proprietor in the “order and disposition” of the original proprietor, and thus vest it in his trustee in case of bankruptcy, see *ante*, p. 128, and *In re Dilworth* (1833), 1 Deac. & C. 411.

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⁰ *Any equities . . . may be enforced.*—Trusts are not entered on the register as such, though deeds containing them are commonly filed. (See sect. 66, and notes thereto, *ante*.)

Rectification
of registers
by Court.

72.—(1.) The Court¹ may, on the application in the prescribed² manner of any person aggrieved³ by the non-insertion in or omission from the register⁴ of patents or designs of any entry, or by any entry made in either such register without sufficient cause,⁵ or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry⁶ as it may think fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.⁷

(3.) The prescribed notice of any application⁸ under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4.) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner,⁹ who shall upon the receipt of such notice rectify the register accordingly.

[Act of 1883,
sect. 90.]

[Act of 1888,
sect. 23.]

90.—(1.) *The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.*

(2.) *The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.*

(3.) *Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.* Sect. 72.

This section is an extension of the old sect. 90, provided for by sect. 40 of the Amendment Act, 1907. It applies to all the subjects comprised in the present Act, and much information may be obtained from the cases on Patents and Trade Marks. Similar provisions for rectification of the register are contained in the Copyright Acts (5 & 6 Vict. c. 45 (literary) and 25 & 26 Vict. c. 68 (artistic)), and the authorities thereunder also apply.

¹ *The Court.*—The High Court of Justice in England has jurisdiction (see sect. 92, *post*), even though the registered proprietor be domiciled in Scotland or Ireland: *Re King & Co.'s Trade Mark* (1892), 10 R. P. C. 350. Whether the Scotch or Irish Courts have a concurrent jurisdiction has been disputed; but the better opinion on the old sect. 90, to which the present section corresponds, was that, in the matter of applications for rectification, the jurisdiction is a special one, and is vested exclusively in the High Court of Justice in England: *Bayer v. Connell* (1897), 14 R. P. C. 275; see *Cowie v. Herbert* (1896), 14 R. P. C. 436 (a Scotch case). Applications under this section are by original motion, and any orders thereon can be appealed against like any other orders of Court. Such orders are, for the purpose of notice of appeal, final orders.

² *In the prescribed manner.*—No particular mode of application is prescribed by the Rules of 1908, so that the old practice will prevail until the issue of further Rules. (See Rule 95, and sect. 93, definition of “prescribed,” *post*.)

³ *Any person aggrieved.*—For those falling under the class of “persons aggrieved,” see *Re Apollinaris Co.'s Trade Marks* (1891), 8 R. P. C. 137; *Re Talbot's Trade Marks* (1894), 11 R. P. C. 77; *Re Powell's Trade Mark* (1893) and (1894), 10 R. P. C. 195; 11 R. P. C. 4; and *Re Wright and Crossley's Trade Mark* (1898), 15 R. P. C. 131. The whole subject is dealt with under the heading “Rectification” in Chap. VI., §§ 99—106, *ante*.

In *Re Morey's Patent* (1858), 25 Beav. 81; 6 W. R. 612, decided under the Patent Law Amendment Act, 1852, it was held that the Court could, on such a motion, direct any *facts* relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them. (See also *In re Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475.)

For the practice in designs cases, see, in addition, *In re Clarke's Design* (1896), 13 R. P. C. 357; *In re Merton's Design* (1899), 17 R. P. C. 117; and *In re Grocott's Design* (1899), 17 R. P. C. 139.

⁴ *Non-insertion or omission from any register.*—Under the old Act, it was held that the provisions of sect. 90 would not enable a person to appeal to the Court from the refusal of the Comptroller or of the Board of Trade to register a design tendered (*Re The Trade Mark “Normal”* (1886), 4 R. P. C. 123); but the wording of the present section is much wider, and the application of this decision may now be questioned. The Comptroller's decision in questions of cancellation under sect. 58 is, however, made final by the Act, and it may be assumed

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that any applications which amount to an indirect appeal against such a decision will not be entertained.

⁶ *Entry made without sufficient cause.*—Where there has been no real user of a registered mark in a particular class, and registration has been effected without any *bona fide* intention to use the mark in that class, it may be expunged under this provision. A mark cannot properly be registered for goods in which the applicant does not deal or intend to deal: *Re Batt's Trade Mark* (1899), 16 R. P. C. 411.

Whether a design can be struck off the register because the applicant has been guilty of misconduct in selling as registered something which is not covered by the registered design, *query*. (See *In re Bayer's Design* (1906), 23 R. P. C. 553.)

⁶ *Varying the entry.*—Under the old Act it was held that the Court had no power under the section to substitute the name of a true proprietor for the name of the person improperly on the register: *Re Guiterman's Design* (1886), 55 L. J. Ch. 309. But where the variation was only one of name and not of ownership (*Re Pneumatic Tyre Co.'s Design* (1894), 11 R. P. C. 636), or where the erroneous entry was made by mistake and not under some claim of right (*In re Grocott's Design, supra*), an order to vary might be made. (See note ² to sect. 71, *ante*, p. 257.) But the extended wording of the present section is intended apparently to cover all cases of wrong entry, whether arising from mistake or otherwise.

⁷ *In connexion with the rectification.*—This would include award of costs incidental to the application. The costs would ordinarily have to be paid by the unsuccessful party, unless that party is the Comptroller, but the matter is discretionary: *Re Guiterman's Design, supra*; but see *Re Pneumatic Tyre Co.'s Design, supra*.

The old section provided for damages being awarded to the party aggrieved, but there is no recorded instance of this having been done in a designs case, and the omission of the words from the new section would suggest that it was not intended to continue the power to make such orders on mere applications to expunge, although the wording of the section would permit of an award of damages in a proper case.

⁸ *The prescribed notice.*—This refers to Rule 95, *post*, which prescribes a four day notice.

⁹ *Notice of rectification in the prescribed manner.*—An office copy of the order together with a request for rectification is to be served on the Comptroller. (See Rule 96, and Form 26, *post*, p. 389.) As to designs for goods in the Manchester Classes, see also Rule 86.

Powers and Duties of Comptroller.

Exercise of
discretionary
power by
comptroller.

73. Where any discretionary power¹ is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed

time² by the applicant) giving the applicant an opportunity of being heard.

Sect. 73.

(*This section repeats sect. 94 of the 1883 Act.*)

¹ *Discretionary power.*—For the cases in which the discretionary powers arise, see sects. 47, 53 (3), 54 (1), 56 (1), 58 (1), 70 and 75, and the notes thereto. For the practice on applications for registration, see Rules 31—34, and in other cases, Rules 55—58, *post*.

² *Prescribed time.*—This is within one month from the date of the Comptroller's objection on applications for registration (Rule 32), and in other cases one month from the date when the matter on which the Comptroller exercises the discretionary power has arisen (Rule 56). As to computation of time, see sect. 82, *infra*.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer¹ for directions in the matter.

Power of comptroller to take directions of law officers.

(*This section repeats sect. 95 of the 1883 Act.*)

¹ *Apply to law officers.*—By sect. 62, sub-sect. (2), the Comptroller acts under the superintendence of the Board of Trade.

Applications to the law officers were not infrequently made under the corresponding section in the old Act, especially in cases of legal questions arising as to the construction of provisions of the Act in the course of practice, and there will now be greater occasion for such applications in view of the largely extended duties and powers of the Comptroller under this Act.

75. The comptroller may refuse¹ to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.²

Refusal to grant patent, &c. in certain cases.

(*This section repeats sect. 86 of the 1883 Act.*)

¹ *Comptroller may refuse.*—As to exercise of discretionary power by the Comptroller, see sect. 49 (3), and sect. 73, *supra*, and Rules 55—58.

Any refusal of the Comptroller under this section may be appealed against to the Board of Trade. (See notes ¹² and ¹³ to sect. 49, *ante*.)

² *Contrary to law or morality.*—Under the corresponding section in the old Act a patent has been refused for an apparatus for a lottery: Griffin, P. C. p. 30.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that

Annual reports of comptroller.

Sect. 76. year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

(This section repeats sect. 102 of the Act of 1883.)

Evidence, &c.

Evidence
before
comptroller.

77.—(1.) Subject to rules under this Act¹ in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration² in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *vivâ voce*³ in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2.) In case any part of the evidence is taken *vivâ voce*, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.⁴

¹ *Subject to Rules under this Act.*—The whole of the provisions of this section are new, and were introduced by sect. 45 of the Amendment Act, 1907. The Rules under the old Act (Rules of 1890, r. 24) required statutory declarations to be used on applications for entry of assignments on the register, but Rule 25 allowed the Comptroller to require further proof. The new section extends this power to all proceedings before the Comptroller under the Act.

The Rules of 1908 leave a large discretion to the Comptroller as to the nature of evidence to be furnished, and statutory declarations are not required on applications for entry of assignments, unless called for by the Comptroller (Rule 46). The only cases in which they are compulsory under the Rules are in answer to applications for cancellation on the ground of non-manufacture (Rules 71 and 73). A general power to dispense with any particular mode of proof is given to the Comptroller in all cases (Rule 62).

² *Statutory declaration.*—The declaration must be made before a justice of the peace or commissioner or other officer authorized to take oaths, if made anywhere in the United Kingdom, or before a

British minister or consular officer, notary public, judge, or magistrate abroad (Rule 78).

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³ *Evidence vivâ voce.*—If the evidence is taken *vivâ voce* it will be on oath, and a note in writing must be taken of it which, it is presumed, will be available for the purposes of appeal in the same way as the statutory declaration for which it is substituted. (See sub-sect. 2, *supra*.) In appeals to the Board of Trade the Board will itself give directions as to the mode in which evidence is to be taken (Rule 92).

⁴ *In the same position as an Official Referee.*—An Official Referee, and apparently therefore the Comptroller, is bound to conduct the taking of evidence in the same manner as nearly as circumstances will admit as on trials before a judge of the Supreme Court; and the attendance of witnesses before him may be enforced by subpoena issued as of course. (See Rules of Supreme Court, Ord. XXXVI. r. 49.)

78. A certificate¹ purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Certificate of comptroller to be evidence.

(*This section repeats sect. 96 of the 1883 Act.*)

¹ *Certificate of the Comptroller.*—The certificate must state the purpose for which it is required. See Rule 67, and Form No. 22, *post*, p. 385.

A certificate as to identity with, or imitation of, a registered design given under Rule 60, is, however, not evidence: *Smith v. Hope* (1889), 6 R. P. C. 204.

79. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence¹ in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Evidence of documents in Patent Office.

(*This section repeats sect. 89 of the 1883 Act.*)

¹ *Admitted in evidence.*—The register is *primâ facie* evidence of any matters by this Act directed or authorised to be inserted therein. (See sect. 52 (3), *ante*.)

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Transmission
of certified
printed copies
of specifica-
tions, &c.

80.—(1.) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted¹ to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2.) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

(This section repeats substantially sect. 100 of the 1883 Act.)

¹ *Shall be transmitted.*—This section re-enacts, with modifications, sect. 5 of the old Patents Act of 1853 (16 & 17 Viet. c. 115).

For the corresponding provisions for registration of the decrees or orders of the Scotch and Irish Courts at the Patent Office, see sects. 94, 95. For the provisions as to designs in the Manchester Classes, see Rules 82 and 88.

Applications
and notices
by post.

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.¹

97.—(1.) *Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.*

(2.) *In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.*

¹ *Sent by post.*—The rules contain similar provisions. (See Rule 9.)

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In *Trotter v. Maclean* (1879), L. R. 13 Ch. D. 574, a witness produced a copy of a letter which he said he had made, and swore that he should in the ordinary course of business have posted the original, and it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence.

The latter part of the old section is now incorporated in the Rules, which also provide that any document sent by post shall be deemed to have been delivered at the time when it would arrive in the ordinary course of post (Rule 9).

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act¹ as an excluded day,² the rules may provide for the thing being done on the next following day not being an excluded day.

Excluded days.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

¹ *Rules under the Act.*—The Rules to be referred to are Rules 64 and 65. Power is also given generally to the Comptroller to enlarge the time for any proceedings by Rule 64.

² *Excluded days.*—These are all Saturdays and Sundays, the King's birthday, Christmas Day, Good Friday and the Bank holidays, *i.e.*, Easter Monday, Whit Monday, the first Monday in August and the 26th December if a week day or the 27th when the 26th is a Sunday.

83.—(1.) If any person is, by reason of infancy, lunacy, or other disability,¹ incapable of making any declaration or doing anything required or permitted by or under this Act,² the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto

Declaration by infant, lunatic, &c.

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(2.) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

(This section repeats substantially sect. 99 of the 1883 Act.)

¹ *Infancy, lunacy or other disability.*—So long as the necessary documents are prepared in the proscribed manner there is nothing to prevent the registration of a design by an infant, and the age, sanity or coverture of an applicant is in no way inquired into by the office or referred to in any of the proceedings to obtain registration.

In the case of an inventor of a design becoming insane before applying for registration, the application might be made for him under this section, and any other steps might, under the section, be taken for him in the event of insanity after application.

² *Permitted by the Act.*—See Rule 62, *post*, as to the power of the Comptroller to dispense with the production of any documentary or other evidence where from any reasonable cause the person required by the Act to supply it is unable to do so.

Register of Patent Agents.

84. *(Refers to agents for obtaining patents only.)*

85.—(1.) Rules under this Act may authorise¹ the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2.) Where a company or firm acts as agents, such

rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager² of the company or is a partner in the firm.

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(3.) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

¹ *Rules may authorise.*—This is a new statutory provision introduced by sect. 48 of the Amendment Act, 1907. A somewhat similar provision was made by Rule 2 of 1898, but this was limited to persons who had been removed from the register of patent agents, and the powers of control are now largely extended. (See Rule 12, *post.*)

² *Acts as director or manager.*—This would cover the case of a person acting in either of these capacities, although he may not have been formally appointed to either office.

Powers, &c. of Board of Trade.

86.—(1.) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act¹—

Power for Board of Trade to make general rules.

- (a) For regulating the practice of registration under this Act:
- (b) For classifying goods for the purposes of designs:
- (c) For making or requiring duplicates of specifications, drawings, and other documents:
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:
- (e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:
- (f) For regulating (with the approval of the Treasury)

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the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

- (g) For regulating the keeping of the register of patent agents under this Act:
- (h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) General rules shall whilst in force be of the same effect as if they were contained in this Act.²

(3.) Any rules made in pursuance of this section shall be advertised³ twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

(This section repeats sect. 101 of the 1883 Act.)

¹ *Subject to the provisions of this Act.*—General Rules have been issued by the Board of Trade under this section, which are to be cited as The Designs Rules, 1908, and came into operation from and immediately after the 31st December, 1907 (Rule 1). The previous General Rules then in force were thereby repealed without prejudice to anything already done under those Rules, or to any application or other matter then pending (Rule 98). For a discussion of the question whether the Court has power to declare the Rules *ultra vires*, see *Institute of Patent Agents v. Lockwood*, [1894] A. C. 347.

² *Of same effect as if contained in this Act.*—The requirements in the Forms are part of the Rules, but these and any of the provisions contained in the Rules will not be taken to import any additional conditions limiting the effect of registration under the statute unless such conditions are made “in clear and unmistakable terms.” Per Lord Herschell in *Re Rollason’s Design* (1898), 15 R. P. C. 441.

³ *Shall also be advertised.*—See the Rules Publication Act, 56 & 57 Sect. 88.
 Viot. c. 66.

87.—(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board. Proceedings
of the Board
of Trade.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

(This section repeats sect. 25 of the Act of 1888, incorporated as sect. 102 (a) in the 1883 Act.)

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order. Provision as
to Order in
Council.

(This section repeats sect. 104 (2) of the 1883 Act.)

Offences.

89.—(1.) If any person makes or causes to be made a false entry¹ in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.² Offences.

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(2.) If any person falsely³ represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence,⁴ on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3.) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying⁵ that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4.) Any person who, after the copyright in a design has expired,⁶ puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5.) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

[Act of 1883,
sect. 93.]

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

[Act of 1883,
sect. 105.]

105.—(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for

the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

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(2.) *A person shall be deemed, for the purpose of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.*

¹ *False entry.*—This does not extend to a case of an entry which is merely ambiguous, although the registered owner might thereby be enabled to misrepresent the nature of the protection to which he is entitled. But whether an ambiguity of this nature would entitle an aggrieved person to expunge under sect. 72, *query*. (See *In re Bayer's Design* (1906), 23 R. P. C. 553.)

² *Misdemeanor.*—For the treatment of this subject generally, see Chap. XII., "Offences," *ante*. As to punishment of misdemeanors in Isle of Man, see sect. 96, *post*.

³ *Falsely.*—*I.e.*, whether the mark is used before registration has been effected, or after the copyright term has expired.

A person cannot mark an article "registered" until he has obtained his certificate of registration: *Reg. v. Crampton* (1886), 3 R. P. C. 367.

And this would apply equally to a case of false representation of an expired registration as still subsisting: *Cheavin v. Walker* (1877), L. R. 5 Ch. D. 863.

⁴ *For every offence.*—A separate fine is incurred for each copy sold: *Reg. v. Crampton, supra*; *cf. Ex parte Beale* (1868), L. R. 3 Q. B. 357 (a copyright case).

⁵ *Expressing or implying.*—Where there is no misrepresentation in fact, *e.g.* where goods have from long usage acquired the designation in the trade generally of "patent," though not in fact patented, there will be no offence: *Marshall v. Ross* (1869), L. R. 18 Eq. 651; *Sen-Sen Co. v. Britten* (1899), 16 R. P. C. 137. But see sub-sect. 4 of this section.

⁶ *After the copyright has expired.*—This is a reversion to the provisions of the 1842 and 1843 Acts (sects. 11 and 4 respectively), which had been omitted in the subsequent Acts.

90.—(1.) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

Unauthorised
assumption of
Royal Arms.

(2.) If any person, without the authority of His Majesty, uses in connection with any business, trade,

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calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

(Sub-sect. (2) repeats substantially sect. 108 of the 1883 Act. Sub-sect. (1) and the proviso at end are new.)

International and Colonial Arrangements.

International
and Colonial
arrangements.

91.—(1.) If His Majesty is pleased to make any arrangement with the government of any foreign state¹ for mutual protection of inventions, or designs, or trade marks,² then any person³ who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants;⁴ and the patent or registration shall have the same date as the date of the application⁵ in the foreign state.

Provided that—

- (a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months,⁶ from the application for protection in the foreign state; and
- (b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2.) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

- (a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or
- (b) in the case of a design, by reason only of the exhibition or use of, or the publication⁷ of a description or representation of, the design; or
- (c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3.) The application for the grant of a patent, or the registration of a design or the registration of a trade mark under this section, must be made in the same manner as an ordinary application⁸ under this Act or the Trade Marks Act, 1905: Provided that—

- (a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and
- (b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council⁹ declares them to be applicable, and so long only in the case of each state as

Sect. 91. the Order in Council continues in force with respect to that state.

(5.) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

(This section repeats substantially sects. 103 and 104 of the 1883 Act, but sub-sect. (2) is so important that the terms of the repealed sect. 103 (2) are here set out.)

[Act of 1883,
sect. 103.]

103.—(2.) *The publication, in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.*

¹ *Arrangements with foreign States.*—For a complete list of the States with which such arrangements have been made, see *post*, p. 414.

² *Mutual protection of inventions, designs, and trade marks.*—The terms of the International Convention contemplate a wider scope, but its operation in Great Britain appears to be limited to the subjects above mentioned, except in so far as the ordinary legal remedies are equally available to foreigners and British subjects. A special arrangement was made with Greece on 27 July, 1894.

³ *Any person.*—*Semble*, a corporation is a “person,” and can claim rights under this section: *Re Carez* (1889), per Webster, A.-G., 6 R. P. C. at p. 552.

A patent under the International Convention and sect. 91 can be granted only to the person who has made the foreign application: *S. C., ubi supra*.

“Person” includes citizen and foreigner alike: *Re Shallenberger* (1889), 6 R. P. C. 550.

⁴ *In priority to other applicants.*—*Query* whether registration of a design would be obtainable under this where the copyright has already been secured by another person: see *In re Mann's Patent*, 7 R. P. C. 13.

⁶ *Date of the application.*—These words were, at the instance of Lord Herschell, substituted by sect. 6 of the Act of 1885 for the words “date of the protection obtained” used in the 1883 Act. They point to the requirement that applications under this section shall be made within the time allowed dating from the *first* foreign application, and this was the practice under the old Rule.

⁶ *Within four months.*—Strict compliance with the Act and Rules is a condition precedent to obtaining the benefits of the Convention, and the Comptroller may refuse to grant priority where there has been an error in the document submitted involving delay which extends beyond the time allowed for the application: *In the matter of an Application, etc.*, 23 R. P. O. 298. (See the International Convention, Art. 4, *post*, p. 323.)

⁷ *By reason of use, exhibition or publication.*—See the International Convention, Art. 4. As to the effect of user abroad after registration here, see sect. 58, *ante*. Under the corresponding section in the old Act it was held that the sale of unmarked articles before the application for priority avoided the copyright under sect. 57, but the new provisions (sect. 54) do not attach this penalty to the failure to mark copies, and only stop the remedy which is not available until the registration has been completed.

⁸ *As an ordinary application.*—See sect. 49, *ante*, for the regulations applying to applications.

⁹ *Orders in Council.*—For complete table of these Orders in Council, see *post*, p. 414.

Definitions.

92.—(1.) In this Act, unless the context otherwise requires, “the Court”¹ means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England. Provisions as to “the Court.”

(2.) Where by virtue of this Act a decision of the comptroller is subject to an appeal² to the Court, or a petition may be referred or presented to the Court, the appeal shall, subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking

Sect. 92. a patent on any ground on which the grant of such patent might have been opposed.

(Sub-sect. (1) repeats substantially the corresponding part of sect. 117 of the 1883 Act. Sub-sect. (2) is new.)

¹ *The Court.*—It was decided in *Proctor v. Sutton Lodge Chemical Co.* (1888), 5 R. P. O. 184, that *the Court* does not include the Court of Chancery of the County Palatine of Lancaster. But now, by 53 & 54 Vict. c. 23, the County Palatine Court has, as regards all persons and property within its jurisdiction, the same jurisdiction and powers as the Chancery Division of the High Court.

The jurisdiction of the County Courts was held to be ousted by the Act of 1883, and this decision still applies: *Reg. v. County Court of Halifax*, 8 R. P. O. 338; *Bow v. Hart* (1905), 21 T. L. R. 251. The repealed Act of 1858 (21 & 22 Vict. c. 70) provided expressly for the institution of proceedings for the recovery of damages in the County Court, but there was nothing similar in the 1883 Act, nor is there in the now Act, unless the power given by sect. 60 (2) to recover a penalty as a simple contract debt may be taken to confer jurisdiction in such cases. (See § 169, and note ¹² to sect. 60, *ante*.)

² *Decision of Comptroller subject to appeal.*—This sub-section is new, and was introduced by sect. 28 of the Amendment Act, 1907. It was apparently intended to apply to appeals in the new matters brought under the jurisdiction of the Comptroller by that Act, but by its inclusion in the present consolidating Act it is made to apply to every appeal from any decision of the Comptroller which is subject to appeal to the High Court.

As to appeals from the Comptroller in matters relating to designs, see sect. 49 (3) (refusal to register), sect. 58 (1) (cancellation of registration), and notes thereon, *ante*.

Judgments in actions for infringement and motions for expunging, etc. under sect. 72 are not affected by this provision, and appeals thereon will be to the Court of Appeal and House of Lords as with other proceedings in the High Court.

Definitions.

93. In this Act, unless the context otherwise requires,—

“Law officer” means the Attorney-General or Solicitor-General for England:

“Prescribed” means prescribed by general rules under this Act:

“British possession” does not include the Isle of Man or the Channel Islands:

“Patent” means letters patent for an invention:

“Patentee” means the person for the time being entitled to the benefit of a patent:

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention :

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“Inventor” and “applicant” shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant :

“Design” means any design¹ (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814)² applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable,³ whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined :

<sup>54 Geo. 3,
c. 56.</sup>

“Article” means (as respects designs) any article of manufacture⁴ and any substance artificial or natural, or partly artificial and partly natural :

“Copyright” means the exclusive right to apply⁵ a design to any article in any class in which the design is registered :

“Proprietor of a new and original design,”—

(a) Where the author of the design, for good consideration, executes the work for

Sect. 93.

some other person, means the person⁶ for whom the design is so executed,⁷ and

(b) Where any person acquires the design or the right to apply the design⁸ to any article, either exclusively of any other person or otherwise,⁹ means, in the respect and to the extent in and to which the design or right has been so acquired,¹⁰ the person by whom the design or right is so acquired; and

(c) In any other case, means the author¹¹ of the design;

and where the property in, or the right to apply, the design has devolved¹² from the original proprietor upon any other person, includes that other person.

(The definitions of "design," "article," and "copyright" repeat sect. 60 of the 1883 Act.) The definition of "proprietor of a new and original design" is taken from the repealed sect. 61, which was in the following terms:—

[Act of 1883,
sect. 61.]

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

¹ *Any design.*—By this "definition" the limits of the operation of the Act are described, but no real definition of the meaning of design is given. For the subject generally see *ante*, Chap. II. on "The Meaning of Design," p. 17 *et seq.*

The wording is the same as that in the Act of 1883 (sect. 60), which, again, was taken from sect. 3 of the Act of 1842, made wider by the omission of the words "for the ornamentation of" before "any article

of manufacture," so as to cover designs for purposes of utility, which was formerly dealt with by the Act of 1843.

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An ornamented design under the Act of 1842 was judicially defined as something in the nature of a drawing, picture, or diagram applicable to the ornamentation of some article of manufacture; and as the representation of something which a draughtsman had for the first time produced: *Harrison v. Taylor* (1859), 29 L. J. Ex. 3.

In *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380, it was said that a design is a thing in which the merit of the invention lies in the drawing or in forms that can be copied: *Holdsworth v. McCrea* (1867), L. R. 2 H. L. 380—388.

The novelty is not required in the idea of the design itself, but in the application of the design to some article of manufacture: *Saunders v. Wiel* (No. 2), 10 R. P. C. 29; *Hothersall v. Moore*, 9 R. P. C. 27; and see *Hanfstaengl v. W. H. Smith and Sons* (a copyright case) (1905), 21 T. L. R. 291.

³ *The Sculpture Copyright Act, 1814.*—This Act applies to every new and original sculpture, model, copy, or cast of the human figure, or any part of it, clothed in drapery or otherwise, or of any animal, or the two in combination, or of "any subject being matter of invention in sculpture," or of any relief representing any such matters or things, and it is obvious that many "designs" may be brought within this "sculptures" Act and *vice versa*; but the protection is uncertain and defective.

³ *By whatever means it is applicable.*—The object of this clause is to make the word "design" throughout "as extensive as it reasonably ought to be." 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 term '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." Per Lord Herschell, *In re Rollason's Design* (1898), 15 R. P. C. 441.

⁴ *Article of manufacture.*—A process of manufacture cannot be a design: *Moody v. Tree* (1892), 9 R. P. C. 333; *Cooper v. Symington* (1893), 10 R. P. C. 264; *In re Bayer's Design* (1907), 24 R. P. C. 65. But the fact that the design incidentally describes a mode of manufacture does not make it any the less a design.

And the fact that an article would be a good subject-matter of a patent does not necessarily mean that it is not a design: *Hecla Foundry Co. v. Walker* (1889), 6 R. P. C. 554; *Werner Motors v. Gamages* (1903), 21 R. P. C. 137, 627.

A design applied to an article made in two parts (*e.g.*, butter dish and cover) forms one design: *Fielding v. Hawley*, 48 L. T. N. S. 639. But see *In re Morton's Design* (1899), 17 R. P. C. 117.

A design may be a complete design though only applied to a part of an article: *Hecla Foundry Co. v. Walker, supra*.

An effect is not a design, but only the combination which produces the effect: *Grafton v. Watson* (1884), 50 L. T. N. S. 420. So the Act does not apply to the things to which a design is applied, but to the design applied to them. But when the design is for the shape of a thing, the distinction is reduced to "the difference between the shape

Sect. 93. of a thing and a thing of that shape." Per Lindley, L.J., in *Re Clarke's Design* (1896), 13 R. P. C. 351.

No mechanical principle or contrivance can be a design, nor is protection given to the object or purpose sought to be attained. If advantages, such as attend a mechanical contrivance, are obtained, it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end: *Hecla Foundry Co. v. Walker*, *supra*; *Walker v. Falkirk Iron Co.* (1887), 4 R. P. C. 390; *Gillard v. Worrall* (1904), 22 R. P. C. 76; and see *Re Bayer's Design*, *supra*.

⁵ *The exclusive right to apply.*—All that is protected by copyright in a design is the particular design and not any idea underlying it: *Saunders v. Wiel* (No. 1), 9 R. P. C. 469. Preparing rollers or dies to print a registered design has been held not to be an application of such a design to an article in the class in which it is registered: *Potter v. Braco de Prata Printing Co.* (1891), 8 R. P. C. 218. But this would probably now be held to be an infringement within the new wording introduced in sect. 60, declaring it to be unlawful "to do anything with a view to enable the design to be so applied."

⁶ *Executes the work for some other person.*—The wording of this definition is taken generally, with the exception hereafter noted (note ³ *infra*), from sect. 5 of the Act of 1842. For the general treatment of the subject, see Chap. VII. on "Proprietor," *ante*, p. 115 *et seq.*

The master of a workman employed to make a design, or of a workman employed in a business, who makes a design for use in that business, is the proprietor of such a design and can register it.

The question of employment on behalf of another person is one of fact, and the onus of proof is on the person who claims to be author or proprietor of the design: *Hothersall v. Moore* (1892), 9 R. P. C. 27; *Re Heinrich's Design* (1892), 9 R. P. C. 73; *Re Grocott's Design* (1899), 17 R. P. C. 139.

Where registration of proprietorship is effected on behalf of an employer under this section, it is important that the name of the actual employer, and not of any person acting as agent on his behalf (*e.g.*, the managing director of a limited company), be inserted, or the registration may be invalidated: *Petty v. Taylor* (1896), 75 L. T. N. S. 545.

⁷ *Means the person for whom the design is executed.*—The section in the old Act of 1842 (sect. 5) contained here the words "and shall be entitled to be registered in the place of the author," and it is doubtful whether, in the absence of similar words from this definition, a subsequent proprietor may not avail himself of an original registration by the author. (See *Ihlee v. Henshaw* (1886), 31 Ch. D. 323.)

⁸ *Acquires the design or the right to apply.*—The assignee of a design, whether of the whole right or of a part, is a proprietor.

The purchaser abroad of an article to which a new and original design has been applied does not acquire a design within the meaning of the Act by bringing the article purchased to this country: *Lazarus v. Charles*, L. R. (1873) 16 Eq. 117; 42 L. J. Ch. 507. If a design thus imported be registered, it can be expunged under sect. 72, on

the ground that the person in whose name it is registered is not the proprietor: *Re Guiterman's Design* (1885), 55 L. J. Ch. 309. "For a man to be a proprietor within the Act he must have some right, either general or limited, to apply the design Acquiring a new and original design, or a right to apply the same, are the same thing for the purpose of the Act." Per Jessol, M.R., in *Jewitt v. Eckhardt* (1878), 8 Ch. D. at p. 408.

Where an American manufacturer sold to the plaintiff the exclusive right to sell in England an article newly designed and then about to be manufactured, and the exclusive right also to obtain such protection for the same as he could do under English law, it being stipulated that the plaintiff should obtain the articles exclusively from the manufacturer, it was held 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 in his own name under the Act: *Jewitt v. Eckhardt*, *supra*. See also *Lazarus v. Charles* (1873), L. R. 16 Eq. 117; *Re Guiterman's Design* (1885), 55 L. J. Ch. 309; and *Woolley v. Broad* (1892), 9 R. P. C. 208. For other cases bearing on this question, see *Betts v. Willmott* (1871), 6 Ch. App. 259; *Pitts v. George*, [1896] 2 Ch. 866; and *Landker and Brown v. Wolff* (1908), Law Journal, 1908, p. 37.

⁹ *Either exclusively or otherwise.*—A license may be given to apply the design to certain articles and not to others, and a license may be either exclusive or non-exclusive. Such a licensee is a proprietor to the extent of his interest, and acquires the same rights in the design as a partial assignee: *Jewitt v. Eckhardt*, *supra*.

A licensee may register himself as a proprietor, but not until the author or sole proprietor has done so (see sect. 56 and note ⁴ thereon); and a licensee who has thus registered himself has, under the terms of sect. 60, a right to sue for infringement of the design. As to registration of partial interests, see sect. 72 (2).

¹⁰ *To the extent.*—Any one or more co-proprietors may assign his or their interests in the copyright, and the assignee may maintain an action for infringement in respect of the interest so acquired without the concurrence of the other partners: *Lauri v. Renad* (1892), L. R. 3 Ch. 402.

¹¹ *The author.*—A person who merely suggests the idea of a design is not the author: *Shepherd v. Conquest* (1856), 17 C. B. 427. But the case may be different if he has a share in the execution of the work: *Hatton v. Kean* (1859), 8 W. R. 7; and see *Springfield v. Thame* (1903), 19 T. L. R. 650.

A person who draws a rough sketch of a design, and gives verbal instructions sufficient for a workman to work by so as to produce the article, is an author: *Pearson v. Wilkinson* (1906), 23 R. P. C. 738. See also *Nevill v. Bennett* (1898), 15 R. P. C. 412.

¹² *Has devolved.*—A design is personal property (see sect. 71 (1)), and devolves like any other personal property.

In case of bankruptcy the property in the design passes to the trustee. A document which creates an equitable proprietorship, though not amounting to a legal assignment, may also be entered on the register so as to give the rights of a registered proprietor: *Stewart*:

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v. *Casey* (1892), 9 R. P. O. 9; and see the now provisions contained in sect. 71 (4) as to the registration of mortgages, licenses and other interests.

Application
to Scotland.

Application to Scotland, Ireland, and the Isle of Man.

94. In the application of this Act to Scotland—

(1.) (*Deals with actions for infringement of a patent.*)

(2.) Any offence¹ under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:

(3.) (*Refers to proceedings for revocation of a patent.*)

(4.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends,² affect the jurisdiction of any Court in Scotland³ in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term “the Court” shall mean any Lord Ordinary of the Court of Session, and the term “Court of Appeal” shall mean either Division of that Court:

(5.) (*Refers to petitions for compulsory licenses, etc.*)

(6.) The expression “Rules of the Supreme Court” shall, except in section ninety-two of this Act, mean act of sederunt:

(7.) If any rectification of a register under this Act is required⁴ in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly:

(8.) The expression “injunction” means “interdict.”

(*The portions of this section referring to Designs repeat sects. 108 and 111 of the 1883 Act.*)

¹ *Any offence.*—For the provisions as to offences, see sects. 89 and 90, *ante*.

² *Except so far as the jurisdiction extends.*—The register is an English one, and any proceedings for expunging or varying entries come within the special jurisdiction created by the Act: *Bayer v. Connell* (1897), 14 R. P. C. 275. But for Scotland see *Cowie v. Herbert* (1896), 14 R. P. C. 436; *Dewars, Ltd. v. J. T. Dewar* (1899), 17 R. P. C. 341, and *Reid v. Thompson* (1905), 22 R. P. C. 250 and 376.

³ *Jurisdiction of any Court in Scotland.*—This jurisdiction is concurrent only. The section does not confer an exclusive jurisdiction on the Scotch Courts, though the registered proprietor be resident in Scotland: *Re King & Co.'s Trade Mark* (1892), 10 R. P. C. 350; *Bayer v. Connell*, *supra*.

⁴ *Rectification of a register . . . is required.*—This does not confer any power to rectify by Order of the Court, but refers only to the result of any proceeding in which the title to the copyright may come in question. In *Bayer v. Connell*, *supra*, the Master of the Rolls said: "Whatever ambiguity there may be in the section of the Act of 1883 as to the meaning which must be given to that word ('jurisdiction'), it is perfectly plain that under the Act of 1875 (38 & 39 Vict. c. 91) there can be no such ambiguity. 'The provisions of this Act conferring a special jurisdiction on the Court, as above defined, shall not, except so far as such jurisdiction extends (*i.e.*, the special jurisdiction), affect the jurisdiction of any Court in Scotland or Ireland in causes, actions or proceedings relating to Trade Marks.' There was no power given to any Court in Scotland or Ireland to alter or rectify the register . . . and it is impossible to suppose that the Act of 1883 intended to confer any such jurisdiction." See Chap. VI. on "The Register," § 107, *ante*, and notes to sect. 72.

95. In the application of this Act to Ireland¹—

Application
to Ireland.

(1.) (*Refers to patents.*)

(2.) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification shall be served

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on the comptroller, and he shall rectify the register accordingly.

(The portions of this section referring to designs repeat sect. 111 of the 1883 Act.)

¹ *Application of Act to Ireland.*—See the notes to the last section, Nos. ¹ to ¹, as to the nature and extent of the jurisdiction, which apply equally to Ireland and the Irish Courts.

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications:—

- (1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts:¹
- (2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:
- (3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction² may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

(This section repeats sect. 112 of the 1883 Act.)

¹ *Any proceeding competent to those Courts.*—This does not extend to a motion to rectify the register which is not within the jurisdiction of the Courts of the Isle of Man. Cf. *Bayer v. Connell, supra*.

² *Punishable on summary conviction.*—See *ante*, sects. 89 and 90.

Repeal, Savings, and Short Title.

97. (*Saving for prerogative in letters patent.*)

Sec. 97.

98.—(1.) The enactments mentioned in the Second Schedule to this Act are hereby repealed¹ to the extent specified in the third column of that schedule—

Repeal and
savings.

(a) As respects the enactments mentioned in Part I.² of that Schedule, as from the commencement of this Act ;

(b) As respects the enactments mentioned in Part II.³ of that Schedule, as from the date when Rules of the Supreme Court regulating the matters dealt with in those enactments come into operation ;

(c) As respects the enactments mentioned in Part III.⁴ of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;

and the enactments mentioned in Part II. and Part III. of that Schedule shall, until so repealed,⁵ have effect as if they formed part of this Act :

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force,⁶ and may be repealed, altered or amended, as if it had been made under this Act.

(2.) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act,⁷ and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

113. *The enactments described in the Third Schedule to this*

Sect. 98.[Act of 1883,
sect. 113.]

Act are hereby repealed. But this repeal of enactments shall not—

- (a) *Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or*
- (b) *Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or*
- (c) *Take away or abridge any protection or benefit in relation to any such action or proceeding.*

[Act of 1888,
sect. 27.]

The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

¹ *Acts repealed.*—The old Acts were all repealed by the Act of 1883. Those relating to designs now repealed are the Act of 1883 (46 & 47 Vict. c. 57), with the small temporary exceptions noted in note ⁴ below; the Act of 1885 (48 & 49 Vict. c. 63); the Act of 1888 (51 & 52 Vict. c. 50); and the Amendment Act of 1907 (7 Edw. VII. c. 28). See the detailed Schedule of all repealed Acts with full titles, *post*, p. 333.

² *The enactments in Part I.*—These are all the above statutes with the exception, so far as concerns designs, of sub-sects. 2 and 3 of sect. 47 and sect. 48 of the 1883 Act, as to which, see note ⁴ below. The repeal takes effect as from the commencement of the Act, *i.e.*, the 1st of January, 1908.

³ *The enactments in Part II.*—These are sub-sects. 5, 6 and 7 of sect. 26 and sect. 29 of the 1883 Act, which relate to patents.

⁴ *The enactments in Part III.*—These are sub-sects. 2 and 3 of sect. 47 of the Act of 1883 (specifying the form of application for registration, its contents and how to be lodged), and sect. 48 of the same Act containing the requirements as to drawings, etc. to be furnished on the application, and the powers of the Comptroller in connection therewith. They were to remain in force only until the new Rules came into operation, but the Rules of 1908 were promulgated before the 1st January, 1908, and came into effect on that date.

⁵ *Until so repealed.*—By the provisions of the new Rules 1 and 98, the excepted enactments are now actually repealed.

⁰ *Continue in force.*—For a full list of the Conventions and Orders in Council which have been made under the old Act and are continued by the present Act, see *post*, p. 414.

Sect. 98.

¹ *Extend to all designs registered.*—This extends the period of copyright now subsisting in designs on the register subject to compliance with the new Rules, as to which see Rules 37—42. But it cannot revive any lapsed rights or affect any designs which have already fallen into the public domain through any provisions in the old Acts, *e.g.*, non-marking, which involved forfeiture under the Act of 1883 (sect. 51).

The repealing section under the 1883 Act (sect. 113) contained provisions in the opposite sense, and declared that the enactment of the new Act should not affect any design registered before the commencement of the Act.

99. This Act may be cited¹ as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation² on the first day of January one thousand nine hundred and eight.

Short title
and com-
mencement.

¹ *Cited.*—By the Act of 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, were to be cited collectively as the Patents, Designs and Trade Marks Acts, 1883 to 1888.

² *Come into operation.*—By sect. 3 of the Act of 1883, that Act, except where otherwise expressed, commenced from and immediately after the 31st Dec. 1883.

By sect. 28 of the Act of 1888, that Act, except as thereby otherwise provided, commenced and came into operation on the 1st Jan. 1899.

There were no special provisions as to time of commencement of the Acts of 1885 and 1886, so that they commenced from the dates of those Acts, *viz.*, the 14th Aug. 1885, and the 25th June, 1886, respectively.

SCHEDULES.

FIRST SCHEDULE.

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

Schedule.

SECOND SCHEDULE.

ENACTMENTS REPEALED.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except sub-sections (5), (6), and (7) of section twenty-six, section twenty-nine, sub-sections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. VII. c. 18.	The Patents Act, 1901	The whole Act.
2 Edw. VII. c. 34.	The Patents Act, 1902	The whole Act.
7 Edw. VII. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (2) and (3) of section forty-seven and section forty-eight.

THE DESIGNS RULES, 1908.

Dated December 17, 1907.

By virtue of the provisions of the Patents and Designs Act, 1907, hereinafter referred to as "the Act," the Board of Trade do hereby make the following Rules:—

The provisions of the Act referred to are those in sect. 86, for which, and the notes thereon, see *ante*, p. 267. In *Re Rollason's Design*, 15 R. P. C. 441, the Lord Chancellor (Halsbury) said, "The Rules are practically part of the Act of Parliament."

PRELIMINARY.

1. These Rules may be cited as the Designs Rules, 1908, and shall come into operation from and immediately after the 31st day of December, 1907.

This Rule repeats Rule 1 of 1890 with alteration of the dates. The 1890 Rules came into operation on the 31st March, 1890.

The coming into operation of the present Rules completes the repeal of all the provisions in the previous Acts relating to designs. The repealing section of the Act (sect. 98) preserved the provisions of sect. 47 (2) and (3) and sect. 48 of the Act of 1883 (see Schedule III. to the Act, *ante*, p. 288) which related to the formalities to be observed on applications for the registration of designs until new Rules were made, and the present Rules fulfil these conditions.

INTERPRETATION.

2. In the construction of these Rules any words herein used, the meaning of which is defined by the Act, shall have the meanings thereby assigned to them respectively. Interpreta-
tion.

"Agent" means an agent resident or having a place of business in the United Kingdom or the Isle of Man, duly authorised to the satisfaction of the Comptroller.

“Office” means the Patent Office, Designs Branch, 25, Southampton Buildings, London, W.C.

“Journal” means the Illustrated Official Journal (Patents).

“Specimen” means an article of manufacture or a substance with the design applied to it.

“Lodged” means left at the Office or sent through the post by a prepaid letter addressed to the Comptroller at the Office.

The first paragraph of this Rule repeats Rule 2 and the last Rule 7 of 1890, the remainder is new.

For the definitions under the Act, see sects. 92, 93, *ante*, pp. 278—281.

As to “lodging” by sending through the post, see Rule 9, *infra*.

FEES.

FEES.

3. The fees to be paid in pursuance of the Act, so far as it relates to designs, shall be the fees specified in the First Schedule hereto.

This corresponds with the old Rule 3. For scale of fees, see *post*, pp. 318—320.

FORMS.

FORMS.

4. The forms herein referred to are the forms contained in the Second Schedule hereto, and such forms shall be used in all cases to which they are applicable and shall be modified as directed by the Comptroller to meet other cases.

This corresponds with the old Rule 4. For the list of Forms and corresponding fees payable on them, see *post*, p. 373. The Forms and the instructions marked on them are part of the Rules. (Per Lindley, L.J., in *Re Clarke's Design* (1896), 13 R. P. C. 351.)

SETS OF ARTICLES.

Sets of articles.

5. “Set” means a number of articles of the same 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.

Where there is any doubt whether given articles do or do not constitute a set, the doubt shall be determined by the Comptroller.

Provisions for registration of a "set" were first made by Rule 4 of 1890.

The definition of "set" is new.

CLASSIFICATION OF GOODS.

6. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to the class to which any particular description of goods belongs, it shall be determined by the Comptroller.

For the full list of Classes in Schedule III., see *ante*, p. 29.

Classes 13, 14 and 15 (textile goods) have a separate register provided for them at Manchester (see Rule 85, *post*), and are throughout this work distinguished as the "Manchester Classes."

DOCUMENTS.

7. Subject to any other directions that may be given by the Comptroller, all applications, notices, papers having representations affixed, and other documents required by the Act or by these Rules to be lodged shall be upon strong paper, and, except where otherwise required, on one side only, of a size of approximately 13 inches by 8 inches, and having on the left-hand part thereof a margin of approximately two inches. Size, &c. of documents.

This repeats substantially the old Rule 8.

8. A document lodged by a firm or partnership may be signed in the firm's name or for and on behalf of the firm or partnership by any one or more members thereof. A document lodged by a body corporate may be signed Signature of documents.

by a director or by the secretary or other principal officer of such body corporate.

This extends the provisions of the old Rule 22.

Service of documents.

9. Any application, statement, notice or other document authorised or required to be lodged or to be left, made or given with or to any person under the Act or these Rules may be sent through the post by a prepaid or official paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

This repeats substantially the old Rule 11. The provision as to service by post is also contained in the Act (sect. 81, *ante*, p. 264). As to computation of time and payment of fees by persons living at a distance, see Rules 65 and 66, *infra*.

ADDRESS.

Address.

10. Where any person is by the Act or these Rules bound to furnish the Comptroller with an address, the following provisions shall apply:—

The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

When a person does not reside in a town with streets, the Comptroller may require the address to include all indications which he thinks necessary for such purpose as far as it can be attained.

When an applicant resides in a town where there are streets, the address given shall include the name of the street and the number in the street or name of premises, if any.

Address for service.

11. Where a registered proprietor of a design lives out of the United Kingdom or the Isle of Man, he may

furnish the Comptroller on Form Designs No. 6 with an address for service within the United Kingdom, which shall be entered in the Register.

All notices and documents, which under these Rules are required to be sent to the registered proprietor, shall be deemed duly sent if sent to him at his registered address if that address be within the United Kingdom or the Isle of Man, or where the registered proprietor lives outside the United Kingdom or the Isle of Man, to his address for service, if any, on the Register.

Where a registered proprietor lives out of the United Kingdom or the Isle of Man and has not furnished such address for service, the Comptroller need not send to him any notice which under these Rules the Comptroller is required to send.

Where an applicant lives out of the United Kingdom or the Isle of Man, he shall furnish the Comptroller with an address for service within the United Kingdom, and until he does so the Comptroller need not proceed with the examination of his application.

When such address for service is furnished, it shall, on the registration of the design, be entered in the Register as the address for service of the proprietor.

The provisions of Rules 10 and 11 are new. They apply to proprietors already on the Register as well as new proprietors, and make necessary the provision of an address for service within the United Kingdom by every registered proprietor to ensure notices being sent to them as provided by the Act.

In particular, see the provisions as to applications for cancellation of entries on the Register under sect. 58 (*ante*, p. 238), and the Rules, on the same subject, Nos. 70 to 75 (*post*, p. 310).

Notice must also be given of every change of address of a registered proprietor. (See Rule 50, *infra*.)

AGENTS.

12. An application for registration and all other com- Agency.
munications between an applicant and the Comptroller, or the Board of Trade, and between the registered proprietor of a design and the Comptroller, or the Board

of Trade, or any other person, may be made by or through an agent.

Any such applicant or proprietor may appoint an agent to represent him in the matter of the design by signing and sending to the Comptroller an authority in writing to that effect in the Form Designs No. 1, or in such other form as the Comptroller may deem sufficient. In case any registered proprietor of a design shall appoint such an agent, service upon such agent of any document relating to such design shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such design may be addressed to such agent.

The Comptroller shall not be bound to recognise as an agent, or to receive further communications in respect of any business under the Act relating to designs from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents kept under the provisions of the Act, and not since restored, or any person who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, or any company, which if it had been an individual, the Comptroller could refuse to recognise as agent, or any company or firm, if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant or other person.

This Rule extends the provisions of Rule 6 of 1890 as amended by Rule 2 of 1898. (See sect. 85 and notes thereon, *ante*, p. 266.)

APPLICATION FOR REGISTRATION.

13. An application for registration of a design shall be signed by the applicant for registration or by his agent. Signature of application.

14. Except as regards applications in Classes 13, 14, and 15, an application for registration of a design shall be lodged at the office, and (except as regards applications for lace designs in Class 9) shall be on Form Designs No. 2, or in the case of a set on Form Designs No. 3. Form of application.

The Forms Nos. 2 and 3 correspond with Forms E. and O. respectively under the old Rules, but they omit the formerly important requirement of "statement of nature of design, such as whether it is applicable for the pattern or the shape," and only require a statement of the article to which the design is to be applied. As to this, see Rule 18, *infra*. The Comptroller has also power to require a statement of the novelty claimed to be added. (See Rule 19, *infra*.)

15. An application for registration of a lace design in Class 9 shall be on Form Designs No. 4, or in the case of a set on Form Designs No. 5. Lace designs.

Forms Nos. 4 and 5 correspond with the old Forms E¹. and O¹. respectively under the old Rules; but the statement of "nature of design" included in the old forms, viz., the pattern, is now omitted.

16. On or after receipt of an application the Comptroller shall furnish the applicant with an acknowledgment thereof. Acknowledgment of application.

17. An application shall state the class in which the design is to be registered, and where it is desired to register the same design in more than one class, a separate application shall be made in each class. In that case each application shall be numbered separately and shall be treated as a separate and distinct application. Class.

This repeats substantially the provisions formerly included in the Act itself (1883), s. 47 (3).

Application
of design.

18. Every application shall state the article or articles to which the design is to be applied, and where the Comptroller so requires, the applicant shall further state for what purpose the article to which the design is to be applied is used and the material or the predominating material of which the article is made.

This replaces the old Rule 9 and the provision of the Act (1883), s. 47 (3), which required the applicant, in describing the nature of the design, to state whether it was applicable "for the pattern or for the shape or configuration of the design," and the means by which it was applicable.

The discussion as to claims for "totality" (*Harper v. Wright and Butler* (1895), 12 R. P. C. 483, and *In re Clarke's Design* (1896), 13 R. P. C. 351), and as to what is included in a description of a design as "applicable for the pattern" (*In re Rollason's Design* (1897), 14 R. P. C. 909), are rendered obsolete by these new provisions so far as regards registrations under the Act of 1907, but they may still affect designs registered under the old Act.

Statement of
novelty.

19. The applicant may, and shall if required by the Comptroller in any case so to do, indorse on the application a brief statement of the novelty he claims for his design, and where representations are furnished shall indorse each with such statement, if any.

This provision is new. As to the effect of such an endorsement, see the discussion in *Re Bayer's Design*, before Warrington, J. (1906), 23 R. P. C. at p. 558.

Representa-
tions.

20. Except as regards applications in Classes 13, 14, and 15, there shall be furnished in connection with an application for the registration of a design to be applied to a single article, three exactly similar drawings, photographs, tracings or other representations of the design, or three specimens.

This repeats (except as to the Manchester Classes) the old Rule 9.

Representa-
tions for set,
and in
Classes 13, 14,
and 15.

21. There shall be furnished in connection with an application for the registration of a design to be applied to a set, four exactly similar drawings, photographs, tracings or other representations of the design, or four specimens: in connection with an application in any one

of the Classes 13, 14, and 15, there shall be furnished six such representations, or six specimens.

This Rule is now, both as to the Manchester Classes and the requirement of an extra copy in the case of a "set." As to applications for goods in the Manchester Classes, see Rules 80 to 88, *infra*.

22. Each representation of the design, or set of designs, must be upon paper of the prescribed size and not on cardboard, and must appear on one side only of the paper. The figure or figures must be placed in an upright position on the sheet. When more figures than one are shown, these should where possible be on one and the same sheet, and each should be designated on the sheet (*e.g.*, front view, side view).

Nature of representations.

The provisions of this and the following Rules, Nos. 23 to 27, were formerly not included in Rules, but were covered by the "Instructions to persons who wish to register" issued by the Comptroller.

23. When drawings or tracings are furnished, they must be in ink, and if on tracing cloth or tracing paper must be mounted on paper of the prescribed size.

Drawings, &c. must be in ink.

24. When the design is to be applied to a set, each of the representations accompanying the application should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Representations for set.

25. When the specimens are not, in the Comptroller's opinion, of a kind which can be conveniently pasted into books, representations shall be furnished for insertion in the Register and for official purposes.

Special representations.

26. Where words, letters or numerals are not of the essence of the design, they shall be removed from the representations or specimens.

Words, &c. on designs.

27. Each representation of a design which consists of a repeating surface pattern must show the complete pattern and a sufficient portion of the repeat in length and width, and ought not to be of less size than 7 inches by 5 inches.

Repeat of pattern.

Specimens of designs.

28. Where representations are supplied, the Comptroller shall also be supplied, if in any case he so requires, with a specimen.

Additional representations or specimens.

29. The Comptroller shall be furnished with more representations or more specimens of any design if he requires them.

Representations of living persons or persons recently dead.

30. Where the names or representations of living persons appear on a design, the Comptroller shall, if he so require, be furnished with consents from such persons before proceeding to register the design. In the case of persons recently dead the Comptroller may call for consents from their legal representatives before proceeding with registration of a design on which their names or representations appear.

This provision is new. The requirements are optional on the part of the Comptroller.

PROCEDURE ON RECEIPT OF APPLICATION.

Acceptance.

31. Upon receipt of an application for registration, the Comptroller shall consider it, and if he thinks there is no objection to the design being registered, he may accept it.

Objections.

32. If after consideration of the application any objections appear, a statement of these objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

This extends the provisions of the old Rules 12 and 13. The Comptroller has power to enlarge the times under Rule 64, *infra*.

Decision of Comptroller.

33. The decision of the Comptroller at such hearing as aforesaid shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month, should he consider it necessary for the purpose of appeal, apply upon Form Designs No. 7

requiring the Comptroller to state in writing the grounds of his decision and the materials used by him in arriving at the same.

This extends the provisions of the old Rule 14. The power to call on the Comptroller to state the grounds of his refusal is new. For the Form No. 7, see *post*, p. 377.

34. Upon receipt of such form the Comptroller shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Comptroller's decision for the purpose of appeal; but if the applicant does not apply for the grounds of the Comptroller's decision, appeal shall be lodged within one month from the date of the decision.

Date for appeal.

The latter part of this Rule corresponds with the old Rule 15. As to the proceedings to be taken on appeal, see Rules 89 to 93, *infra*. As to obtaining an extension of time for appealing, see Rule 94.

NON-COMPLETION.

35. Where an application for registration of a design is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Comptroller shall give notice to the applicant in writing of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If after fourteen days from the date when such notice was sent, the application is not completed, the application shall be deemed to be abandoned, but the Comptroller may with such notice, where the applicant lives at such distance from the Office that he cannot reasonably be expected to do what is necessary within such fourteen days, give a further time after such fourteen days for the completion of such application.

Non-completion within 12 months.

The provisions of this Rule are new. See sect. 49 (4) and the notes thereon, *ante*, p. 218. The Comptroller has power to enlarge the time under Rule 64, *infra*.

DEATH OF APPLICANT.

Death of
applicant
before
registration.

36. In case of the death of any applicant for the registration of a design after the date of his application, and before the design applied for has been entered in the Register, the Comptroller may, on being satisfied of the applicant's death, enter in the Register, in place of the name of such deceased applicant, the name, address and description of the person owning the design, on such ownership being proved to the satisfaction of the Comptroller.

This Rule is new. As to the person "owning" the design, see sect. 93, definition of "proprietor," and notes thereon, *ante*, p. 277.

EXTENSION OF PERIOD OF COPYRIGHT.

Extension of
period of
copyright.

37. At any time after the registration of a design, the period of copyright therein may be extended for a second period of five years if Form Designs No. 8 be lodged; but no period of copyright shall be extended unless an application for extension be lodged at least one week before the expiration of the original period of five years. Where a proprietor has more than one design copyright in which ceases at the same date, he may, in place of using a separate Form Designs No. 8 for each design, include all the designs in one form, stamped with the total amount of the prescribed fees for such designs and so modified as to meet the circumstances of the case. Form Designs No. 8 shall be indorsed with the name and address of the person lodging the same.

The wording of sect. 53 (2), to which this Rule has reference, confers an absolute right to the extension (see *ante*, p. 229). And this applies to existing copyrights in designs registered under the old Act. See sect. 98 (2) and the notes thereon, *ante*, p. 287. For the Form No. 8 required to be lodged, see *post*, p. 378.

Notice of
extension.

38. On receipt of Form Designs No. 8 an entry of the extension of the period of copyright shall be made in

the Register, and the Comptroller shall send to the registered proprietor at his registered address or his address for service, a notice that the period of copyright has been extended for a further period of five years.

As to the meaning of "registered proprietor," see sect. 93 and notes thereon, *ante*, p. 277. As there may be various persons with varying interests registered as "proprietors" of the same design, the operation of the Act (sect. 53 (2)) and these Rules would seem to extend the copyright for the benefit of all on the lodgment of Form No. 8 by any of the persons whose names appear on the Register.

39. At any time not less than six months and not more than twelve months before the expiration of the second period of five years mentioned in sub-section 3 of section 53 of the Act, application may be made to the Comptroller for a further extension of the period of copyright by lodging Form Designs No. 9. Second extension.

This second extension is apparently optional, at the discretion of the Comptroller. (See sect. 53 (3) and notes thereon, *ante*, p. 229.) No grounds are stated on which the discretion is to be exercised; but as to the exercise of discretionary powers by the Comptroller generally, see sect. 73 and notes thereon, *ante*, p. 261, and Rules 53 to 58, *infra*. For the Form No. 9, see *post*, p. 378.

40. If the Comptroller grants the application he shall send notice to the registered proprietor, who shall, at least one week before the expiration of the second period of five years, pay the prescribed fee by lodging Form Designs No. 10. Payment of extension fee.

As to the persons affected by this notice, see note to Rule 38, *ante*.

41. Form Designs No. 10 shall be indorsed with the name and address of the person lodging the same, and on receipt thereof an entry of the further extension of the period of copyright shall be made in the Register, and a notice of such extension, as prescribed by Rule 38, shall be sent. Notice of second extension.

42. Upon an extension of the period of copyright, the extension shall be advertised in the Journal. Advertisement of extension.

ASSIGNMENT, &c.

Joint request
for entry of
assignment,
&c.

43. Where a person becomes entitled as assignee, mortgagee, licensee, or otherwise to any interest in the copyright of a design, he may, conjointly with the registered proprietor, apply on Form Designs No. 11 to have an entry of the fact made in the Register, and on receipt of such form the Comptroller may make a note in the Register of such interest.

The provisions of this Rule are now, and appear to contemplate the entry of proprietorship or other interest on the Register without further evidence, wherever the registered proprietor (as to whom, see sect. 93 and notes thereon, *ante*, p. 277) joins in the application.

For the Form No. 11, see *post*, p. 379. There is a special Form (No. 12, *post*, p. 380) for designs in Class 9 (*laco*), which requires only the statement that the design has been sold to and acquired by the proposed assignee, and this clearly suggests that no further evidence is necessary in such cases. (See sect. 71 and notes thereon, *ante*, p. 256.)

Application
for entry of
assignment
by subsequent
proprietor.

44. Where no such joint application is made, any person who has become entitled to an interest in the copyright of a design by assignment, mortgage, license, or otherwise, may apply for the entry of his name in the Register as proprietor of such interest in such copyright. The application shall be on Form Designs No. 13, and such application shall contain the name, address, and description of the person claiming to be entitled (hereinafter called the claimant).

This corresponds with the old Rules 21 and 22. For the Form No. 13, see *post*, p. 380. A person is entitled to be entered and to sue as proprietor, though he may only have acquired the interest of one of several co-owners: *Lauri v. Renad*, [1892] 3 Ch. 402.

Case accom-
panying
application.

45. Together with such application the claimant shall leave a case stating full particulars of the assignment, mortgage, license, instrument, or other mode of transfer by virtue of which he claims to be entitled to be entered in the Register, so as to show the manner in which, and

the person or persons through whom, such interest has been acquired.

This corresponds with the old Rule 23, but the requirement of a separate case setting out full particulars of the title is new.

46. Where the Comptroller shall determine that the case sets out particulars such as entitle the claimant to be entered in the Register, he may call upon the claimant to furnish a statutory declaration on Form Designs No. 14, verifying the several statements in the case and declaring that the particulars given comprise every material fact and document affecting the matter. Statutory declaration in support of such request.

Under the old Rule 24, every request for entry of assignment, &c. had to be accompanied by a statutory declaration, but in future this will only be required where the Comptroller asks for it. For the Form No. 14, see *post*, p. 381. As to the form and manner in which statutory declarations are to be taken and made, see Rules 77 and 78, *infra*.

47. In any case, the Comptroller may call on any person who desires his name to be entered in the Register for such proof or additional proof of title as the Comptroller may require for his satisfaction. Proof of title.

48. When the Comptroller is satisfied that the claimant is entitled to the entry of his name, he shall make a note in the Register of such interest. Entry in the Register.

As to the power to dispense with or accept less than legal evidence in any particular case, see Rule 62, *infra*.

49. Where the name of a person is entered on the register as mortgagee or licensee, such person may on lodging Form Designs No. 15 have a note entered in the Register that he no longer claims to be mortgagee or licensee, as the case may be. Removal of name.

This provision is new. See sect. 71 (2) and notes thereon, *ante*, p. 256. For the Form No. 15, see *post*, p. 381.

ALTERATION OF ADDRESS.

Alteration of
address in
Register.

50. Every registered proprietor of a design who alters his address or his address for service, shall forthwith apply to the Comptroller on Form Designs No. 16, and the Comptroller shall alter the Register accordingly.

For the provisions as to entry of address, or address for service in the case of proprietors resident abroad, see Rules 10 and 11, *supra*. For the Form No. 16, see *post*, p. 382.

CORRECTION OF CLERICAL ERRORS.

Correction by
applicant.

51. Where an applicant desires to correct a clerical error in his application, he shall lodge a Form Designs No. 17.

The power to correct clerical errors in the application was formerly contained in the Act itself (sect. 91 of 1883). The present Rule is under the general powers conferred on the Board of Trade by sect. 86 (1) (a) (see *ante*, p. 267). Clerical errors in the representation of a design are specially provided for by sect. 70 (c), *ante*, p. 255. See also the general power of amendment given by Rule 63, *infra*.

Correction by
proprietor.

52. Where the registered proprietor of a design desires to correct a clerical error under section 70 of the Act, he shall lodge a Form Designs No. 17.

This applies to clerical errors generally. For the Form No. 17, see *post*, p. 382.

CANCELLATIONS.

Cancellation
of design.

53. Where the registered proprietor of a design desires to cancel his registration either wholly or in respect of any particular goods in connexion with which the design is registered, he shall lodge a Form Designs No. 18.

Cancellation
by trustee in
bankruptcy,
&c.

54. Cancellation may also be effected by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation by the liquidator, or in any other case where the request is made by a person whom the Comptroller may decide to be entitled to act in the name of the registered proprietor.

In such cases Form Designs No. 18 shall be lodged, modified as the Comptroller directs.

These are new provisions. (See sect. 70 (b) and notes thereon, *ante*, p. 255. For the Form No. 18, see *post*, p. 383.)

DISCRETIONARY POWER.

55. Before exercising any discretionary power given Hearing. to the Comptroller by the Act adversely to any person, the Comptroller shall, if so required, hear the person who will be affected by the exercise of such power.

56. An application for a hearing shall be made within Application for hearing. one month from the date when the matter on which the Comptroller is called on to exercise discretionary power has arisen.

This and the preceding Rule correspond with the old Rule 12. (See sect. 73 and notes thereon, *ante*, p. 261.)

57. Upon receiving such application, the Comptroller shall give the person applying ten days' notice of a time Notice of hearing. when he may be heard by himself or his agent.

Within five days from the date when such notice would be delivered in the ordinary course of post, the person applying shall notify the Comptroller whether or not he intends to be heard on the matter.

This corresponds with the old Rule 13.

58. The decision of the Comptroller in the exercise Notification of decision. of any such discretionary power, as aforesaid, shall be notified to the person affected.

The Comptroller may, in any case of doubt or difficulty, apply to a law officer for directions in the matter; but he is not compelled to exercise this power. (See sect. 74 and notes thereon, *ante*, p. 261.)

SEARCHES.

59. Where any person desires to obtain the informa- Search under sect. 57. tion which he is entitled to obtain under section 57 of

the Act, and can furnish the registration number of the design, he shall lodge Form Designs No. 19, and the Comptroller will thereafter furnish him with the information aforesaid.

Where the applicant is unable to furnish the registration number of the design, he shall lodge Form Designs No. 20 together with such information as he is in possession of, and the Comptroller will thereupon make such search in the class indicated as may be possible on the information supplied, and will furnish such information as can be afforded. Where Form Designs No. 20 is accompanied by a representation or specimen of the design, such representation or specimen shall be furnished in duplicate.

This refers to information required as to the existence of registration of a design. (See sect. 57 and the notes thereon, *ante*, p. 237. For the Forms Nos. 19 and 20, see *post*, pp. 383, 384.)

Search among
registered
designs.

60. The Comptroller may, if Form Designs No. 21 be lodged, cause a search to be made among the registered designs and state whether, in his opinion, any design accompanying such form and to be applied to goods in any particular class is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing. The design accompanying Form Designs No. 21 shall be furnished in duplicate.

This corresponds with the old Rule 35. The information given by the Comptroller is not a certificate within the meaning of sect. 78 (*ante*, p. 263) or Rule 67, *infra*, and is not evidence: *Smith v. Hope* (1889), 6 R. P. C. 204.

HOURS OF INSPECTION.

Hours of
inspection.

61. The Office shall be open to the public every week day, except Saturday, between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the day observed as His

Majesty's Birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

The Bank holidays are Easter Monday, Whit Monday, the first Monday in August, and the 26th December, if a week-day, or the next day when the 26th falls on a Sunday.

POWER TO DISPENSE WITH EVIDENCE.

62. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, and upon the production of such other evidence and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence

Dispensing
with
evidence.

This corresponds with the old Rule 29. The Act itself provides for cases of infancy or other disability. (See sect. 83, *ante*, p. 266.)

AMENDMENTS.

63. Any document or drawing or other representation of a design may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if the Comptroller think fit, and on such terms as he may direct.

Amendment
of documents.

This repeats the old Rule 30. The Act contains provisions for certain specific cases of error. (See sect. 70 (b) and (c), *ante*, p. 255, and Rules 51 and 52, *supra*.)

ENLARGEMENT OF TIME.

Enlargement
of time.

64. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

This extends the provisions of the old Rule 31. For extension of time for appealing to the Board of Trade, see the special provision in Rule 94, *infra*.

Excluded
days.

65. Whenever the last day fixed by the Act or by these Rules for doing any thing shall fall on a day when the Office is not open, or on a Saturday, which days shall be excluded days for the purposes of the Act and these Rules, it shall be lawful to do any such act or thing on the day next following such excluded day, or days if two or more of them occur consecutively.

This provision was formerly included in the Act itself (sect. 98 of 1883). As to the days on which the Office is not open, see Rule 61, *supra*. As to the computation of time where a lodgment of documents or service is made by post, see Rule 9, *supra*. (See also sects. 81 and 82, and the notes thereon, *ante*, p. 265.)

Fees paid late
by persons
living at
distances
from Office.

66. Where a time for paying a fee is limited by these Rules, and the person who is bound to pay such fee resides at such distance from the Office that he cannot reasonably be expected to pay the fee on the date limited by the Rule, the Comptroller, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for paying the fee has passed, and treat it as if received on the correct date, provided always that the fee is actually paid with such promptitude as can be expected in the circumstances.

CERTIFICATE BY COMPTROLLER.

67. Where a certificate is required for the purpose of any legal proceeding, or other special purpose, as to any entry, matter, or thing which the Comptroller is authorised by the Act or these Rules to make or do, the Comptroller may, on the lodging of a Form Designs No. 22, give such certificate, which shall also specify on the face of it the purpose for which it has been issued as aforesaid.

Certificate for use in legal proceedings or other purpose.

This repeats the old Rule 34. The certificate is *prima facie* evidence of the facts stated therein (sect. 78, *ante*, p. 263). For Form No. 22, see *post*, p. 385.

MARKING OF ARTICLES.

68. Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall cause each such article to be marked with the word REGISTERED or with the abbreviation REGD or with the abbreviation RD, as he may choose, and also (except in the case of articles to which have been applied designs registered in Classes 9, 13, 14, and 15) with the number appearing on the certificate of registration.

Registration mark.

This corresponds with the old Rule 39. The excepted classes are lace and textile goods. The Rule laid down in *Heinrich v. Bastendorff*, 10 R. P. C. 160, as to articles required to be marked R^d. being sufficiently marked if Reg^d. was used is now extended to all cases. An error in the number will not necessarily invalidate the marking: *Re Rollason's Design* (1897), 14 R. P. C. 893; see sect. 54 (b) and notes thereon, *ante*, p. 231. It is an offence to use the registration mark after the copyright has expired. (See sect. 89 (4), *ante*, p. 270.)

REGISTER OF DESIGNS AND INSPECTION OF REGISTERED
DESIGNS.

69. When a design is accepted, there shall be entered in the Register a representation or specimen of the design, the calling or description of the proprietor, the

Registering design.

date of the application, and such other particulars as the Comptroller may deem necessary.

Inspection of registered designs.

The period under section 56 of the Act during which a design shall not be open to inspection, except as provided in that section, shall be, as regards designs in Classes 13, 14, and 15, five years, and, as regards designs in other classes, two years from the date of the original registration thereof.

CANCELLATION OF DESIGNS USED FOR MANUFACTURE OUTSIDE THE UNITED KINGDOM.

Cancellation of designs used for manufacture outside the United Kingdom.

70. An application for the cancellation of the registration of a design under section 58 of the Act shall be made on Form Designs No. 23, which shall, if so required by the Comptroller, contain an address for service in the United Kingdom. The applicant shall simultaneously with, or as soon as may be after, the leaving of such application at the Office deliver, or cause to be delivered, to the registered proprietor of the design (hereinafter called the proprietor) or his agent a copy of such application, and furnish the Comptroller with evidence of such delivery.

Procedure.

71. The proprietor shall within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the design is used for manufacture in the United Kingdom; and setting out in the event of the design not being used for manufacture in the United Kingdom to an adequate extent the reasons why it is not so used for manufacture.

Copies of evidence.

72. The proprietor shall deliver, or cause to be

delivered, copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery.

73. Within fourteen days from the delivery of such copies, or within such further time as the Comptroller may allow, the applicant shall, if he decides to proceed with his application, leave at the Office statutory declarations in answer, and on so leaving shall deliver to the proprietor or his agent copies thereof, and furnish the Comptroller with evidence of such delivery. Evidence in answer.

74. No further evidence shall be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit. Closing of evidence.

75. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and give the parties ten days' notice at least of such appointment, and in the event of his deciding to take evidence *vivâ voce* in lieu of, or in addition to, the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant or other person whose evidence he may consider desirable. Hearing.

The whole of these provisions are new. See sect. 58 and notes thereon, *ante*, p. 238 *et seq.* Any person may apparently make the application, and, without making out any sort of case against a registered proprietor, compel him to give substantive evidence in support of his registration. The only check is the 1*l.* fee payable on the application, and the liability to costs which is reserved by the section. (See Form 23, *post*, p. 385, and Schedule of Fees, No. 20, *post*, p. 319.)

The Rule applies to all designs now on the Register as well as to any which may be registered under the new Act. See sect. 98 (2) and notes thereon, *ante*, pp. 285, 286.

There is no appeal from the decision of the Comptroller on any such applications. As to the powers of the Comptroller on taking evidence, see sect. 77 and notes thereon, *ante*, p. 262. For the provisions as to the statutory declarations to be used in these cases, see Rules 77 to 79, *infra*.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

Notice of
exhibition.

76. Any person desirous of exhibiting a design or any article to which a design has been applied, at an industrial or international exhibition, which has been duly certified as such by the Board of Trade, or of publishing a description of a design during the period of the holding of such an exhibition, shall give the Comptroller notice, on Form Designs No. 24, of his intention to exhibit the design or article or to publish a description of the design, as the case may be. For the purpose of identifying the design in the event of an application to register the same being subsequently made, the person lodging Form Designs No. 24 shall supply a brief description of the nature thereof, accompanied by a sketch, drawing, or specimen, and shall supply such other information as the Comptroller may in each case require.

This repeats the old Rule 36. The Rule applies to all exhibitions at home or abroad which have been certified as such by the Board of Trade. (See sect. 59 and notes thereon, *ante*, p. 242. For the Form No. 24, see *post*, p. 386.)

STATUTORY DECLARATIONS.

Form, etc. of
statutory
declaration.

77. The statutory declarations required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject. Every statutory declaration shall state the description and true place of abode of the person making the same, and shall bear the name and address of the person leaving it, and shall state on whose behalf it is left.

Manner in
which, and
person before
whom,
declaration is
to be taken.

78. Statutory declarations shall be made and subscribed as follows:—

- (a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer