

**Sect. 11.** to the applicant, the usual practice has been to seal a patent to them *jointly (z)*.  
 tained inven-  
 tion from  
 opponent.

Under sect. 11, sub-s. (1), the comptroller-general or the law officer cannot inquire into the circumstances under which an invention was *imported* into this country, thus, whether there was fraud on the part of the person making the communication from abroad (*a*).

Where fraud is imputed to an applicant, evidence in support of the charge must be filed before appeal to the law officer comes on for hearing (*b*).

Meaning of  
 "legal repre-  
 sentative."

**4 The legal representative :**

As to application by legal representative of deceased inventor, see sect. 34.

This term must probably be construed in its ordinary sense, as meaning an executor or administrator of a deceased person.

*Query* whether it includes a person holding a power of attorney from the alleged true and first inventor (*c*).

The *assignee* of a prior patent is not "the legal representative" of the patentee within the meaning of this sub-section (*d*).

Meaning of  
 "patented."

**5 Has been patented :**

The word "patented" is construed strictly (*e*), and it appears to be necessary that the opponent should prove that a patent for *the same invention* as the applicant's has been granted.

It will not do for him to produce merely a provisional specification (*f*); but in *L' Oiseau and Pierrard (g)*, it was held by Webster, A.-G., that for the purpose of opposition on the ground of a prior patent, it was sufficient to have complete specification accepted. That only is "patented" which the inventor has claimed.

It is immaterial that the previous patent, on which an opponent relies, has expired (*h*).

Where the applicant's invention is simply an improvement on a prior invention, the specification must state this, and a patent will be granted for the improvement only (*i*).

Where two inventions are *clearly identical*, it is no defence for an applicant to allege that his opponent has included in his complete

(z) *Eadie's Patent*, 1885, Griffin, P. O. 279; *Garthwaite's Patent*, 1886, Griffin, P. O. 284.

(a) *Edmunds' Patent*, 1886, Griffin, P. O. 281.

(b) *Huth's Patent*, 1884, Griffin, P. O. 292.

(c) *Edmunds' Patent*, 1886, Griffin, P. O. 282.

(d) *Adolph Spiel's Patent*, 1888, 5 P. O. R. 282.

(e) *Cumming's Patent*, 1884, Griffin,

P. O. 277; *Stubbs' Patent*, 1884, Griffin, P. O. 298; *Welch's Patent*, 1884, Griffin, P. O. 301.

(f) *Bailey's Patent*, 1884, Griffin, P. O. 269.

(g) 1887, Griffin, A. P. O. 36; *op. Dundon's Patent*, 1885, Griffin, P. O. 278.

(h) *Lancaster's Patent*, 1884, Griffin, P. O. 294.

(i) *Hoskins' Patent*, 1884, Griffin, P. O. 291.

specification subject-matter which was not in the provisional. This is an objection to the validity of the prior patent, and cannot be raised before the comptroller-general or the law officer (*k*).

**Sect. 11.**

6 *Or on the ground that the complete specification describes, &c.*—This clause, which was enacted by the Patents Act, 1888, sect. 4, meets and resolves a doubt expressed by Sir Richard Webster, A.-G., in *Newman's Patent* (*l*). Act of 1888,  
s. 4.

It was enacted to prevent fraud arising from a prior applicant taking advantage of information conveyed by the specification of a later applicant.

7 *Notice of opposition to applicant.*—As to procedure, see Patents Rules, 1890, rr. 34 *et seq.*, p. 573.

8 *Decide on the case.*—Where the comptroller-general requires an amendment, but does not, in his decision, settle its terms, the time for appealing dates from the day of forwarding to the opponent a copy of the amendment approved by him (*m*).

9 *Subject to appeal.*—An appeal to the law officer is a re-hearing: but, apart from special circumstances, costs follow the event (*n*).

10 *Hear the applicant.*—In the matter of *Ainsworth's Patent* (*o*), where the applicant failed to appear at the appeal, Sir Richard Webster, A.-G., heard the opponent, and then reserved his decision. Prior to any decision being given, the applicant applied *ex parte* to the Attorney-General for leave to be heard, and, having satisfactorily accounted for his absence on a former occasion, was granted a fresh hearing, on condition of paying the appellant's costs of the adjournment. Practice  
where ap-  
plicant failed  
to appear.

11 *Entitled to be heard.*—See full discussion of the meaning of these words, Chap. IX., p. 175. Entitled to be  
heard.

In the matter of *Heath and Frost's Patent* (*p*), Sir Edward Clarke, S.-G., said: "It seems to me perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. . . . It appears to me that by sect. 11 the only class of persons who are entitled to be heard in opposition before the law officer, are persons who are interested, with a real and legitimate interest, in the prior patent upon which an application is opposed; or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."

(*k*) *Green's Patent*, 1885, Griffin, P. O. 287.

(*l*) 1888, 5 P. O. R. at p. 278.

(*m*) *Chandler's Patent*, 1886, Griffin, P. O. at p. 273.

(*n*) *Stubbs' Patent*, 1884, Griffin, P. C. 298.

(*o*) 1885, Griffin, P. O. 269.

(*p*) 1886, Griffin, P. O. 290.

**Sect. 11.** The purchaser of a prior patent who had worked it, and had manufactured machines in accordance with it, would probably be entitled to be heard (*q*); not so a person who had merely manufactured articles under a prior patent (*r*).

In the matter of *Heath and Frost's Patent* (*s*), Sir Edward Clarke, S.-G., declined to hear a patent agent, who, acting on behalf of a client, opposed in his own name the grant of letters patent.

It would appear that any member of the public can oppose before the comptroller.

In *L'Oiseau and Pierrard* (*t*), however, the comptroller went into the question of interest.

Power of  
law officer to  
summon  
expert.

**12 Power of law officer to call in expert.**—Under the Patent Law Amendment Act, 1852, s. 8, the law officer was empowered “to call to his aid,” in determining whether or not a provisional specification correctly described the nature of the invention claimed, “such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint.”

As to scientific assessors in legal proceedings, see sect. 28, sub-sects. 2 and 3, p. 480; and Chap. XIV., pp. 319, 320.

**13 Treasury :**

Definition of, sect. 117, sub-sect. (1).

Direction as to fees, sect. 24.

Powers in relation to Patent Office, sect. 82, sub-sect. (1).

Powers in relation to invention used by Crown, sect. 27, sub-sect. (2).

Powers in relation to presentation of Patent Office publications, sect. 101, sub-sect 1.

Sealing of  
patent.

**12.** (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent<sup>1</sup> to be sealed with the seal of the Patent Office.<sup>2</sup>

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal<sup>3</sup> of the United Kingdom.<sup>4</sup>

(3.) A patent shall be sealed<sup>5</sup> as soon as may be, and not after the expiration of fifteen months from the date

(*q*) *Glossop's Patent*, 1884, Griffin, R. at p. 286.  
P. O. 286-7.

(*r*) *Bairstow's Patent*, 1888, 5 P. O.

(*s*) Griffin, *ubi sup.* at p. 288.

(*t*) 1887, Griffin, A. P. C. 36.

of application, except in the cases hereinafter mentioned, Sect. 12.  
that is to say—

- (a) Where the sealing is delayed<sup>6</sup> by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.
- (b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.<sup>7</sup>

A complete specification may be left and accepted within such extended times,<sup>8</sup> not exceeding one month and three months respectively after the said nine and twelve months respectively, as the comptroller may on payment of the prescribed fee<sup>9</sup> allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Act 1885,  
s. 3.  
Extension of  
time for leav-  
ing and  
accepting  
complete spe-  
cification and  
sealing.

1 *A patent.*—See Form of Patent, annotated, at pp. 533 *et seq.*

2 *Seal of Patent Office.*—See sect. 45, sub-sect. 4; seal to be judicially noticed, sect. 84.

3 *As if it were sealed with the Great Seal.*—In the case of *The East India Company v. Sandys* (*u*) it is laid down that “all the King’s subjects are bound to take notice of the King’s Great Seal.” The Great Seal proves itself, and cannot be impeached (*x*).

4 *Great Seal of United Kingdom.*—By common law the Sovereign can make a gift of moveable chattels without writing. Every other grant must be by charter or letters patent under the Great Seal. Seals formerly  
in use.

The seal originally used for letters patent for inventions was the Great Seal of England, but after the legislative unions with Scotland and Ireland, the Great Seals of Great Britain and of the United Kingdom were respectively substituted (*y*).

For the purposes of letters patent, however, the seals of the three kingdoms were in one sense distinct (*z*).

(*u*) Skin. 225; and see sect. 84,  
*infra.*

(*y*) Hindmarch, p. 36.

(*z*) 6 Ves. 708.

(*x*) Cp. Hindmarch, 36, 37.

Sect. 12.

In a petition for a patent for Ireland the words "under the Great Seal of Ireland" were inserted; in a petition for a patent in Scotland the words were "under the Seal appointed by the Treaty of Union to be kept and used in Scotland, instead of the Great Seal thereof" (a).

Wafer Great Seal.

The Crown Office Act, 1877, provided that a *wafer* Great Seal might be attached, instead of the Great Seal, to documents prescribed by rules made thereunder by the Lord Chancellor, the Lord Privy Seal, and one of the principal Secretaries of State, or any two of them in case of difference. Letters patent for inventions were so prescribed by rules published in the London Gazette of March 5th, 1878 (b).

Former practice as to time of sealing.

*5 Sealing of patent:*

Under the Patent Law Amendment Act, 1852, ss. 19 and 20—construed together with 16 & 17 Vict. c. 115—no letters patent were to be issued unless (a) application to seal them were made within three months from the date of the law officer's warrant, and (b) letters patent—except those issued in lieu of others lost or destroyed—were issued during the continuance of the protection conferred by the Act.

Where, however, an application to seal letters patent had been duly made, but the sealing had been delayed by a caveat, or opposition, after the expiration of the statutory protection, the Lord Chancellor might cause letters patent to be sealed at such time as he should direct.

16 & 17 Vict. c. 115, s. 6, empowered the Lord Chancellor to cause letters patent to be sealed at any time within one month after the expiry of the statutory protection, provided the delay in such sealing had arisen from accident, and not from the neglect or wilful default of the applicant.

Practice under Act of 1883.

Under the present Act letters patent must be sealed within fifteen months from the date of the application, unless:—

The sealing is delayed by an appeal to the law officer, taken at any stage—in which case the patent may be sealed at such time as the law officer may direct;

Or, the applicant dies within the fifteen months, where a patent may be granted to his legal (personal) representative at any time within twelve months from the death (c);

Or, the comptroller has, under the 3rd section of the Act of 1885, allowed an extended time for leaving and accepting the complete

(a) Webster's Letters Patent, 67, n. (e).

(b) Letters patent for the appointment of Indian judges, Colonial governors, Indian and Colonial bishops, and other matters were in-

cluded in the prescribed documents, by later rules: London Gazette, Aug. 13, 1878.

(c) Cp. Patent Law Amendment Act, 1852, s. 21, *infra*, p. 654.

specification, in which case a further extension of four months after the said fifteen months is granted. **Sect. 12.**

6 *As to appeals in opposition cases, see Chap. IX. p. 173.*

7 *Grant to legal representatives.—See sect. 34.*

8 *A complete specification may be left and accepted, &c.—An application for extension of time for leaving or accepting a complete specification shall be in writing, and shall state in detail in what circumstances, and upon what grounds such extension is applied for; and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary. (Patents Rules, 1890, rr. 49 and 50, pp. 576, 577.)*

9 *Prescribed fee.—These are Fees 39 and 40, see p. 588.*

13. Every patent shall be<sup>1</sup> dated and sealed as of the day of the application: Provided that no proceedings<sup>2</sup> shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.<sup>3</sup>

Where an application for a patent has been abandoned, or become void,<sup>4</sup> the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.<sup>4</sup>

Act 1885,  
s. 4.  
Specifica-  
tions, &c. not  
to be pub-  
lished unless  
application  
accepted.  
Former  
practice.

1 *Date of patent:*

The *date* of letters patent was, by 18 Hen. 6, c. 1, required, on pain of nullity, to be *the day of the delivery of the King's warrant to the Chancellor.*

In practice, however, letters patent usually bore the date of sealing, unless the grant was opposed, in which case the Lord Chancellor might order them to be antedated (*e*).

15 & 16 Vict. c. 83, s. 23, provided that letters patent might (the Act of 18 Hen. VI. c. 1, notwithstanding), be sealed and bear date as of the day of application for the same.

Under this section the Lord Chancellor or the law officer had a limited discretion over the date of the patent, and it was sometimes

(e) 1 Web. P. C. 430, n. (c); also Webster's Letters Patent, p. 33, n.

**Sect. 13.** made a condition of sealing a patent that it should bear a particular date (c).

Act of 1883.

The present Act is imperative upon this point.

As to date of patents granted under International and Colonial Arrangements, see Chap. XX. pp. 415, 416.

Restriction on proceedings.

**2** *Provided that no proceedings, &c.:*

This proviso must be taken along with sect. 15.

The effect of the two sections may perhaps be accurately stated thus:

(1) No action for infringement shall be instituted unless and until a patent has been granted.

(2) Even after a patent has been granted no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

(3) Infringements committed between that date and the sealing of the patent are actionable.

**3** *Rival applications:*

This proviso was inserted to meet the objectionable practice of *racing for the seal*. It was held that the Lord Chancellor could not knowingly grant two patents for the same invention. Consequently, under the Act of 1852 there were several cases in which a later applicant rushed for the seal and then opposed the grant to an earlier applicant, on the ground that a patent had already been granted to him for the same invention (d).

**4** *Abandoned and void applications.*—The specifications are not now published. Under the Act of 1852 provisional specifications of abandoned applications were published.

#### PROVISIONAL PROTECTION.

Provisional protection.

**14.** Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as *provisional protection*.<sup>1</sup>

(c) Cp. *Ex parte Bates and Redgate*, 1869, L. R. 4 Ch. 580; *Ex parte Bailey*, 1872, L. R. 8 Ch. 60; *Ex parte Harrison*, 1874, L. R. 9 Ch. 632.

(d) Cp. *Saxby v. Hennett*, 1873, L. R. 8 Ex. 210; *Scott and Young, Ex parte*, 1871, L. R. 6 Ch. 274.

**1 Provisional protection :**

Provisional protection must not be confounded with the interval between the acceptance of the provisional and the filing of the complete specification.

This is a re-enactment with modifications of the 8th section of the Patent Law Amendment Act, 1852.

The provisional protection—which now extends from the date of the application to the date of sealing a patent granted thereon, instead of for six calendar months from the date of application, as formerly—merely amounts to this, that the applicant may *use* his invention during the protected period, without so *dedicating it to the public* as to avoid the patent subsequently granted to him for want of “novelty.”

The words “to be granted for the same” clearly refer to the patent, and not to the application.

The last clause of the section shows conclusively that provisional protection is *merely* “protection from the consequences of use and publication.”

It does not entitle the inventor to take proceedings for infringements of his invention, committed before the acceptance of the complete specification, even *after* a patent has been granted to him (*e*).

PROTECTION BY COMPLETE SPECIFICATION.

**15.** After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.<sup>1</sup>

Effect of acceptance of complete specification.

**1 Restrictions on proceedings.**—Infringements committed between the date of the acceptance of a complete specification and the date of sealing the patent are actionable; but proceedings cannot be taken unless and until the patent has been granted.

(*e*) Cp. *Ex parte Bates and Redgate*, 1869, L. R. 4 Ch. 577; *Ex parte Bailey*, 1872, L. R. 8 Ch. 60; *In re Henry's Patent*, 1872, L. R. 8 Ch. 167;

*contra*, per Earl Cairns, L. C., *In re Dering's Patent*, 1879, L. R. 13 Ch. D. 393.



Sect. 16.

## PATENT.

Extent of  
patent.

**16.** Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

Prior to this Act, letters patent sealed with the Great Seal of the United Kingdom extended to the Channel Islands also. Cp. 15 & 16 Vict. c. 83, s. 18.

Arrangements for the extension of the provisions of the present Act to the Channel Islands have been proposed but have not been carried into effect.

Prior to 15 & 16 Vict. c. 83, s. 18, a British patent extended to the Colonies also, if the patentee desired it.

For the old law as to the extent of letters patent, see *infra*, pp. 542, 543.

Term of  
patent.

**17.** (1.) The term limited in every patent for the duration<sup>1</sup> thereof shall be fourteen years<sup>2</sup> from its date.<sup>3</sup>

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee<sup>4</sup> fails to make the prescribed payments within the prescribed times.<sup>5</sup>

(3.) If, nevertheless, in any case, by accident, mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time<sup>6</sup> for making that payment.

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(a) The time for making any payment shall not in any case be enlarged for more than three months;

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is pro-

posed to be taken may, if it shall think fit, Sect. 17.  
 refuse to award or give any damages in respect  
 of such infringement.<sup>7</sup>

**1 Duration of patent :**

The term given by a patent commences on *the day of the date* of the letters patent.

The rule is otherwise when anything has to be done in a certain time after a given event or date. Here the time is reckoned exclusively of the day of the event or date (*f*).

**2 Fourteen years.**—Cp. 21 Jac. 1, c. 3, s. 6, *infra*, p. 628.

**3 From its date.**—The patent is dated as of the day of application ; so it is really ante-dated.

As to date of patent under International and Colonial Arrangements, see Chap. XX. pp. 415, 416.

**4 The patentee** means the person who is for the time being entitled to the benefit of a patent (*g*).

**5 Prescribed payment within the prescribed times.**—For the prescribed payments and times, see the Schedule to the Act of 1883, at p. 550 ; and the Patents Rules, 1890, rr. 45—51, pp. 575—577.

A payment is within the prescribed time if made before midnight on the anniversary of the day of the date of the patent (*h*).

**6 Application for enlargement of time.**—For form of application, see Patents Rules, 1890, Form K., p. 745.

As to contents of application, see Patents Rules, 1890, r. 49, p. 575.

An enlargement of time is granted almost as a matter of course.

**7** The patent right may be treated, in fact, as if temporarily suspended.

AMENDMENT OF SPECIFICATION.<sup>1</sup>

**18.** (1.) An applicant or a patentee<sup>2</sup> may, from time to time,<sup>3</sup> by request in writing<sup>4</sup> left at the Patent Office, seek leave to amend his specification,<sup>5</sup> including drawings forming part thereof, by way of disclaimer, correction, or explanation,<sup>6</sup> stating the nature of such amendment and his reasons for the same. Amendment of specification.

(*f*) *Russell v. Ledsam*, 1843-48, per Parke, B., 14 M. & W. at p. 582. As to computation of time for enrolment of the specification under the old law, see *Watson v. Pears*, 1809,

1 Web. P. C. 154, n.

(*g*) Sect. 46. For the table of renewal fees, see p. 587.

(*h*) *Williams v. Nash*, 1859, 28 Beav. 93.

Sect. 18.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner,<sup>7</sup> and at any time within one month from its first advertisement any person<sup>8</sup> may give notice at the Patent Office of opposition<sup>9</sup> to the amendment.

(3.) Where such notice is given the comptroller shall give notice<sup>10</sup> of the opposition to the person making the request, and shall hear and decide<sup>11</sup> the case subject to an appeal to the law officer.

(4.) The law officer shall, if required,<sup>12</sup> hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions,<sup>13</sup> if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required,<sup>12</sup> hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different<sup>14</sup> from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed,<sup>15</sup> except in case of fraud;<sup>16</sup> and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10.) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*] **Sect. 18.**

Repealed.  
Act 1888,  
s. 5.

(10.) The foregoing provisions<sup>17</sup> of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending.<sup>18</sup> **Act 1888,  
s. 5.**

1 *Amendment of specifications.*—See on the whole subject, Chap. VIII. p. 145.

The true reading of sects. 18—21 was given by A. L. Smith, J., *In the matter of Hall and others(h)*:—“Sect. 18 gives power to a patentee, when he finds out the blunder in his specification himself, to seek leave to amend his specification by way of disclaimer, correction, or explanation; and he can go *proprio motu* to the comptroller and say, ‘I want to amend the blunder I have got in my specification, as regards disclaimer, correction, or explanation.’ Then there are a series of sub-sections showing what the comptroller is to do, how notice is to be given, what is to be done, and how other parties may come in and object; and the last sub-section, it seems to me, is most natural . . . that means this, that where a patentee is in litigation, he should not go behind the back of the other party and get these amendments and set himself quite right . . . What would happen if that had remained there? After litigation has been commenced, if there had been no sect. 19, the patentee, as soon as the writ was issued, would be fixed, no matter what small technical blunder there might be in his specification. But what the Legislature says is this—and I read sect. 19 as a proviso to sect. 18—provided always, that a judge or the Court . . . may give *liberty* to the patentee to apply at the Patent Office for leave to amend his specification by way of disclaimer.” **True reading of sects. 18-21.**

In the same case, Cave J., said: “Nothing is said as to the proceedings which are to take place on such an application for amendment; but I think it is perfectly clear, notwithstanding the somewhat awkward language of sub-sect. 10 of sect. 18, that the procedure under sect. 18 is meant to apply to a case in which leave is given to make the application by a judge in the course of the action for the infringement of the patent (*i*).

## 2 *An applicant or a patentee:*

For practice under this section, see Patents Rules, 1890, r. 52, p. 577.

For definition of “patentee,” see note to sect. 46; under that definition a grantee who had wholly parted with his interest in a

(h) 1888, 5 P. O. R. at p. 312.

(i) S. C. at p. 310.

**Sect. 18.** patent could not, it would seem, apply, under sect. 18, sub-sect. (1), for leave to disclaim or amend any part of his specification.

3 *From time to time.*—Second disclaimers are therefore permissible, see *supra*, p. 154.

4 *By request in writing:*

Cp. sect. 97, *infra*, and Patents Rules, 1890, r. 52, p. 577.

For form of application, see Patents Rules, 1890, Form F.

5 *His specification.*—This must mean his complete specification, after acceptance, before which there is no publication from the Patent Office. Cp. sect. 10.

6 *Correction or explanation:*

The power to amend by way of correction or explanation is new.

See general note above, p. 457; also Chap. VIII. p. 154.

7 *Shall be advertised in the prescribed manner:*

Advertisement in the Official Journal of the Patent Office is required. (Patents Rules, 1890, r. 52, p. 577.)

Where an amendment is opposed, the applicant and opponent frequently agree upon modifications in the proposed amendment.

If such modifications are comparatively limited and unimportant, a second advertisement will not be required; but the Comptroller-General may order an amendment, modified to a considerable extent or in important details, to be again advertised.

Cp. *In re Van Gelder*, 1889, 6 P. O. R. 22, and *supra*, Chap. VIII. p. 152.

8 *Any person, i. e., "being in the opinion of the law officer entitled to be heard"* (sub-sect. (4)).

This objection can only be raised *before* the law officer. Cp. note to sect. 11, sub-sect. (3), p. 445.

This limitation on the right of opposition is new.

9 *Notice of opposition, &c.:*

Cp. Patents Rules, 1890, r. 53, p. 578.

There is no limitation upon the *grounds* of opposition.

10 *The comptroller shall give notice*—For practice, see Patents Rules, 1890, r. 53, p. 578.

11 *And shall hear and decide the case.*—It has been held that the Comptroller-General may impose conditions in deciding a case under this sub-section, in spite of the curious wording of the enabling clause, which we find in sub-sect. (5)(j).

(j) *Hearson's Patent*, 1884, Griffin, 309.

The comptroller cannot, however, give costs. See *ante*, p. 156.

Sect. 18.

12 *The law officer shall, if required, &c.*—For practice under this sub-section, see the Law Officers' Rules, *infra*, p. 589.

13 *What conditions, if any, &c.:*

Under 15 & 16 Vict. c. 83, s. 39, no action in respect of an infringement committed *before* a disclaimer, or memorandum of alteration, could be brought without the leave of the law officer. This proviso gave the law officer a practical power of determining the conditions on which a disclaimer should be allowed. Conditions of amendment being allowed.

The law officer's leave is no longer required, but he may still effect the same object by making it a *condition* of the amendment being accepted that no action for a prior infringement shall be brought.

The considerations which guide the law officer in determining whether or not this condition shall be prescribed, are the same as those which formerly influenced him in granting or withholding leave: Had the invention been imperfect long before the disclaimer? Had there been a long prior user? Had manufacturers embarked capital in making and dealing with it? (*k*).

14 *No amendment shall be allowed, &c.:*—

The Act of 1835 struck at any disclaimer which extended *the exclusive right* originally claimed by the patentee.

The words of the present sub-section are much wider. The two inventions are now required to be merely *substantially* identical.

15 *Leave to amend, &c.:*

This is a re-enactment of a similar proviso in 15 & 16 Vict. c. 83, s. 39.

The meaning of the sub-section is this: leave to amend prevents any question being raised as to whether the person at whose instance the amendment was allowed was or was not the applicant or the patentee; it does not debar the Court from inquiring whether the amendment claims an invention substantially larger than, or different from, that claimed in the original specification.

*Van Gelder's Patent*, 1890, per Esher, M. R., 6 P. O. R. at p. 27. The Attorney-General cannot make a valid amendment if it is to substantially enlarge the invention, or make it a different invention. That is by virtue of sect. 18, sub-sect. (8). Sub-sect. (9) has not the effect of making that which he has done invalidly conclusive; and if

(*k*) Cp. *Harrison's Patent*, 1853, Macr. P. C. 31; *Smith's Patent*, 1855, *ibid.* 232, 234; *Tranter's Patent*, 1873, Johns. P. M. 191. For a case

in which a prior infringer was compelled to compound with a patentee, see *Lucas's Patent*, 1854, Macr. P. C. 235.

**Sect. 18.** what he has done is invalid, by reason of sub-sect. (8), whenever anybody attempts to put in force that amendment for any purpose, the Court could say that what the Attorney-General has done has not really altered the original specification. Then the matter must be determined according to the original specification. The amendment would be held to be invalid.

16 *Except in cases of fraud.*—*E.g.*, where leave was given to file a disclaimer on terms refused by the patentee, and the disclaimer was subsequently filed without his consent (*l*).

17 *The foregoing provisions, &c.*—The Act of 1888, sect. 5, from which this new sub-section is taken, has settled several doubts raised by the corresponding sub-section in the Act of 1883 :—

(1) Did the words “legal proceeding in relation to a patent” apply to proceedings before the comptroller? (*m*).

(2) Did they include only actions for infringement and proceedings for revocation? (*n*).

As to the construction of sects. 18—21, see general note above, p. 457.

18 *Pending.*—This means action before judgment in the High Court of Justice. See definition of “Court,” sect. 117, sub-sect. (1), and *Cropper v. Smith*, 28 Ch. D. per Chitty, J., at p. 151.

Power to disclaim part of invention during action, &c.

19. In an action for infringement of a patent,<sup>1</sup> and in a proceeding for revocation<sup>2</sup> of a patent, the Court or a Judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a Judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer,<sup>3</sup> and may direct that in the meantime the trial or hearing of the action shall be postponed.

1 *Action for infringement.*—See sect. 29, and Chap. XIV. p. 245.

2 *Proceeding for revocation.*—See sect. 26, and Chap. XVI. p. 355.

3 *Disclaimer pending action.*—As to disclaimer pending action, see p. 164.

(*l*) *Re Berdan's Patent*, 1875, L. R. 20 Eq. 346.

(*m*) *Cochrane's Patent*, 1885, Griffin, P. O. 305, where the Comptroller-General answered the question in the

negative.

(*n*) *Cropper v. Smith*, 1884, 1 P. O. R. 254; and *In re Hall and others*, 1888, 5 P. O. R. 306.

Only a power of amendment by disclaimer is given under this section. Cp. sect. 18, sub-sect. (1). **Sect. 19.**

As to the construction of the section, cp. above, at p. 457.

Where a request for leave to amend is made in pursuance of an order by the Court or a Judge, an official or verified copy of the order must be left, with the request, at the Patent Office. (Patents Rules, 1890, r. 58, p. 579.)

The judge has an absolute discretion in imposing terms under sect. 19 (o).

**20.** Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.<sup>1</sup> Restriction on recovery of damages.

<sup>1</sup> *Where an amendment by way of disclaimer, &c.*—This section, which is new, does not appear to affect the law officer's power to impose conditions under sect. 18, sub-sects. (4) (7).

**21.** Every amendment of a specification shall be advertised in the prescribed manner. Advertisement of amendment.

*Every amendment, &c.* (sect. 21).—Cp. Patents Rules, 1890, r. 59, p. 579. The amendment is advertised in the Official Journal of the Patent Office, and in such other manner, if any, as the comptroller may direct.

COMPULSORY LICENSES.<sup>1</sup>

**22.** If on the petition of any person interested<sup>2</sup> it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms— Power for Board to order grant of licenses.

(a) The patent is not being worked<sup>3</sup> in the United Kingdom; or

(b) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(o) *Lang v. Whitecross Co.*, 1889, 6 P. O. R. 570.



Sect. 22. (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

P. R. 1890,  
rr. 60—66.

1 *Compulsory licenses*.—As to voluntary licenses and assignments, see Chap. XI., p. 195.

The provisions of this section are new.

For practice under it, see Patents Rules, 1890, rr. 60—66, inclusive.

History  
of the  
compulsory  
license  
clauses.

As to the history of the provisions in this section, see Report of the Commissioners appointed to inquire into the working of the Law relating to Letters Patent for Inventions, 1865, also the Reports of 1871 and 1872.

Committee of  
1865.

The Committee of 1865 reported against compulsory licenses, apparently on two grounds: (1) that the exceptional instances in which patentees were unwilling to grant licenses did not justify a sweeping interference with rights to which law has assigned the character of property; and (2) that the value of a patent and the amount of charge that might reasonably be imposed on persons using it, varied in every instance, and it was impossible to suppose that any system of arbitration would prove satisfactory where neither precedent, nor custom, nor fixed rule of any kind could be appealed to on either side.

Committee of  
1872.

The Select Committee of 1872 recommended the insertion of a compulsory license clause in the letters patent, thus investing the Crown with the same right which the Judicial Committee exercised in recommending the extension of a subsisting grant.

Results of  
compulsory  
license clause.

This section has not justified the hopes of its framers, and bears out the report of the Committee of 1865. It has been practically inoperative, and very few applications have been made under it to the Board of Trade, and no order has been made in any case for a compulsory license.

Up to the end of the year 1887 there was only one informal application for a compulsory license, which was subsequently, by leave of the Board of Trade, withdrawn. In 1888, there was one application. It may be, however, that in some cases these provisions induce patentees to grant licenses rather than be forced to appear before the Board of Trade.

This section does not apply to patents granted, or applications **Sect. 22.** pending, *before* the commencement of this Act (sect. 45, sub-s. (2)); but it applies to a new patent granted after the Act by way of extension of the term of an existing patent (*m*). Scope of section.

No appeal is given from the decision of the Board of Trade; but as the order of the Board is enforced by mandamus, which, being a prerogative writ, may be disputed before the Courts of law, the patentee has practically a right of appeal. An unsuccessful applicant, however, has no remedy.

**2** *Petition.*—See Forms H, and H1, and I, *infra*, pp. 743, 744.

**3** *Working of patent in the United Kingdom.*—According to English law, it has always been considered to be a user if the patented invention is in use in the United Kingdom though the actual articles were imported from abroad, and it does not appear to have been the intention of the Legislature, by section 22 of the present Act, to compel the actual manufacture of patented articles in England. If it could be shown that the patented article had been imported into this country by the patentee in sufficient quantities, so that the public can be supplied at reasonable rates, he would not be held to be in default within the meaning of sect. 22. It is thought that an applicant for a compulsory license could successfully lodge a petition according to any one of the sub-sects. (a) (b) (c), without having to bring himself in any way within the other two. Meaning of working.

#### REGISTER OF PATENTS.

**23.** (1.) There shall be kept at the Patent Office a book called the Register of Patents,<sup>1</sup> wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed. Register of patents.

(2.) The register of patents shall be *primâ facie* evidence<sup>2</sup> of any matters by this Act directed or authorized to be inserted therein.

(3.) Copies of<sup>3</sup> deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in

(*m*) *Wastenev Smith's Patent*, 1885, 2 P. O. R. 14.

Sect. 23. any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

1 *Register of patents.*—See Chap. XII., p. 207.

As to register of patent agents, see p. 526.

Inspection of and extracts from register, sect. 88.

Falsification of register, sect. 93.

Powers of Board of Trade over, sect. 101, sub-s. (1 a).

Under the Act of 1852 (ss. 34 and 35, see *infra*, pp. 658, 659), there were two registers—(1) a register of patents, in which were recorded all matters and things affecting the *validity* of the patents, such as grants, deposits, and filing of certificates, disclaimers, payment of renewal fees, sealing of new patents under order for extension by Privy Council, &c.; and (2) a register of proprietors, in which were recorded all assignments, licenses, and other matters relating to the *proprietaryship* of the patents. The principal changes in the old practice, made under the present Act, are these:—

1. There is now *one* register of patents, of which the former registers are deemed parts (sect. 23, sub-s. (1), and sect. 114, sub-s. (1)).

2. Instead of the documents above referred to being themselves entered, as formerly was the case with the register of proprietors, the *names and addresses* only of grantees, and notifications only of assignments, &c., are now recorded (sect. 23, sub-s. (1)). Copies of the documents registered are, however, left at the Patent Office, and may be inspected there and copies obtained.

3. Formerly documents conferring merely *equitable* interests in patents might be recorded in the register of proprietors, but it is conceived that under sects. 85 and 87, the documents, notification of which may now be entered on the register, must confer a legal interest.

Documents signed or executed between the date of application and the date of actually sealing the patent, will be registered under the same conditions as if entered into after sealing; but it is not the practice at the Patent Office for the comptroller to register any document bearing date before the nominal date of sealing of the patent, that is, before the date of application, though how far this is a proper construction of this section is doubtful. It appears that there may be documents dated before the date of sealing which ought to be entered on the register. I do not think it necessary, said North, J., in *Re Parnell's Patent* (n), to decide, and in deciding I should feel some

(n) 1888, 5 P. O. R. p. 126.

little difficulty, whether the comptroller is entitled to refuse, and whether it is his duty to refuse, to enter on the register any notice of title derived through a document that bore date before the taking out of the letters patent, instead of being dated after them. I feel a difficulty in deciding that point for this reason, that it is very easy to imagine a document executed immediately before the letters patent were issued so clear and so precise as to leave no doubt whatever as to the proposed patent referred to in it, and so clear that if it had been dated immediately after the grant of the letters patent instead of immediately before, the right of the applicant to be registered in respect of it would be perfectly clear also. I decline to lay down absolutely that no document executed before the grant of the letters patent can be entered on the register, though I see that there may be very forcible objections made to the entry of such documents, and that to a great many documents those objections would be insuperable; but I see that there may be documents as to which this objection might not apply, and that is the reason why I decline to lay down a general rule of universal application.

See sects. 87 and 90, *infra*; Patents Rules, 1890, rr. 67—79, and notes thereon, *infra*, pp. 581—584.

**2** *Prima facie evidence.*—The registration of a document is *prima facie* evidence that it is a proper document to be registered, but is not, in itself, notice to all the world of everything contained therein (*n*).

**3** *Copies of deeds, &c.*—As to size of documents, see Patents Rules, 1890, rr. 10, 30—33, pp. 562, 570—572.

Copies of  
deeds, &c.

## FEES.

**24.** (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees<sup>1</sup> in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade;<sup>2</sup> and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

Fees in  
schedule.

(*n*) *Heap v. Hartley*, 1888, 5 P. O. R., per Bristowe, V.-C. at p. 609. This point was not considered on appeal: 1889, 6 P. O. R. 495.

**Sect. 24.** (2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

1 *Fees.*—See list of fees, *infra*, p. 586.

2 *The Board of Trade.*—See note to sect. 22, at p. 462.

#### EXTENSION OF TERM OF PATENT.<sup>1</sup>

Extension of term of patent on petition to Queen in Council.

**25.** (1.) A patentee<sup>2</sup> may, after advertising<sup>3</sup> in manner directed by any rules made under this section<sup>4</sup> his intention to do so, present a petition<sup>5</sup> to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months<sup>6</sup> before the time limited for the expiration of the patent.

(2.) Any person<sup>7</sup> may enter a caveat,<sup>8</sup> addressed to the registrar of the council at the council office, against the extension.

(3.) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same,<sup>9</sup> and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel<sup>10</sup> on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public,<sup>11</sup> to the profits made by the patentee as such,<sup>12</sup> and to all the circumstances of the case.<sup>13</sup>

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent<sup>14</sup> for a further term not exceeding seven, or in exceptional cases fourteen,<sup>15</sup> years; or to order the grant of a new patent<sup>16</sup> for the term therein mentioned, and containing any restrictions,

conditions, and provisions that the Judicial Committee Sect. 25.  
may think fit.<sup>17</sup>

(6.) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.<sup>18</sup>

(7.) The costs<sup>19</sup> of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice. Costs.

1 As to prolongation or extension of patents generally, see Chap. XVIII. pp. 373—403.

This section practically re-enacts the practice and procedure which existed in the Privy Council before the Act of 1883.

It seems as if the operation of this section were suspended till the end of 1897 because of the saving effect of section 113. See also *Brandon's Patent* (q), and the remarks on p. 378. But the matter is of small importance, because, as above stated, this section makes very little change in the law, if any, beyond the provision as to presenting the petition for extension at least six months before the expiration of the patent.

## 2 *A patentee* :

This includes the person for the time being entitled to the benefit of a patent (sect. 46); a petition may therefore be presented by an assignee, executor, or administrator. Meaning of  
"patentee."

Where a patent is mortgaged, the mortgagee ought to be made a party to the petition. In a recent case, however (r), it was held that the absence of the mortgagee, though an irregularity, was not fatal, the parties having agreed to insert his name in the extended patent, so as to give him the same security as formerly.

The legal personal representative of a deceased patentee ought to be made a party to a petition for extension of a patent dealt with otherwise than by assignment (s).

(q) 1884, 1 P. O. R. 154. (s) *In re Willacy's Patent*, 1888, 5  
(r) *In re Church's Patent*, 1886, 3 P. O. R. 690.  
P. O. R. at p. 100.

**Sect. 25.**     **3** *After advertising.*—See form of advertisement, p. 812; affidavit of advertisement, p. 814.

The advertisement.

The advertisement must be proved before the application is heard (*t*).

In the matter of *Derosne's Patent* (*u*), the petitioner resided in France, but had granted licenses to persons resident and carrying on business in London and Liverpool, and caused advertisements to be inserted in the *Gazette* and newspapers published in those places. It was held that this was a sufficient compliance with 5 & 6 Will. IV. c. 83, s. 4.

Rules.

**4** *Rules made under this section.*—No such rules have yet been made. Those, accordingly, which were made in pursuance of 5 & 6 Will. IV. c. 83, are still in force. See below, p. 594.

The petition.

**5** *The petition.*—See forms of petition, *infra*, pp. 816, 817.

A grant of new letters patent being a matter of grace and not of right, a petitioner is bound to strict truth and to the utmost candour and frankness, to *uberrima fides*, in his statement to the Crown (*v*); and the rule has again and again been laid down that where a patentee, whether English or foreign, has obtained foreign patents, there should be a full statement of these in the petition (*w*).

Time of presentation.

**6** *At least six months:*

Under 5 & 6 Will. IV. c. 83.

Under 5 & 6 Will. IV. c. 83, s. 4, the law was that any application by petition for the prolongation of letters patent *must be made and prosecuted with effect* before the expiration of the term originally granted.

Under 2 & 3 Vict. c. 67, s. 2.

2 & 3 Vict. c. 67, s. 2 (*x*), provided that where the failure to comply with the requirement of the earlier statute was shown not to have arisen from the neglect or default of the petitioner, the term of letters patent might be extended, if a petition had been presented to the Judicial Committee six calendar months at least before the expiration of the original term.

Under Act of 1852.

The Patent Law Amendment Act, 1852, s. 40, adopted the provisions of the above mentioned Acts in regard to the extension of letters patent.

In the matter of *Macintosh's Patent* (*y*), a petition was lodged 16th January, 1836, and on the usual application being made shortly afterwards for an early day to be fixed for the hearing, the Judicial Com-

(*t*) *Perkins' Patent*, 1845, 2 Web. P. C. 8.

(*u*) 1844, 2 Web. P. C. 1.

(*v*) *Clark's Patent*, 1870, L. R. 3 P. C. 421.

(*w*) *Pitman's Patent*, 1871, L. R. 4 P. C. 84; *Johnson's Patent*, 1871,

L. R. 4 P. C. 82; *Adair's Patent*, 1881, L. R. 6 A. C. 176.

(*x*) This enactment was passed in consequence of the decision under 5 & 6 Will. 4, c. 83, s. 4, in *Bodmer's Patent*, 1838-40, 2 Moo. P. C. C. 471.

(*y*) 1837, 1 Web. P. C. 739, n.

mittee intimated that as the English patent did not expire till the 17th of June, 1837, the profits accruing in the meantime might materially affect the question of extension, and the application had better stand over for the present. Sect. 25.

By sect. 113 (a), the right of the owner of a patent, existing at the date when the present Act came into operation, is saved. He may, therefore, apply for prolongation at any time before the expiration of the original term (z). Saving of existing rights.

7 *Any person.*—There is no limitation on the right of opposition to the extension of a patent. Cp. *supra*, sect. 11, sub-ss. (1), (3); sect. 18, sub-ss. (2), (4). Who may oppose.

The Crown may adduce evidence against a patent, irrespective of the objections (a), and in *Erard's Patent* (b)—the first application under 5 & 6 Will. IV. c. 83—the Judicial Committee intimated that in all cases of unopposed applications the Attorney-General should attend on the part of the Crown. The Crown.

In *Re Baxter's Patent* (c), the extension of a patent was unsuccessfully opposed by two apprentices, who alleged that they expected to be able to practise the invention on the expiry of the patent, and that they had not been taught any other trade.

8 *Caveat.*—See form of caveat, p. 813; form of notice of objection, p. 837. The caveat.

It appears that the *caveat* must be entered by the actual opponent and not by a patent agent (d).

The present Act, like the repealed Acts, 5 & 6 Will. IV. c. 83, and 2 & 3 Vict. c. 67 (e), does not require particulars of objections in extension cases, but in the matter of *Stewart's Patent* (f), where the opposition succeeded upon the ground of an anticipation not mentioned in the objections, the opponent's costs were disallowed. Particulars of objection.

9 *The said Committee shall proceed to consider.*—By sect. 28, sub-s. (2), the Judicial Committee may call in the aid of an assessor, and determine his remuneration. Judicial Committee.

The books of account produced by a patentee will be *minutely* examined by the Judicial Committee (g). See form of accounts, *infra*, p. 821.

(z) *In re Brandon's Patent*, 1884, 1 P. O. R. 154.

(a) *Church's Patent*, 1886, 3 P. O. R. at p. 101; citing *Re Bull's Patent*, 1879, L. R. 4 A. C. 173.

(b) 1835, 1 Web. P. C. 557.

(c) 1849, 13 Jur. 593.

(d) *Lowe's Patent*, 1852, 8 Moo. P. C. 1.

(e) *Bull's Patent*, 1879, L. R. 4 A. C. 171.

(f) 1886, 3 P. O. R. 7.

(g) *Perkins' Patent*, 1845, 2 Web. P. C. 6.



**Sect. 25. 10 *By counsel:***

Counsel.

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose (*h*).

Position of Attorney-General.

In all petitions for the extension of letters patent, whether opposed or not, the Attorney-General attends on behalf of the Crown (*i*); and he so far represents the government and the public generally, that a government department who had not entered a caveat in time were not allowed, the Attorney-General being present, to enter a caveat and be heard in opposition (*j*).

Nature and merits of invention.

**11 *The nature and merits of the invention in relation to the public.*—**On this subject, see Chap. XVIII. p. 389.

It is not the habit of the Judicial Committee in considering petitions for extension to determine the validity or invalidity of a patent. They leave that question to the ordinary Court of law.

What they do consider is not whether there is sufficient novelty to sustain the patent, but whether the novelty constitutes *that exceptional merit* which justifies an extension (*k*).

Of course, a patent which is clearly bad will not be prolonged (*l*).

Where only *part* of an invention was shown to possess utility, and the accounts as to that part were defective, the Judicial Committee refused an extension (*m*).

Profits of patentee.

**12 *To the profits made by the patentee as such.*—**The Judicial Committee is entitled to look to what has been received by way of profit on the invention in foreign countries (*n*).

Accounts.

Under the Judicial Committee Rules, r. 9, a party applying for an extension of a patent must lodge at the Council Office, at least *one week* before the day fixed for hearing the application, certain copies (*vide infra*, p. 592) of the specification, and of the balance sheet of expenditure and receipts relating to the patent in question. This rule is imperative, and all deductions which the petitioner claims to make from his profits must be set forth in the accounts submitted (*o*).

In a recent case, *Re Yates and Kellett's Patent* (*p*), the petitioner

(*h*) *In re Woodcroft's Patent*, 1841, 3 Moo. P. C. 172, n.

(*i*) *In re Erurd's Patent*, 1835, 1 Web. P. C. 557.

(*j*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133.

(*k*) *In re Stewart*, 1886, 3 P. O. R. 9, 10; cp. also *In re Bailey's Patent*, 1884, 1 P. O. R. 1; *Re Cocking's Patent*, 1885, 2 P. O. R. 151, 153; also citing *Saxby's Patent*, L. R. 3 F. C. App. 294; *Beauland's Patent*, 1887, 4 P. O. R. 491.

(*l*) *Erard's Patent*, 1835, 1 Web. P. C. 557; *Woodcroft's Patent*, 1846, 2 Web. P. C. 18; *Pinkus' Patent*, 1848, 12 Jur. 233; *Saxby's Patent*, 1870, L. R. 3 P. C. 292.

(*m*) *In re Willacy's Patent*, 1888, 5 P. O. R. 690.

(*n*) *In re Newton's Patent*, 1884, 1 P. O. R. 177.

(*o*) *In re Bailey's Patent*, 1884, 1 P. O. R. 1.

(*p*) 1887, 4 P. O. R. 150; cp. *Johnson's and Atkinson's Patents*, 1873, L. R. 5 P. C. 87.

failed to file his accounts within the time fixed by the Judicial Committee Rules, r. 9. The accounts, when lodged, were insufficient. The petitioner then applied for an adjournment, in order to supplement them, but the Judicial Committee refused the application, and dismissed the petition.

Where patent rights have been transferred either in whole or in part to a company, it is essential that there should be deposited not only the patentee's account of his profits, but, in order to test them, the accounts also of the profits of the company to whom the patentee has transferred his patent (*q*).

The *onus* is upon the petitioner to satisfy the Committee that when all circumstances are considered his remuneration has been less than he is equitably entitled to. No one but himself is in a condition to state the whole account, and it is important to have it distinctly understood that the most unreserved and clear statement is an indispensable condition to the success of a petition (*r*).

Onus is on petitioner.

It is the duty of a patentee to keep from the first a patent account distinct and separate from any other business in which he may be engaged (*s*).

Duty to keep patent account.

In estimating a patentee's expenditure, the Judicial Committee may take account of (a) the *reasonable* cost of working the patent (*t*); (b) the value of the patentee's *time* properly expended upon working his invention (*u*); (c) exceptional loss by litigation (*x*); and (d) manufacturer's profits *not due to the monopoly conferred by the patent* (*y*).

On the other hand, if but for the patent there would have been no manufactory, and the patentee is also a manufacturer, then the net profits of the manufacturer are attributable to the patent, and cannot be deducted (*z*).

**13** *All the circumstances of the case.*—The following is a summary of the considerations which guide the committee:—

Considerations which guide committee.

Has the petitioner been prevented by causes beyond his control

(*q*) *In the Matter of Deacon's Patent*, 1887, 4 P. O. R. 122.

(*r*) *Hills' Patent*, 1868, 1 Moo. P. C. N. S. 258; *Saxby's Patent*, 1870, L. R. 3 P. C. 292; *Adair's Patent*, 1881, L. R. 6 A. C. 176.

(*s*) *Bett's Patent*, 1862, 1 Moo. P. C. N. S. 49; *Trotman's Patent*, 1866, L. R. 1 P. C. 118.

(*t*) *Roberts's Patent*, 1839, 1 Web. P. C. 573. See, however, the limitations to the proposition in *Clark's Patent*, 1870, L. R. 3 P. C. 421, per James, L. J.

(*u*) *Roberts's Patent*, *ubi sup.*; *Trotman's Patent*, 1866, L. R. 1 P. C. 118; *Carr's Patent*, 1873, L. R. 4 P. C. 539.

(*x*) *Kay's Patent*, 1839, 1 Web. P. C. 568; *Roberts's Patent*, *ubi supra*; *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133; *Heath's Patent*, 1853, 2 Web. P. C. 247.

(*y*) *Galloway's Patent*, 1843, 1 Web. P. C. 724; *Muntz's Patent*, 1846, 2 Web. P. C. 113.

(*z*) *Saxby's Patent*, 1870, L. R. 3 P. C. 292; *cp. also Hills' Patent*, 1863, 1 Moo. P. C. N. S. 258.

**Sect. 25.** from deriving an adequate remuneration from the working of his patent? (*a*).

Does the invention possess *exceptional merit*, *i.e.*, such novelty or utility as will justify the committee in advising an extension?

“We are here,” said Lord Brougham, in *Perkins’ Patent* (*b*), “by the authority of the Legislature, given to us to advise the Queen, to protect her from rashly and inexpediently for the public granting an extension, which formerly used to require a solemn and deliberate act of all the three branches of the Legislature, involving a double inquiry, together with an opinion of the government itself.”

Each case is dealt with on its own merits; and the only general rule which can be laid down is a negative one, *viz.*, that the novelty and utility which might support an original, may be insufficient to justify an extended grant of letters patent (*c*).

Has the introduction of the patent been slow? If so, was this to be expected from its nature and the circumstances of the case (*d*), or is it in evidence of want of utility? (*e*). If not, has not the patentee been adequately remunerated?

Is the public interest opposed to an extension? (*f*).

14 *To extend the terms of the patent—or part of it* (*g*).

15 *Or in exceptional cases fourteen years.*—This is a re-enactment of 7 & 8 Vict. c. 69, s. 2. An invention may be said to fall under the description of “exceptional,” when it appeals only to a small number of minds, is used only in a small number of cases, and requires a considerable outlay (*h*).

16 The practice is to order new letters patent to be sealed by the comptroller-general with the seal of the Patent Office, and the date of the new patent will be the date following the day of expiration of the old patent; in this way, without overlapping, the patent right is continuously preserved, and the patentee has the full benefit of the exten-

(*a*) Cp. *Southworth’s Patent*, 1837, 1 Web. P. C. 486; *Downton’s Patent*, 1839, 1 Web. P. C. 565; *Norton’s Patent*, 1863, 1 Moo. P. C. N. S. 339; *Trotman’s Patent*, 1866, L. R. 1 P. C. 118; *Sillar’s Patent*, 1882, 1 Goodeve, P. C. 582.

(*b*) 1845, 2 Web. P. C. 6.

(*c*) *Vide supra*, p. 382.

(*d*) *Woodcroft’s Patent*, 1846, 2 Web. P. C. 18; *Carr’s Patent*, 1873, L. R. 4 P. C. 539.

(*e*) *Simister’s Patent*, 1842, 4 Moo. P. C. C. 164; *Pinkus’ Patent*, 1848, 12 Jur. 233; *Bakewell’s Patent*, 1862, 15 Moo. P. C. C. 385; *Norton’s Pa-*

*tent, ubi supra*; *Allan’s Patent*, 1867, L. R. 1 P. C. 507; *Herbert’s Patent*, 1867, L. R. 1 P. C. 399; *Hughes’ Patent*, 1879, L. R. 4 A. C. 174.

(*f*) *Cardwell’s Patent*, 1856, 10 Moo. P. C. C. 488; *McInnes’s Patent*, 1868, L. C. 2 P. C. 54; *Sillar’s Patent*, 1882, *ubi supra*.

(*g*) *Bodmer’s Patent*, 1853, 8 Moo. P. C. C. 282; *Lee’s Patent*, 1856, 10 Moo. P. C. C. 226; *Napier’s Patent*, 1881, L. R. 6 A. C. 174; *Church’s Patent*, 1886, 3 P. O. R. 102.

(*h*) *In re Stoney’s Patent*, 1888, 5 P. O. R. 523.

sion. The form of such letters patent is settled by the Order in Council prolonging the patent, and is different from the common form set out in the schedule to the Act of 1883. The recitals will be different (*i*), and as the patents, which are prolonged under the Act of 1883, will be, for some years to come, patents granted under the Act of 1852, the general form of the letters patent will follow the precedent in use under that Act. Thus, the Channel Islands, though not now included in an ordinary grant, will be properly included in new letters patent granted, or prolongation by Privy Council of patents granted under the Act of 1852. Sect. 25.

The Order in Council prolonging the term of the patent privilege must be registered in the Register of Patents, and a copy of the new letters patent should be filed, and a record thereof put upon the register. It would seem that a copy of the Order in Council ought also to be filed, but this does not seem to have been the practice.

A form of the Order in Council is given in Appendix, p. 838.

It is customary to mark the register in red ink where a patent is extended with words "extended for — years." The volume of the register is ordinarily kept for twenty-one years after date of the latest patent registered therein, but when any patent in a volume of the register has been extended, the volume is kept for seven years after the expiration of the extended patent. See also p. 213.

**17** *Containing any restrictions, conditions and provisions, &c.*—In the event of an extension being granted to an assignee, the Judicial Committee generally require some advantage to be secured to the inventor or his family (*j*).

A condition to the effect that contractors for her Majesty's service should be at liberty to manufacture and use the invention upon terms, has sometimes been imposed (*k*).

A condition requiring the patentee to grant licences to the public, was inserted in *Mallet's Patent* (*l*); but see sect. 22 of the present Act.

In *Hardy's Patent* (*m*), a condition to prevent the price of the articles patented, viz., iron axletrees for railway carriages, being raised out of proportion to the price of the raw material, was imposed.

**18** *Rules of procedure and practice.*—No rules have yet been made. For the old rules still in force, see p. 594. Rules of practice.

(*i*) See Form in Appendix, p. 839.

(*j*) *Whitehouse's Patent* (quoted as *Russell's Patent*, 2 Moo. P. C. C. 496), 1838, 1 Web. P. C. 473; *Markwick's Patent*, 1860, 13 Moo. P. C. C. 310; *Poole's Patent*, 1867, L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452; *Pitman's Patent*, 1871, L. R. 4 P. C. 84.

(*k*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133; *Hughes' Patent*, 1879, L. R. 4 A. C. 174; *Napier's Patent*, 1881, L. R. 6 A. C. 174.

(*l*) 1866, L. R. 1 P. C. 308.

(*m*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441.

**Sect. 25.** 19 *Costs*.—Where there was ground for opposition, and the case was doubtful and difficult, the Judicial Committee made no order as to costs (*n*).

It is unnecessary for opponents to give notice of their intention to apply for costs (*o*), and these will, in general, follow a successful opposition (*p*).

In *Wield's Patent* (*q*), Sir J. W. Colville said, "Their Lordships are inclined to adhere to the rule that has been laid down, almost from the first application under the Act giving them jurisdiction in patent cases, that in the exercise of their power to grant costs, it is certainly not desirable to refuse the costs of a fair opposition, since it is rather in the interest of this tribunal to encourage *bond fide* oppositions, in order that the Court may be put in possession of all that can be alleged against the continuance of the patent."

On the *abandonment* of an application for extension, the practice has been to direct that the costs of the opposition should be taxed by the registrar of the Privy Council, and paid by the petitioner (*r*). In *Milner's Patent* (*s*), an alternative was offered to the petitioner of paying a fixed sum for costs.

A *vexatious* opposition will be punished with costs (*t*).

Where the extension of a patent is opposed by several opponents, and refused, the usual order is that the costs should be distributed by the registrar among the several opponents, unless the petitioner prefer taxation (*u*).

In *Johnson's Patent* (*u*), a lump sum for costs was given to two opponents, who both represented the same kind of opposition; and this seems to be the more common rule now.

#### REVOCATION.

Revocation of patent.

**26.** (1.) The proceeding by scire facias<sup>1</sup> to repeal a patent is hereby abolished.

Petition.

(2.) Revocation<sup>2</sup> of a patent<sup>3</sup> may be obtained on petition<sup>4</sup> to the Court.<sup>5</sup>

(3.) Every ground<sup>6</sup> on which a patent might, at the

(*n*) *Church's Patent*, 1886, 3 P. O. R. at p. 102.

(*o*) *Bridson's Patent*, 1852, 7 Moo. P. C. C. 499.

(*p*) *Westrupp and Gibbins' Patent*, 1836, 1 Web. P. C. 554.

(*q*) 1871, L. R. 4 P. C. 89.

(*r*) *Hornby's Patent*, 1853, 7 Moo. P. C. C. 503.

(*s*) 1854, 9 Moo. P. C. C. 39.

(*t*) *Downton's Patent*, 1839, 1 Web. P. C. 565.

(*u*) *Johnson's Patent*, 1871, L. R. 4 P. C. 75; *Wield's Patent*, 1871, L. R.

4 P. C. 89; *Jones' Patent*, 1854, 9 Moo. P. C. C. 41; *Bovill's Patent*,

1863, 1 Moo. P. C. N. S. 348.

commencement of this Act, be repealed by scire facias shall be available by way of defence to an action of infringement and shall also be a ground of revocation. Sect. 26.

(4.) A petition for revocation of a patent may be presented by—

(a) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

(b) Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :<sup>7</sup>

(c) Any person<sup>8</sup> alleging that the patent was obtained in fraud of his rights,<sup>9</sup> or of the rights of any person under or through whom he claims :

(d) Any person<sup>8</sup> alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :

(e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections<sup>10</sup> on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered. Particulars  
of objections.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a judge. Amendment  
of particulars.

(7.) The defendant shall be entitled to begin,<sup>11</sup> and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the

**Sect. 26.** true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

1 *Scire facias*.—See Chap. XVI., p. 355.

2 *Revocation*.—See Chap. XVI., p. 360.

For order of revocation, see p. 811.

For order dismissing petition, see p. 812.

Revocation in Scotland.

A petition for revocation becomes in Scotland “an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.” (Sect. 109, sub-s. (1), *infra*.)

“Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.” (*Ibid.*, sub-s. (2).)

Patent.

3 *Patent*.—As the term “patent” means “letters patent for inventions” (sect. 46), having “effect throughout the United Kingdom and the Isle of Man” (sect. 16), it seems that a revocation for the whole United Kingdom and the Isle of Man can be obtained in any one of the Courts—as defined below—of the three kingdoms.

Petition.

4 *On petition*.—See forms of petition, *infra*, pp. 809, 810.

A patent may also be repealed by the Sovereign on proof before any six members of the Privy Council that it is contrary to law, or prejudicial, or inconvenient to the public, or not new, or not invented by the patentee. It was probably under this power, which has always been inserted as a proviso in letters patent (*x*), that Queen Elizabeth recalled the letters patent for monopolies which provoked the remonstrance of the House of Commons repeatedly during her reign; but there is no modern instance of its exercise (*y*).

Court.

5 *The Court*.—“Court” means, in England, the High Court of Justice for England (sect. 117, sub-s. (1)); in Scotland, the Court of Session (sect. 111, sub-s. (1)); and in Ireland, the High Court of Justice for Ireland (sect. 117, sub-s. (1)).

(*x*) See Form of Patent, *infra*, p. 532.      (*y*) Hindmarch, p. 431.

6 *Grounds of scire facias*.—An action of *scire facias* lay in three cases (z):— **Sect. 26.**

Grounds of *scire facias* still available.

Where the King by his letters patent had granted the self-same thing to several persons, the first patentee had a *scire facias* to repeal the second grant.

When the grant had been made upon a false suggestion, the King might *jure regio* repeal his own grant.

When the King had granted anything which by law he could not grant, he *jure regio* (for the advancement of justice and right) might have a *scire facias* to repeal his own letters patent.

“The proceedings,” says Mr. Webster (a), “may be instituted on the grounds of fraud, false suggestion, non-compliance on the part of the patentee with the condition of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent.”

7 *Authorization of petition* :

When it is desired to obtain the Attorney-General’s authority under this sub-section, it is necessary to send the following papers to the Patent Clerk, at Room 519, Royal Courts of Justice, London:— **Attorney-General’s authority, how obtained.**

Memorial to the Attorney-General, asking for his authority, and stating all the circumstances.

Statutory declaration verifying the statements in the memorial.

Two copies of the proposed petition, and of the particulars proposed to be delivered with it under sect. 26, sub-s. (5).

Certificate of a barrister that the petition is proper to be authorized by the Attorney-General.

Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition, if unsuccessful.

The Attorney-General sometimes gives or refuses his authority *ex parte*.

In some cases he directs notice to be given to the patentee, and directs the parties to be heard before him.

8 *Any person* :

A petition for revocation cannot be presented under clauses (c) and (d) of this sub-section by an attorney under a power; for the person alleging fraud upon his rights, and all persons beneficially interested in the patent, are necessary parties (b).

A petitioner, qualified in the manner indicated in (c), (d), (e), may impeach a patent *upon any lawful ground*. Thus, a petitioner, alleging prior manufacture, user and sale, may put forward other objections to

(z) 4 Inst. 88.

(b) *Re Avery’s Patent*, 1887, 4 P. O.

(a) Letters Patent for Invention, R. 158, 159; L. R. 36 Ch. D. 307.



**Sect. 26.**

Jurisdiction to repeal patent in England where patentee domiciled Scotchman.

a patent, such as variance, or that the invention was not proper subject-matter (*a*).

In *Drummond's Patent (b)*, F. & Co. presented a petition for the revocation of D.'s patent. D. was a domiciled Scotchman resident in Scotland. A copy of the petition and of the particulars of objections were delivered to him personally in Scotland. He then wrote to the petitioner's solicitors, stating that he did not intend to appear at the hearing of the petition, as he was not subject to the jurisdiction of the English Court. The petitioners applied for directions as to the hearing of the petition, and that it might be heard with witnesses and put down in the witness list. The Court made an order that that course should be adopted, unless by a certain day, of which notice was to be given to D., he should appear and show cause to the contrary, it being open to him if he appeared to dispute the jurisdiction.

Fraud of petitioner's rights.

**9** *In fraud of his rights :*

An act done by an agent under an honest mistake, even though it may cause loss to the principal, is not an act done in fraud of the principal's rights.

To be in fraud of his rights it must be either done with the intention of depriving, or insisted on so as to deprive, the principal of his rights (*c*).

**10** *Particulars of objections.*—See notes to sect. 29, sub-sects. (2)—(5); and see Chap. XV., p. 366.

**11** *The defendant shall be entitled to begin.*—See note to sub-s. (1) of this section. This is a re-enactment of a proviso in the Patent Law Amendment Act, 1852, s. 41.

Subject to sub-sects. (5), (6) and (7), the new Act leaves the practice to be governed by the ordinary practice upon a petition to the High Court. "Plaintiff," in the R. S. C. Ord. XXXI. r. 1, means "petitioner," and that rule applies to petitions for the revocation of a patent (*d*).

CROWN.

Patent to bind Crown.

**27.** (1.) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.<sup>1</sup>

(*a*) *In the Matter of Morgan's Patent*, 1888, 5 P. O. R. 187.

(*b*) 1889, 6 P. O. R. 576; L. R. 43 Ch. D. 80.

(*c*) *Re Avery's Patent*, 1887, 4 P. O. R. p. 327; L. R. 36 Ch. D. 307.

(*d*) *Haddan's Patent*, 1884-5, 54 L. J. Ch. 126; Griffin, P. C. 109.

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury,<sup>2</sup> between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested. Sect. 27.

1 These sub-sections do not apply to patents granted before the commencement of this Act, or upon applications then pending (*e*). Such patents are, therefore, subject to the former law, which it may be interesting to trace. Effect of grant of patent on Crown.

By the theory of the law, the Crown was not bound to grant a patent to any person for a new invention, however valuable, and it was a consequence of the power to withhold a patent altogether that the Crown might make a grant subject to such qualifications as it deemed right; and those qualifications were introduced into each patent according to the discretion of the Attorney-General for the time being. The form generally used was the following proviso: "If the patentee, his executors, &c., shall not supply or cause to be supplied for our service *all such articles of the said invention* as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then the patent shall be void" (*f*). Former law.

Now this proviso had one grave defect (*g*)—

It dealt merely *with the use of patented articles*, and was assumed not to give the Crown the power of using, upon terms, *patented processes*. The result was that *patents for processes* were taken out in the most vague and general terms, not with any view to use by private individuals, but simply in the hope that some improvement, proposed by a public department, would be found to constitute an infringement of the patented process, and that then the patentee might obtain substantial damages or compensation. Defects of old proviso.

(*e*) Sect. 45, sub-s. (2).

(*f*) Cp. Report of the Patent Commissioners, 1865, p. 131; also Hindmarch, p. 71.

(*g*) *Ibid.*, Evidence of the Duke of Somerset, First Lord of the Admiralty, and Rear-Admiral R. S. Robinson, pp. 127—133.

**Sect. 27.** It was suggested that a clause should be inserted in the customary proviso, empowering the officers of any public department to require a patentee to grant *a licence for the use of his patent*; but the decision in *Feather v. Reg. (h)*, that the Crown has, independent of any proviso, the right *to use a patented invention*, seems to have met the difficulty.

**Contractors.** In the form of letters patent now in use, the old proviso is retained. In *Dixon v. London Small Arms Co. (i)*, it was held that the doctrine of *Feather v. Reg. (h)* did not extend to *contractors* for the public service, a decision which still holds good in the case of those patents to which sub-s. (2) of sect. 27 does not apply.

2 *With the approval of the Treasury.*—This clause is in accordance with a recommendation made by the Commission of 1865 (*k*).

#### LEGAL PROCEEDINGS.

Hearing with  
assessor.

**28.** (1.) In an action or proceeding for infringement<sup>1</sup> or revocation<sup>2</sup> of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified,<sup>3</sup> and try and hear the case<sup>4</sup> wholly or partially with his assistance; the action shall be tried without a jury<sup>5</sup> unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.<sup>6</sup>

1 See action of infringement, at p. 245.

2 See revocation of patents, p. 355.

3 *An assessor specially qualified, &c.:*

This power of calling in an assessor has been very rarely exercised.

(*h*) 1865, 35 L. J. Q. B. 200; 6 B. & S. 257.

(*i*) 1875-76, L. R. 1 App. Cas. 632.  
(*k*) Report, &c., 1865, IX.

Scientific  
assessors.

This provision is new, is a development of a similar power conferred by 15 & 16 Vict. c. 83, s. 8, upon the law officer dealing with the sufficiency of a provisional specification, and was enacted in accordance with the recommendations of successive Parliamentary Commissions (*l*).

The power to summon an expert assessor, conferred by this section, has been exercised in Scotland but not in England.

As to power of law officer to summon scientific assessors, see sect. 11, sub-sect. 4.

**4** *Shall try and hear the case.*—It is thought that this clause deprives the Court of the right to remit an action of infringement, although involving a prolonged scientific examination (*m*), to an official referee.

**5** *And the action shall be tried without a jury.*—The reasons why patent cases should be tried without a jury were well summarised by Lord Selborne, L. C., in *Patent Marine Inventions Co. v. Chadburn* (*n*). See p. 313.

Trial without a jury, why advisable.

**6** *Expenses incurred in execution of Act,* see sect. 83, sub-sect. 2.

**29.** (1.) In an action for infringement of a patent<sup>1</sup> the plaintiff<sup>2</sup> must deliver with his statement of claim,<sup>3</sup> or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.<sup>4</sup>

Delivery of particulars.

(2.) The defendant<sup>5</sup> must deliver with his statement of defence,<sup>6</sup> or, by order of the Court or a judge, at any subsequent time, particulars of any objections<sup>7</sup> on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.<sup>8</sup>

(*l*) See Reports of 1851 and 1865, *passim*.

(*m*) Cf. Judicature Act, 1873, s. 57.  
(*n*) 1873, L. R. 16 Eq. 447.

**Sect. 29.** (5.) Particulars delivered may be from time to time amended,<sup>9</sup> by leave of the Court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs<sup>10</sup> in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.<sup>11</sup>

1 *Action for infringement.*—See Chap. XIV. p. 245.

2 *The plaintiff.*—As to who may or should be plaintiffs, see *supra*, p. 254.

Statement of claim.

3 *Statement of claim.*—The subject is treated of under “Action of Infringement,” at p. 280.

For forms of statement of claim, see Appendix, pp. 782—784.

The form of statement of claim for the infringement of a patent, prescribed by the R. S. C. 1883, App. C. Sect. VI. No. 6, contains the following material allegations:—the number, date, and term of the patent, the subject-matter, the fact that the plaintiff is the true and first inventor, and the fact of infringement by the defendant. The claim concludes for an injunction and damages, and refers to the particulars of breaches delivered along with it.

Allegations in statement of claim.

A technical variance from the prescribed form will not be fatal to the plaintiff’s claim (Ord. XIX. r. 26); but the Court has power to strike out any pleading on the ground that it is unnecessary, scandalous, or embarrassing (*ibid.* r. 27).

It was not necessary, even in the old *declaration* in an action at law (*o*), or in the *bill* in a suit at equity (*p*), and is not necessary now, to allege the novelty of the invention protected by the patent.

The allegation of the grant and the production of the letters patent were held to throw upon the defendant the *onus* of disputing the novelty.

In *Sarazin v. Hamel* (*q*) it was doubted whether, under a bill to restrain the infringement of a patent, it was necessary to allege that the patentee had duly paid the instalments of stamp duties necessary to keep the patent alive under 16 & 17 Vict. c. 5, s. 2, and no such allegation is required by the prescribed form.

(*o*) Hindmarch, p. 253.

(*p*) *Armory v. Brown*, 1862, L. R.

8 Eq. 663.

(*q*) 1863, 32 Beav. 145.

**Sect. 29.**

It may be said, generally, that a statement of claim must raise a *prima facie* case strong enough to justify an injunction (*r*), and must contain all the material allegations (with the exception of the particulars) on which the plaintiff relies (*s*).

4 *Particulars of breaches*.—See *supra*, p. 281.

Form of particulars, *infra*, p. 784.

As to history of this requirement, see *supra*, p. 281.

Particulars of breaches.

5 *The defendant*.—As to who may and ought to be defendants, see *supra*, p. 258.

6 *Statement of defence*.—See p. 288.

For forms of defence. See pp. 786 *et seq.*

7 *Particulars of objections*.—For form of particulars, see p. 788.

For particulars of objections generally, see p. 295.

Particulars of objections.

8 *No evidence shall, except by leave, &c.*—The words “except by leave of the Court or judge” are new. The rest of the sub-section re-enacts substantially 5 & 6 Will. IV. c. 83, s. 5, and 15 & 16 Vict. c. 83, s. 41.

Restriction of evidence at hearing.

Where additional evidence comes to the knowledge of a defendant after the delivery of his particulars, the proper course is to apply at once for leave to amend the particulars (*t*).

A recent case, *United Telephone Co., Limited v. Bassano* (*u*), raised an interesting point of practice under this section. The plaintiffs, as owners of two patents, brought two actions for infringement against the defendants, who delivered defences denying infringement, but not impeaching the validity of the patents. The plaintiffs joined issue upon these defences, and set the case down for trial. Sometime afterwards the defendants took out a summons for leave to amend their defences by inserting therein a denial of the validity of the plaintiffs' patents, and urged that the matter should be reserved for disposal by the judge at the trial of the actions. The plaintiffs opposed this application on the ground that the validity of the patents had, to the knowledge of the defendants, been decided in former cases. Pearson, J., declined to postpone the hearing of the trial, but gave the defendants leave to put in, within three days, an amended defence, raising the new issue; and ordered them to pay the costs of the application and any costs occasioned by the amendment.

*United Telephone Company v. Bassano.*

Where the words of the particulars are sufficiently wide, however, to include the new evidence tendered, it will be admitted (*x*).

(*r*) *Curtis v. Cutts*, 1839, 8 L. J. Ch. 38.  
184.

(*s*) R. S. C. 1883, Ord. XIX. r. 4.

(*t*) *Daw v. Eley*, 1865, L. R. 1 Eq.

(*u*) 1885, 2 P. O. R. 70.

(*x*) *Hull v. Bollard*, 1856, 1 H. & N. 134, 137; *Curtis v. Platt*, 1866,

**Sect. 29.** § *Amendment of particulars.*—See p. 304.Amendment  
of particulars.

10 *Shall not be allowed any costs, &c.*—With the exception of the words “to have been reasonable and proper,” this sub-section substantially re-enacts 15 & 16 Vict. c. 83, s. 43.

11 *Without regard to the general costs of the case.*—According to Stephen, J., in *Haslam Co. v. Hall (s)*, this does not mean that the certificate of the judge is to be “without regard,” &c., and the sub-section should read, “and with regard to the general costs of the case, they respectively shall not be allowed any costs,” &c.

Order for in-  
spection, &c.,  
in action.

30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction,<sup>1</sup> inspection<sup>2</sup> or account,<sup>3</sup> and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

1 *Injunctions.*—See Forms, *infra*, pp. 793, 794.

For a full discussion of the former and present practice of the Courts in granting injunctions, &c., see above, p. 264. As to inspection and account, see pp. 305—322.

The following may serve as a summary of the more important points:—

The present section substantially re-enacts 15 & 16 Vict. c. 83, s. 42, of which the object was to vest in the Courts of common law the power to order an injunction, inspection, or account, theretofore exclusively possessed by Courts of equity (*t*). How far this object was attained appears to be somewhat doubtful (*u*), but under the Judicature Act, 1873, and the Rules of the Supreme Court, 1883 (*x*), each division of the High Court of Justice, and any judge of such High Court (*y*), either in Court or in chambers, has the power of making orders for injunction, inspection, or account, whenever it is thought necessary.

35 L. J. Ch. 852, 868; *Sugg v. Silber*, 1874, 2 Q. B. D. at p. 495, per Mellish, L. J.

(*s*) 1888, 5 P. O. R. at p. 26.

(*t*) *Holland v. Fox*, 1854, 23 L. J. Q. B. 357; 3 E. & B. 977; *Patent Type Founding Co. v. Lloyd*, 1860, 29 L. J. Ex. 207; 5 H. & N. 198.

(*u*) *Ibid.*; and S. C., Johns. 727; also *Gittins v. Symes*, 1854, 24 L. J. C. P. 48; 15 C. B. 362.

(*x*) Ord. L.

(*y*) *Beddow v. Beddow*, 1878, L. R. 9 Ch. D. 89; *Thomas v. Williams*, 1880, 14 Ch. D. 864; *Quartz Consolidated Co. v. Beale*, 1882, 20 Ch. D. 501.

As to granting an *interlocutory* injunction, the rule upon which the Courts still act is that stated by Sir George Jessel, M. R., in *Dudgeon v. Thomson* (z):—

“The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent.”

A plaintiff must apply promptly after discovery of an alleged infringement, in order to obtain an interlocutory injunction to restrain it (a).

A person, however, who is threatened with proceedings for infringement is entitled to wait a reasonable time to see what is done in execution of the threat before applying for an interlocutory injunction under sect. 32 (b), (*infra*).

A *perpetual* injunction may be granted by the Court where the plaintiff has established the validity of his patent and the fact of infringement (c), or may be obtained by motion in Court (d), or by order in Chambers (e), where the defendant is willing to submit to the plaintiff's demands without bringing the action to trial.

2 *Inspection*.—See *supra*, p. 305.

Form of order for inspection, p. 794.

Before ordering *inspection* the Court must be satisfied (1) that there is a *prima facie* case to be tried (f); and (2) that the inspection demanded will probably, and not merely possibly (g), yield something material to the case of the party demanding it (h), and will not be oppressive to the other party (i).

(z) 1874, 30 L. T. N. S. 244. Cp. the following modern cases:—*Lister v. Norton*, 1884, 1 P. O. R. 114; *Jackson v. Needle*, 1884, *ibid.* 174; *Briggs v. Lardeur*, 1884, *ibid.* 126; *Shillito v. Larmuth*, 1885, 2 P. O. R. 1; *Read v. Andrew*, 1885, *ibid.* 119; *United Telephone Co. v. St. George*, 1886, 3 P. O. R. 33; *Rothwell v. King*, 1886, *ibid.* 379; *Coles v. Baylis*, 1886, *ibid.* 178.

(a) *Thomson v. Batty*, 1889, 4 Times R. 36; 6 P. O. R. 84.

(b) *United Telephone Co. v. Equitable Telephone Association*, 1888, 5 P. O. R. 233.

(c) *Hill v. Evans*, 1862, 31 L. J. Ch. 457; 4 De G. F. & J. 289.

(d) *Morrell v. Pearson*, 1849, 12 Beav. 284.

(e) Jud. Act, 1873, s. 39; and *Frearson v. Loe*, 1878, L. R. 9 Ch. D. 48; 26 W. R. 138. Cp. also R. S. C. 1883, Ord. LIV. r. 12; and Ord. LV. r. 15.

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

(g) *Smith v. London and Great Western Rail. Co.*, 1854, Macr. P. C. 223; *Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. 13.

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

(i) *Singer Manufacturing Co. v. Wilson*, 1865, 5 N. R. 505.

**Sect. 30.**  
Interlocutory  
injunction.

Perpetual  
injunction.

Inspection,  
when ordered  
by.



**Sect. 30.**

Inspection of  
trade secrets.

That an inspection will lead to the disclosure of trade secrets is not a sufficient ground for refusing it (*k*); but the Court will take steps to prevent the inspection being used to the prejudice of the defendant (*l*), and it has been customary in such cases to order an inspection and report by some scientific man under an "obligation of confidence," and not by the plaintiff (*m*).

Inspection of  
examiner's  
report.

In ordering inspection of an examiner's report under this section, it seems that the Court must certify such inspection to be desirable, and in the interests of justice. (Cp. sect. 9, sub-s. (5).)

The Court has no power under this section to require the defendants to an action for infringement to make an *affidavit* verifying the machines and processes used by them in the manufacture which is in issue (*n*).

Account of  
profits.

**3** *Account*.—See above, p. 322.

Any Division of the High Court of Justice may order an account of profits against a person infringing patent rights (*o*); but the plaintiff must elect between such an account and damages (*p*). The basis of the claim for profits is that the patentee condones the infringement, and does not complain of it, but seeks to recover the whole profit made by the infringer as if it had been made as trustee for him (*q*).

For the form of an order for an account of profits where an article is only partially made by the use of a patented invention, see *Siddell v. Vickers* (*r*).

Certificate of  
validity ques-  
tioned and  
costs thereon.

**31.** In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question;<sup>1</sup> and if the Court or a judge so certifies, then in any subsequent action for infringement,<sup>2</sup> the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

(*k*) *Renard v. Levinstein*, 1864-65, 10 L. T. N. S. 94.

(*l*) *Russell v. Crichton*, 1837, 15 Court of Sess. 270.

(*m*) *Flower v. Lloyd*, 1876, W. N. 230; and *Plating Co. v. Farquharson*, 1879-83, Griffin, P. C. 187.

(*n*) *Drake v. Muntz's Metal Co.*, 1886, Griffin, P. C. 79.

(*o*) R. S. C. 1883, Ord. XV. r. 1; *York v. Stowers*, W. N. 1883, 174.

(*p*) *Neilson v. Betts*, 1871, 5 H. L. 1, per Lord Westbury.

(*q*) *Betts v. De Vitre*, 1873, L. R. 6 H. L. 321; *United Horse Shoe and Nail Co. v. Stewart*, 1886, 3 P. O. R. at p. 123, per Lord Kinneer.

(*r*) 1888, 5 P. O. R. at p. 436.

1 *Certificate of validity.*—See p. 329.

2 *Subsequent action for infringement:*

Where two actions were in the paper for hearing at the same time, the action heard second was held not to be a subsequent action within this section, so as to entitle the plaintiff to solicitor and client costs (*s*).

The Vice-Chancellor of the Palatine Court of Lancaster has no jurisdiction under this section (*t*) to grant a certificate of validity.

No appeal lies from the decision of a Court or judge as to granting or withholding a certificate under this section (*u*).

See form of certificate of validity, p. 801.

**32.** Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens<sup>1</sup> any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats. Provided that<sup>2</sup> this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Remedy in case of groundless threats of legal proceedings.

1 *Action of threats.*—See Chap. XV. p. 348; and also Appendix, p. 808.

Action of threats.

The law, as it existed independently of the present section (which is not retrospective (*v*)), was thus stated by the late Master of the Rolls, giving his own opinion and that of Blackburn, L. J., in *Halsey v.*

Former law.

(*s*) *Automatic Weighing Co. v. International Hygienic Society*, 1889, 6 P. O. R. 480. See further decisions as to solicitor and client costs, *supra*, p. 334.

(*t*) *Proctor v. Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. at p. 184.

(*u*) *Haslam Co. v. Hall*, 1888, 5 P. O. R. at p. 144.

(*v*) *Sugg v. Bray*, 1885, 2 P. O. R. 223.

**Sect. 32.** *Brotherhood* (*w*):—"To support the action (for an injunction to restrain threats) the allegations must not only assert the statement to be untrue, but that it was made without reasonable and probable cause. . . . A man merely giving notice that his rights are being infringed, believing that they are infringed, is not to be subject to an action for giving that notice, even although he does not follow up that notice by bringing an action at law for the infringement." The defendant, however, while not bound to be correct in his statement of the law, was bound to be correct in his statement of facts, and if the threats were not mere allegations of piracy, which is matter of law, but went on to allege untruly matters of fact, an action would lie, whatever the defendant might allege his state of mind to have been (*x*).

Construction  
of present  
section.

The following points have been decided as to the construction of the present section :

It contemplates final judgment. This appears from the circumstance that it speaks of damages which could not be obtained on an interlocutory application (*y*).

In order to grant relief at the trial, the Court must be satisfied that, in fact, the instrument complained of and in respect of which the threats were made is not an infringement of any legal rights of the person making the threats (*z*).

The question whether the patent of the person making the threats is a valid patent must come into consideration in the action if the plaintiff seeks it; and, in such a case, a defendant cannot protect himself by the mere production of his letters patent, but must support them as if he were plaintiff in an action for infringement. "Legal right" means "valid right," and not merely a right under an instrument which is legal only so long as it stands unchallenged (*a*).

In applications for *interlocutory* injunctions, the Court ought to consider, not merely the balance of convenience, but whether the plaintiff has a *prima facie* case (*b*).

To come within the Act, threats need not be made by circular, or advertisement, or something *ejusdem generis*. Threats made by a solicitor's letter are within the Act (*c*); and a letter written "without prejudice" may contain threats within the present section (*d*).

(*w*) 1880-81, L. R. 15 Ch. D. 514; 19 Ch. D. 386. Cp. also *Wren v. Wiold*, 1869, L. R. 4 Q. B. at p. 737.

(*x*) *Dick v. Brooks*, 1880, 15 Ch. D. pp. 39, 40, per Bramwell, L. J.

(*y*) *Challender v. Royle*, 1887, 4 P. O. R. at p. 371.

(*z*) *Ibid.*

(*a*) *Ibid.*; differing from Chitty, J., in *Kurtz v. Spence*, 1886, 33 Ch. D. at

p. 582. See also *Kurtz v. Spence*, 1888, 5 P. O. R. at p. 177.

(*b*) *Ibid.*; reversing Bacon, V.-C., *S. C. ibid.* p. 368; *Walker v. Clarke*, 1887, 4 P. O. R. 111, per Kay, J., also overruled.

(*c*) *Crompton v. The Patents Investment Co.*, 1888, 5 P. O. R. 393.

(*d*) *Kurtz v. Spence*, 1888, 5 P. O. R. 173.

Damages will not in general be allowed where no actual damage has been suggested or sustained (*e*). Sect. 32.

Mere threats and warnings as to something which might be done in the future would not fall within the meaning of the word in the present section. "Everybody," said Bowen, L. J., in *Challender v. Royle* (*f*), "has still a right to issue a general warning to pirates not to pirate, and to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled, and under which he claims, is one that he intends to enforce. But my language must not be misunderstood on this point. It does not follow that because a threat is so worded as in mere language apparently and grammatically to apply only to the future that therefore it may not be in any particular case in substance and in fact applicable to what had been done. Supposing for a moment that a manufacturer is making and issuing machines which the patentee considers to be an infringement of his patent: if, with reference to that act done or to those machines made the patentee endeavours to guard himself against this section by merely issuing a threat in the air, it seems to me he would not escape if the tone gist of what he has done is to apply that threat to a particular person and a particular act." This language has been interpreted (*g*) to mean that "when a threat is given, there must be something then in respect of which the threatened party could claim a right of action, which must not be wholly with reference to something future or contingent—something proposed to be done." "I do not," adds Justice Kekewich, "understand the Lord Justice to say that if a patentee says, 'You have sold so many hundred-weights or tons of the patented article, and I tell you I shall proceed against you if you sell any more.' That is not a threat within the meaning of the section. I hardly know what the use would be of a threat if it was simply with reference to something which is past."

**2 Proviso.**—The proviso means that *the old law shall apply* if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent (*h*), it is not necessary that this action should be brought against the person aggrieved (*i*). Proviso.

(*e*) *Driffield Linseed Cake Co. v. Waterloo Mills Cake Co.*, 1886, 31 Ch. D. at p. 638. Cp. *Kurtz v. Spence*, *ubi supra*, at p. 177.

(*f*) *Ubi supra*, at p. 375.

(*g*) *Kurtz v. Spence*, 1888, 5 P. O. R. at p. 171, per Kekewich, J.

(*h*) *Challender v. Royle*, *ubi supra*, at p. 372. As to due diligence, see *Herrburgher v. Squire*, 1888, 5 P. O. R. at 595.

(*i*) *Ibid.* at p. 373. See the language of Cotton, L. J., as to the reason of this rule, at pp. 373, 374.

## MISCELLANEOUS.

**Sect. 33.**

Patent for  
one invention  
only.

**33.** Every patent may be<sup>1</sup> in the form in the First Schedule to this Act, and shall be granted for one invention only,<sup>2</sup> but may contain more than one claim;<sup>3</sup> but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.<sup>4</sup>

Form of  
patent.

1 *Every patent may be, &c.*—See p. 530. The word *may* is permissive. As a matter of fact the form of the grant in the schedule is adhered to, except in so far as necessary variations are requisite in cases where there are several applicants, or an applicant dies, &c. See pp. 533—536.

Rule as to  
one invention.

2 *One invention only.*—Cp. Patents Rules, 1890, r. 19, p. 566. Where, by mistake, inadvertence, or otherwise, more than one invention is included, the application may be amended and separate patents may be applied for. Every such application may bear the date of the original application.

Unless by implication in this section, the Act neither enables the comptroller to refuse an application on the ground that it claims more than one invention (*k*), nor allows an appeal to the law officer from such a refusal (*l*). In fact, however, the Comptroller-General does exercise this power, and appeals to the law officers have been taken from his decision.

The *test* by which the question of one invention is decided is “the general object of the invention” (*m*).

“If you have a particular general object of an invention,” said Herschell, S.-G., in *Jones’s Patent* (*m*), “to make rails rest more securely, and you describe one, two, or three cognate devices for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, ‘I use this as a substitute for that,’ both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention.”

(*k*) Sect. 7, sub-sect. (1), *supra*.  
(*l*) Sect. 7, sub-sect. (2), *supra*.

(*m*) *Jones’s Patent*, 3 Griffin, P. C. 265; *Hearson’s Patent*, 1885, *ibid.* 266; *Robinson’s Patent*, *ibid.* 267.

**3** *One claim.*—These words appear to have been inserted in the section by mistake. The claim appears in the specification, not in the patent. **Sect. 33.**  
**One claim.**

**4** No objection can be taken to a patented invention on the ground that it comprises more than one invention after the specifications have been accepted by the comptroller.

**34.** (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.<sup>1</sup> **Patent on application of representative of deceased inventor.**

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

**1** *Deceased inventors :*

This section alters the law laid down in *Marsden v. Saville Street Foundry and Engineering Company* (n).

The application must be accompanied by an official copy of, or extract from, the will of the deceased inventor, or the letters of administration granted of his estate and effects, in proof of the applicant's title. (Patents Rules, 1890, r. 20, p. 566.) **Application by representative of deceased inventor.**

If the applicant dies before sealing, a patent may be sealed to his executor or administrator (sect. 12 (3 b)).

Where an applicant dies after the acceptance of the provisional, but before the acceptance of the complete, specification, the practice is for the executor or administrator to produce for the inspection of the Comptroller-General probate of the will, or letters of administration of the deceased inventor, and then to carry out the subsequent stages in his own name.

**35.** A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. **Patent to first inventor not invalidated by application in fraud of him.**

This is substantially a re-enactment of 15 & 16 Vict. c. 83, s. 10.

(n) 1878, 3 Ex. D, 203.

**Sect. 35.** In the case of *Re Vincent's Patent* (o), the sealing of a patent was opposed on the ground of previous public user of the invention; in reply to which the applicant made the case that such user was obtained by fraud on him, so as to bring the case within 15 & 16 Vict. c. 83, s. 10. It was held that the question ought to go before a jury, and that the patent ought to be sealed in order that such a trial might not be precluded.

Assignment  
for particular  
places.

**36.** A patentee may assign<sup>1</sup> his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

<sup>1</sup> *Assignment of patents.*—See Chap. XI. p. 195.

See 15 & 16 Vict. c. 83, s. 35, Appendix, p. 658.

This section applies to existing patents; and a patent granted under the old practice might, therefore, be assigned for the Channel Islands.

Loss or de-  
struction of  
patent.

**37.** If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

This section in substance re-enacts 15 & 16 Vict. c. 83, s. 22.

The fee is £2, Form N., *infra*, p. 747.

Proceedings  
and costs  
before law  
officer.

**38.** The law officers<sup>1</sup> may examine witnesses on oath<sup>2</sup> and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules<sup>3</sup> regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs<sup>4</sup> to be paid by either party, and any such order may be made a rule of the Court.

(o) 1867, L. R. 2 Ch. 341.

1 *The law officer* means Her Majesty's Attorney-General or Solicitor-General for England (*p*). **Sect. 38.**

Law officer.

2 *May examine witnesses on oath.*—This provision is new. The Lord Chancellor had, under the old practice, power to examine witnesses *viva voce* at the hearing of a petition for the Great Seal to be affixed to letters patent (*q*). Examination of witnesses.

3 *And may from time to time make . . . . rules.*—See the Law Officers' Rules, *infra*, p. 589. Law Officers' Rules.

4 *Power of law officer over costs.*—The Comptroller-General has no power over costs. See *Opposition to Grant*, p. 173, and *Amendment of Specification*, p. 156. See also *Law Officers' Rules*, pp. 592, 593. Costs.

When there is no opposition, and the question is only between the Comptroller-General and the applicant, the law officer will not award costs against the Comptroller-General. Under exceptional circumstances the law officer has recommended the fees payable upon appeal to be returned (*r*). In a recent case (*s*), where an applicant for a patent obtained from the law officer a protecting clause, to which he was not absolutely entitled, no costs were allowed to him though successful.

In another case (*t*), the opponent, successful on appeal to the law officer, was allowed costs to cover the stamp on the notice of appeal.

**39.** The exhibition of an invention at an industrial or international exhibition, certified<sup>1</sup> as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a

Exhibition at industrial or international exhibition not to prejudice patent rights.

(*p*) See definitions, sect. 117, subsect. (1), *infra*.

(*q*) *In re Gething*, 1874, L. R. 9 Ch. 633.

(*r*) *Griffin*, P. C. p. 16, n.

(*s*) *Newman's Patent*, 1888, 5 P. O. R. 279.

(*t*) *Aire and Calder Works and Walker's Application*, 1888, 5 P. O. R. at p. 347.



**Sect. 39.** patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

- (a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice<sup>2</sup> of his intention to do so; and
- (b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

Protection of patents and designs exhibited at international exhibitions.  
Act 1886,  
s. 3.

It shall be lawful for Her Majesty, by Order in Council,<sup>3</sup> from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

1 *Exhibition certified as industrial or international.*—In order to have an exhibition certified under this section application must be made by the authorities controlling the exhibition or by some person interested, to the Board of Trade, and evidence produced to satisfy the Board that the exhibition is of sufficient importance, and, generally, a proper subject for the certificate. Upon being so satisfied a certificate is issued (*u*). The Board of Trade communicates the issue of the certificate to the Patent Office, where a list of such certified exhibitions is kept. The notice of intention to exhibit (*v*), and the description of the invention, are left at the Patent Office, and, if satisfactory, the inventor's name will be registered, and he will then be able to apply for a patent within six months of the opening of the exhibition.

The form of certificate by Board of Trade is given in Appendix, p. 845.

2 *Prescribed notice.*—An intending exhibitor of an unpatented in-

(*u*) See Form O., in Appendix, p. 747.

(*v*) Patents Rules, 1890, r. 15, p. 363, and Form O., p. 747.

vention must (1) give the comptroller seven days' notice (*w*) of his intention to exhibit, publish, or use his invention, and (2) furnish the comptroller with a brief description of the invention, accompanied with drawings, if necessary, and with such other information as the comptroller may in each case require. (Patents Rules, 1890, r. 15.) **Sect. 39.**

This section re-enacts, with modifications, 28 Vict. c. 3, and 33 & 34 Vict. c. 27.

3 The form of Order in Council granting temporary protection to inventions exhibited at the Paris Universal Exhibition, 1889, is given in Appendix, p. 845.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions,<sup>1</sup> as well as reports of patent cases decided by Courts of law,<sup>2</sup> and any other information that the comptroller may deem generally useful or important.<sup>3</sup> Publication of illustrated journal, indexes, &c.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications<sup>4</sup> of patents for the time being in force,<sup>5</sup> with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.<sup>6</sup>

1 *An illustrated journal of inventions.*—The journal forms part of *The Illustrated Official Journal (Patents)*, which appears every week. As to previous publications, see p. 65.

2 *Reports of Patent Cases.*—These are appended to the official journal. Formerly they were published separately. There were no official reports of patent cases until 1884.

3 *Any other information.*—See Patent Office circular.

4 *Complete specifications.*—Where an application for a patent has been abandoned or become void, the specification or specifications and drawings, if any, accompanying or left in connection with such ap- Abandoned application.

(*w*) Form O., *infra*, p. 747.

**Sect. 40.** plication, shall not at any time be open to public inspection, or be published by the comptroller.

**5 Specifications of patents in force.**—Printed copies of specifications of patents in force are kept on sale at the Patent Office (Sale Branch), and if the original edition has been exhausted, a further edition will be printed by the comptroller, if the specifications are required, at the public expense. Where the patent has expired, whether by non-payment of renewal fees or otherwise, the comptroller is not bound to keep printed copies on sale, and if the stock has run out any person wanting printed copies must pay the cost of reprinting and lithographing the drawings, if any.

**6 Patent Office publications.**—See list of such publications, *supra*, p. 65.

Patent  
Museum.

**41.** The control and management of the existing Patent Museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.<sup>1</sup>

**1 Patent Museum.**—See history of this Museum, sketched *supra*, p. 56.

Power to  
require  
models on  
payment.

**42.** The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

No demand for models seems now ever to be made by the Patent Office. The few additions made to the Patent Museum at South Kensington, appear to be voluntary gifts.

Foreign  
vessels in  
British  
waters.

**43. (1.)** A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything

intended to be sold in or exported from the United Kingdom or Isle of Man. Sect. 43.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.<sup>1</sup>

**1** *User by foreign vessels in British waters.*

Prior to 15 & 16 Vict. c. 83, s. 26—of which the present section is substantially a re-enactment—the exclusive rights under an English patent were enforced against foreigners while in England, in the same way and to the same extent as against British subjects.

Therefore, in a case in which the foreign owners of a ship caused to be made in their own country, and attached to their vessel, a steam screw propeller, the manufacture and user of which was unrestrained by law there, but restricted in England by a patent, and afterwards sent the vessel with a cargo for the purpose of trade to England, the use of the steam propeller was restrained by injunction while the vessel should be within the waters covered by the English patent (*x*).

*Caldwell v. Vanvlissengen.*

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

*Assignment to Secretary for War of certain inventions.*

(*x*) *Caldwell v. Vanvlissengen*, 1851, 21 L. J. N. S. Ch. 97; 16 Jur. 115.

Sect. 44.

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

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

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

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

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

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any

person authorized by writing under the hand of the Secretary of State to receive it. Sect. 44.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the patent office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the controller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

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

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

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

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

This section is substantially a re-enactment of 22 Vict. c. 13.

**Sect. 44.** For "Memorandum for Inventors," issued by the War Office with regard to applications under this section, and as to other inventions or patents, see p. 846.

There have been very few assignments to the Secretary of State for War under the provisions of this section. Applications to the War Office as to inventions, whether patented or not, are made by letter addressed to the Under Secretary of State for War, stating the nature of the invention and the reward asked for, if any, by the inventor.

#### EXISTING PATENTS.<sup>1</sup>

Provisions  
respecting  
existing  
patents.

**45.** (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.<sup>2</sup>

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses.<sup>3</sup>

(3.) In all other respects (including the amount and time of payment of fees)<sup>4</sup> this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.<sup>5</sup>

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the patent office.

Sub-s. 1. **1 Existing patents.**—This section—especially sub-sect. 3 thereof—must be read to a certain extent with section 113, *infra*. In *Brandon's Patent (t)*, this matter was discussed. See the remarks on this case at pp. 378—9 and 523.

**2 Applications.**—The applications under the Act of 1852, pending

(t) 1884, 1 P. O. R. 154; see also *Singer v. Stassen*, 1884, 1 P. O. R. 121.

at the time of the commencement of the Act of 1883, were completed under the procedure laid down in the earlier Act. Sect. 45.

3 The provisions as to patents binding the Crown are new in the Act of 1883. See sect. 27. The provisions of sect. 22, as to compulsory licences, are likewise new. The effect of this sub-section is to restrict the operation of these new provisions to applications made after 1st January, 1884. Sub-s. 2.

4 The payment of annual fees on patents applied for under Act of 1852, where the third year's renewal fee of 50*l.* had been paid in lieu of the payment of 100*l.* before the end of the seventh year, was regulated by an order of the Board of Trade, made under their general powers under this Act, in August, 1884.

5 *General effect of Act of 1883.*—This sub-section must be read with sect. 113, and, apparently, in subordination thereto. Sub-s. 3.

In *Singer v. Stassen* (u), Bowen, L. J., said, that old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains, but the express repeal of the old law contained in sect. 113 is not to affect them. It appears, therefore, that section 18 as to amendment, and sect. 19 as to disclaimer pending action, apply to all existing patents applied for under the Act of 1852 (x).

As to the effect of sect. 25 of the Act of 1852, providing for the falling of a British patent with any prior foreign patent, see the notes to that section at p. 655, also *Blake's Patent*, 1873, L. R. 4 P. C. 535; and *Winan's Patent*, 1872, L. R. 4 P. C. 93.

## DEFINITIONS.

46. In and for the purposes of this Act—

“Patent”<sup>1</sup> means letters patent for an invention:

“Patentee”<sup>2</sup> means the person for the time being entitled to the benefit of a patent:

“Invention”<sup>3</sup> means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof”), and includes an alleged invention.

In Scotland “injunction” means “interdict.”

1 *Patent.*—As to other grants by letters patent, see pp. 1 and 2.

(u) *Supra.*

(x) *Singer v. Stassen, supra.*

Definitions  
of patent,  
patentee, and  
invention.



**Sect. 46.** **2 Patentee.**—This definition includes an executor, administrator, or assignee; and “person” includes persons. (See 13 & 14 Vict. c. 21, s. 4, and also *Powell v. Head*, 1879, L. R. 12 C. D. at p. 686.)

**3 Invention.**—As to subject-matter of patents, see Chap. IV. pp. 15 *et seq.*

By the definition of “invention” here given, the law as to what inventions are valid subject-matter for a patent is retained intact as it existed prior to the Act of 1883.

## PART V.

### GENERAL.

#### PATENT OFFICE AND PROCEEDINGS THEREAT.

**Patent Office.** **82.** (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.<sup>1</sup>

(2.) Until a new patent office is provided,<sup>2</sup> the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks,<sup>3</sup> who shall act under the superintendence and direction<sup>4</sup> of the Board of Trade.<sup>5</sup>

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

**1 The Patent Office.**—For a full account of the history and present constitution of the Patent Office, and of the business transacted therein, see Chap. V. pp. 49 *et seq.*

**2 New Patent Office.**—No new Patent Office has been provided. 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.

**3** *The Comptroller-General.*—The comptroller has the general superintendence of the patent office under the Board of Trade. **Sect. 82.**

**4** *Who shall act under, &c.*—The comptroller is further enabled by sect. 95, *infra*, to apply to either of the law officers for directions in any case of doubt or difficulty.

**5** *The Board of Trade.*—There is no definition of the Board of Trade in the Act. It is defined, however, in 24 & 25 Vict. c. 47, s. 65.

**83.** (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks,<sup>1</sup> and so many examiners<sup>2</sup> and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks. Officers and clerks.

(2.) The salaries<sup>3</sup> of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

**1** *Appointment of Comptroller.*—Mr. H. Reader Lack was appointed Comptroller-General on the new Act coming into force.

**2** *Examiners.*—See Chap. V. pp. 60 *et seq.*

**3** As to salaries of such officers and clerks, see Comptroller-General's Report for 1889.

**84.** There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence. Seal of patent office.

Letters patent for inventions are now sealed with the seal of the Patent Office. In this respect only the seal of the Patent Office has the same effect as the Great Seal of the United Kingdom, see sect. 12, *supra*.

**85.** There shall not be entered in any register kept Trust not to

**Sect. 85.** under this Act,<sup>1</sup> or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.  
be entered in registers.

**1** *Any register kept under this Act.*—As to the Register of Patents, see sect. 23, and Chap. XII. pp. 207 *et seq.*

It was formerly the practice to enter on the Register of Proprietors deeds of trust relating to patents. And in *Re Morey's Patent* (*y*) it was held that this register might contain not only a register of documents, but any other facts relating to proprietorship of which the Court might think fit to order the insertion.

As a matter of fact, many deeds which are now filed in the Patent 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.

Refusal to grant patent, &c., in certain cases.

**86.** The comptroller may refuse<sup>1</sup> to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

**1** *Refusal of comptroller.*—As to exercise of discretionary power by comptroller, see Patents Rules, 1890, rr. 11—14, pp. 562, 563.

The refusal of the comptroller under this section cannot be appealed against to the law officer.

It is stated that under this section a patent has been refused for an apparatus for a lottery (*z*).

Entry of assignments and transmissions in registers.

**87.** Where a person becomes entitled by assignment,<sup>1</sup> transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register<sup>2</sup> of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to the provisions of this Act and

Act 1888, s. 21.

(*y*) 1858, 6 W. R. 612; 25 Beav. 581.

(*z*) Griffin, P. C. p. 30.

to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property. Sect. 87.

1 *Assignment, &c.*—Although the sixth section of the Statute of Monopolies excepts grants to inventors only, the legality of a limitation of the privilege to executors, administrators, and assigns was never questioned (*a*). Generally.

It was, however, considered that, without express words of limitation in the patent, the grant would be personal merely, and the privilege would cease upon the death of the patentee during the term (*b*); and the form of letters patent contained a proviso against assignment at first to more than *five* (*c*), and afterwards (*d*) to more than *twelve* persons.

This proviso, however, applied to assignments by act of parties merely, and not by operation of law (*e*).

As to assignments and licences generally, see Chap. XI.

As to assignments to Secretary of State for War, see sect. 44, *supra*.

As to the Register of Patents, see sects. 23, 85, 87—91, 93 and 114.

See also Patents Rules, 1890, rr. 67—79, *infra*.

For form of request, see Patents Rules, 1890, Form L. at p. 746.

The stamp is 10s., see Schedule of Fees, p. 587.

Under the present Act, a right of assignment for particular districts or places is expressly given (*f*); but the right to assign the patent itself depends, as formerly, upon the terms of the letters patent. Assignment of share or for district.

A patentee may assign any part or share of his patent (*g*), or the entirety of the patent so far as it relates to a separate and distinct part of the invention (*h*); and the assignee, whether of a share or of

(*a*) Hindmarch, p. 58.

(*b*) *Ibid.*; and *Duvergier v. Fellows*, 1830, 10 B. & C. 826.

(*c*) This rule sometimes proved inconvenient, because, with only five persons an inventor might be unable to raise sufficient capital to carry his invention into effect. It was avoided by putting in names under licenses or as trustees for others: Report,

1829, p. 12.

(*d*) In 1832.

(*e*) *Bloxam v. Elsee*, 1827, 6 B. & C. 169.

(*f*) Sect. 36.

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

(*h*) *Dunnicliff v. Mallett*, 1859, 29 L. J. C. P. 70; 7 C. B. N. S. 209.

**Sect. 87.** the entirety, takes the legal interest, and is not to be considered merely as a licensee (*i*).

“In the case of a patent belonging to several persons in common,” says Lindley, L. J., in his work on Partnership (*k*), “each co-owner can assign his share, and sue for an infringement, and can also work the patent himself, and give licenses to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses.”

It appears to be the law that while an assignee cannot sue until his assignment has been registered, registration relates back to the date of the assignment (*l*).

Under a covenant in a deed of assignment to communicate improvements to the assignees, a patentee cannot be restrained from giving evidence against the assignees as a scientific witness, under a subpoena; nor can he be prevented from disclosing any information in his possession which may tend to show that the patents assigned were invalid (*m*). During an action for infringement, the defendants assigned their business, and then obtained an order in chambers to add the assignees as third parties. On appeal to the judge in Court the order was discharged (*n*).

2 *The Register of Patents.*—See note to sect. 23, *supra*, p. 463.

**88.** Every register<sup>1</sup> kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies,<sup>2</sup> 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.<sup>3</sup>

1 *Every register, &c.*—See sect. 23. For the hours of inspection, see Patents Rules, 1890, r. 78.

2 *And certified copies.*—See sect. 96.

(*i*) *Walton v. Lavater, ubi supra*, at p. 184.

(*k*) Pages 68, 69.

(*l*) *Chollett v. Hoffman*, 1857, 26 L. J. Q. B. 249; 7 E. & B. 686; and *Hassall v. Wright*, 1870, L. R. 10 Eq.

510, per Malins, V.-C.

(*m*) *London and Leicester Hosiery Co. v. Griswold*, 1886, 3 P. O. R. 251.

(*n*) *Briggs v. Lardeur*, 1885, 2 P. O. R. 13.

**3 Prescribed fee.**—The fee for a copy is 4*d.* per folio, but not less than 1*s.* in all. Sect. 88.

If the copy is to be certified the fee is 1*s.* for certifying, plus the cost of copying.

**89.** Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals. Sealed copies to be received in evidence.

This section re-enacts, with alterations, 16 & 17 Vict. c. 115, s. 4. By that Act, the sealed copies were admissible in evidence in all proceedings relating to letters patent for inventions. See also Patents Rules, 1890, r. 79.

The register is *prima facie* evidence of any matters by this Act directed or authorised to be inserted therein (o).

**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. Rectification of registers by Court. Act 1888, s. 23.

(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

(o) Sect. 23, sub-s. (2).

**Sect. 90.** direct that due notice of the rectification be given to the comptroller.<sup>1</sup>

1 The order when received by the comptroller is notified in the register and a copy filed.

For the general practice under this section, see Chap. XII., on the Register of Patents.

For form of motion to rectify register, see Appendix, p. 776.

For form of order thereon, see Appendix, p. 777.

This section applies to all the subjects comprised in the present Act, the provisions of 15 & 16 Vict. c. 83, s. 38, by which the jurisdiction was given to the Master of the Rolls, to the Courts of common law in term time, and to any judge of the said Courts in vacation.

Orders made under that section could not be appealed against (*o*), but the jurisdiction of the Master of the Rolls over patents having passed under the Judicature Act, 1873, s. 16, sub-s. (1), to the High Court, orders made under the present section are subject to appeal like any other orders of Court (*p*).

The following cases will illustrate the practice under the Patent Law Amendment Act, 1852, s. 38:—

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

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

It was also held, in this case, that the Court could, in a motion under 15 & 16 Vict. c. 83, s. 38, direct any *facts* relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them.

(*o*) *In re Horsley and Knighton's Patent*, 1869, L. R. 4 Ch. 784.

(*p*) *Re Morgan's Patent*, 1876, 24 W. R. 246; *Re Myers' Patent*, W. N. 1882, 53, 56.

(*q*) *Re Green's Patent*, 1857, 24 Beav.

145.

(*r*) That the second assignment was fraudulent, appears from *Re Morey's Patent*, 1858, 25 Beav. 581.

(*s*) *In re Morey's Patent*, 1858, 25 Beav. 581.

Scope of section.

Appeals.

Cases under Patent Law Amendment Act.

One of two joint patentees (*t*), by deed, assigned his interest in the patent to a third person, and released to him all the rights of action, &c., against him, of both the patentees, and the deed was set out completely in the register of proprietors. It was held that the other patentee was entitled under 15 & 16 Vict. c. 83, s. 38, to have the entry struck out.

Sect. 90.

In *Re Berdan's Patent* (*u*), it was held that the Master of the Rolls, as keeper of the records, had power to order a disclaimer filed without the consent of the patentee to be taken off the register.

**91.** The comptroller may, on request in writing<sup>1</sup> accompanied by the prescribed fee,<sup>2</sup>—

Power for comptroller to correct clerical errors.

(a) Correct any clerical error in or in connexion with an application for a patent,<sup>3</sup> or for registration of a design or trade mark; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(c) [This sub-sect. relates only to trade marks.]

(d) [Same as (c).]

Act 1888, s. 24.

<sup>1</sup> *Request in writing.*—See Form P., *infra*, p. 747.

<sup>2</sup> *Prescribed fee.*—Fee No. 36, p. 587.

<sup>3</sup> *Clerical errors.*—As to jurisdiction of Master of Rolls, see p. 144. As to jurisdiction of comptroller, see p. 166.

According to sect. 91 only clerical errors in connection with patent applications can be corrected, but by virtue of Rule 16, *infra*, p. 564, clerical errors in a specification after grant of patent can be corrected.

**92.** [This section relates only to trade marks. It is given in Appendix, at p. 716.]

Alteration of registered mark.

**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

Falsification of entries in registers.

(*t*) *In re Horsley and Knighton's Patent*, 1869, L. R. 8 Eq. 475.

(*u*) 1875, L. R. 20 Eq. 347.



**Sect. 93.** or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

This is an application to all the registers kept under the new Act of 15 & 16 Vict. c. 83, s. 37.

See Chap. XVII., p. 368, on Offences and Penalties.

As to punishment of misdemeanours in Isle of Man, see sect. 112, p. 522.

This offence being a misdemeanour, the punishment would be fine or imprisonment, with or without hard labour, for a period not exceeding two years.

Exercise of discretionary power by comptroller.

**94.** Where any discretionary power<sup>1</sup> is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant)<sup>2</sup> giving the applicant an opportunity of being heard personally or by his agent.

<sup>1</sup> Cp. Patents Rules, 1890, r. 11, *infra*, p. 562.

This is a most important provision in favour of patentees, &c.

<sup>2</sup> *If so required.*—Form E., *infra*, p. 741.

Power of comptroller to take directions of law officers.

**95.** The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

By sect. 82, sub-s. (3), the comptroller acts under the superintendence of the Board of Trade. In this Act the Board of Trade replaces the Commissioners of Patents of the Act of 1852.

Applications to the law officers are not infrequently made under this section, especially in cases of legal questions arising as to the construction of provisions of the Act in the practice of the Patent Office.

Certificate of comptroller to be evidence.

**96.** A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made

thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. Sect. 96.

Patents Rules, 1890, r. 79, Form Q., *infra*, p. 748. The comptroller generally gives his decisions on oppositions and amendments in writing.

**97.** (1.) Any application, notice, or other document authorized or required to be left, made, or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. Applications and notices by 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.

These very useful provisions are made much use of in practice.

In *Trotter v. Maclean* (x), 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.

**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. Provision as to days for leaving documents at office.

See Patents Rules, 1890, r. 7, p. 561.

(x) 1879, L. R. 13 Ch. D. 574.

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As to enlargement of time, Patents Rules, 1890, r. 51, p. 577.

As to hours for inspection of register, *ibid.* r. 78, p. 584.

Declaration  
by infant,  
lunatic, &c.

**99.** If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

So long as the necessary documents are prepared in the prescribed manner there is nothing to prevent the grant of a patent to 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 a patent.

In the case of an inventor becoming insane before applying for his patent, it is presumed the application might be made for him under this section. Also that other steps might, under this section, be taken for him in the event of insanity after application.

See Patents Rules, 1890, r. 80, as to the power of the comptroller to dispense with evidence.

Transmission  
of certified  
printed copies  
of specifica-  
tions, &c.

**100.** Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland,

and to the Rolls Office in the Isle of Man, within Sect. 100. twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

See sect. 40, p. 495.

This section re-enacts, with modifications, 16 & 17 Vict. c. 115, s. 5.

**101.** (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs and trade marks:

(c) For making or requiring duplicates of specifications, amendment, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:

(e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public autho-

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rities, bodies and institutions at home and abroad:

(g) Generally for regulating the business of the patent office, and all things by this Act, placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.<sup>1</sup>

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.<sup>2</sup>

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.<sup>3</sup>

<sup>1</sup> Alterations were made by the Patents Rules, 1883, rr. 5 and 6; and the Patents Rules, 1885, rr. 4 and 5. See now Patents Rules, 1890, rr. 5 and 6, pp. 560, 561.

<sup>2</sup> General rules were framed after the passing of the Act and before its coming into operation, and the rules took effect from the 1st January, 1884.

<sup>3</sup> Sub-sections (4) and (5) incorporate the usual provisions where the rules are subject to an Act to have the force of statute law.

**102.** The comptroller shall, before the first day of June in every year, cause a report<sup>1</sup> respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

**Sect. 102.**  
Annual reports of comptroller.

**102a. (1.)** All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

Proceedings of Board of Trade.  
Act 1888, s. 25.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

<sup>1</sup> This Report is made annually, and is the continuation of the Commissioners of Patents Annual Reports made under the Act of 1852. The report is usually issued in June. The first report was made on the working of the Act of 1883 for the first three months of 1884. Afterwards a report was made for the whole year, and there is now one report a year under this section.

The report of the comptroller gives information, amongst other things, upon the following matters (so far as patents are concerned):—

The number of applications and patents sealed.

A table of the sources whence the applications come, giving the number of applications from persons in the United Kingdom and in various countries and colonies.

The number of applications by way of communication.

The number of applications under the International Convention.

The number of patents remaining in force.

The publications of the Patent Office and of the grants made to various libraries, &c.

Particulars of amendments, oppositions, applications for prolonga-

**Sect. 102.**

tion to Privy Council, applications to Board of Trade for compulsory licences, &c.

An account of the receipts and expenditure of the office.

## INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International arrangements for protection of inventions, designs, and trade marks.

Act 1885, s. 6.

**103.** (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states<sup>1</sup> for mutual protection of inventions, designs, and trade marks, or any of them,<sup>2</sup> then any person<sup>3</sup> who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants;<sup>4</sup> and such patent or registration shall have the same date as the [*date of the protection obtained*] date of the application<sup>5</sup> in such foreign state.

Provided that his application is made, in the case of a patent within seven months,<sup>6</sup> and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication,<sup>7</sup> 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 : Sect. 103.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner, as an ordinary application,<sup>8</sup> under this Act: provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council<sup>9</sup> declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

**1 Arrangements with foreign States.**—For a complete list of the States with which such arrangements have been made, see *ante*, p. 411.

**2 Mutual protection of inventions, designs, and trade marks.**—The International Convention seems to 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.

**3 Any person.**—*Semble* a corporation is a “person,” and can claim rights under this section (*y*).

A patent under the International Convention and sect. 103 can be granted only to the person who has made the foreign application (*z*). A communicatee of an invention from abroad cannot claim any rights under this section (*a*).

“Person” includes citizen and foreigner alike (*b*).

In *Main's Patent* (*c*), Webster, A.-G., held that an applicant was entitled to have his English application ante-dated, although his foreign application was made before the country in which it was made had come under sect. 103.

(*y*) *Re Carez*, 1889, per Webster, A.-G., 6 P. O. R. at p. 552 and see sect. 117, *infra*, p. 525.

(*z*) *S. C. ubi sup.*

(*a*) *Re Shallenberger*, 1889, per Webster, A.-G., 6 P. O. R. at p. 551.

(*b*) *Re Shallenberger, ubi supra.*

(*c*) 1890, 7 P. O. R. 13.



**Sect. 103.** 4 *In priority to other applicants.*—See *L'Oiseau and Pierrard* (b), *supra*, p. 415.

This section does not give a foreign applicant any right of opposing, under sect. 11, the grant of a subsequent patent (c).

5 *Date of the application.*—These words were, at the instigation of Lord Herschell (*L'Oiseau and Pierrard, ubi sup.*), substituted for the words in italics by sect. 6 of the Act of 1885.

6 See the International Convention, Art. 4, p. 604.

7 See the International Convention, Art. 4, p. 604.

8 See the procedure to be followed under this section in the Patents Rules, 1890, rr. 24—29, pp. 568 *et seq.*

9 See complete table of these Orders in Council, *supra*, p. 411.

The general effect of this section and its relation to the International Convention are discussed at pp. 408 *et seq.*

Provision for  
colonies and  
India.

**104.** (1.) Where it is made to appear to Her Majesty that the legislature of any British possession<sup>1</sup> has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time by Order in Council<sup>2</sup> to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

1 *British possession.*—See sect. 117, sub-s. (1).

2 *Order in Council.*—See complete list of such Orders in Council, *supra*, p. 411.

(b) 1887, Griffin, A. P. C. 36.

(c) *Re Everitt*, 1888, Griffin, A. P. C. 28.

## OFFENCES.

**105.** (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Sect. 105.

Penalty on falsely representing articles to be patented.

(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.

This section is based upon 5 & 6 Will. IV. c. 83, s. 7.

A person cannot mark his invention "patented," although he has (a) applied for a patent (a), or (b) obtained provisional protection (c), unless or until a complete specification has been accepted, in which case it appears that under sect. 15 the applicant is entitled to do so. But see the Patent Office Circular of Information, where the contrary is stated.

This section does not apply to a case of false representation of an expired patent as still subsisting (f).

**106.** Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Penalty on unauthorized assumption of Royal arms.

(d) *Reg. v. Crampton*, 1886, 3 P. O. R. 367.

(e) *Reg. v. Wallis*, 1886, 3 P. O. R. 1.

(f) *Cheavin v. Walker*, 1877, L. R. 5 Ch. D. 863; *Marshall v. Ross*, 1869, L. R. 8 Eq. 651.

## SCOTLAND, IRELAND, ETC.

**Sect. 107.**

Saving for  
Courts in  
Scotland.

**107.** In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor,<sup>1</sup> shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

<sup>1</sup> *An assessor.*—Sect. 28, p. 480.

*United Horse Shoe & Nail Company v. Stewart (g)*, and *Mackie v. Berry (h)* were tried before a Lord Ordinary of the Court of Session (Lord Kinneir) and an assessor—the late Mr. Fleeming Jenkin, Professor of Engineering in Edinburgh University.

Summary  
proceedings  
in Scotland.

**108.** In Scotland any offence<sup>1</sup> under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

<sup>1</sup> *Offence.*—As to what are offences under the Act, see Chap. XVII. p. 368.

Proceedings  
for revocation  
of patent in  
Scotland.

**109.** (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation  
of remedies in  
Ireland.

**110.** All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in

(g) 1885, 2 P. O. R. 127.

(h) 1885, 2 P. O. R. 146.

respect of a patent as if the same had been granted to Sect. 110.  
 extend to Ireland<sup>1</sup> only.

<sup>1</sup> *Ireland*.—Prior to the Act of 1852, an English patent did not extend to Ireland or Scotland, see *infra*, pp. 551 *et seq.*

Under the Act of 1852, Ireland, as well as Scotland, was embraced in the grant, but sect. 29 of that statute contained a saving clause similar in terms to the present section. In *Bovill v. Finch* (i), a case decided under the old law, three separate original letters patent had been granted in 1849, to an inventor for England, Scotland and Ireland respectively. The Scotch patent was void for want of novelty, and afterwards a prolongation of the terms of the three original patents was granted by one and the same letters patent under the Great Seal of the United Kingdom, pursuant to 15 & 16 Vict. c. 83. It was held, that the grant of prolongation was divisible, and operated as if there had been separate grants by separate instruments for the three countries, so that the prolongation of the English patent was not rendered void by the invalidity of the Scotch patent. In delivering judgment, however, Montague Smith, J., said, “We do not, however, deem it necessary to decide what would be the effect of the want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal.”

**111.** (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term “the Court” shall mean any Lord Ordinary of the Court of Session, and the term “Court of Appeal” shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms “the Court” and “the Court of Appeal” respectively mean the High Court of Justice in Ireland and Her Majesty’s Court of Appeal in Ireland.

General  
 saving for  
 jurisdiction  
 of Courts.

(2.) If any rectification of a register<sup>1</sup> under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other

(i) 1870, L. R. 5 C. P. 523.

**Sect. 111.** authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

1 *Rectification of register.*—See notes to sect. 90, p. 507, and Chap. XII. pp. 207 *et seq.*

Isle of Man.

**112.** This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Jurisdiction  
of Lancashire  
Palatine  
Court.

Act 1883,  
s. 26.

**112a.** [This section relates only to Trade Marks. It is given in the Appendix, at p. 722.]

REPEAL, TRANSITIONAL PROVISIONS, SAVINGS.

Repeal and  
saving for  
past operation  
of repealed  
enactments,  
&c.

**113.** The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enact-

ments, 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

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(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.

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.

Construction of principal Act. Act 1888, s. 27.

See also section 45, *supra*, and the notes thereto.

The provisions of sub-section (a) must be read distributively, and if so read they declare that the enactments of the Act of 1883 shall not affect any patent granted before the commencement of the Act; and they also declare that those enactments shall not affect any *right or privilege* which had accrued to the patentee before or at the commencement of this Act. The privilege enjoyed by a patentee under the Act of 5 & 6 Will. IV., of applying for a prolongation of his patent at any time before its expiration, is a right included in the express reservation of the present section (k).

In *Singer v. Stassen* (l), the effect of this section upon the general body of the Act, as it affects patents applied for under the Act of 1852, was very fully considered in the Court of Appeal. In this case, an action of infringement was commenced in 1883, and in 1884 an application was made by the plaintiff for liberty to apply at the Patent

(k) *Brandon's Patent*, 1884, 1 P. O. R. 164.

(l) 1884, 50 L. T. 326. Cp. also *Hearson's Patent*, 1884, Griffin, P. C. 310.

**Sect. 113.** Office for leave to amend his specification by way of disclaimer. The defendants objected that sect. 19 of the Act of 1883 did not apply to actions pending at the date of its coming into operation, and that the right of the defendants not to have a disclaimer put in evidence in such an action, by virtue of the proviso of 5 & 6 Will. IV. c. 83, s. 1, was saved by sect. 113 of the Act of 1883. Bowen, L. J., summarised the effect of sect. 113 on the effect of the Act of 1883 on patents applied for under the Act of 1852, as follows:—"Old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains, but the express repeal of the old law contained in sect. 113 is not to affect them. They will be still protected by the keeping in force for their benefit of any of the old enactments which are required to safeguard vested rights or interests to the extent to which sect. 113 means it to apply. There is nothing, therefore, which prevents sect. 19 applying to old patents and old patent rights."

See also the trade marks cases—*Hayward's Trade Marks* (m), and *Jackson v. Napper* (n), and the *Design case* (o).

Former registers to be deemed continued.

**114.** (1.) The registers of patents and of proprietors<sup>1</sup> kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

<sup>1</sup> *Old registers.*—See Chap. XII. pp. 207 *et seq.*, where the relation of the Register of Patents and the Register of Proprietors under the Act of 1852, to the Register of Patents and the accompanying *file* under the Act of 1883, is explained.

Saving for existing rules.

**115.** All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they

(m) 54 L. J. Ch. N. S. 1003.  
(n) L. R. 35 C. D. 162.

(o) *Wittman v. Oppenheim*, L. R. 27 C. D. p. 260.

had been made by the Board under this Act, but so that Sect. 115. no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

See Patents Rules, 1890, r. 81. New rules for Patents, Designs and Trade Marks were issued early in 1890, consolidating and amending previous rules made under this Act, which were repealed. For a note on the previous rules relating to Patents, see pp. 585, 586.

**116.** Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof. Saving for prerogative.

As to effect of patent against Crown, see sect. 27, *supra*, p. 478.

This section is very important. Apparently, under it, there is nothing to prevent the Crown granting a patent for an invention altogether outside the procedure laid down in the Patents Acts, 1883—88, provided only the grant be within the common law prerogative, as modified by the Statute of Monopolies.

#### GENERAL DEFINITIONS.

**117.** (1.) In and for the purposes of this Act, unless the context otherwise requires,— General definitions.

“Person”<sup>1</sup> includes a body corporate:

“The Court”<sup>2</sup> means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England:

“Law officer” means Her Majesty’s Attorney-General or Solicitor-General for England:

“The Treasury” means the Commissioners of Her Majesty’s Treasury:

“Comptroller” means the Comptroller General of Patents, Designs, and Trade Marks:



**Sect. 117.** “Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

“Legislature” includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

Register of  
patent agents.  
Act 1888,  
s. 1.

(1.) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.<sup>3</sup>

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules<sup>4</sup> as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bona fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.<sup>5</sup>

(4.) If any person knowingly describes himself as a patent agent

in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds. Sect. 117.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

1 *Person* includes a company registered under the Act of 1862. A body corporate may be registered as proprietors by its corporate name. (Patents Rules, 1890, r. 73.)

2 *The Court* does not include the Court of Chancery of the County Palatine of Lancaster (*p*). But see sect. 112a, added by the Act of 1888, as to trade marks, the registration whereof is applied for in the Manchester office.

3 *Patent agents*.—Prior to this Act, there were no means of excluding unqualified persons from acting as patent agents; and the Parliamentary Reports of 1851 and 1865 contain abundant evidence of the inconvenience and expense to which the absence of any such provision might give rise.

The profession of a patent agent has not been carried on in this country as a separate branch of business more than seventy years.

Prior to the passing of the Patent Law Amendment Act, 1852, a patent agent's business was of a comparatively limited character, as at that time only about 550 patents were taken out annually in England.

Under the Patent Law Amendment Act the number of patents annually obtained greatly increased, and patents were taken out by British subjects abroad much more frequently than formerly.

A communication with a patent agent is not privileged, though he is a solicitor (*q*).

It is hardly necessary to add that a patent agent is liable to his principal for fraud or negligence (*r*).

4 *Register of Patent Agents Rules*.—These rules were issued by the Board of Trade on the 11th June, 1889. The Institute of Patent Agents was thereby intrusted, under the Board of Trade, with the care of the Register of Patent Agents, and the control of the qualifying examinations for admission to the register, &c. For the rules at length, see Appendix, pp. 856 *et seq.*

The Institute of Patent Agents was incorporated as the "Institute of Patent Agents," as an association limited by guarantee, on the 12th August, 1882, under the Companies Acts, 1862 to 1880; and the

(*p*) *Proctor v. Sutton Lodge Chemical Co.*, 1886, 3 P. O. R. 355.  
 (*r*) *Lee v. Walker*, 1872, L. R. 7  
 (*q*) *Moseley v. The Victoria Rubber Co.*, 1883, 5 P. O. R. 184.  
 C. P. 121.

**Sect. 117.** use of the word "limited" was dispensed with by license of the Board of Trade, under the Companies Act, 1867, s. 23.

A royal charter of incorporation has recently been applied for, in which it is proposed that fellows of the institute should be entitled to describe themselves as "chartered patent agents."

5 This sub-section preserves the rights of existing practitioners, and entitles them to be placed upon the register without examination.

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## SCHEDULES.

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### THE FIRST SCHEDULE.

#### FORMS OF APPLICATION, &c.

Section 5.

#### FORM A.

[£1 Stamp.] FORM OF APPLICATION FOR PATENT.

*(This Form is replaced by Forms A, A1, Patents Rules, 1890, see pp. 737, 738.)*

*I,\* John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do solemnly and sincerely declare that I am in possession of an invention for † "Improvements in Sewing Machines;" that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.*

*And I make the above solemn declaration conscientiously*

*believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.*

‡ *John Smith.*

*Declared at Birmingham, in the county of Warwick, this  
day of 18 .*

*Before me,*

§ *James Adams,*

*Justice of the Peace.*

**NOTE.**—*Where the above declaration is made out of the United Kingdom, the words “and by virtue of the Statutory Declarations Act, 1835,” must be omitted; and the declaration must be made before a British consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.*

\* *Here insert name, address and calling of inventor.*

† *Here insert title of invention.*

‡ *Signature of inventor.*

§ *Signature and title of the officer before whom the declaration is made.*

## FORM B.

### FORM OF PROVISIONAL SPECIFICATION.

*(This Form is replaced by Form B, Patents Rules, 1890,  
see p. 740.)*

#### *Improvements in Sewing Machines.\**

*I, † John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do hereby declare the nature of my invention for “Improvements in Sewing Machines,” to be as follows:— ‡*

\*

\*

\*

\*

\*

§ *John Smith.*

*Dated this day of 18 .*

**NOTE.**—*No stamp is required on this document.*

\* *Here insert title as in declaration.*

† *Here insert name, address, and calling of inventor as in declaration.*

‡ *Here insert short description of invention.*

§ *Signature of inventor.*

## FORM C.

[£3 Stamp.] FORM OF COMPLETE SPECIFICATION.

(This Form is replaced by Form C, Patents Rules, 1890, see p. 740.)

*Improvements in Sewing Machines.\**

I, † John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do hereby declare the nature of my invention for "Improvements in Sewing Machines," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:—‡

\* \* \* \* \*

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is §

- 1.
- 2.
3. &c.

|| John Smith.

Dated this      day of      18 .

\* Here insert title as in declaration.

† Here insert name, address, and calling of inventor as in declaration.

‡ Here insert full description of invention.

§ Here state distinctly the features of novelty claimed.

|| Signature of inventor.

Section 33.

## FORM D.

FORM OF PATENT.<sup>1</sup>

Style and address (a).

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:<sup>2</sup>

Recital of

Whereas John Smith, of 29, Perry Street, Birmingham,

(a) These side-notes do not appear in the Queen's Printers' copy.

in the county of *Warwick, Engineer*, hath by his solemn declaration (b) represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

declaration  
and invention.

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

Petition of  
inventor.

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

Recital of  
specification  
of invention.

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:<sup>3</sup>

Recital of  
motive.

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion<sup>4</sup> do by these presents, for us, our heirs and successors,<sup>5</sup> give and grant<sup>6</sup> unto the said patentee<sup>7</sup> our especial licence, full power, sole privilege, and authority,<sup>8</sup> that the said patentee by himself, his agents, or licensees,<sup>9</sup> and no others, may at all times hereafter during the term of years herein mentioned, make,<sup>10</sup> use, exercise, and vend<sup>11</sup> the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man,<sup>12</sup> in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention,<sup>13</sup>

The grant,

to patentee,  
&c.

Extent of  
grant.

(b) *By his solemn declaration.*—These words are now omitted, since an applicant makes no solemn declaration, but merely an ordinary declaration without any formalities, as under the Statutory Declarations Act, 1885, which was contemplated by the

original forms of this schedule. By the new forms of the Patents Rules and the Act of 1885, sect. 2 (see *supra*, p. 430), there is now no solemn declaration, if *solemn* means something beyond a simple declaration.

Term of  
grant.

Prohibition  
against in-  
fringement.

Proviso for  
revocation by  
Crown or  
Privy Council.

Proviso avoid-  
ing patent if  
renewal fees  
not paid.

during the term of fourteen years<sup>14</sup> from the date<sup>15</sup> hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:<sup>16</sup> Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained:<sup>17</sup> Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and

in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained:<sup>17</sup> Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted:<sup>17</sup> And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.<sup>18</sup> In witness whereof we have caused these our letters to be made patent this<sup>19</sup>                      one thousand eight hundred and                      and to be sealed as of the                      one thousand eight hundred and<sup>20</sup>

Proviso in connection with Act of 1883, s. 27, sub-s. 2.

Proviso as to licenses.

Favourable construction.

Date.



Seal.

**1 Form of patent.**—The form here given is only applicable to the case of a single inventor, and it is obvious that considerable alterations must be made in the recitals, and the details of the wording of the patent in the very various forms which a grant may take. If there be several joint inventors, or several joint applicants, one or more of whom only are inventors, or in the case of applications by agents as importers, or where one of the applicants dies, or where an inventor dies before application, in all these cases alterations in the recitals and text of the patent must be made.

Variations in the form of patent.

It will be observed, that by the Act of 1883, s. 33, *supra*, p. 490, a patent may be in this form. Nothing is said about other forms, and there



are no rules issued by the Board of Trade on the subject. It has, however, always been customary to vary the formal parts of the patent as it is required in the office; and, indeed, several forms are printed for use, and these meet all the commoner cases. To meet rarer cases, one of the printed forms is altered in red ink. The printed forms in use have been much more fully punctuated than this form in the schedule; and in all of them the words "*by solemn declaration*" are now omitted.

There are kept in the Patent Office, in stock, eight forms, marked A, B, C, D, E, EE, F and G.

Form A.  
Grant to  
single in-  
ventor.

A is the form of grant to a single inventor, and follows the form in the schedule, except that, as with all the printed forms, the words "*by his solemn declaration*" are omitted, and the punctuation is fuller.

Form B.  
Joint  
applicants.

B is the form of grant to several joint applicants, all of whom are actual inventors. Where necessary the plural is used instead of the singular.

Form C.  
Importers.

C is the form of grant of a patent of communication, and the recitals are different. The patent runs—

VICTORIA, &c., greeting :

Whereas                    hath represented unto us that he is in possession of an invention for                   , that the said invention has been communicated to him from abroad, by                   , and that the same is not in use by any other person, to the best of his knowledge and belief :

And whereas the said declarant hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent for the sole use and advantage of the said invention :

And whereas the said declarant hath by and in his complete specification particularly described the nature of the said invention :

&c., &c., &c.

and then continues as in schedule.

Form D.  
Several appli-  
cants some  
inventors.

D is the form of grant to several applicants. It is in the plural throughout, and the recitals are slightly different. It runs—

VICTORIA, &c., greeting :

Whereas                    have represented unto us that they are in possession of an invention for                   , that                    the true and first inventor thereof, and that the same is not in use by any other person, to the best of their knowledge and belief :

And whereas the said applicants have humbly prayed that we would be graciously pleased to grant unto them (hereinafter, together with their executors, administrators, and assigns, or any of them, referred to as the said patentees) our royal letters patent for the sole use and advantage of the said invention :

And whereas the said applicants have by and in their complete specification particularly described the nature of the said invention :

&c., &c., &c.

E applies to cases where the inventor dies after the application for the patent and before the complete specification is left. It runs— Form E.  
Deceased  
inventor.

VICTORIA, &c., greeting :

Whereas represented unto us that he was in possession of an invention for that and that the same was not in use by any other person, to the best of his knowledge and belief :

And whereas the said declarant humbly prayed that we would be graciously pleased to grant unto him our royal letters patent for the sole use and advantage of his said invention :

And whereas the said declarant departed this life on the :

And whereas the said hath by and in his complete specification particularly described the nature of the invention :

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to grant to the said (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent :

&c., &c., &c.

the grant being to an executor or administrator.

EE is the same except that two or more executors are supposed to have the grant conferred on them jointly after the recital whereas the said declarant departed this life, &c. ; the rest of the patent is in the plural of Form E. Form EE.  
Grant to  
executors.

F.—This applies to the case of a female applicant, and is the same as Form A, except that *he* is changed to *she*, &c., as required. Form F.  
Feminine.

G.—This applies to the case of several joint applicants where one of the applicants die. It runs :— Form G.  
An applicant  
deceased.

VICTORIA, &c., greeting :

Whereas represented unto us that they were in possession of an invention for that and that the same was not in use by any other person, to the best of their knowledge and belief :

And whereas the said declarants humbly prayed that we would be graciously pleased to grant unto them our royal letters patent for the sole use and advantage of their said invention :

And whereas the said declarant departed this life on the :

And whereas the said have by and in their complete specification particularly described the nature of the invention :

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to grant to the said (hereinafter, together with their executors, administrators and

assigns, or any of them, referred to as the said patentees) our royal letters patent :

It will be observed that this form is framed so as to be easily altered to suit varying circumstances.

The *style* and *address*.

**2 Victoria . . . . greeting.**—These words constitute what are called in the old treatises the *style* of the Sovereign, and the *address* or *direction* to her subjects in general.

Letters patent commence in the name of the Sovereign, because although issued, formerly from the Court of Chancery, and now from the Patent Office(c), they are made by the Sovereign as the head of the executive Government, acting with the advice of her ministers, on behalf of the whole community; and the grant is made in her name in order that the authority by which the privilege is created and granted may be thus announced to all those who reside within that part of the United Kingdom to which the patent privilege extends (d).

For the *styles* formerly used by the Kings of England in letters patent, see Co. Litt. 7 a, 7 b; 2 Inst. 1. See also a form of grant in 1717, by James I., before the Statute of Monopolies, in the Appendix, at p. 848.

Letters patent are directed to all persons to whom they shall come, because they are public records, and all persons are bound to take notice of the grants which they contain. It is no defence for an infringer to allege that he was ignorant of the privilege which he has infringed(e).

Letters patent are under seal(f), because the Sovereign cannot grant but by matter of record(g).

Prior to the time of Richard II., the direction of letters patent was as follows:—*Omnibus archiepiscopis ducibus marchionibus countibus episcopis, &c. (h).*

The recitals.

**3 Whereas . . . . request.**—These clauses form the *recitals*, which contain a short statement of the substance of the inventor's declaration and petition for the grant, of the filing of the specification, and the motive of the Sovereign in making the grant.

Before, and under, the Patent Law Amendment Act, 1852, the word "petition" (i) appears in the grant of letters patent, instead of "solemn declaration," which was required by sect. 5 (j) of the present Act. The

(c) Act of 1883, s. 12, sub-s. 1, *supra*, p. 448.

(d) Hindmarch, p. 40.

(e) See 1 Co. R. 45 a; 1 Skin. R. 225; 4 Co. R. 71 b; 6 Co. R. 15 b; also Hindmarch, p. 40.

(f) Formerly the Great Seal; now (sect. 12, sub-sect. 1, p. 448), the

seal of the Patent Office.

(g) Com. Dig. Prerog.

(h) 2 Inst. 1.

(i) See Appendix, p. 667; and Old Forms of Letters Patent, pp. 848 and 850.

(j) See *supra*, p. 430.

words "by his solemn declaration" are now omitted in the form of grant, as the declaration is not now made under the Statutory Declarations Act, 1835 (*k*).

An inventor is not entitled to a patent as of right, but only by the grace and favour of the Crown (*l*). It is necessary that he should inform the Sovereign of his invention, and also that the information should in every material particular be correct. The representations made by the inventor are made at his own peril; they form the *consideration* for the grant; this consideration is *entire*, and if any part of it fail, the patent as a whole will be void, and may be set aside by a petition for revocation (*m*). The allegations in the petition as to the utility and novelty of the invention were the grounds on which the action of *scire facias* was prosecuted, and they are still available by Act of 1883, s. 26, sub-s. (3) (*n*), alike by way of defence to an action for infringement and as grounds of revocation.

Consideration  
for grant.

The present form of letters patent also contains a proviso empowering the Sovereign or any six members of the Privy Council to determine a patent privilege on the same grounds (*o*).

In the reign of John, the king was named in the singular number in his letters patent, but since that period the plural has been adopted (*p*).

Instead of the words, "that he is in possession of an invention," which appear for the first time in the form of letters patent prescribed by the Patent Law Amendment Act, 1852, the earlier recitals set forth "that he hath invented" (*q*), and if the patent was granted for an imported invention, the recital stated the representation in the petition thus: "That in consequence of a communication from a foreigner residing abroad, he is in possession of an invention . . . which the petitioner conceives will be of great public utility, and that the same is new within this realm, and hath not been practised or used therein by any person or persons, whomsoever to the best of his knowledge and belief, the petitioner therefore," &c. (*r*).

Recital of  
invention.

An invention being "any manner of new manufacture, the subject of letters patent and grant of privilege" within the meaning of the Utility.

(*k*) See Act of 1885, s. 2.

(*l*) See also Act of 1883, s. 116, at p. 525.

(*m*) Cp. *Hill v. Thompson*, 1818, 2 B. Moo. 424, per Dallas, J.; *Brunton v. Hawkes*, 1821, 4 B. & A. at p. 549, per Abbott, C. J.; *Kay v. Marshall*, 1839, 5 Bing. N. C. 501, per Tindal, C. J.; *Morgan v. Seaward*, 1837, 2 M. & W. 544. An immaterial mistake does not, however, vitiate a patent, e. g., a grant to a person as a knight, who in

truth was no knight, where the identity of the grantee sufficiently appeared: *R. v. The Bishop of Chester*, 2 Salk. 560; 5 Mod. 297; Show. P. C. 212.

(*n*) See p. 474.

(*o*) See *infra*, p. 545.

(*p*) 2 Inst. 2.

(*q*) See Old Forms of Letters Patent, Appendix, p. 851.

(*r*) Hindmarch, p. 628, n. (*x*).

Statute of Monopolies, sect. 6 (s), it is not necessary, though it was formerly usual (t), to insert in the recital a clause to the effect that the petitioner believes that his invention would be of great public utility.

Nature of invention.

In letters patent granted before the time when a specification began to be required, the nature of the invention was more or less fully set forth in the recital (u), and a patent without such a recital would most probably have been held void (unless it contained a proviso dispensing with it) by reason of the grant being too general and not sufficiently certain (x). As to the proviso by which an insufficient description of the nature of an invention was prevented from invalidating the grant of letters patent, see notes to the words "of our especial grace, knowledge, and mere motion" (y), and to the proviso for favourable construction (z).

Prerogative of Crown in trade matters.

The words "our royal letters patent for the sole use and advantage of his (a) said invention," point to the control which the Crown has always exercised over the trade of the country and to its common law prerogative (which the Statute of Monopolies merely regulated) of granting the exclusive right to trade with a new invention for a limited period (b).

Where complete specification in first instance under Act of 1852.

Where an inventor filed a complete specification in the first instance, under the power in that behalf conferred by the Patent Law Amendment Act, 1852, sect. 9, instead of within six months of the grant, the following clause was formerly added to the recital: "And whereas the said A. B. hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed," &c.

Recital.

Motive of Sovereign.

The words, "and whereas we being willing to encourage all inventions which may be for the public good," were introduced in substance in the earliest forms of letters patent (c); novelty and utility are thus by implication made essential conditions, and the encouragement of the arts is suggested as the motive of the grant. Consequently if these conditions and objects do not exist, or cannot be fulfilled, the

(s) See definitions, Patent Law Amendment Act, 1852, s. 55, *infra*, p. 664; and sect. 46 of the present Act, *supra*.

(t) See p. 851.

(u) Cp. *Small Patents*, 3 Jac. 1; 1 Web. P. C. p. 9; *Baker's Small Patent*, 6 Jac. 1; *ibid.* p. 11; *Mansell's Glass Patent*, 21 Jac. 1; *ibid.* p. 17.

(x) See Vin. Abr. Prerog. (C.c.) (F c.); see note to sect. 5, sub-sect. 5, *supra*, p. 431.

(y) *Infra*, p. 539.

(z) *Infra*, p. 540.

(a) Where an invention had been imported from abroad, it was formerly the practice to substitute "the said invention" for the clause which appears in the text.

(b) Cp. *Caldwell v. Vanvliissingen*, 1851, 21 L. J. N. S. Ch. 97; 9 Hare, 415, per Turner, V.-C.

(c) See Appendix, Forms, *infra*, p. 848.

Crown will have been deceived by false suggestions, and the letters patent will be void (*d*).

4 *Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion.*—The general rule of law that grants shall be construed most strongly against the grantor, and in favour of the grantee, was said to be reversed when the King was the grantor, unless the grant contained some special words indicative of the King's bounty (*e*). The words, "of our especial grace, certain knowledge, and mere motion," were inserted in letters patent in order that they might be construed more favourably for the grantee. "The deed of grant," says an old writer (*f*), "swells with imposing terms which are but the shadows of majesty. The 'certain knowledge and mere motion' turns out to be *clausula clericorum* (*g*), the prohibition useless to the infringer, the proviso for favourable construction useless to the patentee." This sweeping criticism, however, appears to have been unjust. It is thought that the following note accurately expresses the legal efficacy of the special words under discussion:—

The words "of our especial grace," imported that the grant proceeded solely from the grace and bounty of the Crown, and not from any right or title inherent in the grantee (*h*). The words "certain knowledge" implied that the Sovereign had knowledge of the subject-matter of the grant (*i*); but their scope was limited by the clause in the recital making the grant dependent on the representations of the grantee. The words "mere motion," imported that the grant proceeded from the bounty of the Sovereign, without any suggestion or suit by the grantee (*k*). It was, however, the duty of every applicant for letters patent to see that the Sovereign was correctly informed respecting the subject-matter of the grant (*l*); and the recital in the patent showing that the grant was made upon the petition of the patentee diminished the force of the words of grace, and prevented a patent from being reduced to the same standard of construction as the grant of a subject (*m*). What, then, was the practical effect of the

Especial  
grace.

Certain  
knowledge.

Mere  
motion.

(*d*) Webster's Letters Patent for Inventions, Practical Forms, p. 70, n. (*w*).

(*e*) 5 Bac. Abr. 602; 1 Web. P. R. 26; *Alton Wood's Case*, 1 Co. Rep. 27; *Priddle and Napier's Case*, 11 Co. Rep. 110; *R. v. Hussary*, 1738, 1 Web. P. C. 41; *Dobbs v. Penn*, 1849, 3 Exch. 427; *Carpenter's Screw Propeller*, Times, July 11, 1854.

(*f*) Turner, Remarks upon Patent Law, 1851, p. 19.

(*g*) See *Needler v. Bishop of Winchester*, Hob. 221, 222.

(*h*) *Brunton v. Hawkes*, 1821, 4 B. & A. 552, per Bailey, J.

(*i*) A charter in which the words *ex certâ scientiâ* occurred was said to be "assertive" and not "suggestive": 1 Co. 44 a; 10 Co. 112 b; 3 Levinz, 249; Plowd. 502 b.

(*k*) 10 Co. 112 b; Vin. Abr. Prerog.; Bac. Abr. Prerog.; Com. Dig. Grant.

(*l*) 1 Co. R. 52 a.

(*m*) *R. v. Capper*, 1817, 5 Price, 217; 1 Co. R. 46 a, 46 b.

words of grace and bounty? It seems they cured many defects and irregularities which would otherwise have vitiated the grant (*n*). Possibly apart from, and certainly when taken along with, the proviso for favourable construction, they provided that a patent should be valid notwithstanding it did not contain a full and certain description of the invention (*p*). They did not, however, cure a false suggestion on the part of the grantee (*q*). Nor did they authorise any construction against the plain intent and purpose of the grant (*r*).

For us, our heirs, &c.

5 *For us, our heirs and successors.*—The object of inserting the words “for us, our heirs and successors,” is to show that the grant is to continue in force during the whole of the term granted, notwithstanding the demise of the Crown (*s*). It seems, however, that these words are not necessary in order to make the grant binding upon the Queen’s successors (*t*).

Give and grant.

6 *Give and grant.*—The words “give and grant” are the proper operative words in a patent for an invention with regard not only to the Queen, who is grantor, but also to the nature of the grant (*u*).

Definition of patentee.

7 *Patentee.*—The definition of patentee, given by sect. 46 of the present Act, as the person for the time being entitled to the benefit of a patent, renders the insertion of the words executors, administrators, or assigns, as in the earlier forms (*x*) of letters patent, unnecessary.

Especial license.

8 The words “especial license, full power, sole privilege, and authority,” give the patentee a right to exclude all others from the use or exercise of his invention during the patent term.

Agents or licensees.

9 *By himself, his agents or licensees.*—These words are important. For the variation in them where there are several patentees, see *supra*, pp. 533 *et seq.* As to the position of co-owners of a patent, see pp. 192 *et seq.*

The persons authorised to exercise the patent privilege are enume-

(*n*) Webster’s Letters Patent for Inventions, Practical Forms, p. 76, n. (*d*); and 1 Web. P. C. at p. 41; *R. v. Museary*, 1738, *ibid.*; 1 Co. R. 53 a.

(*p*) Hindmarch, pp. 72, 73.

(*q*) *Legal’s Case*, 10 Co. R. 109; *Barwick’s Case*, 5 Co. R. 94; *Cholmley’s Case*, 2 Co. R. 54; *Auditor Curle’s Case*, 11 Co. R. 4; *Eurl of Devonshire’s Case*, 11 Co. R. 80;

*Travell v. Carteret*, 3 Lev. 135; *Alcock v. Cooke*, 1829, 5 Bing. 340; *Morgan v. Seaward*, 1837, 1 Web. P. C. at p. 196.

(*r*) *Alton Wood’s Case*, 1 Co. R. 49 a, 52 b, 53 a.

(*s*) Hindmarch, p. 52.

(*t*) Com. Dig. Grant (G. 3).

(*u*) Shop. Touch. 228.

(*x*) See *infra*, pp. 667, 848, 850.

rated lest any of them should be subject to punishment for creating a monopoly without sufficient authority (*y*).

10 The word *make*, which is within the exception of the Statute of Make. Monopolies, is intended to signify the sole privilege of exercising the invention in the making of articles by manufacture.

11 The word *vend* has given rise to some difficulty. By the first sec- Vend. tion of the Statute of Monopolies, patents granting "the sole buying, selling, making, working, or using of anything" are declared to be void, and the proviso in favour of inventions contained in the sixth section extends only to "grants of privilege of the sole working or making of any manner of new manufactures," leaving the sole buying or selling of anything within the prohibition of the first section of the statute. It seemed, therefore, that a grant of the sole right to *vend* an invention was contrary to the first section of the statute, and not within the meaning of the proviso.

The following considerations, however, dispose of this difficulty:—

The things produced by the exercise of a patent invention must be manufactures, or *vendible* articles, capable of being made the subject of transaction in trade and commerce. But the object of the law in permitting the grant of letters patent is to reward such inventors as shall give to the public the benefit of useful inventions; and that reward is the profit to arise from the exercise or sale of the invention during the patent term.

"Whether a patentee makes and sells those articles himself, or is merely paid by others for making them, it is quite clear that his reward must be derived from the same source; and as no one can use the invention except the patentee, none besides him can lawfully have such articles for sale.

"The sole right to vend articles made by means of a patent invention is, therefore, not only necessarily incident to the privilege granted by the patent, but is also absolutely necessary to enable the patentee to obtain the reward which the law intends for him; and although the exception contained in the 6th section of the Statute of Monopolies, does not expressly save the right of the Crown to grant the sole privilege of vending such articles, there can be no doubt that it is implied; and, indeed, all patents made since the passing of the statute have invariably granted patentees the sole privilege of vending their patent articles, and this shows the construction put upon the statute, not only at the time it was made, but ever since" (*z*).

As to infringement by "vending," see pp. 217 *et seq*.

(*y*) Bac. Abr. tit. Monop. A.

(*z*) Hindmarch, p. 55. Cp. *Minter v. Welle*, 1835, 4 A. & E. 251.



Extent of  
grant.

12 *United Kingdom of Great Britain and Ireland, and Isle of Man.*—Prior to the Patent Law Amendment Act, 1852, s. 18 (a), letters patent obtained in England conferred an exclusive privilege only within England, Wales, Berwick-upon-Tweed, the Channel Islands, the Isle of Man, and the Colonies and plantations abroad, if so expressed in the grant (b). Patents for Scotland and Ireland were required to be taken out under the Great Seals of these countries respectively (c). The hardship which might possibly arise from the exclusion of Scotland and Ireland from an English patent is brought out by a case—apparently hypothetical—put by a witness, a sugar refiner at Liverpool, in his evidence before the Parliamentary Commission of 1851 (d). Suppose that there were two rival sugar refiners, A. and B., carrying on business, one in England, the other in Ireland, and that C. invented an improved process for refining sugar. The expense of taking out a patent in Ireland was very considerable; and the sugar and molasses refining trade in that country was of very limited extent. C. therefore patented his manufacture in England alone. The result was, that A. was obliged to pay patent charges to C. for the use of his new process, while his rival on the other side of St. George's Channel was exempt from any such liability.

Colonies and  
plantations  
abroad.

Letters-patent granted under the Patent Law Amendment Act, 1852, extended to the United Kingdom of Great Britain and Ireland, the Channel Islands, the Isle of Man, and, in case *Her Majesty, by warrant under her royal sign manual so directed, to her colonies and plantations abroad* (sect. 18) (e). The power, hereby reserved to the Sovereign, of including the colonies in letters patent granted after the Act of 1852, was not exercised; and in January, 1853, a letter was addressed on behalf of the Secretary of State to the colonial authorities, making inquiries of the colonial governments on the subject, the result of which was the passing of the various Acts and ordinances under which patents are issued in British India and the Colonies (e).'

(a) This Act came into operation on 1st October, 1852.

(b) See Forms, Petition, *infra*, p. 665; and Old Form of Letters Patent, *infra*, p. 851. The usual custom was, when an invention was supposed to be applicable to the Colonies as well as to England, that the parties petitioned the Crown for letters patent in England and the Colonies; and the Crown granted a patent according to the prayer of the petition. It also granted a further privilege through the Privy Council of enabling the patentee in the Crown Colonies to deposit official or authenticated copies of the patent and the specification,

so that they should be as good evidence as the production of the original documents: Report, 1851, p. 65, Ans. 390.

(c) 6 Ves. 708.

(d) Report, &c., 1851, p. 151, Ans. 975 *et seq.*

(e) Letters patent for England prior to 15 & 16 Vict. c. 83, frequently included, as has been said, the Colonies and plantations abroad; but such grants did not extend to the East Indies, that territory not being regarded in law as a colony or plantation, but as a dependency or possession: Report on Letters Patent, 1872, Appendix A. at p. 157.

The Channel Islands, which were introduced, on the solicitation of Mr. W. Carpmael, by Sir John Campbell (Attorney-General), and Sir R. M. Rolfe (Solicitor-General) into letters patent, granted November, 1838 (*f*), are omitted from sect. 16 of the present Act. Channel Islands.

13 In the form of letters patent which was in use before (*g*), and under (*h*), the Patent Law Amendment Act, 1852, the manner in which the patent privilege was to be exercised was left, as it substantially is in the present form, to the discretion of the patentee. Exercise of invention.

Mr. Hindmarch (*i*) expresses a doubt whether a patentee was bound under that clause to exercise his patent at all during the continuance of his right. The declaration in an action for infringement always, indeed, alleged that the plaintiff had "made, used, exercised, and vended the invention to his great advantage and profit;" but the object of this allegation was to show that the plaintiff had been injured by the invasion of his privilege, and that the patent did not confer upon him a bare right of no utility or benefit; and it was never decided that a patentee must have exercised his invention in order to enable him to prevent others from infringing his patent right.

There was, however, usually inserted in the form of letters patent a proviso requiring the patentee to supply articles of his invention for the service of the Crown, in such manner, at such times, and upon such terms as might be settled by the officers or commissioners requiring the same; and, independently of the new provisions as to compulsory licences (sect. 22, *supra*, p. 461), a grant of letters patent might probably be avoided as "prejudicial and inconvenient" to the Sovereign's "subjects in general" (*k*), if it were made to appear to the Privy Council that the patentee was not exercising his privilege. Saving of rights of Crown.

The term of a patent includes the day of its date (*l*).

14 *Fourteen years.*—Patents are now always granted for fourteen years, as provided by Act of 1883, sect. 17, sub-s. 1. But it seems the Sovereign might grant a patent for a less time (*m*).

15 *Date.*—A patent is sealed as of the day of application (*n*). This ante-dating is a curious contrivance, under which the advantages of provisional protection are obtained without further special provisions being required as to anticipation, priority, &c. It is also adopted in applications under the International and Colonial Arrangements.

After the clause defining the extent of letters patent, there was *Habendum.*

(*f*) Webster's Letters Patent for Inventions, p. 15, n. (*y*).

(*g*) See *infra*, p. 850.

(*h*) See *infra*, p. 667.

(*i*) Page 56.

(*k*) *Infra*, p. 545.

(*l*) *Russell v. Ledsam*, 1843-8, 14 M. & W. at p. 382. See sect. 17, sub-sect. (1), *supra*, p. 454.

(*m*) See Act of 1883, s. 116.

(*n*) Act of 1883, s. 13.

formerly inserted in the grant what was technically called the *Habendum* (*p*), declaring that the inventor, his executors, administrators, and assigns, should have and enjoy the privilege according to the statute in such case made and provided. From this clause it was clear that the grant was intended to be made subject to the conditions required by the Statute of Monopolies (*q*).

Prohibitory  
part of grant.

16 *And to the end . . . . thereby occasioned.*—This is the *prohibitory* part of the grant. It has been referred to already, under the head of infringement (*r*).

All persons are bound to take notice of the grant of the Crown, and the object of the prohibition is to warn them of its effect and what the law requires them to abstain from doing (*s*). The prohibition extends to all subjects of the Crown living within those parts of the realm to which the privilege extends, and it operates during the whole term of the patent. The granting and the prohibitory parts differ in the terms employed, those of the former being, “make, use, exercise, and vend;” those of the latter, “make use of, or put in practice.” The prohibitory words, however, are in aid of the grant and not in derogation from it (*t*), and will receive from the Court the construction which will effectuate the purpose of the patent and prevent acts injurious to the patentee, with as little restraint on the public as possible (*u*). The omission of the word “vend” from the prohibition will not, therefore, diminish the effect of the preceding grant. The words “put in practice” appear from the declaration of intention at the commencement of the clause to be synonymous with “exercise.”

Prior to the Statute of Monopolies, questions on patent rights were determined in the Star Chamber, and infringements were punishable as contempt of royal authority (*x*). In addition to his equitable and common law remedies of injunction and damages, a patentee was enabled by 5 & 6 Will. IV. c. 83, s. 7, to recover a penalty of 50*l.* against any person who had made an unauthorised use of his name (*y*). This statute was, however, repealed by the present Act (*z*).

See sections 105 and notes thereon (*a*).

(*p*) See Appendix, Forms, *infra*, p. 851.

(*q*) Hindmarch points out (p. 63) that this clause was in itself sufficient to dispose of the supposition, which, he says, received some countenance in *Brown v. Annandale*, 1841-42, 1 Web. P. C. 433, that the effect or intent of a patent was to grant a privilege on the terms merely of the conditions comprised in the patent, excluding all others.

(*r*) See p. 216.

(*s*) Hindmarch, p. 60.

(*t*) *Caldwell v. Vanvliissingen*, 1851, 21 L. J. N. S. Ch. 97; 9 Hare, 415, per Turner, V.-C.

(*u*) *Minter v. Williams*, 1835, 4 A. & E. 251, per Coleridge, J.

(*x*) 3 Inst. 182, 183. See also pp. 247 *et seq.*

(*y*) See Appendix, p. 639.

(*z*) See also pp. 368 *et seq.*

(*a*) *Supra*, p. 519.

The prohibition formerly contained a command by the Sovereign to all justices, officers, and ministers, not to molest the patentee in the lawful use and exercise of his invention at any time during the patent term (y). The reason for this clause being inserted is thus explained by Hindmarch (z). "All monopolies, except those preserved by the provisoes in the Statute of Monopolies, are contrary to law, and persons who put them in force may be punished by fine and imprisonment. The grant to a patentee of the sole use of his invention being a lawful grant, this clause seems to have been introduced into the patent as a protection to the patentee, so that if he were to be charged before any justices or officers of the Crown with putting an illegal monopoly in force, he might produce his patent to them in proof of his right, and to show by the command contained in it that they had no power to proceed against him."

17 *The three provisoes.*—These provisoes constitute the *conditions of* Provisoes. *the grant* of letters patent. The first makes a grant revocable by the Sovereign, or any six members of the Privy Council, for certain causes mentioned in the proviso. A similar power of summary revocation has been inserted in all letters patent granted since the Statute of Monopolies, but no authentic (a) instance of its exercise is on record, and it is difficult to see how it could be exercised. In *Reg. v. Eastern Archipelago Co.* (b), the Court of Queen's Bench was equally divided as to the effect of a similar condition upon proceedings by *scire facias* to repeal a charter granted to an incorporated company. In the opinion of Campbell, C. J., the proviso gave only an additional and cumulative remedy, by enabling the Crown in a summary manner to revoke the charter or modify it.

The object of this proviso is thus explained by Hindmarch (c): "The grant of a patent is a matter of grace and favour, and therefore . . . . the Crown may annex any condition it pleases to the grant; and this condition seems to have been inserted with the view of enabling the Crown to determine any illegal grant which may be unadvisedly made, without allowing the public to be put to the trouble or cost of resisting the unlawful patent."

The revocation, if by the Sovereign, must be either under the signet or the Privy Seal; if exercised by the Privy Council, it must be under the hands of six or more members thereof.

The grounds of revocation under this proviso are—(1) that the grant

(y) See Form, *infra*, p. 850.

(z) Page 61.

(a) Hindmarch suggests (p. 432) that it was probably under this or a similar proviso that Queen Elizabeth was enabled to recall the patents

for monopolies, which were found to be so grievous to the public during her reign.

(b) 1853, 21 L. T. 35.

(c) Page 431.

is contrary to law, or prejudicial or inconvenient to the people of the kingdom in general, (2) that the invention is not new as to public use, or (3) that the patentee is not the first and true inventor thereof within the realm. Of these grounds, the first is merely an affirmance of the common law (*d*), corroborated by the Statute of Monopolies (*e*), that letters patent which are contrary to law or common justice, or prejudicial or inconvenient to her Majesty's subjects, are null and void; the second expresses the conditions of novelty and non-user, the third also is declaratory of the common law, and in accordance with the Statute of Monopolies.

Prior user.

Prior to the Patent Law Amendment Act, 1852 (*f*), the proviso, avoiding a grant of letters patent if the invention was not new, or the grantee was not the true and first inventor, ran thus: "or that the said invention is not a new invention as to the public use and exercise thereof in that part of our United Kingdom of Great Britain and Ireland called England, our Dominion of Wales, and Town of Berwick-upon-Tweed (*g*), aforesaid, or not invented and found out by the said (A. B.) as aforesaid." This form was adopted at a time when the realm only included England, Wales, and Berwick-upon-Tweed; and the alteration in the law, produced by the union with Scotland and Ireland, not being adverted to, the officers of the Crown adhered to the old form which was in use before the alteration of the law. The opinion, however, which for some time prevailed in the legal profession, that it was only necessary for an invention to be new *within the districts mentioned in the above form*, was definitely rejected by the House of Lords in *Brown v. Annandale* (*h*), in which a Scotch patent was held to be invalidated by prior public user in England.

*Brown v.  
Annandale.*

In the form prescribed by the Patent Law Amendment Act, 1852 (*f*), the condition, as in the present form, required an invention to be new within the realm.

Up to the date of the present Act, the form of letters patent contained a proviso that the patent should not affect any former grant (*i*). In some cases letters patent under the Great Seal—containing, for example, a new commission of the peace—operate so as to determine the powers or privileges conferred by previous letters patent. The proviso, under consideration, seems to have been inserted in order to except letters patent for inventions from this general rule, and to prevent the rights of different patentees from clashing with each other. This express stipulation was, however, unnecessary, for it was clearly the law, that

(*d*) Shep. Abr. Prerog. 48, ss. 6, 7; Godbolt, 254.

(*e*) 21 Jac. 1, c. 3, s. 6.

(*f*) See Forms, Appendix, p. 852.

(*g*) The Channel Islands, the Isle of Man, and the Colonies and planta-

tions abroad, were added, if necessary.

(*h*) 1841, 1842, 1 Web. P.C. 433; *Roe-buck and Garbett's Case*, 1774, 1 Web. P.

C. 49. Cp. Hindmarch, pp. 63, 64.

(*i*) See Forms, Appendix, p. 852.

if the Sovereign by his letters patent granted the same thing to several persons, a *scire facias* would be for the repeal of the last patent (*k*).

Letters patent are frequently granted for an improvement on an existing patent, but where the improvement could not be used without the original invention, the subsequent patentee cannot make use of the former patent without licence, during the continuance of the term (*l*).

Prior to the Patent Law Amendment Act, 1852, a proviso was inserted in letters patent against the assignment of the patent privilege to more than *twelve*—(before 1832, to more than *five*)—persons at any one time, *entitled to divide the profits as partners* (*m*). This clause was introduced in conformity with the Statute 6 Geo. I. c. 18, against the unlimited raising of transferable shares, and its object was double—viz. to prevent the public being imposed upon by specious projects under the colour of letters patent, and to avoid the oppression which, it was thought, would be practised if powerful companies were allowed to become possessed of patent privileges (*n*). This proviso applied only to assignments by act of party, and not to assignments by operation of law (*o*) and any number of licences, exclusive or common, might be granted, in spite of it (*p*). Whenever it was desired to transfer a patent to a company of more than twelve persons, an Act of Parliament was necessary. Many such special Acts were passed before the Act of 1852.

Proviso against assignment to more than twelve.

As to the proviso for the enrolment of a specification under the Act of 1852, and the origin and introduction of the specification itself, see p. 83 *et seq.*

Proviso for enrolment of specification.

As to the fees payable by a patentee, see *infra*, p. 550.

Proviso as to fees.

“In manner for the time being by law provided.”—These words are new. In previous forms of letters patent, the settlement of the terms of the supply of patented articles for the public service was left to the department requiring it; and considerable hardship was sometimes caused to the patentees thereby. In the evidence of a witness (*q*) before the Select Committee of 1851 (*r*) was mentioned the following case: A large number of vessels had been supplied with patent screws by the Admiralty. The whole amount of horse-power applied to such screws was upwards of 12,500 horse-power.

(*k*) Hindmarch, p. 65; Coryton's Law of Patents, p. 172, n. (*y*), and authorities there cited.

(*l*) *R. v. Lister*, 1826, Webster's Letters Patent, p. 80, n. (*f*); *R. v. Fussell*, *ibid.*; *Cochrane v. Braithwaite*, 1830, *ibid.* p. 79; *Crane v. Price*, 1242, 1 Web. P. C. 413. Cp. also *Harmer v. Playne*, 1807, 14 Ves. jun. 130; *Ex parte Fox*, 1812,

1 Ves. & B. 67; *Lewis v. Davis*, 1829, 3 C. & P. 502.

(*m*) Appendix, p. 853.

(*n*) Hindmarch, p. 66.

(*o*) *Bloxam v. Elsee*, 1825, 6 B. & C. 169.

(*p*) *Protheroe v. May*, 1839, 1 Web. P. C. 414.

(*q*) Mr. J. B. Westhead, M.P.

(*r*) Page 352, Ans. 2661, 2662.

The Admiralty paid at the rate of 2*l.* per horse-power for the patent-right on 2,420 horse-power, and then declined to pay upon the remainder. There were various grounds for the refusal, sometimes that the Crown was not liable, sometimes that they had no certainty that the parties who claimed under the patents were the only parties or the right parties. The whole sum received by the inventors from the Admiralty in respect of these inventions, which had cost them not less than 56,000*l.*, was about 4,840*l.*

It appears that the proper remedy of a patentee against a public department refusing to settle terms according to the patent was by petition of right, and not by mandamus (*r*); and this is still the law in the case of patents existing before the commencement of the present Act, to which the provisions of sect. 27, as to patents binding the Crown, do not apply (*s*).

Proviso as to licences.

The proviso authorising the grant of licences was, prior to the Patent Law Amendment Act, 1852, inserted in the grant of letters patent immediately after the condition against assignment to more than twelve persons as partners. The interest of a licensee under letters patent is totally of a distinct nature from that of the assignee of a part: the latter is a partner dividing or entitled to divide the profits with the other assignees, whereas the former has acquired only a right of user for some assigned or assignable consideration (*t*).

Favourable construction.

18 As to the effect of the proviso for favourable construction, see *supra*, p. 540.

Name letters patent.

19 *In witness whereof*.—The name “letters patent” is derived from this clause, which occurs in the old forms also, by which it is in effect declared that the Queen makes her grant “patent,” or known to all persons, by passing it under the Great Seal, or now the seal of the Patent Office (*u*).

Conclusion.

The formal conclusion, which was in use till 1852, ran thus: “In witness whereof we have caused these our letters to be made patent. Witness ourself at Westminster, this                      day of                      , in the year of our reign.”

Patents for inventions were always tested in the name of the Sovereign.

Date.

20 *Date*.—In *Lord Zouch and More's Case* (*v*) it was laid down that “the King's patent may be without date; for he may resort to the enrolment and the Privy Seal to help it.” But the statute 18 Hen VI.

(*r*) *Ex parte Pering*, 1836, 4 A. & E. 949. Cp. *Walker v. Congreve*, 1816, Coop. 1 P. C. 356.

(*s*) See also sect. 45, sub-s. (2), *supra*, p. 500.

(*t*) Webster's Letters Patent, p. 83, n. (*v*), (*p*).

(*u*) 2 Inst. 78.

(*v*) Godbolt, 416.

c. 1, s. 1, provided that letters patent should bear date the day of the delivery of the Privy Council bill to the Chancellor, and that letters patent made to the contrary should be void. Under sect. 13 of the present Act, every patent is dated as of the day of application, and the term runs from that date inclusive.

Letters patent had formerly subscribed to them the words "By warrant," or "By writ of Privy Seal," to show that the patent had been made in pursuance of a command contained in the Queen's writ, or warrant under her Privy Seal (*x*).

At the bottom was written the name of the clerk of patents (*y*), and a heavy wax impression of the Great Seal was affixed to the document, as is still done in those letters patent for other royal grants to which the wafer Great Seal is not affixed. The Great Seal gave authority to the document; all persons were bound to take notice of it, and it was admissible in evidence without further proof.

21 *The Seal of the Patent Office* has now (sect. 12, sub-s. (2)) the same effect as the Great Seal of the United Kingdom. From the 1st October, 1852, when the Patent Law Amendment Act came into force, to the 1st March, 1878, the impression of the Great Seal was always appended to the parchment. At the latter date, under the Crown Office Act, 1877, sect. 5, and the rules made by the Privy Council (*z*) thereunder, letters patent for inventions were sealed with the wafer Great Seal. Since 1st January, 1884, the seal of the Patent Office is impressed on the letters patent.

### Form E.

Section 47.

#### FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

*See Designs Rules, 1890.*

### Form F.

Section 62.

#### FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

*See Trade Marks Rules, 1890.*

(*x*) 2 Inst. 555, 556; 8 Co. R. 18 b.  
(*y*) See 3 & 4 Will. IV. c. 84.

(*z*) See *London Gazette*, March 5, 1878.

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Section 24.

## THE SECOND SCHEDULE.

*Fees\* on Instruments for obtaining Patents, and Renewal.*(a) *Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection . . . . .	1	0	0			
On filing complete specification . . . . .	3	0	0			
	<hr/>			4	0	0
				<hr/>		
<i>or,</i>						
On filing complete specification with first application . . . . .				4	0	0

(b) *Further before end of four years from date of patent.*

On certificate of renewal . . . . .	50	0	0†
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\* Should the renewal fees not be paid in due course, an enlargement of time for payment may be made, subject to the following penalties :—

	£	s.	d.
Not exceeding one month - - - - -	3	0	0
„ „ two months - - - - -	7	0	0
„ „ three months - - - - -	10	0	0

† The provisions for the payment of this fee are retrospective, and apply to patents applied for prior to Act of 1883, so that the time for the payment was extended from the third to the fourth year, and might be effected either in one sum or by annual instalments commencing at the fourth year from the date of the patent.

(c) *Further before end of seven years, or in the case of patents granted after the commencement of this Act, before the end of eight years from date of patent.*

On certificate of renewal ..... 100 0 0‡

*Or in lieu of the fees of £50 and £100 the following annual fees:—*

Before the expiration of the fourth year from the date of						
			the patent	10	0	0
”	”	fifth	”	10	0	0
”	”	sixth	”	10	0	0
”	”	seventh	”	10	0	0
”	”	oighth	”	15	0	0
”	”	ninth	”	15	0	0
”	”	tenth	”	20	0	0
”	”	eleventh	”	20	0	0
”	”	twelfth	”	20	0	0
”	”	thirteenth	”	20	0	0

*Fees on Patents under the Old Law before Act of 1852.*

It may be interesting at this place to give an account of the fees payable before 1852. The old procedure is thus rendered more easy of appreciation.

The fees under the Act of 1852 appear in the schedule to that Act. See Appendix, p. 665.

Previously to the Patent Law Amendment Act of 1852, letters patent, passed under the Great Seal of England, extended only to Former fees.

‡ In the case of patents granted before the commencement of the said Act, a patentee who has paid the prescribed fee of 50*l.* may, in lieu of the prescribed fee of 100*l.* payable before the end of seven years from the date of patent, pay the following annual fees:—

Before the end of the seventh year from the date of						
			the patent	10	0	0
”	”	eighth	”	10	0	0
”	”	ninth	”	10	0	0
”	”	tenth	”	15	0	0
”	”	eleventh	”	15	0	0
”	”	twelfth	”	20	0	0
”	”	thirteenth	”	20	0	0

This reduction was made by the Board of Trade in August, 1884.

England, Wales, and Berwick-upon-Tweed. The following (b) is a table of the fees which were then payable upon a

PATENT FOR ENGLAND.

		Secretary of State's	£	s.	d.	£	s.	d.
		Reference .....	2	2	6			
		Warrant .....	7	13	6			
		Bill .....	7	13	6			
			<hr/>			17	9	6
		Mr. Attorney-General's						
		Report .....	4	4	0			
Stamps..	£ s. d.	Bill .....	15	16	0			
	6 0 0		<hr/>			20	0	0
		Signet Office,						
		*Fees .....	3	1	0			
		Gratuity .....	1	1	0			
		Office keeper .....	0	5	0			
			<hr/>			4	7	0
		Privy Seal,						
		*Fees .....	2	16	0			
		Gratuity .....	1	1	0			
		Office keeper .....	0	5	0			
			<hr/>			4	2	0
		Great Seal Office,						
		†Fees .....	5	17	8			
	30 2 0	Stamps .....	30	2	0			
		Boxes .....	0	9	6			
		Gratuity .....	2	2	0			
		Hanaper .....	7	13	6			
		Deputy .....	0	10	6			
		Recipi .....	1	11	6			
		Sealers .....	0	10	6			
		Office keeper .....	0	5	0			
			<hr/>			49	2	2
		Passing of the Patent .....				10	10	0
		Letters, &c. ....				1	1	0
	5 0 0	Specification according to its length ..						
Stamps	£41 2 0					£106	11	8

\* The fees for two names at the Signet and Privy Seal were as follow:—

Signet Office,	£	s.	d.	Privy Seal Office,	£	s.	d.
Fees and Stamps .....	7	13	0	Fees and Stamps .....	7	8	0
Gratuity .....	2	2	0	Gratuity .....	2	2	0
Receiver and Assistant Clerk	0	10	6	Record Keeper.....	0	10	6
	<hr/>				<hr/>		
	£10	5	6		£19	0	6

† Every additional name was charged £2 13s. 4d. at the Great Seal.

The colonies and Channel Islands.

A patentee might, however, if he desired it, have his patent extended to the Colonies and the Channel Islands by a slight alteration in the prayer of the petition. The additional expense of including either or both amounted to 7*l.* 7*s.* 6*d.*: viz., 1*l.* 7*s.* 6*d.* both on the warrant and on the bill, 2*l.* 5*s.* both at the Signet and the Privy Seal, and 2*s.* 6*d.* on the Attorney-General's bill (c).

(b) Report, &c., 1820, Evidence of Mr. Moses Poole, p. 87. See also Webster's Letters Patent for Inven-

tions, p. 123.

(c) Webster's Letters Patent for Inventions, p. 123.

The Channel Islands do not seem to have been included in letters patent till 1838; and applications for patent privileges in the Colonies and plantations abroad were rare, partly because the inventions which would be chiefly used in the Colonies were not numerous, and partly because in those Colonies which possessed local legislatures proceedings for infringement could not be taken in a local Court of justice unless an express Act of the Colonial Legislature had been applied for at the time when the patent in this country had been obtained (*e*).

Reasons why grant seldom extended to the colonies.

An English patentee, who desired to have his privilege protected in Scotland and Ireland, was obliged, prior to the Patent Law Amendment Act, 1852, to take out a separate patent for each of these countries. The following Table (*f*) will show the cost of the

Scotch and Irish patents.

## PATENT FOR SCOTLAND.

Scotch patent.

£ s. d.		£ s. d.	£ s. d.
	Secretary of State's		
	Reference .....	2 2 6	
1 10 0	Warrant .....	15 7 0	
	Stamp .....	1 10 0	
		18 19 6	
	Lord Advocate's		
	Report .....		4 4 0
	Director .....	15 0 0	
	Clerk .....	7 10 0	
	Translator .....	1 1 0	
	Director .....	1 1 0	
	Servant .....	0 2 6	
	Livery .....	0 3 7½	
	Extra .....	0 2 6	
		25 0 7½	
	Great Seal,		
	Lord Keeper .....	6 13 4	
	Deputy .....	2 10 0	
	Usher .....	2 4 5½	
	Appendee .....	2 2 0	
	Deputy .....	1 1 0	
	Wax .....	0 7 6	
	Extra .....	0 2 6	
	Agents .....	4 4 0	
		19 4 9½	
	Passing Patent .....		10 10 0
	Letters .....		1 11 6
	Specification according to length .....		
5 0 0			£79 10 5
Stamps	£6 10 0		

A patent for Scotland was obtained more expeditiously than a patent for England. As soon as the Lord Advocate had made his report—similar to the Attorney-General's report in England—the Sovereign

(*e*) This was done in the case of molasses from sugar: Report, &c. 1829, p. 18.

(*f*) Report, &c., 1829, *ubi supra*.

issued a warrant, which was in substitution for the Bill used in England. The royal signature was only required once for a Scottish patent (*g*).

Irish patent.

The mode of taking out a patent for Ireland was as follows (*h*):— The first step was an affidavit and petition to the Sovereign, as in England, but the prayer was for a patent in Ireland, instead of in England, Wales, and Berwick-upon-Tweed. Then the petition was referred to the Attorney and Solicitor-General for Ireland, after which it went before the Lord-Lieutenant, who referred it to the Attorney and Solicitor-General for report. Then it came back to England for the King's letter, which was similar to the warrant on an English patent. After this the King's letter was sent to Dublin, and the patent, having passed through several offices, was granted under the Great Seal of Ireland. An Irish, like a Scotch, patent received the royal signature only once.

The following Table (*i*) will show the cost of taking out a separate

PATENT FOR IRELAND.

£ s. d.			£ s. d.			£ s. d.			
			Secretary of State's						
			Reference .....	2	2	6			
			Warrant .....	7	13	6			
Stamp ..	1	10	Stamp .....	1	10	0			
				<hr/>			11	6	0
			Mr. Attorney-General's and Solicitor-						
			General's Report .....				31	10	0
			Paid entering at Signet Office .....				3	3	0
			" " " Seal Office .....				2	14	6
			Lord Lieutenant for fiat .....				5	5	0
			Mr. Attorney-General and Clerk for fiat				11	0	3
			Clerk of the Hanaper .....				8	9	2
	23	13	Stamp to the Grant .....				21	13	4
			Enrolling .....				1	1	8
Stamp to			Further Fees paid in Ireland .....				21	2	6
Specifi-	1	0	Passing the Patent .....				10	10	0
cation..		0	Letters .....				0	10	6
	<hr/>						<hr/>		
	£26	3					£128	5	11

It thus appears that the cost of taking out separate patents for

(*g*) In *Brown v. Annandale*, 1842, 1 Web. P. C. 433, it was held that the public use of an invention in England prior to the date of letters patent for Scotland would invalidate such letters patent. Cp. *Roebuck v. Stirling*, 1774, 1 Web. P. C. 48; *Re Pow*, 1845, 2 Web. P. C. 5, reported as *Robinson's Patent*, 5 Moo. P. C. 65. Neither in *Roebuck's* nor in *Brown's* case, however, was the grantee of the patent

the true and first inventor in England, and the above decision did not apply to a case in which the true and first inventor in one part of the realm was the grantee of the letters patent in the other part: 1 Web. P. C. 454, n.; *Magill v. Ewing*, 11 Ir. Jur. N. S. 164.

(*h*) Report, &c., 1829, Evidence of Mr. Francis Abbott, at p. 50.

(*i*) Report, &c., 1829, p. 88.

England, Scotland, and Ireland amounted to about 350*l.*, a sum which attorneys' bills and other incidental expenses are said to have raised to 400*l.* or 500*l.*

Under the Patent Law Amendment Act, 1852, letters patent extended to the United Kingdom, the Isle of Man, and the Channel Islands (*k*), and the cost of taking out a patent and maintaining it for the full term amounted to 175*l.*, as contrasted with the old charge of 350*l.* This sum was made up as follows: 5*l.* at each of the following stages, the application, the notice to proceed, the warrant, the sealing, and the filing of the complete specification; 50*l.* before the expiration of the third year, and 100*l.* before the expiration of the seventh; and the patent became void on default of either the second or the third payment. In the original Act there were two schedules (*l*), and the payments were divided as fees and stamp duties, but under a subsequent statute—16 Vict. c. 5—the whole of the fees were taken in stamps (*m*).

Cost of patent under Patent Law Amendment Act.

Under the Patent Law Amendment Act, 1852, it was sufficient if the renewal fees were paid before midnight on the anniversary of the day of the date on which the letters patent were granted (*n*).

The advantage of spreading the payments required from a patentee over his term was that while applications for patents were not discouraged, a cheque was given to the multiplication of frivolous and obstructive patents, by which artizans, small tradesmen, and manufacturers, who could not face the expense of litigation, however weak might be the case against them, had been seriously embarrassed. Thus it was stated in evidence before the Parliamentary Committee of 1865 (*o*) that over two-thirds of the patents sealed became void by reason of the nonpayment of the 50*l.* at the end of the third year, and nine-tenths failing the payment of the 100*l.* at the end of the seventh year. Under the Act of 1883, a very small proportion of patents are kept in force until the end of the term. It may, however, be doubted if the present renewal fees are not much too high. The total cost of a patent which runs fourteen years is now 154*l.*

Policy of reducing fees.

The mode of payment introduced by the Patent Law Amendment Act, 1852, had other advantages also. The preliminary payments of 25*l.* were not sufficiently large to discourage poor inventors, who experienced little difficulty in obtaining the necessary capital. The postponement of the heavier payments till the expiration of the third

Mode of payment under 15 & 16 Vict c. 83.

(*k*) Not to the colonies or plantations abroad, unless specially mentioned. See p. 667.

Ans. 523, 527, 534. Report, &c., 1871, Evidence of Mr. T. Webster, Q.C., p. 93, Ans. 1077.

(*l*) *Infra*, p. 665.

(*n*) *Williams v. Nash*, 1859, 28

(*m*) Report, &c., 1865, Evidence of Mr. Leonard Edmunds, pp. 26-9,

L. J. Ch. 886; 28 Beav. 93.

(*o*) Edmunds' Evidence, p. 28.

and seventh years of the patent term enabled the patentee to determine whether it would pay him to keep up his patent, and acted as a more effectual deterrent from the continuance of a useless patent than the system of annual payments which was then in force upon the continent (*y*).

**Present fees.** The fees comprised in the present schedule are paid by stamps impressed on the proper forms, which can be obtained at any money order office in the United Kingdom. By sect. 24, sub-s. 2, the Board of Trade may from time to time, with the consent of the Treasury, reduce any of these fees. The annual fees in lieu of the 100*l.* fee payable on patents applied for under the Act of 1852 have been reduced: see *ante*, p. 551. The comptroller-general has no power to remit them. But the time for payment may be extended for the term of three months on payment of a fee, see p. 577.

(*y*) Report, &c., 1872, Evidence of 588; and of Mr. J. Howard, M.P., Mr. C. W. Siemens, p. 31, Ans. 581, pp. 48, 49, Ans. 921, 924.

Section 113.

### THE THIRD SCHEDULE.

#### *Enactments repealed.*

21 James 1, c. 3 .. [1623.]	The Statute of Monopolies ( <i>a</i> ). In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62.. [1835.] In part.	The Statutory Declarations Act, 1835 ( <i>b</i> ). In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83.. [1835.]	An Act to amend the law touching letters patent for inventions ( <i>c</i> ).
2 & 3 Vict. c. 67 .. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions" ( <i>d</i> ).
5 & 6 Vict. c. 100.. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 55 .. [1843.]	An Act to amend the laws relating to the copyright of designs.

(*a*) This is given entire in the Appendix, p. 628 *et seq.*

(*b*) Appendix, p. 630.

(*c*) Ibid. p. 637 *et seq.*

(*d*) Ibid. p. 640 *et seq.*

*Enactments repealed—continued.*

<p>7 &amp; 8 Vict. c. 69 (e) [1844.] In part.</p>	<p>An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled “An Act for the better administration of justice in his Majesty’s Privy Council, and to extend its jurisdiction and powers” (f). In part; namely,— Sections two to five, both included.</p>
<p>13 &amp; 14 Vict. c. 104 [1850.]</p>	<p>An Act to extend and amend the the Acts relating to the copyright of designs.</p>
<p>15 &amp; 16 Vict. c. 83.. [1852.]</p>	<p>The Patent Law Amendment Act, 1852 (g).</p>
<p>16 &amp; 17 Vict. c. 5.. [1853.]</p>	<p>An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications (h).</p>
<p>16 &amp; 17 Vict. c. 115 [1853.]</p>	<p>An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act (i).</p>
<p>21 &amp; 22 Vict. c. 70.. [1858.]</p>	<p>An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.</p>
<p>22 Vict. c. 13..... [1859.]</p>	<p>An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war (j).</p>
<p>24 &amp; 25 Vict. c. 73.. [1861.]</p>	<p>An Act to amend the law relating to the copyright of designs.</p>
<p>28 &amp; 29 Vict. c. 3.. [1865.]</p>	<p>The Industrial Exhibitions Act, 1865 (k).</p>
<p>33 &amp; 34 Vict. c. 27.. [1870.]</p>	<p>The Protection of Inventions Act, 1870 (l).</p>
<p>33 &amp; 34 Vict. c. 97.. [1870.]</p>	<p>The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the schedule the words and figures— “Certificate of the registration of a design ..... £5 0 0 And see section 65.”</p>
<p>38 &amp; 39 Vict. c. 91.. [1875.]</p>	<p>The Trade Marks Registration Act, 1875.</p>

(e) Sects. 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

(f) Appendix, p. 641 *et seq.*

(g) *Ibid.* p. 646 *et seq.*

(h) Appendix, p. 670 *et seq.*

(i) *Ibid.* p. 672 *et seq.*

(j) *Ibid.* p. 674.

(k) *Ibid.* p. 676.

(l) *Ibid.* p. 677.



*Enactments repealed—continued.*

38 & 39 Vict. c. 93.. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33.. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37.. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10.. [1880.]	The Great Seal Act, 1880 ( <i>n</i> ). In part; namely,— Section five,
45 & 46 Vict. c. 72.. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882 ( <i>o</i> ). In part; namely,— Section sixteen.

*(n)* Appendix, p. 678.*(o)* Appendix, p. 678.

## PATENTS RULES, 1890 (*a*).



By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following rules:—

### SHORT TITLE.

1. These rules may be cited as the Patents Rules, 1890. Short title.

For the rules repealed by these Rules, see notes to Rule 81.

### COMMENCEMENT.

2. These rules shall come into operation from and immediately after the 31st day of March, 1890. Commencement.

### INTERPRETATION.

3. In the construction of these rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

For definitions of terms used in the Patent Acts, see Act of 1883, sects. 46 and 117. For definition of Board of Trade, see note (*a*) below.

(*c*) These Rules consolidate the Patents Rules, 1883, 1885, 1886, and the International and Colonial Arrangements Rules of 1888. They are made by the Board of Trade, under sect. 101 of the Patents Act, 1883, and are signed by the President of the Board. There is no authoritative definition of the term "Board of Trade," except that in 24 & 25 Vict.

c. 47, s. 65, viz., "The Lords of the Committee of the Privy Council appointed for the consideration of matters relating to Trade and Foreign Plantations." Cp. also 22 Geo. III. c. 82, ss. 1, 15. It will be observed that in most instances these rules merely re-enact the provisions of the Patents Acts, 1883—88.

## FEES.

Fees.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these rules.

*Fees.*—For schedule of fees, see p. 586.

The fees are prescribed by the Board of Trade, with the consent of the Treasury (*b*).

As regards the amount and time of payment of fees, the Act of 1883 is retrospective (*c*).

The fees are paid by stamps impressed on the forms in the schedule to these rules. These forms cannot be obtained at the Patent Office in Southampton Buildings, or at the Patent Office (Sale Branch) in Curator Street, but may be obtained at Room 6, Royal Courts of Justice, and there impressed with the necessary stamps in payment of the prescribed fees. Stamped or blank forms may also be obtained through any money order office on a few day's notice, or at certain post offices throughout the United Kingdom.

## FORMS.

Forms.  
Alterations.

5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the Second Schedule to these rules.

*Forms in Schedule to Act of 1883.*—These forms are given at p. 528 *et seq.*

*Patents Rules, 1890.*—These forms are given at p. 737 *et seq.*

Application.

6.—(1.) An application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the Act of 1883 and section 2 of the Act of 1885 shall be made either in the Form A or the Form A1, or the Form A2, set forth in the Second Schedule to these rules, as the case may be.

Specification.

(2.) The Form B in such schedule of provisional specification and the Form C of complete specification shall respectively be used.

(*b*) See sect. 24 of the Act of 1883; Patents Rules, 1890, rr. 45—48.      (*c*) Cp. sect. 45, p. 500.

(3.) The remaining forms other than A, A1, A2, B Other forms. and C, set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules.

Under the Patents Rules, 1883, r. 6 (1), application for a patent was made by a statutory declaration. The Patents Act, 1885, s. 2, allowed the declaration to be either statutory or not, as might be prescribed; and the present form contains merely a statement in writing, which, if false, will avoid the patent, but on which a prosecution for making a false declaration, as provided by the Statutory Declarations Act, 1835, would not lie.

## GENERAL.

7. The Patent Office shall be open to the public every Hours of business. week day, between the hours of ten and four, except on the days and times following:—

Christmas Day.

Good Friday.

The day observed as her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

See provision as to days for leaving documents at the Patent Office, Act of 1883, s. 98.

As to days when the Register of Patents is open to public inspection, see r. 79.

The library is open from 10 a.m. to 10 p.m. daily.

8. An application for a patent must be signed by the Agency. applicant, but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require, resident in the United Kingdom.

As to patent agents, see p. 526.

For practice on applications, see, also, notes to sects. 4, 5, *supra*, pp. 427 *et seq.*, and Chapter on Applications, pp. 81 *et seq.*

As to applications under the International and Colonial Arrangements, see rr. 24—29.

When an applicant desires to change his agent, the words, "And I hereby cancel all previous authorisations," should be inserted in the authorisation of the new agent (*b*).

For a form of authorisation of agent, see p. 738.

An authorisation to an agent can be given at any time during the progress of an application for a patent.

Statement of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

The statement of address should be on a separate sheet, but may be written on the back of the application, and generally is so written.

Size, &c. of documents.

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office, or otherwise furnished to the Comptroller or to the Board of Trade, shall be written or printed in large and legible characters and unless otherwise directed in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

As to the sizes and methods of preparing drawings accompanying provisional or complete specifications, see rr. 30—33.

Duplicates of specifications and drawings are required by the Comptroller.

Exercise of discretionary power by Comptroller.

11. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specifica-

(*b*) Griffin, P. C. p. 322.

tion, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice of hearing.

This is practically a repetition of Act of 1883, s. 94.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.

Notice by applicant.

See form of notice by applicant, Form E, *infra*, p. 741. No fee is payable.

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

Comptroller may require statement, &c.

The Comptroller General does not usually require the applicant to be present, but will decide in his absence if he gives notice that he does not desire to be heard.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

Decision to be notified to parties.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller

Industrial or international exhibitions.

notice, in writing, of his intention to exhibit, publish, or use the invention, as the case may be.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

As to industrial or international exhibitions, see Act of 1883, s. 39; and as to foreign exhibitions, see Act of 1885, s. 3.

Form of notice, *infra*, p. 747. The fee is 10s. (*b*).

Form of certificate by Board of Trade, *infra*, p. 845.

Power of amendment, &c.

16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

This is a very important rule.

*For the amending of which no special provision is made.*—The following documents are therefore excepted from the operation of this rule:—

A complete specification after acceptance (*c*);

An application for a patent, so far as clerical errors are concerned (*d*);

Drawings (*e*);

The register (*f*);

as to all of which the Comptroller General has a special jurisdiction.

The Act gives no power for the amendment of *letters* patents, unless possibly in Act of 1883, s. 23 (1).

In *Re Airey* (*g*), where a notice of opposition omitted to give the date and title of a prior patent, in accordance with rule 36, *infra*, the Comptroller gave leave to amend under this rule, as it appeared that the applicant had before him the means of referring to the specification; and in *Re Lake* (*h*), where the notice of opposition had been signed by the opponent's agent, who died before the hearing, the

(*b*) Schedule of Fees, pp. 586—588.

(*c*) Act of 1883, ss. 18—21.

(*d*) *Ibid.* s. 91 (*n*).

(*e*) *Ibid.* ss. 7 and 9.

(*f*) *Ibid.* s. 91 (*b*).

(*g*) 1888, 5 P. O. R. 348.

(*h*) 1887, Griffin, A. P. C. 35.

name of the real opponent was allowed to be substituted. See other cases, *supra*, p. 170.

16A. Any application, notice, or other document authorised or required to be left, made or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

17. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

Manner in which, and persons before whom declaration is to be taken.

- (a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding ;
- (b) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding ; and
- (c) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

See the Commissioners for Oaths Act, 1889 (52 Vict. c. 10).

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively



numbered, and each paragraph shall so far as possible be confined to one subject.

APPLICATION<sup>1</sup> WITH PROVISIONAL OR COMPLETE  
SPECIFICATION.<sup>2</sup>

Order of  
recording  
applications.

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

<sup>1</sup> For application generally, see Chapter VI., p. 69.

As to applications for patents generally, see pp. 81, 82.

As to joint applications, see sect. 4, p. 427.

As to applications under sect. 103, see p. 516, and rules 24—29, *infra*.

The form must be signed by the applicant, and not by an agent (*i*).

In the case of an application by a company, the form should be signed by the secretary and two directors, and must have the common seal affixed to it. But unless under the International and Colonial Arrangements, a company cannot be a sole applicant, because it cannot be an inventor.

As to sending applications through the post, see Act of 1883, s. 97.

Although not required by the Acts or Rules, a list of applications is advertised weekly in the Official Journal.

<sup>2</sup> For the relative advantage of filing a provisional or complete specification in the first instance, see pp. 71 *et seq*.

Application  
for separate  
patents by  
way of  
amendment.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire to that effect to the Comptroller, bear the date

of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

As to the provision against a patent comprising more than one invention, see note to sect. 33, *supra*, p. 490.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

Application by representative of deceased inventor.

There is no special form of application by legal representative of deceased person.

As to the right of such representative to be an applicant, see Act of 1883, ss. 34 and 12 (3b).

As to form of grant in such cases, see p. 535.

21. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Notice and advertisement of acceptance.

Notice of acceptance. See form of, at pp. 757, 758.

The advertisement is in the Illustrated Official Journal, published every Wednesday. The advertisement of the acceptance of the complete specification only is required by the Act.

As to acceptance of specifications, see Act of 1888, s. 2, and Act of 1883, s. 10.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

Inspection on acceptance of complete specification.

See Act of 1883, s. 10. The Act of 1885, s. 4, provided that publication should only take place in the event of acceptance. The fee for inspection is 1s. (*j*).

(*j*) See Schedule, p. 587.

The printed specifications are issued about three weeks after the acceptance of the complete specification. So that there is five weeks after the issue of the printed specification during which the advisability of entering an opposition may be considered, besides the three weeks during which only the written copies can be inspected.

#### APPLICATION ON COMMUNICATION FROM ABROAD.

Communica-  
tion from  
abroad.

23. An application for a patent for an invention communicated from abroad shall be made in the Form A 1 set forth in the Second Schedule to these Rules.

The person to whom a communication from abroad is made must be resident in the United Kingdom or the Isle of Man.

The Patent Office does not recognise agents not resident in this country.

A communicator cannot apply under sect. 103. *Re Shallenberger*, 1889, 6 P. O. R. 551.

#### INTERNATIONAL AND COLONIAL ARRANGEMENTS (*l*).

24. The term "foreign application" shall mean an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order of Her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

This and the five succeeding rules were the Patents (International and Colonial Arrangements) Rules, 1888.

*British possession.*—See definition of this term in sect. 117, *supra*, p. 526.

*Order in Council.*—See list of such Orders and the States to which they are applicable, *supra*, at p. 411.

On International and Colonial Arrangements generally, see sects. 103 and 104, *supra*, at pp. 516 *et seq.*, and also at Chapter XX.

*Foreign application.*—See *Re Van de Poelle* (1890, 7 P. O. R. 69), and *supra*, p. 416.

25. An application<sup>1</sup> in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify<sup>2</sup> all the Foreign States or British Possessions in which foreign

(*l*) See Chapter XX.

applications have been made and the official date or dates thereof respectively. The application must be made within 7 months<sup>3</sup> from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

1 *Application*.—See Form A2, *infra*, p. 739.

As to who may apply, see Rule 23.

2 *Shall specify*.—See the case of *Re L'Oiseau and Pierrard (l)*, and *supra*, at p. 415.

3 *Seven months*.—See International Convention, 1883, Art. 4, and Chap. XX.; also Act of 1883, s. 103, p. 516.

26. The application in the United Kingdom shall be made in the Form A2 in the Second Schedule to these Rules, and in addition to the specification, provisional or complete, left with such application must be accompanied by—

- (1.) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such Foreign State or British Possessions as aforesaid, or otherwise verified to the satisfaction of the Comptroller;
- (2.) A statutory declaration<sup>1</sup> as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification<sup>2</sup> or document corresponding thereto be in a foreign language, a trans-

(l) 1887, Griffin, A. P. C. 36.

lation thereof shall be annexed to and verified by such statutory declaration.

1 *Statutory declaration.*—As to manner in which, and persons before whom, such declarations may be taken, see r. 17, *supra*, p. 565.

2 *Specification.*—The foreign and British specification need not be in the same terms if they are in substance identical (*m*).

27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof (if any) as the Comptroller may require of or relating to such foreign application or of the official date thereof, the Comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

28. All further proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

A “foreign applicant” cannot, however, oppose the grant of a subsequent British patent for the same invention as his own, under the Act of 1883, s. 11, sub-s. 1 (*n*).

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

#### SIZES AND METHODS OF PREPARING DRAWINGS ACCOMPANYING PROVISIONAL OR COMPLETE SPECIFICATIONS.

Drawings for specifications.

30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the

(*m*) *Re L'Oiseau and Pierrard*, 1887, Griffin, A. P. C. 37.

(*n*) *Re Everitt*, 1888, Griffin, A. P. C. 28.

provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself.

Drawings are required in duplicate, see Rule 32.

31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality, and where possible without colour or Indian-ink washes. Requirements as to paper, &c.

They must be on sheets of one of the two following sizes (the smaller being preferable) 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be  $\frac{1}{2}$  an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in. Size of drawings.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink*; the same strength and colour of fine and shade lines to be maintained throughout. Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement (o). Reference figures and letters must be bold, distinct, not less than  $\frac{1}{8}$  of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must Quality of ink.

(o) This drawing is not given here, but is issued with the Patent Rules, which may be purchased at the Patent Office Sale Branch, Cursitor Street, W.C. Price 6d.

be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c., need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings to bear name of applicant, &c.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

No written description of the invention should appear on the drawings.

Restrictions as to wood engravings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings.

32. A *facsimile* of the original drawings but *without* colour or Indian-ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "true copy."

The office prefers that the lettering on the duplicate copy should be in pencil, preferably blue pencil.

Provisional drawings used for complete specification.

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

As to the law in regard to drawings, see *supra*, pp. 107, 433.

OPPOSITION TO GRANTS OF PATENTS (*o*).

34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (hereinafter in Rules 37, 38, 41 and 43, called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Notice of  
opposition.

Notice of opposition must be *signed* by the opponent (*p*), but may, with the permission of the Comptroller General, under rule 16, be signed after delivery. Although rule 8 does not expressly apply to an opponent, the Comptroller General permits agents to act for opponents as well as for applicants.

35. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant.

Copy for  
applicant.

36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice.

Particulars of  
prior patent.

An omission *per incuriam* is curable by the Comptroller General under Rule 16, subject to costs of the day if the correction renders an adjournment of the hearing necessary.

As to disallowance of opposition, see Rule 42.

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

Opponent's  
evidence.

The Comptroller may extend the time under r. 51.

*Statutory declarations.*—See r. 17, *supra*, p. 565.

38. Within 14 days from the delivery of such list

Applicant's  
evidence.

(*o*) For this subject generally, see Chap. IX.

(*p*) See, however, Act of 1883, s. 99.



Evidence in  
reply.

the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

The declarations in reply should be confined strictly to matters in reply, otherwise they may be ordered to be removed from the file.

Closing of  
evidence.

39. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application in writing made to him for that purpose.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Such leave will not be granted unless the Comptroller-General is satisfied that the further evidence which it is desired to give was not within the knowledge of, or reasonably obtainable by, the party applying for leave, within the times allowed by rr. 35 and 36.

Notice of  
hearing.

41. 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 shall give the parties 10 days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the Comptroller an application on Form E. The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the Comptroller shall decide the case and notify his decision to the parties.

See Fee 6, Form E, *infra*, pp. 586 and 741.

The attendance of both or either of the parties is not required.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

Disallowance of opposition in certain cases.

See also Rule 36, *supra*.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

This rule is new.

44. The decision of the comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

Decision to be notified to parties.

The decision of the Comptroller is usually given to the parties with the reasons therefor in writing.

### CERTIFICATES OF PAYMENT OR RENEWAL (*q*).

45. If a Patentee<sup>1</sup> intends at the expiration of the fourth or eighth year from the date of his patent<sup>2</sup> to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee<sup>3</sup> of 50% or 100%, as the case may be.

Payment of fees of 50% and 100% for continuance of patent.

<sup>1</sup> *Patentee*.—See definition of: Act of 1883, s. 46, p. 501.

<sup>2</sup> *Date of his patent*.—See sect. 13, *supra*, p. 451.

(*q*) As to renewal fees generally, see Act of 1883, second schedule, pp. 550 *et seq.*

*Prescribed fee.*—See Act of 1883, s. 24, and second schedule thereto, at p. 550. See also Schedules of Fees to these Rules, at p. 586.

As to patents granted before commencement of Act.

46. In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words “seventh year” were therein written instead of the words “eighth year.”

*The commencement, &c.*—The Act of 1883 commenced on 1st January, 1884 (r); the Act of 1885, on 14th August, 1885; the Act of 1886, on 25th June, 1886; and the Act of 1888, on 1st January, 1889.

Payment of annual fees in lieu of 50% and 100%.

47. If the patentee intends to pay annual fees in lieu of the above mentioned fees of 50% and 100%, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, pay the prescribed fee.

The Form J in the second schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.

*Annual fees.*—See Fees 15—25. Form J is given at p. 744. And see Act of 1883, second schedule.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

See form of certificate, *infra*, p. 745.

On issue of certificate, the amount and date of payment is entered on the Register of Patents: see Rule 76. The patentee's failure to make any prescribed payment is also recorded on the register: see Rule 77.

### ENLARGEMENT OF TIME.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the

(r) See Act of 1883, s. 3.

circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Cp. Patents Rules, 1883, r. 46.

See form of such application, *infra*, p. 745.

An enlargement of time for payment may be made, subject to the following penalties:—

Not exceeding one month, 3*l.*

Not exceeding two months, 7*l.*

Not exceeding three months, 10*l.*

No enlargement is granted after three months: Act of 1883, s. 17, sub-s. 4 (a).

See prescribed payments, schedule of fees, *infra*, p. 587.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary.

Extension of time for leaving and accepting complete specification.

This rule is new.

51. 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.

In other cases.

See Rule 35.

This application is not granted as a matter of course. The written consent of the other side, if there be one, should, if possible, be obtained, and good cause must be shown for the extension.

This rule applies only to the times prescribed by *the rules*. See sect. 98, *supra*, p. 511, as to the days for leaving documents, &c. at the Patent Office in the case of Sunday, holidays, &c.

### AMENDMENT OF SPECIFICATION (s).

52. A request for leave to amend a specification must

Request for leave to amend.

(s) As to amendments of specifications generally, see pp. 145 *et seq.*

Advertisement.

be signed by the applicant or patentee (hereinafter, in Rules 54, 55, and 58, called the applicant), and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

As to amendment of specifications generally, see Act of 1883, ss. 18—21; and Act of 1885, s. 5; also Chap. VII.

For form of request, see p. 742.

*Signed.*—The application for leave to amend must be signed by the applicant or patentee. Subsequent proceedings may be conducted by an agent.

*Advertised.*—The advertisement is in the Illustrated Official Journal.

Notice of opposition.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

See Act of 1883, s. 18, sub-s. 2, p. 456. The notice must be given within one month of the first advertisement; and this time cannot, it seems, be extended, as Rule 31 applies only to the times prescribed under the rules. The notice of opposition should be on Form G (t), with a fee of 10s. (u). It must be signed by the opponent, who must be “a person entitled to be heard” under Act of 1883, s. 18, sub-s. 4.

Copy for the applicant.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

Opponent's evidence.

55. Within 14 days after the expiration of one month from the first advertisement of the application for

(t) See Appendix, p. 742.

(u) See Schedule of Fees, p. 586.

leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

*To the applicant, i. e., to the applicant or his authorised agent (x).*

See Rule 37, *supra*, p. 573.

56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44, shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Further proceedings.

57. Where leave to amend is given the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31.

Requirements thereon.

58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

Leave by order of Court.

*An Order of the Court.*—See Act of 1883, s. 19, *supra*, p. 460.

59. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

Advertisement of amendment.

See Act of 1883, s. 21, *supra*, p. 461.

The advertisement is in the Illustrated Official Journal.

### COMPULSORY LICENCES (y).

60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the nature of the petitioner's interest, and the ground or

Petition for compulsory grant of licences.

(x) Rule 8.

(y) See Act of 1883, s. 22.

grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

For form of petition, see p. 743. For fees, see schedule, p. 587.

To be left  
with evidence  
at Patent  
Office.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

Directions as  
to further  
proceedings  
unless peti-  
tion refused.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

Petitioner's  
evidence.

63. If and when a *prima facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Patentee's  
evidence.

64. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in  
reply.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

66. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition. Further proceedings.

### REGISTER OF PATENTS (z).

67. Upon the sealing of a patent the comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention. Entry of grant.

There is no entry upon the Register until the patent is sealed.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the Patent Office. Request for entry of subsequent proprietorship.

Forms of request, Appendix, Form L., p. 746.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner. Signature of request.

A body corporate may be registered as proprietor by its corporate name: Rule r. 74.

(z) See Chap. XII., on the Register of Patents.



Particulars to be stated in request.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

See Forms L and M, p. 746.

Production of documents of title and other proof.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof, as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller.

Copies for Patent Office.

72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

Body corporate.

73. A body corporate may be registered as proprietor by its corporate name.

Entry of orders of the Privy Council

74. Where an order has been made by Her Majesty in Council for the extension of a patent for a further

term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent, or the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.

or of the  
Court.

As to extension of letters patent, see Act of 1883, s. 25, *supra*, p. 466; and chapter on Extension, pp. 373 *et seq.*

As to revocation of patents, see Act of 1883, s. 26, *supra*, p. 474; and chapter on Revocation, at p. 355.

As to rectification of register, see Act of 1883, s. 90, and *supra*, pp. 210 *et seq.*

Order in Council for extension, see form of, at p. 838.

Order of Court for revocation, see form of, at p. 811.

Order for rectification of register, see form of, at p. 777.

75. Upon the issue of a certificate of payment under Rule 48, the comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of pay-  
ment of fees  
on issue of  
certificate.

See form of certificate of payment, *infra*, p. 745.

As to fees, see Act of 1883, second schedule, p. 550.

76. If a patentee fails to make any prescribed payment<sup>1</sup> within the prescribed time<sup>2</sup> or any enlargement<sup>3</sup> thereof duly granted, such failure shall be duly entered in the register.

Entry of  
failure to pay  
fees.

1 *Prescribed payment.*—See Schedule of Fees, 14—25, *infra*, p. 587.

2 *Prescribed times.*—See Act of 1883, s. 17, sub-ss. 2, 3, 4, *supra*, p. 454.

3 *Enlargement.*—See Rules 49—51.

77. An attested copy of every license granted under a patent shall be left at the Patent Office by the licensee,

Entry of  
licences.

with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

As to licences generally, see p. 202.

See form of request, Form M, p. 746.

For fee, see p. 587.

Hours of  
inspection of  
register.

78. The Register of Patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following:—

- (a) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or
- (b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;
- (c) Times when the register is required for any purpose of official use.

As to hours of business at Patent Office, see Rule 7, *supra*.

Certified  
copies of  
documents.

79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee.

The fee is No. 35 (1s.), *infra*, p. 587, besides the cost of copying, at fourpence a folio.

#### POWER TO DISPENSE WITH EVIDENCE, &c.

80. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to

make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

See Act of 1883, s. 99, *supra*, p. 512, as to declarations by infants, lunatics, &c.

### REPEAL (*a*).

81. All general rules heretofore made by the Board of Trade under the Patents Designs and Trade Marks Acts, Repeal.

(*a*) The Patent Rules, 1890, consolidate in one set the Patents Rules of 1883, 1885, 1886, and 1888, and make some amendments and additions. Among other alterations it is provided as regards hearings before the comptroller or the law officers, that (by rule 17*a*) statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject; by rule 41, 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 shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E. The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the comptroller shall decide the case and notify

his decision to the parties; that (by rule 43) where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Rule 47 abolishes the necessity of notice by a patentee who intends to pay annual fees in lieu of the fees of 50% and 100%. Form J duly stamped is sufficient.

As regards the recording subsequent proprietorship of patents, it is provided (by rule 72):—

There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application then pending.

The Patents Rules made previously under the Act of 1883 were:—

The Patents Rules, 1883, which came into operation the 1st January, 1883.

The Patents Rules, 1885, which came into operation on the 15th August, 1885.

The Patents Rules, 1886, which came into operation on the 16th September, 1886.

The Patents (International and Colonial Arrangements) Rules, which came into operation on the 1st June, 1888.

Dated the 31st day of March, 1890.

M. E. HICKS-BEACH,  
President of the Board of Trade.

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### FIRST SCHEDULE.

#### LIST OF FEES PAYABLE ON AND IN CONNEXION WITH LETTERS PATENT.

*Up to Sealing.*

	£	s.	d.	£	s.	d.
1. On application for provisional protection . . . .	1	0	0			
2. On filing complete specification . . . . .	3	0	0			
	<hr/>			4	0	0
or						
3. On filing complete specification with first application	4	0	0			
4. On appeal from comptroller to law officer. By appellant	3	0	0			
<hr/>						
5. On notice of opposition to grant of patent. By opponent	0	10	0			
6. On hearing by comptroller. By applicant and by opponent respectively . . . . .	1	0	0			

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	£	s.	d.
7. On application to amend specification :—			
Up to sealing. By applicant.....	1	10	0
8. After sealing. By patentee .....	3	0	0
9. On notice of opposition to amendment. By opponent..	0	10	0
10. On hearing by comptroller. By applicant and by opponent respectively .....	1	0	0
11. On application to amend specification during action or proceeding. By patentee .....	3	0	0
—————			
12. On application to the Board of Trade for a compulsory license. By person applying.....	5	0	0
13. On opposition to grant of compulsory license. By patentee .....	5	0	0
14. On certificate of renewal :—			
Before end of 4 years from date of patent .....	50	0	0
15. Before end of 7 years, or in the case of patents granted under the “ Patents, Designs, and Trade Marks Act, 1883,” before the end of 8 years from date of patent .....	100	0	0
or in lieu of the fees of 50% and 100%, the following annual fees :—			
16. Before the expiration of the 4th year from the date of the patent..	10	0	0
17.        ”        ”        5th        ”        ”        ..	10	0	0
18.        ”        ”        6th        ”        ”        ..	10	0	0
19.        ”        ”        7th        ”        ”        ..	10	0	0
20.        ”        ”        8th        ”        ”        ..	15	0	0
21.        ”        ”        9th        ”        ”        ..	15	0	0
22.        ”        ”        10th        ”        ”        ..	20	0	0
23.        ”        ”        11th        ”        ”        ..	20	0	0
24.        ”        ”        12th        ”        ”        ..	20	0	0
25.        ”        ”        13th        ”        ”        ..	20	0	0
On enlargement of time for payment of renewal fees :—			
26. Not exceeding 1 month .....	3	0	0
27.        ”        2 months .....	7	0	0
28.        ”        3 months .....	10	0	0
29. For every entry of an assignment, transmission, agree- ment, license, or extension of patent .....	0	10	0
30. For duplicate of letters patent .....	2	0	0
31. On notice to comptroller of intended exhibition of a patent under section 39 .....	0	10	0
32. Search or inspection fee.....	0	1	0

## PATENTS RULES, 1890.

	£	s.	d.
33. For office copies, every 100 words (but never less than one shilling) .....	0	0	4
34. „ „ of drawings, cost according to agreement.			
35. For certifying office copies, MSS., or printed, each ..	0	1	0
36. On request to comptroller to correct a clerical error—			
Up to sealing .....	0	5	0
After sealing .....	1	0	0
37. For certificate of comptroller under section 96 .....	0	5	0
38. For altering address in register .....	0	5	0
39. For enlargement of time for filing complete specification not exceeding one month .....	2	0	0
40. For enlargement of time for acceptance of complete specification—			
Not exceeding one month .....	2	0	0
„ two months .....	4	0	0
„ three months .....	6	0	0

M. E. HICKS-BEACH,

President of the Board of Trade.

31st March, 1890.

Approved: R. E. WELBY,

For the Lords Commissioners of  
Her Majesty's Treasury.

31st March, 1890.

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SECOND SCHEDULE.

*(For these Forms, see Appendix, pp. 737—750.)*

## LAW OFFICERS' RULES (*a*).

### RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS (*a*).

I. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the Acts, he shall within 14 days from the date of the decision appealed against file in the Patent Office a notice of such his intention. Notice of appeal.

An appeal lies to the law officer from the decision of the comptroller:

- (a) Requiring the amendment of an application or specification, or of drawings (*b*);
- (b) Refusing an application on the ground that the invention comprised in it is the same as that comprised in a prior application (*c*);
- (c) Requiring the amendment of a complete specification (*d*);
- (d) Upon opposition to the grant of letters-patent (*e*);
- (e) Upon opposition to the amendment of a specification (*f*);
- (f) Refusing leave to amend a specification (*g*).

There is no right of appeal to the law officer from the Comptroller General, refusing—

- (a) To enlarge the time prescribed by the principal Act for the payment of fees (*h*);
- (b) To grant a patent for an invention of which the use would in his opinion be contrary to law or morality (*i*); or
- (c) To extend the time for leaving a complete specification (*j*).

(*a*) These Rules are made under sect. 38 of the principal Act, which further empowers the law officer to examine witnesses on oath and to award costs. The comptroller has no power to award costs, and evidence before him must be given by way of statutory declaration. He has no power to administer oaths or to examine witnesses on oath.

- (*b*) Act of 1883, s. 7, sub-s. 2.
- (*c*) *Ibid.* s. 7, sub-s. 6.
- (*d*) *Ibid.* s. 9, sub-s. 2.
- (*e*) *Ibid.* s. 11, sub-s. 2.
- (*f*) *Ibid.* s. 18, sub-s. 3.
- (*g*) *Ibid.* s. 18, sub-s. 6.
- (*h*) *Ibid.* s. 17.
- (*i*) *Ibid.* s. 86.
- (*j*) Act of 1885, s. 3.



Appeals have been taken to the law officer from the decision of the Comptroller General under sect. 33, that a patent contains more than one invention; but these are rather in the nature of references under Act of 1883, s. 95, by which the comptroller may apply to either of the law officers in case of doubt and difficulty.

For notice of appeal, see Form T, *infra*, p. 749. The fee is £3, *infra*, p. 586.

In cases where by his decision the comptroller requires an amendment to be made, *and does not in his decision settle the specific words of the amendment*, the time for appealing is regarded as dating from the day of forwarding to the opponent a copy of the amendment approved by him (*k*). Notice of appeal may be signed by an agent authorized by appellant (*l*).

Notice to  
state what  
part appealed  
against.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

The effect of Rules I. and II. is to limit the hearing before the law officers to points specifically raised by the notice of appeal; and where a notice of appeal is as to part only of the comptroller's decision, the person receiving such notice, and desiring to question other parts of the comptroller's decision, must give a counter-notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter-notice may be extended under Rule 5 (*m*). A counter-notice is necessary when the appeal is from the whole decision (*n*).

Service of  
notice of  
appeal.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at room 549, Royal Courts of Justice, London; and when there has been an opposition before the comptroller, to the opponent or opponents; and when the comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

As to how notice may be sent, see r. XIV., *infra*.

(*k*) *Re Chandler*, 1886, Griffin, P. C., at p. 273; *Re Cooper and Ford*, 1885, *ib.* 276.

(*l*) *Re Anderson and McKinnell*, 1887, Griffin, A. P. C., at p. 24.

(*m*) *Re Bairstow*, 1888, per Clarke, S.-G., 5 P. O. R., at p. 286.

(*n*) *Re Hall and Hall*, 1888, 5 P. O. R. 283.

In *Re Anderson and McKinnell* (o), it was held by Clarke, S.-G., that this rule applied only when the *applicant appealed*. But in *Re Hill* (p), Webster, A.-G., while agreeing with this construction of the terms of the rule, said that due notice should be given of the appeal to the respondent, even if he were applicant before the comptroller, either through the Patent Office or through the official clerk. (Cp. *Re Rylands*, 1888, 5 P. O. R. 668.)

IV. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made. Transmission of papers to law officer.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer. Extension of time for appealing.

The time for appealing has been extended by the Comptroller General in cases in which the parties were resident abroad. Time for appealing.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given. Notice of hearing of appeal.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant. To whom notice of hearing to be given.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the Evidence before law officer.

knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

A specification which had come to the knowledge of an appellant since the hearing before the comptroller cannot be put in before the law officer on opposition to the grant of a patent. Such a specification is not evidence, but an additional ground of opposition (*p*). *Herschell, S.-G.*, refused to allow an imputation of fraud in a notice of opposition to be gone into, on the ground that no evidence had been filed in support of it; nor would he allow time for evidence as to fraud to be put in (*q*).

Cross-examination.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

Powers of law officer.

As to the power of the law officer to examine witnesses on oath, see sect. 38, *supra*.

“When it is desired to obtain an order for the attendance of declarants for cross-examination, a list of such persons must be left with the law officers' clerk, with a request for an order for their attendance. Copies of the request and list should be sent to the other side. The law officer then requests the attendance of both parties before him, with reference to the application, and if satisfied that an order should go directs that summonses should be issued, which the law officers' clerk then issues in due course” (*r*).

Conduct money to witnesses on cross-examination.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness, whose attendance is required, a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the

(*p*) *Re Bailey*, 1884, Griffin, P. C. 293; cp. *Re L'Oiseau and Pierrard*, 1887, Griffin, A. P. C. 36, and *ante*.  
 269.  
 (*q*) *Re Huth*, 1884, Griffin, P. C. (*r*) Griffin, P. C. p. 319.

amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

As to the law officer's power over costs, see Act of 1883, s. 38, and note thereto, *supra*, p. 492. Costs.

The law officer makes costs follow the event in appeals if he possibly can (*s*).

The law officer usually orders a lump sum to be paid on account of costs.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act. Order for payment of costs.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary. Documentary evidence.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post. How notices may be sent.

A.-G.

S.-G.

This rule seems to be already covered by Act of 1883, s. 97, *supra*, p. 511.

(*s*) *Re Anderton*, 1886, Griffin, A. P. C. 25; *Re Fletcher*, 1887, Griffin, A. P. C. 30.

PRIVY COUNCIL RULES IN PATENT CASES  
BEFORE THE JUDICIAL COMMITTEE.



RULES TO BE OBSERVED IN PROCEEDINGS before the RIGHT HONOURABLE the LORDS of the JUDICIAL COMMITTEE OF THE PRIVY COUNCIL under the Act of the 5th and 6th William IV., intituled "An Act to amend the Law touching LETTERS PATENT FOR INVENTIONS," cap. 83.

No rules made under Act of 1883.

No rules having yet been made under sect. 25, sub-s. 6 of the Act of 1883, these Rules, which were made to regulate procedure under the statute 5 & 6 Will. IV. c. 83, are still in force. It is understood that the Judicial Committee have no present intention of issuing new rules. Apparently the procedure on prolongation is unaltered, as only patents granted before the Act of 1883 can be prolonged for some years to come (a). There is no confirmation now by petition to Privy Council, except perhaps for patents granted under the Act of 1852.

Petition for confirmation.

RULE I.—A party intending to apply by petition, under sect. 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such adver-

(a) See Chapter XVIII.

tisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the council office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This Rule relates to the provision contained in 5 & 6 Will. IV. c. 83, s. 2, for the confirmation of letters patent, invalid for want of novelty. That provision has not, however, been re-enacted in the present Act.

As to confirmation generally, see Chapter XIX.

RULE II.—A party intending to apply by petition, under sect. 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the council office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Petition for  
prolongation.

The *sect. 4*, here referred to, dealt with the prolongation of letters patent and required the petitioner to advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where, or near to which, he carried on any manufacture of anything made according to his speci-

ation, or near to, or in which he resided in case he carried on no such manufacture, or published in the county where he carried on such manufacture, or where he lived, in case there should not be any paper published in such town, that he intended to apply to the Sovereign in Council for extension.

This mode of advertisement must still be followed.

“When the patentee resides abroad, and the invention is carried on under licenses, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on” (*b*).

To entitle an equitable assignee to appear with the legal assignee of a patent on a petition for extension, the name of the former must appear with that of the latter in the advertisements required by sect. 4 of 5 & 6 Will. IV. c. 83 (*c*).

The advertisements should be proved before the case is heard (*d*).

In *Macintosh's Patent* (*e*), a petition for extension, presented nearly eighteen months before the expiration of the patent, was ordered to stand over as the profits accruing in the meantime might materially affect the question as to the propriety of an extension being granted. Upon the application to fix a day for the hearing being renewed, it was questioned, but not decided, whether the old notices would be sufficient.

For forms of advertisements, see Appendix, p. 812 *et seq.*

Petitions.  
When petition must be presented.

**RULE III.**—Petitions under sects. 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

In a case where delay arose from the mistake of the petitioner's agent, this rule was waived by the Judicial Committee (*f*), and in *Reece's Patent* (*g*), a supplementary statement to correct errors in a petition was allowed to be delivered before the hearing.

For forms of petition, see Appendix, p. 816 *et seq.*

(*b*) *Derosue's Patent*, 1844, 2 Web. P. C. . . “The statute,” said Lord Brougham, in this case, “provides for two cases, the patentee carrying on a manufactory, or residing; but there would be no sense in inserting an advertisement in the ‘Moniteur,’ when the man resides in Paris; that would afford no protection to the Queen's subjects, for whose protection the rule is intended”: *Ibid.*

(*c*) *In re Noble's Patent*, 1850, 7 Moo. P. C. 191.

(*d*) *In re Perkins's Patent*, 1845, 2 Web. P. C. 8; *Bell's Patent*, 1846, *ibid.* p. 160.

(*e*) 1837, 1 Web. P. C. 739, n.

(*f*) *In re Hutchinson's Patent*, 1861, 14 Moo. P. C. 364.

(*g*) Cited by Lawson, p. 259, from Eng. Rep., Jan. to Mar. 1881, xiv.

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of sect. 4 of the said Act, and the 1st and 2nd of these rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions. Affidavits of advertisements.

RULE V.—All persons entering caveats under sect. 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect. 2 of the said Act, and all persons lodging notices of opposition under the 1st of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service. Caveats.

For form of caveat, see Appendix, p. 813.

Where the Judicial Committee made an order to receive a petition which had not been presented in accordance with rule 3, *supra*, and a caveat had been entered, it was held that as the party filing the caveat was interested in sustaining the objection to the reception of the petition notice of the application must be served upon him (*h*).

RULE VI.—All parties served with petitions shall lodge at the council office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions. Grounds of objection.

Under this rule, it is sufficient to state the grounds, without the particulars, of the objections (*i*).

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense. Copies.

RULE VIII.—The registrar of the privy council, or Costs.

(*h*) *In re Hutchinson's Patent*, 1861, 14 Moo. P. C. 364.

(*i*) *Ball's Patent*, 1879, L. R. 4 App. Cas. 171.



other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Documents to  
be lodged at  
Council  
Office.

RULE IX.—A party applying for an extension of a patent, under sect. 4 of the said Act, must lodge at the council office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The Crown.

The Judicial Committee will hear the Attorney-General, or other Counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

Copies of  
specification,  
&c.

In *Bell's Patent* (*k*), a petition was allowed to proceed, although copies of the specification had not been lodged as required by this rule, the omission being unintentional, and due to the rule not being generally known, but the Judicial Committee intimated that their leniency in that case was not to be taken as a precedent.

The rule as to copies of the balance-sheet is imperative (*l*), and is intended to enable the Attorney-General to inspect the accounts, and to make inquiries before the hearing of the petition.

(*k*) 1846, 2 Web. P. C. 159.                      and *Kellett's Patent*, 1887, 4 P. O. R.  
(*l*) *Johnson's and Atkinson's Pa-*              151.  
*tents*, 1873, L. R. 5 P. C. 87; *Yates*

In considering a petition for the extension of a patent which has not come into use, and is not likely to be used except by the Government, the Judicial Committee rely, to a large extent, upon what is said in favour of the patent by the representatives of the Crown (*m*).

In *Ball's Patent* (*n*), it was observed by Sir Barnes Peacock that the Attorney-General might introduce evidence impeaching a patent irrespective of the notice of objections.

(*m*) *Hughes' Patent*, 1879, 4 A. C. 174.      (*n*) 1879, 4 A. C. 171.

## INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (a).

*Signed at Paris March 20, 1883.*

[Ratifications exchanged at Paris, June 6, 1884.]

### I.

#### INTERNATIONAL CONVENTION (b).

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects

Recital of  
objects of  
convention.

(a) "Industrial property" includes patents, industrial designs and models, trade marks and trade names. See, however, Clause I. of the Protocol, p. 614.

We are here concerned with the Convention only in so far as it deals with patents, although the text is given in full.

For an account of the origin of this Convention, see p. 408.

The legal relation of this Convention to the Patents Act, 1883, ss. 103 and 104, has been taken up at p. 413 *et seq.*

(b) The original Convention was published in French, which, under Art. 6 of the Final Protocol (*infra*, p. 617), is the official language of the International Office. The authorised English translation has been given here; but, except in the formal parts, the French version of each article has been printed immediately below the paragraph to which it refers. The terms of the Convention, both in the original and in the English translation, are often vague. In such cases a reference to the original French text is of assistance.

and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say:—

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ; Plenipotentiaries.

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c. ;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon, Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, His Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c. ;

The President of the French Republic: M. Paul Challemel-Lacour, Senator, Minister for Foreign Affairs; M. Hérisson, Deputy, Minister of Commerce; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c. ;

The President of the Republic of Guatemala: M. Crisanto-Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Italy: M. Constantin Resson, Commander of His Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c.;

His Majesty the King of the Netherlands: the Baron de Zuylen de Nyevelt, Commander of His Majesty's Order of the Netherlands Lion, Grand Cross of His Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Portugal and the Algarves: M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c.;

The President of the Republic of Salvador: M. Torres-Caicedo, corresponding Member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Servia: M. Sima M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c.;

And the Federal Council of the Swiss Confederation: M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permanent Commission for the protection of Industrial Property;

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles :—

Articles  
agreed upon.

### ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the protection of Industrial Property.

Union for pro-  
tection of  
industrial  
property.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la protection de la Propriété Industrielle.

The necessary ratifications were exchanged by the plenipotentiaries of the High Contracting Parties on June 6, 1884, and as Article XVIII. provides that the convention should come into operation one month after the exchange of ratifications, the date from which it applies to the countries named in Article I. is July 6, 1884.

Date of the  
Convention.

The words "industrial property" are to be understood in their broadest sense ; they are not to apply simply to "industrial products," properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.). (See Final Protocol 1, *infra*, p. 614).

"Industrial  
property."

### ARTICLE II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Legal  
remedies.

Les sujets ou citoyens de chacun des États Contractants jouiront,

dans tous les autres États de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque État.

"Patents."

Under the word "patents" are comprised the various kinds of industrial patents, recognised by the legislation of each of the Contracting States, such as importation patents, improvements patents. (See Final Protocol, 2.)

The last paragraph of this Article does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals and the competence of those tribunals. (Final Protocol, 3.)

### ARTICLE III.

Rights of subjects of States not within Union established in countries within Union.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

Sont assimilés aux sujets ou citoyens des États Contractants les sujets ou citoyens des États ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des États de l'Union.

By this Article subjects or citizens of non-contracting States who are domiciled or have establishments in contracting States are placed on a better footing than their compatriots at home. It is possible that difficult questions may arise upon the meaning of the words "*domiciled or have industrial or commercial establishments.*"

### ARTICLE IV.

Right of priority.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third

parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des États Contractants, jouira, pour effectuer de dépôt dans les autres États, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres États de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

When first this Article came into operation, some doubt existed whether the six months were to be computed from the date of deposit of the application for a patent, or from the date on which the patent was actually sealed in Great Britain, or signed in the other contracting States. The Act of 1885, s. 6, substituted "*date of application*" for "*date of the protection obtained*." Construction of this article.

See now Patents Rules, 1890, rr. 24—29; and see Patents Act, 1885, s. 103, sub-s. 1, where seven months is the period within which application must be made.

It appears that *one of the contracting States* means the first state



where application was made, so that six months, or if beyond the sea seven months at most from the time of first making an application in any of the countries which are parties to the convention, is the extent of priority given.

Is Great Britain beyond sea?

It was also a question whether Great Britain was, as regards France, &c., a country beyond sea. The comptroller-general was instructed that it was not; on the other hand, it is held here that France and other continental countries are, as regards Great Britain, countries beyond the sea.

### ARTICLE V.

Importation and forfeiture.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des États de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

Date of first conference.

The first conference of delegates of the contracting States was held at Rome in April and May, 1886, the second at Madrid in 1890.

On the former of those occasions the following addition to Article V. was recommended:—

“Exploiter.”

Each country shall determine the sense in which the word *exploiter* (work) is to be interpreted by the law of that country.

Compulsory working.

The compulsory working of inventions is a source of much useless effort, and gives rise to many technical evasions of the laws. Most foreign countries, however, still exact a “working” of the invention at stated intervals within their own territories.

This is practically the principal advantage accruing to Great Britain under the Convention, as formerly the introduction of a patented article into France forfeited the French patent rights.

### ARTICLE VI.

Registration of trade marks.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected

in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

### ARTICLE VII.

The nature of the goods on which the trade-mark is to be used can, in no case, be an obstacle to the registration of the trade-mark.

Nature of goods to be no obstacle to registration of trade mark.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

### ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

Protection of trade names.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

## ARTICLE IX.

Seizure of  
goods bearing  
illegal trade  
mark or name.

All goods illegally bearing a trade-mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des États de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque État.

## ARTICLE X.

Goods falsely  
bearing name  
of a locality.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

## ARTICLE XI.

Protection at  
exhibitions.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial

designs or models, and trade-marks, for articles exhibited at official or officially recognized International Exhibitions.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues.

*Temporary protection.*—See sect. 39 of Act of 1883, as amended by the Act of 1886, s. 3.

The form of an Order in Council granting temporary protection to inventions at the Paris Universal Exhibition of 1889 is given at page 845.

## ARTICLE XII.

Each of the High Contracting Parties agree to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

Government  
Office.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété Industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

In this country the Patent Office fulfils this obligation.

## ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

International  
Bureau.

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les États Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les États l'Union.

See the Final Protocol, 5 and 6, *infra*, p. 615.

*An international office, &c.*—This office has been established at Berne. A monthly periodical, entitled *La Propriété Industrielle*, is published under its supervision.

#### ARTICLE XIV.

Conferences.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by Delegates of the said States. The next meeting shall take place in 1885 at Rome.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des États Contractants, entre les Délégués des dits États.

La prochaine réunion aura lieu en 1885, à Rome.

The first meeting was held at Rome in April and May, 1886.

#### ARTICLE XV.

Special arrangements between contracting parties.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles,