for the infringement of a patent the patentee is not entitled both to an account of profits and an inquiry into damages. That principle applies to every case of infringement, and therefore it must be taken to have settled conclusively that the patentee must, in all these cases where he has a decree, elect whether he will have an account of profits or an inquiry into damages (*q*). And in general he will elect to have damages (*r*).

To what profits account extends.

An account extends to all the direct or collateral profit which the defendant has made (*s*), and to any saving he has effected (*t*), by infringing the plaintiff's patent privilege. The question is, What profit is fairly attributable to the use of the plaintiff's invention? If the defendant had not used the plaintiff's invention, what would he have lost thereby? This is the amount recoverable by the plaintiff as profit (*u*).

It does not include the entire loss which the plaintiff sustained by reason of the infringement (*x*). The only question is what advantage the infringer has derived from the use of the patent over and above what he would have got from the use of processes open to the public (*y*).

An order for money payable as the result of an account is a debt provable in the infringer's bankruptcy (*z*).

An account will not be ordered when the evidence shows either that no profits have been made at all (*a*), or that the sales have been insufficient to make it worth while (*b*).

A plaintiff's right to an account, as well as to an injunction, may be barred by delay or acquiescence (*c*).

(*q*) *De Vitre* v. *Betts* (1873), L. R. 6 H. L. 321; *American Wire Co.* v. *Thompson* (1890), 44 Ch. Div. at p. 287; 7 R. P. C. at p. 158.

(*r*) Per Lindley, L. J., in *Siddell* v. *Vickers* (1892), 9 R. P. C. 152.

(*s*) *Crossley* v. *Derby Gaslight Co.* (1834), 3 My. & Cr. 428.

(*t*) *Household Co.* v. *Neilson* (1843), 1 Web. P. C. 697, n. (*r*). In *Bacon* v. *Spottiswoode* (1839), 1 Beav. 387, it was held that in such a case as *Household Co.* v. *Neilson* the plaintiff must allege in his bill and prove at the trial that such a saving had been effected.

(*u*) *Siddell* v. *Vickers* (1892), 9 R. P. C. 152.

(*x*) *Ellwood* v. *Christy* (1865), 18 C. B. N. S. 494; 34 L. J. C. P. 130; overruling *Walton* v. *Lavater* (1860), per Byles, J., 8 C. B. N. S. 190; 29 L. J. C. P. 275. For other decisions under the Act of 1852, see *Holland* v. *Fox* (1854), 3 E. & B. 977; *Vidi* v. *Smith* (1854), *ibid.* 969. In *Ellwood* v. *Christy*, where the plaintiff was assignee, an account was ordered only from the date of the registration of the assignment. But see *United Horseshoe and Nail Co.* v. *Stewart* (1888), 13 App. Ca. 401, 417; 5 R. P. C. 260.

(*y*) *United Horseshoe and Nail Co.* v. *Stewart* (1886), 3 R. P. C. 143, per Lord Kinnear; and American case, *Mowry* v. *Whiteley*, cited by him *ubi supra*; and 14 Wall. N. S. 620.

(*z*) *Watson* v. *Holliday* (1881), 20 Ch. Div. 780.

(*a*) *Bergmann* v. *Macmillan* (1881), L. R. 17 Ch. D. 423.

(*b*) *Sanitas Co.* v. *Condy* (a trade-mark case) (1887), 4 R. P. C. 533.

(*c*) *Crossley* v. *Derby Gas Light Co.* (1834), 1 Web. P. C. 120; 4 L. J. Ch. 25.

In taking an account against a defendant who has infringed a patent, it is proper to take into account, for the purpose of comparison, the profits made by him prior to the date of infringement. In *Siddell* v. *Vickers* (*d*), the patentee of an invention for an appliance for operating on large forgings commenced an action for infringement of his patent against Messrs. V. & Co. At the trial the Judge granted an injunction, and an account of profits. The defendants appealed, and the Court of Appeal affirmed the judgment, and directed an account of all iron or steel forgings manufactured by the defendants by the use of the plaintiff's invention, and also of the profits made by the defendants by reason of such use. On the taking of the account the defendants refused to give any account of the profits made by them prior to the date at which they commenced to use the plaintiff's invention. The plaintiff took out a summons for directions as to taking the account, and that the defendants should bring in a further and better affidavit. It was held that the plaintiff was entitled to an account of the profits made by the defendants prior to the date at which they commenced their use of his invention.

The plaintiff is entitled to discovery in aid of taking the account (*e*). The costs of taking the account may be, and generally are, reserved (*f*). The inquiry may be made by the chief clerk or a master, or may be sent to a referee, special or official.

(*d*) *Delivery up of Infringing Articles.*

Delivery up of infringing articles.

Besides an injunction, an account of profits or damages, a successful patentee may obtain an order that within a time limited thereby (*g*), the infringing articles shall, if possible (*h*), be ascertained, and either destroyed (*i*) or delivered up to the plaintiff (*k*), or marked (where the patentee's invention is com-

(*d*) (1889) 6 R. P. C. 464.

(*e*) *Saxby* v. *Easterbrook* (1872), L. R. 7 Ex. 207; 41 L. J. Ex. 113. In that case discovery was ordered, notwithstanding the pending of an appeal. And see cases quoted *ante*, p. 442, n. (*b*).

(*f*) *Slack* v. *Midland Railway* (1880), 16 Ch. Div. 81; *Cole* v. *Saqui* (1888), 5 R. P. C. 489, 497; *Siddell* v. *Vickers* (1888), 5 R. P. C. 101. In *Ellwood* v. *Christy* (1865), 18 C. B. N. S. 494, 495; 34 L. J. C. P. 130. The order was that if plaintiff did not succeed in surcharging the admitted profits by one-sixth the plaintiff should pay the costs of the inquiry.

(*g*) *Washburn and Moen Manufacturing Co.* v. *Patterson* (1884), 1 R. P. C. 191; *Otto* v. *Steel* (1886), 3 R. P. C. 109, 120.

(*h*) *Chadburn* v. *Mechan* (1895), 12 R. P. C. 135.

(*i*) *Betts* v. *De Vitre* (1864), 34 L. J. Ch. 289, 291; *Emperor of Austria* v. *Day* (1861), 3 De G. F. & J. 217; *Howe* v. *Webber* (1895), 12 R. P. C. 470.

(*k*) *Tangye* v. *Stott* (1865), 14 W. R. 386; *Young* v. *Fernie*, Pemberton, 236; *Washburn, &c., ubi supra*, 158, 162, 191.

posite, and the various parts may be innocently used for other purposes) so as to prevent a continuation of the infringement (*l*).

In *Edison-Bell Phonograph Co.* v. *Smith* (*m*), the Court of Appeal, varying the order of Wright, J., limited the order for delivery up to the infringing parts of the defendant's machine. The right of property in the infringing articles remains in the infringer (*n*).

Sect. 11.—Costs.

Costs before 1840.

Prior to 1840, a plaintiff in an action of infringement, who obtained even nominal damages, was entitled to recover his full costs against the defendant, unless the Judge before whom the action was tried certified under 43 Eliz. c. 6, s. 2, that no costs should be allowed.

Costs where less than forty shillings recovered.

The statute 3 & 4 Vict. c. 24, s. 1, repealed so much of that enactment as related to costs in actions of trespass on the case (which included patent actions), and provided that if the plaintiff recovered less than 40*s*. damages he should not be entitled to any costs at all unless the presiding Judge should, immediately after verdict, certify that "the action was really brought to try a right besides the mere right to recover damages . . . . or that the trespass or grievance in respect of which the action was brought was wilful and malicious."

Certificate had to be obtained immediately after trial.

A certificate could only be granted under 3 & 4 Vict. c. 24, immediately after the trial. The lapse of several months between a verdict for nominal damages (*o*) and an application for a certificate by the successful plantiff was held to be a fatal obstacle to the exercise by the Judge of his statutory discretion; and the Court even doubted whether a certificate could be granted after another cause had been called on (*p*).

Certificate of validity under Act of 1835.

The statute 5 & 6 Will. IV. c. 83, enacted that in any action at law, or any suit in equity, in respect of any alleged infringe-

(*l*) *Needham* v. *Oxley* (1863), 8 L. T. N. S. 532; *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1884), 1 R. P. C. 229; *Plimpton* v. *Malcolmson*, Seton, 565; *Badische Anilin, &c.* (1884), 24 Ch. D. 156.

(*m*) (1894) 11 R. P. C. 389; and see *Automatic Weighing Machine Co.* v. *Fearby* (1893), 10 R. P. C. 442.

(*n*) See *Vavasseur* v. *Krupp* (1878), 9 Ch. Div. 351.

(*o*) The damages awarded under this Act were usually nominal, the plaintiff's object being to establish his right at law before seeking pecuniary reimbursement for his losses from a suit in Equity. Sometimes, however, they were exemplary. Thus in *Lewis* v. *Marling* (1829), 1 Carp. 475, the jury gave 200*l*. damages; and in *Newton* v. *Grand Junction Railway Co.* (1845), 5 Exch. 331, they were assessed at 1,000*l*. Coryton, p. 307.

(*p*) *Gillett* v. *Green* (1841), 10 L. J. Ex. 124; 7 M. & W. 347.

ment of letters patent, the Judge might certify that the validity of the patent came in question before him, and that on this certificate being given in evidence in any other suit in which the patentee obtained a verdict, the patentee should be entitled to receive treble costs, unless the Judge certified to the contrary (sect. 3), *to be taxed at three times the taxed costs* (*q*).

Treble costs.

There were two conditions precedent to the enjoyment by a patentee of the protection of this enactment: (1) he must have obtained a verdict or decree in the subsequent action; and (2) the Judge before whom the first action was tried must have granted his certificate that the validity of the patent had come in question before him. The second condition was necessary because the pleadings in a cause might, upon the face of them, appear to raise almost every possible question respecting the validity of the patent; and yet the defendant might not at the trial or hearing raise any such question (*r*). The Judge could deprive a successful plaintiff of costs if he thought fit.

Conditions necessary to obtain treble costs.

The privilege conferred on patentees by this statute was, however, abused. An instance is recorded by Godson, in which a successful patentee commenced no less than forty actions. Accordingly, the Act 5 & 6 Vict. c. 97, s. 1, repealed that portion of 5 & 6 Will. IV. c. 83, s. 3, which gave treble costs, and provided that the costs should be taxed in such a way as to be a "*full* and reasonable indemnity as to all costs, charges, and expenses incurred in and about" the action.

Abuse of rule as to treble costs.

The right of a patentee to have full costs under 5 & 6 Will. IV. c. 83, s. 3, amended by 5 & 6 Vict. c. 97, s. 1, was dependent on the discretion of the Judge before whom the second action was tried, and who might deprive him of such costs by certifying to that effect at the trial. This discretion was liable to be exercised when the certificate of validity had been obtained by the patentee

Under the Act of 1852.

(*q*) The costs which this statute enabled a patentee to recover on a second or subsequent verdict passing for him were "treble costs, *to be taxed at three times the taxed costs.*" The words in italics prevented the application of the ordinary rule as to double or treble costs, viz., that "double or treble costs are not to be understood to mean, according to their literal import, twice or thrice the amount of single costs." Without any such clause of interpretation, the amount of treble costs would have been calculated in the following manner. To the sum allowed to the party for costs taxed in the ordinary way, was added one-half of that sum, and also one-fourth of the same sum, and these three sums being added together, formed what was technically termed treble costs, *i.e.*, common costs, and three-fourths of the common costs, or one-fourth less than twice the common costs. Hindmarch, p. 303; Webster Stats. p. 37, n. (*o*).

(*r*) *Ibid.* p. 302; and see *Stocker* v. *Rogers* (1843), 1 C. & K. 99; *Gillett* v. *Wilby* (1839), 9 C. & P. 334; 1 W. P. C. 270; *Newall* v. *Wilkins* (1851), 17 L. T. 20.

Collusion. Unnecessary action. Compromise. Validity not questioned.

in an action tried by collusion for the purpose of obtaining it (*s*), or where the second action appeared to be a harsh or unnecessary proceeding, or ended in a compromise (*t*), or when the defendant in that action did not question the validity of the patent, but wished *bonâ fide* to try a doubtful question of infringement (*u*).

Effect of Act of 1852.

Any doubt as to the meaning of the term "full costs" in 5 & 6 Vict. c. 97, s. 1, was removed by sect. 43 of the Patent Law Amendment Act, 1852, which defined it as "full costs, charges, and expenses, taxed as between attorney and client," and repeated in substance the provisions of the earlier statutes, and enacted that it should be lawful for the Judge before whom an action for infringing letters patent was tried, to certify on the record that the validity of the patent came in question, and that the record with such certificate being given in evidence in any suit or action for infringing the said letters patent should entitle the plaintiff, on obtaining a decree, decretal order, or final judgment, to full costs as above defined, unless the Judge should certify that he ought not to have them (*x*).

Certificate of validity.

Costs under the present practice.

The ordinary rules as to costs are those to be found in R. S. C. Order LXV. When any action, cause, matter or issue is tried with a jury the costs follow the event, unless the Judge shall for good cause otherwise order (*y*). In other cases the costs are awarded in the discretion of the Court (*y*). The County Courts Act, 1888, limits the costs in certain cases. But as infringement actions cannot be tried in the County Court (*z*) this will not affect the costs in an infringement action.

The rules relating to costs may be found in the R. S. C. 1883,

(*s*) *Davenport* v. *Rylands* (1865), L. R. 1 Eq. 302; 35 L. J. Ch. 204.

(*t*) *Betts* v. *De Vitre* (1864), 11 Jur. N. S. 9.

(*u*) Cp. *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140.

(*x*) The practice under this section was as follows:—

(1) The provisions applied only to a patentee; and no certificate could be given to the defendant in an action for infringement: *Badische Anilin, &c.* v. *Levinstein* (1885), 29 Ch. D. 366, per Bowen, L. J., at p. 419.

(2) It was necessary that the certificate of validity should be given in evidence at the subsequent trial.

(3) The words "decree, decretal order, or final judgment," did not include a motion for a new trial of a subsequent action, and the costs of an unsuccessful motion of that description were given only as between party and party: *Boviil* v. *Goodier*, Griff. A. P. C. 49.

(4) Under sect. 43 of the Act of 1852 it was necessary that the certificate of validity should be given by "the Judge before whom the trial was heard;" see *Otto* v. *Linford* (1880), 46 L. T. N. S. 35.

(5) It was necessary that the decree or order should contain an express direction to the taxing master that the costs be so taxed: *Lister* v. *Leather* (1858), 4 K. & J. 425.

(*y*) R. S. C. Order LXV. rule 1.

(*z*) *Queen* v. *County Court Judge of Halifax* (1891), 2 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 342.

Order LXV., and in the notes to that order in the "Annual Practice." But the following need special attention: (a) Costs where a certificate of validity has previously been given. (b) Costs of particulars of breaches and objections. (d) Apportionment of costs of issues. (d) Costs on higher scale. (e) Costs where defendant submits.

(a) *Certificate of Validity and Costs.*

Act of 1883.

Under sect. 31 of the present Act a certificate of validity may be granted by the Court (*i.e.*, by the High Court of Justice (*a*) or, perhaps, the Court of Appeal (*b*)) or a Judge, *i.e.*, may be given in Chambers (*c*).

Vice-Chancellor of Lancaster.

There was a question whether the Vice-Chancellor of the County Palatine of Lancaster was within the meaning of the words "Court or a Judge" in this section (*d*). But under the Chancery of Lancaster Act, 1890 (*e*), undoubtedly the Vice-Chancellor has the power to give a certificate.

Provisions of Act of 1883.

The section provides that, in an action for infringement of a patent the Court or a Judge may certify (*f*) that the validity of the patent came in question, and if the Court or a Judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

Cases.

The following decisions under this section may be mentioned, though they must be read with this qualification, that the power of granting or of refusing solicitor and client costs is discretionary, notwithstanding the certificate.

Solicitor and client costs.

An action commenced before a certificate is given that the validity of a patent has come in question is not a subsequent action so as to entitle a successful plaintiff to solicitor and client costs, though it be tried after the certificate has been given in the other action (*g*).

(*a*) Cp. sect. 117, sub-sect. 1.

(*b*) R. S. C. 1883, Order LVIII. rule 4; *Cole* v. *Saqui* (1889), 40 Ch. Div. 132: 6 R. P. C. 41. But see *Incandescent Gas Light Co.* v. *De Mare, &c., Syndicate* (1896), 13 R. P. C. at p. 579.

(*c*) Jud. Act, 1873, sect. 39.

(*d*) Day, J., decided in the negative in *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. at p. 185.

(*e*) 53 & 54 Vict. c. 23.

(*f*) A certificate under this section is not a judgment, decree, or order within the meaning of the Judicature Act, 1873, sect. 19, and is not therefore appealable: *Haslam Co.* v. *Hall* (1888), 20 Q. B. D. 491; 5 R. P. C. 144.

(*g*) *Automatic Weighing Co.* v. *International Hygienic Society* (1889), 6 R. P. C. 475. Solicitor and client costs were not given on a breach of an injunction where what was done by the

Uncontested action.

It is doubtful whether a certificate of validity will be granted in an uncontested action. Kay, J., refused to certify in *Peroni* v. *Hudson* (*h*), where the defendant did not appear at the trial; but in a similar case, *Haydock* v. *Bradbury* (*i*), Kekewich, J., granted the usual certificate, notwithstanding the defendant's absence. "If a defendant," said his Lordship, "by non-appearance at the trial, could deprive a successful plaintiff of the right which you are now claiming for him, he might be put to the trouble of proving it all over again."

In *Delta Metal Co., Ltd.* v. *Maxim-Nordenfelt Guns and Ammunition Co.* (*k*), defendant consented to judgment. Collins, J., gave a certificate that validity had come in question, but gave no opinion on the point himself.

Certificate of validity where patent not really contested.

The objection to granting a certificate where there has been no contest is thus expressed, in *Stocker* v. *Rogers* (*l*), by Erle, J.: "I think that, as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties, and it would be possible in a case like the present for two parties by collusion to consent to a verdict in favour of a patent; and if they could obtain a certificate under sect. 3 of the statute, to use it afterwards to the injury of a third party who was really contesting the validity of the patent."

Where a certificate of validity has been granted in a previous action, it need not be again granted. To do so would be to throw doubt on the sufficiency of the former certificate (*m*).

If a certificate be granted, and in a subsequent action a defendant does not attack the validity of the patent, but relies on non-infringement, it is doubtful whether plaintiff will get solicitor and client costs; there are cases both ways (*n*).

defendants was not done vexatiously or improperly, but in the erroneous belief that they were entitled so to do: *Spencer* v. *Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 46.

(*h*) (1884) 1 R. P. C. at p. 263.

(*i*) (1887) 4 R. P. C. at p. 75. See also *Edison-Bell Phonograph Co.* v. *Edison Phonograph Co.* (1894), 11 R. P. C. 33.

(*k*) (1891) 8 R. P. C. 247.

(*l*) (1846) 1 C. & K. 99.

(*m*) *Edison Co.* v. *Holland* (1889), 6 R. P. C. at p. 287.

(*n*) In *Automatic Weighing Machine Co.* v. *International Hygienic Society* (1889), 6 R. P. C. 475, and in *Boyd* v. *Tootal & Co.* (1894), 11 R. P. C. 175, solicitor and client costs were refused. To the contrary, see *United Telephone Co.* v. *Townshend* (1886), 3 R. P. C. 10: *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140: *United Telephone Co.* v. *St. George* (1889), 3 R. P. C. 33, 321. In *Automatic Weighing Machine Co.* v. *Fearby* (1893), 10 R. P. C. 442, a very slight attack on the patent resulted in an order for solicitor and client costs. And see *Davenport* v. *Rylands* (1866), 1 Eq. 302; 35 L. J. Ch. 204.

In *United Telephone Co.* v. *Patterson* (*o*), an action for infringement of two patents, the plaintiffs claimed the usual injunction and damages. In his defence the defendant did not question the validity of the patents and denied the infringement, but paid 75*l.* into Court in the alternative. At the hearing the application for granting an injunction was not resisted by the defendant, and the inquiry as to damages was referred to Chambers. The plaintiffs having proved the certificate of validity of the patents being questioned in previous actions under sect. 43 of Patent Act, 1852, and sect. 31 of Patent Act, 1883, the defendant applied to the Judge to certify that the plaintiffs ought not to have costs as between solicitor and client, on the ground that the plaintiffs' patent had not been disputed, and their claim to relief not seriously contested by the defendant. It was held that the plaintiffs were entitled to costs of the action as between solicitor and client, those of the reference as to damages being reserved, and that the fact that the defendant had not disputed the validity of the patent, and had by paying money into Court so far admitted his liability, afforded no ground for granting defendant a certificate depriving plaintiffs of costs as between solicitor and client.

Action for threats.

Doubt exists upon the point whether an action for threats is "an action for infringement of a patent" within the meaning of sect. 31. In *Kurtz* v. *Spence* (*p*), Mr. Justice Kekewich held that it was not. In *Crampton* v. *The Patents Investment Co.* (*q*), Mr. Justice Field granted a certificate without prejudice to its validity if it came into operation. His Lordship expressed great doubt, however, whether he had jurisdiction to grant it.

This section, like sect. 43 of the Act of 1852 (*r*), applies only to a second action for infringement.

Only applies to second action.

In *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.* (*s*), where the second action was in the paper for trial at the same time as the first action, it was held that a certificate given in the first action did not make the defendant in the second action, although he raised the question of the validity of the patent, liable to solicitor and client costs.

(*o*) (1889) 6 R. P. C. 140. But see next case.
(*p*) (1888) 5 R. P. C. at p. 184.
(*q*) (1888) *Ibid.* at p. 404.
(*r*) *Penn* v. *Bibby* (1866), L. R. 3 Eq. 308; 36 L. J. Ch. 277.
(*s*) (1889) 6 R. P. C. 121; and see *Bovill* v. *Hadley* (1864), 10 L. T. N. S. 650; 17 C. B. N. S. 435.

Validity impeached on new grounds.

When the validity of a patent was impeached in a second action on grounds different from the grounds of its impeachment in the first action, the costs as between solicitor and client were not allowed. A second certificate of validity may be granted with reference to the extent to which the validity of the patent came in question in the second action (*t*).

In *Haslam Co.* v. *Hall* (*u*), where the patent was held to be invalid, Stephen, J., granted a certificate that the validity had come in question, but refused to certify anything further.

A certificate of validity may perhaps be granted, although the plaintiff has failed on the issue of infringement (*x*); but it cannot be granted to a defendant, though successful (*y*).

Discretion of Judge in refusing full costs same as before Act of 1883.

The law as to the discretion of the Judge in refusing full costs where there has been a certificate of validity has not been altered by the Act of 1883; but *primâ facie* the holder of the certificate is entitled to his solicitor and client costs (*z*).

Action vexatious.

Where defendants did not question the validity of the plaintiff's patent, admitted that they had used it many years ago, but explained that they had not since used, and did not intend to use it, and where the damage, if any, had been very trifling, the Court considered the action very vexatious, and deprived the plaintiff of full costs (*a*). And where validity was not questioned, and the infringement was innocent, the ordinary costs alone were granted (*b*).

Full costs where validity not disputed a second time.

(*b*) *Costs of Particulars* (*c*).

By the Act of 1852, sect. 43, it was (*inter alia*) provided that, in taxing the costs in any action, regard shall be had to the particulars delivered in such action, and the plaintiff and

(*t*) *Otto* v. *Steel* (1886), 3 R. P. C. at p. 120.

(*u*) (1888) 5 R. P. C. at p. 27.

(*x*) *Automatic Weighing Machine Co.* v. *Knight* (1889), 6 R. P. C. 113, 126; *Tweedale* v. *Ashworth* (1890), 7 R. P. C. at p. 436; *Birch* v. *Harrap* (1896), 13 R. P C. 615. But Lord Herschell did not encourage this in *Morris* v. *Young* (1895), 12 R. P. C. at p. 465.

(*y*) *Badische, &c.* v. *Levinstein* (1885), 29 Ch. Div. 366, 419; 2 R. P. C. 94.

(*z*) *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140.

(*a*) *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. 184.

(*b*) *Boyd* v. *Tootal, Broadhurst Lee Co.* (1894), 11 R. P. C. 175.

(*c*) The General Rules of Hilary Term (2 Will. IV.) provided, by sect. 74, that no costs should be allowed on taxation to a plaintiff upon any counts or issues upon which he had not succeeded; and the costs of all issues found for the defendant were to be deducted from the plaintiff's costs. The statute 5 & 6 Will. IV. c. 83, s. 6, provided that in taxing costs regard should be had to the part of the case proved and certified by the Judge, and that "the costs of each part of the case should be given according as either party had succeeded or failed therein, regard being had to the notice of objections as well as the counts in the declaration, and *without regard to the general result of the trial.*"

defendant respectively shall not be allowed any costs in respect of any particular unless certified by the Judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause.

Under this section it was decided that—

The certificate of the Judge who tried the cause that the defendant had proved his particulars of objections, was a condition precedent to his right on taxation to any costs in respect of such particulars, even in the case of a nonsuit (*d*). "With respect to the costs of the issues," said Pollock, C. B., in *Honiball* v. *Bloomer*, "there is no doubt that where the plaintiff is nonsuited, the defendant is entitled to all the costs of the issues, that is to say, of the pleadings and evidence necessary to support them. But as the particulars are the creatures of this statute, and the costs of this particular class of proceedings are declared by the Legislature to be no part of the general costs of the cause, and that, in the absence of a certificate, they shall not be recoverable, they are not recoverable."

Honiball v. *Bloomer* was considered in *Batley* v. *Kynock* (*e*), where, after the trial of issues had been fixed, the plaintiff obtained the common order at the Rolls, dismissing his own bill with costs. Among the items in the defendant's bill of costs were charges for drawing particulars of objections, and having the same settled by counsel, the expenses of scientific witnesses and the price of a model, all of which the taxing master had substantially allowed. Bacon, V.-C., in confirming this decision, said: "Here the state of circumstances contemplated by the statute never did and never could arise. The case referred to at common law (*Honiball* v. *Bloomer*, 10 Ex. 538) has no application to the present." Sect. 43, however, applied only to cases where there had been a trial; where there had been no trial the law stood as it did before (*f*).

Act of 1883.

Sect. 29, sub-sect. 6 of the Patents Act, 1883, provides that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and that they respectively shall not be allowed any costs in respect of any particular

(*d*) *Honiball* v. *Bloomer* (1854), 24 L. J. Ex. 11; 10 Exch. 538; *Parnell* v. *Mort* (1884–85), L. R. 29 Ch. D. 325.

(*e*) (1874–75) 20 Eq. 635.

(*f*) *Greaves* v. *Eastern Counties Railway Co.* (1859), 28 L. J. Q. B. 290; 1 E. & E. 961, but distinguish *Curtis* v. *Platt* (1864), 10 Jur. N. S. 823.

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.

This section differs in effect from the Act of 1852, sect. 43, in the addition of the words "or to have been reasonable and proper."

"Court or a Judge" means a Judge of the High Court, whether sitting in Court or Chambers, and includes the Court of Appeal (*g*); and now includes the Vice-Chancellor of the County Palatine of Lancaster (*h*). If the application for the certificate is not made at the trial, it may be made within a reasonable time after (*i*).

Costs of particulars when defendant not called on.

In *Griffin* v. *Weaver* (*k*), G. brought an action for infringement of a patent for improvements in metallic boxes or receptacles for holding alimentary and other substances. By his defence, the defendant alleged that the patent was invalid on a number of different grounds, including anticipation. At the trial the plaintiff's first witness, in cross-examination, was unable to distinguish the alleged invention from a previous specification, and the action was dismissed on the ground of that prior publication. The defendant was allowed the costs of all particulars of objections involved in that decision.

In *Germ Milling Co.* v. *Robinson* (*l*) the plaintiffs, in an action for infringement, failing on the ground of the invalidity of their patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence. The defendants applied for a certificate that their particulars of objections were reasonable and proper, and the plaintiffs applied for a certificate that they had proved their particulars of breaches. It was held, that the Judge must decide which of the particulars of breaches were reasonable and proper in regard to the case so far as it had gone, that a certificate would be granted in respect of those particulars only which the Judge specifically mentioned, and also that, as the plaintiffs were not entitled to any costs, they were not entitled to any certificate.

In *Young* v. *Rosenthal* (*m*) Grove, J., granted a certificate of

(*g*) *Cole* v. *Saqui* (1889), 40 Ch. Div. 132; 6 R. P. C. 41.

(*h*) 53 & 54 Vict. c. 23, s. 3.

(*i*) *Rowcliffe* v. *Morris* (1886), 3 R. P. C. 145.

(*k*) (1889) 6 R. P. C. 396; cp. *Slazenger* v. *Feltham*, *ibid.* 130.

(*l*) (1886) 3 R. P. C. 254; cp. *Rothwell* v. *King* (1887), 4 R. P. C. 397; *Albo-Carbon Light Co.* v. *Kidd*, *ibid.* 539; *Longbottom* v. *Shaw* (1888), 5 R. P. C. 497, and (1889) 6 R. P. C. 147; *Oddy* v. *Smith* (1888), 5 R. P. C. 503; *Cole* v. *Saqui* (1888), 5 R. P. C. 489; *Boyd* v. *Horrocks* (1889), 6 R. P. C. 152, 162.

(*m*) (1884) 1 R. P. C. at p. 41.

breaches where the patent was invalid, but infringement was proved. This was also done in *Badische, &c.* v. *Levinstein* (*n*).

Practice of Court of Appeal and House of Lords.

The Court of Appeal has power to give a certificate of particulars of objections, if it has sufficient material on which to determine that they are reasonable and proper, where it reverses the judgment of the Court below by which the patent was found valid (*o*). The House of Lords may do the same (*p*).

But where the Court of Appeal is able to dispose of an action on one point, viz., that there is no infringement, it will not hear the case further to decide if the objections were reasonable (*q*). Nor can it give a certificate unless it has sufficient material on which to found an opinion (*r*).

If the appeal is dismissed, a difficult point arises, and it is doubtful whether the Court above has power to make any order as to the particulars differing from what the Judge has ordered (*s*). Order LVIII., rule 4, authorises the Court of Appeal to make orders that *ought* to have been made, so that when the Court of Appeal reverses the Court below it may certify for particulars on the ground that the Court ought to have done so, but the case is different if it affirms the order of the Judge. There is no appeal from the granting or withholding of the certificate (*t*).

Not always necessary to prove particulars if they were reasonable.

The application for a certificate may be granted, although the particulars have not been proved, if the Court is of opinion that the particulars were reasonable and proper (*u*).

In *Cassel Gold Co.* v. *Cyanide Recovery Co.* (*x*), the patentee was defeated in the Court below; on appeal his patent was declared invalid on the ground that the first claim was bad, but the Court decided that the invention was new, useful, and good subject-matter. The defendants had pleaded want of novelty and invention, and in support of their pleas had delivered particulars of objections, which the Judge below had certified to have been reasonably and properly delivered. The Court of Appeal refused to disturb the certificate, for (assuming that

(*n*) *Badische, &c., Fabrik* v. *Levinstein* (1885), 29 Ch. Div. at p. 419; 2 R. P. C. at p. 118; 52 L. J. Ch. 704. And see a converse case, *Jardine* v. *King-Mendham & Co.* (1896) 13 R. P. C. 411.

(*o*) *Cole* v. *Saqui* (1889), 40 Ch. Div. 132; 6 R. P. C. 41.

(*p*) *Morris* v. *Young* (1895), 12 R. P. C. at p. 465. In *Morgan* v. *Windover* (1890), 7 R. P. C. 446, the matter went back to the Judge.

(*q*) *Boyd* v. *Horrocks* (1889), 6 R. P. C. 162; *Longbottom* v. *Shaw* (1889), *ibid.* 143.

(*r*) *Ibid.*

(*s*) See per Lindley, L. J., in *Cassel Gold Co.* v. *Cyanide Recovery Co.* (1895), 12 R. P. C. 303.

(*t*) *Haslam* v. *Hall* (1888), 20 Q. B. D. 491; 57 L. J. Q. B. 352; 5 R. P. C. 144.

(*u*) *Phillips* v. *Ivel Cycle Co.* (1890), 7 R. P. C. 77.

(*x*) (1895) 12 R. P. C. 303.

it had power) it considered that the defendants had acted reasonably and properly in using them, and were entitled to have them allowed, though they were not proved.

The Court must be satisfied that particulars are reasonable and proper.

The Court has no power to give a certificate as to particulars unless it is satisfied that they were reasonable and proper. And as the Court cannot go through the particulars and try bye-issues merely to determine the question of costs, it frequently happens that the successful party fails to get the costs of particulars through no fault of his own. The following cases illustrate the law on this point:—

Longbottom v. *Shaw* (*y*).—An action for infringement was dismissed with costs, the defendant not being called upon; the Judge refused to certify for the particulars of objection, and they were disallowed on taxation. Kay, J., said: "There might well be a case when the matter was decided against the plaintiff without calling on the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses (*z*), might think it right to look at the particulars of objections and allow the costs of such particulars of objections as were, in fact, made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be in such a case as this, or in a similar case, like that which I have just described, propriety in the Court looking into the particulars of objections and saying whether they were reasonable or not, having regard to the specification. But in this case, right or wrong, the Court came very clearly to the conclusion that it was not bound to do that, because the thing had been decided absolutely on the words of the specification itself. Therefore it seems to me that the Act of Parliament is quite express."

Court will not go into the case merely to try the propriety of the particulars.

In the same case (*a*) it had been determined by the Court of Appeal that the Court should not go into the particulars merely to decide whether they were reasonable and proper, and with a view to giving a certificate for the costs.

In *Mandelberg* v. *Morley* (*b*), the plaintiffs at the trial sub-

(*y*) (1889) 43 Ch. Div. 46; 58 L. J. Ch. 734; 6 R. P. C. 510. See also *Dairy* v. *Bailey* (1891), 8 R. P. C. at p. 168. The fact that defendant does not appear will not *per se* deprive plaintiff of his certificate: *Pneumatic Tyre Co.* v. *Carr*, Law Journal (1896), 15 Aug.

(*z*) In *Badham* v. *Bird* (1888), 5 R. P. C. 238, the plaintiff's case broke down, but only those particulars used in cross-examination were certified for.

(*a*) (1889) 6 R. P. C. 143; and cf. *Boyd* v. *Horrocks* (1889), *ibid.* 152.

(*b*) (1895) 64 L. J. Ch. 245; 12 R. P. C. 35.

mitted to have their action dismissed with costs before the completion of the trial. Stirling, J., refused a certificate as to those particulars which had not been in evidence; and not being satisfied that those on which he had some materials to form a judgment were reasonable and proper, he refused the certificate also for them.

In *Middleton* v. *Bradley* (*c*), plaintiff had discontinued the action. It was decided that there could be no certificate for the particulars of objection, and therefore no costs could be allowed for them, as the Court had no materials on which it could form a judgment as to their propriety. But the Court may look at affidavits or other evidence used in any interlocutory proceedings, in order to determine whether the particulars are reasonable and proper.

Boake, Roberts & Co. v. *Stevenson* (*d*) is a case of a different character. The plaintiff applied for leave to discontinue, and the Court gave leave upon certain terms, one of which was the payment of the costs of particulars of objections. This decision, therefore, does not in any way affect the rule to be derived from the cases last quoted. Nor do the decisions in *Germ Milling Co.* v. *Robinson* (*e*); *Albo-Carbon Light Co.* v. *Kidd* (*f*); *Nuttall* v. *Hargreaves* (*g*). See also *Newsum* v. *Mann* (*h*) (no certificate); *Lees* v. *West London Cycle Stores* (*i*) (certificate granted); *Willoughby* v. *Taylor* (*k*) (certificate granted in a threats action).

Successful party not bound to pay costs of particulars unless they are disallowed by order.

If a certificate is not granted, the taxing master cannot look into the particulars, but unless they are specially disallowed, the successful party (*l*), though he cannot get the costs of the particulars, cannot be made to pay the costs of them to his opponent (*m*).

If the patent is upheld, costs of particulars going to the validity will usually be disallowed, though they affect the constructions put on the claims by the Court (*n*).

(c) *Apportionment of Costs of Issues.*

Costs of issues.

Where issues of fact and law are raised upon a claim or counter claim, the costs of the several issues, both in law and

(*c*) (1895) 2 Ch. 716; 12 R. P. C. 390.
(*d*) (1895) 12 R. P. C. 228.
(*e*) (1886) 3 R. P. C. 254, *supra*.
(*f*) (1887) 4 R. P. C. 535.
(*g*) (1891) 8 R. P. C. 273. See an interesting article in the Law Journal (1895), at p. 405.
(*h*) (1890) 7 R. P. C. 307.
(*i*) (1892) 9 R. P. C. 301.
(*k*) (1894) 11 R. P. C. 55.
(*l*) R. S. C. Order LXV., rule 27 (29).
(*m*) *Garrard* v. *Edge* (1890), 44 Ch. Div. 224; 59 L. J. Ch. 379; 7 R. P. C. 139.
(*n*) *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 343. But see *Cassel Gold Co.* v. *Cyanide Recovery Co.* (1895), 12 R. P. C. 303.

fact, unless otherwise ordered, follow the event (*o*). The general principle on which the Court acts in applying this rule to the costs occasioned by issues raised in actions of infringement, was thus stated by Bowen, L. J., in *Badische Anilin, &c.* v. *Levinstein* (*p*): "It seems to me that, without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they will be defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense."

General principles, Bowen, L. J.

The principle of apportionment, thus defined, has accordingly been applied not only where a plaintiff had established the validity of his patent without proving infringement (*q*), but also where a defendant, while failing on the issue of infringement, had succeeded on that of validity (*r*).

In *Phillips* v. *Ivel Cycle Co.* (*s*), a defendant succeeded on the issue of validity, but failed on the issue of infringement; he was allowed no costs of the infringement issue, but was not ordered to pay any. In other cases (*t*), the costs of the infringement issue have been given to an unsuccessful plaintiff who proved infringement. On the other hand, seeing there can really be no infringement of an invalid patent, the Court has refused to make a successful defendant pay the costs of an infringement issue (*u*).

(*o*) R.S.C. (1883), Order LXV., rule 2.

(*p*) (1885) 29 Ch. D. at p. 419; 2 R. P. C. at p. 418; 52 L. J. Ch. 704. In the same case the Court of Appeal decided that apportionment of costs will apply to the costs of an appeal: *ibid.* 420.

(*q*) *Simmonds* v. *Hitchman* (1881), Lawson, 174; 29 Ch. D. 417, n. (4); *Needham* v. *Johnson* (1884), 1 R. P. C. 49, 59; *Nordenfelt* v. *Gardner* (1884), *ibid.* 61; *Westinghouse* v. *Lancashire and Yorkshire Railway Co.* (1884), *ibid.* 229; *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 343.

(*r*) *Wegmann* v. *Corcoran* (1878–79), 27 W. R. 357, 362; *United Telephone Co.* v. *Harrison* (1882–83), 21 Ch. D. 747; 51 L. J. Ch. 705; *Hocking* v. *Fraser* (1886), 3 R. P. C. 7; *Edison, &c., Co.* v. *Woodhouse* (1886), *ibid.* 167; *Young* v. *Rosenthal* (1884), 1 R. P. C. 29, 41; Cp. *Pooley* v. *Pointon* (1885), 2 R. P. C. 167; *Lawrie* v. *Baker* (1885), *ibid.* 213; *Lawrence* v. *Perry* (1885), 2 R. P. C. 179; *Lister* v. *Norton* (1886), 3 R. P. C. 199, 211; *Badham* v. *Bird* (1888), 5 R. P. C. 238.

(*s*) (1890) 7 R. P. C. 77.

(*t*) *Binnington* v. *Hill* (1891), 8 R. P. C. 326; *Blakey* v. *Latham* (1889), 6 R. P. C. 29, 184.

(*u*) *Guilbert-Martin* v. *Kerr* (1887), 4 R. P. C. 18; *Westley-Richards* v. *Perkes* (1893), 10 R. P. C. 194.

The Court has, however, refused to allow the costs of an issue which were trifling and were not materially different from the costs of the cause (*x*).

In *Sugg* v. *Bray* (*y*), where it appeared that if the costs were apportioned the defendant would have to pay, in respect of issues on which he had failed, at least as much as he would be entitled to receive from the general costs of the cause, the Court, to avoid a very troublesome and difficult apportionment of costs on taxation, cut the knot by giving no costs to either party.

In *Moore* v. *Bennett* (*z*), the Court of Appeal had held the plaintiff's patent bad on account of insufficiency in the specification, and also that there had been no infringment. The House of Lords adjudged the patent to be valid, but confirmed the decision of the Court below on the question of infringement. The appeal was therefore dismissed, but, as it had resulted in a material and important advantage to the plaintiff, without costs.

In *Boyd* v. *Horrocks* (*a*), an action in the Palatine Court for the infringement of a patent, the defendants unsuccessfully raised numerous issues, including that of infringement. Judgment was given for the plaintiff with costs, and a certificate was granted that his particulars of breaches had been proved, and were reasonable. The plaintiff's taxed costs were, by consent, paid into Court by the defendants, pending an appeal to the Court of Appeal. On the hearing of the appeal, the Court, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the action with costs. The defendants applied for repayment of the costs paid by them into Court. It was held that the plaintiff was not entitled to an apportioned part of these costs attributable to the points other than infringement on which he had succeeded at the trial, and that the costs must be paid out of Court without waiting for the result of an appeal to the House of Lords. Though it is right for the Court, if, after hearing the evidence, it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues, nevertheless the Court will not apportion the costs of issues which have never been heard owing to the Court deciding that the patent is bad at the outset of the case (*b*).

(*x*) *Kaye* v. *Chubb* (1887), 4 R. P. C. 300, 302; Cp. *Edison, &c., Co.* v. *Holland* (1888), 5 R. P. C. 483; *Blakey* v. *Latham* (1889), 6 R. P. C. 38, 186, 190.

(*y*) (1885) 2 R. P. C. at p. 248, per North, J.

(*z*) (1884) 1 R. P. C. at p. 148.

(*a*) (1889) 6 R. P. C. 528.

(*b*) Cf. cases under the Designs sec-

In *Vorwerk* v. *Evans* (*c*), a litigant was allowed the costs of proving an assignment to himself which had been denied on the pleadings for the purpose of causing a certain witness to be called.

Sometimes two or more patents are sued on, and it may be that one is upheld whilst another is declared invalid, or the infringement issue may result differently in each case. The costs will then be apportioned according to the results (*d*). Thus where the Court decided that there had been no infringement, but that the attack on the patent failed, the costs of establishing validity were given to the plaintiff nevertheless (*d*).

(*d*) *Costs on the Higher Scale.*

Costs may be allowed on the higher scale on special grounds.

It is provided by the Supreme Court Rules that costs on the "higher scale" may be allowed either generally in any cause or matter, or as to the costs of any particular application made, or business done, in any cause or matter, if, on special grounds arising out of the nature and importance or the difficulty or urgency of the case, the Court or a Judge shall, at the trial or hearing or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or matter shall or shall not be brought to trial, or hearing, or to further consideration (as the case may be), so order, or if the taxing officer, under directions given to him for that purpose by the Court or a Judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid (*e*).

Where the action was of a complicated nature, the Court, considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing master to allow all or any part of the plaintiff's costs on the higher scale, if he thought fit, on the ground of the "nature" or "difficulty" of the case (*f*).

Costs of action for injunction not allowed on higher scale on ground that defendant submitted to an injunction (*g*), nor merely on the ground that important questions were raised (*h*).

tions: *Winfield* v. *Snow* (1891), 8 R. P. C. 15; *Blank* v. *Footman* (1888), 39 Ch. Div. 678; 57 L. J. Ch. 909; 5 R. P. C. 653; *Cooper* v. *Symington* (1893), 10 R. P. C. 264.

(*c*) (1890) 7 R. P. C. 167.

(*d*) *Shoe Machinery Co.* v. *Cutlan* (1895), 12 R. P. C. 343; *Wegmann* v. *Corcoran* (1879), 27 W. R. 357, 362.

(*e*) R. S. C. Order LXV., rule 9.

(*f*) *Fraser* v. *Brescia Steam Tramways Co.* (1887), 56 L. T. 771.

(*g*) *Hudson* v. *Osgerby* (1884), W. N. 83; 32 W. R. 566.

(*h*) *Grafton* v. *Watson* (1884), 51 L. T. 141. See also *Cardiff Steamship Co.* v. *Barwick* (1885), 53 L. T. 56.

Costs on the higher scale will sometimes be allowed in patent cases where scientific witnesses are necessarily called (*i*); but the rule is not invariable, and it must not be assumed that costs on the higher scale will usually be allowed in patent cases. Exceptional circumstances are requisite to entitle the successful party to costs on the higher scale (*k*).

In considering whether the costs of a cause shall be on the higher scale, the Court will have regard to the importance of the questions in issue in the action, and also to the manner in which the case has been prepared and conducted at the trial (*l*).

It seems that, although a case, as presented to the Court, may not be of a special "difficulty" within the meaning of this rule, leave may be given to the taxing master to tax all or any part of the costs on the higher scale, if it appears on such taxation that the difficulty was removed by the expenditure of time, money, and learned industry (*m*).

Where the action was one requiring special knowledge on the part of those concerned in it, costs on the higher scale were allowed (*n*).

In *Automatic Weighing Co.* v. *Combined Weighing Machine* (*o*), an appeal was dismissed with costs, and the defendants *subsequently* applied for costs on the higher scale. Held, that the application should be granted, but without costs, as it should have been made at the hearing of the appeal.

In cases involving long examinations, preparation of models, and the calling of expert evidence, costs on the higher scale have been allowed against unsuccessful litigants (*p*). The fact, however, that a defendant submits to an injunction is not a "special ground" within the meaning of Order LXV., rule 9 (*q*). The amount of money in question may have some

(*i*) *Ellington* v. *Clark* (1889), 58 L. T. 818.

(*k*) *Tweedale* v. *Howard* (1896), 13 R. P. C. 522; *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 516; *Farbenfabriken, &c., Co.* v. *Bowker* (1891), 8 R. P. C. 389. Costs on the higher scale were refused in *Westley-Richards* v. *Perkes* (1892), 9 R. P. C. 181; *Wenham Gas Co.* v. *Champion Gas Co.* (1891), 8 R. P. C. 313; *American Braided Wire Co.* v. *Thomson* (1890), 7 R. P. C. 152, and granted in *Automatic Weighing Machine Co.* v. *Hygienic Co.* (1889), 6 R. P. C. 475; *Otto* v. *Steel* (1886), 3 R. P. C. 120; *Edison* v. *Holland* (1888), 5 R. P. C. 459; *Blakey* v. *Latham* (1889), 6 R. P. C. 29; *Tweedale* v. *Ashworth* (1890), 7 R. P. C. 426; *Farbenfabriken Co.* v. *Bowker*, *supra*.

(*l*) *Davies* v. *Davies* (1887), 56 L. J. Ch. 481.

(*m*) *Fraser* v. *Brescia Tramways Co.* (1887), 56 L. T. 771.

(*n*) *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 241. See too *Farrar* v. *Farrar*, 59 L. T. 619.

(*o*) (1889) 6 R. P. C. 372.

(*p*) *Wenham* v. *May* (1888), 5 R. P. C. 310.

(*q*) *Peroni* v. *Hudson* (1884), 1 R. P. C. 261.

effect in determining whether costs on the higher scale shall be allowed (*r*).

In *Peroni* v. *Hudson* (*s*), where the defendant did not appear at the trial, costs on the higher scale were refused to the plaintiff.

In *Grafton* v. *Watson* (*t*) costs on appeal against an interlocutory injunction were allowed only on the lower scale, although an important question was raised.

In *Ellington* v. *Clark* (*u*). Here costs on the higher scale were allowed by the Court of Appeal, although refused by the Judge in the Court below. In *Crampton* v. *The Patents Investment Co.* (*v*) the Judge at the trial refused to allow the costs on the higher scale at that stage, but reserved the question until after taxation, and gave liberty to apply thereafter if the defendants could show that they had suffered any injustice by the costs being taxed on the lower scale.

(*c*) *Costs when Defendant offers to submit.*

Costs when the defendant submits to an injunction.

If the defendant offers to submit to an injunction or promises no longer to infringe, it will depend upon circumstances whether he will be ordered to pay the costs incurred subsequently to his submission. The real point for determination is whether the plaintiff must go on with his proceedings or whether he is already sufficiently protected by the surrender of his opponent. This is practically the same as whether the acts of the defendant have disentitled him to an injunction (*x*). The plaintiff is generally entitled to go on if there be any doubt, at any rate until he has obtained his injunction (*y*), but the Court will use its discretion on the facts of each case.

The following cases are illustrative:—

Cases.

Cooper v. *Whittingham* (*z*). Here defendants were sued for infringement under the Copyright Act, 1842, and an injunction was asked for to restrain a sale; defendants pleaded that when they received the copies they at once recognised the piracy, and determined not to sell. Jessel, M. R., made them pay the costs

(*r*) *Muirhead* v. *Commercial Cable Co.* (1895), 12 R. P. C. 39, 64.

(*s*) *Peroni* v. *Hudson* (1884), 1 R. P. C. 261.

(*t*) (1884) 51 L. T. N. S. 141.

(*u*) (1888) 5 R. P. C. 319.

(*v*) (1888) 5 R. P. C. 404.

(*x*) *Proctor* v. *Bailey* (1889), 42 Ch. Div. 390; 59 L. J. Ch. 12; 6 R. P. C. 538; *Upmann* v. *Elkan* (1871), 7 Ch. 130; 41 L. J. Ch. 246; *Millington* v. *Fox* (1838), 3 My. & Cr. 338.

(*y*) *Colbourne* v. *Sims* (1843), 12 L. J. Ch. 338; 2 Ha. 543; *Nunn* v. *D'Albuquerque* (1865), 34 Beav. 595; *Geary* v. *Norton* (1846), 1 De G. & Sm. 9; and see *Fradella* v. *Weller* (1831), 2 Russ. & My. 247.

(*z*) (1880) 15 Ch. Div. 501; 49 L. J. Ch. 752.

of the motion. He said: "As I understand the law as to costs it is this, that where the plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of costs—the Court has no discretion, and cannot take away the plaintiff's right to costs."

Upmann v. *Forester* (*a*). The defendant (a china merchant) purchased abroad, for his own private use, some cigars, which were consigned to him at the docks; they bore a spurious brand, purporting to be that of the plaintiffs. When plaintiffs issued their writ and served a notice of motion for an injunction, the defendant stated to them that he had no intention of selling the cigars, offered all relief asked for by the writ, and, when the motion came on, agreed to an undertaking in the terms of the writ. Chitty, J., decided that the defendant must pay the costs, but added: "The result of my decision, however, will not be, as the defendant has suggested, that every purchaser of a small parcel of spurious goods incurs a liability to pay the costs of an action in the Chancery Division for infringing a patent or trade-mark. I cannot pass over the fact that there is in the present case a large consignment of goods—5,000 cigars is rather a large order for personal consumption—and the plaintiffs were justified in suspecting that so large a consignment was intended for distribution."

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

(*a*) (1883) 24 Ch. Div. 231; 52 L. J. Ch. 946; and see *Grace* v. *Newman*, 19 Eq. 623; 44 L. J. Ch. 298.

(*b*) (1884) 27 Ch. Div. 260; 54 L. J. Ch. 56.

(*c*) (1883) 24 Ch. Div. 231; 49 L. J. Ch. 752.

issuing their writ without notice, and after that the only offer which the defendant could properly make was to submit to an injunction and to pay the costs."

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

In *Lyon* v. *Mayor, &c., of Newcastle-upon-Tyne* (*f*), plaintiff discovered that the Corporation of Newcastle were in possession of a machine made in infringement of his patent; the town clerk stated to the plaintiff that the Corporation did not dispute the patent, had never used the machine, and did not intend to use it, and undertook not to use it. The plaintiff's solicitors would not accept this nor any other undertaking, and moved for an injunction. On the undertaking being given to the Court, the motion was dismissed with costs (*g*).

(*f*) *Miscellaneous.*

Shorthand Notes.—The costs of the notes of the judgment are frequently allowed, but it is not the practice to allow notes of the evidence unless in unusual circumstances (*h*). The parties,

(*d*) (1892) L. R. 1 Ch. 630; 61 L. J. Ch. 242; 9 R. P. C. 218.

(*e*) *Supra.*

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

(*g*) A late case, much to the same effect, is *Jenkins* v. *Hope and others* (1896), 13 R. P. C. 57. See *Losh* v. *Hayne*, 1 W. P. C. 200; *Geary* v. *Norton* (1846), 1 De G. & Sm. 9; *United Telephone Co.* v. *London and Globe Telephone Co.* (1884), 1 R. P. C. 117; 26 Ch. Div. 766; 53 L. J. Ch. 1158; in all of which plaintiff obtained his costs; also *Nixey* v. *D'Albuquerque* (1865), 34 Beav. 595; *Fletcher* v. *Glasgow Gas Commissioners* (1887), 4 R. P. C. 386, in which the plaintiffs did not get their costs.

(*h*) *Morris* v. *Young* (1895), 12 R. P. C. 455; *Automatic Co.* v. *Knight* (1889), 6 R. P. C. 297; *American Braided Wire Co.* v. *Thomson* (1890), 7 R. P. C. 152; *Ungar* v. *Sugg* (1892), 9 R. P. C. 113.

however, may make what arrangement they think fit, and this course is frequently pursued (*i*).

Costs of Inquiry as to Damages.—Chitty, J., refuses to make any order as to these at the trial, but leaves the matter for subsequent consideration (*k*). This seems to be the usual practice.

Costs of three counsel are not usually allowed; see, *e.g.*, *Smith* v. *Buller* (*l*), *Leonhardt* v. *Kallé* (*m*). In the same case it was stated that ten guineas a day was a fee ordinarily allowed to an eminent expert for qualifying and giving evidence, but that each case must be determined by its own circumstances.

The costs of drawings of exhibits put in the margin of counsel's brief were disallowed in *Smith* v. *Buller* (*l*).

Costs as against Third Parties.—See *Edison* v. *Holland* (*n*).

Costs in the Court of Appeal.—See R. S. C. Order 58.

Sect. 12.—Stay of Execution.

Rules as to stay of execution.

Under the Rules of the Supreme Court, 1883, Order LVIII., rule 16. proceedings will not be stayed pending an appeal, except in so far as the Court appealed from, or any Judge thereof, or the Court of Appeal, may order. No general rules can be laid down as to the circumstances under which the Court will exercise its discretion, and each case will be judged on its own merits. The following points have, however, been decided, and it may be useful to note them.

As a general rule, an appeal is no reason to stay proceedings (*o*).

Where judgment is given for a defendant with costs, execution will generally not be stayed, if the defendant's solicitors give their personal undertaking to repay any costs received by them, if the judgment should ultimately be reversed (*p*).

An order for the delivery up of infringing machines has been suspended on the defendants undertaking that neither they nor any articles made by them should be removed out of or used in

(*i*) Yorkeer v. *Evans* (1890), 7 R. P. C. 169; *Bown* v. *Centaur Cycle Co.* (1891), 8 R. P. C. 109.

(*k*) *United Telephone Co.* v. *Fleming* (1886), 3 R. P. C. 282; *United Telephone Co.* v. *Patterson* (1889), 6 R. P. C. 140.

(*l*) (1874) 19 Eq. 473; 45 L. J. Ch. 880.

(*m*) (1895) 12 R. P. C. 306; and see as to experts *Batley* v. *Kynoch* (1875), 20 Eq. 632. 44 L. J. Ch. 565; as to three counsel, *Smith* v. *Buller*, *supra*.

(*n*) (1889) 41 Ch. Div. 28; 58 L. J. Ch. 524; 6 R. P. C. 243.

(*o*) *Edge* v. *Johnson* (1892), 9 R. P. C. at p. 142.

(*p*) *Easterbrook* v. *G. W. Railway Co.* (1885), 2 R. P. C. 212; *Merry* v. *Nickalls* (1873), 8 Ch. 205; *Morgan* v. *Elford* (1876), 4 Ch. D. 287; *Ticket Punch Co.* v. *Colley's Patents* (1895), 12 R. P. C. 10; *Deeley's Patent* (1895), *ibid.* 75.

this country pending an appeal (*q*). The order for destruction of infringing articles has been suspended pending an appeal (*r*).

Where a defendant moved for a stay of proceedings pending an appeal to the House of Lords, and it appeared that, as the defendant was no longer making the infringing machines, the sole object was to prevent persons from being deterred by the judgment from buying them, the motion was refused (*s*).

The operation of an injunction (*t*) and [or (*u*)] of an order for an account (*x*) has been suspended on the defendant undertaking to keep an account, and to appeal promptly, the plaintiff having liberty to apply if the appeal was not promptly prosecuted (*y*).

But it is unusual to stay either an injunction or an account (*z*). Sometimes injunctions have been suspended in regard to orders already taken in hand by the defendant (*a*).

Sect. 13.—Appeals.

The Court of Appeal may hear appeals from judgments, orders, decrees, or rules (*b*), but not from the granting or refusal of certificates (*c*) nor from any order simply as to costs (*d*). An appeal from any interlocutory judgment or order can be brought only if the Judge or the Court of Appeal gives leave (*e*). But where an application has been made to appoint a receiver or to grant an injunction, there is an appeal from the decision to the Court of Appeal without leave (*f*). If leave is required it must be made in the first instance to the Judge below (*g*).

The procedure relating to appeals is governed by R. S. C.

(*q*) *Washburn and Moen Manufacturing Co.* v. *Patterson* (1884), 1 R. P. C. 191.

(*r*) *Howes* v. *Webber* (1895), 12 R. P. C. 470.

(*s*) *Proctor* v. *Bennis* (1887), 4 R. P. C. 363; cp. *Adair* v. *Young* (1879), 11 Ch. D. 136; *Nordenfelt* v. *Gardner* (1884), 1 R. P. C. 63; *Otto* v. *Steel* (1886), 3 R. P. C. 109, 121.

(*t*) *Hocking* v. *Fraser* (1886), *ibid.* 7.

(*u*) *Woodward* v. *Sansum* (1886), *ibid.* 366. But in *Humpherson* v. *Syer* (1887), 4 R. P. C. 184, Kekewich, J., refused to suspend the injunction, pointing out that the orders in the previous cases might have been made without opposition.

(*x*) *Kaye* v. *Chubb* (1887), 4 R. P. C. 23.

(*y*) *S. C.*

(*z*) *Otto* v. *Steel* (1886), 3 R. P. C. 121; *Chadburn* v. *Mechan* (1895), 12 R. P. C. at p. 135; *Edison* v. *Woodhouse* (1886), 3 R. P. C. 178; *Saxby* v. *Easterbrook* (1872), L. R. 7 Ex. 207; 41 L. J. Ex. 113.

(*a*) *Lyon* v. *Goddard* (1893), 10 R. P. C. 135; *Duckett* v. *Whitehead* (1895), 12 R. P. C. 191. But see *Lyon* v. *Goddard* (1893), 10 R. P. C. 348.

(*b*) Judicature Act, 1873, sects. 19 and 100.

(*c*) *Haslam* v. *Hall* (1888), 20 Q. B. D. 491; 57 L. J. Ch. 352; 5 R. P. C. 144.

(*d*) Judicature Act, 1873, sect. 45.

(*e*) Judicature Act, 1894, sect. 1. See *Boake* v. *Stevenson* (1895), 12 R. P. C. at p. 231.

(*f*) *Ibid.*

(*g*) R. S. C. 1883, Order LVIII., rule 17.

1883, Order LVIII. See particularly Order LVIII., rule 4, and the remarks of Smith, L. J., on it in *Shoe Machinery Co.* v. *Cutlan* (*h*).

New trials.

Applications for new trials must be made direct to the Court of Appeal (*i*), and the procedure is prescribed by R. S. C. 1883, Order XXXIX. Where a case tried by a Judge without a jury comes before the Court of Appeal, the Court presumes that the decision of the Judge on the facts is right, and will not disturb it unless the appellant satisfactorily makes out that it is wrong; Kay, L. J.'s view, does not go so far as this (*k*).

There is an appeal from the Court of Appeal to the House of Lords. See Appellate Jurisdiction Act, 1876.

Appeals, how brought.

All appeals to the Court of Appeal are to be by way of rehearing, and are to be brought by notice of motion in a summary way.

It is not, under any circumstances, necessary for a respondent to give notice of motion for a cross appeal unless he proposes to contend, on the hearing of the appeal that the decision of the Court below should be varied, in which case he should give notice to any parties affected by such contention (*l*).

Bankrupt appellants.

A novel point as to the position of bankrupt appellants was raised and decided in *United Telephone Co.* v. *Bassano* (*m*). Judgment had been given restraining the defendants from the manufacture or sale of articles of a certain construction as being an infringement of the plaintiff's patent, and ordering delivery up of all instruments so constructed. The defendants appealed, but before the appeal was ready for hearing became bankrupt. It was held that the defendants, though bankrupt, had still such an interest in being relieved from the injunction as entitled them to proceed with the appeal on giving security for costs. An order was accordingly made dismissing the appeal, unless within a certain time the bankrupts gave security for costs, or the trustee in bankruptcy made himself a party to the proceedings.

The Court is invested with the widest powers of varying, in whole or in part, any judgment appealed against, and of making any order that the case may require (*n*).

(*h*) (1896) 1 Ch. 108; 65 L. J. Ch. 314.

(*i*) Judicature Act, 1890. For some grounds for a new trial see *King* v. *Oliver* (1884), 1 R. P. C. 32, 44.

(*k*) *Colonial Securities Trust Co.* v. *Massey* (1896), 1 Q. B. 38: 65 L. J. Q. B. 100: *Savage* v. *Adam* (1895), W. N. 109; *Penn* v. *Bibby* (1866), 2 Ch. 127; 36 L. J. Ch. 455.

(*l*) *Ibid.*, rule 6.

(*m*) (1886) 31 Ch. D. 630.

(*n*) *Ibid.*, rule 4.

Further evidence on appeal.

The Court of Appeal has full discretionary power to allow amendments and to receive further evidence upon questions of fact (*o*); but upon appeals from a judgment after trial or hearing of any cause or matter upon the merits such further evidence, save as to matters subsequent as aforesaid, shall be admitted on special grounds only, and not without special leave of the Court (*p*). The term "special grounds" was judicially considered in *Hinde* v. *Osborne* (*q*). "I cannot," said Lindley, L. J., in that case, "understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence simply because a man has failed at the trial, and he thinks he can get more evidence which, if he had got it before, would have enabled him to succeed on the trial. . . . There must be some ground shown to satisfy the Court that there is some evidence now forthcoming which with due diligence he could not have got, and it must, moreover, in accordance with the usual practice, be evidence—not merely swearing by affidavits, or anything of that kind, but something in the nature of the production of a lost document or something of that sort—which will not expose the parties to a mere flood of affidavits made up to meet the blots and the defects which have been disclosed upon the first trial."

Further evidence.

Illustrations.—(1) The defendant in an action for infringement went to trial on a defence of non-infringement simply; he had previously pleaded want of novelty in the patent, but withdrew the plea. The plaintiff obtained an injunction, and the defendant appealed. The defendant subsequently moved for leave to adduce fresh evidence on the hearing of the appeal as to some anticipation of the plaintiff's patent, which he alleged that he had discovered since the trial. The motion was refused on the ground that it did not appear that the defendant was unable to get sufficient information to support the plea of want of novelty which he had abandoned at the trial (*r*).

(2) W., a petitioner for revocation of letters patent, applied for leave to adduce further evidence of anticipation on the hearing of an appeal. It appeared that the plaintiff had been

(*o*) R. S. C. Order LVIII., rule 4; and see *Shoe Machinery Co.* v. *Cutlan* (1896), 1 Ch. 108; 65 L. J. Ch. 314; 13 R. P. C. 141, 345.

(*p*) *Ibid.* Cp. *Edison Co.* v. *Shippey* (1887), 4 R. P. C. 471; *Walker* v. *Hydrocarbon Syndicate, Ltd.* (1886), 3 R. P. C. 253.

(*q*) (1885) 2 R. P. C. 47.

(*r*) *Hinde* v. *Osborne* (1885), 2 R. P. C. 47.

examined *de bene esse* before the trial, and that the alleged anticipation had been put to him in cross-examination. The motion was therefore refused (*s*).

In *Nordenfelt* v. *Gardner* (*t*), Lindley, L. J., intimated that the Court of Appeal would allow a merely formal defect of title, such as the non-production of a link in a chain of assignments, to be cured under the general powers to amend and admit further evidence (*u*).

In *Blakey* v. *Latham* (*x*), an appellant moved for leave to adduce further evidence on the appeal, on the ground that two of the witnesses who had given evidence at the trial as to an alleged anticipation had subsequently made statements, some on oath and others not, which tended to show that their evidence in the Court below was untrue in material respects, and on the further ground that the plaintiff had since the trial discovered further evidence with regard to such alleged anticipation which he could not with due diligence have discovered before. The Court of Appeal gave liberty (*y*) to the plaintiff to subpœna such witnesses with reference to the alleged anticipation, as he should name to the respondent ten days before the appeal was first in the paper for hearing, with liberty to the respondent to subpœna such witnesses as he might desire, and give the names to the plaintiff within five days before the appeal, and the Court ordered the rest of the motion to stand over until the hearing of the appeal.

If the Court of Appeal is able to determine the matter on one point, it will not consider others for the purpose of certifying for costs (*z*).

(*s*) *Walker* v. *Hydro-carbon Syndicate* (1886), 3 R. P. C. 253.

(*t*) (1884) 1 R. P. C. at p. 73.

(*u*) R. S. C. 1883, Order LVIII., rule 4.

(*x*) (1889) 6 R. P. C. 186. A motion for sequestration and attachment for breach of an injunction contained in a consent judgment in an action for infringement of a patent is an interlocutory application within rule 4 of R. S. C. 1883, Order LVIII., and further evidence can be admitted on appeal: *Spencer* v. *Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 46.

(*y*) *Britain* v. *Hirsch* (1888), 5 R. P. C. 226. See also *Deutsche Näturaschinen Fabrik, &c.* v. *Pfaff* (1889), 6 R. P. C. 251.

(*z*) *Ante*, p. 456; *Longbottom* v. *Shaw* (1889), 6 R. P. C. 143.

CHAPTER XIV.

ACTION TO RESTRAIN THREATS.

PRIOR TO THE ACT OF 1883.

Origin of action to restrain threats.

AT least as early as the year 1869 (*a*) it had been recognised that damages might be recovered and an injunction granted against a person who issued threatening notices of legal proceedings in order to deter others from purchasing alleged infringements of his patent, and the existence of this remedy had never subsequently been questioned.

Judicial opinion, however, had been divided as to one of the *facta probanda* in such proceedings.

Want of *bonâ fides* material.

In *Wren* v. *Weild* (*a*) it was held by the Court of Queen's Bench that an action would not lie unless the plaintiff affirmatively proved that the defendant's claim was not a *bonâ fide* claim in support of a right which, with or without cause, he fancied he had, but a *mala fide* and malicious attempt to injure the plaintiff by asserting a claim of right against his own knowledge that it was without any foundation. Want of *bonâ fides* or the presence of *mala fides* was therefore a material fact to be alleged and proved. This view of the law had the subsequent assent, first of Jessel, M. R., and then of the Court of Appeal, in the case of *Halsey* v. *Brotherhood* (*b*). So far the Courts were unanimous.

Patentee, whether bound to follow up threats.

In the cases of *Rollins* v. *Hinks* (*c*) and *Ermann* v. *Lund* (*d*), however, Malins, V.-C., held that a patentee is not entitled to publish statements of his intention to institute legal proceedings if he has no *bonâ fide* intention to follow up his threats by taking

(*a*) *Wren* v. *Weild*, L. R. 4 Q. B. 730, 737; 38 L. J. Q. B. 327. The burden of proving falsity of the threats is on the plaintiff: *Burnett* v. *Tak* (1882), 45 L. T. N. S. 743; *Anderson* v. *Liebig's Meat Co.* (1881), 45 L. T. N. S. 757, 759.

(*b*) (1880-81) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233; Cp. *Sugg* v. *Bray*, an action brought before but tried under the Patents Acts, 1883-1885, 1 R. P. C. 45; 2 R. P. C. 224.

(*c*) (1872) L. R. 13 Eq. 355; 41 L. J. Ch. 358.

(*d*) (1874) L. R. 18 Eq. 330; 51 L. J. Ch. 170.

such proceedings, and that the Court will in such case restrain him from making such publication.

In *Halsey* v. *Brotherhood* (*e*), Jessel, M. R., rejected this statement of the law. "A man," said his Lordship, "merely giving notice that his rights are being infringed, believing that they are infringed, is not to be subjected 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."

Evidence necessary if injunction claimed.

In the same case it was held that if the plaintiff wanted an injunction he must make out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement by the plaintiff was untrue.

Summary of law prior to 1883.

Prior to the Act of 1883, it appears, therefore, that the law as to threatening notices may be stated thus. Two remedies—damages and an injunction—were available to any person injuriously affected by the threat of legal proceedings. To secure the former the plaintiff was required to prove that the statements complained of were injurious to him, untrue, and made *mala fide*. Failure on the part of a defendant to follow up his threats by raising an action for infringement did not *per se* make him liable to an action for damages. To entitle him to an injunction the plaintiff was required to prove not only that the representations complained of were untrue, but that the defendant intended continuing to make them.

Under Act of 1883.

Patents Act, 1883, sect. 32.

Sect. 32 of the Act of 1883 provides that "where any person claiming to be the patentee of an invention by circulars, advertisements, or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage, if any, as may have been sustained thereby, if the alleged manufacture, use, sale or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

(*e*) (1880-81) 15 Ch. Div. 514; affirmed 19 Ch. Div. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233. But false statements of facts may make the issuer liable: *Dicks* v. *Brooks* (1880), 15 Ch. Div. at p. 40; 49 L. J. Ch. 812.

Alterations introduced by Act of 1883.

This section has altered the earlier law in several respects, of which the chief are these: (a) The *bonâ fides* of the patentee threatening legal proceedings or liability is immaterial if (1) the acts of the plaintiff are not in fact an infringement of his patent right; and (2) he fails with due diligence to commence and prosecute an action for infringement (*f*). (b) The doctrine laid down in *Rollins* v. *Hinks* (*g*) and *Axmann* v. *Lund* (*h*), but dissented from in *Halsey* v. *Brotherhood* (*i*), that a person giving notice that his rights are being infringed, and threatening with legal proceedings, is liable to an action for damages if he does not follow up that notice by bringing an action for infringement, has now received legislative sanction.

I. *The Threat.*

The threat of legal proceedings.

(1) The threat of legal proceedings, which is the subject-matter of the action, must not be merely a warning about something which is going to be done, but must be a threat about an act done. It must be a threat of legal proceedings or liability in respect of an alleged manufacture, use, sale or purchase of the invention (*k*). Threats do not fall within this definition if they are mere general threats or warnings as to something which may be done in the future. "Everybody 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. . . . 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 has 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 . . . he would not escape if the true gist of what he has

(*f*) *Skinner* v. *Shew* (or *Perry*) (1893), 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1; *Herburger* v. *Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194.

(*g*) (1872) L. R. 13 Eq. 355; 41 L. J. Ch. 358.

(*h*) (1874) L. R. 18 Eq. 330; 51 L. J. Ch. 170.

(*i*) (1879) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

(*k*) *Challender* v. *Royle* (1887), 36 Ch. Div. at p. 441; 56 L. J. Ch. 995; 4 R. P. C. 363.

done is to apply that threat to a particular person and to a particular act" (*l*).

These remarks must, however, be read in the light of subsequent cases. In *Kurtz* v. *Spence* (*m*) Kekewich, J., said: "I understand the Lord Justice 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 understand the Lord Justice to say that if a patentee says, 'You have sold so many hundredweights or tons of the patented article, and I tell you I shall proceed against you if you sell any more,' that that is not a threat within the meaning of the section. I hardly know what would be the use of a threat if it were simply with reference to something which is past. Lord Justice Bowen does not seem to me to mean that it must refer only to something which is past. As I understand his language, it must not be only with reference to something in the future, but a threat expressed only in the way I have suggested would be held to be a threat within the meaning of the section as interpreted by the Lord Justice."

A threat regarding the future is within the section.

The point was considered by the Court of Appeal in *Johnson* v. *Edge* (*n*). Lindley, L. J., then said (*o*) that this section might apply to an intended infringement provided that it could be shown that the intended infringement, if carried out, would be in fact an infringement—*e.g.*, if a person issues notices of intention to make a thing which would be made in infringement of another's alleged patent, and if that latter threatens, he would bring himself within this section. Kay, L. J. (*p*), after stating that a general warning, not pointed against any particular person, would not be within the section, goes on to say: "I can conceive one case of future infringement which would come entirely within the mischief which this section was intended to provide against. Suppose a man issued a circular saying, 'I have a patent for such and such an article. I understand that Messrs. A. & Co. have recently erected a large manufactory for the purpose of manufacturing articles which, if made, will be an infringement of my patent.' Can it be said that a case like that

General warning not necessarily a threat.

(*l*) *Challender* v. *Royle* (1887), 4 R. P. C. at pp. 374, 375; 36 Ch. Div. at p. 441; 56 L. J. Ch. 995.

(*m*) (1889) 5 R. P. C. at p. 171; 57 L. J. Ch. 238.

(*n*) (1892) 2 Ch. 1; 9 R. P. C. 142; 61 L. J. Ch. 262.

(*o*) Page 9.

(*p*) At p. 12.

would not come within the mischief intended to be provided against by this section (*q*)? Could not Messrs. A. & Co. bring an action against the person who issued that circular for an injunction? I should wish at least to suspend my opinion on that subject until that point comes before the Court of Appeal to be tried."

Difficulties when the threat is aimed at an intended infringement.

The Lord Justice would probably have to hold that the "manufacture, use, sale, or purchase" spoken of in the section includes "*intended* manufacture, use, sale, or purchase." This is of itself an objection to his view. But there is a further difficulty. The section clearly shows that the threat must refer to something complained of which entitles the threatener to issue his writ for infringement. But, taking the above example, if A. & Co. bring their threats action, the threatener could hardly bring an action for infringement, and could therefore not get within the proviso. Neither could they justify their threats on the ground that A. & Co. had actually infringed. It would seem, therefore, *bonâ fide* being no defence (*r*), that the mere issue of the threat would entitle A. & Co. to succeed, even though A. & Co. did actually intend to infringe; and though they would obtain no damages, they might get an injunction. Could this be the intention of the section? To support the view to which Kay, L. J., inclines, not only would the words "or intended" have to be read into the section before the words "manufacture, use," &c., but the words "or intended infringement" would have to be added to the word "infringement," and the proviso would need to have read into it at the end the words "or an action to restrain intended infringement." These difficulties are serious, and any decision will be received with interest (*s*).

Ejusdem generis construction does not apply.

The section refers to threats made by circular, advertisement, or "otherwise." It is now absolutely settled that the *ejusdem generis* construction does not apply to the word "otherwise" (*t*). Threats are within this section, whether made at interviews (*u*), by private letter (*x*), by a solicitor's letter (*y*), and whether or not

(*q*) It might, and yet not come within the words of the section. The intention of the Legislature is not very clearly brought out.

(*r*) *Skinner* v. *Shew* (1893), 1 Ch. 413; 10 R. P. C. 1; 62 L. J. Ch. 196.

(*s*) The judgment of Day, J., in *Willoughby* v. *Taylor* (1894), 11 R. P. C. 45, throws little light on the point in question here.

(*t*) *Skinner* v. *Shew* (1893), 1 Ch. 413, 425; 10 R. P. C. 1; 62 L. J. Ch. 196.

(*u*) *Kurtz* v. *Spence* (1888), 5 R. P. C. at p. 172; 57 L. J. Ch. 238.

(*x*) *Kurtz* v. *Spence*, *supra*.

(*y*) *Driffield & Co.* v. *Waterloo & Co.*

made to plaintiff in the threats action or to another person (*z*) (provided always that the plaintiff is a party aggrieved—see below), or by advertisement or circular (*a*). Though the threats are in answer to an inquiry, the result is the same (*b*).

In *Kurtz* v. *Spence* (*c*), where (a) the threats were conveyed in the course of a correspondence conducted mainly "without prejudice," and with a view to the amicable adjustment of the legal rights of the parties; and (b) the plaintiffs had not yet erected plant and machinery for the manufacture of the articles alleged to infringe the defendants' patent, Kekewich, J., held the plaintiff entitled to an injunction with costs. Threats without prejudice.

Where a defendant complains not of the plaintiff's invention *simpliciter*, but that the plaintiff's invention is being so used by third parties as to infringe his patent, this is not a threat within the meaning of sect. 32 if the notice be so framed as to make it clear that the use by the third parties and not the invention itself is complained of (*d*).

A threat of legal proceedings contained in a letter which has never been qualified or withdrawn, is held to be continued (*e*).

A few examples of the threats on which decisions have been given may elucidate the matter.

(1) "It having come to our knowledge that certain of our patents are being infringed, notably . . . we hereby caution our numerous friends against purchasing these imitation goods. It cannot be too generally known that all parties who handle a patent article, from the maker to the user . . . are liable to the patentee. Our patent solicitor has instructions to take proceedings against all infringers." Bowen, L. J., doubted whether there was a threat upon which action could be founded (*Challender* v. *Royle*) (*f*).

(2) "Notice to grocers and others. Information of extensive violation of Mr. Edge's patent rights has been received. All

(1886), 31 Ch. Div. 638; 55 L. J. Ch. 391; 3 R. P. C. 46; *Combined Weighing, &c., Co.* v. *Automatic Weighing, &c., Co.* (1889), 42 Ch. Div. 665; 58 L. J. Ch. 769; 6 R. P. C. 502.

(*z*) *Douglass* v. *Pintsch's Patent Lighting Co., Ltd.* (1896), 13 R. P. C. 673; *Barrett* v. *Day* (1889), 43 Ch. Div. 435; 7 R. P. C. 51.

(*a*) See the words of the section; also *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. 142; 61 L. J. Ch. 262.

(*b*) *Skinner* v. *Shew* (1893), 1 Ch. 413; 10 R. P. C. 1; 62 L. J. Ch. 196.

(*c*) (1888) 5 R. P. C. 161.

(*d*) *Burt* v. *Morgan* (1887), 4 R. P. C. at p. 280.

(*e*) *Driffield, &c., Co.* v. *Waterloo, &c., Co.* (1886), 31 Ch. Div. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*f*) (1887) 36 Ch. Div. 425; 56 L. J. Ch. 995; 4 R. P. C. 363.

parties are warned not to infringe these rights. R. and R. C. Winder, Solicitors, &c." Held (on the facts), to be a threat within the section (*Johnson* v. *Edge*) (*g*).

(3) "We beg to confirm our opinion previously expressed that the camera in question is an infringement of our patent. . . . We have taken further advice in the matter, and are prepared to stop the sale of this camera if placed on the market." Held a threat (*Skinner* v. *Shew*) (*h*).

(4) "We understand that your house is being supplied with electric light by the . . . Co., which company, as you are doubtless aware, is being sued for damages for infringement of our patent system of electric distribution. We have been advised that you, as one of the users of this said system of distribution, are liable for infringement. We beg, therefore, to caution you of this fact, and to offer you an indemnity upon the terms contained in the enclosed circular." Held to be a threat (*Kensington, &c., Electric Lighting Co.* v. *Lane-Fox Electrical Co.*) (*i*).

(5) "I am afraid this matter will lead to a great deal of difficulty and unpleasantness, and you must not be surprised if my Company applies for an injunction against Mr. D. to restrain," &c. (*Douglass* v. *Pintsch's Patent Lighting Co.*) (*j*).

II. *The Action.*

The Parties.—The plaintiff may be any "person aggrieved," *i.e.*, the person threatened or any person injuriously affected by the threats. In *Johnson* v. *Edge* (*k*), the plaintiff was a manufacturer of similar goods to the defendant's, into the hands of whose customers defendant's circular had come. See also *Kensington, &c., Co.* v. *Lane-Fox Electric Light Co.* (*l*), *Colley* v. *Hart* (*m*), *Skinner* v. *Shew* (*n*).

The Pleadings.—If it is intended to rely upon the common law, *mala fides* must be alleged in the statement of claim. Forms of claim and defence thereto will be found in the Appendix, *post*, pp. 847, 848. Speaking generally, the plaintiff should allege: (a) the threats; (b) that the defendant's patent is invalid; (c) that plaintiff has not infringed.

(*g*) (1892) 2 Ch. 1; 61 L. J. Ch. 262; 9 R. P. C. 142.
(*h*) (1893) 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.
(*i*) (1891) 2 Ch. 573; 8 R. P. C. 277.
(*j*) (1896) 13 R. P. C. 673.
(*k*) See the threat set out *supra*.
(*l*) (1891) 2 Ch. 573; 8 R. P. C. 277.
(*m*) (1890) 44 Ch. Div. 179, 186; 7 R. P. C. 101.
(*n*) (1893) 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.

Invalidity of the patent may be raised.

It was at one time doubted whether want of validity of the defendant's patent could be raised in a threat action, but it may now be taken to be decided that this is permissible (*o*).

Defence.

The defendant may set up: (a) he did not threaten; (b) he commenced and prosecuted an action for infringement with due diligence, and so brings his case within the proviso (see below); (c) the plaintiff in fact infringed his patent.

Procedure when an infringement action is pending.

Should the defendant have started his infringement action, and in the threats action plead both (b) and (c), it seems probable that two actions will be proceeding at the same time in which the same point is being tried. To avoid the unnecessary expense such a course would entail, the defendant should either counterclaim, or arrangements should be made for one of the actions to stand over until the decision in the other has been given (*p*). It may be convenient to try the existence or non-existence of a threat before proceeding with the more complicated points in the action (*q*).

Particulars.—If the plaintiff alleges want of validity of defendant's patent, he must give such particulars of objection as would be given in an infringement action; but the plaintiff is entitled first to know the patents on which the threats were based. Should there be but one patent, and this well known to plaintiff, he should give particulars of objection forthwith; in other cases he may await the production of the list of patents on which defendant relies (*r*). Particulars of objection may be required before delivery of defence (*s*). Other particulars to which a defendant is entitled are: particulars of the threats complained of (*s*), but not of the names of customers whom plaintiff had agreed to indemnify in consequence of the threats, unless perhaps where the amount of damage is to be assessed at the trial (*t*). He is also entitled to particulars of the agents through whom it is alleged the threats were made (*u*).

(*o*) Dicta of the L. JJ. in *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 443; 56 L. J. Ch. 995; 4 R. P. C. 363; *Kurtz* v. *Spence* (1887), 36 Ch. Div. 770; 4 R. P. C. 427; practically overruling *Kurtz* v. *Spence* (1886), 33 Ch. Div. 579; 55 L. J. Ch. 919. See also *Herrburger* v. *Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194.

(*p*) *Combined Weighing, &c., Co.* v. *Automatic Weighing, &c., Co.* (1889), 42 Ch. Div. 665, 674; 58 L. J. Ch. 709; 6 R. P. C. 502.

(*q*) *Kurtz* v. *Spence* (1888), 57 L. J. Ch. 238; 5 R. P. C. 161, 169.

(*r*) *Union Electrical Power, &c., Co.* v. *Electrical Power Storage Co.* (1888), 38 Ch. Div. 325; 5 R. P. C. 329; *Law* v. *Ashworth* (*supra*), at p. 89.

(*s*) *Law* v. *Ashworth* (1890), 7 R. P. C. 86.

(*t*) *Law* v. *Ashworth* (*supra*), at p. 88.

(*u*) *Dowson Taylor* v. *Drosophore Co.* (1894), 11 R. P. C. 536; 12 R. P. C. 95.

The defendant must give particulars of infringement (*x*), if infringement be relied upon.

Quære, whether sect. 29 of the Act of 1883 applied.

Sect. 29 of the Patents, &c., Act, 1883, regulates particulars in actions for infringement, but does not deal with threats actions (*y*). In *Willoughby* v. *Taylor* (*z*), Day, J., gave a certificate that the particulars of objection were reasonable and proper, but *semble*, the application was unnecessary, the matter being one for taxation. If the certificate was required at all, it could only have been because sect. 29 was considered to apply, and in such case the learned Judge could not have given the certificate unless the particulars were proved to him to have been reasonable (*z*).

The Trial.—The case may be tried before a jury, as sect. 29 does not refer to a threats action; but leave must be obtained as provided by R. S. C. Order XXXVI. rules 2 *et seq.* The plaintiff, the burden of proof being to a certain extent on him (*a*), would have the right to begin, save where the only issues are infringement or on the proviso. In *Kurtz* v. *Spence* (*b*), the Court of Appeal, as a condition of allowing an amendment setting up invalidity of the defendant's patent, gave defendant the right to begin and reply.

Defendant must support patent as in action for infringement if patent is attacked.

In an action for damages under this section, the question who is the true and first inventor is an issue of fact, which is not concluded by the defendant merely producing the original letters patent duly sealed. If the patent is attacked he is bound to support it as if he were plaintiff in an action for infringement (*c*).

Certificate that validity of patent was in question should not be given.

Certificate that Validity of the Patent came in Question.—Field, J., in one case gave a certificate to this effect for what it was worth, but it is submitted that its worth was very little. Sect. 31, which deals with such certificates, refers only to actions for infringement. In *Herrburger* v. *Squire* (*d*), Charles, J., was about to make a declaration that defendant's patent was invalid, but he stopped short of so doing. It is submitted that he had no power to make such a declaration.

(*x*) *Wren* v. *Weild* (1869), L. R. 4 Q. B. 213; *Willoughby* v. *Taylor* (1894), 38 L. J. Q. B. 327; 11 R. P. C. 45. The latter case is peculiar because the defendant did not at the trial nor even by his pleadings allege that there had been infringement; *Quære*, whether particulars should in such case have been ordered.

(*y*) See per Chitty, J., in *Kurtz* v. *Spence* (1886), 33 Ch. Div. at pp. 383—4.

(*z*) (1894) 11 R. P. C. 45.

(*a*) *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 435; 4 R. P. C. 363; 56 L. J. Ch. 995.

(*b*) (1887) 36 Ch. Div. 770; 4 R. P. C. 427.

(*c*) *Kurtz* v. *Spence* (1888), 5 R. P. C. at p. 177; 57 L. J. Ch. 238.

(*d*) (1888) 5 R. P. C. 581.

Remedies.

The remedies to which a threatened person is entitled are: (1) an injunction, interim or perpetual; and (2) damages. These remedies are concurrent.

Injunction.—In considering a motion (which should not be made *ex parte* (*e*), for an interlocutory injunction under sect. 32, the Court looks not so much to the balance of convenience and inconvenience, but requires the applicant to make out at least a *primâ facie* case (*f*) that the act complained of is not an infringement. And where the defendant expressed his intention of not threatening pending the action, and undertook to proceed diligently with his action for infringement, the Court refused an injunction, but gave plaintiff liberty to apply, if necessary (*g*).

Injunction.

Balance of convenience looked to.

In a class of case not dissimilar to a threats action it is usual to grant the interlocutory injunction without insisting on the ordinary undertaking as to damages (*h*).

If the threats are of old standing, and the plaintiff has not bestirred himself, though acquainted with the threats, the Court will hardly grant an injunction (*i*).

Damages.—Damages will be awarded only where substantial injury has been sustained.

Damages when awarded.

Thus in *Driffield, &c., Co.* v. *Waterloo, &c., Co.* (*k*), where the plaintiffs had merely been compelled by the threats complained of to look over their machinery, and to suspend certain building operations, Bacon, V.-C., held that the granting of damages was out of the question.

In *Kurtz* v. *Spence* (*l*), where (a) the threats were conveyed in the course of a correspondence conducted mainly "without prejudice," and with a view to the amicable adjustment of the legal rights of the parties, and (b) the plaintiffs had not yet

Damages where the threats were made without prejudice.

(*e*) *Wilson* v. *Church, &c., Engineering Co.* (1885), 2 R. P. C. 175.

(*f*) *Challender* v. *Royle* (1887), 36 Ch. Div. 435; 4 R. P. C. 363; *Colley* v. *Hart* (1889), 6 R. P. C. 17; cp. *Société Anonyme des Manufactures des Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 1; 55 L. J. Ch. 1; *Barney* v. *United Telephone Co.* (1885), 28 Ch. D. 394; 2 R. P. C. 173; where evidence of no infringement was held to be a condition precedent to the grant of an interlocutory injunction; *Walker* v. *Clarke* (1888), 4 R. P. C. 111; 56 L. J. Ch. 239; where this extreme view was dissented from.

(*g*) *Mackie* v. *Soho Laundry Co.* (1892), 9 R. P. C. 465.

(*h*) *Fenner* v. *Wilson* (1893), 2 Ch. 656; 62 L. J. Ch. 984; 10 R. P. C. 283.

(*i*) *Edlin* v. *Pneumatic Tyre Co.* (1893), 10 R. P. C. 311; *Colley* v. *Hart* (1889), 6 R. P. C. 20, 21.

(*k*) (1886) 31 Ch. Div. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*l*) (1887) 5 R. P. C. 177; 57 L. J. Ch. 238.

erected plant and machinery for the manufacture of the articles alleged to infringe the defendants' patent, Kekewich, J., refused to direct a reference as to damages, and awarded the plaintiffs 40*s*., with costs on the higher scale.

Damages usually assessed after judgment.

On the other hand, substantial damages may often be recovered. In *Ungar* v. *Sugg* (*m*) the Court of Appeal, being of opinion that a rough guess could be made at the amount of loss, thought that the Judge should have assessed the damages at the trial. But this is not the course usually followed. Thus in *Johnson* v. *Edge* (*n*), Matthew, J., referred the damages to an official referee.

A plaintiff may recover damages if, owing to the threat, a contract is lost (*o*).

III. *The Proviso.*

Although the defendant has threatened, and although the plaintiff has not infringed, nevertheless the defendant may be entitled to judgment, with the attendant costs, if he bring himself within the proviso. This runs as follows: "Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent." Thus it may happen that a plaintiff who at the time of issue of the writ has a good cause of action, may at the time of the trial cease to have a cause of action at all. See *Combined Weighing, &c., Co.* v. *Automatic Weighing Co.* (*p*); *Colley* v. *Hart* (*q*).

A discontinued or abortive action may bring the threatener within the proviso.

It is not necessary that in order to protect the defendant the action for infringement should have been carried to a successful result. In the former of the cases just mentioned, the threatener failed in his action for infringement; in the latter, he discontinued it as hopeless. Nevertheless, in both, the threatener's position came within the terms of the proviso, and consequently won his threats action.

An action for infringement, to come within the proviso, must be to restrain an infringement similar to that which is threatened; and the proviso is not satisfied by an action to restrain a different infringement (*r*).

(*m*) (1889) 9 R. P. C. 113.

(*n*) (1892) 2 Ch. 1; 61 L. J. Ch. 262; 9 R. P. C. 142.

(*o*) *Skinner* v. *Shew* (or *Perry*) (1894), 2 Ch. 581; 11 R. P. C. 406; 64 L. J. Ch. 826.

(*p*) (1889) 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502.

(*q*) (1890) 44 Ch. Div. 179; 59 L. J. Ch. 308; 7 R. P. C. 101.

(*qq*) On threats subsequent to a discontinuance, see *Fusee Vesta Co.* v. *Bryant and May* (1887), 56 L. T. N. S. 136.

(*r*) *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502, 507.

To enable the defendant to avail himself of the proviso, the parties to the infringement action must be the threatener himself (not his assignee) as plaintiff (*s*), and as defendant either the plaintiff in the threats action, or some third person against whom the threats complained of were directed; probably no other defendant will suffice to bring the case within the proviso (*t*).

But the infringement action may be within the proviso, whether brought before or after the threats action (*u*), provided it be commenced and prosecuted with due diligence. In determining the question of diligence the date of the utterance of the threats will be considered (*x*).

Action for infringement not brought with *bonâ fides* will not protect.

It is only a *bonâ fide* action for infringement which can have the effect of bringing the threatener within the proviso (*y*); a collusive action, or an action brought after the threats action merely for the purpose of evading the latter, will not avail (*z*). But discontinuance of the infringement action is not *per se* evidence of *malâ fides* (*a*).

The *bonâ fides* of the infringement action is thus a question which may be raised. The *bonâ fides* on the part of the threatener is no answer to a threats action brought under this section (*b*).

Due diligence a question of fact.

An infringement action is not an answer to an action for threats, unless the former be commenced and prosecuted "with due diligence." Whether in any given case due diligence has been shown is a question of fact (*c*).

The abandonment of the action is not necessarily proof of want of due diligence; see *English and American Machine Co.* v. *Gare* (*d*), *Colley* v. *Hart* (*e*).

Examples.

The following examples will show what has been considered due diligence, though it has to be borne in mind that the facts of every particular case have to be separately considered:—

(*s*) *Kensington, &c., Electric Light Co.* v. *Lane-Fox Electric Light Co.* (1891), 2 Ch. 573; 8 R. P. C. 277.

(*t*) *Challender* v. *Royle* (1887), 36 Ch. Div. 425, 439, 442; 4 R. P. C. 363; 56 L. J. Ch. 995; *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.*, *ubi infra*.

(*u*) *Barrett* v. *Day* (1889), 43 Ch. Div. 435; 7 R. P. C. 54.

(*x*) *Challender* v. *Royle*, *supra*.

(*y*) *Challender* v. *Royle* (1887), *supra*; *Barrett* v. *Day* (1893), *supra*.

(*z*) *Johnson* v. *Edge* (1892), 2 Ch. 1; 9 R. P. C. p. 142; 61 L. J. Ch. 262.

(*a*) *English and American Machine Co.* v. *Gare Machinery Co.* (1894), 11 R. P. C. 627.

(*b*) *Skinner* v. *Shew* (1893), 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1; *Herrburger* v. *Squire* (1888), 5 R. P. C. 581; 6 R. P. C. 194; *Johnson* v. *Edge* (1892), *supra*.

(*c*) *Combined Weighing, &c., Co.* v. *Automatic, &c., Co.* (1889), 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502; *Colley* v. *Hart* (1890), 44 Ch. Div. 179; 59 L. J. Ch. 308; 7 R. P. C. 101.

(*d*) (1894) 11 R. P. C. 627.

(*e*) *Ubi supra*.

Challender v. *Royle*(*f*).—March, 1887, threats uttered; June 11, writ at threats action; June 15, action for selling goods made by the plaintiff within threats action in alleged infringement of the threatener. The Court of Appeal held that the threatener had proceeded with due diligence, and had brought himself within the proviso.

Herburger v. *Squire* (*g*).—October, 1886, threats, the threatener being at the time aware of infringements; September, 1887, threats repeated; November 12, 1887, threats action; November 14, infringement action against third partner; December 23, counterclaim in threats action. Charles, J., considered that the defendant had not shown due diligence.

Combined Weighing and Advertising, &c., Co. v. *Automatic, &c., Co.*(*h*).—September 21, threats; September 27, threats action; September 30, action for infringement. The Court of Appeal considered the latter to have been brought with due diligence.

Colley v. *Hart* (*i*).—September, 1888, threats; September 22, 1888, threats action; December 6, 1888, infringement action; February 8, 1889, statement of claim in the threats action; May 13, statement of claim in the infringement action. The parties in both actions had asked for and had been granted extension of time for pleading. November 6, 1889, an expert reported that the threatener's patent was bad; November 7, 1889, the threatener discontinued his infringement action. Held (by North, J.), that the infringement action had been prosecuted with due diligence and that the proviso applied. A threatener is entitled to keep back his statement of claim in the infringement action, as by so doing he may be able to raise the point by counterclaim in the threats action.

Edlin v. *Pneumatic Tyre Co.* (*k*).—In this case the threats were uttered three years before the infringement action, but under the peculiar circumstances of the case, Chitty, J., said that he could not decide that the defendants had not shown due diligence in bringing their infringement action, and he refused an interlocutory injunction in the threats action.

English and American Machine Co. v. *Gare Machinery Co.* (*l*).—November 9 and November 18, 1893, threats; November 23,

(*f*) (1887) 36 Ch. Div. 425; 4 R. P. C. 363; 56 L. J. Ch. 995.
(*g*) (1888) 5 R. P. C. 581; 6 R. P. C. 194.
(*h*) (1889) 42 Ch. Div. 665; 58 L. J. Ch. 709; 6 R. P. C. 502.
(*i*) (1890) 44 Ch. Div. 179; 59 L. J. Ch. 308; 7 R. P. C. 101.
(*k*) (1893) 10 R. P. C. 311.
(*l*) 11 R. P. C. 627.

threats action; December 4, infringement action; January 24, 1894, statement of claim in the infringement action; March 22, defence in the infringement action; both parties required extension of time, the particulars of objection requiring careful examination. It was decided by Chitty, J., that due diligence had been shown in prosecuting the infringement action, and that the proviso applied.

Forms of pleadings, &c., see *post*, pp. 847 *et seq.*

CHAPTER XV.

REVOCATION OF PATENTS.

Scire facias before Act of 1883.

BEFORE the Act of 1883 the mode of revoking and cancelling patents for inventions was by an action of *scire facias*, in which a person complaining of the illegality of a patent was authorised by the fiat of the Attorney-General to proceed in the name of the Crown to obtain the judgment of the Court of Chancery for its repeal (*a*).

The procedure for the repeal of letters patent for inventions was formerly the same as that for the repeal of other royal grants. And *scire facias* still lies to repeal such of these other grants as may be contrary to law, or have been obtained by false suggestion.

Remedy for the public by *scire facias*.

The various objections which can be taken to a patent for an invention, by a person against whom the patentee may institute legal proceedings, have already been considered (*b*); and the law provided a remedy for the public by action of *scire facias*, in which similar objections might be taken, and if any valid objection was sustained, the result was that the patent was repealed or annulled, and ordered to be cancelled.

Queen may proceed by *scire facias* to cancel a patent.

R. v. *Butler*.

Magdalen College case.

Legat's case.

The Queen has by the common law an undoubted right to proceed by *scire facias* to repeal and cancel a patent respecting which she has been deceived, or by which her subjects are prejudiced. This was laid down by the Judges in the House of Lords in the case of *R.* v. *Butler* (*c*), and there are several old authorities to the same effect (*d*). In the *Magdalen College case* (*e*), it was said, that "The law has given the King a great prerogative above any of his subjects, that where by fraud or false suggestion he is deceived, that he himself in such cases shall avoid his own grant *jure regio*." And in *Legat's case* (*f*), it was said, that "When upon false insinuations or pretences the King makes any

(*a*) See a full account of the practice in proceedings by *scire facias* in Hindmarch, pp. 376 *et seq*. The cumbrous nature of the procedure is there demonstrated.

(*b*) *Ante*, pp. 387 *et seq*.

(*c*) 3 Lev. 220, 221.

(*d*) See Staund. Prerog. 84, a; Brook. Abr. Pat. 14, Petit. 11, and Sci. Fa.; Rol. Abr. Prerog. (S.) p. 191; 21 Ed. III. 47 B. & 10 Co. 113, b.

(*e*) 11 Co. R. 74, b.

(*f*) 10 Co. R. 109.

grant, as of any monopoly, &c., which, in truth, is to the prejudice of the King and commonwealth, the King *jure regio* shall avoid such grants, *and such letters patent by judgment of law shall be cancelled*"(*g*).

Former grounds for *scire facias*.

The grounds on which an action of *scire facias* might formerly be instituted were "fraud, false suggestion, non-compliance on the part of the patentee with the conditions 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"(*h*).

Fraud and false suggestion.

Fraud and false suggestion may be considered together (*i*).

Cases.

Letters patent were granted for "certain improvements in steam engines and in machinery for propelling vessels." One of the inventions as described in the specification was not an improvement. The grant was held bad for falsity of suggestion (*k*).

Letters patent were taken out for a watch. The invention as disclosed by the specification was only of part of a watch. The patent was repealed (*l*).

The patentee of an improved machine claimed as his invention a part of it which turned out to be useless. The specification did not describe it as essential to the machine. It was held that the patent was not vitiated (*m*).

The distinction between the first two and the last of the cases just cited is clear. In each of the former there was a false statement, recited in the patent by way of suggestion, and forming a material part of the consideration for the grant. In the latter the false recital was not made by way of suggestion at all (*n*). Even if such a false recital did affect in some degree the suggestion made by the patentee to the Crown, the patent will not necessarily be held void.

Non-compliance with conditions of patent.

A specification described various parts of machinery, but no complete machine, and the defendant did not point out what parts were new. The patent was repealed (*o*).

(*g*) This and the third previous paragraph are adapted from Hindmarch, pp. 377–79.

(*h*) Webs. Lett. Pat. p. 32.

(*i*) See *R.* v. *Mussary* (1738), 1 Web. P. C. 41, n. 2.

(*k*) *Morgan* v. *Seaward* (1835–37), 2 M. & W. at p. 561.

(*l*) Before 1795; 1 Web. P. C. 42, n.; cp. *R.* v. *Wheeler* (1819), 2 B. & Ald. 349; *Hill* v. *Thompson* (1818), 1 Web. P. C. 239; *Brunton* v. *Hawkes* (1821), 4 B. & Ald. 551, 552, 558; *Felton* v. *Greaves* (1829), 3 C. & P. 611.

(*m*) *Lewis* v. *Marling* (1829), 1 Web. P. C. 496; cp. *Morgan* v. *Seaward* (1837), 1 Web. P. C. 197, per Alderson, B.

(*n*) See 1 Web. P. C. 42, n.; cp. *Morgan* v. *Seaward* (1837), 1 Web. P. C. 197, per Alderson, B.; cp. *Travell* v. *Carteret*, 3 Lev. 134; *Alcock* v. *Cooke* (1829), 5 Bing. 340, cited by Parke, B., in *Morgan* v. *Seaward*, *ubi supra*, at p. 196.

(*o*) *R.* v. *Arkwright* (1785), 1 Web. P. C. 64, and other authorities there cited; *R.* v. *Cutler* (1816), 1 Web. P. C. 76; and Specification, *supra*, p. 83.

Want of novelty and utility.

A patent was granted for "improvements in fire-grates or stoves." The specification, after describing the stove, claimed as the invention the construction of stoves in such manner as that the fuel necessary to supply the fire shall be introduced from beneath, either in a perpendicular or in an oblique direction. Ellenborough, C. J., was of opinion that the evidence showed grates to have been constructed prior to the patent on a principle identical with that described in the specification; that the patentee by his claim had confined himself to that principle, and that therefore the patent could not be supported (*p*).

The *defects* in the proceeding by *scire facias* were in many ways objectionable. (1) It was cumbrous. (2) It was costly (*q*). (3) No interest in the repeal was necessary. (4) Although particulars of objection were required, and although it was provided —15 & 16 Vict. c. 83, s. 41—that no evidence should be admitted on any subject not mentioned therein, the particulars supplied were usually so vague as to give no information at all, and the patentee came into Court without any accurate knowledge of the case he had to meet.

Revocation under Act of 1883.

Proceedings under the Act of 1883.

The proceedings by *scire facias* is now in form abolished, and revocation of a patent may be obtained by petition to the Court.

Every ground on which a patent might, before the Act of 1883. be repealed by *scire facias* is now a ground of revocation, and also available by way of defence to an action of infringement (*r*).

Letters patent for inventions assigned to the Secretary of State for War are not revocable (*s*).

The Court.

The "Court" means the High Court of Justice in England (*t*), the Court of Session in Scotland (*u*), and the High Court of Justice in Ireland (*x*).

Lancaster Palatine Court.

Petitions for revocation could not formerly be presented in the Court of the County Palatine of Lancaster, which is not a Court within the meaning of the Patents Act, 1883, except for the

(*p*) *R.* v. *Cutler*, *ubi supra*.

(*q*) The patentee, if successful in an action of *scire facias*, obtained only such costs as were covered by the petitioner's bond; the petitioner, who succeeded in setting aside a patent, got no costs at all, on account of the general rule of law which then prevailed, that the Queen received no costs in any action to which she was a party.

(*r*) Act of 1883, sect. 26, sub-sects. 1, 2, 3.

(*s*) sect. 44, sub-sect. 9.

(*t*) *Ibid.* sect. 117.

(*u*) *Ibid.* sect. 109.

(*x*) *Ibid.* sect. 111, sub-sect. 1.

purpose expressly set forth in sect. 112 (a) (*y*). But see now the Lancaster Palatine Court Act, 53 & 54 Vict. c. 23, 1890.

Jurisdiction to repeal patent in England where patentee domiciled abroad.

A petition cannot be served on a patentee resident abroad (*z*), but where a petition was presented for the revocation of a patent belonging to a domiciled Scotchman to whom a copy of the petition was personally delivered, and who stated he did not intend to appear, the Court, on the application of the petitioner, made an order that the petition should go into the witness list, unless the patentee showed cause to the contrary, it being left open to the patentee, if he appeared, to dispute the jurisdiction (*a*). This course was suggested by North, J., in *Goerz case* (*z*). In *Kay's Patent* (*b*) one of the patentees had not been served, he being abroad. Stirling, J., refused to hear the petition, put it in the witness list, but directed that it should not come on for hearing without leave of the Judge, unless the absent patentee should appear. In a trade-mark case, *Re King & Co.'s Trade Mark* (*c*), the Court heard an application to rectify the register, on proof that a domiciled Irishman had received written notice of the proceedings.

Nature of petition for revocation.

A petition for revocation is in the nature of an "action," or at any rate is a "matter," and therefore (*d*) it can be sent for trial at assizes before a Judge without a jury; but such an order will not prevent the Judge at the trial from acting on his own view of his jurisdiction (*e*).

The fact that the patentee has declared his willingness to abandon his patent and does not defend revocation proceedings, is no ground for refusing to give the petitioner the costs of the proceedings (*f*).

Who may petition.

A petition for revocation may be presented by any of the following persons (*g*):—

(*y*) *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. at p. 185.

(*z*) *Re Goerz and Hoegh's Patent* (1895), 12 R. P. C. 370.

(*a*) *Drummond's Patent* (1889), 6 R. P. C. 576; L. R. 43 Ch. D. 80; 59 L. J. Ch. 102.

(*b*) (1894) 11 R. P. C. 279.

(*c*) (1892) 2 Ch. 462; 62 L. J. Ch. 153; 9 R. P. C. 350, and see *La Compagnie D'Eaux Minerales et des Bains de Mer* (1891) 3 Ch. 451; 8 R. P. C. 446; *Re Cliff* (1895) 2 Ch. 21.

(*d*) Either under R. S. C. 1883, Order XXXVI. rule 1; or Order XXX. rule 1.

(*e*) *In re Edmonds' Patent*, W. N. 1888, p. 234; (1889) 6 R. P. C. 355.

(*f*) *Re Wallace's Patent* (1895), 12 R. P. C. 444. See also *Simmons' Patent* (1895), 12 R. P. C. 446; *Rendell's Patent* (1894), 11 R. P. C. 277.

(*g*) Patents Act, 1883, sect. 26, sub-sect. 4. Proceedings in Scotland for revocation of a patent takes the form of an action of reduction at the instance of the Lord Advocate; or of a party having interest with his concurrence, which concurrence may be given on just cause shown only. (1883) Sect. 109, sub-sect. 1. It appears, therefore, that a petitioner before the Court of Session for revocation of letters

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

(b) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland (*gg*).

(c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.

(d) Any person alleging that he, or any person 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.

Notwithstanding that the petitioner for revocation has been sued for infringement and unsuccessfully attacked the validity of the patent, he may proceed with the petition. Also if the defendant successfully attacked the validity, the plaintiff may set up validity in subsequent proceedings for revocation started by the defendant. In other words, the matter is not made *res judicata* by the decision in the infringement action; the parties may be the same, but they do not appear in the same capacity; in revocation proceedings the petitioner acts, in form at least, for the public (*h*).

Fiat of Attorney-General, how obtained.

When it is desired to obtain the fiat of the Attorney-General, the following papers must be sent to the Patent Clerk, at Room No. 549, Royal Courts of Justice, London: a memorial to the Attorney-General asking for his authority, and stating all the circumstances; a statutory declaration verifying the statements in the memorial; two copies of the proposed petition and of the particulars proposed to be delivered with it; the certificate of a barrister that the petition is proper to be authorised by the Attorney-General; the certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is able to pay the costs of all proceedings in connection with the petition, if unsuccessful.

patent, is required to have both an interest in the patent which he seeks to repeal and the concurrence of the Lord Advocate.

(*gg*) A paragraph in the petition should recite the authorisation: *Glazbrook* v. *Gillatt* (1840), 9 Bear. 492.

(*h*) *Re Deeley's Patent* (1895), 1 Ch. 687; 64 L. J. Ch. 480; 12 R. P. C. 192; *Shoe Machinery Co.* v. *Cutlan* (1896), 1 Ch. at p. 113; 65 L. J. Ch. 44; 12 R. P. C. at p. 533.

Fiat not issued as of course.

The fiat of the Attorney-General has never been, and is not now, issued as a matter of course.

Although it was laid down in *Butler's case* (*i*) that "where a patent is granted to the prejudice of a subject the King, of right, is to permit him upon his petition to use his name for the repeal of it," it is also stated that "the subject had not a right *mero motu* to have a *scire facias*" (*j*), and there seems to have been no doubt that if the Attorney-General were to have accepted insufficient security, or if after his fiat had been granted the bail or security had failed, the Court would have ordered a stay of proceedings until further security had been given (*k*). In *Reg.* v. *Neuall* (*l*), Sir F. Pollock, A.-G., on a petition for relief against certain suggestions in a writ of *scire facias*, which had regularly issued, decided that he would direct a *nolle prosequi* to be entered as to certain parts of the writ if the prosecutor insisted on retaining them.

Fiat may or may not be granted *ex parte*.

The Attorney-General may either give or refuse his authority *ex parte*, or direct that the patentee shall have notice and liberty to be heard before him. The fiat may be granted even after the petition has come on for hearing, but before judgment (*m*).

Principles on which Attorney-General acts.

The following cases show the principles on which the law officer acts in issuing or withholding his fiat :—

A. was the patentee of a process for the production of paraffin oil by the distillation of bituminous coal. B. applied for *scire facias*. B. was the owner of a coal-field in Scotland, containing a certain mineral called the Torbane Hill mineral, the right to get which was leased to certain persons, who sold it to the patentee for the purposes of his manufacture. Under the terms of the said lease B. had a pecuniary interest in the quantity of mineral raised. B. alleged that A.'s invention was not new, and that the patent, by restricting the sale of the

(*i*) 2 Vent. 344.

(*j*) *Reg.* v. *Neilson* (1842), 1 Web. P. C. 672; *R.* v. *Betts* (1850), 19 L. J. Q. B. 531; 15 Q. B. 540. Sir Frederick Pollock in argument said: "I never knew a *scire facias* except in the case of a patent for an invention. The only case which I recollect of anything like two grants having been issued occurred not in this country, but in the colony of New South Wales. The Attorney-General of that colony had refused to permit a *scire facias* to issue for the very purpose of trying whether land granted by a second grant had not been granted before. Upon a case which came afterwards before my learned friend the Solicitor-General and myself it appeared that the late law officers of the Crown had advised that the Attorney-General ought to allow the *scire facias* to issue, from which I presume it was considered that the subject had not a right *mero motu* to have a *scire facias*."

(*k*) 1 Web. P. C. 671, 672.

(*l*) *Ibid.* n. (*i*).

(*m*) *Re Dege's Patent* (1895), 12 R. P. C. 448.

Torbane Hill mineral, prejudicially affected his interests. At the date of the application an action raised by B. in Scotland for the reduction of A.'s Scotch patent for the same invention was pending. Sir R. Bethell, A.-G., refused his fiat (a) because the writ of *scire facias* ought not to be used for purely private ends; (b) because the convenient and proper course seemed to be to allow the Scotch action to go on, and to be guided by its issue; and (c) because the patent was eleven years old, had been the subject of several legal proceedings, and ought not, therefore, to be lightly challenged (*n*).

The H. F. Co. applied for authority as regards a patent of B. and C., who had raised an action for infringement, then pending in Scotland, against the applicants. James, A.-G., directed that notice should be given to the patentees, and on their objecting that, as they were resident in Scotland, the application should have been made to the Lord Advocate, refused authority pending the result of the action in Scotland, but gave leave to renew the application if necessary (*o*).

V. applied for authority as regards S.'s patent. Russell, A.-G., directed notice to be given to S., and at the hearing ordered the application to stand over generally upon S. undertaking to bring an action against the applicants within a month, costs of the application to be by consent costs in the cause (*p*).

B. applied for authority as to W.'s patent. B. had been a defendant in an action by W. *v.* S., and this application was made in the interval after the judgment against B. in the Court below, and before the hearing in the Court of Appeal. Russell, A.-G., directed that W. should have notice, and on his failure to appear at the hearing granted authority (*q*).

F. applied for authority as regards G.'s patent. No other proceedings were pending. Webster, A.-G., granted his fiat without directing notice to be given to G. (*r*).

K.'s trustees applied for authority as to R.'s patent. R. had sued K. in the Palatine Court for infringement, had abandoned the action after the delivery of K.'s defence, and had made an application (then pending at the Patent Office) for leave to

(*n*) *Young's Patent*, Pract. Mech. Jour., 2nd series, vol. vi. p. 98. See also vol. vii. p. 44; and Lawson, p. 105.

(*o*) *Bell and Coleman's Patent*, Griffin, P. C. 320.

(*p*) *Siddell's Patent*, *ibid.* In *Martin's Patent*, *ibid.*, James, A.-G., after consultation with Herschell, S.-G., held that, where an application for his authority had been eventually abandoned, he had no power, under sect. 35, to give costs.

(*q*) *Watling's Patent*, *ibid.*

(*r*) *Gaulard and Gibbs's Patent*, ibid.

amend. The applicants carried on K.'s business, with which it was alleged that R.'s patent interfered. Webster, A.-G., gave unconditional authority, without directing notice to be given to R. (*s*).

Meaning of "in fraud of the rights of another."

A patent will not be held to have been obtained in fraud of the rights of another unless the patentee has been guilty of dishonest and culpable acts in obtaining it (*t*). Cotton, L. J., said, speaking of an allegation against an agent: "To be in fraud of his rights it must be either done with the intention of depriving the principal of his rights, or must be insisted on so as to deprive the principal of his rights" (*u*).

In 1885 a patent was granted to L. for improvements in the means of generating fixed gases. In 1886 A., a subject of the United States, presented a petition for revocation, on the grounds that the invention was a communication from abroad—a fact which L. had not disclosed—and that the patent had been obtained by fraud. A.'s petition contained no allegation that he was the true and first inventor. It appeared that L. had not been guilty of fraud, but had acted upon the advice of a competent patent agent in taking out the patent in his own name, and had intended to it hold for the benefit of A. It was held, affirming Mr. Justice Stirling, that even assuming the patent to be void by reason of the non-disclosure of the fact that part of the invention was a communication from abroad, yet it was not proved to have been obtained in fraud of the petitioner's rights, and that the petition must be dismissed without prejudice to any claim which A. might make under sect. 26, sub-sect. 4 (d), as a person alleging that he was the true and first inventor of any of the inventions included in the claim of the patent (*x*).

The question still remains, said Mr. Justice Stirling in this case (*y*), Was (the patent), in the language of the statute, obtained in fraud of the petitioner's rights? The first point to be determined in answering that question is the sense of the word "fraud" as used in the statute. We have not to deal with a statute 300 years old, like the Statute of Monopolies, nor

(*s*) *Rothwell's Patent*, *ibid.*

(*t*) *Avery's Patent* (1887), per Stirling, J., 4 R. P. C. at p. 165; and see also Cotton, L. J., 36 Ch. Div. at p. 324.

(*u*) *Ibid.*; and see *Norwood's Patent* (1895), 12 R. P. C. 214.

(*x*) *Avery's Patent* (1887); 36 Ch. Div. 307; 56 L. J. Ch. 1007; 4 R. P. C. 152, 322. For an example of what would be fraud within the meaning of this sub-section, see *Re Norwood's Patent* (1895), 12 R. P. C. 214; *Gates' Patent* (1891), 8 R. P. C. 439; *Edge* v. *Harrison* (1891), 8 R. P. C. 74.

(*y*) *Avery's case*, 36 Ch. Div. at p. 319.

is there any current of decision to fix the sense in which the word therein is used, and in Mr. Justice Stirling's judgment it would be wrong to construe the word, occurring as it does in an Act recently passed, and in the absence any context imperatively demanding such a construction, otherwise than in accordance with the usual construction of the English language, and consequently as involving grave moral culpability in the person obtaining the patent.

Where a patent is revoked on the ground of fraud, the comptroller may grant the true inventor 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 (*z*). The comptroller is not bound to do this (*a*).

The petition should be presented in the name of the person making the allegations which would destroy the grant, and not in that of his attorney, and all other persons interested in the grant must be made respondents (*b*).

True inventor of invention included in claim of patentee.

The case of *Walker* v. *Hydro-carbon Syndicate, Ltd.* (*c*), turned on the words "true inventor of any invention included in the claim of the patentee. In this case W., the grantee of a patent, presented a petition under sub-sect. 2 of sect. 26 of the Patents Act, 1883, for revocation of patents granted to H. and B., alleging that he was the true and first inventor of the inventions comprised in such patents. It was held, on the construction of the specifications of the three patents, and also of a patent granted in 1865 to one Wise, that eliminating from W.'s patent matters of common knowledge, the inventions claimed by H. and B. were not similar to the invention claimed by W., and that the petition must therefore be dismissed with costs. The following extract from the judgment of Bacon, V.-C., will show the *ratio decidendi* :—

Judgment of Bacon, V.-C.

"There was a common universal knowledge that petroleum, dangerous in itself, inapplicable in itself, could by means which

(*z*) (1883) sect. 26 (8).

(*a*) *Norwood's Patent* (1895), 12 R. P. C. at p. 219.

(*b*) *Re Avery* (1887), 36 Ch. Div. pp. 310, 311; 56 L. J. Ch. 1007; *Re Haddan's Patent* (1885), 2 R. P. C. 218.

(*c*) (1885) 2 R. P. C. p. 3. An appeal was lodged against the decision in this case, but subsequently abandoned. Preliminary applications—(a) that the appeal might stand over till the return from America of the plaintiff, who was an engineer, and wished to be present at the hearing for the purpose of instructing his counsel; and (b) that the plaintiff should be allowed to adduce fresh evidence on appeal, were dismissed: (1886) 3 R. P. C. 253.

had been resorted to long ago in Wise's patent, and long before that, namely, by being reduced into the form of spray, be usefully applied for the purposes for which petroleum alone is valuable, and avoiding all the danger which would attend the application of it in any other way. The three patents . . . are not for totally different purposes, but are totally different in their mode of application; and now I am to be told, after a mechanical invention has been produced for a common object, that any person who makes a better combination of machinery (not by the mere introduction of mechanical equivalents, but by the exercise of mechanical genius or talent, or whatever it may be called) could not obtain a patent for it; that he has no right to say, . . . 'Admitting yours was a good patent, and your contrivances are very ingenious and clever, I see a much better way of dealing with the basis of common knowledge, . . . and I do it better and differently from the way in which you do it.' That is the whole case."

Prior user.

If a petitioner can show that prior to the grant of a patent he had publicly manufactured the subject-matter by a process substantially similar to that used by the patentee. revocation will be granted (*d*).

Where *locus standi* patent may be impeached on all grounds.

A petitioner qualified to present a petition in the manner pointed out in clauses (c). (d). and (e). above. may impeach the patent on any other ground when he has established his *locus standi* (*e*). He may do so though he has already raised the same issues as defendant in an infringment action. Conversely, a decision against the patent in an infringement action does not prevent the patentee from alleging validity when the patent is attacked in revocation proceedings (*f*).

If, however, the petitioner has no *locus standi*, and if he is not one of the persons entitled under the Act to present a petition to revoke the letters patent. the Court will not go into the question whether the patent is or is not good (*g*).

Particulars of objections with petition.

The plaintiff must deliver with his petition particulars of the objections on which he means to rely. and no evidence shall, except by leave of the Court or a Judge. be admitted in proof

(*d*) *Haddan's Patent* (1880). 2 R. P. C. 218.

(*e*) *Morgan's Patent* (1887). 5 R. P. C. 186; *Doyle's Patent* (1895). 12 R. P. C. 448.

(*f*) *Re Dudgeon's Patent* (1895). 1 Ch. 687; 64 L. J. Ch. 180; 12 R. P. C. 102; *Shoe Machinery Co. v. Cutlan* (1896). 1 Ch. at p. 113; 65 L. J. Ch. 44; 12 R. P. C. 533.

(*g*) *Avery's Patent* (1887). 36 Ch. D. at p. 323. per Cotton, L. J.; 56 L. J. Ch. 1007; 4 R. P. C. 322.

of any objection of which particulars are not so delivered (*h*). Disconformity is still a ground for revocation (*i*).

Certificate as to particulars proved, &c.

In the matter of *Goulard and Gibbs's Patent* (*j*), Mr. Justice Kekewich held (*k*) that he had no power to grant a certificate as to particulars of objections delivered (*l*) by a petitioner for revocation, but gave the petitioners leave to make a renewed application for a certificate at their own risk as to costs.

Amendment of particulars.

Particulars delivered may be from time to time amended by leave of the Court (*m*).

Contrary to the rule which prevailed in the action of *scire facias* (*n*) prior to the Act of 1852, the defendant is now, as under the Act of 1852, entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply (*o*).

Subject to sect. 26, ordinary practice on petition holds.

Subject to the provisions contained in the Patents Act, 1883, sect. 26, the practice is governed by the ordinary practice upon a petition to the High Court. Accordingly a petitioner on making the usual deposit will be allowed to administer interrogatories to the respondent (*p*). The Court has the same power as to costs as in an ordinary action (*q*). But a respondent resident abroad will not on that account be made to give security for costs; he is not in the position of a plaintiff (*r*).

Petition "an action."

A petition for revocation is in every sense of the word an "action," except that it is not commenced by writ, and involves precisely the same issues as an action to try the validity of the patent (*s*). Respondents who desire it may have a petition for revocation tried on *viva voce* evidence (*t*).

Fraud of opponent's right.

Revocation on the ground of prior user by the petitioner, or a person through whom he claims (*u*), is in form apparently new,

(*h*) Sect. 26, sub-sect. 5. See form of particulars of objection, *infra*, pp. 788—790; and *Haddan's Patent* (1885), 2 R. P. C. 219.

(*i*) *Vickers* v. *Siddell* (1890), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292; *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23, 28; 61 L. J. 94; 8 R. P. C. at p. 454.

(*j*) (1888) 5 R. P. C. 526; affirmed (1889) 6 R. P. C. 215.

(*k*) Upon a consideration of sects. 26, 28, sub-sect. 1, and 29, sub-sects. 2, 4, and 6.

(*l*) Under sect. 26, sub-sect. 5.

(*m*) *Ibid.* sub-sect. 6.

(*n*) Hindmarch, p. 412.

(*o*) Sect. 26, sub-sect. 7.

(*p*) *Haddan's Patent* (1884-85), 54 L. J. Ch. 126; Griff. 108.

(*q*) *Re Edmonds's Patent* (1889), 6 R. P. C. at p. 358.

(*r*) *Re Miller's Patent* (1894), 63 L. J. Ch. 324; 11 R. P. C. 55.

(*s*) 1883, sect. 26 (7). If the trial be on affidavit evidence, the defendant should file his evidence before petitioner files his: *Gale's Patent* (1891), 8 R. P. C. 438.

(*t*) *Gaulard and Gibbs's Patent* (1887), per North, J., 34 Ch. D. 396. This is the better method of trial: *Gale's Patent* (1891), 8 R. P. C. 438.

(*u*) Sect. 26, sub-sect. 4, clause (*e*).

though, of course, a *scire facias* would have lain for want of novelty at the instance of any person.

Registration of order revoking patent.

The person in whose favour an order for the revocation of a patent has been made is required to leave forthwith at the Patent Office an office copy of such order (*x*).

That a specification does not end with a distinct statement of the invention claimed is not a ground of revocation (*y*).

Where a patent has been revoked on the ground of fraud, the comptroller may on the application of the true inventor, made in accordance with the provisions of the 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 (*z*).

There is no provision in the Act of 1883 for the cancellation of a revoked patent, according to the practice which prevailed in proceedings by *scire facias*. But the order revoking the patent is entered upon the register, which is indeed sufficient.

A specification cannot be amended under the Act of 1883, sect. 18, whilst a petition for revocation is pending, but under sect. 19 the Court or a Judge may, subject to such terms as to costs and otherwise as are thought fit, give leave to apply at the Patent Office for liberty to amend the specification by way of disclaimer, and may direct a stay of proceedings in the meantime (*a*).

In *Dudley* v. *Perkes* (*b*) a difficult question arose. The Court of Appeal declared one claim of a patent to be good, but the other bad, and revoked the patent; the patentee appealed to the House of Lords. The House after argument deferred judgment to enable the patentee to apply at the Patent Office for leave to disclaim the obnoxious claim. But the comptroller declined jurisdiction, basing his decision on the ground that by the judgment of the Court of Appeal the patent was revoked, that there was nothing to amend. It was stated by the Lord Chancellor that the Court of Appeal should have ordered that the patent be revoked unless within a time fixed by the Court the patentee should obtain leave to disclaim the bad claim.

(*x*) P. R. 1890, rule 74.

(*y*) *Vickers* v. *Siddell* (1888), 15 App. Ca. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

(*z*) Sect. 26, sub-sect. 8.

(*a*) See *ante*, p. 233.

(*b*) (1896) App. Ca. 496; 13 R. P. C. 581. And see *Re Dellwik's Patent* (1896), 2 Ch. 705; 13 R. P. C. 591; 65 L. J. Ch. 905.

CHAPTER XVI.

PROLONGATION OR EXTENSION OF PATENTS (*a*).

Before 1835 no prolongation except by special Act.

PRIOR to 1835, the term of letters patent could not be extended except by a special Act of Parliament. The cases mentioned in note (*b*) illustrate the kind of circumstances under which a statutory prolongation of a patent could be obtained (*b*).

Lord Brougham's Act.

The frequency of applications for statutory assistance suggested the propriety of framing some general measure providing for the extension of letters patent, and Lord Brougham's Act (5 & 6 Will. IV. c. 83, s. 3) was eventually passed. Sect. 4 of that

(*a*) The author is indebted to Mr. G. P. Wheeler, Barrister-at-Law, of the Judicial Department, Privy Council, for much information in connection with this subject.

(*b*) A patent for an engine for making stone pipes had been granted to one John Juite in 1734. The undertaking stood still until John Elwick purchased the patent right, and at many thousand pounds' expense improved the engine beyond what it was capable of doing when first invented. An additional term of fourteen years was granted in 1743 (16 Geo. II. c. 25).

Israel Pownoll had obtained a patent in 1712 for an engine for raising ballast, suttege, and sand, and for removing banks, shelves, and shoals in rivers and harbours, and completed the engine before his death, but afterwards his children, being young, could not work it; and, the patent being expired, it was not likely to be brought into use without a new grant. It was, therefore, renewed for fourteen years from 1st August, 1750 (23 Geo. II. c. 33, 1749). See also *Cookworthy's case* (1738) (materials for porcelain) (15 Geo. III. c. 52); *Liardet's case* (1773) (16 Geo. III. c. 29).

David Hartley obtained a patent for England and the Colonies in 1773 for his method of applying iron plates to cover the woodwork of buildings and ships, so as to prevent the action of fire; and having expended large sums in experiments to perfect the invention, and still more money being requisite without a prospect of recompense during the term of the patent, the term was prolonged thirty-one years, upon conditions similar to those mentioned in the last case, with a further provision that the invention might be applied in any buildings used in fitting out or victualling the King's ships of war without licence from the patentee (17 Geo. III. c. 6, 1777).

Dr. Edward Bancroft had a patent in 1775 for the use of certain vegetables growing spontaneously in America, for dyeing, staining, printing, and painting certain valuable colours. Having been deprived of the benefit of his patent by the American war, he was allowed an extension of fourteen years upon the usual terms (25 Geo. III. c. 38, 1785).

James Turner had a patent in 1781 for a yellow colour for painting coaches and other works. Owing to secret piracies from 1787 to 1789, his sale was almost taken from him. He brought one action to trial, and obtained two verdicts therein (a new trial having been granted), also an injunction, but he only gained nominal damages, and was not rewarded for his invention. The term of the patent was extended for eleven years from 24th June, 1792, upon the following conditions: Turner was not to sell the colour at more than

statute declared "that if any person who now hath or shall hereafter obtain any letters patent as aforesaid—*i.e.*, as grantee, assignee, or otherwise—shall advertise in the *London Gazette* three times, and three times in some country paper published in the town where or near to which he carried on manufacture of anything made according to his specification, or near to or in which he resides in case he carried 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 apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a *caveat* at the Council office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such *caveats*, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering *caveats* shall likewise be heard by their counsel and witnesses, whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary notwithstanding, provided it shall appear that the letters patent of which it is intended to extend the term by such Bill will expire within two years from the commencement of the session of Parliament in which the application for such Bill shall be made, and unless it shall appear that the application to Parliament for extending the term of the letters patent is made by the person, or by the representatives of the person, who himself originally discovered the invention for which such letters patent were granted by his Majesty; and that the knowledge of such invention was not acquired by such person as aforesaid, by purchase or otherwise, from the inventor or owner of the same, or by information that such invention was known and pursued in any foreign country."

500 guineas per cwt. The Act was not to hinder any person from making any yellow colour which was publicly used before the date of the patent, but only such as was of Turner's invention, and as was described in his specification. Every objection which might have been made to the said yellow colour not being a new invention within the meaning of 21 Jac. I. sufficient to invalidate letters patent should be a bar to any action brought by virtue of the Act. The privilege was not to be assigned to more than five persons (32 Geo. III. c. 72, 1792).

On March 29th, 1808, the House of Lords made a standing order "that no Bill for the purpose" (of extending the terms of letters patent) "shall be read a third time in this House, unless

that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

Amendments of Lord Brougham's Act.

Various changes in the procedure here described have been made by subsequent legislation. The Judicial Committee was empowered by the statute 7 & 8 Vict. c. 69, s. 2, to recommend an extension of the original term of letters patent for a period not exceeding fourteen years where it was shown that the patentee had been unable to obtain a due remuneration for his expense and labour in perfecting his invention, and that an additional term of seven years would not suffice for his reimbursement. Again, the clause in 5 & 6 Will. IV. c. 83, s. 4, requiring a petition for extension to be not only presented, but "prosecuted with effect," before the expiration of the original term, was, owing to the circumstances in the case of *Bodmer's Patent* (*c*), repealed by 2 & 3 Vict. c. 67.

Bodmer's Patent.

The facts in that case were as follows: An application was made in May, 1838, for an extension of the term of Bodmer's patent for cotton-spinning machinery. *Caveats* were entered in July. The case came on before the Privy Council on 17th August, when, according to the rules of practice (*d*), the opposing party was entitled to four weeks' notice of the hearing for the purpose of preparing evidence. Before the expiration of this month the Privy Council would have closed its sittings. The case was opened, and adjourned to the 29th of November. In the meantime the opposition was withdrawn, but the patent had also expired. It was held that the words "prosecuted with effect" meant that something must have been effected, some conclusion arrived at by the Council before the expiration of the patent; and no conclusion having been arrived at, nothing effected, the law did not empower the Council to proceed with the matter further, or the Crown to grant new letters patent for an invention open to the public (*e*).

2 & 3 Vict. c. 67.

The statute 2 & 3 Vict. c. 67, s. 2—under which Bodmer's Patent was subsequently extended (*f*)—empowered the Privy Council to report in favour of an extension, in spite of failure to prosecute with effect before the expiration of the original term, where such default arose from other causes than the neglect

(*c*) 15 Lond. Jour. Arts.
(*d*) J. C. Rules, rule 2, *infra*, p. 718.
(*e*) Web. Letts. Pat. p. 58, n. (*s*); also 1 Web. P. C. 740.
(*f*) For a term of seven years. The new patent bore date 18th July, 1840. 1 Web. P. C. 740.

or default of the petitioner. The same section also provided that no extension would be granted upon petitions presented after the 30th November, 1839, "unless such petition be presented six calendar months, at the least, before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term." Under the Patents Act, 1883, s. 25, letters patent may be extended for seven, or in exceptional cases for fourteen years (*g*), and the petition for extension must be presented at least six months before the expiration of the original term (*h*).

Act of 1883.

The Act of 1883, s. 25, leaves the law and procedure relating to prolongation practically unaltered (*i*). As sect. 113 saves the rights of all existing patentees, and no prolongation for patents granted under the Act of 1883 can take effect until 1898, it appears that the provisions of sect. 25 are at present suspended, or at any rate so far suspended as rights or privileges accrued prior to 1st January, 1884, are concerned, notwithstanding the repeal of the statutes regulating the law and practice of prolongation at the time when the Act of 1883 was passed (*k*). This was the opinion of the Judicial Committee in *Brandon's Patent* (*l*).

In *Brandon's Patent* (*l*), a petition presented on the 24th May, 1884, for the prolongation of a patent dated the 31st October, 1870, was refused by the registrar as not being presented within six months of the expiration of the patent, as provided by the Act of 1883, s. 25. The petitioner moved, before the Judicial Committee of the Privy Council, that the petition might be admitted. "Their Lordships," said Lord Watson, in giving the decision of the Judicial Committee, "have come to the conclusion that the petition presented the 24th May, 1884, ought to be received. It is obvious that the petition would not be competently presented if the provisions of sect. 25 applied. But their Lordships are of opinion that those provisions do not apply, and that the proceeding falls within the exceptions introduced by sect. 113 of the statute of 1883. The provisions of sub-sect. (a) of that section must be read distributively, and so read they declare that

(*g*) Sub-sect. 5.
(*h*) Sub-sect. 1.
(*i*) A different term is used in this Act—viz., *extension*, instead of *prolongation*.
(*k*) See schedule to that Act.
(*l*) (1884) 9 App. Ca. 589; 53 L. J. P. C. 84; 1 R. P. C. 154.

the enactments of the new statute shall not affect any patent granted before the commencement of the Act. And they also declare in express terms that those enactments shall not affect any right or privilege which has accrued to the patentee before or at the commencement of this Act. Now, the patent which was held by the present petitioner at the passing of this Act of 1883 was an exclusive right to use a certain invention for a definite period of time; but as incidental to that right he had, by virtue of the provisions of the Act 5 & 6 Will. IV., the further privilege of leave to apply for a prolongation of his patent at any time before its expiration, upon such grounds as commended themselves to this Board. That right had accrued to him. He was in a position, if he had chosen, to make the application when the new statute came into force; and their Lordships find it impossible, looking to the precise terms of sect. 113, to hold that that privilege, which was incident to and part of his patent right, was taken away by the provisions of the new Act; or, rather, they find it impossible to hold that it is not a right included in the express reservation made by sect. 113. They will therefore direct that the petition be received, and the usual procedure followed." See also *Jablochkoff's Patent* (*m*), *Marshall's Patent* (*n*), and *Semet and Solray's Patent* (*o*).

No new rules relating to petitions for prolongation have been made by the Privy Council, and it is understood that it is not yet intended to alter the existing rules made under 5 & 6 Will. IV. c. 83, so that the practice appears to remain unaltered at present.

Advertisements.

Sect. 4 of 5 & 6 Will. IV. c. 83, requires 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 specification; or near to or in which he resides, in case he carried 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."

Rule II. of the Judicial Committee Rules provides that "a party intending to apply by petition, under sect. 4 of the

(*m*) (1891) App. Ca. 293; 8 R. P. C. 281; 60 L. J. P. C. 61.
(*n*) (1891) App. Ca. 430.
(*o*) (1895) App. Ca. 78; 64 L. J. P. C. 41; 12 R. P. C. 10.

said Act, shall, *in the advertisements* (*p*) 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 be not 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 (*q*) must be entered." The time may be extended, but no extension will be granted if the intending opponent's sole excuse for not entering his caveat in time is that he did not see the petitioner's advertisement (*r*). Caveats.

Where the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on (*s*). "The statute," said Lord Brougham (*s*), "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" (*s*).

To entitle an equitable assignee to appear with the legal assignee of a patent, the name of such equitable assignee must appear in the advertisements with that of his co-petitioner (*t*). "If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation" (*u*).

The Petition.—The next (*x*) step is the presentation of a petition (*y*) to the Queen in Council, praying that the petitioner's letters patent "may be extended for the further and additional term of fourteen years, or for such other term" as to her Majesty may seem fit. The petition.

As we have already pointed out, in *Brandon's Patent* (*z*), it appears that the petition need not be presented six months before Time when to be presented.

(*p*) Before the Judicial Committee Rules were made, it seems that notice of the intention to apply for extension, and of the day on which application would be made to fix the hearing of the petition, were not necessarily included in one advertisement. See *Erard's Patent* (1835), 1 Web. P. C. 559. n. (*c*). For a form of the present advertisement, see Appendix, p. 853.

(*q*) For form of caveat, see Appendix, p. 854. All persons entering a caveat, or *caveators*, are entitled to be served with the petition, and to appear at the hearing.

(*r*) *Hopkinson's Patent* (1896), 13 R. P. C. 114.

(*s*) *Derosne's Patent* (1844), 2 Web. P. C. 2.

(*t*) *In re Noble's Patent* (1850), 7 Moo. P. C. 191.

(*u*) Per Lord Brougham, *ibid.* p. 194

(*x*) See sect. 25, sub-sect. 1, *infra*, p. 598.

(*y*) See Forms, Appendix, pp. 856–8.

(*z*) (1884) 1 R. P. C. p. 154; 9 App. Ca. 589.

the expiration of the patent. The old rule prevails, and provided a petition be "*prosecuted with effect*" (*a*) before the expiration of the term, a petition can be presented at any time, if there be time to proceed with it, before the expiration of the patent (*b*). If, however, the petition be not "*prosecuted with effect*" before the end of the term, it appears that unless the petition has been presented six months before the end of the term, the claim to prolongation is lost (*c*).

The petition should not be presented too long before the expiration of the patent, otherwise it may be ordered to stand over, as the profits accruing in the meantime might materially affect the question of extension (*d*).

Petition must set out all facts fully and fairly.

As the recommendation to the Crown for the prolongation of the term of letters patent is a matter of discretion in the Judicial Committee, it is imperative that the petition for such prolongation should state fairly and fully everything relating to the patent, and an omission to do so is *generally* (*e*) fatal to the application (*f*). Forms of petition are given in the Appendix (*g*).

Cases.

A petition was presented for the extension of a patent for a foreign invention which had been patented in America prior to the date of the English patent. It appeared that the American

(*a*) The application for renewal is "prosecuted with effect," within the words of the statute, if the party applying obtains the report of the Judicial Committee before the expiration of the original patent: *Ledsam* v. *Russell*, 1 H. L. Ca. 687. But the Crown is not restricted as to the time within which it may not act upon such report, and renewed letters patent are not void because they are dated after the expiration of the patent.

(*b*) *Marshall's Patent* (1891), App. Ca. 430.

(*c*) See 5 & 6 Will. IV. c. 83, s. 4; 2 & 3 Vict. c. 67, ss. 1, 2, and 7 & 8 Vict. c. 69, s. 2, under which it seems to have been the practice of the Privy Council to allow a petition to be presented at any time.

(*d*) See *Macintosh's Patent*, 1 Web. P. C. 739.

(*e*) In *Pitman's Patent* (1871), L. R. 4 P. C. 84, the Judicial Committee stated that for the future they would invariably act upon the principle that failure to make a full disclosure of everything relating to the patent, the term of which it was desired to extend—*e.g.*, particulars as to foreign patents—should be fatal to a patent. In *Re Hutchinson's Patent* (14 Moo. P. C. 364), material facts showing the title of the petitioner were disclosed in evidence which were not stated in the petition for prolongation. The hearing was postponed, and an amendment of the petition allowed. The date of this case, however, was 1861, so that it is not an exception to the rule in *Pitman's Patent*, which was laid down in 1871. But in *Reece's Patent* (Eng. Rep. January to March, 1881, XIV.), a petitioner who had, in ignorance of the Privy Council's rule, omitted in his petition to give the proper information as to his foreign patents, was allowed, on application made before the hearing, to correct the omission by adding a supplementary paper. This does not, however, contravene the decision in *Pitman's Patent*, as the petition was amended before the case came on, *vide Adair's Patent* (1881), L. R. 6 App. Cas. 176, at p. 180.

(*f*) *In re Pitman's Patent* (1871), *ubi supra*; *In re Johnson's Patent* (1871), L. R. 4 P. C. 75; cp. also *In re Clark's Patent* (1870), L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; *In re Horsey's Patent* (1884), 1 R. P. C. 225.

(*g*) At pp. 856, 858.

patent had expired, was subsequently renewed, and would finally come to an end in August, 1876. These facts were not stated in the petition. Extension refused (*h*).

A petition was presented nominally by one company, but really was for the benefit of another company, to which the shares of former had been transferred. The statement of the fact appeared in the petition, and the real facts were only brought forward by the Attorney-General. Petition dismissed (*i*).

A limited company, who were the registered assignees of *Horsey's Patent* (No. 3145 of 1870), presented a petition for the prolongation of the term of such patent. The company consisted mainly of seven persons, to whom a share each was given, to enable the requirements of the Joint Stock Companies Act to be literally complied with, but the only persons really interested were the patentee and a creditor of his for money borrowed. These facts were not stated in the petition. Held, that the requisite good faith had not been observed by the petitioners, and the prayer of the petition must, therefore, be refused (*k*).

One of several joint patentees carried on the manufacture of the patented article in combination with the manufacture of other articles. No allusion to that fact was made in the petition, nor was there any intimation in the accounts that any other manufacture excepting that of the patented article was so carried on. Extension refused (*l*).

Who may be petitioner.

A petition for extension may be presented by any person *who is for the time being entitled to the benefit* of the patent, the term of which it is sought to extend. Under the clause in italics, which is the definition of "patentee" given by sect. 46 of the Patents Act, 1883, the following persons may petition for extension:—

The patentee.

1. The *original patentee*, whether inventor or merely importer of the patent. The non-inventor importer, however, being less

(*h*) *In re Pitman's Patent* (1881), *ubi supra*. "It is desirable that those who come to oppose a patent should know the precise circumstances and the possible conditions on which renewal was granted, and therefore it does appear to their Lordships that this was eminently a case in which the suggestions of Mr. Archibald in *Re Johnson's Patent* (1871), L. R. 4 P. C. 75, approved by their Lordships, should have been followed, and that there should have been a full disclosure of all the circumstances relating to the American patent": per Sir J. W. Colville. Cp. *Adair's Patent* (1881), L. R. 6 App. Ca. 176; 50 L. J. P. C. 68. The remuneration which a patentee has obtained from foreign patents, as well as from his English patent, should be stated.

(*i*) *Reece's Patent*, Eng. Rep. January to March, 1881, XIV.

(*k*) *Re Horsey's Patent* (1884), 1 R. P. C. 225.

(*l*) *In re Yates and Kellett's Patent* (1887), L. R. 12 App. Ca. 147; 4 R. P. C. 150.

than that of an inventor (*m*), the Judicial Committee regards such applications with jealousy, and will carefully consider the merit of the invention imported (*n*).

Illustrative cases.

A petition was presented for the extension of the term of a patent imported from abroad. The importers had embarked a large capital upon machinery in trying to introduce it to general use, and incurred considerable loss in so doing. Extension of letters patent for six years granted (*o*).

C. imported an invention from Paris, patented it in England, and assigned it for 8,000*l.* to a joint stock company, whose trustees petitioned for an extension on the ground that the company had expended 23,000*l.* in carrying out the invention, and that the profits made had not compensated for the losses incurred. In delivering judgment, Sir John Jervis said: "Each case must be dealt with according to its own particular circumstances, and their Lordships have looked at this case as to the merits of Claridge as the inventor according to the strict meaning of that word. He introduces, not a piece of complicated machinery, or a manufacture of difficulty or science, but something in general use at Paris. . . . . He does obtain a patent, and forms a joint stock company, and receives 8,000*l.* for the introduction of a well-known substance from a foreign land; so far as he is concerned, he has had adequate satisfaction for any merits he had in the introduction. We must take this case upon the basis of the original importer's merit, taking into consideration that those who now apply entered into a commercial speculation with a full knowledge of all the circumstances, and with the expectation of a profit, which, if they have not got, is no reason to entitle them to call upon us to grant this application" (*p*).

Executor, &c.

2. The *executor* (*q*) or *administrator* (*r*) of a deceased patentee.

Where it appears on the face of a petition presented by the equitable owner of the patent of which extension is desired, that the legal personal representative of the patentee may possibly have an interest in the patent, such legal personal representative will be added as a co-petitioner.

(*m*) *Soames' Patent* (1843), 1 Web. P. C. at p. 733; *Johnson's Patent* (1871), L. R. 4 P. C. 75; *Pitman's Patent* (1871), L. R. 4 P. C. 84; *Adair's Patent* (1881), L. R. 6 A. C. 176.

(*n*) *Claridge's Patent* (1851), 7 Moo. P. C. 394; cp. *Bell's Patent* (1846), 2 Web. P. C. 159.

(*o*) *In re Berry's Patent* (1850), 7 Moo. P. C. 187.

(*p*) *Claridge's Patent* (1851), 7 Moo. P. C. 394.

(*q*) Cp. *In re Bodmer's Patent* (1849), 6 Moo. P. C. 469.

(*r*) *In re Downton's Patent* (1839), 1 Web. P. C. 565; *In re Heath's Patent* (1853), 2 Web. P. C. 247.

A petition was presented for the prolongation of a patent by C., a son of the patentee, who had acquired an interest in the patent for the benefit of his mother and sisters from L., to whom it had been assigned by the trustee in liquidation of the patentee. The patentee had, up to his death, worked the patent under a verbal agreement with L., that L., when he had been paid 500*l.* out of profits, would settle the patent on a member of the patentee's family. The patentee had paid 300*l.* at the date of his death, and C. paid 200*l.* subsequently. The patent was handed over to C., but no assignment was executed by L. The Judicial Committee intimated that the legal personal representative of the patentee ought to be a party to the petition, which was amended accordingly (*s*).

3. *Assignees.* Assignees.

The power of the Crown to extend letters patent is not confined to *grantees*, but extends to *assignees;* and such renewed letters patent, granted to the assignee, were good by the statute 5 & 6 Will. IV. c. 83, independently of the express provision in 7 & 8 Vict. c. 69, s. 4 (*t*).

The following extract from the judgment of Lord Romilly, M. R., in *Norton's Patent* (*u*), shows very clearly the considerations which guide the Court in dealing with applications for extension on the part of assignees: "It must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

Another view of the principle on which applications on the part of assignees are entertained by the Judicial Committee was given by Lord Brougham in *Morgan's Patent* (*x*): "Their Lordships have always been used to consider that by taking into their view and favourably listening to the application of the assignee,

(*s*) *In the matter of Willacy's Patent* (1888), 5 R. P. C. 690.

(*t*) *Russell* v. *Ledsam* (1845), 14 M. & W. 574; 12 L. J. Ex. 439; judgment affirmed in Exch. Ch. 16 M. & W. 633; 14 L. J. Ex. 353; and in H. of L. 1 H. L. Cas. 687.

(*u*) (1863) 1 Moo. P. C. N. S. 339; 11 W. R. 720.

(*x*) (1843) 1 Web. P. C. 737.

they are, though not directly, yet mediately and consequentially . . . . as it were, giving a benefit to the inventor; because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and, consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent."

In *Bower-Barff Patent* (*y*), it was stated that no extension should be made to an assignee unless the inventor would directly or indirectly obtain an advantage from it, and the circumstances are such that, if the application were made by the inventor himself, it would be granted.

General principle.

It will be found that all the recorded successful applications, on the part of assignees, for the extension of letters patent, can be justified by reference to one or other of the principles stated in the extracts above quoted—the benefit of the public, and the benefit of the inventor.

Illustrative cases.

A joint stock company purchased a patent for a sum of money paid to the patentee, and the allotment to him of a number of paid-up shares, and spent a large amount of money in a *bonâ fide* endeavour to bring the invention, which was highly meritorious, into public use, without profitable result either to the patentee or to themselves. Extension granted (*z*).

The assignees of a patent for improvements in machinery petitioned for extension. The invention was of great commercial value, and the petitioners had embarked a large capital in bringing the patent into use, but the machinery was expensive, and heavy losses had been sustained. Extension granted (*a*).

Petitioners were a company who bought a patent and made a considerable sum of money by selling their shares at a premium

(*y*) (1895) App. Ca. 675; 12 R. P. C. 383. The position of an assignee was discussed in a later case, *Re Hopkinson's Patent* (1896), 14 R. P. C. 5.

(*z*) *Houghton's Patent* (1871), L. R. 3 P. C. 461.

(*a*) *Berry's Patent* (1850), 7 Moo. P. C. 187. Lord Brougham said in this case, "The patent law is framed in a way to include two species of public benefactors: the one, those who benefit by their ingenuity, industry, and science, and invention and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the results of foreign invention. In this case certain parties have, by their adventurous spirit and by the outlay of capital, benefited the public in proportion of the value of the foreign invention in question, which, but for that adventurous spirit and outlay of capital, would not have been available to the people of this country. That, therefore, is to be considered as a solid claim to the exercise of the *quasi* legislative power which the statute vests in this Commission."

on the Stock Exchange. Extension was refused, on the ground that the petitioners had taken over the invention as a speculative undertaking, and not for the purpose of benefiting the public (*b*).

A company bought a patent for the purpose of trading with it, and not for any purpose by means of which any benefit could come to the original inventor, who had not only parted with all interest in it, but had died since the assignment. Extension refused (*c*).

An assignee petitioning for the extension of the term of a patent was required to secure to the inventor an annuity (*d*), or a share of the profits (*e*).

Assignees petitioned for the extension of a patent. The patentee had parted with his interest for a large sum of money. Extension granted to the assignees without conditions (*f*).

If there be a mortgagee of the patent sought to be prolonged, he should be a party to the application (*g*).

When petition to be presented.

Under the Act of 1883, the petition for extension must be presented at the Privy Council Office at least six months before the time limited for the expiration of the patent (*h*). The right, however, to present, under Lord Brougham's Act, a petition for the prolongation of a patent at any time before the expiration of the patent, is a right or privilege accrued under those enactments, and is, therefore, saved by sect. 113 of the present Act, in the case of patents existing at its commencement (*i*). In such cases the old law still prevails, and the petition for prolongation may be presented at any time, provided that it is prosecuted with effect during the existence of the patent (*j*). The petition may be presented pending an appeal from the decision of a Court declaring the patent invalid (*k*).

By the Rules the petition must be presented within one week

(*b*) *Sillar's Patent* (1882), Goodeve, P. C. 581; cp. also *Electric Telegraph Co.*, per Lord Langdale, M. R., cited in Goodeve, P. C. 554.

(*c*) *Norton's Patent* (1863), 1 Moo. P. C. N. S. 339.

(*d*) *Whitehouse's Patent* (1838), 1 Web. P. C. 476; *Markwick's Patent* (1860), 13 Moo. P. C. 310; *Russell* v. *Ledsam* (1845), 14 M. & W. 574; 14 L. J. Ex. 353.

(*e*) *Hardy's Patent* (1849), 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep. April to June, 1881, VII.

(*f*) *Bodmer's Patent* (1849), 6 Moo. P. C. 468; *Napier's Patent* (1861), 13 Moo. P. C. 543.

(*g*) *Church's Patent* (1887), 3 R. P. C. at p. 100.

(*h*) Patents Act, 1883, sect. 25, subsect. 1.

(*i*) *Brandon's Patent* (1884), 9 App. Ca. 589; 53 L. J. P. C. 84; 1 R. P. C. 154. Subject to sect. 25 of the Act of 1852; see *Jablochkoff's Patent* (1891), A. C. 293; 60 L. J. P. C. 61; 8 R. P. C. 281.

(*j*) See *Marshall's Patent* (1891), App. Ca. 430.

(*k*) *Lane-Fox's Patent* (1892), 9 R. P. C. 411.

from the insertion of the last of the advertisements required to be published in the *London Gazette* (*l*).

Affidavit of advertisements.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of Lord Brougham's Act, sect. 4, and the 1st and 2nd of the Rules of the Judicial Committee (*m*).

There is no affidavit verifying the petition; the evidence in support of the petition is given at the hearing.

On or before the day fixed for that purpose in the advertisements (*n*), any person may enter at the Council Office a caveat (*o*) addressed to the Registrar of the Council, against the extension prayed for in the petition (*p*).

Interest of opponent.

There is no requirement of interest in an opponent to the prolongation of letters patent, such as exist in the case of opposition to the grant of patents (*q*), or the amendment of specifications (*r*).

An alien resident abroad, who was interested in an English patent by a foreign inventor, and who had also considerable dealing in this country in respect of sales of the patented machine, and in granting licences for the use of such patent, was held, under the circumstances, to have such a *locus standi* as would entitle him to oppose the extension of an English patent which would interfere with that in which he was interested (*s*).

Grounds of objections.

The caveat must be entered in the name of the opponent himself, and not in that of a patent agent (*t*). Every person entering a caveat is entitled to be served with a copy of the petition for prolongation, and no application to fix a time for hearing is allowed to be made without an affidavit of such service being produced. All parties served with petitions are required to lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections (*u*).

Under the repealed Acts, it was unnecessary for an opponent to the prolongation of letters patent to give particulars of the objections on which he proposed to rely. It was sufficient to state generally the grounds of objection (*x*). The present Act

(*l*) J. C. Rules, rule 3, *infra*.
(*m*) J. C. Rules, rule 4.
(*n*) J. C. Rules, rule 2.
(*o*) See Form, Appendix, p. 854.
(*p*) Patents Act, 1883, sect. 25, sub-sect. 2.
(*q*) *Ibid.*, sect. 11, sub-sects. 1 and 3.
(*r*) *Ibid.*, sect. 18, sub-sects. 2 and 4.
(*s*) *In re Schlumberger's Patent* (1853), 9 Moo. P. C. 1.
(*t*) *Lowe's Patent* (1852), 8 Moo. P. C. 1.
(*u*) J. C. Rules, rules 5 and 6. For forms of objections, see Appendix, p. 864.
(*x*) *Ball's Patent* (1879), L. R. 4 App. Cas. 171; 48 L. J. P. C. 24.

contains no provision altering this practice, and in a recent case (*y*) successful opposers were permitted to give evidence of an instance of prior user not stated in the particulars, but their costs were disallowed.

The Attorney-General, on behalf of the Crown, is entitled to give evidence of objections to the extension of a patent irrespective of the particulars (*z*).

A party applying for the extension of letters patent must give four weeks' notice of the time appointed for the hearing to any person who has entered a caveat against such extension (*a*); and, according to the usual practice of the Judicial Committee, is required to advertise the day fixed in the *London Gazette*, and in two other newspapers named in the order (*b*).

Not less than a week before the day fixed for hearing the application, the petitioner 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 (*c*).

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 will be deemed sufficient (*d*).

In *Re Bell's Patent* (*e*), an unintentional omission to comply with the above rule as to copies of the specification was not held to be fatal; but the Judicial Committee intimated that their leniency upon this occasion must not be used as a precedent, and their Lordships may refuse to go into accounts which have not been filed within the prescribed time (*f*).

The hearing.

The Hearing.—Under 7 & 8 Vict. c. 69, s. 8, the Judicial Committee may appoint one of the clerks of the Privy Council to take any formal proofs required to be taken in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself. This

(*y*) *Stewart's Patent* (1886), 3 R. P. C. 7.

(*z*) *Ball's Patent, ubi supra*; *Stewart's Patent* (1886), 3 R. P. C. 7; *Church's Patent* (1886), 3 R. P. C. 101.

(*a*) J. C. Rules, rule 2. But the time may be extended.

(*b*) Lawson, p. 444.

(*c*) It has of recent years been customary to lodge eight copies of the balance-sheets.

(*d*) J. C. Rules, rule 9.

(*e*) (1846) 2 Web. P. C. 159.

(*f*) *Chatwood's Patent* (1873), L. R. 5 P. C. 88, n.; and *Johnson and Atkinson's Patent* (1873), L. R. 5 P. C. 87.

section was not repealed by the Patents Act, 1883. Under sect. 28 of the Patents Act, 1883, the Judicial Committee may call in the aid of an assessor specially qualified (sub-sect. 2), may try the case wholly or partially with the assistance of such assessor (sub-sect. 1), and may determine his remuneration, which is to be paid in the same manner as the other expenses of the execution of the Act (sub-sect. 3).

At the hearing, the petitioner and any parties opposing may appear either by themselves or by counsel.

The Attorney-General, in accordance with a rule laid down by the Judicial Committee in *Erard's Patent* (*g*)—the first application for extension under 5 & 6 Will. IV. c. 83—always appears to watch, on behalf of the Crown and the public, the progress of extension petitions, whether opposed or not, and is entitled to set forth his views, although no caveat has been entered (*h*).

In *Pettit Smith's Patent* (*h*), an application by the Lords of the Admiralty to enter a caveat and be heard against the petitions, such caveat not having been filed within the time required by the rules, was refused, on the ground that the Attorney-General represented the interests of the Crown as well as those of the public.

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard upon either side (*i*).

Subject to two qualifications—viz., that the advertisements must be proved first in the case (*k*), and that when the accounts are *primâ facie* unsatisfactory, the petition will be dealt with without reference to the merits (*l*), the Judicial Committee follows as closely as possible the rules of evidence in courts of law (*m*).

Grounds of extension.

The Grounds of Extension.—Speaking generally, the applicant must prove two things: that the invention has unusual merit, and that he has been insufficiently remunerated for his work (*n*). It is thought that the law bearing upon the subject is accurately stated in the following propositions:—

Position of Judicial Committee.

I. *As regards the extension of letters patent, the Judicial Committee consider that they represent the Legislature to a certain*

(*g*) (1835) 1 Web. P. C. 557, n. (*a*); and see *Whitehouse's Patent* (1838), *ibid.* p. 474.

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

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

(*k*) *Perkin's Patent* (1845), 2 Web. P. C. 6.

(*l*) *Saxby's Patent* (1870), L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; *In re Clark's Patent* (1870), *ibid.* 421; *ibid.* 255.

(*m*) *Erard's Patent* (1835), 1 Web. P. C. 557, n. (*a*).

(*n*) *Livet's Patent* (1892), 9 R. P. C. 327.

degree, and that they are invested with somewhat similar powers of discretion to those exercised formerly by Parliament (*o*).

The extension of letters patent has never been granted as a matter of course (*p*).

The Judicial Committee have, as a general rule, recommended an extension of the term of letters patent on grounds similar to those adopted by the Legislature, and recited in the old acts of prolongation (*q*).

But it has never been their course to put themselves precisely in the situation of the Legislature, and never to grant an extension in a case where an Act of Parliament would not have been obtained (*r*). Lord Brougham's Act was passed with the view of providing a remedy easier and cheaper than a petition to Parliament, and better in this respect, that it took account of cases which never would have prevailed on the Legislature to make a new personal law prolonging the monopoly, but meritorious enough as regards the individual, beneficial enough as regards the public, and deficient enough in remuneration, to justify interference (*s*).

Nature and merits of invention, &c.

II. *In considering their decision, their Lordships have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case* (*t*).

The Patents Act, 1883, sect. 25, sub-sect. (4), from which this proposition is taken, does not alter in this respect the practice of the Judicial Committee under the repealed Act (*u*).

What petitioner must prove.

The petitioner for the prolongation of letters patent is bound to prove—(a) that the invention is meritorious; (b) that everything in the power of the parties interested has been done to bring out the invention, and to turn it to advantage; and (c) that owing to circumstances beyond his control, he has been unable to obtain an adequate remuneration (*x*).

Invention meritorious.

(a) It is, of course, impossible to define strictly the degree of merit which will induce the Judicial Committee to extend the

(*o*) *In re Morgan's Patent* (1843), per Lord Brougham, 1 Web. P. C. 739; cp. *Erard's Patent* (1835), 1 Web. P. C. 557, n. (*a*); *In re Soames' Patent* (1843), 1 Web. P. C. 733; *Perkin's Patent* (1845), 2 Web. P. C. 18.

(*p*) *In re Jones' Patent* (1840), 1 Web. P. C. 579; *In re Derosne's Patent* (1844), 2 Web. P. C. 4; *In re Honiball's Patent* (1855), 9 Moo. P. C. 378; *Cardwell's Patent* (1856), 10 Moo. P. C. 488.

(*q*) 1 Web. P. C. 557, n. (*a*).

(*r*) *In re Morgan's Patent, ubi supra.*

(*s*) *In re Soames' Patent, ubi supra.*

(*t*) Patents Act, 1883, sect. 25, sub-sect. (4).

(*u*) *Newton's Patent* (1884), L. R. 9 App. Cas. 592; 1 R. P. C. 177.

(*x*) *Markwick's Patent* (1860), 13 Moo. P. C. 310.

term of a patent. A few leading principles may, however, be referred to with advantage.

The ordinary merit, which would sustain a patent in the first instance, is not sufficient to justify an extension of the term (*y*).

"The law presumes some merit in a patent by the mere granting of it," said Sir William Grove in the case of *Stoney's Patent* (*y*); "in practice very little merit will do, and I do not know that the . . . . law officers of the Crown, who advise the Crown, go into merit, in the sense in which it is used in this Board, further than seeing that the invention, or alleged invention, is not an absurd one. The theory, therefore, of patents is that they are granted *ex mero motu* by the Crown, on the recommendation of the legal advisers of the Crown, upon *primâ facie* novelty and *primâ facie* merit. But, to induce the lords of the Privy Council to extend a patent, there must be something more than that; in other words, there must be more merit than would merely support a patent in a court of law."

In the word "merit," as used in this connection, two distinct ideas seem to be involved—the exercise of invention or ingenuity on the part of the patentee, and the utility of the invention to the public.

These two elements are not, however, of equal importance. A patent for an invention which was "very small in point of discovery," but useful and of great benefit to the public, may be extended (*z*).

On the other hand, the Judicial Committee would probably refuse an extension of letters patent for a comparatively worthless or trivial invention, however ingenious (*a*). It has already been shown (*b*) that the importer of a highly meritorious invention may petition successfully for the prolongation of letters patent which he has obtained for it, and that the Judicial Committee will also recognize the claims of an assignee who has incurred expense in bringing a useful patent into public use.

Upon the same principle, it is not the person who merely displays ingenuity in throwing out the idea of the possibility of doing a thing, but the person who follows out that suggestion,

(*y*) *Stoney's Patent* (1888), 5 R. P. C. at p. 521, per Sir William Grove; *Swaine's Patent* (1837), 1 Web. P. C. 559.

(*z*) *Derosne's Patent* (1844), 4 Moo. P. C. 416; *Beanland's Patent* (1887), 4 R. P. C. at p. 491, per Lord Hobhouse.

(*a*) *Beanland's Patent*, *ubi supra*.

(*b*) See *supra*, p. 503.

and after repeated experiments gives it a practical application, that is the real benefactor to the public, and possesses that description of merit which constitutes one of the grounds for extending the term of a patent (*c*).

Circumstances which do not weigh against merit.

The following considerations do not weigh against the merit of an invention :—

That only a small step was made in advance of existing knowledge—the whole history of science being a continued illustration of the slow progress by which the human mind makes its advance in discovery (*d*).

That such improvements on the original invention had been made *by the patentee* (*e*) that no person would after these ever think of using the invention as it originally stood ; if such an argument were to prevail, any improvement made by the patentee upon the patent would at once take away the patentee's right to obtain an enlargement of the term (*f*).

That the patentee's invention consisted of improvements upon a former patent taken out by him in consequence of a communication from abroad, such improvements being novel and of public utility (*g*).

That the working of the invention under the original patent has been altered during the term (*h*).

Circumstances which do.

The following circumstances weigh against the merit of an invention :—

That it has not been brought into public use (*i*). The presumption arising from non-user will be considered in dealing with the duty of a patentee to employ every means of making his invention a commercial success ; but non-user is not necessarily fatal ; it may be explained (*k*).

That it would exclude the public from the use of well-known sanitary agents. This may seem a somewhat special issue to take notice of, but it has been raised in several cases, of which

(*c*) *In re Bett's Patent* (1862), 7 L. T. N. S. 577 ; 1 Moo. P. C. 49, 61 ; cp. *Woodcroft's Patent* (1846), per Lord Brougham, 2 Web. P. C. at p. 23.

(*d*) *Soames' Patent* (1843), 1 Web. P. C. 735.

(*e*) *Aliter*, where the invention in its improved form was imported by persons other than the petitioner. *Woodcroft's Patent* (1841), 1 Web. P. C. 740.

(*f*) *Galloway's Patent* (1843), 1 Web. P. C. at p. 727. The original invention must, however, have possessed utility. *Bell's Patent* (1846), 2 Web. P. C. 160.

(*g*) *Borill's Patent* (1863), 1 Moo. P. C. N. S. 348.

(*h*) *Heath's Patent* (1853), 2 Web. P. C. 247.

(*i*) *Allan's Patent* (1867), L. R. 1 P. C. 507 ; *Normand's Patent* (1870), L. R. 3 P. C. 193.

(*k*) *Southby's Patent* (1891), App. Ca. 432 ; 8 R. P. C. 433.

Sillar's Patent (*l*) may be taken as an instance. Here an extension of the patent would have prevented any members of the public from using alum, clay, and charcoal in stated proportions for the purpose of deodorizing manure. The petition was dismissed. "The question," said Sir Barnes Peacock, delivering the judgment of the Judicial Committee, "is whether this patent is of such utility as to justify the renewal of the patent, excluding the public, upon this general specification, from the use of those ingredients for the purpose of deodorizing sewage, the use of two of those ingredients—viz., alum and charcoal—being well known."

Everything done to bring invention into use.

(b) Where a patentee has *intentionally delayed* for a length of time attempting to put his invention into practice, an extension will not be recommended, unless he can show some reasonable excuse, such as want of funds, for the delay (*m*).

The fact that a patent, *in spite of the efforts of the patentee*, has not come into public and general use, raises a strong presumption against its utility (*n*). But in all cases where the utility of a patent has not been tested by actual employment the question to be considered is whether the evidence was sufficient to rebut the presumption arising from its non-use that the invention is one of no practical utility (*o*).

This presumption may, however, be rebutted by such evidence as the following:—

That, from the nature of the invention, it would not be likely to come into immediate use, or was only capable of being employed to a limited extent (*p*).

Illustrative cases.

An application on behalf of a patented knapsack was supported by very favourable reports from officers who had examined it. It was deposed that the fact of nine out of ten men in our infantry becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by

(*l*) (1882) Goodeve's Patents, 581; cp. *McDougall's Patent* (1867), L. R. 2 P. C. 1; 5 Moo. P. C. N. S. 1; *McInnes's Patent* (1868), L. R. 2 P. C. 54; 37 L. J. P. C. 23; 5 Moo. P. C. N. S. 78.

(*m*) *In re Cardwell's Patent* (1856), 10 Moo. P. C. 488; cp. *Wright's Patent* (1839), 1 Web. P. C. 575; *Southworth's Patent* (1837), *ibid.* 486; *Pieper's Patent* (1895), 12 R. P. C. 292; *Dolbear's Patent* (1896), 13 R. P. C. 203.

(*n*) *Wright's Patent* (1839), 1 Web. P. C. 575; *Simister's Patent* (1842), 4 Moo. P. C. 164; *Bakewell's Patent* (1862), 15 Moo. P. C. at p. 386; *Allan's Patent* (1867), L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Herbert's Patent* (1867), *ibid.* 300; L. R. 1 P. C. 399; *Hughes's Patent* (1879), 4 App. Ca. 174; 38 L. J. P. C. 20.

(*o*) *Ibid.*; 48 L. J. P. C. 20; *Southby's Patent* (1891), App. Ca. 432; 8 R. P. C. 433.

(*p*) *Jones's Patent* (1840), 1 Web. P. C. 577.

the patentee, but hitherto without return. The committee, allowing their doubt as to its utility, arising from its not having been adopted by the Government, to be slightly founded, in the absence of evidence of its failure, recommended its extension for five years (*q*).

A patentee presented a petition for prolongation of his patent "improvements in sluices and flood-gates." He satisfied the Judicial Committee that his invention was meritorious, but was, from its nature, only capable of being employed to an occasional or limited extent. Ten years' extension granted (*r*).

That, from circumstances beyond the control of the patentee, the merits of the patent had not been appreciated (*s*).

Illustrative cases.

(1) A patent for preserved meats was extended for five years on the grounds that the patentee had used every exertion in his power to introduce the invention, and had expended large sums in so doing, but, by reason of the distrust with which the public viewed preparations of that nature, the inadequacy of the patentee's means, and his want of influence with public boards, he had been prevented from obtaining such a fair trial as would lead to the adoption by the public of his invention (*t*).

(2) The patentee of an invention, which had never been brought into public use during the period of fourteen years, accounted for the non-user on the ground that the invention was of such a nature that it could only be carried out by a company, which he had failed to form. It was held that the explanation was not sufficient to rebut the presumption against the practical utility of the patent, and an extension of the term was refused (*u*).

(3) The patentee of a captain's bridge, constructed as a self-launching life-raft, petitioned for prolongation on the ground that, owing to illness and other circumstances beyond his control, he had not been adequately remunerated. It was proved that for nearly eight years he had been practically incapacitated for business in consequence of a railway accident. The invention had been awarded prizes at exhibitions, but had never been brought into actual use. Extension for seven years was granted (*x*).

(*q*) *Berrington's Patent* (1852), cited by Coryton, p. 225.

(*r*) *Stoney's Patent* (1888), 5 R. P. C. 520.

(*s*) *Kollman's Patent* (1839), 1 Web. P. C. 564.

(*t*) *Payne's Patent* (1854), cited in Higgins's Digest, p. 111.

(*u*) *Bakewell's Patent* (1862), 13 Moo. P. C. 385.

(*x*) *Roper's Patent* (1887), 4 R. P. C. 201.

(4) The introduction of a patent for the improvement of the spinning jenny was violently resisted by the trade, so that the patentee received no adequate remuneration during the term. Extension granted for seven years (*y*).

(5) Extension has been granted when a patentee or his assignee has been prevented by necessary litigation from reaping his reward during the original term (*z*). Disputes between the co-owners of a patent will not justify the failure of a petitioner for extension to bring the invention into public use (*a*). Negligence on the part of a patentee in restraining infringement is a good ground of opposition for extension (*b*).

That he has at all times been ready to give the public the benefit of his invention (*c*).

That the circumstances have ceased which prevented the patent from being lucrative, and that it is really coming into use (*d*).

Remuneration insufficient (*e*).

(c) A petitioner for the prolongation of letters patent must satisfy the Judicial Committee that, regard being had to all the circumstances of the case, he has not received a remuneration adequate to the merit of his invention and the time and money he has properly expended in working it (*f*). In one case it was pointed out that patentees who had received over 200,000*l*. could hardly expect prolongation; hitherto prolongation has not been allowed in any case where the patentee has obtained 20,000*l*. from his invention (*g*), but there is no binding rule.

The chief difficulty which the petitioner has to overcome is to present accounts showing, in a manner which admits of

(*y*) *Robert's Patent* (1839), 1 Web. P. C. 573; cp. *Stafford's Patent* (1838), *ibid.* 563.

(*z*) *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133; *Heath's Patent* (1853), 2 Web. P. C. 217.

(*a*) *Patterson's Patent* (1849), 6 Moo. P. C. 469.

(*b*) *Simister's Patent* (1841), 1 Web. P. C. 724.

(*c*) *Stewart's Patent* (1886), 3 R. P. C. 7, 10.

(*d*) Per Lord Brougham in *Woodcroft's Patent* (1846), 2 Web. P. C. 29. In *Foarde's Patent* (1855), 9 Moo. P. C. 376, it was held that the fact of an Act of Parliament having passed which would compel the use of the petitioner's patent formed no objection to a renewal of the term, the merits of the invention and loss incurred in carrying it out being established.

(*e*) Forms of account in a recent case, which were considered satisfactory by the Judicial Committee, are given in the Appendix, p. 861.

(*f*) *Bate's Patent* (1836), 1 Web. P. C. 739; *Southworth's Patent* (1837), *ibid.* 486; *Downton's Patent* (1839), *ibid.* 565; *Derosne's Patent* (1844), 2 Web. P. C. 1; *Nussey and Leachman's Patent* (1890), 7 R. P. C. 22; *Lake's Patent* (1891), App. Ca. 240; 8 R. P. C. 230; 60 L. J. P. C. 57.

(*g*) *Thomas's Patent* (1892), 9 R. P. C. 367.

no controversy, the amount of remuneration which in every point of view the invention has brought to him (*h*).

It is not for the Judicial Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been that he has received (*h*). In one or two cases (*i*) the hearing of a petition has been adjourned to enable a petitioner to produce better evidence as to his profits, but this was merely an exceptional indulgence, and in all probability would not again be allowed (*k*). And in one case where the accounts were imperfect, but a dead loss had clearly been incurred, prolongation was granted (*l*).

Practice as regards imperfect accounts.

The following cases illustrate the modern practice of the Judicial Committee in dealing with imperfect accounts:—

Foreign patents.

The accounts of a petitioner were silent in reference to receipts and expenditure in respect of foreign patents for the same invention, although the attention of the petitioner had been called to the omission in a notice of objection delivered by opponents. The Judicial Committee refused an adjournment and dismissed the petition (*m*).

The statement of the remuneration received by a petitioner was, on the face of the petition and accounts filed, unsatisfactory. Petition dismissed, without reference to the merits of the invention (*n*).

Full and unreserved statement of profits.

The most unreserved and clear statement of the patentee's remuneration is an indispensable condition in an application for extension (*o*). The actual expenses and receipts must be shown. It is not sufficient to show generally that there

(*h*) *Saxby's Patent* (1870), per Lord Cairns, 7 Moo. P. C. N. S. at p. 85; L. R. 3 P. C. 292. *Re Williams and Robinson's Patent* (1896), 13 R. P. C. 550. The balance-sheet should be handed over to the solicitor for the Treasury before applications for extension are heard: *Perkin's Patent* (1845), 2 Web. P. C. at p. 14, per Lord Campbell.

(*i*) *Ibid.* at p. 17; *Heath's Patent* (1853), *ibid.* at p. 256.

(*k*) *Clark's Patent* (1870), 7 Moo. P. C. N. S. 255; L. R. 3 P. C. 421.

(*l*) *Darby's Patent* (1891), 8 R. P. C. 380.

(*m*) *Newton's Patent* (1884), 1 R. P. C. 177; 9 App. Ca. 592.

(*n*) *Clark's Patent, ubi supra; Houghton's Patent* (1871), 7 Moo. P. C. N. S. at p. 311, per James, L. J.; L. R. 3 P. C. 461. The statement of accounts being *primâ facie* satisfactory, the petitioners may be allowed to prove the merits of the invention before going into the accounts: *S. C.* at p. 309; *Wield's Patent* (1871), 8 Moo. P. C. N. S. 300; L. R. 4 P. C. 89; *Johnson's and Atkinson's Patents* (1873), L. R. 5 P. C. 87; *Willacy's Patent* (1888), 5 R. P. C. 690.

(*o*) *Hill's Patent* (1863), 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; cp. *Bett's Patent* (1861), *ibid.* 49.

has been no profit (*p*), nor will it be safe to lump items together (*q*).

The applicant must show what profits have been derived from any foreign patents he may have for the invention (*r*), and also from sales for exportation (*s*).

Licensees. The profits derived by licensees from the working of the patent should sometimes also appear in the accounts of a petitioner for prolongation (*t*). Whether they should or not will depend on the particular circumstances of the case (*u*).

In a petition for prolongation of a patent, where the 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 account also of the company (*x*). This rule was not, however, insisted upon in the case of a patent of great merit and usefulness (*y*).

A patentee ought from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. The patentee knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original patent. It is not, therefore, too much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent (*z*).

In the matter of *Willacy's Patent* (*a*) the accounts did not show that the expenditure charged had been incurred with reference to the only part of the patent which was proved to possess utility, and an extension was therefore refused.

In *Yates and Kellett's Patent* (*b*) the grantees of a patent

(*p*) *Quarrill's Patent* (1840), 1 Web. P. C. 740.

(*q*) *Thomas's Patent* (1892), 9 R. P. C. 367.

(*r*) *Johnson's Patent* (1871), L. R. 4 P. C. 75; 8 Moo. P. C. N. S. 291, dissenting from *Poole's Patent* (1867), 4 Moo. P. C. N. S. 452; L. R. 1 P. C. 514; *Adair's Patent* (1881), L. R. 6 A. C. 178; *Newton's Patent* (1884), 1 R. P. C. 177; 9 A. C. 592; *Pieper's Patent* (1895), 12 R. P. C. 293.

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

(*t*) *Trotman's Patent* (1866), L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

(*u*) *Thomas's Patent* (1892), 9 R. P. C. 367.

(*x*) *Deacon's Patent* (1887), 4 R. P. C. 119; *Lawrence's Patent* (1892), 9 R. P. C. 85.

(*y*) *Ibid.*

(*z*) *Adair's Patent* (1881), L. R. 6 App. Ca. 176; 50 L. J. P. C. 68; *Lake's Patent* (1891), App. Ca. 240; 8 R. P. C. 230; *Bett's Patent* (1861–62), 1 Moo. P. C. N. S. 49, per Lord Chelmsford.

(*a*) (1888) 5 R. P. C. at p. 695.

(*b*) (1887) L. R. 12 App. Ca. 147; 57 L. J. P. C. 1; 4 R. P. C. 150; cp. *Duncan and Wilson's Patent* (1884), 1 R. P. C. 257.

petitioned for prolongation on the ground of inadequate remuneration. No accounts were presented till within a week of the hearing, and the accounts then filed were insufficient. The petitioners applied for an adjournment in order that they might amend the accounts. The Judicial Committee refused the application, and the petition was dismissed. "The explanation," said Lord Hobhouse, "given at the bar is that the patentee who has carried on this manufacture has destroyed his books, that the materials are not forthcoming out of which a better account might be made, and that the patentee was in difficulties and started afresh. The destruction of his books, for aught their Lordships know, may have been a perfectly honest and perfectly reasonable operation for him to perform, but he cannot escape from the consequences; and a man who is bound to show what his profits have been before he can come for the renewal of the patent must, if he destroys his books, destroy the very case on which he must rely for a renewal of the patent." In the absence of books, things are viewed in a light most unfavourable to the patentee (*c*).

Deductions allowed.

A petitioner for the extension of letters patent is entitled, in the petition or accounts which he submits to the Judicial Committee, to claim certain deductions from the profits made by him as patentee.

The personal expenses of the patentee for the *exclusive* devotion of his time in bringing the patent into practical operation and public notice may be deducted (*d*). Such an allowance will not be made where the whole of the time charged for has not been devoted to the extension and furtherance of the patent (*e*). An allowance may be claimed by a patentee, who is also a manufacturer, for his personal superintendence of the working of his invention (*f*).

But where the petitioner did not manufacture the patented articles, but only granted licences, a charge for his personal

(*c*) *Lawrence's Patent* (1892), 9 R. P. C. 85.

(*d*) *Carr's Patent* (1873), L. R. 4 P. C. 539; cp. *Bate's Patent* (1836), 1 Web. P. C. 739; *Roberts's Patent* (1839), *ibid.* 575; *Galloway's Patent* (1843), *ibid.* 724; *Newton's Patent* (1861), 14 Moo. P. C. 156. A patentee residing in America, for the purpose of getting the patented article into use in England, arranged with an agent in England, and in consideration gave him a moiety of the royalties. It was held, that in estimating the profits of the patentee derived from the patent such moiety must be deducted: *Poole's Patent* (1867), L. R. 1 P. C. 514; 36 L. J. P. C. 76; 4 Moo. P. C. N. S. 452.

(*e*) *Furness's Patent* (1885), 2 R. P. C. at p. 177.

(*f*) *Roberts's Patent, ubi supra; Perkins's Patent* (1845), 2 Web. P. C. 6, 17.

allowance and subsistence money while visiting and overlooking the works of the licensees was disallowed (*g*). "It was no part," said Lord Chelmsford in this case, "of the covenant with the licensees that the petitioner should superintend their operations, and if they required his assistance to instruct their workmen, they should have engaged him and paid him for his services. If they had done so, this would have constituted a fair deduction out of the profits of the licensees, and would have properly entered into the patent account."

The expenses of taking out and defending a patent, and of experiments, may be deducted (*h*).

But although law expenses incurred by the patentee in maintaining his patent rights are allowed in deduction of his profits, yet where the patentee compromised suits and gave up costs to which he had an apparent title, a deduction on that head will not be allowed (*i*).

The difference between the sum for which a patentee has sold his patent and that which he has paid in buying it again cannot be allowed in the accounts as an item of loss, but must be regarded as a mere commercial speculation (*k*).

A deduction may be allowed for profits made by the patentee as manufacturer, but not due to his monopoly (*l*).

The distinction between the manufacturing profits which a petitioner for extension may and those which he may not deduct cannot better be stated than in the following language:—

"If but for the patent there would have been no manufactory, then the net profits of the manufacturer are, in that large sense, attributable to the patent. With it the manufacturer has a monopoly. . . . . The patent may be said to create his trade; at least, it developed it to an extent which would be impossible without it" (*m*).

"It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as

(*g*) *Trotman's Patent* (1866), L. R. 1 P. C. 118.

(*h*) *Bate's Patent, ubi supra; Roberts's Patent, ubi supra; Kay's Patent* (1839), 1 Web. P. C. 568; *Galloway's Patent, ubi supra; Bett's Patent* (1861), 1 Moo. P. C. N. S. 49; *Davies's Patent* (1894), 11 R. P. C. 28.

(*i*) *Hill's Patent* (1863), 1 Moo. P. C. N. S. 258.

(*k*) *Wield's Patent* (1871), L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(*l*) *Galloway's Patent* (1843), 1 Web. P. C. 724; *Bett's Patent* (1862), 1 Web. P. C. N. S. 49.

(*m*) *Hill's Patent* (1863), 1 Moo. P. C. N. S. 258, per Lord Chelmsford.

the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacturer, and there may be patents of a different kind where there is an intimate connection with the business of the manufacturer, such that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer" (*n*).

It appears, therefore, that the manufacturer's profits which the Judicial Committee will take into consideration in estimating the remuneration of a patentee are those which could not have been made but for the preference monopoly created by the patent (*o*).

Where, however, the profits made by the patentee as manufacturer are not the profits of the monopoly, but simply the profits which any manufacturer, employed to make the patented articles, would have derived thereby, though he had no right to the patent or the monopoly, a fair deduction will be allowed (*p*).

The test above stated will be applied to profits arising from the manufacture of the materials out of which the patented articles are made (*q*), and from the sale of the patented articles (*r*).

Any deductions from profits which it is intended to claim must be set forth in the petition or the accounts, and evidence in support of claims not specifically made will not be admitted (*s*).

The practice where patentee has allowed foreign patents for the same invention to lapse.

The Committee will always have regard to the interests of the public. Therefore when the patentee has foreign patents for the same inventions, which he has allowed to lapse, the Committee will take into consideration the fact that British subjects may be unduly handicapped if prolongation is granted (*t*). Under the Act of 1852 a patent for an invention obtained after the date of a foreign patent would not have continued in force when the foreign patent expired (*u*). This Act is repealed. Therefore if application be made to prolong a patent, and at least six months remain before the original patent expires, the application may be under sect. 25 of the Act of 1883, and therefore in such case the Act of 1852 will not hamper the discretion of the Privy Council in granting or refusing an extension. But if the application be

(*n*) *Saxby's Patent* (1870), per Lord Cairns, L. R. 3 P. C. 292.

(*o*) *Muntz's Patent* (1846), 2 Web. P. C. 113.

(*p*) *Galloway's Patent* (1843), 1 Web. P. C. 724.

(*q*) *Norton's Patent* (1881), Eng. Rep. Jan. to Mar., 1881, xvi.; Lawson, p. 90.

(*r*) *Bailey's Patent* (1884), 1 R. P. C. 1.

(*s*) *Ibid.*

(*t*) *Semet and Solvay's Patent* (1895), App. Ca. 78; 64 L. J. Ch. 41; 12 R. P. C. 10.

(*u*) *Pieper's Patent* (1895), *ibid.* 293; 1852, sect. 25.

made within six months of the termination of the original fourteen years, then the right to prolongation exists only where the patent was granted before 1884 and is preserved by sect. 113; and if this section be prayed in aid, the Act of 1852 applies, and sect. 25 of that Act will prevent a prolongation where a foreign patent has lapsed which was granted for the invention prior to the English grant (*x*).

Where the English patent was prior in date to the foreign one, the Committee may exercise the ordinary discretionary powers (*y*).

Case of *primâ facie* validity must be made out.

It is not the practice of the Judicial Committee to decide upon the novelty or utility of a patent, although it will of course abstain in any case from prolonging a patent which is manifestly bad; it is for the petitioner to make out a case of *primâ facie* validity (*z*).

Cases.

A petition was presented for the prolongation of a patent on the ground that the patentee had been inadequately remunerated. The merit of the invention was proved, and the inadequacy of the remuneration was not seriously disputed, but objections were taken to the novelty of the invention and the sufficiency of the specification, and it was suggested that the patent, if prolonged, should be made subject to the compulsory licences clause of the new Patents Act, 1883. The objection was repelled, and the patent extended for five years without conditions (*a*).

S., being the patentee of an invention for "improvements in sugarcane mills," petitioned for the prolongation of his patent on the ground of having sustained an actual loss in working it. M. & Co. and others opposed, and tendered evidence to show anticipations by machines made by W., and by the publication in England of the American specification of H. Extension refused (*b*).

A petition for prolongation stated that various legal proceedings

(*x*) *Jablochkoff's Patent* (1891), App. Ca. 293; 8 R. P. C. 281; 60 L. J. P. C. 61.

(*y*) *Semet and Solvay's Patent* (1895), App. Ca. 78; 64 L. J. P. C. 41; 12 R. P. C. 10; *Livet's Patent* (1892), 9 R. P. C. 327; *Marshall's Patent* (1891), App. Ca. 430.

(*z*) Per Lord Cairns in *Saxby's Patent* (1870), L. R. 3 P. C. 294; cp. *Erard's Patent* (1835), 1 Web. P. C. 557, n. (*a*); *Hill's Patent* (1863), 1 Moo. P. C. N. S. 258; *Stoney's Patent* (1888), 5 R. P. C. at p. 522; *Kay's Patent* (1839), 1 Web. P. C. 568; *Galloway's Patent* (1843), *ibid.* 725; *Woodcroft's Patent* (1846), 2 Web. P. C. 18; *Pinkus's Patent* (1848), 12 Jur. 234; *Bett's Patent* (1862), 1 Moo. P. C. N. S. 49; *McDougal's Patent* (1867), 5 Moo. P. C. N. S. 1; L. R. 2 P. C. 1; *McInnes's Patent* (1868), *ibid.* 72; L. R. 2 P. C. 54.

(*a*) *Cocking's Patent* (1885), 2 R. P. C. 153. The utility of an invention is of more importance than its novelty for the purpose of a successful petition for prolongation: *Church's Patent* (1886), 3 R. P. C. 95.

(*b*) *Stewart's Patent* (1886), ibid. 7.

had been taken and were still pending, but that the petitioner could not postpone his application until their decision, as the patents were nearly expired. The petition further stated that, by reason of litigation and expenses incurred, the inventor had not been adequately remunerated. Extension for three years granted (*c*).

Period of extension: generally seven years, but ten or even fourteen years under special circumstances.

The Judicial Committee does not usually recommend extensions for periods of more than seven years, the usual practice being to extend the period either for five or seven years. But in exceptional cases the seven years' limit has been exceeded, and ten or even fourteen years' extension has been granted. *Moncrieff's Patent* for gun-carriages was extended fourteen years, and *Stoney's Patent* (*d*) for improvements in sluices or flood-gates was extended ten years on the ground that from its nature it was capable only of limited and occasional use.

When an extension has been once recommended, and new letters patent granted, the power of the Judicial Committee is exhausted, and they have no jurisdiction to entertain a petition for a further prolongation of the term (*e*).

If the Judicial Committee report that the patentee has been inadequately remunerated by his patent her Majesty in Council may extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years, or order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee think fit (*f*).

It is now (*g*) the practice of the Judicial Committee to prolong letters patent by ordering a new grant to be made for the extended term (*h*).

In order that the exact relations of the new to the original letters patent may be understood, the following points must be noticed:—

Renewed letters patent are not void, if dated after the expiration of the original term (*i*).

(*c*) *Kay's Patent* (1839), 1 Web. P. C. 568; cp. *Heath's Patent* (1853), 2 Web. P. C. 247.

(*d*) (1888) 5 R. P. C. 518.

(*e*) *Goucher's Patent* (1865), 2 Moo. P. C. N. S. 532.

(*f*) Patents Act, 1883, sect. 25, subsect. 5.

(*g*) As to extension of a patent for an invention patented abroad, see *Bodmer's Patent* (1853), 8 Moo. P. C. 282; *Aube's Patent* (1854), 9 Moo. P. C. 43; *Bett's Patent* (1861), 1 Moo. P. C. N. S. 49.

(*h*) *Cocking's Patent* (1885), 2 R. P. C. at p. 152; *Stoney's Patent* (1888), 5 R. P. C. at p. 524. For the form of new grant in *Stoney's Patent* see Appendix, p. 866.

(*i*) *Russell* v. *Ledsam* (1845), 14 M. & W. 574, decided under 5 & 6 Will. IV. c. 83, s. 4.

As a matter of fact, the new letters patent are ordered to be sealed by the comptroller-general with the date of expiration of the original patent. The order in Council (*k*) prolonging the patent usually fixes the time within which application may be made for the new letters patent.

It is not necessary that a new specification of the extended patent should be filed (*l*). It appears that no renewal fees are payable.

The new patent will be subject to sects. 22 and 27 of the Patents Act, 1883, as to compulsory licences and patents binding the Crown (*m*).

In the case of *Bovill* v. *Finch* (*n*) separate patents had been granted to Bovill in England, Scotland, and Ireland previous to the passing of the Patent Law Amendment Act, 1852. By that Act and its amending Act, 16 & 17 Vict. c. 115, it was provided that the letters patent granted for the prolongation of a patent should for the future be sealed with the Great Seal of the United Kingdom, and be of force in the whole of the United Kingdom. Letters patent were subsequently granted, sealed with the Great Seal of the United Kingdom, prolonging for a term of five years from their expiration the privileges granted by the three patents above mentioned. It was held that the effect was the same as if the three patents had been separately prolonged, and the fact of one of the original patents being void for want of novelty would not prevent the letters patent being valid as a prolongation of the other patents (*o*).

Reservations in new grant.

The following cases illustrate the nature of "the restrictions, conditions, and provisions" which the Judicial Committee may insert in a new grant of letters patent. There is nothing in the statute 5 & 6 Will. IV. c. 83 to fetter the discretion of the Crown in the renewal, except the length of term (*p*).

Cases.

Patent with several claims.

Letters patent comprised three separate subjects. Upon an application for extension, one only of the three subjects appeared to the Judicial Committee to be deserving of a renewed grant. Prolongation was granted, under 15 & 16 Vict. c. 83, s. 40, as to that part alone (*q*).

(*k*) Appendix, p. 865.

(*l*) *Wasteney Smith's Patent* (1885), 2 R. P. C. 14.

(*m*) *Ibid.*; but see *Cocking's Patent*, *ubi supra*. Conditions allowing the Crown to use the invention patented were formerly inserted in the new grant: *Pettit Smith's Patent* (1850), 7 Moo. P.C. 133; *Carpenter's Patent* (1854), 2 Moo. P. C. N. S. 191, n.; *Lancaster's Patent* (1864), *ibid.* 189.

(*n*) (1870) L. R. 5 C. P. 523; L. J. C. P. 277.

(*o*) See also *In re Bovill's Patent* (1863), 1 Moo. P. C. N. S. 348.

(*p*) *Ledsam* v. *Russell*, 1 H. L. Ca. 687.

(*q*) *Lee's Patent* (1856), 10 Moo. P.C. 226; cp. *Bodmer's Patent* (1853), 8 Moo.

Assignees.

A petition for extension was presented by an assignee. (a) The patentee had made nothing by his patent. The Judicial Committee required the assignee to secure an annuity or a share of the profits to the inventor or his representatives (*r*); (b) Valuable consideration had been given for the assignment, and the assignee had sustained considerable loss. Prolongation was granted unconditionally (*s*).

Action for infringement before patent sealed.

A patentee, having obtained an extension warrant, neglected to get the patent sealed. A subsequent petition to the Crown by a foreigner to revoke this warrant was dismissed on condition of the payment by the patentee of the petitioner's costs, and that no action should be brought for any infringement between the date of the warrant and the subsequent petition. There was held to be jurisdiction under 3 & 4 Will. IV. c. 41 (*t*).

Licences.

A patentee, formerly in partnership with J. and W., by a deed of dissolution, stipulated that J. and W. should have the exclusive right of granting, in certain cases therein provided, licences for manufacturing the patent article. In recommending an extension of the term of the patent the Judicial Committee imposed a condition upon the patentee to secure to J., in whom the interest in the deed of dissolution then vested, the same interest in the new letters patent in regard to the granting of licences as was provided by the deed of dissolution; but refused to allow J. to substitute new licences for those granted under the original letters patent in the event of the original licensees declining to renew their licences from him under the new grant (*u*).

Prices.

Disclaimer.

A successful petitioner for prolongation has been required (a) to grant licences to the public upon terms similar to one already granted by him (*x*); (b) to sell the patented article at a certain fixed price (*y*); (c) to disclaim all the parts of the original

P. C. 282; *Church's Patent* (1886), 3 R. P. C. at p. 102; Joy's Patent (1893), 10 R. P. C. 89. See also *Metford's Patent* (1879). 48 Engineer, 15.

(*r*) *Whitehouse's Patent* (1838), 1 Web. P. C. at p. 476; *Russell* v. *Ledsam* (1845–48). 14 M. & W. 574; *Hardy's Patent* (1849), 6 Moo. P. C. 441; *Markwick's Patent* (1860), 13 Moo. P. C. 310; *Herbert's Patent* (1867), 4 Moo. P. C. N. S. 300: L. R. 1 P. C. 399; *Pitman's Patent* (1871), L. R. 4 P. C. 87; *Morton's Patent* (1881), Eng. Rep. April to June, 1881, vii.

(*s*) *Bodmer's Patent* (1849), 6 Moo. P.C. 468. "Terms are only imposed upon the assignee where the inventors and patentees have made nothing by their invention," per Lord Brougham, *ibid.* p. 469.

(*t*) *Schlumberger's Patent* (1853), 9 Moo. P. C. 1.

(*u*) *Normandy's Patent* (1855), *ibid.* 452.

(*x*) *Mallet's Patent* (1866), L. R. 1 P. C. 308; 4 Moo. P. C. N. S. 175; *Lyon's Patent* (1894), 11 R. P. C. 537.

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

patent not worked out (*z*); (d) to procure the surrender of an exclusive licence (*a*); (e) to undertake to give security over the prolonged patent to his mortgagee (*b*).

In *Dixon* v. *London Small Arms Co.* (*c*) it was held that private contractors, not being servants or agents of the Crown, could not use a patented invention of another in manufacturing articles for the Government service. This led in some cases to the insertion of a reservation in favour of the Government and its contractors in some new grants by the Judicial Committee, where the invention was likely to be of use in the Government service (*d*).

The person in whose favour an order for the extension of a patent has been made is required to leave forthwith at the Patent Office an office copy of such order (*e*).

Costs.

Costs.—In dealing with the question of costs, the Judicial Committee acts upon the principle that *bonâ fide* opposition ought rather to be encouraged than discountenanced (*f*).

The costs of successful opposition are, therefore, allowed unless the Judicial Committee is dissatisfied with the manner in which the opposition has been conducted, *e.g.*, where much expense was occasioned by the opponent's relying upon patents for inventions which bore no resemblance to the patent in question, or producing discreditable witnesses, or otherwise prolonging the inquiry (*g*).

Again, costs of opposition will in general be allowed when the petitioner abandons his application for extension (*h*).

(*z*) *Bodmer's Patent* (1853), 8 Moo. P. C. 282.

(*a*) *Shone's Patent* (1892), 9 R. P. C. 438; *Lyon's Patent* (1894), 11 R. P. C. 537; and see *Darby's Patent* (1891), 8 R. P. C. 380.

(*b*) *Church's Patent* (1896), 3 R. P. C. 95.

(*c*) (1875) L. R. 1 App. Ca. 632; 46 L. J. Q. B. 617.

(*d*) See *Napier's Patent* (1881), L. R. 6 App. Ca. p. 174, where a reservation in favour of the Government and its contractors was inserted; and see also *Hughes's Patent*, L. R. 4 App. Ca. 174, where a similar condition was inserted to that in *Palliser's Patent*. This condition in *Palliser's Patent* was as follows:—"Upon condition that the officers of her Majesty's Government, and all persons who may from time to time contract for the supply of ordnance and projectiles for her Majesty's service in respect of work done in the execution of such contracts, shall be at liberty to use the same invention or inventions during the continuance of the new letters patent."

(*e*) Patents Rules, 1890, rule 74, *infra*.

(*f*) *Wield's Patent* (1871), 8 Moo. P. C. N. S. at p. 304; L. R. 4 P. C. 89; cp. *Westrupp and Gibbins's Patent* (1836), 1 Web. P. C. 556.

(*g*) *Muntz's Patent* (1846), 2 Web. P. C. 113; *Honiball's Patent* (1855), 9 Moo. P. C. 378.

(*h*) *Macintosh's Patent* (1837), 1 Web. P. C. 739; *Bridson's Patent* (1852), 7 Moo. P. C. 499; *Hornby's Patent* (1853), *ibid.* 503; *Milner's Patent* (1854), 9 Moo. P. C. 39; *Morgan Brown's Patent* (1886), 3 R. P. C. 212. When the petition is abandoned, it is not necessary that the opposers should serve the petitioners with notice of their intended application to the Court for costs of opposition: *Bridson's Patent*, *ubi supra*.

In a doubtful case, which caused the Judicial Committee great difficulty, no costs were given to the successful petitioner (*i*).

Costs will be given to a successful petitioner where there was no ground for opposition (*k*).

Where there are several opponents representing the same kind of opposition, one set of costs, to be apportioned between them by the Registrar of the Privy Council, will be allowed (*l*). Upon the other hand, where the objections of several opponents are quite distinct, separate costs may be awarded to each (*m*). It is not unusual to grant a lump sum for costs, in which case a taxation is avoided.

(*i*) *Church's Patent* (1886), 3 R. P. C. 95.

(*k*) *Downton's Patent* (1839), 1 Web. P. C. 567.

(*l*) *Milner's Patent* (1854), 9 Moo. P. C. 39; *Jones's Patent* (1854), *ibid.* 41; *Hill's Patent* (1863), 1 Moo. P. C. N. S. 258; *Wield's Patent* (1871), *ubi supra*; *Johnson's Patent* (1871), 8 Moo. P. C. N. S. 282.

(*m*) *Newton's Patent* (1881), Eng. Rep. Jan. to Mar. 1881.

CHAPTER XVII.

CONFIRMATION OF PATENTS.

No confirmation except by special Act before 1835.

It has always been the law that it is necessary for the validity of a patent that the invention should be new as well as that it should be useful, and if it can be proved that the invention has been practised publicly by any person before the letters patent are granted, the patent is invalid (*a*). The hardship which this rule of law may cause in certain cases was well explained in the evidence of one of the witnesses (*b*) before the Parliamentary Committee of 1829 (*c*): "It very often happens that a person—I will say ten years ago—invents a machine which for want of just exactly the right thing does not act; he tries it; it is a complete failure; the thing is thrown by. Some eight or ten years afterwards everybody (I will say that it is an invention for the spinning of cotton) is trying who can save an hour in the spinning of cotton; it is likely a second person may invent the same thing, or may catch at the same principle; he adopts a different mode of carrying it into effect, and being a little more clever than the other, he hits on the point the other wanted, and makes his a most valuable invention: he takes out his patent for it. Away comes the other man who ten years ago invented something that involved some few of the parts this new invention does; he says, 'I made such and such wheels, and put them together for the same purpose, ten years ago. I did this much of it,' and that patent is upset."

Prior to 1835, there was no power in the Crown to confirm or render valid letters patent in such a case, and the only remedy was by a special Act of Parliament.

Lord Brougham's Act.

With a view to relieve patentees against this hardship, the statute 5 & 6 Will. IV. c. 83, s. 2 (*d*), passed in 1835, provided that "if in any suit or action it shall be proved or specially found that any person who shall have obtained letters patent for

(*a*) *In re Card's Patent* (1848), per Lord Campbell, 6 Moo. P. C. 212; 2 W. P. C. 161.

(*b*) Mr. Benjamin Rotch.

(*c*) Pp. 113, 114.

(*d*) See *infra*, pp. 752, 753.

any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assignees to petition his Majesty in Council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council." The section then goes on to state the *grounds* upon which this discretionary power may be exercised, viz., that the patentee believed himself to be the first and original inventor, and that the invention or part thereof had not been publicly and generally used before the date of the letters patent which it was sought to confirm.

Grounds for confirmation by Privy Council.

The following are the chief points of interest in connection with the confirmation of letters patent which are not provided for in the new Act, and on which, therefore, it may be sufficient to dwell very lightly:—

(1) If the defect in the patent could be cured by disclaimer or memorandum of alteration, confirmation would not be granted (*e*). Cases.

(2) The petition for confirmation was required to admit the invalidity of the patent, and the petitioner ought not to bring an action for infringement before confirmation, the two proceedings being contradictory (*f*).

(3) The petitioner had to satisfy the Judicial Committee (a) that he believed himself to be the true and first inventor (*g*), and (b) that the invention was not publicly and generally used prior to the date of his patent (*h*).

(4) The Act was meant to apply to the case of an invention abandoned, and not in use at the time of the patent; and if those conditions were absent, the Judicial Committee would not exercise its discretion, even although the person who had publicly used the invention prior to the date of the patent consented to the confirmation (*i*).

(*e*) *In re Westrupp and Gibbins's Patent* (1836), 1 Web. P. C. 555.

(*f*) *In re Stead's Patent* (1846), 2 Web. P. C. 147.

(*g*) *In re Honiball's Patent* (1855), *ibid.* 201; *In re Card's Patent* (1848), *ibid.* 161.

(*h*) *Ibid.*

(*i*) *In re Lamenaude's Patent* (1850), *ibid.* 164.

(5) Where it appeared on a petition for confirmation that part of the patentee's invention formed the subject of an expired French patent, but that it had never been used or known in England otherwise than by a description in a book published in France, a copy of which was in the British Museum, notice of the day of hearing was directed to be given to the French patentee, and on an affidavit that such notice had been sent through the post-office, directed to Paris, confirmation was recommended (*k*).

(6) The confirmation merely obviated objections arising from prior user or publication, leaving the patent still open to all other objections to which it might be liable (*l*).

Where, however, the prior publication was that of two prior patents which had not been publicly or generally used, Lord Lyndhurst said that he did not think the Act was intended to apply to such a case. The petitioner might have gone to the office and seen the prior specifications (*m*).

Confirmation since the Act of 1883.

This Act of 5 & 6 Will. IV. c. 83 was repealed by the Patents Act, 1883, so that there can now be no confirmation except by special Act of Parliament, at least so far as patents granted under the Act of 1883 are concerned. But confirmation may still be applied for so far as patents obtained under the Act of 1852 are concerned (*n*), provided that, if a previous patent for the same invention has been obtained in a foreign country, application for confirmation must be made before the foreign protection expires (*o*).

Brandon's Patent.

The decision in *Brandon's Patent* (*p*), which has already been referred to (*q*), shows that all rights or privileges of patentees under the Act of 1852 are preserved; and confirmation and prolongation in the cases contemplated by 5 & 6 Will. IV. c. 83 are equally such rights or privileges. There have been, however, no petitions for confirmation of patents granted under the Act of 1852 presented since the Act of 1883.

Confirmation in cases not provided for in Act of 1835.

The statute of Will. IV. only applied to cases where the patent was void by reason of prior user or invention, and there was no provision for confirming or rendering valid a patent void for any

(*k*) *In re Heurteloup's Patent* (1836), 1 Web. P. C. 553.
(*l*) Hindmarch, p. 201.
(*m*) *Wells's Patent*, 1 Web. P. C. 554.
(*n*) 1883, sect. 113.
(*o*) *Re Jablochkoff's Patent* (1891), App. Ca. 294; 8 R. P. C. 281; 60 L. J. P. C. 61.
(*p*) (1884) 1 R. P. C. 154; 9 App. Ca. 589.
(*q*) See previous chapter.

other reason. In such cases it was therefore necessary to apply to Parliament for a special Act. Two such Acts were passed prior to the Act of 1852, and patents were declared valid where the specification had been enrolled after the six months, provided by the letters patent (*r*).

Non-payment of renewal.

After 1852 the fees on patents were paid in two instalments of 50*l*. and 100*l*. before the end of the third and seventh years. In order to revive a patent which had been allowed to lapse owing to non-payment of the stamp duty within the prescribed time, it was necessary to apply to Parliament, and a considerable number of special Acts were obtained with this object between 1852 and 1884 (*s*).

Since the Act of 1883, sect. 17, the comptroller has power to enlarge the time for payment of the renewal fees, and in consequence it appears that very few Acts will in future be passed confirming patents void for non-payment of renewal fees. In 1887 three Bills were introduced for confirming letters patent void for non-payment of renewal fees, and a Select Committee reported on the whole matter (*t*).

Select Committee, 1887.

Recommendations of Committee.

Previous to 1887 there were three confirming Acts in 1884 (*u*), and one in 1885 (*x*); but in 1887 the Select Committee reported that, having regard to the Act of 1883, sect. 17, in future no private Act to confirm letters patent should be allowed to proceed where the excuse offered for default in payment of a renewal fee falls short of serious illness or some other cause for which the patentee ought not to be held responsible, and which may sufficiently account for the non-payment otherwise than by neglect, inadvertence, or mistake.

The Committee further reported that a person beneficially interested in a patent should be held responsible for default in registered patentee or his agents, also that where any Bill is entertained clauses should be inserted for the protection of persons who may have availed themselves of the subject-matter

(*r*) *Westhead's Patent*, where the specification was enrolled five days late. The Act was passed in 1849, seven months after the forfeiture, and contained no saving clause. In *Laird's Patent* the specification was enrolled one day late, but the Act was not passed till 1851, which was seven years after the forfeiture. In this Act there was a saving clause. See Report of Select Committee House of Lords on Potter's Patent Bill, &c., in 1887, at p. 43.

(*s*) See Report, &c., *supra*, last note. A list of these Acts is there given. See also Official Journal of Patent Office of December 23, 1884.

(*t*) Report of Select Committee on Potter's Patent Bill, Skrivanow's Patent Bill, and Gilbert and Sinclair's Patent Bill, House of Lords, 1887.

(*u*) Wright's Patent Act, Boult's Patent Act, and Bradbury and Leman's Patent Act.

(*x*) Auld's Patent Act.

of the patent after it has been announced as void in the Official Journal (*y*).

Potter's Patent Act, 1887.

The Committee allowed Potter's Patent Bill to proceed, being satisfied that non-payment of the renewal fees arose from serious illness of the applicant, and not from neglect, inadvertence, or mistake.

Since this date, several Bills have been before the House, and the rules above set out have been followed, though their application has not been characterised with extreme rigidity. In 1891, Worms and Bale's Act (*z*) was passed to confirm a patent and to allow it to be antedated, so as to avoid the effect of the prior publication in this country of an abridged American edition of the specification. The case seems to have been one which fell within the equity of sect. 103, though outside the letter; hence probably the special indulgence.

In 1892 came a batch of statutes confirming several patents which had lapsed owing to non-payment of fees. The default was caused by the fraud of a patent agent, to whom the requisite money had been given by the respective inventors, and who had failed to use it for the purpose of paying the fees. Special provisions will be found in all these Acts for the protection of those who, acting under *bona fides* after the patent had lapsed, had infringed the patent, or had spent money on preparations to infringe it (*a*).

(*y*) The clauses suggested are set out in Potter's Patent Act, 1887, sect. 2, Appendix, p. 869.

(*z*) 54 & 55 Vict. c. 182.

(*a*) See Nussey and Leachman's Act, 55 & 56 Vict. c. 115; Horsfall's Act, *ibid.* c. 114; Whitehead's Act, *ibid.* c. 116; Simpson and Fawcett's Act, *ibid.* c. 129.

CHAPTER XVIII.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International recognition of rights of inventors.

For at least ten years prior to the Act of 1883, there had been a strong opinion, both in England and in other countries, in favour of an attempt to create an international patent law, or at least some international recognition of the rights of inventors (*a*).

Select Committee, 1872.

Adopting to some extent the views expressed in 1871 by Sir H. Bessemer and Sir William Armstrong, and again in 1872 by Mr. C. W. Siemens and others, the Select Committee of 1872 recommended that there should be an assimilation in the law and practice in regard to inventions amongst the various civilised countries of the world, and that her Majesty's Government should be requested to inquire of foreign and colonial Governments how far they were ready to concur in international arrangements in relation thereto.

Circular to British colonies.

A circular, dated August 31st, 1872, was, in accordance with this recommendation, addressed to the governors of the British colonies by the Earl of Kimberley, then Colonial Secretary, and the replies received thereto were in the main favourable (*b*).

Reports on foreign patent laws.

At the same time (*c*), her Majesty's representatives abroad were directed by Lord Granville to prepare succinct reports upon the patent laws of the countries to which they were severally

(*a*) As early as 1851, an association called the "Association of Patentees" sought to include in their list of reforms of the patent law "international arrangements for a mutual recognition of the rights of inventors." It was suggested, among other proposals, that (1) where any person patented an invention in one country that person or his assignees should have the sole and exclusive title to a patent for the same invention in every other country for the space of six months after the date of his original patent; and (2) patents of importation in the name of parties other than the inventor or his assignees should be abolished in every country. The latter suggestion was supported on the ground that every improvement or discovery made in one part of the civilised world is, sooner or later, made known by the public journals in every other part; and it ought not, therefore, to be permitted to any one (except the inventor or his assignees) to step in and deprive the public of what is likely to be communicated to them in due course.

The above shows that the ideas underlying the Convention are much older than is popularly supposed. The Convention considerably modified the position of importers.

(*b*) Correspondence respecting International Arrangements, May, 1874 (C. 999).

(*c*) By circular of August 14th, 1872.

accredited, and these reports were published and laid before Parliament in 1873 (*d*).

International Convention, 1883.

The International Congress at Vienna in 1873 and the Paris Congress of 1878 (*e*) carried the movement towards an international patent law considerably further; and on March 20th, 1883, an international convention for the protection of industrial property was signed at Paris (*f*). The necessary ratifications were exchanged by the plenipotentiaries of the contracting parties on June 6th, 1884, and the Convention came into effective operation a month later (*g*).

The original signatories.

The original signatories were the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland. Great Britain was not included. Indeed, it was necessary that statutory power should be given to the Crown to allow the antedating of the patent, which might otherwise be void by reason of anticipation.

Power for her Majesty to make arrangements with foreign states.

By the Patents Act, 1883 (*h*), it was provided that if her Majesty is pleased to make any arrangement with the Government or Governments of any foreign state or states for the mutual protection of inventions (*i*), any person who has applied for protection for any invention in any such state shall be entitled to a patent for his invention in priority to other applicants, and such patent shall have the same date as the date of the application (*k*) in such foreign state.

Seven months' priority.

The application in England must be made within seven months from the date of application in the foreign state with which the arrangement is in force.

(*d*) Reports of her Majesty's Secretaries of Embassy and Legation respecting the law and practice in foreign countries with regard to inventions, 1873 (C. 741).

(*e*) Organised during the Exhibition of 1878.

(*f*) See the text of the Convention, pp. 723 *et seq.*

(*g*) The contracting parties agreed to interfere as little as possible with the particular laws of the different states. The first principle was to ask only from each country the same treatment for subjects of each of the other countries as was accorded to their own subjects. The Convention was in no way based upon the principle of strict reciprocity, and uniform regulations were only insisted upon where they were considered indispensable in order to obtain effective reciprocal protection. Not only was it agreed to permit each state to maintain its own law without modification, except on the above points, but countries—*e.g.*, Holland, Switzerland, and Servia—were admitted in which all branches of industrial property were not at the time and are not now protected.

(*h*) Sect. 103.

(*i*) The section deals also with trademarks and designs, which are foreign to the present work.

(*k*) The words *date of application* were, at the instigation of Lord Herschell, substituted by sect. 6 of the Act of 1885 for the words *date of the protection obtained*, which appear in sect. 103; cp. *L'Oiseau and Pierrard*, per Webster, A.-G. (1887), Griff. A. P. C. at p. 39.

No action for infringement till complete specification accepted.

The patentee, moreover, will not be entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in this country (*l*).

Publication during the seven months.

The publication in the United Kingdom or the Isle of Man during the seven months aforesaid of any description of the invention, or its use therein during such period, shall not invalidate the patent which may be granted (*m*).

Application, how to be made.

The application for the grant of a patent under these provisions must be made in the same manner as the ordinary application for the British patent (*n*).

Order in Council.

These provisions are, moreover, to apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*o*).

Her Majesty's Government acceded to the Convention (*p*), so far as Great Britain and Ireland are concerned, on the 17th March, 1884, and reserved power to subsequently accede on behalf of the Isle of Man (*q*), Channel Islands, or any of her Majesty's possessions. The accession was accepted (*r*) on the 2nd April following. By an Order in Council (*s*) dated the 26th June, 1884, the provisions of the Patents Act, 1883, s. 103, were applied to the countries then signatories to the Convention, and the Order took effect from the 7th July, 1884.

Subsequent withdrawals and accessions.

There have been subsequent accessions to and withdrawals from the Convention (*t*).

Colonial arrangements.

Provision for colonies and India.

As most of the British possessions have now patent laws of their own, it was necessary to make provisions for mutual protection of inventions between the colonies and Great Britain, and accordingly the Act of 1883 (*u*) provides that where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country it shall be lawful

(*l*) Sect. 103, sub-sect. 1.

(*m*) *Ibid.* sub-sect. 2.

(*n*) *Ibid.* sub-sect. 3. This, however, is not quite the fact, as several other matters have to be considered, and special forms of procedure are prescribed by Patents Rules, 1890, rules 24—29. See p. 691.

(*o*) *Ibid.* sub-sect. 4. Orders in Council have been issued.

(*p*) For text of Convention, see pp. 723 *et seq.*

(*q*) By this reservation on behalf of the Isle of Man the patent granted to foreigners in countries which are signatories to the International Convention is not co-extensive with the ordinary grant, which extended to the Isle of Man.

(*r*) See p. 619.

(*s*) See pp. 620, 621.

(*t*) Art. XVI. of the Convention provided for subsequent adhesions, Art. XVIII. for subsequent withdrawals.

(*u*) Sect. 104.

for her Majesty from time to time by Order in Council to apply the provisions of sect. 103 as to international arrangements, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

Effect of Order in Council.

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.

The position of Great Britain with regard to arrangements made under sects. 103 and 104 may be presented most conveniently in tabular form:—

Foreign State or Colony.	Date of Order in Council.
Belgium	26 June, 1884.
Brazil	26 June, 1884.
Denmark (including the Faroe Islands)	20 Nov., 1894.
Dominican Republic	21 Oct., 1890.
France	26 June, 1884.
Italy	26 June, 1884.
Mexico	28 May, 1889.
Netherlands	26 June, 1884.
Netherlands (East Indian Colonies)	17 Nov., 1888.
Netherlands (Curaçao and Surinam)	17 May, 1890.
New Zealand	8 Feb., 1890.
Norway	See below.
Paraguay	24 Sept., 1886.
Portugal	26 June, 1884.
Queensland	17 Sept., 1885.
San Domingo	27 Jan., 1885.
Servia	26 June, 1884.
Spain	26 June, 1884
Sweden and Norway	9 July, 1885
Switzerland	26 June, 1884
Tasmania	30 April, 1894.
Tunis	26 June, 1884.
United States.	12 July, 1887.
Uruguay	24 Sept., 1886.
Western Australia	11 May, 1895.
Zanzibar	16 May, 1893.

[An international office in connection with the Convention has been established at Berne, where a monthly periodical, entitled "La Propriété Industrielle," is published.]

Conferences under International Convention.

The International Convention provided for conferences being held successively in one of the contracting states by delegates of the said states, with a view to improvements upon the system of the Union (*x*).

(*x*) Art. XIV.

The first meeting took place in Rome in April and May, 1886 (*y*), and the second at Madrid in April, 1890.

Rules for application under sects. 103 and 104.

Rules prescribing the formalities to be observed in applications for patents made under the international and colonial arrangements were issued by the Board of Trade and duly laid before Parliament on the 11th May, 1888, were published four days later, and came into force on 1st June, 1888. They are now Rules 24—29 of the Patents Rules, 1890.

General scope of International Convention.

The provisions of the International Convention, so far as relates to patents, may be shortly summarised as follows:—

Priority.

1. An applicant for a patent in any one of the contracting states can obtain protection in any of the other contracting states by application there within a period of six, or in the case of countries beyond the seas of seven, months from the date of his first application. The subsequent application is antedated to the date of the first application; and is, consequently, not defeated, as otherwise it would have been, by prior publication or user in the protected interval (*z*).

Importation.

2. Formerly a patentee could not introduce into some of the states of the Union articles manufactured according to his patent in this or other countries without forfeiture of his rights. Free importation of such articles without the penalty of forfeiture is now allowed, but the patentee remains bound to "work" his patent in conformity with the laws of the country into which he introduces the patented articles (*a*).

Exhibitions.

3. Temporary protection is accorded by each of the contracting states to patented articles exhibited at official or officially recognised international exhibitions (*b*).

International office.

4. An international office in connection with, and under Art. XIII. of the Convention, has been established at Berne, Switzerland. Its expenses are defrayed by the Governments of all the contracting states, its functions are determined by

(*y*) The British delegates on this occasion were the comptroller-general (Mr. H. Reader Lack) and Mr. J. H. G. Bergne, of the Foreign Office, assisted by Mr. C. Belk, the Master Cutler of Sheffield, and Mr. H. Hughes, secretary of the Sheffield Chamber of Commerce.

The following addition to the Convention, in so far as it relates to patents, was agreed upon: to Art. V., "Each country shall decide the meaning of the word *exploiter* for itself."

The number of applications under the provisions of the International Convention amounted to twenty-six in 1887, and to seventy-one in 1888.

(*z*) Art. IV.

(*a*) Art. V.

(*b*) Art. XI. The Act of 1886 gave her Majesty power, by Order in Council, to declare the provisions of Act 1883, sect. 39, applicable to foreign exhibitions. For the Order in Council in case of Paris Exhibition, 1889, see p. 872.

agreement between them, and it publishes a monthly periodical entitled *La Propriété Industrielle* (*c*).

Legal effect of Orders in Council under sect. 104.

The legal effect of arrangements made for the colonies and India by Order in Council, under sect. 104, is clear, because the Order in Council may vary or add to the provisions of sect. 103; and the Order in Council is to be read with the Act as if it were contained in it. The Order in Council and sect. 103 will, therefore, be read together, and construed in the same manner as any other statutory enactment.

General relation of Convention to laws of contracting states.

But it is a matter of no little difficulty to determine the precise relation which the International Convention bears to the laws of the contracting states. The position of the Convention will probably vary, in different countries, according to the legal effect given to treaty arrangements (*d*).

Practice under sect. 103, the Convention, and the Patents Rules.

An application in the United Kingdom for a patent for any invention, in respect of which a foreign application (*e*) has been made, must contain a declaration that such foreign application has been made, and must specify all the foreign states or British possessions in which foreign applications have been made, and the date or dates thereof respectively. It must be made in Form A2.

The application must be made within seven months 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.

(*c*) The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 cents, payable to MM. Jent & Reinert, Imprimeurs, Berne.

(*d*) It is to be observed, that one of the chief difficulties, under sect. 103, is the vagueness of the word *any* in the clause beginning, "If her Majesty is pleased to make *any* arrangement with the Government or Governments of any foreign state," &c. But it is provided that the section shall only apply to those foreign states with respect to which her Majesty shall from time to time, by Order in Council, declare it to be applicable. Most of the Orders in Council which have been made simply apply sect. 103 to the countries with which arrangements have been made. So that, so far as the treaties are concerned, it would appear that they need not be looked at, except, perhaps, to see if the provisions of the Order in Council are all contained in the treaty. All that needs attention is sect. 103, and to see how far the Order in Council applies its provisions. If the Order in Council applying sect. 103 to the countries under the International Convention was properly made, it would seem that her Majesty may, by Order in Council, apply some only of the provisions of sect. 103. For in this Order in Council there is a reservation of the Isle of Man. As to the general position of treaties and Orders in Council made under statutory authority, and applying the provisions thereof, see *Reg.* v. *Wilson* (1877), L. R. 3 Q. B. D. p. 42, and *Parlement Belge* (1880), 5 P. D. 197.

(*e*) "The term 'foreign application' means an application by any person for protection of his invention in a foreign state or British possession to which, by any Order of her Majesty in Council for the time being in force, the provisions of sect. 103 of the Patents Act, 1883, have been declared applicable:" Patents Rules, 1890, rule 24.

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 (*f*).

Application on Form A2.

The application in the United Kingdom must be made in the Form A2 in the second schedule to the Patents Rules, 1890 (*g*), and, in addition to the specification, provisional or complete, left with such application, as in the case of an ordinary 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 possession as aforesaid, or otherwise verified to the satisfaction of the comptroller;

(2) A statutory declaration 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 or document corresponding to it be in a foreign language, a translation must be annexed and verified by the statutory declaration (*h*).

Variance in English and foreign specifications.

Minor matters of departure in a foreigner's English specification from his foreign specification are unimportant, if the law officer is enabled by the translation to judge of the substantial identity of the inventions described therein (*i*).

Entry by comptroller of dates.

On receipt of the application, together with the prescribed specification, and the other document or documents accompanying the same, 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 makes an entry of the applications in both countries and of the official dates of such applications respectively (*k*).

Further proceedings same as in other cases.

All further proceedings in connection with the application are taken within the times and in the manner prescribed by the Acts or rules for ordinary applications (*l*).

Renewal fees.

The patent, when granted, is entered on the Register of Patents, as dated of the date on which the first foreign application was made, and the payment of the renewal fees and the

(*f*) *Ibid.* rule 25.
(*g*) *Infra*, p. 807.
(*h*) Patents Rules, 1890, rule 26.
(*i*) *L'Oiseau and Pierrard* (1887), per Webster, A.-G., Griff. A. P. C. at p. 37; *Main's Patent* (1890), 7 R. P. C. 13.
(*k*) Patents Rules, 1890, rule 27.
(*l*) *Ibid.* rule 28.

expiration of the patent are reckoned from the date of the first foreign application (*m*).

Decisions under sect. 103.

There have been several recent decisions under sect. 103, to which it is necessary to allude.

Position of applicant where previous foreign patent not disclosed.

L'Oiseau and Pierrard (*n*).—On 8th October, 1886, L. and P., two foreigners, left at the Patent Office an application in common form, with a provisional specification, for letters patent for "automatic apparatus for subjecting the person to the action of electric currents." A complete specification was deposited on 29th January, 1887, and this was accepted on the 28th March following. On 28th May, 1887, notice of opposition to the grant of a patent to L. and P. was given by E. on the ground that the invention had been patented on an application by him of prior date. E.'s application bore date 20th August, 1886, and his complete specification had been left on 3rd March, 1887, and had been accepted on the 27th of the following May.

The applicants then called attention to a patent granted to them in France for the same invention on 18th August, 1886, and contended that, under sect. 103 and the Convention, their patent would be dated 18th August, 1886, and would therefore be prior to E.'s. No notice had been given by L. and P. at the Patent Office of the existence of this French patent; the English specification contained claims not described in the French specification, and the applicants asked leave to strike out from the former the claim applicable to so much as was not described in the latter. Webster, A.-G., allowed the excision to be made, declined to treat the hearing as an application for an amendment which would justify him in imposing any terms, and, as there was nothing to show that L. and P.'s omission to refer to the foreign application was due to bad faith, directed their patent to be sealed as of the 18th August, 1886 (*o*).

In a subsequent case (*p*), however, it was held that the

(*m*) *Ibid.* rule 29.

(*n*) (1887) Griff. A. P. C. 36.

(*o*) "I think," added the A.-G. "(and I wish to reserve this point), that if it were shown that the Patent Office had been misled, and the opponents had been misled by any positive misrepresentation, or if there were anything which would amount to want of good faith, I should like to consider on another occasion whether an applicant who claims the benefit of sect. 103 is entitled to receive it. But once given that there has been a *bonâ fide* application within the period prescribed by statute, and no conduct which would amount to a breach of good faith or a breach which would prevent a man from being entitled to claim his rights, I am afraid that the words of the statute are so distinct that I have no alternative in the matter." See, however, the positive requirements of rules 25 and 26, Patents Rules, 1890.

(*p*) *Re Everitt* (1888), per Webster, A.-G., Griff. A. P. C. at p. 29.

applicants in *L'Oiseau and Pierrard* had no right under sect. 103 to oppose the grant of letters patent to E. under sect. 11 of the Act of 1883.

Retrospective effect of Orders in Council applying sect. 103.

In *Main's Patent* (*q*), Main, who was an American, had applied for a patent on the 18th April, 1887, in the United States. On the 12th July, 1887, an Order in Council applied the provisions of sect. 103 to the United States as from the 12th July, 1887. On the 18th November, 1887, Main applied for the British patent. The application was not made under the rules relating to applications under the International Convention. The grant of the patent was opposed on the ground that the invention had been patented on an application of prior date (the 8th June, 1887). The similarity of the inventions was not denied, but the applicant for the patent claimed to antedate his application to the 18th April, 1887, under the provisions of sect. 103. It was held, that notwithstanding the fact that the provisions of sect. 103 did not apply at the time of the United States application the applicant was so entitled to antedate his application. It was also objected that the application ought to have been made as an application under the International and Colonial Arrangement Rules; but *L'Oiseau and Pierrard's Case* (*r*) was followed, and the patent ordered to be sealed as of the 18th April, 1887.

Importer has no rights under sect. 103.

A person to whom an invention has been communicated from abroad cannot claim any rights under sect. 103. The rights under that section are personal rights, and were intended to encourage people who had invented to come to this country and make known their inventions (*s*).

A patent under the International Convention can only be granted to the person (*t*) who has made the foreign application (*u*).

In *Re Van de Poele* (*x*) an important point was decided. An American inventor applied for a patent in the United States, abandoned the application, and subsequently lodged a fresh application in respect of the same invention. Upon the latter occasion he was permitted by the Patent Office as a matter of

(*q*) (1890) 7 R. P. C. 13.
(*r*) *Supra.*
(*s*) *Re Shallenberger* (1889), per Webster, A.-G., 6 R. P. C. 550.
(*t*) *Semble*, a corporation can apply under sect. 103: *Re Carez* (1889), per Webster, A.-G., *ibid.* 552; *Re Shallenberger, supra.*
(*u*) *Re Carez* (1889), 6 R. P. C. 552; *Re Shallenberger* (1889), *ibid.* 550.
(*x*) (1890) 7 R. P. C. 69.

convenience to make use of the documents filed with his first application, but the application itself was no longer operative in America after its abandonment. Webster, A.-G., held that the second application was "the first foreign application" under the circumstances.

Position of a person protected abroad.

A person applying for an English patent who has previously obtained a patent in a country with which the Convention has been made has an option. He can apply for a patent in the ordinary way, or he may apply under sect. 103. If he applies under sect. 103, his patent dates back to the application in the foreign country (*y*), whilst if he applies in the ordinary way, it dates from application in England. In the former case he gets a shorter term of protection, but he may avoid anticipations which would be fatal to a patent obtained in the ordinary course (*z*). Whether the patentee has elected the one course or the other will appear from the date of the patent (*a*). Though a patent has been granted abroad, the comptroller may refuse to seal the patent, if there then exist reasons which would prevent the sealing of a patent on an ordinary application of the date of the foreign application (*b*).

The terms of the Convention may not be used as a guide to the meaning of the section (*c*).

(*y*) 1883, sect. 103 (1).

(*z*) Per Romer, J., in *British Tanning Co.* v. *Groth* (1891), 8 R. P. C. at p. 121; 60 L. J. Ch. 235. See also *Re Shallenberger* (1889), 6 R. P. C. 550, and Transactions of the Institute of Patents Agents, vol. xiii., p. 35.

(*a*) 1883, sect. 103 (2).

(*b*) Cf. *Carter's T. M.* (1892), 9 R. P. C. 401.

(*c*) *Californian Fig Syrup Co.* (1889), 40 Ch. Div. 620; 58 L. J. Ch. 341; 6 R. P. C. 126.

CHAPTER XIX.

OFFENCES AND PENALTIES.

Remedy for imitation prior to 1835.

Before the year 1835 the only remedy which a patentee had against any person for imitating his name or device was by a bill in Chancery for an injunction, or an action at law for the damages which he might have sustained (*a*).

Act of 1835, sect. 7. Protection to names and marks of patentees.

The statute 5 & 6 Will. IV. c. 83, provided an additional protection to patentees in such cases (*b*).

In *Myers* v. *Baker* (*c*), an action for a penalty for putting on an article made according to a patent the words "K. & G. Patent Elastic," without the licence of the patentee, it was held to be no defence that "the invention was not a new manufacture."

Patents Act, 1883, sect. 105.

Under the Patents Act, 1883 (*d*), it is provided that any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

Use of words, "patent," "patented," &c.

Also that a person shall be deemed to represent that an article is patented if he sell the article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.

The false representation of an expired patent as being still subsisting, would not be an offence under the present Act; at any rate if the article is marked with the year and number of the patent (*e*).

(*a*) Hindmarch, p. 367.

(*b*) By that statute it was enacted that any person who counterfeited or imitated the name, or the stamp, mark, or device of any patentee, should for every such offence be liable to a penalty of 50*l*., to be recovered by action of debt in any of his Majesty's Courts of Record in Westminster, or in Ireland, or in the Court of Session in Scotland, one-half to his Majesty, his heirs, and successors, and the other to any person who shall sue for the same.

(*c*) (1858) 3 H. & N. 802. In this case it was, however, held to be necessary to prove that the words "K. and G. Patent Elastic" did imitate, and were so put on by the defendant "with a view of imitating" the mark of the patentee.

(*d*) Sect. 105.

(*e*) See *Gridley* v. *Swinborne*, quoted in the "Law Journal" for 1894, at p. 683, and cf. *Cheavin* v. *Walker* (1877), 5 Ch. Div. at p. 863; *Marshall* v. *Ross* (1869), 8 Eq. 651. In a recent case, *Pharmaceutical Society* v. *Fox* (1896), Wills, J., speaking of a patent medicine, said, that a patent medicine was one for which there is a

The sale of an article as "patented," which is merely the subject of provisional protection, is an offence against the Act (*f*).

Marking between acceptance of complete and sealing.

It is difficult to say whether the offence is committed if the article is marked "patent" after acceptance of the complete specification, and before the patent is sealed. It will be observed that the offence is representing the article to be a patented article when "no patent has been granted." Before sealing no patent has been granted, and as the grant may be successfully opposed after acceptance of the complete specification, it may be that no patent ever will be granted in the particular case. Nevertheless it is the opinion of some that no offence is committed if the article is not marked till after the complete specification has been accepted, and this opinion is based on sect. 15 of the Act of 1883. There are no authoritative decisions available on this point. At the Mansion House on November 19th, 1894, a conviction was obtained under the circumstances in question (*g*); whilst in *Davies* v. *Townsend* Mr. Bushby, in a similar case, refused to convict. Until the point is definitely settled, it is unwise to mark the article until the patent is sealed.

The section is not to be used as a substitute for an infringement action.

This section is framed for the benefit of the public, and not for the protection of a rival trader. If, therefore, one man makes an article according to another's patent, it is submitted that he does not commit an offence under this section if he marks the article so made "patent." The point arose in a case heard at the Mansion House in June, 1895. It appeared that A. had manufactured an article in alleged infringement of B.'s patent, and had marked it "A.'s patent." The Lord Mayor, hearing that A. had no patent, was inclined to convict, but eventually, owing to extraneous circumstances, the case was not pressed. It is submitted that under this section he would have had no power to convict.

In *Cochrane* v. *Macnish* (*h*) the words, "manufactured in Ireland by H.M. Royal Letters Patent," were printed on the label of bottles of soda-water; the soda-water was not made by a patent process, but it being proved that the words referred to patented machinery with which the water was made, the Court considered them unobjectionable.

patent, not one for which there had been a patent. But the case was not one tried under this Act.

(*f*) *Reg.* v. *Wallis* (1886), 3 R. P. C. 1; *Reg.* v. *Crampton* (1886), *ibid.* 367.

(*g*) See "Law Journal" (1894), p. 683; xiii. Transaction, I. P. A., p. 67; also an article in "Commerce," Dec. 12th, 1894.

(*h*) (1896) App. Ca. 225.

Penalty on unauthorised assumption of the royal arms.

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 (*i*).

Falsification of entries in registers.

Any person who makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, shall be guilty of a misdemeanor (*k*).

Summary proceedings in Scotland.

In Scotland, any offence under the Act of 1883 may be prosecuted in the Sheriff's Court (*l*).

Isle of Man.

The punishment for a misdemeanor in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding 100*l*., at the discretion of the Court; and any offence 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 (*m*).

Person improperly describing himself as a patent agent.

After the 1st day of July, 1889, no person is 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; and 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 20*l*. (*n*).

(*i*) Act of 1883, sect. 106.
(*k*) Act of 1883, sect. 93.
(*l*) Sect. 108.
(*m*) Sect. 112, sub-sects. 2 and 3.
(*n*) Act of 1888, sect. 1.

PART II.

THE PATENTS ACTS, 1883 TO 1888,

CONSOLIDATED (a) AND ANNOTATED.

BEING,

46 & 47 VICT. c. 57.—An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August, 1883.] — Act of 1883.

48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.] — Act of 1885.

49 & 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [25th June, 1886.] — Act of 1886.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.] — Act of 1888.

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

(a) The form in which these Acts have been drawn renders consolidation a simple matter, without departing from the text of the Acts. The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

PART I.

PRELIMINARY.

Sect. 1. Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

The principal Act of 1883 and the amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

The short titles of the amending Acts are respectively—

The Patents, Designs, and Trade Marks (Amendment) Act, 1885;

The Patents Act, 1886;

The Patents, Designs, and Trade Marks Act, 1888.

As we are concerned with patents only here, these Acts are frequently cited as the Act of 1883, Act of 1885, &c., or sometimes as the Patents Act, 1883, the Patents Act, 1885, &c.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—PRELIMINARY.
II.—PATENTS.
III.—DESIGNS.
IV.—TRADE MARKS.
V.—GENERAL.

In this work we are not concerned with Parts III. and IV., or with some sections of Part V. These portions of the Act are therefore omitted in this part of the work, though for completeness the whole of the Acts are given in the Appendix. Occasions may arise where a consideration of sections relating to trade marks or designs may be of use in considering the sections relating to patents.

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

Act 1888, s. 28.

The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

There is no special provision as to time of commencement of the Acts of 1885 and 1886, so that they commence from the dates of those Acts, the 14th August, 1885, and the 25th June, 1886, respectively.

Part II.

PATENTS.

APPLICATION FOR[1] AND GRANT OF PATENT.[2]

Sect. 4.

Persons entitled to apply for patent.

4. (1.) Any person,[3] whether a British subject or not,[4] may make an application for a patent.

(2.) Two or more persons may make a joint application[5] for a patent, and a patent may be granted to them jointly.[6]

Act 1885, s. 5. Power to grant patents to several persons jointly.

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor, be it therefore enacted and declared, that it has been and is lawful under the principal Act to grant such a patent.[7]

1 *Application for patent:*

For rules as to applications, Patents Rules, 1890, p. 689.
Outline procedure on applications, Chap. V., p. 118.
Rival applicants, sect. 7, sub-sect. 5, p. 566.
Application to true inventor where patent revoked on ground of fraud, sect. 26, sub-sect. 8, p. 607.
Application in fraud of first inventor, sect. 35, p. 629.
Deceased inventors, sect. 34, p. 629.
Correction of clerical errors in application, sect. 91, p. 629.
Amendment of application, sect. 7, p. 569; sect. 91 (a), p. 647;
General form of application, Patents Rules, 1890, Form A, p. 805.
Form of application by importer, Patents Rules, 1890, Form A1, p. 806.
Applications sent by post, sect. 97, sub-sect. 1, p. 648.
Applications under International and Colonial Arrangements, Chap. XVIII., p. 533; sect. 103, p. 653; and Patents Rules, 1890, p. 691.
Form of application under Patents Rules, 1890, Form A2, p. 807.

2 *Grant of patent:*

Grant and its effect, Chap. IX., p. 270.
The effect of grant on Crown, sect. 27, p. 610.
Opposition to grant, sect. 11, p. 572; Chap. VIII., p. 239; Patents Rules, 1890, p. 696.
Date of grant, sect. 13, p. 580.

Sect. 4.

Extent, sect. 16, p. 583.
Term, sect. 17, p. 583.
One invention only, sect. 33, p. 628.
Assignment of grant, sect. 36, p. 630, and Chap. X., p. 281.
Variations in form of grant, under this Act, p. 670.

Coverture. Infancy. Lunacy.

3 *Any person.*—It may be laid down as a general proposition that there is now no limitation arising from incapacity—such as coverture, infancy, or lunacy—upon the right to apply for a patent, so long as all proceedings are taken in due form, there is no inquiry at the Patent Office as to age, sanity, or coverture. Sect. 99 provides for certain difficulties which may arise.

Corporation.

A body corporate, which is expressly (sect. 117, sub-sect. 1) included in the definition of a "person," may be a patentee. But only as a joint patentee, as a corporation cannot apparently be an inventor; but, *semble*, a body corporate may be an applicant under sect. 103: *Re Carez* (1889), 6 R. P. C. 552.

Importers.

As to communications from abroad, and the position of importers, see note to sect. 5, sub-sect. 2.

Persons possibly incapacitated. Sovereign. Clergymen. Alien enemy.

The only persons as to whose capacity there still appears to be some doubt are the Sovereign, who cannot, says Hindmarch, make a grant to herself; a beneficed clergyman, under the provisions of 1 & 2 Vict. c. 106, sects. 28–30, Hindmarch, p. 35; and perhaps an alien enemy.

Member of official commission, when disqualified.

A member of an official commission or committee cannot take out a patent for the subject-matter of their official investigation, or for the results of such investigation, embodied in an official report to the public authorities: *Patterson* v. *Gas Light & Coke Co.* (1877), 3 A. C. 239; also 2 Ch. Div. 833.

Official in Patent Office.

Probably no official in the Patent Office would be allowed to apply for or hold any interest in a patent.

Aliens.

4 *Whether a British subject or not.*—An *alien amy* (a) resident in this country, or (b) resident abroad, may obtain a patent. The dictum of Lord Cairns, C., however, in *Re Wirth's Patent* (1879), 12 Ch. Div. at p. 304, that a patent might be granted to an alien *resident abroad for an invention communicated to him* by another alien, also resident abroad, must be read in connection with Form A1, Patents Rules, 1890, which contemplates a resident applicant only in such cases.

Joint applicants.

5 *Joint application.*—For form of application, see Patents Rules, 1890, Form A, or Form A1, pp. 805, 806.

This part of the sub-section is declaratory of the existing law.

As to filing specification on a joint application, see *Apostoloff's Application* (1896), 13 R. P. C. 275.

Joint grantees.

6 *Joint grantees.*—As to joint grantees, see pp. 277 *et seq.*; form of grant, p. 671.

Where a patent for inventions is granted to two or more persons in the usual form, each one may use the invention without the consent of the others, and without being liable to account to them for the profits made by such use: *Mathers* v. *Green* (1865–66), 1 Ch. 29; 35 L. J. Ch. 1; *Steers* v. *Rogers* (1893), App. Ca. 232; 10 R. P. C. 245.

Powers of co-grantees.

The power of one of several co-grantees of letters patent to grant a valid licence without the consent of the others probably depends upon the authority conferred by the granting and prohibitory clauses. Where the grant is, as in *Mathers* v. *Green* (*supra*), to A., B., and C., their executors, administrators, and assigns, "that they, by themselves . . . . and *such others as they may agree with*, and no others, may use the invention," then, unless the effect of these words is modified by the prohibitory clause, it would seem that none of the co-grantees could grant a licence without the concurrence of all the others. In *Mathers* v. *Green*, 34 Beav. 170, Lord Romilly held that one of several co-grantees would be bound to account to the others for royalties received from a licensee. This point was not judicially reviewed on the appeal.

7 Patents are now frequently granted to joint applicants where some only are inventors as here provided. In this way a company or other capitalist may obtain an immediate interest in the patent.

Application and specification.

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form[1] as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.[2]

Declaration.

(2.) An application must contain a declaration[3] to the effect that the applicant is in possession of an invention, whereof he or, in the case of a joint application, one or more of the applicants claims or claim to be the true and first inventor or inventors,[4] and for which he or they desires or desire to obtain a patent; and must be accompanied[5] by either a provisional[5a] or complete specification.[5b]

Specification.

Sect. 5.

Act 1885, s. 2. 5 & 6 Will. IV., c. 62.

The declaration may be either a statutory declaration, under the Statutory Declarations Act, 1835,[6] or not, as may be from time to time prescribed.

(3.) A provisional specification must describe the nature of the invention,[7] and be accompanied by drawings, if required.[8]

(4.) A complete specification, whether left on application or subsequently,[9] must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed,[10] and must be accompanied by drawings, if required.[8]

Act 1886, sect. 2. The same drawings may accompany both specifications.

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that, instead of being accompanied by drawings, the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

(5.) A specification, whether provisional or complete, must commence with the title,[11] and in the case of a complete specification must end with a distinct statement[12] of the invention claimed.[13]

1 *Such other form.*—See Patents Rules, 1890, rule 5, &c., p. 682, and Forms A, A1, A2, *ibid.* pp. 805–7 *et seq.* But this is directory only, an observation which applies to the greater portion of this section. See *Siddell* v. *Vickers*, per Fry, L. J., 39 Ch. Div. 108, 109; 5 R. P. C. 416; and in the House of Lords 15 App. Ca. 496; 7 R. P. C. 292.

The application must be signed by applicant: Patents Rules, 1890, rule 8, p. 684; *Grenfell and McEvoy's Patent* (1890), 7 R. P. C. 151.

2 *Prescribed manner.*—See Patents Rules, 1890, *infra*, pp. 689 *et seq.*

Applications by post, sect. 97, sub-sect. 2, p. 689.

3 *A declaration.*—For form of declaration, see Patents Rules, 1890, rule 6 (3), and note thereto, p. 684, also Forms, *infra*, pp. 805 *et seq.*

By 47 & 48 Vict. c. 62, s. 9, a statutory declaration in connection with an application for a patent was exempted from the stamp duty of 2s. 6*d.*, chargeable on statutory declarations under the Stamp Act, 1870.

For declaration by representative of deceased inventor, sect. 34, p. 629.

For declaration on behalf of infant, lunatic, &c., sect. 99, p. 649.

4 *True and first inventor.*—The meaning of these words is fully considered *ante*, p. 263. The definition of invention under the present Act is the same as it was under the Statute of Monopolies. See sect. 46, *infra*, p. 639.

If novelty is proved, this will not suffice to show that the patentee is the true and first inventor; novelty and subject-matter show *an* invention; the patentee must be prepared to go further and show that he is *the* inventor: *Thomson* v. *Macdonald* (1891), 8 R. P. C. at p. 9; *Cornish* v. *Keene* (1838), 1 W. P. C. at p. 507; and see *ante*, p. 263. Whether a patentee is the true inventor is a question of fact: *Minter* v. *Wells* (1834), 1 W. P. C. at p. 134; *Kurtz* v. *Spence* (1888), 5 R. P. C. 161. This is peculiarly the case when it has to be determined whether the master or his servant is the inventor. See, *e.g.*, *Heald's Patent* (1891), 8 R. P. C. 429; *David and Woodley's Application*, Griff. A. P. C. 26.

If the invention is in use at the time the grant is made, the applicant cannot have a patent, although he is the original inventor; if it is not in use, he cannot obtain a patent if he is not the original inventor, per Lord Lyndhurst, C., in *The Householl Co.* v. *Neilson* (1843), 1 W. P. C. 719. He is not called the inventor who has in his closet invented it, but who does not communicate it; the first person who discloses that invention to the public is considered as the inventor: *Ibid.* And see *Dollond's Patent* (1776), 1 W. P. C. 43.

First importer.

By the common law (*Hastings Patent* (1567), 1 Web. P. C. 6; *Matthey's Patent*, Eliz., 1 Web. P. C. 6; *Humphrey's Patents*, 1 Web. P. C. 7; *Darcy* v. *Allin* (1602), 1 Web. P. C. 6, affirmed by the Statute of Monopolies and a series of judicial decisions (*e.g.*, *Edgeberry* v. *Stephens*, 1 Web. P. C. 35; *Walton* v. *Bateman* (1842), 1 Web. P. C. 615; *Beard* v. *Egerton* (1846), 3 C. B. 97; *Nickels* v. *Ross* (1849), 8 C. B. 679; *In re Lamenaude's Patent* (1850), 2 Web. P. C. 169; *Steedman* v. *Marsh* (1856), 2 Jur. N. S. 391; *Marsden* v. *Saville St., &c., Co.* (1878), per Jessel, M. R., 3 Ex. D. 203, 205), a patent might be granted to the first importer into this realm of a foreign invention. Scotland is "within the realm" in the sense of sect. 6 of the Statute of Monopolies: *Plimpton* v. *Malcolmson* (1876), 3 Ch. Div. 555. The words "within the realm" were not, however, reproduced in sect. 5, sub-sect. 2, of the Patents, &c., Act, 1883; and as the form of application originally prescribed by the Act (Form A, *infra*, p. 805) drew no distinction between an original and a communicated invention, it seemed as if the right of the first

Importers.

Sect. 5. importer of an invention from abroad to obtain a patent in respect of it had implicitly been taken away, and that a person taking out a patent and making a declaration, as required by this sub-section, that he was a true and first inventor, when in truth he was only the importer of a communicated invention, might be making a false suggestion, which would avoid the grant. The Patents Rules of 1883, however, gave a form specially applicable to communications from abroad. There is also the definition of an invention given in sect. 46 of the present Act, which defines an invention to be any manner of new manufacture, the subject-matter of letters patent, and grant of privilege within the meaning of sect. 6 of Statute of Monopolies. Many applications are now made by agents as importers, under Form A1.

Another difficulty, however, remains. The Patents Rules, 1890 (rule 6), provide that "an application for a patent containing the declaration mentioned in sub-sect. 2 of sect. 5 of the principal Act *shall be made either in the Form A or in the Form A1 set forth in the second schedule hereto, as the case may be.*" Form A contains a declaration that the applicant is "the true and first inventor" of the subject-matter in respect of which a patent is claimed. Form A1 deals with communicated inventions. Suppose that a person in possession of a communicated invention uses Form A instead of Form A1, is the patent which he obtains liable to be avoided as containing a false suggestion? In *Re Avery's Patent* (1887), 36 Ch. Div. 307; 4 R. P. C. 163, Stirling, J., appears to have considered that such a patent would be valid, and *Moser* v. *Marsden* (1893), 10 R. P. C. at p. 359, points to the same result; but the point has not been expressly decided.

An inventor does not cease to be such because he employs assistance in carrying out his invention; if in the result the main invention is his, he remains the inventor although his employés may have made suggestions as to details. See and compare these cases: *Minter* v. *Wells* (1834), 1 W. P. C. 127; *Bloxham* v. *Elsee*, 1 W. P. C. 132, n.; *Kurtz* v. *Spence* (1888), 5 R. P. C. 161; *Elias* v. *Grovesend Tin Plate Co.* (1890), 7 R. P. C. 455. But if another gives him an important part of the invention, he is not the true and first inventor; see, *e.g.*, *Tennant's Case*, 1 W. P. C. 125, n.

A communication made in England by one British subject to another British subject cannot be patented by the receiver of the communication, so as to make the receiver the true and first inventor within the meaning of the patent laws: *Marsden* v. *Saville St., &c., Co.* (1878), 3 Ex. D. 204.

The fraud of the importer is not *per se* sufficient to make him not an inventor: *Edmunds's Patent* (1886), Griff. P. C. 281.

A foreigner abroad who has received the invention by communication from another foreigner abroad might have applied for a patent as true and first inventor: *Re Wirth's Patent* (1879), 12 Ch. Div. 303; but see now Form A1 (*post* p. 806), which has to be used, and which is so framed as to make this difficult.

5 *Must be accompanied by, &c.* :—

At common law no specification was required, but the patent contained a description defining the nature of the invention. Probably the grant would have been void for uncertainty otherwise: Hindmarch, 151. Frequently a clause was inserted requiring the patentee to take apprentices and teach them the invention.

The Statute of Monopolies made no change in this respect. In the reign of Anne the practice arose of inserting a proviso in patents that the patentee should specify in a written, sealed instrument the exact nature of his invention. See, *e.g.*, *Nasmyth's Patent*. A certain time was allowed in which this should be done. If not done in the time, the grant was null and void. This instrument, to which the name "specification" was given, could have been enrolled in one of the three offices in Chancery, but for these one was substituted in 1847.

Under some circumstances the specification could be dispensed with; the last time this happened was in the case of *Lee's Patent* in 1813.

Forms of specifications, Appendix, pp. 809, 818 *et seq.*

As to relative advantages and disadvantages of leaving complete specification in first instance, see pp. 119–121.

Publication of specifications, sect. 13, p. 580.

Indexes of, sect. 40, p. 634; sect. 101, sub-sect. 1, p. 650.

5a The provisional specification was introduced in 1852, which gave a certain protection for a period of six months. The nature of the invention alone had to be mentioned. The present Act allows the provisional and complete specifications to be filed at the same time (sect. 5, sub-sect. 4).

5b A complete specification is now a condition precedent; no patent is granted till it is accepted; the patent then dates back to the application.

For further information as to the history of the specification, see *ante*, Chap. VI.

6 *Statutory Declarations Act*, 1835.—5 & 6 Will. IV. c. 62.

Sect. 11 of this statute was repealed by sect. 113 of the Act of 1883.

Sect. 5. Before the Statutory Declarations Act, 1835 (5 & 6 Will. IV. c. 62), s. 11, the application (then a *petition*) for letters patent was verified by an *affidavit* sworn before a master, or a master extraordinary, in Chancery. "The solemn declaration," introduced by the Statutory Declarations Act, was quite distinct from the *petition*, but afterwards formed *part of the application.*

There is now no *statutory* declaration in an application for a patent. It is a simple declaration. But see Patents Rules, 1890, rules 24—29, as to applications under international and colonial arrangements.

7 *A provisional specification, &c.:—*

As to essentials of provisional, see *ante*, p. 141.

Since the present Act has been in force, the patent is not granted until the final specification has been accepted, but the grant, when made, dates back to the application: sect. 13.

The object of the provisional is to state and identify the invention. It must do this distinctly and intelligibly, and its whole nature must be disclosed: *Penn* v. *Bibby* (1866), 2 Ch. 127; 36 L. J. Ch. 455.

The principle which underlies the invention must be plainly and specially stated; the details and the method of carrying out the invention need not be included: *Penn* v. *Bibby* (1866), 2 Ch. 127; *Newall* v. *Elliott*, 4 C. B. N. S. 269; 27 L. J. C. P. 337; 52 L. J. Ex. 120; *Woodward* v. *Sansum* (1887), 4 R. P. C. 166; and see *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92. The provisional specification must not be framed with a view to hide the invention; it must be framed fairly and honestly: per Fry, J., in *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. 747. The provisional specification need not claim anything: *Lucas* v. *Miller* (1885), 2 R. P. C. 159. Its function is not to define or show clearly what the patentee claims, but merely to identify the invention.

After the provisional has been filed, the inventor may perfect his details, modify, supplement, and develop, provided that he keeps within the ambit of the invention as described in the provisional specification: *Woodward* v. *Sansum* (1887), 4 R. P. C. 166, 178; *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 426.

One object of the provisional is to give the inventor an opportunity to improve the means of putting his discovery into operation. There is nothing to prevent the addition to the provisional of the method, but the tactical reasons against such a course are obvious.

The inventor may in his complete specification include less than in the provisional. He may drop part of his invention as there described: *Penn* v. *Bibby* (1866), 2 Ch. 134.

It is not an objection to the draughtsmanship of the provisional that

an intelligent workman accustomed to the class of work to which the invention relates is unable from it to construct the thing invented; for the provisional is not intended to show how the invention is carried out, but to state what it is: *Stoner* v. *Todd* (1876), 4 Ch. Div. 58. Moreover, as the public may not use the invention, they are not prejudiced by not being informed of the method of so doing.

The advantage given by the acceptance of a provisional specification is styled provisional protection, and is limited to protection against the consequences of use and publication of the invention: Act of 1883, sect. 14. No proceedings shall be taken in respect of any infringement committed before the publication of the complete specification: Act of 1883, sect. 13.

An inventor may abandon his application and make a fresh one, as the provisional is not a bar on account of prior publication. In fact, the provisional is not published save with the complete. The examiner must ascertain and report to the comptroller whether the nature of the invention has been fairly described (sect. 6, *infra*), but the report of the examiner is intended to assist, and not to fetter, the comptroller. If, therefore, upon the face of the specification and apart from the report of the examiner, it is clear that the specification is insufficient, the comptroller must deal with it and refuse the application or require an amendment: *In the Matter of C.'s Patent* (1890), 7 R. P. C. 250.

A defect in the provisional specification will not render the patent bad; but care must be taken that it covers what is intended to be claimed, as the invention as disclosed in the complete specification must not travel beyond limits laid down in the provisional. See below, notes to sect. 9, under heading "Substantially the same." If, however, there be no variance between the complete and the provisional, the former may be explained by the latter: *Siddell* v. *Vickers*, 39 C. D. 92, 97; 5 R. P. C. 426; and see *Neilson* v. *Harford* (1841), 1 W. P. C. 331, a case relating to the analogous question of interpretation of the title of the specification. The size, &c., of the paper on which the provisional is to be written or printed and the formalities connected with the application are dealt with by rule 10. See *post*, p. 685. Drawings must sometimes accompany the application. See next note and rules 30—33, *post*. Duplicates, documents, and drawings are required by the comptroller. See Form B, *post*, p. 808. The provisional specification need not be stamped. The applicant (or his agent) must affix the date and sign the provisional on the last sheet. If there be several joint applicants, the specification need not be signed by them all: *In the Matter of Grenfell's and McEvoy's Patent* (1890), 7 R. P. C. 151.

Sect. 5.

Reference to examiner, sect. 6, p. 563.
Amendment of sect. 7, sub-sect. 1, p. 565; Chap. VIII. sect. 5, p. 213.
Comparison of, with complete, sect. 9, sub-sect. 1.
Variance between provisional and complete, sect. 11, sub. sect. 1, also *ante*, p. 146.
Advertisement of acceptance is not required. See rule 21 p. 690, and notes, *post*.
Drawings.—See p. 694, and next note.
Form.—See *post*, p. 808.

Drawings.

8 *Drawings.*—For the rules as to drawings, and for the existing regulations as to size, paper, quality of ink, scale, &c., see Patents Rules, 1890, rules 30—33, *post*, p. 694.

The words *if required* are new, the use of drawings having formerly been permissive, not compulsory (*Boulton* v. *Bull* (1795), 2 H. Bl. 481, per Buller, J.; *Bloxam* v. *Elsee* (1825), 1 C. & P. 564, per Abbott, C. J.), and mean if required by the comptroller-general.

A specification could consist simply of a drawing, and a description of it, provided that the invention was distinctly described and claimed: *Brunton* v. *Hawkes* (1820), 1 Carp. P. C. 410, per Abbott, C. J.; *Fawell* v. *Bostock* (1864), 10 L. T. N. S. 146, per Lord Westbury, L. C.; *Poupard* v. *Purdell* (1869), 18 W. R. 129.

In view of the wording of sub-sects. 3 and 4, it is very doubtful whether the comptroller could pass a specification consisting solely of drawings.

Drawings are taken to be part of the specification: *Williams* v. *Brodie*, cited in *R.* v. *Arkwright* (1785), 1 Web. P. C. 71; *Hastings* v. *Brown* (1853), 1 E. & B. 454; *Morgan* v. *Seaward* (1836), 1 Web. P. C. 173; *Morton* v. *Middleton* (1863), 1 C. R. & S. 3rd Ser. 722—724; *Daw* v. *Eley* (1867), L. R. 3 Eq. 500, n.; 14 W. R. 126.

As to the extent to which drawings will amplify or explain the rest of the specification, see *Macfarlane* v. *Price* (1816), 1 Web. P. C. 74; *Fairburn* v. *Household* (1886), 3 R. P. C. 266. See also *supra*, p. 200.

As to erroneous drawings, see *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. 106, 111; *Simpson* v. *Holliday* (1866), 13 W. R. 578.

9 *Whether left on application or subsequently.*

On a joint application the comptroller cannot accept more than one specification; therefore the parties must agree as to its form: *Apostoloff's Application* (1896), 13 R. P. C. 275.

10 *Complete specification* :—
Reference to examiner, sect. 9, p. 568.
Time for leaving, sects. 8, 9, pp. 567, 568.
Acceptance of, sect. 9, sub-sect. 4, p. 569.
Comparison with provisional, sect. 9, sub-sect. 1, p. 568, and notes thereto.
Protection under, sect. 15, p. 582.
Amendment of, sect. 18, p. 585; and *ante*, p. 213.
Transmission of copies of, sect. 100, p. 650.
Board of Trade may require duplicates of, sect. 101, sub-sect. 1 (c), p. 650.
Forms of, see pp. 808, 818 *et seq.*

This sub-section is declaratory of the common law.

Nature of complete specification.

While an exhaustive definition of the words "must particularly describe and ascertain" falls beyond the scope of this note, it may be possible to indicate with general accuracy the *tests of sufficiency* which the Courts have from time to time applied in the construction of specifications.

They are—Does the specification contain a full and *bonâ fide* disclosure of all things material to the particular invention within the knowledge of the patentee at the time of specifying? *Cartwright* v. *Eamer* (1800), cited 14 Ves. 131, 136, per Lord Eldon; *R.* v. *Arkwright* (1785), 1 Web. P. C. 66, per Buller, J.; *Bovill* v. *Moore* (1815-16), Dav. P. C. 361, per Gibbs, C. J.; *Sturtz* v. *De la Rue* (1828), 5 Russ. 324, per Lord Lyndhurst, L. C.; *Coles* v. *Baylis* (1886), 3 R. P. C. 180, per Bacon, V.-C.

The two requisites of a complete specification mentioned in this sub-section must be kept separately and distinctly in mind. The specification must show (1) what the invention is, and (2) how it is to be carried out.

A specification may be insufficient if ambiguous, *e.g.* if a generic term is used, and a particular species alone will avail: *Turner* v. *Winter* (1787), 1 W. P. C. 77; *Wegmann* v. *Corcoran* (1879), 13 Ch. Div. 65; *Gandy* v. *Reddaway* (1885), 2 R. P. C. 49.

When the specification omits proportions of the ingredients, the specification is sometimes bad, sometimes not. See *Patent Type-founding Co.* v. *Richards* (1859), 1 Johns. 381; *British Dynamite Co.* v. *Krebs* (1879), Good. P. C. 88.

A specification which does not disclose improvements discovered by the inventor since the provisional was filed, and which relate to the invention, is bad, if the improvements are really but improved means of carrying out the invention disclosed in the specification. If the improvements amount to an invention which goes beyond the invention disclosed in the provisional, the applicant not only need

Sect. 5. not, but must not (on account of disconformity), include them in the complete. See and cf. *Edison* v. *Woodhouse* (1886), 32 Ch. Div. 521; *Miller* v. *Searle Barker* (1893), 10 R. P. C. 106, 111; *Crossley* v. *Beverley* (1829), 1 W. P. C. 117.

The specification should distinguish what is old and what is new; but this need not be stated in express terms, and if from the specification can be gathered what is claimed as the novelty, this requisite is satisfied. See *Carpenter* v. *Smith* (1841), 1 W. P. C. 532. This applies to a patent for improvements: *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298. It applies equally to patents for combinations, but when the combination is claimed without the subordinate integers, the claim for the combination alone suffices, for it may be gathered that the combination as a whole is the novelty, and that the parts are not claimed to be new. See *inter alia Harrison* v. *Anderston Foundry Co.* (1876), 1 App. Ca. 577, 583; *Clark* v. *Adie* (1877), 2 App. Ca. 315; *Moore* v. *Bennett* (1884), 1 R. P. C. 143; *Proctor* v. *Bennis* (1887), 36 Ch. Div. 740, 762; 4 R. P. C. 333; *Kelly* v. *Heathman* (1890), 45 Ch. Div. 256; 8 R. P. C. 343; *Lyon* v. *Goddard* (1894), 11 R. P. C. 357.

The following is a test of the sufficiency of the description: Is the description of the invention sufficiently accurate to enable a careful and competent workman, accustomed to the kind of manufacture forming the matter of the patent, to make the invention without any further experiment or aid than that which his practical knowledge and the specification afford him? *British Dynamite Co.* v. *Krebs* (1879), 1 Good. P. C. 88, 91; *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. 106, 111; *Badische Anilin und Soda Fabrik* v. *Levinstein* (1887), 12 A. C. 710, 713; 4 R. P. C. 449; and per Lindley, L. J., in *Edison* v. *Holland*, 6 R. P. C. 281.

For a fuller discussion of this subject, see *ante*, p. 173.

11 *The title.*—The House of Lords has decided that the part of the section requiring a claim is directory only (*Vickers* v. *Siddell*, 15 App. Ca. 496). Sect. 7 (*infra*, p. 565) makes insufficiency of title a ground for refusing a patent, and practically, therefore, the title is still a necessity.

Nature of title.

The law as found in the older cases stands thus:—The title must express correctly and concisely the subject-matter of the invention; and ought to be neither too narrow to include the whole invention, nor so wide that it includes more than the patentee has invented.

Variance between title and specification.

The introduction of the provisional specification and the power to require amendments, now conferred upon the comptroller-general, have made the old cases as to variance between the title and the

specification of less importance; but for convenience of search the title is still useful, and its accuracy is matter of importance, as it may have an important bearing on the construction of the claim when the sufficiency of the specification or the novelty of the invention is in question.

The objection to the title may be taken by the Crown when the patent is applied for; but probably nowadays a patent once granted will not be invalidated merely on the ground of insufficiency of title. It will be observed that amongst the grounds of opposition to the grant of a patent insufficiency of title is not named. See *infra*, sect. 11.

The generality of the title may be restricted by the specification, and in some cases the converse holds good. The title and specification are to be read together: *Hornblower* v. *Boulton* (1799), 8 T. R. 95; *Neilson* v. *Harford* (1841), 1 W. P. C. 295, 331; *Lister* v. *Norton*, 3 R. P. C. 203. But the specification has never been allowed to extend the meaning of the title so as to make the grant include that which could not fairly come within it: *Croll* v. *Edge* (1850), 9 C. B. 479; 19 L. J. C. P. 261. The title should not be too narrow, as it may in such case restrict the grant: *Wright* v. *Hitchcock* (1870), L. R. 5 Ex. 37.

The title may be amended by excision under sects. 7 and 9: *Dart's Patent*, Griff. P. C. 307. If the specification has already been made public property, the application should be made under sect. 18: *Jones's Patent*. Griff. P. C. 313.

As to the title generally, its nature, variance between title and specification, &c., see *ante*, Chap. VI., p. 135.

Report of examiner upon the title, sect. 7, sub-sect. 1.

Amendment.—See sects. 7, 9, 18.

Meaning of "distinct statement."

12 *A distinct statement.*—"Distinct" means independently of and apart from the mere description of the nature of the invention and of the way in which it is to be carried into effect: *Siddell* v. *Vickers* (1888), 39 Ch. Div. 92; 5 R. P. C. 428; 15 App. Ca. 496.

The claims.

13 *The claim.*—The important subject of claims is fully dealt with *ante*, p. 18.

This provision is directory only. A specification without a claim should not be passed by the comptroller; but if by any chance it were, the patent would not, therefore, be bad: *Siddell* v. *Vickers* (1890), 15 A. C. 496; 60 L. J. Ch. 105; 7 R. P. C. 292.

Under the old law it has been stated that a claim is in fact a disclaimer. See, *e.g.*, per James, L. J., in *Plimpton* v. *Spiller* (1877), 6 Ch. Div. 426; also *Hinks* v. *Safety Lighting Co.* (1876), 4 Ch. Div. 612; *Easterbrook* v. *G. W. Railway* (1885), 2 R. P. C. 208; *Lucas*

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v. *Miller* (1885), 2 R. P. C. 159. Under the present Act the claim still performs to some extent the function of a disclaimer, but it is no longer correct to look upon it merely as performing that function. "Since 1883 it is not correct to speak of a claim as a disclaimer, as one can now only protect what is claimed:" per Herschell, L. C., in *Parkinson* v. *Simon* (1895), 12 R. P. C. 406; but see dicta of Kay, L. J., and Smith, L. J., in *Edison Phonograph Corporation* v. *Smith and Young* (1894), 11 R. P. C. 401, 405.

The claim should not be too wide, as it may then include within its scope that which is not patentable. In such case the claim is bad, and with it the patent falls: *Rose* v. *Braby* (1894), 11 R. P. C. 198; *Parkinson* v. *Simon* (1895), 12 R. P. C. 408. Whether a claim which is too wide, in view of the invention specified, would be bad if the excess is new and otherwise patentable, *quære*. Wright, J. (supported by Smith, L. J.), thought not. See *Edison and Bell Phonograph Corporation* v. *Smith* (1894), 11 R. P. C. 163, 408; and see *ante*, pp. 186, 187. But the patentee may disclaim a bad claim. See sects. 18 to 20.

If the claim is too narrow there is danger that in an action for infringement the defendant may be able to show that his manufacture keeps outside the claims of the plaintiff. See especially *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Syndicate* (1895), 12 R. P. C. 232; *Parkinson* v. *Simon* (1895), 12 R. P. C. 408.

The effect of the words "substantially as described," "in apparatus such as described," was considered in the following, amongst other, cases: *Young* v. *Rosenthal* (1884), 1 R. P. C. 33; *Plimpton* v. *Spiller* (1876), 6 Ch. Div. 426; *Cassel Gold, &c., Co.* v. *Cyanide Gold, &c., Co.* (1895), 12 R. P. C. 232; *Parkinson* v. *Simon* (1895), 12 R. P. C. 408; *Edison-Bell, &c., Corporation* v. *Smith* (1894), 11 R. P. C. 389. The general result seems to be that such words must be given a full meaning, and generally will throw those construing the claim back to the body of the specification, but if this cannot be done consistently with giving a proper construction to the rest of the claim the words will not have this effect. And though mere redundancy or repetition will not invalidate a claim (*Wenham Gas Co.* v. *Champion Gas Lamp Co.* (1892), 9 R. P. C. at p. 98), an interpretation which would give an identical meaning to several separate claims would *primâ facie* be the wrong interpretation: *Parkinson* v. *Simon* (1895), 12 R. P. C. 408.

If two modes of performing are claimed, and one will not work, see and contrast *Lewis* v. *Marling* (1829), 10 B. & C. at p. 25, *R.* v. *Cutler* (1849), 14 Q. B. 372, n., and *Simpson* v. *Holliday* (1866), 5 N. R. 340.

A claim must be very wide to justify any Court in saying that

a patent cannot be supported based upon it: Cotton, L. J., in *Arnold* v. *Bradbury* (1871), 6 Ch. 711. But "I claim every mode of cutting ice except by human power" would be bad: *Ibid.* **Sect. 5.**

It is allowable to point out that the invention can be utilised for a known process provided it be clearly pointed out that the old process is not claimed: *Goddard* v. *Lyon*, 11 R. P. C. 354.

Claims for improvements are allowable, but the improvement must be specified in accordance with the doctrine of *Foxwell* v. *Bostock* (1864), 4 De G. J. & S. 298; and see *ante*, p. 189.

The combination may be claimed alone without the subordinate integer. In that case there is no need to disclaim the separate parts: *Clark* v. *Adie* (1875), 2 A. C. 320; *Moore* v. *Bennett* (1884), 1 R. P. C. 129, 143; and see *ante*, p. 189 *et seq.* Hence if each of the parts be old, but the combination be new and patentable, the claim for the combination will be good, *e.g.*, *Hayward* v. *Hamilton* (1879), Griff. P. C. 115 (pavement lights case); *Kelly* v. *Heathman* (1890), 45 Ch. Div. 256; 8 R. P. C. 343 (telescopic ladder case); *Peckover* v. *Rowland* (1893), 10 R. P. C. 224 (apparatus for softening water in boilers, &c.).

Claims for the subordinate integers may be joined with claims for the whole combination. In such case the claims for the integers, if claimed as independent inventions, or, as it is styled, *in gross*, are treated as substantive claims, and if they are bad the patent is invalid until the bad claims are got rid of. If, on the other hand, the subordinate integers are but part of the main invention, if they are *appendant*, want of novelty in them will not affect the patent. As to *integers in gross*, see *Clark* v. *Adie* (1875), 2 App. Ca. 320; as to integers appendant, see *British Dynamite Co.* v. *Krebs* (1879), Good. P. C. 93, 94; also *Plimpton* v. *Spiller* (1877), 6 Ch. Div. 426 (roller skate case).

The construction of a specification of claims is considered *ante*, p. 202. Stated shortly and generally, the rule with regard to claims is as follows: The claims must be construed as any ordinary documents would be construed, and if the meaning is clear, that meaning must be given to them; but if the "language of a claim be ambiguous, and it be fairly capable of two constructions, the Court would be disposed to adopt that construction which would uphold the patent, and not that which would render it invalid:" Lord Davey in *Parkinson* v. *Simon* (1895), 12 R. P. C. at p. 411.

6. The comptroller[1] shall refer every application to an examiner,[2] who shall ascertain and report[3] to the comptroller whether the nature of the invention has been fairly described,[4] and the application, specification, and Reference to Examiner.

Sect. 6. drawings (if any) have been prepared in the prescribed manner,[5] and the title[6] sufficiently indicates the subject-matter of the invention.

1 *The comptroller* :—

This is the first mention of the comptroller in the Act; his duties are best considered under the various sections in which his name occurs.

As regards the Patent Office and the comptroller's connection with it, see *ante*, p. 110.

2 *The examiners.*—As to examiners generally, *ante*, p. 111.

Appointment of, sect. 83, sub-sect. 1.

Reference of specifications to, sect. 9, sub-sect. 1.

Reports by, sects. 7—9, sub-sect. 2.

3 *Reports of examiners.*—These reports are private, and are only liable to production under sect. 9, sub-sect. 5. The comptroller is not bound by the report; he must use his own judgment: *C.'s Patent* (1890), 7 R. P. C. 250.

The examiner has to report on the following points:—

Is the nature of the invention fairly described?

Have the application and specification or specifications and drawings, if any, been prepared in the prescribed manner?

Does the title sufficiently indicate the subject-matter of the invention?

Is more than one invention claimed?

And where there is a provisional specification left in the first instance, the examiner has to report on the second reference to him with the complete specification whether the complete describes substantially the same invention as the provisional specification.

Whether the invention is contrary to law or morality.

4 *Fairly described.*—See note *supra*, sect. 5, sub-sect. 4.

5 *Prescribed manner.*—Cp. Patents Rules, 1890, pp. 689, 694 *et seq.*

6 *The title.*—See note *supra*, sect. 5, sub-sect. 5. The provisional specification "must describe the nature of the invention." It is now sufficient for the title to indicate its subject-matter.

Power of comptroller to refuse application or require

7. (1.) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate*

the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.

(2.) *Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

(3.) *The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.*

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

(5.) *If after an application has been made, but before a patent has been sealed, an application is made accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.*

(6.) *Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.*]

Sect. 7. amendment. Repealed. **Act 1888, sect. 2.**

"7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention,[1] the comptroller may refuse to accept the application,[2] or require that the application, specification, or drawings be amended before he proceeds with the application;[3] and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

Act 1888, sect. 2. Power of comptroller to refuse application or require amendment.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.[4]

Appeal to law officer.

"(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the application shall be accepted.

Hearing by law officer.

"(4.) The comptroller shall, when an application has been accepted, give notice[5] thereof to the applicant.

Notice of acceptance.

Sect. 7.

Rival applications.

"(5.) If after an application for a patent has been made, but before the patent thereon has been sealed,[6] another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."[7]

1 See note to sect. 6, *supra*.

2 Though the examiner does not report that an amendment is requisite, it is the comptroller's duty to require one if he thinks fit. The examiner's report does not fetter; it assists the comptroller to form a judgment: *C.'s Patent* (1890), 7 R. P. C. 250.

3 *The comptroller may require that the application, &c., be amended.*

In determining what amendment is requisite the comptroller is not fettered by the report of the examiner; he must use his own judicial discretion: *C.'s Application* (1891), 7 R. P. C. 250.

Grounds on which comptroller may require amendment.

The grounds on which the comptroller may require amendment are—that the nature of the invention is not fairly described; that the application, specification, &c., have not been prepared in the prescribed manner; or that the title does not sufficiently indicate the subject-matter of the invention.

He has no authority to refuse an application or to require amendment on the ground that the subject-matter is not useful, or not novel, or impracticable.

Scope of examiner's preliminary duty.

There has not been as yet any judicial construction of the words "if the examiner reports that *the nature of the invention is not fairly described;*" and the precise scope of the examiner's preliminary duty is therefore uncertain. He has not to decide what the amendment is to be: *C.'s Application* (1891), 7 R. P. C. 250.

But it seems improbable that the Legislature intended anything more than that the examiner should ascertain and report whether the specification *on the face of it* fairly describes the invention. The most absurd invention would be passed by an examiner, provided that the inventor's meaning were intelligible. The decision of Sir Richard Webster, A.-G., in *Brown's Patent* (1887), Griff. A. P. C. 2, lends colour to this view of the character of the examiner's duty.

Semble, any amendment under this section must in form be at the requirement of the comptroller or of the law officer. As to voluntary amendment by the patentee, see notes to sect. 18.

Proceedings to amend a specification which has not yet been published are taken under this section, or under sect. 9. After the

specification has become public property the procedure of sect. 18 must be used: *Jones's Patent*, Griff. P. C. 313. But *quære*, does it become public property before it is *accepted* by the Patent Office: see *Jones's Patent*, *supra*, which is not very satisfactory on this point. Cf. *Dart's Application*, Griff. 307.

4 *The law officer.*—This is the first mention of the law officer in the Act.

As to definition of law officer, sect. 117, sub-sect. 1.

Appeals to, against refusal of comptroller-general to accept complete specification, sect. 9, sub-sects. 2, 3.

Appeals to, on opposition, sect. 11, sub-sects. 2, 3.

Appeals in regard to amendment of specifications, sect. 18, sub-sects. 3—7.

Costs in proceeding before, sect. 38.

Power to examine witnesses on oath, *ibid.*

Power to make rules, *ibid.*

Power to summon expert, *ibid.*

The appeal to the law officer is new.

See "Rules Regulating the Practice and Procedure on Appeals to the Law Officers," and notes thereon, *infra*, Appendix, p. 713.

5 *Notice of acceptance.*

The application is accompanied by a provisional or a complete specification.

The acceptance is to be advertised in the Official Journal of the Patent Office, (Patent Rules, 1890, rule 21, p. 690).

6 *Sealing.*—As to sealing, see sects. 12, 13, p. 577.

Seal of Patent Office see sect. 84, p. 641.

7 *Rival applications.*—This sub-section amends the corresponding sub-section in the Act of 1883, in the following particulars:—(1) the report of the examiner, with regard to conflicting and pending applications, is dispensed with; (2) the comptroller's power to decline to proceed with the second application is discretionary.

Time for leaving specification.

8. (1.) If the applicant does not leave a complete specification with his application,[1] he may leave it at any subsequent time within nine months[2] from the date of application.

Act 1885, sect. 3.

A complete specification may be left within such extended time,[3] not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.[4]

Sect. 8. (2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.[5]

1 *Complete specification with application.*—As to leaving complete specification in first instance, see sect. 5, sub-sect. 2, *ante*, p. 541.

2 *Nine months.*—Month here means calendar month: 13 & 14 Vict. c. 21, s. 4. The day of application is excluded in the reckoning: *Williams* v. *Nash* (1859), 28 L. J. Ch. 886; 28 Beav. 93; *Russell* v. *Ledsam* (1845), 14 M. & W. 574, 582. In the event of the last day falling on Christmas Day, Good Friday, Saturday, Sunday, or Bank Holiday, an extra day is allowed; see 1883, sect. 98, and Patents Rules, 1890, rule 7.

3 *Extension of time.*—The extension of time for one month is readily granted by the comptroller, the general reason being experiments not completed, or desire to apply for and obtain foreign patents.

4 *Prescribed fee.*—The fee is £2, see p. 712.

5 *Abandonment of application.*—Under the Act of 1852 it was held that the abandonment of a provisional specification did not amount to a publication of it, so as to invalidate a patent upon a subsequent application for the same invention: see *Oxley* v. *Holden* (1860), 30 L. J. Ch. 68; 8 C. B. N. S. 666.

In *Lister* v. *Norton* (1886), 3 R. P. C. 200, under substantially the same circumstances as before, it was held that the abandonment of the first provisional specification would not avoid the patent, even if actual user during the currency of the first provisional specification can be shown.

This case opens an important question as to how long an inventor can obtain protection by filing provisionals in succession. He appears to be protected from acts of user, and under the Act of 1885, sect. 4, the specifications accompanying an abandoned application are never exposed to public inspection.

Comparison of provisional and complete specification.

9. (1.) Where a complete specification is left after a provisional specification,[1] the comptroller shall refer both specifications to an examiner[2] for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner,[3] and whether the invention particularly described in the complete specifica-

tion is substantially the same[4] as that which is described in the provisional specification.[5] **Sect. 9.**

(2.) If the examiner reports[6] that the conditions hereinbefore contained have not been complied with, the comptroller may refuse[7] to accept the complete specification unless and until the same shall have been amended to his satisfaction;[8] but any such refusal shall be subject to appeal to the law officer.[9]

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted[10] within twelve months from the date of application,[11] then (save in the case of an appeal[12] having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.[13]

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow.[14] **Act 1885, sect. 3.**

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding *other than an appeal to the law officer under this Act*, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.[15] Repealed. **Act 1888, sect. 3.**

1 *Complete left after provisional.*—Cp. sect. 5, sub-sect. 2, and *ante*, pp. 119, 120.

2 *Examiner.*—See note to sect. 6.

The examination is not conclusive on the question of nonconformity of the provisional and complete specifications, and the patent is liable to be revoked if the specifications do not conform: *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23; 8 R. P. C. 450, and see *infra*, note 4.

3 *Whether the complete specification has been prepared in the prescribed manner.*—Cp. Patents Rules, 1890, rules 30—33, pp. 695, 696.

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Effect of variance under present Act.

4 *Substantially the same.*—From the language of Lord Halsbury, in *Siddell* v. *Vickers* (1888), 15 A. C. 496, quoted under sect. 5, sub-sect. 5, it appeared that variance between the complete and the provisional specifications derives no new significance from this Act, and is fatal, if at all, in virtue of the previous law. The Court of Appeal has accepted this dictum: *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23; 8 R. P. C. 450.

The complete should not contain as a part of the invention anything not within the ambit of the provisional: *Woodward* v. *Sansum* (1887), 4 R. P. C. 166. It may not contain a different invention, whether alone or in conjunction with one fairly within the scope of the provisional: *Bailey* v. *Roberton* (1878), 3 App. Ca. 1055; *Watling* v. *Stevens* (1886), 3 R. P. C. 147, 151; *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 526; *United Telephone Co.* v. *Harrison* (1882), 21 Ch. Div. 720.

But an improvement or better means of carrying the invention into effect may, and generally must, be included in the specification, without danger of conformity: *Miller* v. *Searle, Barker & Co.* (1893), 10 R. P. C. 111; *Bailey* v. *Roberton, ubi supra*; *Gadd* v. *Mayor of Manchester, ubi supra*; *Woodward* v. *Sansum, ubi supra*; *Penn* v. *Bibby* (1866), 2 Ch. 127; *Crossley* v. *Beverley* (1829), 1 W. P. C. 112. An entirely new invention cannot be included under the guise of an improvement: *Gadd* v. *Mayor of Manchester* (1892), 9 R. P. C. 526.

Matters of detail may be added to the complete, though not in the provisional: *Lucas* v. *Miller* (1885), 2 R. P. C. 155.

If the provisional contains more than the complete, this alone is no ground for declaring the patent invalid: *Thomas* v. *Welch* (1866), L. R. 1 C. P. 192; *Penn* v. *Bibby, ubi supra*.

Whether the provisional and complete are in such conformity as is required by law is a question of fact: *Needham* v. *Oxley* (1863), 8 L. T. N. S. 532; 1 H. & M. 248.

In an action the plea of insufficiency of the specification entitles the defendant to set up the invalidity of the patent on the ground of disconformity: *Penn* v. *Bibby, ubi supra*. But the defendant must give particulars: (1886) *Watling* v. *Stevens*, 3 R. P. C. 153, 154.

The provisional is not published until the acceptance of the complete specification, but this does not affect the rule relating to nonconformity: per Lindley, in *Cassel Gold Extracting Co.* v. *Cyanide Gold Recovery Co.* (1895), 12 R. P. C. 249.

It has been decided that the Court must not be too severe in judging of questions of nonconformity; the specifications must be read as meaning what they say, but unless there is clearly a different invention included in the final, the Court will hesitate to declare the patent invalid on this ground: per Lindley, L. J., *Gadd* v

Mayor of Manchester (1892), 9 R. P. C. 527; per Romer, J., in *Chadburn* v. *Meehan* (1895), 12 R. P. C. 120.

For right to oppose on ground of nonconformity, see Act of 1888, sect. 4, *infra*.

For effect of amendment in causing nonconformity, see *Lane-Fox* v. *Kensington Electric Lighting Co.* (1892), 3 Ch. 424; 9 R. P. C. 222, 413; *Goulard and Gibbs' Patent* (1889), 6 R. P. C. 215.

Revocation for nonconformity: see *infra*, sect. 26.

The general effect of the cases, bearing upon the point of variance, may be stated in this way. There is no variance if the difference between the two specifications is merely in a matter of detail, or if the complete specification is the legitimate development of, and contains nothing that is not foreshadowed in, the provisional: see above quoted cases and *Lucas* v. *Miller* (1885), 2 R. P. C. 155; *Horrocks* v. *Stubbs* (1886), 3 R. P. C. 223; *Moseley* v. *Victoria Rubber Co.* (1887), 4 R. P. C. 241, 248; *Anglo-American Brush* v. *Crompton* (1887), 4 R. P. C. 27 and (1888) 5 R. P. C. 398; *Hutchison* v. *Patullo* (1887-8), 4 R. P. C. 332 and 5 R. P. C. 351.

On the whole subject of variance between the specifications, and for a consideration of the cases, see *ante*, p. 146.

5 The language of the statute would seem more clear if it ran, "As the invention, the general nature of which is described," &c.

6 *Examiner's report.*—See note to sect. 6.

7 *Refusal of comptroller.*—The formal letters from comptroller were published in the first edition of this work; it has not been thought necessary to reproduce them in this edition. No specified forms are provided.

8 *Unless and until the same shall have been amended.*—There must be no variance between the amended complete specification and the provisional: *Goulard and Gibbs's Patent* (1888), 5 R. P. C. at p. 532. When the specification has been published, amendment may be made only as provided in sect. 18: *Jones's Patent*, Griff. P. C. 313.

9 *Appeal to law officer:*—

For rules regulating such appeals, see *infra*, p. 713.

See also note to sect. 7, sub-sect. 2.

10 *Acceptance of complete specification.*—The Act does not make the acceptance of a complete specification conclusive as to its sufficiency; and insufficiency of the specification is a ground for the revocation of a patent now, as before the Act of 1883. Cp. *infra*, sect. 26, sub-sect. 3, and *Goulard and Gibbs's Patent*, *supra*, where a patent was revoked on this ground.

Acceptance of complete specification not conclusive of sufficiency.

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11 *Date of application.*—The day of the date is excluded. See note to sect. 8, sub-sect. 2.

12 *Notice of appeal.*—Form T, *infra*, p. 817.

13 *Application void.*—As to abandonment of application and its effect, see note to sect. 8, sub-sect. 2.

A list of abandoned and void applications is published weekly in the "Illustrated Official Journal."

14 *Comptroller may allow.*—As to letters from comptroller, see note (7), *supra*.

Fee, No. 38, p. 712.

15 *Reports of examiners.*—These reports are put into the *file* when the patent is sealed, and the grant entered on the register; but they are not open to public inspection.

Unless the Court . . . shall certify.—No such order appears to have been made.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance;[1] and the application and specification or specifications, with the drawings (if any), shall be open to public inspection.[2]

1 *Advertisements of acceptance* of complete specifications appear weekly in the "Illustrated Official Journal." See Patents Rules, 1890, rule 21, p. 690.

2 *Inspection.*—Until the specifications are printed only the duplicate copies can be seen at the Patent Office.

It takes usually about three weeks after acceptance of complete specification before the printed specifications are published.

Cp. Patents Rules, 1890, rule 22, p. 691.

For list of applications open to inspection, but not continued to sealing stage, see Report for 1889, p. 9.

Opposition to grant of patent.

11. (1.) Any person[1] may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice[2] at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him,[3] or from a person of whom he is the legal representative,[4] or on the ground that the invention has been patented in this country on an application of prior date[5] *or on the ground of an examiner having reported to the*

Repealed. Act 1888, sect. 4.

comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application], or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.[6] **Sect. 11.** **Act 1888, sect. 4.**

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant,[7] and shall on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case,[8] but subject to appeal to the law officer.[9]

(3.) The law officer shall, if required, hear the applicant[10] and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant,[11] and shall determine whether the grant ought or ought not to be made.[12]

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert,[13] who shall be paid such remuneration as the law officer, with the consent of the Treasury,[14] shall appoint.

Under the present Act there may be opposition (1) to the grant of a patent (sect. 11, sub-sect. 1, and Chap. VIII.), (2) to the amendment of a specification (sect. 18, sub-sect. 2, and Chap. VII.), and (3) to the extension of the term of a patent (sect. 25, sub-sect. 2, and Chap. XVI.). Opposition under Act of 1883.

The law relating to each of these subjects is fully discussed in the several chapters above referred to.

We shall only mention here those cases which bear upon the construction of the words of the section.

1 *Any person.*—As to procedure on oppositions generally see Patents Rules, 1890, rule 34, p. 696, and Law Officers' Rules, *infra*, p. 713. Note that in sub-sect. 3 the words are "Any person . . . entitled to be heard." See note *post*.

2 *Notice of opposition.*—Form D, p. 808.

Opposition before the law officer to the grant of a patent, or to the Who entitled to oppose.

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amendment of a specification, can be offered by such persons only as in the law officer's opinion are "entitled to be heard" upon the subject. See sect. 11, sub-sect. 3, and sect. 18, sub-sect. 4. It would seem, therefore, that the twelfth section of the Patent Law Amendment Act, 1852, limiting opposition to the grant of a patent to persons "having an interest in opposing the grant of letters patent," is still substantially in force.

There is no restriction imposed by sect. 25, sub.-sect. 2, upon the persons who may enter a caveat against the extension of letters patent.

Grounds of opposition.

3 *The applicant having obtained the invention from him.*—Invention here means the *entire* invention. It means an invention identical with the invention purported to be intended to be patented, and does not involve that the opponent must have a patentable invention: *Thwaites's Application* (1892), 9 R. P. C. 515.

Applicant having obtained invention from opponent.

Where *part* of an invention only was communicated by the opponent to the applicant the usual practice has been to seal a patent to them *jointly*: *Eadie's Patent* (1885), Griff. P. C. 279; *Garthwaite's Patent* (1886), Griff. P. C. 284.

Under sect. 11, sub.-sect. 1, the comptroller-general or the law officer cannot inquire into the circumstances under which an invention was *imported* into this country, *e.g.*, whether there was fraud on the part of the person making the communication from abroad: *Edmunds's case* (1886), Griff. 281; *Higgins's case* (1892), 9 R. P. C. 74.

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: *Huth's Patent* (1884), Griff. P. C. 292.

Meaning of "legal representative."

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: *Edmunds's Patent* (1886), Griff. P. C. 282.

The *assignee* of a prior patent is not "the legal representative" of the patentee within the meaning of this sub-section: *Adolph Spiel's Patent* (1888), 5 R. P. C. 282.

Meaning of "patented."

5 *Has been patented*:—

The word "patented" is construed strictly (*Cumming's Patent* (1884), Griff. P. C. 277; *Stubbs's Patent* (1884), Griff. P. C. 298; *Welch's Patent* (1884), Griff. P. C. 301), 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. But it is not necessary to show that the patent is a valid one: *Thornborough's case* (1896), 13 R. P. C. 115. **Sect. 11.**

It will not do for him to produce merely a provisional specification (*Bailey's Patent* (1884), Griff. P. C. 269); but in *L'Oiseau and Pierrard* (1887), Griff. A. P. C. 36 (cp. *Dundon's Patent* (1885), Griff. P. C. 278), 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: *Lancaster's Patent* (1884), Griff. 294; *Re Stewart's Application* (1896), 13 R. P. C. 627.

Where the applicant's invention is simply an improvement on a prior invention the specification should state this, and a reference or disclaimer will be required showing that the patent is granted for the improvement only: *Hoskins's Patent* (1884), Griff. 291; *Welch's Patent* (1884), Griff. 200; *Van Gelder's Patent* (1892), 9 R. P. C. 325; *Tattersall's Patent* (1892), 9 R. P. C. 150.

The law officers are unwilling to refuse to seal the patent applied for unless there is a tolerably clear case of identity between the invention covered by it and that covered by the old patent: *Stuart's Application* (1892), 9 R. P. C. 452. They do not consider whether the invention claimed is subject-matter: *Todd's Application* (1892), 9 R. P. C. 487. Want of invention may be an element to be considered when there is doubt whether the prior patent is the same as that before the law officer. If, *e.g.*, after eliminating from the applicant's invention everything in the prior invention, there be nothing patentable left, the patent will be refused. See *Wylie and Norton's Application* (1896), 13 R. P. C. 97; *Hedge's Patent* (1895), 12 R. P. C. 136.

Where two inventions are *clearly identical*, it is no defence for an applicant to allege that his opponent has included in his complete 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: *Green's Patent* (1885), Griff. 287. Indeed, before the law officer complete specifications only are considered, except in case of opposition on the ground mentioned in the next note. Where the field of invention is narrow the applicant will be tied down very closely to what is foreshadowed in the provisional.

6 *Or on the ground that the complete specification describes, &c.*— This clause, which was enacted by the Patents Act, 1888, sect. 4, Act of 1888, sect. 4.

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meets and resolves a doubt expressed by Sir Richard Webster, A.-G., in *Newman's Patent* (1888), 5 R. P. C. 278. As to its effect on applications under international arrangements, see *Main's Application* (1890), 7 R. P. C. 13.

The clause does not cause that to be nonconformity which was not so before; it merely entitles parties to object to a grant of a patent who previously had no *locus standi*: *Edwards's Application* (1894), 11 R. P. C. 461. As to how far this is retrospective see *Anderson* v. *Anderson* (1891), 8 R. P. C. 323.

7 *Notice of opposition to applicant.*—As to procedure, see Patents Rules, 1890, rules 34 *et seq.*, p. 696.

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: *Chandler's Patent* (1886), Griff. 273.

The patent should be stopped only in a clear case: *Todd's Application* (1892), 9 R. P. C. 487.

9 *Subject to appeal.*—An appeal to the law officer is a re-hearing; but, apart from special circumstances, costs follow the event: *Stubbs' Patent* (1884), Griff. P. C. 298.

Practice where applicant failed to appear.

10 *Hear the applicant.*—*In the matter of Ainsworth's Patent* (1885), Griff. 269, 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.

Entitled to be heard.

11 *Entitled to be heard.*—*In the matter of Heath and Frost's Patent* (1886), Griff. P. C. 290, 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."

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: *Glossop's Patent* (1884), Griff. 286; not so a

person who had merely manufactured articles under a prior patent: *Bairstowe's Patent* (1888), 5 R. P. C. 286.

In the matter of Heath and Frost's Patent (1886), Griff. 288, 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. The grantee of a prior expired patent was heard: *Re Lancaster* (1884), Griff. 293; and see *Re Stewart* (1896), 13 R. P. C. 627.

It would appear that any member of the public can, on the stated grounds, oppose before the comptroller. In *L'Oiseau and Pierrard* (1887), Griff. 36, however, the comptroller went into the question of interest.

If a person is before the law officer he may rely upon specifications in which he is not interested, provided he have a *locus standi*: *Stewart's Application* (1896), 13 R. P. C. 627.

The grounds of opposition before the law officer are the same as those before the comptroller: *ibid.*

12 It wants a clear case to stop a patent; see note 8. A reference to a former patent should be ordered only if without it the sealing would necessarily be refused: *Marsden's Patent* (1896), 13 R. P. C. 87. It is not usual to insert a reference merely to call attention to a prior patent: *Adams's Application* (1896), 13 R. P. C. 548. As to special references, see *Heald's Patent* (1891), 8 R. P. C. 429; *Stell's Patent* (1891), 8 R. P. C. 235; *Welch's Patent* (1891), 8 R. P. C. 442.

13 *Power of law officer to call in expert.*—Under the Patent Law Amendment Act, 1852, sect. 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."

Power of law officer to summon expert.

As to scientific assessors in legal proceedings, see sect. 28, sub-sects. 2 and 3, p. 612.

14 *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.

12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a

Sealing of patent.

Sect. 12. patent, the comptroller shall cause a patent[1] to be sealed with the seal of the Patent Office.[2]

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

(3.) A patent shall be sealed[5] as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

(a) Where the sealing is delayed[6] 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.[7]

Act 1885, sect. 3. Extension of time for leaving and accepting complete specification and sealing.

A complete specification may be left and accepted within such extended times,[8] 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[9] 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.

1 *A patent.*—See Form of Patent, annotated at pp. 665 *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*, Skin. 225, 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. Cp. Hindmarch, 36, 37.

Seals formerly in use.

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.

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: Hindmarch, p. 36.

For the purposes of letters patent, however, the seals of the three kingdoms were in one sense distinct: 6 Ves. 708.

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": Webs. 67, n. (*e*).

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.

Former practice as to time of sealing.

5 *Sealing of patent:*

Under the Patent Law Amendment Act, 1852, sects. 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;

Sect. 12. Or, the comptroller has, under sect. 3 of the Act of 1885, allowed an extended time for leaving and accepting the complete specification, in which case a further extension of four months after the said fifteen months is granted.

6 *As to appeals in opposition cases*, see *ante*, p. 244.

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, rules 49 and 50, pp. 699, 700.

9 *Prescribed fee.*—See p. 712.

Date of patent.

13. Every patent shall be[1] dated and sealed as of the day of the application: Provided that no proceedings[2] 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.[3]

Act 1885, sect. 4.
Specifications, &c., not to be published unless application accepted.

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

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 ante-dated: 1 W. P. C. 430, n. (*c*).

15 & 16 Vict. c. 83, s. 23, provided that letters patent might (the Act of 18 Hen. 6, 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

made a condition of sealing a patent that it should bear a particular date. Cp. *Ex parte Bates and Redgate* (1869), L. R. 4 Ch. 577; *Ex parte Bailey* (1872), L. R. 8 Ch. 60; *Ex parte Harrison* (1874), L. R. 9 Ch. 632.

The Act is imperative upon this point. Act of 1883.

As to date of patents granted under International and Colonial Arrangements, see Chap. XVIII., pp. 533 *et seq.*

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

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. See *Ex parte Bates, supra.* Cp. *Saxby v. Hennett*, 1873, L. R. 8 Ex. 210; *Ex parte Scott and Young*, 1871, L. R. 6 Ch. 274.

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.

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.[1] Provisional protection.

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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. The period of provisional protection is that between the date of application and the actual date of sealing of the patent.

This is a re-enactment, with modifications, of sect. 8 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. 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; *contrâ*, per Earl Cairns, L. C., *In re Dering's Patent* (1879), L. R. 13 Ch. D. 393.

It does not entitle him to sell his articles with the word "patent" on them: *R.* v. *Wallis* (1886), 3 R. P. C. 1; *R.* v. *Crampton* (1886), 3 R. P. C. 367.

It may be taken that provisional protection dates from the day of the application, but that when obtained it is obtained only after the official acceptance of the provisional by the Patent Office. An applicant, therefore, runs some risk in exhibiting or vending his invention prior to this date, the comptroller having power to cause an application to be post-dated in case of insufficiency of the application and of the accompanying specification. In case of application with a complete in the first instance, the same caution has to be observed.

PROTECTION BY COMPLETE SPECIFICATION.

Effect of acceptance of complete specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant

shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification:[1] 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.[2] Sect. 15.

1 Does this entitle him to mark articles sold with the word "patent," and yet avoid the penalty prescribed by sect. 105? The answer to be given is not certain. See notes to sect. 105, *post*, p. 656; and see *ante*, p. 544.

2 *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.

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

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. There is at present no patent right for inventions in the Channel Islands.

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

17. (1.) The term limited in every patent for the duration[1] thereof shall be fourteen years[2] from its date.[3] Term of patent.

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease[3a] if the patentee[4] fails to make the prescribed payments within the prescribed times.[5]

(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[6] for making that payment.

Sect. 17. (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 proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.[7]

1 *Duration of Patent:*

The term given by a patent commences on *the day of the date* of the letters patent; Patent 1st January, 1890, expires 31st December, 1904: *Russell* v. *Ledsam* (1845), 14 M. & W. 574, 582.

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: *Ibid.*

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

3 *From its date.*—The patent is dated as of the day of application; so it is really ante-dated. As to this, see *ante*, p. 580.

As to date of patent under International and Colonial Arrangements, see p. 653.

3a If the prescribed time, or the prescribed time as extended, has elapsed, there is yet a means of getting the patent supported, viz., to apply to Parliament to pass a bill to confirm the patent. But special circumstances must be shown; see *ante*, Chap. XVII.

4 *The patentee* is the person who is for the time being entitled to the benefit of a patent: sect. 46.

5 *Prescribed payment within the prescribed times.*—For the prescribed payments and times, see the Patents Rules, 1892, p. 709.

A payment is within the prescribed time if made before midnight on the anniversary of the day of the date of the patent: *Williams v. Nash* (1859), 28 Beav. 93; 28 L. J. Ch. 886.

6 *Application for enlargement of time.*—For form of application, see Patents Rules, 1890, Form K., p. 813.

As to contents of application, see Patents Rules, 1890, rule 49, p. 699.

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.[1]

Amendment of specification.

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

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

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

(4.) The law officer shall, if required,[12] 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,[12a] and shall determine whether and subject to what conditions,[13] if any, the amendment ought to be allowed.

(5.) When 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 comp-

Sect. 18. troller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required,[12] hear the person making the request and the comptroller,[13a] 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[14] 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,[15] except in case of fraud;[16] and the amendment shall in all Courts and for all purposes[16a] be deemed to form part of the specification.

Repealed. Act 1888, sect. 5. (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.*

Act 1888, sect. 5. (10.) The foregoing provisions[17] of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.[18]

1 *Amendment of specifications.*—See on the whole subject Chap. VII., p. 211. For the practice under this and the following section, see Patents Rules, 52 *et seq.*, *post*, p. 700, also Law Officers' Rules, *post*, p. 713.

After publication of the specification proceedings to amend under sects. 7 and 9 are improper: *Jones's Patent* (1816), Griff. P. C. 313.

True reading of sects. 18–21. The true reading of sects. 18—21 was given by A. L. Smith, J., *In the matter of Hall and Others* (1888), 21 Q. B. D. 137; 5 R. P. C. 312:—"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."

2 *An applicant or a patentee* :—

For practice under this section, see Patents Rules, 1890, rule 52, p. 700.

For definition of "patentee," see note to sect. 46. Under that definition a grantee who had wholly parted with his interest in a patent could not, it would seem, apply under sect. 18, sub-sect. 1, for leave to disclaim or amend any part of his specification. As to the position of a mortgagee and a co-owner, see *ante*, p. 219.

3 *From time to time.*—Second disclaimers are therefore permissible, but are not encouraged: *Re Haddan*, Griff. A. P. C. 13. Nor should a disclaimer be unnecessarily brought before the comptroller twice: *Re Arnold*, Griff. A. P. C. 5.

4 *By request in writing* :—

Cp. sect. 97, *infra*, and Patents Rules, 1890, rule 52, p. 700.

For form of application, see Form F, *post*, p. 810.

5 *His specification.*—This must mean his complete specification after acceptance, before which there is no publication from the Patent Office. Cp. sect. 10; but see remarks of Webster, A.-G., in *Re Jones*, Griff. 313.

6 *Disclaimer, correction, or explanation* :—

The power to amend by way of correction or explanation is new. It will be observed that the same power is not given in sect. 19.

When it is probable that a combination alone is claimed, though the language be ambiguous, it is permissible so to amend as to make it clear that a combination alone is claimed: *Allen's Patent* (drain-pipes), Griff. A. P. C. 3; *Kelly* v. *Heathman* (folding ladders) (1889), 45 Ch. Div. 256; 8 R. P. C. 343.

But if an improved method is claimed apart from particular means, the patentee cannot amend so as to insert all particular means: *Nairn's Patent* (1891), 8 R. P. C. 445; *Beck and Justice's Application*, Griff. A. P. C. 10; *Nordenfelt's Patent*, Griff. A. P. C. 18, even though the

Sect. 18. principal part be struck out: *Serrell's Patent* (1889), 6 R. P. C. 101. But if every means of carrying out the invention is claimed, and one only is stated in the specification, the generality of the claim may be restricted: *Re Ashworth*, Griff. A. P. C. 6.

The function of an explanation is to say what the patentee meant at the time of sending in his specification; it is not allowable to amend a specification in order to make it keep pace with newly discovered facts: *Re Beck and Justice, supra.*

If the original specification amply describes the invention, amendment by way of explanation will not usually be allowed: *Re Nordenfelt*, Griff. A. P. C. 21.

Amendment by disclaimer is not allowed as a means of turning an insufficient into a sufficient description: *Re Johnson's Patent* (1896), 13 R. P. C. 659.

The reasons are no part of the amendment.

7 *Shall be advertised in the prescribed manner:—*

Advertisement in the Official Journal of the Patent Office is required (Patents Rules, 1890, rule 52, p. 700).

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.

Want of advertisement was one of the grounds upon which the amendments were disallowed in *Re Jones*, Griff. 313.

In *Fabenfabriken* v. *Bourker* (1891), 8 R. P. C. 389, Romer, J., refused to upset an amendment on the ground of non-advertisement, saying that he could not go behind the comptroller-general's amendment.

8 *Any person:—*

In *Bell's case*, Griff. A. P. C. 10, the comptroller seems to have decided that this means a person who has an interest in opposition, but *quære;* and contrast the language of sub-sect. 4.

9 *Notice of opposition, &c.:—*

Cp. Patents Rules, 1890, rule 53, p. 701.

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

The notice should be signed.

10 *The comptroller shall give notice.*—For practice, see Patents Rules, 1890, rule 53, p. 701.

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: *Hearson's Patent* (1884), Griff. 309. It is better to give leave than to refuse in doubtful cases, as the amendment is taken at the applicant's peril: *Re Bell*, Griff. A. P. C. 10; *Re Lake*, *ibid.* 16. Evidence may be heard; the regulations as to declarations will be found in Patents Rules, 1890, rules 56, &c., *post*, p. 702. The evidence before the law officer should be the same as that used before the comptroller: Law Officers' Rules, rule 8. The law officer may compel attendance for cross-examination. See Law Officers' Rules, rule 9, *post*, p. 716. It is not obligatory to file declarations: *Re Rylands*, 5 R. P. C. 665. Unnecessary declarations will be discouraged: per Lockwood, S.-G., 12 R. P. C. 102.

The comptroller cannot, however, give costs. See *ante*, p. 231.

The law officer can give costs. See *infra*, sect. 38. He usually makes the unsuccessful party pay costs: *Re Haddan*, Griff. A. P. C. 13; but he neither gives costs to the comptroller nor makes him pay them, either directly, or by way of condition; but he may impose a pecuniary condition otherwise than by way of costs: *Re Lake*, Griff. A. P. C. 17.

12 *The law officer shall, if required, &c.*—For practice under this sub-section, see the Law Officers' Rules, *infra*, p. 713.

12a It is not every person who may oppose before the law officer, *aliter* before the comptroller. See sub-sect. 2.

13 *What conditions, if any, &c.:—*

Conditions of amendment being allowed.

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. 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. In view of sect. 20, this is not usually imposed unless the patent was one granted before 1884; and even then *quære: Re Ashworth*, Griff. A. P. C. 6; *Re Allen*, Griff. A. P. C. 3. In *Re Ainsworth* (1895), 13 R. P. C. 76, Finlay, S.-G., refused to make the amendment conditional on the patentee undertaking neither to bring action nor to threaten in respect of acts done prior to amendment, but he thought he had power to do so.

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?

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Had there been a long prior user? Had manufacturers embarked capital in making and dealing with it? Cp. *Harrison's Patent* (1853), Macr. P. C. 31; *Smith's Patent* (1855), *ibid.* 232, 234; *Tranter's Patent* (1873), Johns. P. M. 191. As to time whence amendment dates when condition is accepted, practice as to recording of the condition, &c., see *Andrew* v. *Crossley* (1892), 1 Ch. 492; 9 R. P. C. 165; also for refusal of condition (1892), 1 Ch. 498.

13a The comptroller may appear, but will ordinarily neither get nor pay costs.

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.

An amendment which merely removes ambiguity is unobjectionable: *Moser* v. *Marsden* (1894), 10 R. P. C. 350. See note 6 above.

At one time the tendency was to allow an amendment at the patentee's risk, but the decision in *Moser* v. *Marsden* (13 R. P. C. 24; and see note 16a, *infra*) has caused the law officers to be more difficult to satisfy. And see *Re Parkinson* (1896), 13 R. P. C. 509.

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. Does it debar the Court from inquiring whether the amendment claims an invention substantially larger than, or different from, that claimed in the original specification? See *Farbenfabriken Co.* v. *Bowker* (1891), 8 R. P. C. 389; *Van Gelder's Patent* (1890), per Esher, M. R., 6 R. P. C. at p. 27. It has been said that the Attorney-General cannot make a valid amendment if the effect is to substantially enlarge the invention, or make it a different invention. That is by virtue of sect. 18, sub-sect. 8. Now, however, it is clear that an amendment, when once allowed by the law officer, is conclusive. See *Moser* v. *Marsden*, in the House of Lords, 13 R. P. C. 24; and see *ante*, pp. 231, 232.

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: *Re Berdan's Patent* (1875), 20 Eq. 346.

16a "For all purposes" must now be taken to mean that an amendment once made by the law officer is unimpeachable: *Moser* v. *Marsden* (1896), 13 R. P. C. 24.

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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? *Cochrane's Patent* (1885), Griff. P. C. 305.

(2) Did they include only actions for infringement and proceedings for revocation? *Cropper* v. *Smith* (1884), 1 R. P. C. 254; and *In re Hall and Others* (1888), 21 Q. B. D. 137; 5 R. P. C. 306.

As to the construction of sects. 18—21, see general note above, p. 586.

18 *Pending.*—This means action before judgment in the High Court of Justice. See definition of "Court," sect. 117, sub-sect. 1. Therefore the provisions of sect. 18 apply after judgment pending appeal: *Cropper* v. *Smith*, 28 Ch. D., per Chitty, J., at p. 151. In *Farbenfabriken, &c., Co.* v. *Bowker* (1891), 8 R. P. C. 389, Romer, J., refused to go into the question whether an action was pending when leave to amend was granted. He said he could not go behind the comptroller-general's amendment. If the comptroller gives leave to amend upon a condition accepted at the hearing, see *Andrew* v. *Crossley* (1892), 1 Ch. 492; on the question of the pendency of the amendment when action is commenced, *ante*, pp. 233 *et seq.*

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

19. In an action for infringement of a patent,[1] and in a proceeding for revocation[2] of a patent, the Court or a Judge[2a] 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,[3] and may direct that in the meantime the trial or hearing of the action shall be postponed.

If leave is obtained the procedure of sect. 18 applies so far as possible: Cave, J., in *Re Hall* (1888), 21 Q. B. D. 137; 5 R. P. C. 312; *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389.

1 *Action for infringement.*—See Chap. XIII.

2 *Proceeding for revocation.*—See sect. 26 and Chap. XV. It seems doubtful if an amendment pending appeal can be made if the patent was revoked in the Court below, unless time for appeal was given in the judgment: *Deeley's Patent* (1896), App. Ca. 496; 13 R. P. C. 581.

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2a This means the High Court of Justice. See *post*, sect. 117. But the Palatine Court of Lancaster has jurisdiction: *Winter* v. *Baybut* (1884), 1 R. P. C. 76. The application may be made at Chambers: *Singer* v. *Stassen* (1884), W. N. 83; 1 R. P. C. 121.

3 *Disclaimer pending action.*—As to disclaimer pending action, see p. 233.

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

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, rule 58, p. 702.

The Judge has an absolute discretion in imposing terms under sect. 19: *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389. The usual conditions imposed relate to costs, previous infringements, and using the amended specification in the action; viz., plaintiff (1) pays costs of amendment and all costs of action up to amendment (*e.g.*, *Goulard* v. *Lindsay* (1888), 5 R. P. C. 194); (2) undertakes to claim no relief for damage suffered prior to amendment (*e.g.*, *Lang* v. *Whitecross Co.* (1890), 7 R. P. C. 389); (3) agrees not to use the amended specification in the action (*e.g.*, *Singer* v. *Sassen* (1884), 1 R. P. C. 121; W. N. 83). His right to an injunction for threatened future proceedings is left to him.

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages[1] 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.[2]

1 An injunction would not be affected by this.

2 *Where an amendment by way of disclaimer, &c.*—For examples, see *Wenham* v. *Carpenter* (1888), 5 R. P. C. 68; *Hopkinson* v. *St. James's and Pall Mall Electric Light Co.* (1893), 10 R. P. C. 46. This section does not appear to affect the law officer's power to impose conditions under sect. 18, sub-sects. 4, 7.

Advertisement of amendment.

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

Every amendment, &c. (sect. 21).—Cp. Patents Rules, 1890, rule 59, p. 702. The amendment is advertised in the Official Journal of the Patent Office, and in such other manner, if any, as the comptroller may direct. **Sect. 21.**

COMPULSORY LICENCES.[1]

Power for Board to order grant of licences.

22. If on the petition of any person interested[2] it is proved to the Board of Trade that by reason of the default of a patentee to grant licences[2a] on reasonable terms—

(a) The patent is not being worked[3] in the United Kingdom, or

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

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

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just,[4] and any such order may be enforced by mandamus.

1 *Compulsory licences.*—As to voluntary licences and assignments, see *ante*, p. 300.

The provisions of this section are new, and apparently only refer to patents applied for since January 1st, 1884.

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

History of the compulsory licence 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 1864.

The Committee of 1864 reported against compulsory licences, apparently on two grounds: (1) that the exceptional instances in which patentees were unwilling to grant licences 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

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Committee of 1872.

The Select Committee of 1872 advised the insertion of a compulsory licence 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.

The difficulty is not to compromise the rights of the owner in his invention, and at the same time to obviate the objection commonly raised against patent right in inventions, that it gives an opportunity for the acquisition of patents for obstructive purposes. But for this section a patent might be thus used to prevent a subsequent patentee of an improvement making use of his invention.

Results of compulsory licence clause.

This section has not justified the hopes of its framers, and has been practically inoperative. Up to the end of the year 1887 there was only one informal application for a compulsory licence, 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 licences rather than be forced to appear before the Board of Trade.

Scope of section.

This section does not apply to patents granted, or applications pending, *before* the commencement of this Act (sect. 45, subsect. 2); but it applies to a new patent granted after the Act by way of extension of the term of an existing patent: *Wasteney Smith's Patent* (1885), 2 R. P. C. 14. But it is difficult to understand this decision in the face of decisions under sect. 113 of Act of 1883. Of course the Judicial Committee in recommending an extension may make any conditions with regard to the patent, and among others may be liability to the compulsory licence provisions of this 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 H 1, and I, *infra*, pp. 811, 812.

2a Suppose an exclusive licence has been granted to some person, then *quære* can the Board of Trade make an order for a licence to another person? It would seem that this could be done. The holder of the exclusive licence must be presumed to know of this risk. If the exclusive licence operated as an assignment, then the application ought to be against exclusive licensee.

Proof of default in granting licences on reasonable terms is a condition precedent to order for compulsory licence. **Sect. 22.**

Meaning of working.

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 sect. 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 could 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 licence could successfully lodge a petition, according to any one of the sub-sections (a), (b), (c), without having to bring himself in any way within the other two.

4 This would be a difficult matter, and would probably necessitate a reference to one of the conveyancing counsel to the Court.

REGISTER OF PATENTS.

Register of Patents.

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

(2.) The Register of Patents shall be *prima facie* evidence[2] of any matters by this Act directed or authorised to be inserted therein.

(3.) Copies of[3] deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

1 *Register of Patents.*—See Chap. XI., p. 309.
Inspection of and extracts from register, sect. 88.
Falsification of register, sect. 93.

Sect. 23. Powers of Board of Trade over, sect. 101, sub-sect. 1 a.

Under the Act of 1852, 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, licences, and other matters relating to the *proprietorship* 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-sect. 1, and sect. 114, sub-sect. 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-sect. 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 under sects. 85 and 87, the documents, notification of which may now be entered on the register, must confer a legal interest. Nevertheless an equitable assignment of a patent or a share in it may be registered: *Stewart* v. *Casey* (1892), 1 Ch. 104; 9 R. P. C. 9. But the documents must be complete in themselves, and must show the assignment, otherwise they will not be registered: *Fletcher's Patent* (1893), 10 R. P. C. 252. As to the registration of mortgages, see *Van Gelder* v. *Sowerby Bridge Flour Co.* (1890), 7 R. P. C. 208; 44 Ch. Div. 374.

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* (1888), 5 R. P. C. p. 126, "to decide, and in deciding I should feel some 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." **Sect. 23.**

See sects. 87 and 90, *infra*; Patents Rules, 1890, rules 67—79, *infra*, pp. 704 *et seq.*

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: *Heap* v. *Hartley* (1888), 5 R. P. C. 609, and 42 Ch. Div. 461.

3 *Copies of deeds, &c.*—As to size of documents, see Patents Rules, 1890, rules 10, 30—33, pp. 685, 694. 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[1] in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees in schedule.

(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. 710.

Sect. 25.

EXTENSION OF TERM OF PATENT.[1]

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

25. (1.) A patentee[2] may, after advertising[3] in manner directed by any rules made under this section[4] his intention to do so, present a petition[5] 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[6] before the time limited for the expiration of the patent.

(2.) Any person[7] may enter a caveat,[8] 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,[9] and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel[10] 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,[11] to the profits made by the patentee as such,[12] and to all the circumstances of the case.[13]

(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[14] for a further term not exceeding seven, or in exceptional cases fourteen,[15] years; or to order the grant of a new patent[16] for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.[17]

(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.[18]

(7.) The costs[19] 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. **Sect. 25.** Costs.

1 As to prolongation or extension of patents generally, see Chap. XVI. pp. 496 *et seq.*

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 sect. 113. See also *Brandon's Patent* (1884), 9 App. Ca. 589; 1 R. P. C. 154, and *ante*, p. 499. 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 (*Church's Patent* (1886), 3 R. P. C. 95), 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: *In re Willacy's Patent* (1888), 5 R. P. C. 690.

An assignee will not get an extension unless the result will be directly or indirectly to the advantage of the inventor, and only then in a case when the inventor himself has been entitled: *Re Barff-Bower* (1895), App. Ca. 675; 12 R. P. C. 383; *Re Hopkinson's Patent* (1896) 14 R. P. C. 5.

3 *After advertising.*—See form of advertisement, p. 853; affidavit of advertisement, p. 854. The advertisement.

The advertisement must be proved before the application is heard: *Perkin's Patent* (1845), 2 W. P. C. 8.

In the matter of Derosne's Patent ((1844) 2 W. P. C. 1), the petitioner resided in France, but had granted licences to persons

Sect. 25. 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 with 5 & 6 Will. IV. c. 83, are still in force.

The petition.

5 *The petition.*—See forms of petition *infra*, pp. 856-8.

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 (*Clark's Patent* (1870), L. R. 3 P. C. 421); 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: *Pitman's Patent* (1871), L. R. 4 P. C. 84; *Johnson's Patent* (1871), L. R. 4 P. C. 75; *Adair's Patent* (1881), L. R. 6 A. C. 176. If he knows of a prior specification which might affect the question he should produce it: *Livet's Patent* (1892), 9 R. P. C. 327.

Time of presentation.

6 *At least six months:*

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. 2 & 3 Vict. c. 67, s. 2, provided that where the failure to comply with the requirement of the earlier statute was shown not to have arisen from neglect or default of the petitioner, the term of letters patent might be extended, if a petition has 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, sect. 40, adopted the provisions of the above mentioned Acts in regard to the extension of letters patent.

Saving of existing rights.

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: *Brandon's Patent* (1884), 9 App. Ca. 589; 1 R. P. C. 154. But in such case if his patent is posterior in date to a foreign patent granted to him for the same invention, he cannot obtain prolongation if his foreign patent has lapsed: *Jablochkoff's Patent* (1891), App. Ca. 293; 8 R. P. C. 281. *Aliter*, if the foreign patent was the later: *Semet and Solvay's Patent* (1895), App. Ca. 78; 12 R. P. C. 10.

Sect. 25.

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

Who may oppose

The Crown may adduce evidence against a patent, irrespective of the objections (*Church's Patent* (1886), 3 R. P. C. at p. 101; citing *Re Ball's Patent* (1879), L. R. 4 A. C. 173), and in *Erard's Patent* ((1835) 1 Web. P. C. 557)—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* ((1849) 13 Jur. 593), 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. 854; form of notice of objection, p. 864.

The caveat.

It appears that the caveat must be entered by the actual opponent and not by a patent grant: *Lowe's Patent* (1852), 8 Moo. P. C. 1.

Particulars of objection.

The present Act, like the repealed Acts, 5 & 6 Will. IV. c. 83, and 2 & 3 Vict. c. 67 (*Ball's Patent* (1879), L. R. 4 A. C. 171), does not require particulars of objections in extension cases, but in the matter of *Stewart's Patent* ((1886) 3 R. P. C. 7), where the opposition succeeded upon the ground of an anticipation not mentioned in the objections, the opponent's costs were disallowed.

9 *The said Committee shall proceed to consider.*—By sect. 28, sub-sect. 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: *Perkin's Patent* (1845), 2 Web. P. C. 6. See form of accounts, *infra*, p. 861.

10 *By counsel:*

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose: *In re Woodcroft's Patent* (1841), 3 Moo. P. C. 172, n.

Counsel.

In all petitions for the extension of letters patent, whether opposed or not, the Attorney-General attends on behalf of the Crown (*In re Erard's Patent* (1835), 1 Web. P. C. 557); 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: *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133.

Position of Attorney-General.

Sect. 25.

Nature and merits of invention.

11 *The nature and merits of the invention in relation to the public.*—On this subject, see Chap. XVI., p. 511.

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. They will hear a petition though an appeal be pending from the decision of a Judge declaring the patent invalid: *Lane-Fox's Patent* (1892), 9 R. P. C. 411.

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: *In re Stewart* (1886), 3 R. P. C. 9, 10; cp. also *In re Bailey's Patent* (1884), 1 R. P. C. 1; *Re Cocking's Patent* (1885), 2 R. P. C. 151, 153; also citing *Saxby's Patent*, L. R. 3 P. C. App. 294; *Beanland's Patent* (1887), 4 R. P. C. 491; *Livet's Patent* (1892), 9 R. P. C. 327. But a patent which is clearly bad will not be prolonged: *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.

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: *Re Willacy's Patent* (1888), 5 R. P. C. 690.

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: *Pieper's Patent* (1895), 12 R. P. C. at p. 293; *In re Newton's Patent* (1884), 1 R. P. C. 177; 9 A. C. 592. A licensee's profits should generally be shown; certainly if the licensee is a free licensee: *Thomas' Patent* (1892), 9 R. P. C. 367. The profits of an assignee or part assignee should be taken into the account: *Ibid.*; *Barff-Bower Patent* (1895), App. Ca. 675; 12 R. P. C. 383.

Accounts.

Under the Judicial Committee Rules, rule 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 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: *Re Bailey's Patent* (1884), 1 R. P. C. 1. Where the patentee had made a complete loss, accurate accounts were dispensed with: *Darby's Patent* (1891), 8 R. P. C. 380.

In *Re Yates and Kellett's Patent* ((1887) 4 R. P. C. 150; 12 A. C. 147; cp. *Johnson's and Atkinson's Patents* (1873), L. R. 5 P. C. 87), the petitioner failed to file his accounts within the time fixed by the

Judicial Committee Rules, rule 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: *In the matter of Deacon's Patent* (1887), 4 R. P. C. 122.

Onus is on petitioner.

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. The absence of books tells heavily against the petition: *Lawrence's Patent* (1892), 9 R. P. C. 85. 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: *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 App. Ca. 176: *Williams* v. *Robinson* (1896), 13 R. P. C. 350. The Committee cannot be asked to undertake a minute investigation: *Lake's Patent* (1891), App. Ca. 240; 8 R. P. C. 230.

Duty to keep patent account.

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: *Bett's Patent* (1862), 1 Moo. P. C. N. S. 49; *Trotman's Patent* (1866) L. R. 1 P. C. 118; *Lake's Patent* (1891), A. C. 240; 8 R. P. C. 230.

In estimating a patentee's expenditure, the Judicial Committee may take account of (a) the *reasonable* cost of working the patent: *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.; (b) the value of the patentee's *time* properly expended upon working his invention: *Roberts's Patent, ubi supra; Trotman's Patent* (1866), L. R. 1 P. C. 118; *Carr's Patent* (1873), L. R. 4 P. C. 539; (c) exceptional loss by litigation: *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; (d) manufacturer's profits *not due to the monopoly conferred by the patent*: *Galloway's Patent* (1843), 1 Web. P. C. 724; *Muntz's Patent* (1846), 2 Web. P. C. 113; and (e) costly experiments in connection with the invention: *Davies' Patent* (1894), 11 R. P. C. 28.

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

Sect. 25. be deducted: *Saxby's Patent* (1870), L. R. 3 P. C. 292; cp. also *Hills' Patent* (1863), 1 Moo. P. C. N. S. 258.

Considerations which guide committee.

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

Has the petitioner been prevented by causes beyond his control from deriving an adequate remuneration from the working of his patent? 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.

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 *Perkin's Patent* ((1845) 2 W. P. C. 6) "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.

Has the introduction of the patent been slow? If so, was this to be expected from its nature and the circumstances of the case (*Woodcroft's Patent* (1846), 2 Web. P. C. 18; *Carr's Patent* (1873), L. R. 4 P. C. 539), or is it in evidence of want of utility? (*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 Patent, 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); or want of energy? *Re Pieper* (1895), 12 R. P. C. 293.

Is the public interest opposed to an extension? *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.* Is the prolongation likely to handicap English as against foreign manufacturers: see as to this *Semet and Solvay's Patent* (1895), App. Ca. 78; 12 R. P. C. 10; *Pieper's Patent* (1895), 12 R. P. C. 293.

14 *To extend the terms of the patent*—or part of it: *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 R. .P C. 102.

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: *In re Stoney's Patent* (1888), 5 R. P. C. 519.

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 extension. 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, 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.

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. 865.

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. No fees are payable on sealing the new patent.

17 *Containing any restrictions, conditions and provisions, &c.*—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: *Pettit Smith's Patent* (1850), 7 Moo. P. C. 133; *Hughes' Patent* (1879), L. R. 4 App. Ca. 174; *Napier's Patent* (1881), L. R. 6 App. Ca. 174.

A condition requiring the patentee to grant licences to the public was inserted in *Mallet's Patent* (1866), L. R. 1 C. P. 308; but see sect. 22 of the present Act.

In *Hardy's Patent* (1849), 6 Moo. P. C. 441, a condition to prevent

Sect. 25. 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.

Rules of practice.

18 *Rules of procedure and practice.*—No rules have yet been made. For the old rules still in force, see p. 718.

19 *Costs.*—Where there was ground for opposition, and the case was doubtful and difficult, the Judicial Committee made no order as to costs: *Church's Patent* (1886), 3 R. P. C. at p. 102.

It is unnecessary for opponents to give notice of their intention to apply for costs (*Bridson's Patent* (1852), 7 Moo. P. C. C. 499), and these will, in general, follow a successful opposition: *Westrupp and Gibbins' Patent* (1836), 1 Web. P. C. 554.

In *Wield's Patent* ((1871), L. R. 4 P. C. 89), 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 *bonâ 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: *Hornby's Patent* (1853), 7 Moo. P. C. C. 503. In *Milner's Patent* ((1854) 9 Moo. P. C. C. 39), an alternative was offered to the petitioner of paying a fixed sum for costs.

A vexatious opposition will be punished with costs: *Dournton's Patent* (1839), 1 Web. P. C. 565.

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

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

Petition.

26. (1.) The proceeding by *scire facias*[1] to repeal a patent is hereby abolished.

(2.) Revocation[2] of a patent[3] may be obtained on petition[4] to the Court.[5]

(3.) Every ground[6] on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(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 authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland:[7]

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

(d) Any person[8] 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.

Particulars of objections.

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

Amendment of particulars.

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

(7.) The defendant shall be entitled to begin,[11] 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,[12] 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[13] 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. XV., p. 484.

2 *Revocation.*—See Chap. XV., p. 484.

For order of revocation, see p. 852.

For order dismissing petition, see p. 853.

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-sect. 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-sect. 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*, p. 850.

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, 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: Hindmarch, p. 431.

Court.

5 *The Court.*—"Court" means, in England, the High Court of Justice for England (sect. 117, sub-sect. 1); in Scotland, the Court of Session (sect. 111, sub-sect. 1); and in Ireland, the High Court of Justice for Ireland (sect. 117, sub-sect. 1). Service of the petition cannot be made on a person domiciled abroad, but notice of the proceedings should be given him; and the Court, if satisfied that injustice will not be done by proceeding, will allow the petition to go on: see *Drummond's Patent* (1889), 43 Ch. Div. 80; 6 R. P. C. 576:

Re Goerz's & Hoegh's Patent (1896), 12 R. P. C. 370; *King & Co.'s Trade Mark* (1892), 2 Ch. 462; 9 R. P. C. 350; *Re Kay's Patent* (1894), 11 R. P. C. 279; *Re La Compagnie Générale d'Eaux Minerales, &c.* (1891), 3 Ch. 451; 8 R. P. C. 441. The defeated party may appeal to the Court of Appeal and thence to the House of Lords, as was done in *Re Deeley's Patent* (1896), App. Ca. 496; 13 R. P. C. 581.

6 *Grounds of scire facias.*—An action of *scire facias* lay in three cases.

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 (4 Inst. 88).

7 *Authorization of petition:*

When it is desired to obtain the Attorney-General's authority under this sub-section, it is necessary to send certain papers to the Patent Clerk, at the Royal Courts of Justice, London, and these are set out *ante*, p. 488.

The Attorney-General sometimes gives or refuses his authority *ex parte*. He may give it after revocation proceedings have been actually started: *Re Dege's Patent* (1895), 12 R. P. C. 448.

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

The principles upon which the Attorney-General acts are stated *ante*, p. 489.

The authorization should be recited in the petition: *Glazbrook* v. *Gillatt* (1840), 9 Beav. 492.

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: *Re Avery's Patent* (1887), 36 Ch. D. 307; 4 R. P. C. 158, 159.

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 a patent, such as variance, *Vickers* v. *Siddell* (1890), 15 App. Ca. 496; 7 R. P. C. 292; *Nuttall* v. *Hargreaves* (1892), 1 Ch. 23, 28; 8 R. P. C. 450; or that the invention was not proper subject-matter:

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Re Morgan's Patent (1888), 5 R. P. C. 187; *Re Dege's Patent* (1895), 12 R. P. C. 448. But he must, as a preliminary, prove his right to a *locus standi*: *Re Dege's Patent, supra.*

9 *In fraud of his rights.*—For an example see *Re Norwood's Patent* (1895), 12 R. P. C. 214.

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: *Re Avery's Patent* (1887), 36 Ch. Div. 307; 4 R. P. C. 327.

10 *Particulars of objections.*—See notes to sect. 29, sub-sects. 2—5.

11 *The defendant shall be entitled to begin.*—If the defendant intends to take advantage of this, and if the trial be on affidavit evidence, he must file the evidence before the petitioner files his evidence: *Re Gale's Patent* (1891), 8 R. P. C. 438. But though entitled to begin, a respondent is not in the position of a plaintiff, and therefore cannot be ordered to give security for costs on the ground of foreign residence: *Re Miller's Patent* (1894), 63 L. J. Ch. 324; 11 R. P. C. 55.

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., Order XXXI. rule 1, means "petitioner," and that rule applies to petitions for the revocation of a patent: *Haddan's Patent* (1884-5), 54 L. J. Ch. 126; Griffin P. C. 109.

12 The comptroller is not bound to grant the patent under any circumstances: *Re Norwood's Patent* (1895), 12 R. P. C. 214.

13 Cf. sect. 35, *infra.*

Amendment of specification.—During revocation proceedings this is governed by sect. 19, *ante*, p. 591. But if the decision is against the patent, there would be a difficulty in amending pending an appeal, for so long as the decision remains unreversed, the patent has gone. A judgment for revocation should therefore declare the patent revoked only if notice of appeal be not given within a certain time: see *Re Deeley's Patent* (1896), App. Ca. 496; 13 R. P. C. 591.

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.[1]