LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS

TREATISE

ON THE

LAW AND PRACTICE

RELATING TO

Letters Patent for Inventions

WITH

AN APPENDIX

OF

STATUTES, INTERNATIONAL CONVENTION, RULES, FORMS AND PRECEDENTS, ORDERS, &c.

BY

ROBERT FROST, B.Sc. (LOND.)

FELLOW OF THE CHEMICAL SOCIETY;
OF LINCOLN'S INN, ESQUIRE, BARRISTER-AT-LAW

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TO

THE RIGHT HONOURABLE LORD ALVERSTONE,

LORD CHIEF JUSTICE OF ENGLAND,

THIS WORK IS BY PERMISSION

Dedicated

PREFACE.

SINCE the last edition of this work was published two Patent Acts, viz., those of 1901 and 1902, have been added to the Statute Book; new Rules regulating matters of procedure at the Patent Office and before the Judicial Committee of the Privy Council have been made; and many important cases have been decided.

In response to suggestions from both Bench and Bar, I have divided the book into two volumes. I have endeavoured to so arrange the text that only one volume will be required during the hearing of a particular matter, whether in Court, the Judicial Committee of the Privy Council, Judge's Chambers, or at the Patent Office; and the Table of Cases and Index will be found in each separate volume. If desired, the Publishers will supply the two volumes bound in one.

Though the result of my labour falls far short of perfection, I venture to hope that those who consult the book will consider it satisfactorily brought up to date.

I have pleasure in thanking Mr. W. C. Fairweather for the great assistance he gave me in correcting the proof sheets as they came from the press.

5 NEW COURT,
LINCOLN'S INN, W.C.,
October 1906.

PREFACE TO THE FIRST EDITION.

THIS book is my attempt to bring within a reasonable compass our law, as it at present exists, in reference to Letters Patent for Inventions. Any complete history of our legislation in the past upon the subject would have inconveniently added to the bulk of the volume; and, consequently, it has not been referred to, except where necessary to explain the present practice. For the same reason I have omitted all reference to the laws of foreign countries where legal protection to Inventors is afforded.

To the extent that the book approximates to the end I had in view, so must be the measure of its success or failure. Whatever its shortcomings, I hope it may be found of use.

ROBERT FROST.

8 KING'S BENCH WALK, TEMPLE,
January 1891.

ABBREVIATIONS USED IN THIS WORK.

A. & E.	Adolphus and Ellis' Reports.
B. & Ad.	Barnewall and Adolphus' Reports.
B. & Ald.	Barnewall and Alderson's Reports.
B. & C.	Barnewall and Cresswell's Reports.
Beav.	Beavan's Reports.
B. & S.	Best and Smith's Reports.
Bing. N. C.	Bingham's New Cases.
B. & P. N. R.	Bosanquet and Puller's New Reports.
Brod. & Bing.	Broderip and Bingham's Reports.
Bull. N. P.	Buller's Nisi Prius.
Camp.	Campbell's Reports.
C. B.	Common Bench Reports.
C. B. N. S.	Common Bench Reports, New Series.
Car. & K.	Carrington and Kirwan's Reports.
Car. & P.	Carrington and Payne's Reports.
Carp. P. C.	Carpmael's Patent Cases.
C. L. R.	Common Law Reports.
Cl. & F.	Clark and Finnelly's Reports.
Co. R.	Coke's Reports.
Coop. Ch. Ca.	Cooper's Chancery Cases.
Cr. M. & R.	Crompton, Meeson, and Roscoe's Reports.
D. & L.	Danson and Lloyd's Reports.
Dav. P. C.	Davies' Patent Cases.
De G. F. & J.	De Gex, Fisher, and Jones' Reports.
De G. & J.	De Gex and Jones' Reports.
De G. M. & G.	De Gex, Macnaghten, and Gordon's Reports.
De G. J. & S.	De Gex, Jones, and Smith's Reports.
Dowl. & Ry.	Dowling and Ryland's Reports.
Dr. & S.	Drewry and Smale's Reports.
E. & B.	Ellis and Blackburn's Reports,
E. B. & E.	Ellis, Blackburn, and Ellis' Reports.
E. & E.	Ellis and Ellis' Reports.
Eng.	The Engineer (a weekly publication).
Eq. Rep.	Equity Reports.
Exch.	Exchequer Reports.
F. & F.	Foster and Finlason's Reports.
Giff.	Giffard's Reports.
Griff. L. O. C.	Griffin's Patent Cases decided by the Comptroller-General and Law Officers in 1887.
Griff. P. C.	Griffin's Patent Cases.
G. P. C.	Goodeve's Patent Cases.
G. P. P.	Goodeve's Patent Practice.
H. Bl.	H. Blackstone's Reports.
H. & M.	Hemming and Miller's Reports.
H. L. C.	House of Lords Cases.
Holt N. P.	Holt's Nisi Prius Cases.
H. & N.	Hurlstone and Norman's Exchequer Reports.
Ir. Ch. Rep.	Irish Chancery Reports.
Iron	Iron (a weekly publication).

Johns.	Johnson's Reports.
J. & H.	Johnson and Hemming's Reports.
Jur. N. S.	Jurist, New Series.
Jur. O. S.	Jurist, Old Series.
K. & J.	Kay and Johnson's Reports.
L. J. N. S. Ch.	Law Journal Reports, New Series, Chancery.
L. J. N. S. C. P.	" " " Common Pleas.
L. J. N. S. Ex.	" " " Exchequer.
L. J. N. S. Q. B.	" " " Queen's Bench.
L. J. O. S.	Law Journal Reports, Old Series.
L. O. C.	Griffin's Patent Cases decided by the Comptroller-General and Law Officers in 1887.
L. R. App. Cas.	Law Reports, Appeal Cases.
L. R. Ch.	" Chancery Appeals.
L. R. Ch. D.	" Chancery Division.
L. R. C. P.	" Common Pleas Cases.
L. R. E. & I. App.	" English and Irish Appeal Cases.
L. R. Eq.	" Equity Cases.
L. R. Ex.	" Exchequer Cases.
L. R. H. L.	" House of Lords.
L. R. P. C.	" Privy Council Cases.
L. R. Q. B. D.	" Queen's Bench Division.
L. T.	Law Times, Old Series.
L. T. N. S.	Law Times, New Series.
M. & G.	Manning and Granger's Reports.
M. & S.	Maule and Selwyn's Reports.
M. & W.	Meeson and Welsby's Reports.
Mac. & G.	Macnaghten and Gordon's Reports.
Macr. P. C.	Macrory's Patent Cases.
Marsh.	Marshall's Reports.
Mer.	Merivale's Reports.
Moo. P. C. N. S.	Moore's Reports of Cases in the Privy Council, New Series.
Moo. P. C. O. S.	Moore's Reports of Case in the Privy Council, Old Series.
Myl. & Cr.	Mylne and Craig's Reports.
N. R.	The New Reports.
Newt. L. J. C. S.	Newton's London Journal of Arts and Sciences, Conjointed Series.
Newt. L. J. N. S.	Newton's London Journal of Arts and Sciences, New Series.
Parl. Rep.	Parliamentary Reports.
Phill.	Phillips' Reports.
P. O. R.	Patent Office Reports of Patent Cases.
Q. B.	Queen's Bench Reports.
R.	The Reports.
R. P. C.	Patent Office Reports of Patent Cases.
R. S. C.	Rules of the Supreme Court.
Russ.	Russell's Reports.
Russ. & M.	Russell and Mylne's Reports.
Ry. & M.	Ryan and Moody's Reports.
Scott N. R.	Scott's New Reports.
Stark. R.	Starkie's Reports.
Taunt.	Taunton's Reports.
T. R.	Term Reports.
Times R.	Times Law Reports.
Tyr.	Tyrwhitt's Reports.
Ves.	Vesey's Reports.
W. N.	Weekly Notes.
W. P. C.	Webster's Patent Cases.
W. R.	The Weekly Reporter.
Y. & C.	Younge and Collyer's Reports.

TABLE OF CONTENTS.

VOLUME I.

CHAPTER III.

NOVELTY.

CHAPTER IV.

UTILITY.

CHAPTER V.

THE SPECIFICATIONS.

CHAPTER VI.

REVOCATION OF LETTERS PATENT.

CHAPTER VII.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

Part I.

Part II.

CHAPTER VIII.

ACTION OF INFRINGEMENT.

VOLUME II.

CHAPTER I.

OBTAINING LETTERS PATENT FOR INVENTIONS.

CHAPTER II.

AMENDMENT OF THE SPECIFICATIONS.

PART I.

PART II.

CHAPTER III.

ASSIGNMENT OF LETTERS PATENT.

CHAPTER IV.

LICENCES.

CHAPTER V.

EXTENSION OF LETTERS PATENT.

APPENDIX.

TABLE OF CASES.

LIST OF DEFENDANTS IN ACTIONS.

Scars, Pickard *v.*
Seaward, Morgan *v.*
Seine, R. *v.*
Sewell, Moser *v.*
Seymer, Patent Bottle Envelope Co. *v.*
Shankey, Duckett *v.*
Sharp, Cartsburn Sugar Refining Co. *v.*
Sharples, United Telephone Co. *v.*
Shaw, Barker *v.*
Shaw, Longbottom *v.*
Shaw, Pether *v.*
Sheba Gold Mining Co., African Gold Recovery Co. *v.*
Shephard, Gavioli *v.*
Sherrin, British Motor Syndicate, Ld. *v.*
Sherwood, Defries *v.*
Shewes, Bickford *v.*
Shippey, Edison Electric Co. *v.*
Siddell, Vickers *v.*
Siemens Brothers & Co., Ld., Patent Exploitation, Ld. *v.*
Silber, Sugg *v.*
Silver, Tuck *v.*
Simmons, Hicks *v.*
Simms, Colburn *v.*
Simon, Parkinson *v.*
Simplex Gear Case Co., Ld., Presto Gear Case and Components Co., Ld. *v.*
Singer, Otto *v.*
Singer Manufacturing Co., Ld., Gammons *v.*
Singer Manufacturing Co., Nähmaschinen Fabrik *v.*
Skidmore, Saccharin Corporation, Ld. *v.*
Skinner, Perry *v.*
Sluces, Incandescent Gas Light Co. *v.*
Smethurst, Cochrane *v.*
Smith, Bancroft *v.*
Smith, Bovill *v.*
Smith, Bowden's Patent Syndicate (E. M.), Ld. *v.*
Smith, Carpenter *v.*
Smith, Cropper *v.*
Smith, Edison-Bell Phonograph Corporation *v.*
Smith, Heath *v.*
Smith, Jensen *v.*
Smith, Kerrison *v.*
Smith, Oddy *v.*
Smith Ralston *v.*
Smith (Herbert) & Co., Ld., Reynolds *v.*
Smith, Riding *v.*
Smith, Vidi *v.*
Société de Lunetiers, Perry *v.*
Société General d' Electriccité, Werderman *v.*
Somervell, Hancock *v.*
Somervell, Kenny's Patent Buttonholing Co. *v.*
South Eastern Ry. Co., London Chatham and Dover Ry. Co. *v.*
Sowerby Bridge Flour Society, Van Gelder Apsimon & Co. *v.*
Speight, Tolson *v.*
Spence, Kurtz *v.*
Spence, Mayer *v.*
Spiller, Plimpton *v.*
Spilsbury, New Ixion Tyre and Cycle Co. *v.*
Spirey, Badische Anilin Und Soda Fabrik, *r.*
Sponge, Heine *v.*
Spottiswood, Bacon *v.*
Squire, Herrberger *v.*
Starbruck Waggon Co., Eades *v.*
Stassen, Singer *v.*
Steel, Brooks *v.*
Steel, Crossthwaite *v.*
Steel, Otto *v.*
Stephens, Edgebury *v.*
Sterckx, Shrewsbury and Talbot Cab Co. *v.*
Stevens, Parkes *v.*
Stevens, Watling *v.*
Stevenson, Boake Roberts & Co. *v.*
Stevenson, Hess *v.*
Stevenson, Temler *v.*
Stewart, Crossley *v.*
Stewart, United Horseshoe and Nail Co. *v.*
St. George, United Telephone Co. *v.*
St. James Electric Light Co., Hopkinson *v.*
Stone, Wyeth *v.*
Stone and Corser, Dunlop Pneumatic Tyre Co. *v.*
Stott, Tangye *v.*
Stowers, York *v.*
Stubbs, Horrocks *v.*
Suction Cleaners, Ld., British Vacuum Cleaners Co., Ld. *v.*
Sugg, Ungar *v.*
Sunlight Incandescent Gas Lamp Co., Incandescent Gas Light Co. *v.*
Sutton Lodge Chemical Co., Proctor *v.*
Sutton, Swabey *v.*
Swears, Nicoll *v.*
Swedish Horse Nail Co., United Horseshoe and Nail Co. *v.*
Syer, Humpherson *v.*
Szalay, Sandow *v.*

ADDENDA.

VOLUME I.

Page 40, note (*d*), *add* "Northern Press and Engineering Co., Ld. *v.* Hoe (R.) & Co., (1906) 23 R. P. C. 417."

„ 108, „ (*r*), *add* "Hudson, Scott & Sons, Ld. *v.* Barringer, Wallis & Manners, Ld., (1906) 23 R. P. C. 502."

„ 125, „ (*x*), *add* "23 R. P. C. 506."

„ 207, „ (*f*), *add* "23 R. P. C. 461."

„ 291, „ (*i*), *add* "*Times*, July 24th, 1906."

„ 334, „ (*l*), *add* "Gawthorp *v.* Mason, (1906) 23 R. P. C. 401."

„ 367, line 16, *add* "*Brown* v. *Hastie* (*John*) *& Co., Ld.*, (1906) 23 R. P. C. 361."

„ 376, note (*z*), *add* "23 R. P. C. 433."

„ 492, „ (*b*), *add* "Davidson *v.* Sun Fan Co., Ld., (1906) 23 R. P. C. 493."

„ 513, line 24, *add* "*Dr. Joung* v. *United Motor Co.*, (1903) 20 R. P. C. 472."

„ 521, note (*b*), *add* "as to principles on which objections should be certified as reasonable and proper, *see* Clay *v.* Allcock & Co., Ld., (1906) 23 R. P. C. 381."

„ 529, „ (*a*), *add* "Anti-Vibration Incandescent Lighting Co., Ld., *v.* Wholesale Incandescent Fittings Co., (1906) 23 R. P. C. 399."

„ 533, „ (*x*), *add* "See also Osmond *v.* Mutual Cycle and Manufacturing Supply Co., Ld., [1899] 2 Q. B. 488."

VOLUME II.

Page 83, note (*l*), *add* "Andrews' Patent, (1906) 23 R. P. C. 441; Waterhouse's Patent, (1906) 23 R. P. C. 470."

„ 179, „ (*i*), *add* "Scott's Patent, (1906) 23 R. P. C. 473."

„ 182, „ (*n*), *for* "L. R. 4 P. C., App. Cas. 88 *n.*," *read* "L. R. 5, App. Cas. 88 *n.*"

„ 182, „ (*q*), *add* "Cross, Bevan and Beadle's Patent, (1906) 23 R. P. C. 485."

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

OBTAINING LETTERS PATENT FOR INVENTIONS.

Prerogative of the Crown.

Crown exercises its prerogative

No person can demand protection for an invention by letters patent as of right. The power of the Crown to grant letters patent is purely discretionary. It was exercised during, and most probably previous to, the reign of Edward III., (*a*) and preserved by the Statute of Monopolies with reference to new inventions, (*b*) and is not suspended during the minority or other incapacity of the reigning Sovereign. (*c*)

through the medium of certain officers.

The Crown exercises its prerogative in the matter of granting patents for inventions through the medium of certain officers referred to in the Patents, Designs, and Trade Marks Act, 1883—viz., the Comptroller-General of the Patent Office, and the Attorney-General, or the Solicitor-General.

Except under sec. 103 or 104 of the Act of 1883 the Crown can grant letters patent for an invention only to the true and first inventor or inventors alone, or jointly with any other person or persons. (*d*)

Grant is made at the patentee's peril.

Every grant of letters patent is made at the grantee's peril, and on condition that it is valid only if one or more of the grantees is or are in fact the true and first inventor or inventors, the invention is new and useful, and the specification is sufficient to fulfil the requirements of the law; moreover, the Crown in no way whatever guarantees the validity of any letters patent if the representations and conditions on

(*a*) Year Book, part iv., 40 Edw. III. fol. 17, 18; Darcy *v.* Allen, (1602) Moore's Reps. 675.

(*b*) 21 Jac. I. c. 3.

(*c*) Co. Lit. 43b; 5 Co. 27a; 7 Co. 12a. See 46 & 47 Vict. c. 57, p. 241 *post*.

(*d*) 21 Jac. I. c. 3, s. 6; 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, ss. 5, 103, 104.

Patent Agents.

the strength of which it is made are not rigidly correct and fulfilled.

Practice is regulated by Acts and rules made thereunder.

The practice, which it is necessary for any person desirous of obtaining a grant of letters patent to observe, is laid down and regulated by the Act of 1883, together with the Amending Acts of 1885, 1886, 1888, 1901, and 1902, and the rules and regulations from time to time made by the Board of Trade in pursuance of the powers conferred by those statutes. (*e*)

Patent Agents.

It is the usual practice for a would-be patentee to engage the services of a patent agent of experience and skill to aid him in filling up the necessary forms, drafting the specifications, meeting objections, and attending the hearing of oppositions, if any, to the grant of the patent.

The form of application, and also any notice of abandonment of, or of intention not to proceed with, the application, must be signed by the applicant himself; but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller or Examiner, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require, resident in the United Kingdom. (*f*)

Qualifications of registered patent agents

With a view to avoid the abuse of ill-qualified persons practising as patent agents, Parliament, by the Patents, Designs, and Trade Marks Act, 1888, provided that, if after the passing of that Act any person describe himself as a patent agent, either 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 the Act, (*g*) he is liable on summary conviction to a fine not exceeding twenty pounds. But any person who proves to the satisfaction of the Board of Trade that he had been practising *bonâ fide* as a patent agent prior to December 24, 1888, is entitled as of right to be registered. (*h*) A person, however, who is not registered and knowingly describes himself as a "Patent Agent" is liable to fine, on summary conviction, notwithstanding that he *bonâ fide* practised and described himself as a patent agent before the Act of 1888

(*e*) 46 & 47 Vict. c. 57, s. 101.
(*f*) P. R. (1903) r. 81.
(*g*) 51 & 52 Vict. c. 50, s. 1.
(*h*) *Ibid.* sub-s. 3.

Patent Agents.

came into force—*i.e.*, by having so practised a person does not acquire a right within the meaning of sec. 27 of the Act, and registration and payment of fees is a condition precedent to his being allowed to continue so practising and describing himself. (*i*)

It is also provided by the Act of 1888 that persons seeking to be registered as patent agents must satisfy various examinational tests before they are entitled to be placed on the register.

Register of Patent Agents.

Correct copies of the Register of Patent Agents are published annually, and may be obtained at the Patent Office, or any of the depôts where its publications are kept on sale, for the sum of one shilling. In this list will be found the names and business addresses of all the registered members of the Chartered Institute of Patent Agents for the time being.

Register of Patent Agents' Rules.

The Act further provides (*k*) that the Board of Trade shall have power from time to time to make such general rules as are in the opinion of the Board required for giving effect to the provisions of the Act, and that the provisions of sec. 101 of the Act of 1883 (*l*) shall apply to all rules so made as if they were made in pursuance of that section. The Register of Patent Agents' Rules for the time being in force will be found in the Appendix. (*m*) The rules so made by the Board of Trade are submitted to Parliament, and, if not annulled by either House within forty days after they are laid on the table, they acquire the force of an Act of Parliament, and the Courts will not entertain the question of any rules made with the prescribed formalities being *ultra vires*. (*n*) In case of the infraction of any rule for which a penalty is imposed—*e.g.*, practising as a patent agent without registration—the proper course is for the Institute of Patent Agents to prosecute for the penalty, and it is incompetent for the Institute or any other person aggrieved to proceed by way of action for injunction in the Supreme Court. (*o*)

Any one may act as an ordinary agent.

It has been decided that notwithstanding the Act of 1888 a person is entitled to act on behalf of another, in the matter of obtaining a patent, as an ordinary agent, and may so describe himself on every document without fear of

(*i*) Storey *v.* Graham, (1899) 16 R. P. C. 106.

(*k*) s. 1, sub-s. 2; p. 249 *post*.

(*l*) 46 & 47 Vict. c. 57, s. 101; p. 236 *post*.

(*m*) p. 337 *post*.

(*n*) Chartered Institute of Patent Agents *v.* Lockwood, (1893) 10 R. P. C. 167; 11 R. P. C. 374.

(*o*) *Ibid*.

Application.

prosecution. He is not entitled to describe himself as a "patent agent." (*p*)

The above decision of the Courts has enabled persons to evade the Act of 1888 by avoiding the use of the words "patent agent," though really representing themselves to the public as patent agents, by employing such titles as "patent office," "office for patents," "inventors agent," and other similar descriptions. A bill has recently been introduced by Lord *Coleridge* which seeks to obtain from Parliament power to prevent such evasions of the intention of the Act of 1888. (*q*)

Application.

Any person may make an application.

Any person, whether a British subject or not, is entitled to make an application for a patent, and two or more persons may make a joint application, and a patent may be granted to them jointly. (*r*)

How the application must be made.

The application must be made on one of the forms set forth in the first schedule to the Act of 1883, or in such other form as may be from time to time prescribed. (*s*)

If an invention is partly original and partly communicated from abroad, it is doubtful whether it is incumbent on the applicant to distinguish which is which; (*t*) and it is an undecided point whether or not the omission to do so would render the patent void. (*u*) It is the usual practice, however, to state on the application form that the invention is partly communicated from abroad.

Form A is not applicable to the case of a corporation alone, but is intended for cases where there is a personal applicant who is the true and first inventor. Form A1 is intended for use where there has been a communication from abroad, whether the communicatee is a corporation or a private individual. (*x*)

Application must be left at or sent by post to the Patent Office,

The applicant having filled up the form of application, which must be signed by himself, must leave it at, or send it by post

(*p*) Graham *v.* Fanta, (1872) 9 R. P. C. 164. See also Graham *v.* Eli, (1898) 15 R. P. C. 259.

(*q*) The Act has not yet been passed.

(*r*) 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, s. 5.

(*s*) 46 & 47 Vict. c. 57, s. 5, sub-s. 1. The forms at present in use for this purpose will be found in the second schedule to the Patent Rules, 1903; see p. 345 *post*.

(*t*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 177.

(*u*) *Re* Avery's Patent, (1887) L. R. 36 Ch. D. 307; Moser *v.* Marsden, (1893) 10 R. P. C. 209, 350.

(*x*) Société Anonyme du Générateur du Temple's Patent, (1896) 13 R. P. C. 54.

to, the Patent Office. If sent by post as a prepaid letter it will be deemed to have been left at the Patent Office at the time when the letter containing the same would be delivered in the ordinary course of post, and, in case it becomes necessary to prove such sending, it will be sufficient to prove that the application was properly addressed and posted. (*y*)

Application.

The application must contain a declaration, which may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed, (*z*) to the effect that the applicant is in possession of an invention whereof he claims, 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, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or a complete specification. (*a*) In accordance with sec. 5 of the Act of 1883, the application must also be accompanied by drawings if required.

and must contain a declaration, and be accompanied by a specification.

The form of declaration at present in use for the purpose of an application for a grant of a patent (*b*) is not a declaration, under the Statutory Declarations Act, 1835.

Statutory declarations required for use in the Patent Office are to be made and subscribed as follows (*c*) :—

Statutory declarations for use in the Patent Office are to be made and subscribed in a certain manner,

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b) In any other part of his Majesty's dominions, before any Court, Judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(c) If made out of his Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or before a notary public, or before a Judge or magistrate.

If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration, or doing anything required or permitted by the Act of 1883, or by any rules

(*y*) 46 & 47 Vict. c. 57, s. 5, sub-s. 1; s. 97; P. R. (1903) r. 80.
(*z*) 48 & 49 Vict. c. 63, s. 2.
(*a*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2. As to size of paper drawings, &c., see P. R. (1905) rr. 16–24.
(*b*) See p. 345 *post*.
(*c*) P. R. (1903) r. 26; see Appendix.

Examination and Acceptance.

made thereunder, then the guardian or committee (if any) of such incapable person, or, if there be none, any person appointed by the Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing, in the name and on behalf of such incapable person, and all acts done by such substitute are, for the purposes of the Act, as effectual as if done by the person for whom he is substituted. (*d*)

and are exempt from duty under Stamp Act, 1870.

A statutory declaration, made under the provisions of the Statutory Declaration Act, 1835, and forming part of an application for a patent, in conformity with the Patents, Designs, and Trade Marks Act, 1883, is exempt from the stamp duty charged on a statutory declaration, under the provisions of the Stamp Act, 1870. (*e*)

Application should comprise only one invention.

An application for a patent should comprise only one invention. It is provided by the Act of 1883 (*f*) that every patent shall be granted for one invention only; though, if a patent should, by inadvertence, include several inventions, it is not competent for any person, in an action, or other proceeding, to take any objection on the ground that it comprises more than one invention. (*g*)

Every application is referred to an examiner appointed under the Act of 1883 to discharge certain duties.

Examination and Acceptance of Application.—Every application for a patent is referred by the Comptroller-General to an examiner appointed under the Act of 1883, (*h*) whose duty it is to ascertain whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and whether the title sufficiently indicates the nature of the invention. (*i*) It is also the examiner's duty to report whether the invention is contrary to law and morality, (*k*) and whether the application comprises more than one invention. (*l*) 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

(*d*) 46 & 47 Vict. c. 57, s. 99.
(*e*) 47 & 48 Vict. c. 62, s. 9.
(*f*) s. 33.
(*g*) 46 & 47 Vict. c. 57, s. 33.
(*h*) *Ibid.* s. 83.
(*i*) *Ibid.* s. 6. See chap v.
(*k*) *Ibid.* s. 86.
(*l*) *Ibid.* s. 33.

Examination and Acceptance.

subject-matter of the invention, or that the application comprises more than one invention, the Comptroller may, subject to appeal to the law officer, refuse to accept the application, or require that the specification or drawings be amended before he proceeds further; and in the latter case the application must, if the Comptroller so directs, bear date as from the time when the requirement is complied with. (*m*) It is also competent to the Comptroller to inquire whether the alleged invention is an invention within the definition contained in sec. 46 of the Patents Act, 1883 (*n*)—*i.e.*, whether it is a manufacture within the meaning of sec. 6 of the Statute of Monopolies, (*o*) and, subject to appeal to the law officer, to refuse the application, if he is satisfied that it is not. (*p*)

Comptroller acts on the report of the examiner.

On the question whether or not the use of an invention is contrary to law or morality there appears to be no appeal from the decision of the Comptroller.

Exercise of discretionary powers by Comptroller.

The Comptroller is not entitled to exercise any discretionary power adversely to an applicant without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent. (*q*)

Right of appeal to the law officer from any decision of the Comptroller.

In any case where a person, having the right, intends to appeal to the law officer from a decision of the Comptroller, he must, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such intention, stating the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so what part, of the decision, and he must otherwise conform to the Law Officer's Rules. (*r*) Where the right of appeal to the law officer lies against a decision of the Comptroller, the effect of Nos. 1 and 2 of the Law Officer's Rules is to limit the hearing before the law officer to points specifically raised by the notice of appeal, and in opposition cases where a notice of appeal is given as to parts only of the Comptroller's decision, the person receiving such notice, if he desires to question other parts of the decision, must give a counter notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter notice may be extended under Rule 5. (*s*)

(*m*) 46 & 47 Vict. c. 57, ss. 33, 86; 51 & 52 Vict. c. 50, s. 2.

(*n*) 46 & 47 Vict. c. 57, s. 46.

(*o*) See Vol. I. p. 22.

(*p*) Cooper's Patent, (1901) 19 R. P. C. 53; Johnson's Patent, (1901) 19 R. P. C. 56.

(*q*) 46 & 47 Vict. c. 57, s. 94; see P. R. (1903) rr. 28–31.

(*r*) See p. 323 *post*.

(*s*) In the Matter of Bairstow's Patent, (1888) 5 R. P. C. 289.

Examination and Acceptance.

The Act of 1883 gives the law officer control over the costs of the proceedings before him, but there is no such provision in the case of proceedings before the Comptroller. (*t*)

Costs.

As a general rule, the costs of an appeal to the law officer follow the event, (*u*) unless there has been unfair conduct; (*x*) and where an appeal is withdrawn the appellant pays the costs. (*y*)

Example of an objection to the title.

In *Brown's Application* (*z*) for a patent under the title "improvements in casks and tubs," accompanied by a complete specification in the first instance, which stated that the invention was applicable to barrels or other casks and also to tubs *and analogous vessels*, in which the staves are formed with a croze or groove for receiving the head or bottom, and the object of the invention was to secure the bottom or head against outward displacement, and also to support the staves beyond the croze against any force or blow delivered upon the exterior of the staves such as would tend to break off their ends projecting beyond the croze, the Comptroller refused to accept the specification unless the words "and analogous vessels" were added to the title or omitted from the specification, on the ground that the title did not, in view of the words "and analogous vessels" in the body of the specification, sufficiently indicate the subject-matter of the invention. The law officer on appeal, however, reversed the Comptroller's decision, being of opinion that the title, taken together with the claims, which were specific, was sufficient, and he also pointed out that the patentee is entitled to frame his title in his own way, provided he does not infringe the rules of the statute.

Application comprising more than one invention may be amended by limitation to one invention.

The Patent Rules, 1905, (*a*) provide that where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawing, or any of them, so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment. Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or

(*t*) 46 & 47 Vict. c. 57, s. 38.

(*u*) Anderton, (1885) Griff. L. O. C. 25; *Ex parte* Fox, (1812) 1 V. & B. 67; 1 W. P. C. 431 *n*.

(*x*) *Re* Lowe's Patent, (1856) 25 L. J. N. S. Ch. 456.

(*y*) Knight, (1886) Griff. L. O. C. 35; *Re* Cobley's Patent, (1861) 8 Jur. N. S. 106; *Re* Ashenhurst's Patent, (1853) 2 W. R. 3.

(*z*) (1887) Griff. L. O. C. 1.

(*a*) P. R. (1905) r. 5.

such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the Act and Rules thereunder for the time being in force. Examination and Acceptance.

Where the Comptroller has required or allowed any application, specification, or drawing to be amended as aforesaid, such application shall, if the Comptroller at any time so direct, bear such date, subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

When a specification comprises several distinct matters they are not deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus, or process. (*b*) Test of one invention.

Lord *Herschell*, when Solicitor-General, (*c*) gave it as his opinion that the general object of the invention is the test by which the question of one invention must be decided, and in reference to a particular case said—

> "If you have a particular general object of an invention to make rails rest more securely, and you describe one, or two, or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention. But if you say, 'I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct,' then those are six inventions."

The following two cases are given as illustrations of the circumstances in which an applicant is required to amend his application so as to limit it to one invention only :—

In *Hearson's Patent*, (1885) Griff. P. C. 266, an applicant applied for a patent, under the title "Improvements in apparatus for rapidly heating flowing water, *a part of which* Examples of cases in which amendment by limitation to

(*b*) P. R. (1905) r. 5. (*c*) Jones's Patent, Griff. P. C. 265.

Examination and Acceptance.

one invention is required.

improvements is applicable to other purposes," and after describing in his provisional specification an apparatus consisting of several parts, including improved mechanism, by which the turning of the taps of a geyser, otherwise than in the required order, was prevented, stated: "The arrangements hereinbefore described for locking the water and gas-cocks is applicable to oxyhydrogen light apparatus, and to other apparatus in which two cocks, or a number of cocks, are required to be turned in a certain order," he was ordered to amend his application by striking out from the title the words in italics. Both the Comptroller and the law officer were of opinion that the application, as it stood before amendment, included more than one invention, and the latter pointed out that the applicant was entitled, if he so desired, to make a separate contemporary application for his new and improved cock, or arrangement of cocks by itself, and that he might of course describe the cock, or arrangement of cocks, as part of his combination or apparatus which he claimed to have invented, but that he should in doing so refer to his contemporary application if he desired to make one.

In *Robinson's Patent,* Griff. P. C. 267, a person applied for a patent for an invention of "improvements in the art of producing and utilising induced electrical currents for telegraphy and other purposes," and it appeared that the invention consisted in the employment in telegraphic transmitting and receiving instruments of a certain appliance. The Comptroller objected to the title, stating that the appliance could be applied to purposes other than telegraphic, and required an amendment so as to limit the invention to such purposes, and held that, if the applicant desired to claim the general use of the appliance for the production of induced currents, it must form the subject of a separate patent.

On appeal, the law officer informed the applicant that if he intended to claim, as a combination, the whole of the apparatus as one telegraphic apparatus, then it might all be included in one specification; but if he was including, for all purposes, the invention of "the appliance," then it was something different, which could not be protected by the same patent. The law officer further stated that he would allow that, if the whole were limited to telegraphy, because that would make an improved telegraphic arrangement, and although consisting of several parts, he would allow it to be included in one patent; but if there were to be two separate things, which could only be allowed together because they went to make up one better kind of instrument or machine, then he would never allow the use of a part of that for a purpose independent of the main object of the machine.

Examination and Acceptance.

It was therefore a question for the applicant whether it answered his purpose better to protect "the appliance" for all purposes, or to protect improved telegraphic apparatus, consisting of the employment of "the appliance" therein. The applicant elected to take a patent for the general use of "the appliance," and the law officer allowed the title to be amended to "improvements in the art of producing and utilising induced electrical currents," the description of the telegraphic apparatus being struck out of the provisional specification.

The decisions above quoted still hold good as to what is *not* one invention.

It is not easy to generalise from the practice of the Patent Office, but it is safe to state that examiners do not now accept as conclusive the test of "one general object" in support of a plea to claim alternative forms, and only permit separate claims for alternative solutions of the same problem when the problem is recognised and solved for the first time. Co-operating elements of a new combination may still be claimed in one patent, but, generally, interdependence is not recognised between two arrangements either of which can be used not only with the other but also with any known equivalent. A complete machine and a subordinate integer cannot be claimed in the same patent when the subordinate integer is unnecessary to the carrying out of the invention as a whole, and in itself has a character independent from that of the complete machine. On the other hand, the Office makes no objection to an applicant making separate claims for a process, apparatus for carrying out such process and the product thereof.

Separate patents granted to joint applicants who are inventors of distinct parts.

If an application be made by two or more joint applicants, and it appears that the invention consists of distinct parts, invented separately by the applicants respectively, separate patents may be granted to the actual inventors in respect of the separate and distinct parts. (*d*)

Appeal from Comptroller on refusal to accept application, or to require an amendment.

Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, (*e*) who, if required, hears the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the application shall be accepted. (*f*)

(*d*) See Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.

(*e*) 51 & 52 Vict. c. 50, s. 2 (2).

(*f*) *Ibid.* s. 2 (3). The practice on appeal to the law officer is regulated by the Law Officer's Rules, see p. 323 *post*.

Statutory Offences.

Notice of acceptance of application.

If the application is accepted the applicant will receive due notice to this effect, (*g*) and the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice to the patent to be granted for the same; (*h*) though the applicant is not entitled to sue in respect of infringements of the invention committed before the acceptance and publication of the complete specification. (*i*)

Representation that an article is patented where no patent has been granted.

Statutory Offences.—Sec. 105 of the Act of 1883 provides 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. The effect of sec. 15 of the same Act, however, is to render it no offence to represent an article as "patented" when the complete specification has been accepted, though the patent has not been sealed. (*k*)

It is probably no offence under the Act of 1883 to represent an article as patented when the patent has expired and the fair implication is that the article was made under an expired and not under an existing patent. (*l*)

A person is deemed to represent that an article is patented if he sells the article with the word "patent," "patented," or any other word expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article. (*m*)

Unauthorised use of the Royal Arms.

Any person who, without the authority of His Majesty, or any of the Royal Family, or of any Government department, assumes or uses in connection 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, is liable, on summary conviction, to a fine not exceeding twenty pounds. (*n*)

Penalties in Scotland.

In Scotland, any offence under the Act of 1883 declared to

(*g*) 51 & 52 Vict. c. 50, s. 2 (4).

(*h*) 46 & 47 Vict. c. 57, s. 14; Vol. I. p. 187.

(*i*) *Ibid.* s. 13; Vol. I. pp. 187, 383.

(*k*) R. *v.* Townsend, (1896) 13 R. P. C. 265; in R. *v.* Wallis, (1886) 3 R. P. C. 1; and R. *v.* Crampton, (1886) 3 R. P. C. 367, fines were inflicted.

(*l*) See Cheavin *v.* Walker, (1877) L. R. 5 Ch. D. 850; Merchandise Marks Act, 1887, s. 3.

(*m*) 46 & 47 Vict. c. 57, s. 105, sub-s. 2; but see Cheavin *v.* Walker, (1877) L. R. 5 Ch. D. 863; Linoleum Co. *v.* Nairn, (1877) L. R. 7 Ch. D. 834.

(*n*) 46 & 47 Vict. c. 57, s. 106; 5 Edw. VII. c. 15, s. 68.

be punishable on summary conviction may be prosecuted in the Sheriff Court. (*o*)

Filing Complete Specification.

The punishment for a misdemeanour, under the Act of 1883, in the Isle of Man, is imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court. (*p*) 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. (*q*)

Penalties in the Isle of Man.

Filing the Complete Specification.—If an applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months, or, on obtaining the leave of the Comptroller on payment of the prescribed fee, within a further extended period of one month (*r*) from the date of application, but, unless a complete specification is left within that time, the application will be deemed to be abandoned. (*s*)

Complete specification must be filed within six, or upon leave seven, months from date of application.

The six months is reckoned exclusively of the day of the date of the application. (*t*)

Where an application for a patent has been abandoned or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application are not at any time open to public inspection, or published by the Comptroller, (*u*) except in cases under the convention.

The complete specification must be signed by the applicant or his authorised agent, but in the case of a joint application the Comptroller will probably not refuse to accept the complete specification on the ground that it is signed by, or on behalf of, one applicant only. (*x*)

Complete specification must be signed, and

It is provided by sec. 5, sub-s. 5 of the Patents Act, 1883, that a complete specification must end with a distinct statement of the invention claimed. (*y*)

must end with distinct,

It is required by Rule 4 of the Patent Rules, 1905, that the

and clear and succinct state-

(*o*) 46 & 47 Vict. c. 57, s. 108.
(*p*) *Ibid.* s. 112, sub-s. 2.
(*q*) *Ibid.* sub-s. 3.
(*r*) 2 Ed. VII. c. 34, s. 1 (8); see R. R. (1903) rr. 10, 77.
(*s*) 46 & 47 Vict. c. 57, s. 8; see also s. 98.
(*t*) Russell *v.* Ledsam, (1843) 14 M. & W. 572, 582; 16 M. & W. 633; Williams *v.* Nash, (1859) 28 Beav. 93.
(*u*) 48 & 49 Vict. c. 63, s. 4.
(*x*) In the Matter of Grenfell and McEvoy's Patent, (1890) 7 R. P. C. 151.
(*y*) See Vol. I. p. 248.

Filing Complete Specification.

statement of the invention claimed, with which a complete specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification. (*z*) Claims are not disallowed merely on account of their number. (*a*)

ment of the invention claimed.

Reference of the complete specification to an examiner.

The complete specification, if left after a provisional, is referred to an examiner for report whether the complete has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification, and, if the examiner reports that it is not so, the Comptroller is empowered to refuse to accept the complete specification unless and until it shall have been amended to his satisfaction; any such refusal, however, is subject to appeal to the law officer, who must, 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. (*b*)

The requisite amendment, if any, is to be determined by the judicial act of the Comptroller, subject to appeal to the law officer. The function of deciding what the amendment is to be is not delegated by the Act to the examiner, though the application proceeds if he reports favourably to the applicant. (*c*)

The fact that the complete specification narrows the scope of the provisional is not a ground on which the Comptroller or law officer is justified in refusing it, and the applicant may be permitted to excise any abandoned portion of the provisional specification. (*d*) Thus in *Everitt's Application* (*e*) the Comptroller refused to accept the complete specification on the ground that it claimed only a special means of carrying a principle into effect, whilst the provisional was apparently for the principle; but this decision was reversed on appeal, on the ground that in law the Comptroller was not entitled to refuse to accept the complete specification, which only narrowed down the ambit of the provisional and did not go outside it.

Examination as to novelty.

The examiner, when the complete specification has been

(*z*) As to the interpretation of this Rule in practice, see Bancroft's Application, (1905) 23 R. P. C. 89.

(*a*) *Ibid.*

(*b*) 46 & 47 Vict. c. 57, s. 9 (1), (2), 3); see In the Matter of Anderson's Patent, (1890) 7 R. P. C. 323.

(*c*) See C.'s Patent, (1890) 7. R. P. C. 256.

(*d*) Everitt, (1886) Griff. L. O. C. 27, Vol. I. pp. 184, 185.

(*e*) (1888) Griff. L. O. C. 27.

Filing Complete Specification.

deposited, in addition to the report above referred to forthwith makes a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification), published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application. (*f*)

If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant is informed thereof, and he may, within such time as may be prescribed, amend his specification, and the amended specification is then investigated in like manner as the original specification; and the examiner reports to the Comptroller the result of his investigations. (*g*)

Acceptance.

If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned he, in the absence of any other lawful ground, accepts the specification. (*h*) If, however, he is not so satisfied after hearing the applicant, and unless the objection be removed by amending the specification to his satisfaction, he determines whether a reference to any, and, if so, what prior specification or specifications ought to be made in the specification by way of notice to the public. (*i*) An appeal lies to the law officer from the Comptroller's decision in this matter. (*k*)

It is presumed that the Comptroller will be guided in the matter of ordering the insertion or addition of specific references by the decisions which have been given, and regulate the practice in cases where the grant is opposed on the ground that the invention has been patented in this country on an application of prior date. (*l*)

It is the present practice of the Office, if the date for acceptance permit, when the specification is ready for acceptance, to issue a preliminary notice to the effect that the formal notice of acceptance will be issued after the expiration of a month, unless sufficient ground for further delay is

(*f*) 2 Ed. VII. c. 34, s. 1 (1).
(*g*) *Ibid.* s. 1 (2), (3).
(*h*) *Ibid.* s. 1 (5).
(*i*) *Ibid.* s. 1 (6); Patent Rules (1905) r. 10.
(*k*) 2 Edw. VII. c. 34, s. 1 (7).
(*l*) See pp. 43-50 *post*.

Filing Complete Specification.

afforded. This preliminary notice is, however, *only* sent in cases in which the result of the investigation prescribed by sec. 1 (1) of the Patents Act, 1902, has not been previously communicated to the applicant. No such notice is sent in convention cases, or in cases in which the applicants or agents are outside the United Kingdom. (*m*)

The investigations and reports above referred to are no guarantee of the validity of the patent, if and when obtained; and no liability attaches to the Board of Trade or any officer thereof by reason of, or in connection with, any such investigation or report, or any proceeding consequent thereon. (*n*)

The procedure as to the examination of earlier specifications is regulated by the Patents Act, 1902, and the Patents Rules, 1905, rr. 6–11. (*o*)

In case the result of the examiner's search discloses that any of the claims is or are wholly or in part anticipated by prior patents, the official letter addressed to the applicant or his agent states, as a rule, whether the invention is anticipated wholly or in part, and in the latter case as to what part. The term for replying to the objections is two months, and the applicant may either satisfy the examiner by filing a statement of arguments or by amending the specification or claims, or he may apply for an interview with the examiner and discuss the effect of the references and the wording of the proposed amendment. The said term of two months may be extended in exceptional circumstances, but if the applicant does not satisfy the examiner, and the Comptroller issues a further letter based on the same references, the term of two months dates from the first official letter. If a suitable amendment is not filed within two months, then the Comptroller appoints a hearing and decides between the applicant and the examiner. If the search has only been provisional, then, even though the Comptroller decide in favour of the applicant, instead of the application being accepted, the case is referred back to the examiner to continue his search, in which case further objections may be taken and a second hearing may be necessary.

Reports of examiners are not published.

Reports of examiners are not in any case published or open to public inspection, and are not liable to production or inspection in any legal proceedings under the Act of 1883, unless the Court or officer having power to order discovery in

(*m*) See Official Notice, P. O. J. February 14, 1906, p. 189.

(*n*) 2 Edw. VII. c. 34, s. 1 (3).

(*o*) See Appendix.

Filing Complete Specification.

such legal proceedings shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed. (*p*) It consequently follows that where there are two applicants for a patent for the same or analogous inventions, each cannot know the nature of the other's specification until the rival complete specifications themselves are open to public inspection. (*q*) The examiner cannot base an objection on the fact that the applicant's invention is described in a specification of an earlier patent, which was only published after the date of the application, but he may draw the applicant's attention to it so that the applicant can consider the desirability of making an amendment.

Subsequent application before seal is obtained in respect of a prior application.

Sub-s. 5 and 6 of sec. 7 of the Act of 1883 were found in practice to be useless, and to give rise to much hardship and blackmailing, perpetrated by prior against later applicants, and they were abolished by the Act of 1888, which substituted a new section for sec. 7 of the original Act of 1883, and *inter alia* provides that (*r*) "if, after an application for a patent has been made, but before the patent thereon has been sealed, 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."

Amendment of a complete specification before and after acceptance.

It may happen that the applicant himself may desire to amend his specification before the seal is obtained. In this case the Comptroller may, under the substituted sec. 7 and sec. 9 of the Act of 1883, and sec. 2 and sec. 6 of the Act of 1902, allow the amendment before acceptance of the complete specification. (*s*) In the case of a voluntary amendment, which will occasion extra trouble for the Patent Office, the applicant must file a stamped form of request, and proceed under sec. 18 of the Act of 1883, (*t*) even though the complete specification has not been accepted. (*u*) If the complete specification has not become open to public inspection (*x*) there is no necessity for the advertisement of the request for leave to amend under sec. 18. (*y*)

(*p*) 46 & 47 Vict. c. 57, s. 9, sub-s. 5; 51 & 52 Vict. c. 50, s. 3; 2 Edw. VII. c. 34, s. 1 (4).
(*q*) 46 & 47 Vict. c. 57, s. 10.
(*r*) 51 & 52 Vict. c. 50, s. 2.
(*s*) Dart's Patent, Griff. P. C. 307.
(*t*) p. 83 *post*.
(*u*) Jones's Patent, Griff. P. C. 313.
(*x*) p. 18 *post*.
(*y*) Jones's Patent, Griff. P. C. 313. In

Filing Complete Specification.

The applicant should bear in mind that it is his duty to frame his specification in such a way that a patent may properly be granted; and though in suitable cases (*z*) the Comptroller or Law Officer will exercise the power of requiring amendments as a condition of granting a patent or allow an amendment under sec. 18 of the Act of 1883, yet it is not at all a matter of course that the necessary amendments will be allowed, if the specification is originally presented in such a form that the patent cannot be granted without alteration.(*a*)

Disagreement by joint applicants as to form of specification.

When joint applicants disagree as to the form of the complete specification and desire to file separate specifications, the Comptroller and law officer have no jurisdiction to decide between them, or to accept two separate specifications, or to accept a specification at all, unless the parties come independently to an agreement and settlement as to its form. (*b*)

Acceptance of complete specification is no guarantee in law.

The acceptance of a specification by the Comptroller is no guarantee that it is good in law. The Comptroller is only required to be satisfied that the specification is prepared in the prescribed manner, and that the invention particularly described in the complete is substantially the same as that described in the provisional specification, and to consider and act upon the examiner's reports. (*c*)

Acceptance of complete specification must take place within a definite period.

If a complete specification is not accepted within twelve months from the date of application, or within further extended periods not exceeding three months, on obtaining the leave of the Comptroller and payment of the prescribed fees, (*d*) then (save in the case of an appeal having been lodged against the refusal to accept) the application at the expiration of such period becomes void. (*e*)

When a complete specification becomes public.

When the complete specification is accepted, the Comptroller is required by the Act of 1883 to advertise the acceptance in the official journal of the Patent Office, and the application and specification or specifications, with the drawings (if any), are thereupon open to public inspection and may be inspected at the Patent Office upon payment of the prescribed fee. (*f*)

this case the complete specification was not yet open to public inspection. The term "public property" in the Attorney-General's judgment probably referred to the date of lodging the specification.

(*z*) Harrild and Parkin's Patent, (1900) 17 R. P. C. 617.

(*a*) See Thomas and Prevost's Patent, (1898) 16 R. P. C. 70; Garnett's Patent, (1899) 16 R. P. C. 154; Mills's Patent, (1901) 18 R P. C. 322; Crist's Patent, (1903) 20 R. P. C. 475; p. 49 *post*.

(*b*) Apostoloff's Patent, (1896) 13 R. P. C. 275.

(*c*) See p. 6 *ante*.

(*d*) 48 & 49 Vict. c. 63, s. 3.

(*e*) 46 & 47 Vict. c. 57, s. 9 (4).

(*f*) *Ibid.* s. 10; P. R. (1903) rr. 11, 12.

Foreigner's Application.

Foreign applicants.

Applications under International and Colonial Arrangements.—In order to enable the British Government to join the "Union for the Protection of Industrial Property," which consists at present of the following States—Great Britain, Belgium, Brazil, Ceylon, Cuba, Denmark, Germany, New Zealand, Japan, San Domingo, Spain, France, Italy, Holland and its colonies, Portugal, Servia, Switzerland, Norway, Sweden, Tunis, the United States, and Mexico—it is provided by sec. 103 of the Act of 1883, as amended by sec. 6 of the Act of 1885, and sec. 1 of the Act of 1902, as follows:—

"If her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, then any person who has applied for protection for any invention in any such State shall be entitled to a patent for his invention under the Act of 1883, in priority to other applicants; and such patent shall have the same date as the date of application in such foreign State: provided that his application is made within twelve months from his applying for protection in the foreign State with which the arrangement is in force: And provided further that the patentee shall not be entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification."

The word "person" includes "corporation," and so the section gives the same rights of priority to corporations as to individuals. (*g*)

It is also enacted that the publication in the United Kingdom or the Isle of Man, during the above period of twelve months, of any description of the invention, or the use therein during such period of the invention, shall not invalidate the patent which may be granted for the same.

This latter provision does not apply in all cases where a patent has been previously applied for in a foreign country, but is only applicable, as part of the general provisions of sec. 103 of the Act of 1883, to cases where the patentee avails himself of the privilege given by that section. The Act gives a foreign patentee, who has obtained a patent in a State which has joined the convention, a double right—viz., either to apply in this country for a patent antedated to the date of his foreign application, or, running the risk of publication, to obtain a patent in the ordinary way for the full period from the date of

(*g*) Carez's Patent, (1889) 6 R. P. C. 552; Société Anonyme du Générateur du Temple's Patent, (1896) 13 R. P. C. 56.

Foreigner's Application.

application. (*h*) A foreign applicant who wishes to obtain in this country an antedated patent must make his election and claim the earlier date before the expiration of twelve months from the date of his first application in a foreign country, otherwise he will be too late and a subsequent request for the benefit of sec. 103 of the Patents Act, 1883, will not be acceded to by the authorities at the Patent Office. (*i*) Sub-s. 2 of sec. 103 of the Act of 1883 gives protection against publication only to patents which are granted upon applications made under the provisions of sec. 103 as amended by subsequent Acts. (*k*)

An application under the above provisions must be accompanied by a complete specification and a copy of the foreign specification, and otherwise be made in the same manner as an ordinary application; and such provisions apply only in the case of those foreign States with respect to which his 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. (*l*)

Retrospective effect of Order in Council.

An Order in Council, made under the above provisions, has a retrospective effect unless specially framed to the contrary. Thus, where a person had applied for a patent in the United States of America to which the provisions of sec. 103 of the Act of 1883 had not been extended at the date of the application, he was declared to be entitled to a British patent, bearing the date of the United States application, the provisions of sec. 103 of the Act of 1883 having been extended to such foreign State before the expiration of the period allowed by the Act. (*m*)

Provisions of s. 103 of Act of 1883 may by order in Council be applied to British possessions.

The Act of 1883 further empowers his Majesty, where it is made to appear to him that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, by Order in Council (to take effect as if its provisions had been contained in the Act, and from the date fixed by the Order), to apply the above provisions with such variations or additions, if any, as to his Majesty in Council may seem fit; and it is lawful for his Majesty in Council to revoke any such order. (*n*)

(*h*) British Tanning Co., Ld. *v.* Groth, (1897) 8 R. P. C. 113; Acetylene Illuminating Co., Ld. *v.* United Alkali Co., Ld., (1902) 19 R. P. C. 213.

(*i*) See Acetylene Illuminating Co., Ld. *v.* United Alkali Co., Ld., (1902) 19 R. P. C. 213; 20 R. P. C. 161.

(*k*) *Ibid.*

(*l*) 46 & 47 Vict. c. 57, s. 103, (3) and (4); 1 Edw. VII. c. 18, s. 1 (2); P. R. (1903) rr. 13-16; Acetylene Illuminating Co., Ld. *v.* United Alkali Co., Ld., (1902) 19 R. P. C. 213.

(*m*) In the Matter of Main's Patent, (1890) 7 R. P. C. 13; 1 Edw. VII. c. 18, s. 1 (1).

(*n*) 46 & 47 Vict. c. 57, s. 104; see International Convention in the Appendix.

Foreigner's Application.

A patent in this country can only be granted under the provisions of sec. 103 or sec. 104, to a person who has actually made application for protection in the foreign State, and not to another person on his behalf. (*o*) A corporation can, it is submitted, legally apply in its own name alone. Where the foreign applicant is a firm the partners must combine to file a joint application.

Only the person who actually made the foreign application is recognised.

Moreover, secs. 103 and 104 of the Act of 1883 do not confer any rights on a person making an application for a British patent, in respect of an invention communicated to him from abroad. The rights conferred by the sections are personal, and intended to encourage people who have invented abroad to come to this country and to make known their inventions. (*p*) If the British specification be not accepted within twelve months of the foreign application, then the documents are laid open to inspection at the Patent Office before acceptance. (*q*)

The rights conferred by s. 103 are personal.

L'Oiseau and *Pierrard's Application* (*r*) is an instance of the advantages conferred on foreign applicants by sec. 103 of the Act of 1883. In that case the applicants applied for a patent for "automatic apparatus for subjecting the person to the action of electric currents," which was opposed by one *Everitt*, on the ground that his prior application, in which his complete specification had been accepted, for a patent for "improvement in completing electric currents," contained the subject-matter of the applicant's alleged invention. It appeared, however, that *L'Oiseau* and *Pierrard* had obtained a patent for their invention in France on a French application of earlier date than *Everitt's* application in England. *L'Oiseau* and *Pierrard* were therefore held entitled to an English patent, under the Act of 1883 and the Convention of 1884, to the disadvantage of *Everitt*.

Effect of an abortive foreign application.

When an inventor makes an abortive application in a foreign country, and then a successful application, before applying in this country, the British patent is antedated to the date of the successful foreign application.

Thus when a person on February 8, 1887, made an application in America for a patent, which became abortive, and on September 7, 1887, renewed his application, and then on April 8, 1888, made an application for a British patent, under sec. 103 of the Act of 1883, to bear date September 7, 1887, the

(*o*) In the Matter of Shallenberger's Application, (1889) 6 R. P. C. 550; in the Matter of Carez's Application, (1889) 6 R. P. C. 552.

(*p*) In the Matter of Shallenberger's Application, (1889) 6 R. P. C. 550.

(*q*) See 1 Edw. VII. c. 18, s. 1 (2).

(*r*) (1887) Griff. L. O. C. 36.

Foreigner's Application.

Comptroller refused the application. The law officer reversed the Comptroller's decision, and ordered a patent to be granted and dated September 7, 1887, on the ground that the patentee had no subsisting rights under his abortive application in America, of February 8, 1887. (*s*)

Practice on applications under s. 103 of the Act of 1883.

An applicant for a British patent under the provisions of sec. 103 of the Act of 1883 must include in his application a declaration that the foreign application as defined by the Patent Rules, 1903, has been made, (*t*) and must specify the foreign States or British possessions in which foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a complete specification, and signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any, (*u*) and letters of administration must be taken out in this country.

The application in the United Kingdom must be made on the Form A2, (*x*) and must be accompanied by, in addition to the complete specification left therewith, a copy or copies of the specification, and drawings 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. If any specification or other document relating to the application is in a foreign language, a translation thereof must be annexed thereto, and verified by statutory declaration or otherwise to the satisfaction of the Comptroller. (*y*)

Minor differences of departure in an applicant's English specification may be allowed, if the Comptroller and law officer are enabled, by the agreed translation of the foreign

(*s*) In the Matter of Van de Poele's Patent, (1890) 7 R. P. C. 69.

(*t*) "Foreign application" means an application by any person for protection of his invention ir a foreign State, or British possession, to which by an order of his Majesty in Council for the time being in force the provisions of s. 103 of the Act of 1883 have been declared applicable, see Patent Rules (1903) r. 3.

(*u*) See P. R. (1903) r. 13.

(*x*) See p. 349 *post*.

(*y*) See P. R. (1903) r. 14; for further details as to practice on applications under s. 103 of Act 1883, see rr. 15, 16.

Opposition—General.

specification, to conclude that the inventions referred to in the two documents are identical, or, at least, that the invention sought to be patented in the United Kingdom is not larger than that forming the subject of the foreign application. (*z*) Should the British patent be granted for an invention different to that forming the subject of the foreign application, this fact may seriously affect the validity of the patent. (*a*)

Though when an applicant applies for a British patent under the provisions of sec. 103 of the Act of 1883 his specification must not claim any invention which is not included in his foreign application, the British specification may be amplified beyond the disclosure made in the foreign specification; provided that the claim is limited to the invention covered by the foreign application. (*b*)

In the case where an invention is protected in the foreign State by more than one patent bearing the same date it is permissible to combine the various features in a single British application so long as sec. 33 of the Act of 1883 is complied with. Conversely an applicant relying on sec. 103 of the Act of 1883 may be required to divide his application, notwithstanding the fact that his invention is protected by a single patent in the foreign State.

It is immaterial whether the invention be protected in a foreign State by Letters Patent, Privilege, Certificate of Addition, or by Useful Model Registration. In all cases the period of priority allowed is twelve months. It is the practice for the examiner to quote against an application under the Convention all specifications published prior to the actual date of filing in this country, but when the previously published specification belongs to a patent of later date than that claimed under the Convention the Comptroller will not order the insertion of a reference to such prior specification.

The date of the British patent when sealed will be the date of the foreign application relied on.

Opposition.

By sec. 11 of the Patents, Designs, and Trade Marks Act, 1883, as amended by the Act of 1888, which (*inter alia*) relieved the

S. 11 of Act of 1883 as amended by Act of 1888.

(*z*) L'Oiseau and Pierrard, (1887) Griff. L. O. C. 37; in the Matter of Main's Patent, (1890) 7 R. P. C. 13.

(*a*) Avery's Patent, (1887) 4 R. P. C. 152; Renard *v.* Levinstein, (1864) 10 L. T. 177; Milligan *v.* Marsh, (1856) 2 Jur. N. S. 1083; Moser *v.* Marsden, (1893) 10 R. P. C. 209.

(*b*) L'Oiseau and Pierrard's Patent, (1887) Griff. L. O. C. 36.

Opposition—General.

Patent Office officials of the necessity of sending notices of interferences to prior applicants or patentees, (*c*) it is enacted as follows:—

"(1) Any person may, at any time within two months from the date of the advertisement of the acceptance of a complete specification, give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, 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.

"(2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, 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, but subject to appeal to the law officer.

"(3) The law officer shall, if required, hear the applicant and any person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

"(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint."

Opposition is allowed on only three grounds.

Hence the only grounds on which a person entitled so to do may oppose the grant of letters patent are—

(1) That the applicant has obtained the invention from him, or from a person of whom he is the legal representative.

(2) That the invention has been patented in this country, on an application of prior date.

(3) 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.

(*c*) 51 & 52 Vict. c. 50, s. 4.

Opposition—General.

Formerly, want of novelty, non-utility, and lack of subject-matter were all grounds of opposition, but the effect of the Act of 1883 is to abolish the right of the opposer to raise any of these grounds on an application for a patent; though, if the patent is granted, the Crown in no way guarantees that it may not be upset on one or other of these points in subsequent proceedings. (*d*)

When the two months' time-limit for giving notice of opposition has expired, it is submitted, a would-be opponent can only obtain leave to oppose by obtaining a *fiat* from the Privy Council.

Notice of opposition.

A person entitled so to do, and desirous of opposing a grant of letters patent, must, within the two months allowed from the date of the advertisement of the acceptance of the complete specification, give a notice of his opposition at the Patent Office, on Form D, stating the ground or grounds on which he intends to oppose, and he must himself sign the notice, stating his address, for service in the United Kingdom, and he must accompany his notice of opposition by an unstamped copy, which will be transmitted by the Comptroller to the applicant, (*e*) and, if he opposes on the ground that the invention has been patented in this country on an application of prior date, the notice must specify the title, number, and date of the patent granted on such prior application. (*f*)

The Comptroller has power to allow an amendment of an improperly drawn notice of opposition to be made at the hearing, but he cannot impose terms. (*g*)

Evidence of opponent and applicant.

Where the ground of opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation to be left at the Patent Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's specification the opposition is deemed to be abandoned; (*h*) and where this ground of opposition is raised the Comptroller may request or allow any person who has made a statutory declaration in the matter to attend before him at the hearing of the case and make oral

(*d*) p. 1 *ante*.

(*e*) P. R. (1903) r. 32.

(*f*) P. R. (1903) r. 35. The practice on oppositions to grants of patents is regulated by the Patent Rules (1903) rr. 32–41, and the Law Officer's Rules.

(*g*) In the Matter of Airey's Application, 5 P. O. R. 348; Lake, (1886) No. 8642, Griff. L. O. C. 35; P. R. (1903) r. 76.

(*h*) P. R. (1903) r. 33.

Opposition—General.

explanations with respect to such matters as the Comptroller may require.

Except in the case of the above mentioned ground of opposition being raised, statutory declarations need not be left in connection with an opposition, but the opponent may, within fourteen days after the expiration of two months from the date of advertisement of the acceptance of the applicant's complete specification, leave at the Patent Office statutory declarations in support of his opposition, and on so leaving must deliver to the applicant copies thereof. (*i*)

The applicant on his part may, within fourteen days from the delivery of such copies, leave at the Patent Office statutory declarations in answer, delivering copies thereof to the opponent, who then is allowed fourteen days from such delivery to leave at the Patent Office statutory declarations in reply, which must be confined strictly to matters in reply, and copies of which he must deliver to the applicant. (*k*)

If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do) within three months from the date of the advertisement of the acceptance of his complete specification, leave at the Patent Office statutory declarations in support of his application, and on so leaving declarations, he must deliver to the opponent copies thereof. (*l*)

Within fourteen days from the delivery of such last-mentioned copies, the opponent may leave at the Patent Office statutory declarations in answer, and on so leaving must deliver to the applicant copies thereof, and within fourteen days from such delivery the applicant may leave at the Patent Office his statutory declarations in reply, which must be confined to matters strictly in reply, and at the same time he must deliver copies thereof to the opponent. (*m*)

No further evidence can be left on either side except by leave, or on the requisition of the Comptroller. (*n*)

If either party files a useless and unnecessary multiplicity of declarations, the law officer will, as far as possible, endeavour to fix him with the costs and responsibility of them. (*o*)

Hearing.

When the evidence is finally completed, the Comptroller

(*i*) P. R. (1903) r. 36.
(*k*) *Ibid.* r. 37.
(*l*) *Ibid.* r. 38.
(*m*) *Ibid.* r. 39.
(*n*) *Ibid.* r. 40.
(*o*) Brand's Patent, (1894) 12 R. P. C. 102.

Opposition—General.

appoints a time for the hearing of the case, of which he must give at least ten days' notice to the parties. (*p*)

If the applicant or opponent desires to be heard, he must forthwith send the Comptroller an application on Form E. (*q*) The Comptroller may refuse to hear either party who has not sent such application for hearing.

If either party does not desire to be heard he should as soon as possible notify the Comptroller to that effect. (*r*)

If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. (*s*)

After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing the Comptroller decides the case and notifies his decision to the parties. (*t*)

As a rule, at the hearing of an opposition, the applicant begins; but when the opponent alleges *fraud* as a ground of opposition, the *onus* being on him, his evidence may be ordered to be taken first. (*u*)

If the opponent does not appear at the hearing, the Comptroller will decide the case in his absence, and will not recall his decision, even though it is subsequently shown that the opponent did not, in fact, receive the notice of hearing, which was duly posted. In such a case, on appeal to the law officer, the matter would most probably be sent back to the Comptroller for rehearing. (*x*) The mere withdrawal of an opposition does not entitle the applicant to the grant of a patent; the Comptroller of Law Officer, as the case may be, will hear and decide the case in the absence of the opponent. (*y*)

Appeal from the Comptroller's decision.

The evidence used on an appeal will be the same as that used at the hearing before the Comptroller, and no further evidence can be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law

(*p*) P. R. (1903) r. 41. The hearing may be during the legal vacations.
(*q*) P. R. (1903) r. 41.
(*r*) *Ibid.*
(*s*) *Ibid.*
(*t*) *Ibid.*

(*u*) Luke's Patent, (1887) Griff. P. C. 294.
(*x*) Warmann, (1887) Griff. L. O. C. 43.
(*y*) Kempton and Mollan's Patent, (1905) 22 R. P. C. 573.

Opposition—General.

officer, upon application for that purpose. (*z*) Such leave may in a proper case be obtained for the examination of witnesses who did not make declarations when the matter was before the Comptroller. (*a*)

An appeal to the law officer is a rehearing. (*b*) The law officer is entitled, if he desires it, to the assistance of an expert; (*c*) and he is also empowered, at the request of either party, to order the attendance at the hearing, for the purpose of cross-examination, of any person who has made a declaration; (*d*) and he is entitled to examine witnesses on oath, and to administer oaths for that purpose, and to order costs to be paid by either party. (*e*)

The law officer does not allow the cross-examination of witnesses or the admission of further evidence, when it appears to him that there has been ample opportunity for the filing of declarations when the case was before the Comptroller, and that he could not deal better with evidence given on cross-examination than with the declarations. (*f*) The law officer does not take on himself to decide adversely to the applicant fine points of anticipation. (*g*)

The law officer (and [*sic*] the Comptroller) is entitled to look at models in order to better understand the drawings and specifications, though the models are not exhibits, and consequently not evidence. (*h*)

Where an opposer appeals to the law officer from a decision of the Comptroller, it is not necessary that he should send a copy of his notice of appeal to the applicant. (*i*)

Power of Comptroller and law officer to impose conditions.

Both the Comptroller and the law officer have power to impose conditions on the granting of a patent, which power arises from the discretion of the Crown exercised through the Comptroller-General and the law officer to refuse the grant altogether. (*k*) Many instances of conditions imposed, and the reasons for the same, will be found in the following pages, where the different grounds on opposition are separately discussed.

Patent is only refused when

A patent is only refused in cases where the opposer proves

(*z*) L. O. Rules, r. viii.; 46 & 47 Vict. c. 57, s. 38; Hampton *v.* Facer, (1887) Griff. L. O. C. 13; Cheeseborough's Patent, Griff. P. C. 303.

(*a*) Thwaite's Patent, (1892) 9 R. P. C. 515.

(*b*) Stubbs' Patent, Griff. P. C. 298.

(*c*) 46 & 47 Vict. c. 57, s. 11 (4).

(*d*) L. O. Rules, r. ix.

(*e*) 46 & 47 Vict. c. 57, s. 38.

(*f*) In the Matter of Pitt's Patent, (1888) 5 R. P. C. 343, 345.

(*g*) *Ibid.*

(*h*) Lancaster's Patent, (1887) Griff. P. C. 294.

(*i*) Anderson and McKinnell, (1886) Griff. L. O. C. 23.

(*k*) p. 1 *ante*; L'Oiseau and Pierrard's Patent, (1886) Griff. L. O. C. 36.

his ground or grounds of opposition beyond all possibility of doubt, as there is no appeal from the decision of the law officer. It is evident that, should the law officer wrongfully refuse a patent the applicant would suffer an irremediable injury, whereas if a grant be made in the face of what is really a valid ground of opposition the public injury thereby occasioned may be remedied in a subsequent action for infringement, or petition for the revocation of the patent. (*l*)

Opposition—General.

the opposition is proved.

The law officer, having examined all the evidence given on one side or the other, is only justified in stopping the issue of a patent, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept the finding and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence. (*m*)

Costs.

The law officer, unlike the Comptroller, has power to award costs at the hearing before him. (*n*)

It is not the custom of the law officer to attempt to give costs to such an amount as would indemnify the parties. To do so would be seriously to discourage appeals, and to limit very much the usefulness of the office which the law officers fill in these matters (*o*)

Where an applicant, on appeal, consented to make a slight modification in his specification to satisfy the ground of opposition, but asked for costs of appeal, as he had not been previously asked to make the modification, costs were disallowed, as it was not the fault of the other side that the matter had arisen. (*p*)

In cases of unsuccessful opposition, the insertion of a few explanatory words in the specification may be allowed at the hearing before the law officer, and if the amendment is not a

(*l*) *Re* Russell's Patent, (1857) 2 De G. & J. 130, 132; *Re* Simpson and Isaacs' Patent, 21 L. T. N. S. 81; *Re* Spence's Patent, (1859) 3 De G. & J. 523; *Re* Lowe's Patent, 25 L. J. Ch. 454; *Re* Tolson's Patent, (1856) 6 De G. M. & G. 422; Chandler's Patent, (1886) Griff. P. C. 270; Stubbs' Patent, (1884) Griff. P. C. 298; Welch's Patent, (1884) Griff. P. C. 300; Edmund's Patent, (1886) Griff. P. C. 281; Newman, (1887) Griff. L. O. C. 40; Jones, (1887) Griff. L. O. C. 33; in the Matter of Aire and Calder Glass Bottle Works and Walker's Application, (1888) 5 R. P. C. 345; in the Matter of Daniel's Application, (1888) 5 R. P. C. 413; in the Matter of Wallis and Ratcliff's Application, (1888) 5 R. P. C. 347; in the Matter of Luke's Patent, (1889) 6 R. P. C. 548; Stuart's Patent, (1892) 9 R. P. C. 452; Codd's Patent, (1892) 9 R. P. C. 488; Levinstein's Patent, (1894) 11 R. P. C. 348.

(*m*) As to reopening cases decided by the Comptroller or Law Officer, see Thomas and Prevost's Patent, (1898) 15 R. P. C. 257. Per Clarke, S.-G., Stuart's Patent, (1892) 9 R. P. C. 452.

(*n*) 46 & 47 Vict. c. 57, s. 38.

(*o*) Per Clarke, S.-G., Stuart's Patent, (1892) 9 R. P. C. 453.

(*p*) Woodhead, (1886) Griff. L. O. C. 44.

Opposition—First Ground.

substantial alteration the costs of the appeal may be given as if no such modification had been accepted. (*q*)

Grounds of Opposition.—It will be convenient to consider separately the three grounds on which the grant of a patent to the applicant may be opposed by persons having a *locus standi* to oppose.

I. *The applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.*

Legal representative.

A person who has obtained an assignment of a patent, with the full benefit of all improvements and modifications thereof, from the assignee of the patentee, does not thereby become the legal representative of the patentee, so as to entitle him to oppose the grant of a patent to another inventor on the ground that the applicant obtained the invention from the prior patentee; (*r*) nor is a person holding a power of attorney from a patentee his legal representative within the meaning of the Act. (*s*) The term legal representative must be construed in its ordinary meaning of executor or administrator. (*t*)

Issue of true and first inventor is not open.

It is not the duty of the Comptroller on an application which is opposed, or of the law officer on appeal, to decide whether or not the applicant is the true and first inventor, and he cannot inquire into the circumstances under which the applicant became possessed of the invention, other than those which go to show that it was derived from the opponent, or the person of whom he is the legal representative, if this ground of opposition is properly raised. (*u*)

If this objection be clearly proved no patent will be granted. (*x*)

Objection may succeed in part.

The objection may succeed as to part only of the applicant's claim, in which case a patent may be ordered to be sealed for that portion only to which the opposition does not extend. (*y*)

The words "obtained the invention" are to be read as

(*q*) Fletcher, (1886) Griff. L. O. C. 30.

(*r*) Spiel's Patent, (1887) 5 R. P. C.

(*s*) Edmund's Patent, (1888) Griff. P. C. 281.

(*t*) *Ibid.*

(*u*) See in the Matter of Adolph Spiel's Application, (1888) 5 R. P. C. 281; in the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(*x*) In the Matter of Marshall's Application, (1888) 5 R. P. C. 661; in the Matter of Griffin's Application, (1889) 6 R. P. C. 296; Stuart's Patent, (1892) 9 R. P. C. 452; Paterson and Dundon's Patent, (1884) Griff. P. C. 295; Griffin's Patent, (1888) 6 R. P. C. 452.

(*y*) Thwaite's Patent, (1892) 9 R. P. C. 515.

meaning "obtained the invention which is purported to be patented," and as referring to the identity of the invention and not to the right of the person from whom it was obtained to be regarded as the first and true inventor. (*z*)

Opposition—First Ground.

If at the hearing before the Comptroller the evidence as to the applicant having obtained the invention from the opponent or a person of whom he is the personal representative is conflicting, the patent will be ordered to be sealed without prejudice to an appeal to the law officer, (*a*) and in order that the witnesses may be cross-examined. (*b*)

Patent is sealed when evidence is conflicting.

With regard to the right of an employer to oppose the grant of a patent for an invention to his servant, it is to be noticed that there is no authority which lays down that, in the absence of special contract, the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer so as to prevent the person employed from taking out and exclusively enjoying a patent for it. (*c*)

Employer and employed.

In *David* and *Woodley's Application*, (*d*) the facts were that *Jones*, having invented some improvements in sewing machines, was introduced by *David* to *Woodley*, and *Woodley* was employed by *Jones* and *David* conjointly (*David* claiming some interest in *Jones's* invention) to make a model. *Woodley* made some suggestions, which were embodied in the model. *Jones* took out a patent for the machine, whereupon *David* and *Woodley* applied for a patent for the suggestions made by *Woodley*. *David* and *Woodley* had also applied for a patent for alleged improvements on this invention. The Comptroller refused the grant, and the law officer upheld his decision, on the ground that when a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them. Further, if *Woodley* was in the employment of *Jones* and *David*, and not of *Jones* alone, the invention was *Jones's*, and he had never parted with his property in it, and *Woodley*

(*z*) Thwaite's Patent, (1892) 9 R. P. C. 515.

(*a*) Luke's Patent, (1887) Griff. P. C. 294.

(*b*) Hatfield's Patent, (1884) Griff. P. C. 288.

(*c*) See Heald's Patent, (1891) 8 R. P. C. 429; Vol. I. pp. 14, 15.

(*d*) (1884) Griff. L. O. C. 26.

Opposition—First Ground.

stood to *Jones* in the relation of paid servant to employer. *David* was entitled to enforce in a court of law any claims he might have against *Jones*, founded on the alleged partnership or of a pecuniary character.

Experiments by persons other than applicant.

The fact that other persons have made experiments identical with the applicant's will not stop the patent being granted unless the opposer shows that the applicant derived the invention from the person making such experiments, and then only if such person or his legal representative is the opponent. (*e*)

Assignment of unpatented and unpublished inventions.

In cases of agreements for the assignment of unpatented and unpublished inventions questions may arise as to the right of the alleged assignee to be made the patentee.

Thus, where an opponent in carrying on business had got into difficulties and had made an agreement to sell the business to the applicant, part of the consideration being an understanding that the opponent should give the applicant the benefit of a certain invention for sewing button-holes, and the opponent opposed on the ground that the invention had been obtained from him, the patent was refused in the absence of a written assignment. (*f*)

Fraud committed by applicant abroad.

Fraud committed abroad will not prejudice an applicant in respect of an invention stated to have been communicated to him from abroad.

Thus where, (*g*) on an application for a patent on a communication from abroad, the opposer objected that the applicant had obtained the invention from him through a third party abroad, the patent was granted on the ground that a person availing himself of information from abroad is an inventor within the Statute of Monopolies. (*h*) It is to be observed that the Comptroller and law officer have no authority to inquire into the source of the patentee's information in such a case; (*i*) neither will they inquire as to any alleged fraud committed by the applicant (communicatee) against the opponent abroad. (*k*)

(*e*) See *Ex parte* Henry, (1872) L. R. 8 Ch. 167; in the Matter of Homan's Patent, (1889) 6 R. P. C. 104; Saxby *v.* Gloucester Waggon Co., (1887) Griff. L. O. C. 57.

(*f*) In the Matter of Marshall's Application, (1888) 5 R. P. C. 661.

(*g*) In the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(*h*) 21 Jac. I. c. 3, s. 6; Nickels *v.* Ross, (1849) 8 C. B. 679.

(*i*) See Edmund's Patent, (1886) Griff. P. C. 281; in the Matter of Adolph Spiel's Patent, (1888) 5 R. P. C. 281; in the Matter of Bairstow's Patent, (1888) 5 R. P. C. 286.

(*k*) Higgin's Patent, (1891) 9 R. P. C. 74; Edmund's Patent, (1886) Griff. P. C. 283; Spiel's Patent, (1887) 5 R. P. C. 281; Bairstow's Patent, (1887) 5 R. P. C. 286; Lake's Patent, (1887) 5 R. P. C. 415.

Though a foreign applicant has important rights under sec. 103 of the Act of 1883 and the Convention of 1884, he is not entitled, on the ground that the applicant obtained part (*l*) or the whole (*m*) of the invention from him, to oppose an application in this country of earlier date than his own. (*n*)

Opposition—First Ground.

Rights of inventor who is a foreigner.

It is a good ground of opposition to the grant of a patent for a communication from abroad that the applicant had no authority from the foreign inventor to make the application, but that the opposer was the person to whom the foreigner entrusted his invention with the view of getting protection in this country. (*o*)

Sometimes the patent is granted to the applicant and opponent conjointly, if it appears that the invention is the joint production of both. (*p*)

Joint grantees.

When there were concurrent applications for a patent in respect of the same invention, it was formerly a recognised principle that the patent would be awarded to the inventor who ran quickest through the process and was ready first to obtain the Great Seal. (*q*) Now, however, since the patent is in all cases dated as on the day of application, (*r*) in the case of concurrent applications on the same day, one patent would most probably be granted to the two applicants jointly, and if the concurrent applications were not made on the same day the prior applicant would be entitled to the prior patent.

Concurrent applications.

It may be made a condition that the grantee shall assign a certain share to another person if the interests of justice appear to require it, as in the case of joint inventors making separate applications; (*s*) and each co-owner may be bound to pay a proportionate part of the fees necessary to keep the patent on foot. (*t*)

Condition that grantee shall assign a share.

The condition has been imposed, under circumstances that called for it, that the grantee and opponent should enter into an agreement by which the former should undertake to do all such acts as might be necessary to secure to the latter the full rights of a joint patentee in the invention, and the latter

Condition that opponent shall be made a joint patentee.

(*l*) Edmund's Patent, (1886) Griff. P. C. 281.

(*m*) In the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(*n*) Everitt, (1887) Griff. L. O. C. 28.

(*o*) Fiechter, (1882) Griff. P. C. 284.

(*p*) Eadie's Patent, (1885) Griff. P. C. 279; *Re* Russell's Patent, (1857) 2 De G. & J. 130; Luke's Patent, (1886) Griff. P. C. 294.

(*q*) *Ex parte* Dyer, Hindmarch on Patents, p. 535; *Re* Simpson and Isaacs' Patent, (1853) 21 L. T. 81.

(*r*) 46 & 47 Vict. c. 57, s. 13.

(*s*) Evans and Otway's Patent, (1884) Griff. P. C. 279; Garthwaite's Patent, (1886) Griff. P. C. 284.

(*t*) Evans and Otway's Patent, (1884) Griff. P. C. 279.

Opposition—Second Ground.

should undertake not to commence proceedings for revocation of the patent when granted. (*u*)

Rival applicants.

In the case of rival applicants, if it appear that distinct parts are the separate inventions of the rival applicants, separate patents will be ordered to be sealed to each applicant in respect of his own invention alone. (*x*)

Applicant's invention only an improvement on opponent's.

When it is clear that the applicant obtained the idea of his alleged invention from the opponent, and that the alleged invention is really nothing more than an improvement upon the opponent's patented invention, the application will be allowed only on the condition that the applicant insert in his specification a statement to the effect that his invention is an improvement upon the opponent's. (*y*)

II. *The invention has been patented in this country on an application of prior date.*

Opponent must have a *locus standi*.

It would appear at first sight that this ground of opposition is open to any person, whether he have a direct interest in opposing the patent or not; but the decisions lead to the conclusion that only persons having a direct interest are allowed to oppose on this ground now, as they were formerly by the special enactment of the repealed Act of 1852. (*z*) It must also be noticed that sub-s. 3 of sec. 11 of the Act of 1883 directs the law officer, on an appeal, to hear the applicant and any person giving notice, and being, "*in the opinion of the law officer*, entitled to be heard," and thus it is evident that the section contemplates the existence of persons who have no right of opposition, and constitutes the law officer the ultimate authority to decide the question of an opponent's *locus standi*. (*a*)

According to the law officer's decisions upon the present Acts and the practice based thereon, the only persons recognised as having a *locus standi* to be heard on this ground of opposition before the Comptroller, or, on appeal from him, before the law officer, are those who whether as original owners or assignees or otherwise have a direct interest in showing that the patent sought by the applicants would, if

(*u*) Luke's Patent, (1885) Griff. P. C. 294.

(*x*) Craig and Macfarlane's Applications, P. M. J. vol. iv. 3rd series, p. 366.

(*y*) Hoskins's Patent, (1884) Griff. P. C. 291; Newman's Patent (No. 2), (1838) 5 R. P. C. 279; for form of statement, see Griff. P. C. 292 *n*.

(*z*) s. 12.

(*a*) The Queen *v.* Comptroller-General of Patents: *Ex parte* Tomlinson, (1899) 16 R. P. C. 233.

granted, include what has already formed the subject of an earlier grant. (*b*) Thus in *Meyer's Patent* (*c*) a person who had *bonâ fide* attempted to carry out an invention but had been stopped in consequence of the existence of a patent with regard to it was held to have such an interest as entitled him to appear and support an opposition on the ground that the invention sought to be protected was identical with that which he had desired to carry out. The law officer has no wider jurisdiction than the Comptroller. He only hears cases by way of appeal, and the words "being in the opinion of the law officer entitled to be heard" refer back to the persons who are allowed to oppose by sub-s. 1 of sec. 11 of the Patents Act, 1883. (*d*)

Opposition—Second Ground.

It was held in *Bairstow's Patent* (*e*) that where a person was about to commence to work an invention, which he alleged was included under certain expired patents, he had not such an interest in the expired patents as to entitle him to be heard in opposition to the granting of a fresh patent; and in *Macevoy's Patent* (*f*) that a person who has no further interest in an expired patent than the fact that he manufactured under it is likewise not entitled to be heard in opposition to the grant of a fresh patent. Having regard, however, to the decision in *Meyer's Patent* it is extremely doubtful whether the decisions in *Bairstow's Patent* and *Macevoy's Patent* would be followed in future cases, and, it is submitted, they must be regarded as overruled.

A person who is merely an agent—*e.g.*, a patent agent—of a prior patentee has not such an interest in the prior patent as will entitle him to oppose a subsequent application in his own name. (*g*) The opposition must be in the name of the principal: otherwise this ground of opposition cannot be raised. (*g*)

A person having a *locus standi* on the second ground of opposition is entitled to rely in his opposition upon specifications

(*b*) Meyer's Patent, (1899) 16 R. P. C. 526; The Queen *v.* Comptroller General of Patents: *Ex parte* Tomlinson, (1899) 16 R. P. C. 233; J. and J.'s Patent, (1902) 19 R. P. C. 555; Stewart's Patent, (1896) 13 R. P. C. 672; Lancaster's Patent, (1884) Griff. P. C. 293; Glossop's Patent, (1884) Griff. P. C. 285; Heath and Frost's Patent, (1886) Griff. P. C. 288; Hookham's Patent, (1886) Griff. L. O. C. 32; Macevoy's Patent, (1888) 5 R. P. C. 285.

(*c*) (1899) 16 R. P. C. 526.

(*d*) See cases, note (*b*) above.

(*e*) (1888) 5 R. P. C. 286.

(*f*) (1888) 5 R. P. C. 285; see also Hookham's Patent, (1886) Griff. L. O. C. 32.

(*g*) Heath and Frost's Patent, (1886) Griff. P. C. 288; Lake, (1887) Griff. L. O. C. 35; Hookham, (1887) Griff. L. O. C. 32.

Opposition—Second Ground.

other than those in which he is, or was, interested and from which he derives his *locus standi*. (*h*)

It would appear that the effect of sec. 15 of the Act of 1883 is to place a person who has had a complete specification accepted in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose; (*i*) and, similarly, any other person who has a *bonâ fide* interest in showing that the invention claimed in an accepted complete specification, upon which no actual grant has been made, is identical with that of the applicant, would be allowed to oppose. (*k*)

Though law officer overrules Comptroller on question of *locus standi*, he will not lightly interfere with result of the decision.

Though the law officer on appeal allows the objection that the opponent is not a person entitled to be heard, he will not interfere with the Comptroller's decision as to the grant or refusal of the patent, unless he is satisfied that, looking at the substance of it, that decision ought to be interfered with. (*l*)

Patent allowed in doubtful cases.

When an application is resisted on this ground of opposition, (*m*) all the Comptroller or law officer can, on the hearing, be called on to decide is, whether or not the invention sought to be patented is the same as that patented on an application of prior date, and in cases of doubt the grant is allowed. (*n*)

(*h*) Stewart's Patent, (1896) 13 R. P. C. 627; Glossop's Patent, (1884) Griff. P. C. 285; Heath and Frost's Patent, (1886) Griff. P. C. 288; Hookham's Patent, (1886) Griff. L. O. C. 32; Macevoy's Patent, (1888) 5 R. P. C. 285.

(*i*) L'Oiseau and Pierrard, (1887) Griff. L. O. C. 36; but see *Ex parte* Henry, (1872) L. R. 8 Ch. 167.

(*k*) *Ibid.*; Meyer's Patent, (1899) 16 R. P. C. 526.

(*l*) Heath and Frost's Patent, (1886) Griff. P. C. 290.

(*m*) p. 34 *ante*.

(*n*) Cf. pp. 67, 68 *post*; Jones, (1886) Griff. L. O. C. 33. In the following reported cases, decided since the Act of 1883 came into operation, patents were refused on the ground that the respective inventions had been patented on applications of prior date:—

Heath and Frost's Patent, (1886) Griff. P. C. 310.
In the Matter of Daniel's Application, (1888) 5 R. P. C. 413.
In the Matter of Aire and Calder Glass Bottle Works and Walker's Application, (1888) 5 R. P. C. 345.
In the Matter of Wallis and Ratcliff's Application, (1888) 5 R. P. C. 347.
In the Matter of Webster's Patent, (1888) 6 R. P. C. 163.
Green's Patent, (1887) Griff. P. C. 286.
Lancaster's Patent, (1887) Griff. P. C. 293.
Re Bailey, Goodeve, P. P. 57.
Todd's Patent, (1892) 9 R. P. C. 488.
Boult's Application, (1893) 10 R. P. C. 275.
Stewart's Application, (1896) 13 R. P. C. 627.
Whittaker's Application, (1896) 13 R. P. C. 580.
Smith's Application, (1896) 13 R. P. C. 200.
Wylie and Morton's Application, (1896) 13 R. P. C. 97.

In the following reported cases, decided since the Act of 1883 came into operation, the objection was taken that the respective inventions had been patented on applications of prior date, but unsuccessfully:—

In the Matter of Lorrain's Patents, (1888) 5 R. P. C. 142.
In the Matter of Newman's Patent, (1888) 5 R. P. C. 271.
In the Matter of Pitt's Patent, (1888) 5 R. P. C. 343.
In the Matter of Airey's Application, (1888) 5 R. P. C. 348.
In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484.

Opposition—Second Ground.

If an invention is only described and not claimed in a prior specification, it may be patented on an application of later date, it being a long-established and obvious rule that only that is patented which the inventor claims. (*o*) There would, of course, be great doubt as to the validity of a patent granted under such circumstances. (*p*) A manufacture though within the broad words of a prior claim is not considered as *patented* in cases before the Comptroller and law officer, unless it is clearly set out in the body of the prior specification (*q*)—*i.e.*, unless it is quite clear that the prior patent deals with the difficulties and dangers which the later applicant alleges he has contemplated and overcome. (*r*) Thus where an applicant sought to patent the manufacture of a safety explosive from certain definite proportions of ingredients in view of the facts that the explosive so made was particularly safe against fire-damp and coal-dust in mines the seal was allowed, though opposed on the ground that a claim in a prior patent included the use of the same ingredients for making explosives and in variations of proportions which would include the specific proportions claimed by the applicant. The ground of the decision was that it could not be said that the prior patentee had contemplated the safety of the explosive from the point of view of safety by reason of the absence of deleterious effects after explosion, and that under such circumstances there *might* be invention in selecting the specific proportions claimed by the applicant. (*s*)

Invention described, but not claimed in a prior patent.

Ambit of opponent's claim may be disputed.

The question of the validity of the prior patent, which is said by the opponent to cover the whole or a part of the applicant's claim, is quite immaterial. (*t*) An applicant, however, is entitled to contend that the state of common knowledge is such that the opponent's claim ought to be read in a

In the Matter of Brownhill's Patent, (1889) 5 R. P. C. 135.
Anderton, (1837) Griff. L. O. C. 25.
Fletcher, (1887) Griff. L. O. C. 30.
Von Buch, (1887) Griff. L. O. C. 40.
Huth's Patent, (1884) Griff. P. C. 292.
Cumming's Patent, (1884) Griff. P. C. 277.
Stubbs' Patent, (1884) Griff. P. C. 298.
Ross' Patent, (1891) 8 R. P. C. 477.
Bartlett's Patent, (1892) 9 R. P. C. 511.
Maxim and Silverman's Application, (1894) 11 R. P. C. 314.
Marsden's Patent, (1896) 12 R. P. C. 87.
Southwell's Patent, (1899) 16 R. P. C. 361.
Nahnsen's Patent, (1900) 17 R. P. C. 203.

(*o*) Von Buch, (1887) Griff. L. O. C. 40.
(*p*) See Vol. I. chap. iii.
(*q*) See Nahnsen's Patent, (1900) 17 R. P. C. 203.
(*r*) *Ibid.*
(*s*) *Ibid.*
(*t*) Thornborough and Wilks' Patent, (1896) 13 R. P. C. 115.

Opposition—Second Ground.

particular way which will exclude the subject-matter of the applicant's claim. (*u*)

Conjoint effect of several prior patents.

The point always is, Has what the applicant claims been already granted by the Crown, *i.e.*, formed the subject of a prior claim or claims? No doubt it would require a very clear case to stop a patent when it is sought to establish this ground of opposition by putting together claims taken from two separate prior specifications, but still it is submitted this might be done; (*x*) but, when the case is clear, the patent will be refused on the ground that all the applicant seeks to claim is covered by claims taken from two or more specifications. (*y*)

Patent is refused when there is no appreciable difference between the applicant's and opponent's claims.

In cases where the law officer is forced to the conclusion that there is no substantial difference between the invention or combination claimed in the applicant's specification and an earlier specification it has not only been the practice but it is the duty of the law officer to refuse the patent. (*z*) For example, when the applicant merely claimed to effect a certain result by the use of one of many salts of chromium and one of many salts or iron from out of those covered by the claim on the opponent's specification, and there was no particular advantage shown in doing so, the patent was refused. (*a*)

When an application is opposed on the ground that an alleged invention is the same as that comprised in the opponent's patent, and it appears that there is a difference, but that such difference is quite immaterial, the patent is refused. (*b*)

In *Hedge's Patent* (*c*) it appeared that after eliminating matters of common knowledge nothing in the slightest degree materially different remained to distinguish the applicant's claim from the opponent's that could possibly be valid subject-matter, and the patent was refused accordingly.

(*u*) Haythornthwaite's Patent, (1890) 7 R. P. C. 71.

(*x*) Ross' Patent, (1891) 8 R. P. C. 477.

(*y*) Harrild and Perkin's Patent, (1900) 17 R. P. C. 617.

(*z*) Per Webster, A.-G., Todd's Patent, (1892) 9 R. P. C. 488; see also Thwaite's Patent, (1892) 9 R. P. C. 515; Daniel's Patent, (1888) 5 R. P. C. 413; Aire and Calder's Patent, (1888) 5 R. P. C. 345; Wallis and Ratcliff's Patent, (1888) 5 R. P. C. 347: Webster's Patent, (1888) 6 R. P. C. 163; Bailey's Patent, (1887) Goodeve P. C. 57; Boult's Patent, (1893) 10 R. P. C. 275; Bridge's Patent, (1901) 18 R. P. C. 257.

(*a*) Wylie's Patent, (1896) 13 R. P. C. 97; see Vol. I. p. 41, as to selection from a class being the subject-matter of invention.

(*b*) In the Matter of Aire and Calder's Patent, (1883) 5 R. P. C. 345; Wallis and Ratcliff's Patent, (1888) 5 R. P. C. 347; In the Matter of Daniel's Application, (1888) 5 R. P. C. 413; In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70; Heath and Frost's Patent, (1886) Griff. P. C. 310.

(*c*) (1895) 12 R. P. C. 136.

Opposition—Second Ground.

It is competent to the Comptroller or law officer, when an application is opposed on the ground that the invention has been patented on an application of prior date, to consider the question of mechanical equivalents; (*d*) though the application will not be refused unless it is clear that the invention in respect of which it is made is practically identical with that forming the subject-matter of the prior patent (*e*)—*e.g.*, where the only difference was the substitution of a coil for an internal cylinder in a heating apparatus, (*f*) or an equivalent for a crank bar (*g*) when the opponent's claim referred to a "crank bar or its equivalent."

Mechanical equivalents.

When a would-be patentee has good subject-matter, which is not identically the same as that comprised in a prior patent, he is entitled to have his patent sealed, though an action for infringement may lie against him if he puts his alleged invention into practice. (*h*)

It is no part of the duty of the Comptroller or law officer to inquire whether the applicant's patent, if granted, would infringe a prior patent, (*i*) or whether the alleged invention is proper subject-matter, (*k*) or whether the patent, if granted, would be invalid from any other cause; (*l*) and the applicant in all cases frames his specification at his peril. (*m*)

Notice of opposition must be distinct.

The notice of opposition must distinctly allege this ground of opposition in specific terms; it will be wrong in form if it allege that the prior invention was the same, "*or substantially the same*," as the applicant's, (*n*) or that the applicant's invention is "*a direct infringement of the opponent's patent.*" (*o*)

Question of validity of prior patent is not open.

It is not competent to the applicant to object that the prior patent relied on was void on the ground of disconformity between the specifications or between the title and the specifications, or upon any other ground. (*p*)

Green's Patent.

In *Green's Patent*, decided under the Act of 1883, before amendment of the Act of 1888, (*q*) the grant was opposed by

(*d*) In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70; Smith's Patent, (1896) 13 R. P. C. 200.

(*e*) p. 36 *ante*.

(*f*) Smith's Patent, (1896) 13 R. P. C. 200.

(*g*) Whittaker's Patent, (1896) 13 R. P. C. 580.

(*h*) In the Matter of Newman's Patent, (1888) 5 R. P. C. 271.

(*i*) Jones, (1887) Griff. L. O. C. 35; In the Matter of Sieluff's Application, (1888) 5 R. P. C. 484.

(*k*) Jones, (1887) Griff. L. O. C. 33.

(*l*) p. 1 *ante*.

(*m*) In the Matter of Lorrain's Patents, (1888) 5 R. P. C. 142.

(*n*) Jones, (1887) Griff. L. O. C. 33.

(*o*) In the Matter of Daniel's Application, (1888) 5 R. P. C. 413.

(*p*) Green, (1887) Griff. P. C. 286; Newman, (1887) Griff. P. C. 40; In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70.

(*q*) (1885) Griff. P. C. 286.

Opposition—Second Ground.

Lowcock and *Sykes*, on the ground that the invention for which the applicant sought to obtain protection had been, as to certain parts, patented by them. The applicant objected that the opponent's patent was bad, because the complete specification went beyond the provisional, which did not include the parts which the applicant wished to cover. The law officer held that, though the opponent's patent might in fact be void, yet he could not entertain the objection; and since the opponent's patent included the parts in dispute he could not allow a patent to be sealed to the applicant. The applicant consequently suffered in that he was prevented from obtaining a patent for the parts which he had invented between the dates of filing the opponent's specifications. The opponent's specifications having been referred to an examiner, and reported favourably upon by him, it was the duty of the Comptroller and law officer, for the purpose of the application, to treat them as good specifications, and consequently the question of disconformity could not be raised. (*r*)

The third ground of opposition, (*s*) which was introduced by the Act of 1888, (*t*) provides for such a case as the above. If the Act of 1888 had then been in force it would have been competent to *Green* to have opposed the grant to *Lowcock* and *Sykes*, and to have himself applied for a patent in respect of his own invention.

Claim by applicant for something not foreshadowed in the provisional specification of patent relied on by the opponent.

Where something claimed by the applicant is not to be found foreshadowed in the provisional specification of the patent relied on by the opponent, though it may possibly be found described in the complete specification of such patent, and the said complete specification was in fact filed after the date of the application, these dates become most important. In such a case the patent of the applicant should be sealed on the ground that, by refusing it, great injustice might be done to the applicant. He might succeed, if the patent is allowed, in satisfying a Court that what was described in the opponent's complete specification was in fact novel at the date of his application, since it was not foreshadowed in the opponent's provisional. (*u*)

Expiration of prior patent relied on is no bar.

Whenever the application is opposed on the ground now under discussion it does not signify that the prior patent has

(*r*) Green's Patent, (1895) Griff. P. C. 286. In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70.

(*s*) p. 50 *ante*. In the Matter of Anderson and Anderson's Patent, (1890) 7 R. P. C. 323.

(*t*) s. 4.

(*u*) Bartlett's Patent, (1892) 9 R.P. C. 511.

expired; (*x*) but if an invention has only been described in a provisional specification it cannot be made an objection to a later application. (*y*)

Opposition—Second Ground.

It is the duty of the Comptroller and the law officer, on appeal from him, to see that no claim in an applicant's specification is allowed which is wide enough to include something which might unquestionably form part of that which is claimed in a prior specification relied on by the opponent. (*z*) This principle is given effect to by disallowing the claim, or by ordering the claim as originally drawn to be modified, or a general or special disclaimer of the principle embodied in the prior patent to be inserted in the applicant's specification. (*a*)

Object of the power to refuse the patent, or to require an amendment or a disclaimer.

The exercise of the authority of the Comptroller and law officer to impose conditions on the grant of a patent in this way operates for the protection of previous inventors (*b*) and the public generally. (*c*)

If a subsequent patent be granted and a specification accepted which actually or apparently claims something which is included in a prior patent, or something which is not patentable, the prior patentee in the one case, or the public in the other, suffers what may be a disadvantage to them, in so far as the subsequent patentee may endeavour under his grant to lay claim to the exclusive monopoly in the particular thing in question, yet they do not sustain any permanent injury, for the subsequent patent granted under such circumstances would be void. (*d*)

It is not to the interests of subsequent patentees that their patents should be apparently for an original or far-sweeping invention, when, as a matter of fact, they can only claim a particular combination which they have described; and it is not to the interest of the public that they should be led into supposing that a description in a specification is entirely general, whereas it can only be supported as a specification of valid letters patent if the description be understood to be a description of an improvement. (*e*)

(*x*) Lancaster's Patent, (1884) Griff. P. C. 293.

(*y*) Bailey's Patent, (1884) Griff. P. C. 269; Patterson's Patent, Griff. P. C. 295.

(*z*) Curtis and André's Patent, (1892) 9 R. P. C. 499; Hamilton's Patent, (1901) 19 R. P. C. 33.

(*a*) Curtis and Andrés Patent, (1892) 9 R. P. C. 495; Hamilton's Patent (1901) 19 R. P. C. 35.

(*b*) In the Matter of Newman's Patent, (1888) 5 R. P. C. 271; Griff. L. O. C. 40.

(*c*) In the Matter of Lorrain's Patent, (1888) 5 R. P. C. 142; In the Matter of Guest and Barrow's Patent, (1888) 5 R. P. C. 312; Teague's Patent, (1884) Griff. P. C. 298.

(*d*) Vol. I. chap. iii. In the Matter of Hill's Application, (1888) 5 R. P. C. 599.

(*e*) Hoskins' Patent, (1884) Griff. P. C. 291; In the Matter of Newman's

Opposition—Second Ground.

Grounds for requiring a disclaimer.

The Comptroller and law officer, in deciding upon the propriety or impropriety of inserting a disclaimer in the applicant's specification, are in no way whatever concerned with the question whether the applicant's claim amounts to an infringement of the opponent's patent or not. And it is not their duty to stop a patent at the instigation of an opponent because some principle of patent law may be infringed. (*f*) Thus when the opponent desired a special reference in the applicant's specification on the ground that a claim in the prior specification amounted to a legitimate broad claim to a principle as carried out by the means described by the applicant, which were analogous to those claimed in the opponent's specification, the law officer allowed the patent without a disclaiming clause at all. (*g*) To obtain a disclaimer the opponent must show that the applicant's claim, without it, will be a repetition of the opponent's. (*h*)

That is to say, it is a principle recognised by the law officers that where there is an existing patent, and there is fair ground for supposing that on the true construction a claim made by a subsequent applicant would interfere with the rights claimed by an existing patentee, he is entitled to be protected; and such protection is usually given by the insertion in the specification of the subsequent applicant of a general disclaiming clause or special reference. (*i*)

It would appear that, if there be a distinct reference in the applicant's provisional specification to an invention or device, which was within the specification of the opponent properly construed, the opponent is entitled to have a disclaimer on the face of the complete specification. (*k*)

It is to the interests of the public that, where patents overlap, the distinctions between the inventions described in the specifications filed under the earlier and later applications

Patent (No. 2), (1888) 5 R. P. C. 279; see also Hamilton's Patent, (1901) 19 R. P. C. 35.

(*f*) Newman's Patent, (1887) 5 R. P. C. 277; McHardy's Patent, (1891) 8 R. P. C. 432; Todd's Patent, (1892) 9 R. P. C. 487.

(*g*) Marsden's Patent, (1896) 13 R. P. C. 87.

(*h*) Stell's Patent, (1891) 8 R. P. C. 236; Hill's Patent, (1888) 5 R. P. C. 599.

(*i*) In the Matter of Newman's Patent, (1888) 3 R. P. C. 271; In the Matter of Hall and Hall's Patent, (1888) R. P. C. 283; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; In the Matter of Gozney's Patent, (1888) 5 R. P. C. 597; In the Matter of Guest and Barrow's Patent, (1888) 5 R. P. C. 312; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Anderson and McKinnell, (1887) Griff. L. O. C. 23; In the Matter of Hoffman's Patent, (1889) 7 R. P. C. 92; see pp. 43–50 post.

(*k*) Hookham, (1887) Griff. L. O. C. 32; see also In the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

should be made clear; (*l*) but it must be remembered that the object of a disclaiming clause is to guard against the inclusion in a new patent of something embraced by the old patent, not of something merely mentioned in the old patent, but of something which has been claimed as part of the previous invention. (*m*)

Opposition—Second Ground.

Thus Lord *Alverstone*, L.C.J., then *Webster*, A.-G., in *Stell's Patent* (*n*) stated the principles on which special disclaimers, *i.e.*, references *nominatim* to prior patents, are ordered or refused as follows:—

Principles upon which special disclaimers are ordered.

> "The principles upon which the law officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and, secondly, if it is clear that the public would be misled by the later specification without disclaimer."

And in *Atherton's Patent* (*o*)—

> "I consider, assuming a proper statement of prior knowledge is inserted for the protection of the public, that the claims in a specification are inserted at the risk of the patentee, because he jeopardises his own patent by inserting too much. . . . With regard to the point as to statement of prior knowledge, an important question of principle is involved, upon which I have more than once expressed my opinion, but I wish to express it again. There is no objection at all to a patentee inserting (provided he does it fairly) what he believes to be a statement of prior knowledge. It is, in my opinion, a very convenient course. He does it at his own peril; but I consider it to be a protection to the public in directing their attention to what the patentee believes to be the state of knowledge, and, further, in enabling them to see whether the patentee has made a mistake in the event of his having thought that the prior knowledge did not cover any particular device which he included, as matter of invention, in the specification. . . . But I object to any one putting in his construction of written documents, because, in my opinion, written documents have to speak for themselves or be interpreted by the Court. . . . A patentee has no right to try and put on the public what he believes to be the construction of the written document. He

(*l*) In the Matter of Hill's Application, (1888) 5 R. P. C. 599.
(*m*) In the Matter of Gozney's Patent, (1888) 5 R. P. C. 597; In the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.
(*n*) (1891) 8 R. P. C. 236.
(*o*) (1889) 6 R. P. C. 547.

Opposition—Second Ground.

has a perfect right to give his own statement of the prior knowledge and say he refers, in support of his statement, to any number of previous specifications."

And in *Guest and Barrow's Patent* (*p*)—

"I have on many occasions pointed out that the insertion of these disclaimers does not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interests, in order that his specification may not be considered as being too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge. It is not because a particular patentee, or a prior inventor, has made a broad claim that he is entitled to have limiting words inserted, unless he can show, upon a fair view of the evidence before the law officer, or before the Comptroller, that such words are really necessary to protect him." (*q*)

Special references and concurrent applications.

There is no reported case of a special reference having been ordered where the application of the opponent, though prior to, is practically concurrent with that of the applicant, and *Webster*, A.-G., pointed out that where the applications are concurrent the principles applicable to cases of previous patent do not equally apply, and reserved the decision of the question as to what are the proper disclaimers or references to be inserted in the case of concurrent applications till the matter has to be decided for the purposes of a particular case. (*r*) As a rule, concurrent applicants might be expected to agree on the matter to their mutual advantage. (*s*)

References to defects.

Where a specification only contains a statement of general knowledge, there is nothing in the Patent Law to prevent a patentee on the face of his specification referring to the general defects which he alleges rightly or wrongly exist; but it would appear that, if a prior patentee is referred to specifically in a subsequent specification, no reference to any defect in the prior invention ought to be allowed in the latter specification. (*t*)

When special disclaimers are required.

The Comptroller and law officers are always very unwilling to order the insertion of a special reference to the patent of a

(*p*) (1888) 5 R. P. C. 312.

(*q*) See also Newman's Patent, (1888) 5 R. P. C. 279, 281; In the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

(*r*) Gaunt's Patent and Greenhalgh's Patent, (1897) 14 R. P. C. 388.

(*s*) *Ibid.*

(*t*) Guest and Barrow's Patent, (1888) 5 R. P. C. 316.

Opposition—Second Ground.

prior inventor and opponent, unless they can be sure that they have the whole knowledge of the trade before them, and that there are no other specifications which claim part of the ground claimed by the applicant (*u*)—*e.g.*, where it is practically admitted by the applicant that the governing principle was for the first time discovered or disclosed in the opponent's specification. (*v*)

The rule was stated by *Webster*, A.-G., in *Southwell's Patent* (*x*) to the effect that unless the parties before the Comptroller agree on a state of knowledge that is to be assumed to be the basis of both inventions, if an opponent is desirous of having a claim in an earlier specification construed as a pioneer or master claim to such an extent that he is entitled to a wide construction for the purpose of stopping future patents, he is bound to bring the state of knowledge before the Comptroller. A person who describing in specific language a method of arriving at a given end, afterwards, seeks to say that the language is to include something which is on the face of it different cannot ask the Comptroller so to act without establishing that for the purposes of the Comptroller's decision the earlier patent is to be regarded as a master patent, (*y*) and the fact that during the performance of an applicant's process certain results are obtained which may be the same as results obtained by another patented process does not make the patent for the earlier process a master patent *quoad* the applicant's process. (*z*) Where, however, the specification of the applicant shows at best a mere minimum of invention the position of an alleged master patent will not be discussed by the law officer in any narrow spirit. (*a*) Where the applicant's claim extends to something which is the subject of a claim made by a prior patentee amendment by excision, or disclaimer, will be required. (*b*)

General disclaimers are more usually required than special disclaimers.

The Comptroller and law officer usually prefer to insert a general disclaimer of the principle included in the invention of the prior patentee, (*c*) bearing in mind that every prior

(*u*) See Stell's Patent, (1891) 8 R. P. C. 236; Kilner's Patent, (1889) 8 R. P. C. 35.

(*v*) Welch's Patent, (1891) 8 R. P. C. 442.

(*x*) (1899) 16 R. P. C. 362.

(*y*) Southwell's Patent, (1899) 16 R. P. C. 362.

(*z*) Meyenberg and the Clayton Anilin Co.'s Application, (1905) 22 R. P. C. 353.

(*a*) Sach's Patent, (1900) 18 R. P. C. 221.

(*b*) See Hetherington's Patent, (1889) 7 R. P. C. 419.

(*c*) Anderson and McKinnell, (1887) Griff. L. O. C. 23; In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Kilner's Patent, (1889) 8 R. P. C. 35.

Opposition—Second Ground.

patentee does not possess a right to have a disclaiming clause inserted in a subsequent specification, because, as was pointed out by Lord *Cairns*, every specification must be read as though the patentee had a knowledge of every previous complete and published specification of earlier letters patent. (*d*)

Speaking generally, a special reference, at the request of the opponent, to a prior patent ought to be allowed only if in the event of the insertion of that reference being refused by the applicant the Comptroller or law officer would be justified in saying that the patent with the proposed claim should not be sealed at all, (*e*) or where there is substantial identity between the fundamental parts of the two inventions, but a difference which can only be justified upon the ground of improvement. (*f*) Sometimes the opponent is allowed to elect whether the objectionable claim of the applicant should be struck out or a disclaiming clause should be inserted in his specification. (*g*)

The legitimate objects for which general and special disclaimers are ordered.

Disclaimers and especially special disclaimers ought not to be ordered for the mere purpose of making earlier patents known, but only for the purpose of explaining what the claim of the applicant really is. A claim may be so general in its terms as to include something which has been the subject of a prior grant, as well as the improvement which the applicant has, or thinks he has, invented. It is in such a case, where it might be the duty of the Comptroller and law officer to refuse the patent altogether, unless the claim were amended in such a way as to show that it is not directed to the matters which have formed the subject of the prior grant or grants, that a special disclaimer referring *nominatim* to the prior patent or patents should be ordered. The special disclaimer is only a substitute for the more scientific way of altering the language of the claim itself to the form it ought to have assumed if it had been skilfully drawn in the first instance, having regard to the prior patent or patents. (*h*)

In cases, therefore, where the rights of prior patentees or the public cannot be effectually protected without special mention of the prior patents, the insertion of a special disclaimer is usually made a condition of the granting of a patent

(*d*) See In the Matter of Newman's Patent (1888) 5 R. P. C. 279.

(*e*) Per Finlay, S.-G., Marsden's Patent, (No. 2), (1897) 14 R. P. C. 174; see also Stell's Patent, (1891) 8 R. P. C. 235.

(*f*) Newton's Patent, (1899) 17 R. P. C. 124.

(*g*) Teague's Patent, (1885) Griff. P. C. 298.

(*h*) Marsden's Patent, (1896) 13 R. P. C. 87; Adam's Patent, (1896) 13 R. P. C. 548; Marsden's Patent, (1897) 14 R. P. C. 174.

Opposition—Second Ground.

to a subsequent applicant, and the form of reference generally ordered is to the effect that the patentee is aware of the existence of the prior patent, and that he does not claim anything claimed and described therein. (*i*) So also in the case of concurrent applications and cross oppositions, if it appear that the specification of one of the applicants includes something which is the sole invention of the other applicant the Comptroller will insist on the first applicant amending his specification so as to confine it to what has actually been invented by him. (*k*)

On the same principle, if an invention is merely an improvement on and subsidiary to a prior patented machine or process, the Comptroller and law officer will require a disclaimer by reference to the name and number of the prior patent, since it is only just to the opponent and in the interests of the public that this should be so. (*l*)

The Comptroller and law officer are bound to protect the public from being misled; (*m*) and the object for which special references to prior patents are ordered to be inserted in the applicant's specification is to guide the public to the proper construction of the claim made by the applicant. (*n*) So a special disclaimer may be ordered for the purpose of removing an ambiguity. (*o*) If, on the other hand, a special disclaimer might prejudice the construction a mere reference to the prior patent will be ordered instead, (*p*) or a disclaimer following the identical words of the opponent's claim, but without any special reference to the opponent's patent (*q*)—*e.g.*, in *Maxim and Silverman's Patent*, (*r*) where neither the Comptroller nor the law officer could come to a clear conclusion that the invention had been patented on the application of prior date relied on, and the Comptroller had ordered a special

(*i*) In the Matter of Lorrain's Patent, (1888) 5 R. P. C. 142; In the Matter of Airey's Patent, (1888) 5 R. P. C. 348; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; In the Matter of Newman's Patent, (1888) 5 R. P. C. 271; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Hoskins' Patent, (1884) Griff. P. C. 291; Welch's Patent, (1884) Griff. P. C. 300.

(*k*) Paterson's Patent, (1884) Griff. P. C. 295; Craig and Macfarlane's Application, P. M. J. vol iv. 3rd series, p. 366.

(*l*) Hoskins' Patent, (1884) Griff. P. C. 291; Welch's Patent, (1884) Griff. P. C. 300; In the Matter of Newman's Application, (1888) 5 R. P. C. 271, 279; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; Levinstein's Patent, (1894) 11 R. P. C. 349; Tattersall's Patent, (1892) 9 R. P. C. 150.

(*m*) Lorrain's Patent, (1888) 5 R. P. C. 143.

(*n*) Van Gelder's Patent, (1892) 9 R. P. C. 326; pp. 41, 46 *ante*.

(*o*) Brand's Patent, (1895) 12 R. P. C. 102.

(*p*) Van Gelder's Patent, (1892) 9 R. P. C. 325; Maxim and Silverman's Patent, (1894) 11 R. P. C. 314.

(*q*) Newton's Patent, (1899) 17 R. P. C. 123, 125.

(*r*) (1894) 11 R. P. C. 314.

Opposition—Second Ground.

disclaimer in the words, "We are aware of the specification of patent No. of granted to , *and we make no claim to anything described and claimed therein*," the law officer, on appeal, to meet the justice of the case and the public interest, ordered the words, "*and we make no claim to anything described and claimed therein*," to be struck out. (*s*) And in *Newton's Patent*, (*t*) where the Comptroller had ordered a special reference to the opponent's patent, the law officer not being satisfied that the difference between the applicant's alleged invention and the opponent's was one which could only be justified on the ground of improvement ordered a disclaimer in terms identical with the opponent's claim, but without any special reference to the opponent's patent.

It must be borne in mind that a statement of public knowledge in the terms of an opponent's claim has by no means the same effect as a special reference. It does not allow the inference that the ambit of the invention is the same in whole or in part in both cases, but leaves the question of invention to be determined from the consideration of that which the earlier patentee and the later patentee have described. (*u*) A special disclaimer may be ordered on the ground that though in the applicant's specification there are differences from the opponent's, yet there is a very strong resemblance between the mechanism as claimed by the opponent's specification and that described in the applicant's specification and drawings. (*v*)

A special reference will sometimes tend to stop further litigation where a general disclaimer would not, and will be ordered to be inserted on that account. (*x*)

Agreement between parties as to the meaning of a specification.

If the meaning of a specification be ambiguous, the Comptroller or law officer may, on the hearing of the application, order it to be placed on record to what the specification is understood to be confined by the statement and agreements of both the opposer and applicant; (*y*) and, if the provisional specification contain a reasonably clear indication of the improvement it is ultimately desired to protect by the patent, the Comptroller has power to order any amendment which will put the particular description of the invention claimed absolutely beyond doubt. (*z*)

(*s*) (1894) 11 R. P. C. 314.
(*t*) (1899) 17 R. P. C. 123.
(*u*) *Ibid.*
(*v*) Thornborough and Wilks' Patent, (1896) 13 R. P. C. 115.
(*x*) In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663.
(*y*) Anderton, (1887) Griff. L. O. C. 25.
(*z*) Chandler's Patent, (1884) Griff. P. C. 270, 274.

Opposition—Second Ground.

Sometimes a claim in an applicant's specification is ordered to be struck out altogether, when it includes something claimed by the complete specification under a prior patent; (*a*) but it must be remembered that the applicant is entitled to frame his specification as he pleases, so long as he does not interfere with existing rights (*b*) The Comptroller or law officer has no authority to order a claim to be struck out merely because it may invite the public to infringe a prior patent, if the applicant, in the body of the specification, shows some invention with regard to the thing claimed. (*c*) Nor can the Comptroller or law officer require the amendment of a claim in order to make it conform to the description in the specification, if the claim is otherwise a real statement of the invention claimed. (*d*)

Striking out claims.

Necessity for amendment or disclaimer should be avoided.

The applicant should draft his claim in the first instance so as to embrace only his real invention. If he does not do so, he runs the risk, in the event of opposition, of not being allowed to make such an extensive amendment as might be required to remedy a defective claim, or to remedy the claim by the less scientific method of inserting a special reference to the opponent's patent. (*e*) Thus the law officer refused to seal a patent when the applicant's specification contained a claim wide enough to include, without doubt, what had been patented by the opponent; and he further refused to allow a special disclaimer or words limiting the claim, on the express ground that the claim should have been drawn originally for the slight alleged improvement if the intention was to claim it (*f*) Further, the fact that the law officer may not have the materials before him necessary to enable him to say whether, having regard to prior patents, the amended claim sought by the applicant should be allowed or not may sufficiently justify him in disallowing it. (*g*)

On the other hand, a case may well arise in which the applicant would, at the hearing of an opposition, be allowed to amend by making a claim entirely differing from that in the complete specification as originally framed. (*h*)

(*a*) In the Matter of Hall and Hall's Patent, (1888) 5 R. P. C. 283; In the Matter of Webster's Patent, (1889) 6 R. P. C. 163; Hamilton's Patent, (1901) 19 R. P. C. 35.

(*b*) See p. 18 *ante*.

(*c*) In the Matter of Webster's Patent, (1889) 6 R. P. C. 165.

(*d*) Smith's Patent, (1884) Griff. P. C. 268.

(*e*) See Whittaker's Patent, (1896) R. P. C. 58.

(*f*) Lupton and Place's Patent, (1897) R. P. C. 261.

(*g*) See Mills' Patent, (1901) 18 R. P. C. 324.

(*h*) Harrild and Perkin's Patent, (1900) 17 R. P. C. 617; but see Mills'

Opposition—Third Ground.

An opponent, though not appealing against the grant of a patent, is entitled to appeal against the Comptroller's decision that no reference to his patent be inserted in the specification. (*i*)

Appeal may be limited to the question of a special reference.

III. *That the complete specification describes and 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.*

When disconformity is a ground for refusing the patent.

A disconformity between the complete and provisional specifications is fatal to the validity of the grant of letters patent, as has been already demonstrated. (*k*) Disconformity, however, will not induce the Comptroller and law officer to refuse to seal a patent after the specification has been accepted, unless in accordance with the above-stated ground of objection (*l*) the matter in the applicant's complete specification which is in excess of the provisional has, in the interval between the leaving of the two documents, formed the subject of an application by the opponent.

When this objection is raised it is the duty of the Comptroller or law officer to ascertain what is the real and proper construction of the language of the provisional specification, and not to accept any meaning suggested by the applicant which the document itself will not bear out. (*m*) It then becomes important to ascertain whether the alleged excess invention is really only a legitimate development of the invention to be found described in the provisional, (*n*) or whether it is really a different one, and the same as that forming the subject of the opponent's subsequent application. If it is only a legitimate development the opposition will fail. (*o*) The law officer should carefully consider the question whether the patent should be stopped, because should he

Patent, (1901) 18 R. P. C. 324; and Lancaster's Patent, (1902) 20 R. P. C. 366, where a substituted claim was disallowed by the law officer on the ground that it was for something absolutely different from what was described in the provisional specification.

(*i*) Brownhill's Patent, (1889) 6 R. P. C. 135.

(*k*) Vol. I. p. 190.

(*l*) Sec. 4 of Act, 1888, Appendix.

(*m*) Birt's Patent, (1892) 9 R. P. C. 489.

(*n*) See Vol. I. p. 188.

(*o*) Edward's Patent, (1894) 11 R. P. C. 461; Miller and Miller's Patent, (1898) 15 R. P. C. 718; Birt's Patent, (1892) 9 R. P. C. 489.

improperly allow the seal, his decision might affect the question of disconformity if subsequently raised in the superior Courts. (*p*)

Sealing the Patent.

Wilson's Patent (*q*) and *Hudson's Patent* (*r*) afford good illustrations of this ground of opposition. In the former case the invention related to bicycle tyres, and the applicant's provisional specification described various combinations of parts for the construction of tyres, but did not allude to any method or methods of fastening the tyres to the wheels. The complete specification, on the other hand, described the tyres as fitted to specially constructed wheel rims with special means for fastening the tyres, and the rims, combined with the methods of fastening, were the subjects of claims. The grant was opposed by four different opponents, who had, between the dates of the filing of the applicant's provisional and his complete specification, made applications for patents for the various methods of attachment claimed in the applicant's complete specification. The Comptroller ordered the excision of the figures and drawings and of the corresponding description and claims referring to the methods of fastening the tyres to the wheels. The law officer on appeal somewhat varied the Comptroller's decision, but required that the complete specification should be amended so as to prevent the applicant from claiming as a part of his invention the means of fastening the tyres to the wheels as distinct from the construction of the tyres themselves.

Sealing the Patent.

Seal of the Patent Office.

If there be no opposition, or if there be opposition, and the determination is in favour of the grant of a patent, the Comptroller is required, on the applicant filing a request to have the patent sealed, (*s*) to cause a patent to be sealed with the seal of the Patent Office, which is equivalent for this purpose to the Great Seal of the United Kingdom. (*t*)

Time within which the patent must be sealed.

A patent cannot be sealed after the expiration of fifteen months from the date of application, (*u*) except in the following cases:—

(*p*) See Hudson's Patent, (1904) 22 R. P. C. 218.
(*q*) (1892) 9 R. P. C. 512.
(*r*) (1904) 22 R. P. C. 218.
(*s*) Patent Rules, (1905) r. 12; 46 & 47 Vict. c. 57, s. 12; 2 Edw. VII. c. 34, s. 1 (10).
(*t*) 46 & 47 Vict. c. 57, s. 12, sub-s. 2.
(*u*) *Ibid.* sub-s. 3.

Sealing the Patent.

(1) When the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, in which case the patent may be sealed at such time as the law officer may direct. (*y*)

(2) If the person making the application dies before the expiration of fifteen months from the date of application, in which case the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant. (*z*)

(3) Where the Comptroller has granted an extension of time for the leaving or accepting of a complete specification, in which case a patent may be sealed within nineteen months from the date of the application. (*a*)

In the case of delay caused by opposition, a patent may be sealed at such time as the law officer appoints, even though the opposition is not adjudicated upon till after the expiration of fifteen months from the date of the application; (*b*) the case, however, is different when the delay is caused by the applicant. Thus, where there was an opposition which caused some delay, and the applicant by mere inadvertence neglected to comply with the Comptroller's requisition till long after fifteen months from the application, the law officer refused to seal the patent on the ground that the delay was not caused by the opposition. (*c*) An applicant may, under some circumstances, desire to delay the sealing of the patent for a longer period than fifteen months from the date of application. If this be so, he should arrange that the allowable extension to nineteen months may suffice his purpose. It is neither right nor politic that he should attempt to gain time by means of a bogus or collusive opposition to the grant; and such a proceeding would more likely than not have the effect of losing him the patent altogether as the law officer, on the ground that the opposition was not genuine, would refuse the necessary extension of time for sealing the patent. (*d*) In fact, according to the report of one such case the law officer refused to extend the time upon the express ground that, as the delay had not been caused by the opponent but had been brought about

(*y*) 46 & 47 Vict. c. 57, s. 12, sub-s. 3, p. 206 *post*.

(*z*) *Ibid*.

(*a*) 48 & 49 Vict. c. 63, s. 3, p. 245 *post*.

(*b*) 46 & 47 Vict. c. 57, s. 12 (3); cf. *Re* Somerset and Walker's Patent, (1879) L. R. 13 Ch. D. 397; *Re* Johnson's Patent, (1879) L. R. 13 Ch. D. 398 *n*.

(*c*) A. and B.'s Patent, (1896) 13 R. P. C. 63.

(*d*) See A. and B.'s Patent, (1902) 19 R. P. C. 403.

for an ulterior object, he had no jurisdiction at all under sec. 12 (3) (*a*) of the Patent Act, 1883. (*e*)

Extent and Duration of Letters Patent.

It is expressly enacted that every patent shall be dated and sealed as of the day of the application: Provided that, in the 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. (*f*)

Before the Act of 1883, where there was more than one applicant for a patent for the same invention, the applicant who first obtained the Great Seal was held to be entitled to the benefit of it, and the patent of any other applicant, if granted at all, was dated subsequently. (*g*) Such is not the case now, for the patent of each applicant (if granted) must bear the date of the application, and consequently the first applicant is the one who gets the real benefit of the invention; for where there is more than one patent for the same invention, anything done under those subsequently dated is an infringement of that which bears the earliest date. (*h*) Formerly, however, in cases where there was evidence of *mala fides* the patent of a second applicant was ordered to be dated before that of the prior applicant. (*i*) The reason was that the Crown will not grant a second patent in derogation of its own grant, and the system of ante-dating enabled the question of validity to be decided in subsequent proceedings. (*k*)

Extent and Duration of Letters Patent.

Geographical extent.

Every patent when sealed has effect throughout the United Kingdom and the Isle of Man, (*l*) but not the Channel Islands. To extend the patent to the Channel Islands the patentee should enrol copies at the Royal Courts of Jersey and Guernsey. The term for which every patent is granted originally is fourteen years, (*m*) which may however, in certain cases, be prolonged on petition to His Majesty in Council. (*n*) The time from which a patent runs

(*e*) A. and B.'s Patent, (1902) 19 R. P. C. 556.

(*f*) 46 & 47 Vict. c. 57, s. 13.

(*g*) *Ex parte* Bates and Redgate, (1876) L. R. 4 Ch. 577, 580; see Vol. I. p. 8.

(*h*) Saxby *v.* Hennett, (1873) L. R. 8 Ex. 210.

(*i*) *Ex parte* Scott and Young, (1871) L. R. 6 Ch. 274; Saxby *v.* Hennett, (1873) L. R. 8 Ex. 210; *Re* Vincent's Patent, (1867) L. R. 2 Ch. D. 341.

(*k*) *Ex parte* Bailey, (1872) L. R. 8 Ch. 61; *Ex parte* Henry, (1872) L. R. 8 Ch. 167, 169; *Ex parte* Bates and Redgate, (1869) L. R. 4 Ch. 577.

(*l*) 46 & 47 Vict. c. 57, s. 16.

(*m*) *Ibid.* s. 17.

(*n*) *Ibid.* s. 25; chap. v.

Extent and Duration of Letters Patent.

dates from, and includes, the day on which the patent is dated. (*o*)

A patent is conditional on the patentee making the prescribed payments within the prescribed times, (*p*) and ceases if he fail to do so. (*q*)

Conditional on payment of renewal fees.

Enlargement of time for payment of fees.

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 for making that payment, and the Comptroller may, if he is satisfied that the failure has arisen from any of the above causes, on receipt of the prescribed fee for enlargement, (*r*) 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. (*s*)

An application for enlargement of the time for making a prescribed payment must state in detail the circumstances in which the patentee, by accident, mistake, or inadvertence, had failed to make such payment, and the Comptroller may require the patentee to substantiate, by such proof as he may think necessary, the allegations contained in the application for enlargement. (*t*)

Whenever the last day for leaving any document, or paying a fee, at the Patent Office falls on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the documents may be left, or the fee may be paid, on the day next following any of these days. (*u*)

Revival of patent void through non-payment of fees.

If a patentee fails to make a prescribed payment, whether he has obtained an enlargement of time or not, his patent is void and can only be revived by a special Act of Parliament. (*x*) A

(*o*) Russell *v.* Ledsam, (1847) 14 M. & W. 574.

(*p*) 46 & 47 Vict. c. 57, s. 24; p. 212 *post*.

(*q*) 46 & 47 Vict. 57, s. 17 (2).

(*r*) See Appendix.

(*s*) 46 & 47 Vict. c. 57, s. 17 (3) (4).

(*t*) P. R. (1903) r. 67.

(*u*) 46 & 47 Vict. c. 57, s. 98.

(*x*) *E.g.*, Wright's Patent Act (1884); Boult's Patent Act (1885); Bradbury and Leman's Patent Act (1884); Auld's

special Act will most probably not be obtained unless it is made clear that the renewal fees were not paid in consequence of a special circumstance such as the serious illness of the patentee,(*y*) and if a special Act is passed it will most probably provide protection for persons who may have used the subject-matter of the invention after notice of the lapse of the patent. (*z*)

Journal and Report of Cases.

Sec. 35 of the Act of 1883 enacts that a patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Application in fraud of true and first inventor.

In the event of a patent being lost or destroyed, or its non-production being accounted for to the satisfaction of the Comptroller, the Comptroller has authority at any time to cause a duplicate to be sealed. (*a*)

Duplicates of letters patent.

A decision in an action brought upon a patent to the effect that a claim in the specification cannot be supported does not annul the patent. (*b*) Such a decision is not an order for revocation, but merely a decision that the specification is bad as it stands. The defect may well be one capable of being cured by amendment, (*c*) in which case fresh actions might be brought upon the patent after amendment. (*d*)

Adverse decision in action of infringement does not annul the patent.

Illustrated Journal and Reports of Cases.

The Comptroller is required to cause to be issued periodically an illustrated journal of patented inventions, as well as reports of cases decided by Courts of law, and any other information that he may deem generally useful or important. (*e*) The Comptroller is also required to keep on sale copies of the illustrated journal, and all complete specifications of patents for the time being in force; and to prepare

Illustrated journal and reports of cases.

Patent Act (1885); Potter's Patent Act (1887). See also Appendix A to Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill [H. L.], and Gilbert and Sinclair's Patent Bill [H. L.].

(*y*) See Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill [H. L.], and Gilbert and Sinclair's Patent Bill; Worms and Bale's Patent Act (1891).

(*z*) *Ibid.*; Appendix A, Potter's Patent Act (1887); Worms and Bale's Patent Act (1891).

(*a*) 46 & 47 Vict. c. 57, s. 37; P. R. (1890) Form N.

(*b*) Decley's Patent, (1894) 11 R. P. C. 75.

(*c*) See chap. ii. *post*.

(*d*) p. 82 *post*.

(*e*) 46 & 47 Vict. c. 57, s. 40.

Patent Office Museum. Register of Patents.

and publish indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit. (*f*)

Patent Office Museum.

Patent Office Museum.

The control and management of the Patent Museum is vested in the Department of Science and Art, subject to such directions as His Majesty in Council may see fit to give. (*g*)

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

Register of Patents.

Register of Patents under Act of 188[illegible]

The Act of 1883 (*i*) provides that there shall be kept at the Patent Office a book called the Register of Patents, 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. Such other matters include applications for amendments of specifications and notices of oppositions thereto, as well as the decisions of the Comptroller and law officer; requests for entry of notifications of assignments, licences, Orders in Council affecting the patent; certificates of enlargements of time within which renewal fees may be paid; and notifications of the expiration of patents.

The present practice relative to the Register of Patents is regulated by the Patent Rules, 1903, rr. 51–65. (*k*) Any person interested in a particular patent may lodge at the Patent Office a request that he be informed if and when any attempt

(*f*) 46 & 47 Vict. c. 57, s. 40. The Illustrated Official Journal, with accompanying reports of the cases decided by the courts of law, the Comptroller, and the law officers, is at present published weekly. Cases decided before the Comptroller or the law officer ought not to be cited before the High Court of Justice or the Court of Appeal; Siddell *v.* Vickers, (1888 5 R. P. C. 416, 136.

(*g*) 46 & 47 Vict. c. 57, s. 41.

(*h*) *Ibid.* s. 42.

(*i*) s. 23.

(*k*) p. 311 *post.*

is made to register an assignment or other similar document, and if he do so the Office will notify him of any application for registration of any assignment or other similar document affecting the patent, and the registration will be suspended for a few days so as to afford such person an opportunity of taking any steps to prevent registration he may consider advisable. Where a person has lodged such a request and thinks himself aggrieved by an attempted registration, the proper course for him to adopt is to notify the Office and to apply to the Court for leave to serve notice of motion for an early date, which would be granted as a matter of course. (*l*)

Register of Patents.

The Register of Patents is *primâ facie* evidence of any matters by the Act directed or authorised to be inserted therein. (*m*) The register is admissible evidence of the various matters referred to therein, but the weight and effect of the evidence is to be considered by the Court in subsequent proceedings. Thus, though from entries on the register it appeared that a defendant to an infringement action was entitled to a licence from the patentee, the Court found to the contrary, since it was established that the order entered on the register was obtained under circumstances calculated to arouse suspicion of collusion between the defendant and the grantee of the patent who was under contract to assign it to the plaintiff in the action. (*n*)

Register is *primâ facie* evidence.

It is provided that former registers of patents and of proprietors shall be deemed parts of the same book as the Register of Patents, kept under the Act of 1883. (*o*)

Where any person becomes entitled by assignment transmission, or other operation of law, to a patent, it is the duty of the Comptroller on request, and on proof of title to his satisfaction, to cause the name of such person to be entered as proprietor of the patent in the Register of Patents; and the person for the time being entered in the Register of Patents as proprietor of a patent has, subject to the provisions of the Act of 1883, and to any rights appearing from such register to be vested in any other person, power absolutely to assign, grant licences as to or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing: Provided that any equities in respect of

Effect of registration.

(l) See Viola *v.* Sharpe, (1904) 22 R. P. C. 23.

(m) 46 & 47 Vict. c. 57, s. 23 (2).

(n) See Action Gesellschaft für Cartonnagen Industrie *v.* Temler, (1900) 18 R. P. C. 14.

(o) 46 & 47 Vict. c. 57, s. 114.

Register of Patents.

such patent may be enforced in like manner as in respect of any other personal property. (*p*)

Notices of trusts, as such, cannot be registered,

By sec. 85 of the Act of 1883 (*q*) it is provided that no notice of any trust—expressed, implied, or constructive—is to be entered on the Register of Patents, nor is any such notice receivable by the Comptroller. (*r*)

but documents affecting the proprietorship —*e.g.*, equitable assignments—can be registered.

The effect of this sec. 85, read, as it must be, together with secs. 23 and 87, and the Patent Rules, 1903, rr. 51–65, is only to exclude from the register simple notices of trusts, but not documents affecting the proprietorship of a patent, whether by creating trusts or otherwise. Consequently equitable assignments of a patent, or of a share in a patent, may be entered on the register as documents affecting the proprietorship. (*s*)

Documents creating neither legal nor equitable interests cannot be registered.

A document which creates neither a legal nor an equitable interest cannot be registered. Thus, a patentee wrote a letter agreeing to give an exclusive licence, and, the patentee and proposed licensee subsequently disagreeing as to whether the amount of royalty had been fixed by subsequent parol agreement, the licensee obtained an entry of the letter on the register. On subsequent motion for rectification of the register, *North*, J., held that, even assuming the royalty had been subsequently fixed by parol agreement, the letter itself did not give any legal or equitable interest in the patent, and could not be registered. (*t*)

Documents of earlier date than the patent.

Questions sometimes arise as to the entry on the register of documents dated prior to the patent.

For example, where it appeared that, before the date of a patent, the grantee and another person signed a document referring to certain proposed dealings with the ownership of patents to be obtained for a process said to be the invention for which a patent was subsequently granted, the Comptroller refused to enter this document on the Register of Patents, on the ground that it was dated before the grant of the patent; and this decision was upheld on motion to the Court, but upon the ground that the applicant did not appear to be entitled to any share in the patent. (*u*)

It would appear from the judgment in *Parnell's Patent* (*x*)

(*p*) 46 & 47 Vict. c. 57, s. 87; 51 & 52 Vict. c. 50, s. 21.

(*q*) p. 232 *post*.

(*r*) *Ibid.*

(*s*) Stewart *v.* Casey, (1891) 9 R. P. C. 9; in view of this case the decision in Haslett *v.* Hutchinson, (1891) 8 R. P. C. 457, would appear to be wrong.

(*t*) In the Matter of Fletcher's Patent, (1893) 10 R. P. C. 252.

(*u*) In the Matter of Parnell's Patent, (1888) 5 R. P. C. 126.

(*x*) (1888) 5 R. P. C. 128.

that there may be documents dated before the grant of a patent which ought to be entered on the register after the patent is obtained, and that an agreement as to the ownership is such a document. Register of Patents.

Registration under the Act of 1883 of an exclusive licence for a limited area is not notice to the world, so as to affect defendants buying certain machines manufactured by the patentee outside the area, (*y*) and using them inside the area, without notice of the licence. Registration is not notice to all persons.

The Register of Patents is at all convenient times open to the inspection of the public, subject to the provisions of the Act of 1883, and to the prescribed regulations, (*z*) and any person requiring it may obtain, on payment of the prescribed fee, a certified copy, sealed with the seal of the Patent Office, of any entry made in the register. (*a*) Inspection of Register.

Printed or written copies or extracts, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, are admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals. (*b*) Evidence of entries on the Register.

A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised under the Act of 1883, or any general rules made thereunder, to make or do, is *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. (*c*)

The Court is empowered by sec. 90 of the Act of 1883, as amended by sec. 23 of the Act of 1888, on the application of any person aggrieved by the omission, without sufficient cause, of the name of any person, or of any other particulars, from the register, or of any entry made without sufficient cause in the register, to make such order for making, expunging, or varying the entry as the Court thinks fit, or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit. And the Court has power, in any proceedings under this section, to decide any question that it may be Rectification of the Register.

(*y*) Heap *v.* Hartley, (1888) 5 R. P. C. 603; 6 R. P. C. 495.
(*z*) Patent Rules, (1890) r. 78.
(*a*) 46 & 47 Vict. c. 57, s. 88; 51 & 52 Vict. c. 50, s. 22.
(*b*) 46 & 47 Vict. c. 57, s. 89.
(*c*) *Ibid.* s. 96.

Register of Patents.

necessary or expedient to decide for the rectification of the register, and to direct an issue to be tried for the decision of any question of fact, and to award damages to the party aggrieved.

The purchaser of a share of a patent is "a person aggrieved" by the entry of an assignment of a share purporting to have been made by a person in fact a bankrupt. (*d*)

Before the Court will accede to a request for the rectification of the register by the entry of a person's name as assignee of a patent or share of a patent the applicant must of course prove his title. (*e*)

Any order of the Court rectifying the register must direct that due notice of the rectification be given to the Comptroller. (*f*) Where an order has been made by His Majesty in Council for the extension of a patent for a further term, or for the grant of a new patent, (*g*) or where an order has been made by the Court for the revocation of a patent or the rectification of the register under sec. 90, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made is required forthwith to leave at the Patent Office an office copy of such order. The register will thereupon be rectified, or the purport of such order will otherwise be duly entered in the register, as the case may be. (*h*)

It is submitted that the Act of 1883 (*i*) gives the Court power to expunge any entry fraudulently made on the register, and to enter any facts relative to the ownership of a patent, but not any legal inference to be drawn from these facts. It was held that the corresponding section of the repealed Act of 1852 (*k*) gave such power to the Master of the Rolls alone. (*l*)

An appeal lies from any order made by the Court or a Judge for the rectification of the register, (*m*) though formerly there was no appeal from the decision of the Master of the Rolls.

If any rectification of the Register of Patents is required in

(*d*) Manning's Patent, (1902) 20 R. P. C. 74.

(*e*) *In re* Holmstrom, (1904) 22 R. P. C. 213.

(*f*) 46 & 47 Vict. c. 57, s. 90, sub-s. 3.

(*g*) Chap. v. *post*.

(*h*) P. R. (1890) r. 74.

(*i*) s. 90.

(*k*) s. 38.

(*l*) *Re* Morey's Patent, 25 Beav. 581; *Re* Green's Patent, (1857) 24 Beav. 145; *Re* Horsley and Knighton's Patent, (1869) L. R. 8 Eq. 475; *Re* Berdan's Patent, (1875) L. R. 20 Eq. 346.

(*m*) *Re* Morgan's Patent, (1876) 24 W. R. 245; *Re* Myer's Patent, (1882) W. N. 53, 76.

pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification must be served on the Comptroller, who is required to rectify the register accordingly. (*n*)

Register of Patents.

It is a misdemeanour for any person to make, or cause to be made, a false entry in the Register of Patents, or a writing falsely purporting to be a copy of an entry in such register, or to produce or tender, or cause to be produced or tendered, in evidence any such writing, knowing the writing or entry to be false. (*o*)

Falsification of the Register is a misdemeanour.

(*n*) 46 & 47 Vict. c. 57, s. 111 (2).

(*o*) *Ibid.* s. 93.

CHAPTER II.

AMENDMENT OF THE SPECIFICATIONS.

PART I.—GENERAL.

Certain amendments are allowable.

A PATENT may be void and of no effect on account of a defect in a specification, but the law, in the interests and for the protection of patentees, allows certain amendments to be made from time to time; so a patent, otherwise void, owing to the carelessness or ignorance of the patentee in fulfilling his obligation of specifying the invention and the mode of carrying it into practical operation, may, by amendment of the specification, be made perfectly valid. (*a*)

It is not the practice of the Patent Office however to allow the amendment of the provisional specification further than what is required by the examiner, or by way of excision made before the acceptance of the complete specification, or by the correction of mere clerical errors. (*b*)

Necessity for amendments should be avoided.

It will appear that it is greatly to the interest of the patentee to draft the specifications in the first instance with such care as will render subsequent amendments unnecessary. The consequences of an amendment may be, not only the incurring of expense, but the possible inability to recover damages in respect of infringements of the patent committed before the amendment.

Procedure when specification is published.

The present procedure relative to the amendment of specifications which have become public property is regulated by sec. 18 (as amended by sec. 5 of the Act of 1885) and sec. 19 of the Act of 1883, together with the Patent Rules, 1903, made under the powers conferred by the Act of 1883. Where this

(*a*) 46 & 47 Vict. c. 57, s. 20. The present chapter deals mainly with the amendment of specifications which have been accepted and become open to public inspection (46 & 47 Vict. c. 57, s. 10); questions relating to the amendment of the specifications before they have become public property are treated of in chap. i. *ante*.

(*b*) Patent Office Circular of Information

Allowable Amendments.

procedure applies it is immaterial whether the Patent Office has, or has not, advertised its acceptance of the complete specification. (*c*) Consequently, when a complete specification has been accepted, though the Patent Office has not by advertisement (*d*) signified its acceptance, it is not a valid objection to an amendment, once it is allowed, that the request for and the nature of the amendment were not advertised in the prescribed manner. (*e*)

The hearing of an opposition to the grant of a patent will be postponed to the hearing of an opposition to an application for leave to amend the specification. (*f*)

Defects which are fatal.

If the specification describe and claim anything which is not subject-matter (*g*) or which is useless (*h*) or which is not new (*i*) at the date of the patent, the patent is void. Again, if the title of the invention is inaccurate and misdescribes the invention in any respect, the patent may be void on the ground of misrepresentation, though there may have been no intention to deceive either the Crown or the public ; (*k*) and if the specification be insufficient as to any part of the invention, or if it contain any misstatement respecting any material particular relating to the invention, whether inadvertently inserted or not, the patent is wholly void so long as the specification remains tainted with any of the above defects. (*l*)

History of power of amendment.

Nature of Allowable Amendments.—Before 1834, the date of the statute 5 & 6 Will. IV. c. 83, it was impossible to cure any defects such as the above, and persons not unfrequently lost the benefit of useful and meritorious inventions in consequence. The passing of the above statute, however, to a great extent removed this reproach to our Patent Laws, and though it was repealed by the Act of 1883, (*m*) its provisions and the benefits which it extended to patentees, were, with further additions, re-enacted by that Act.

From 1834 to the passing of the Act of 1883 patentees could only amend their specifications by way of disclaimer, (*n*) that is to say, they could only cut matter out which they considered to be superfluous as lacking utility or novelty, or as not being subject-matter.

If what was left of the specification would satisfy the

(*c*) Jones' Patent, Griff. P. C. 313.
(*d*) 46 & 47 Vict. c. 57, s. 10, p. 206 *post*.
(*e*) *Ibid.* ss. 10, 18; pp. 206, 208 *post*.
(*f*) Cochrane's Patent, (1885) Griff. P. C. 304.
(*g*) Vol. I. chap. ii.
(*h*) Vol. I. chap. iv.
(*i*) Vol. I. chap. iii.
(*k*) Vol. I. chap. v.
(*l*) *Ibid.*
(*m*) 46 & 47 Vict. c. 57.
(*n*) Foxwell *v.* Bostock, (1864) 4 De G. J. & S. 298, 306.

Allowable Amendments.

requirements of the law, then the patent would be saved; but there was no provision for making a bad or incomplete description into a good or complete one, neither was it allowable to explain any ambiguity. It, consequently, very frequently happened that patentees found their specifications construed by Judges in a manner which they never intended, and were, sometimes, to their mortification told that, though their inventions were good and valuable, yet their specifications were so defective, and so hopelessly beyond the power of amendment by any means known to the law, as to make it impossible to maintain protection in respect of such inventions.

Very slight additions, however, were formerly allowed when they were necessary to render what remained after disclaimer intelligible, (*o*) as, for example, the addition or transfer of the words "herein described," (*p*) and additions in the nature of explanations necessary to define a disclaimer are allowable under the present practice. (*q*)

Amendments allowed under Act of 1883.

The Act of 1883 not only provides that patentees may disclaim any portion of their specifications, but extends to them the right, with the sanction of the Comptroller-General, and the law officer on appeal, to correct or explain any defective passage on condition that such disclaimer, correction, or explanation does not make the specification as amended claim an invention substantially larger or substantially different from the invention claimed by the specification as it stood originally. (*r*)

If there be no action for infringement or proceeding for the revocation of the patent pending at the time the patentee wishes to make an amendment in the specification, or if there be an action for infringement, or petition for revocation pending, and the patentee has obtained the necessary permission of the Court or a Judge, (*s*) all that it is necessary for him to do is to obtain the sanction of the Comptroller-General, or law officer, in the prescribed manner, when he will be allowed to make the amendment as a matter of course. (*t*)

An amendment, when there is no pending action or petition for revocation, may consist of a *disclaimer*, *correction*, or *explanation*; but when a patentee desires to amend his

(*o*) Ralston *v.* Smith, (1865) 11 H. L. C. 223, 245.

(*p*) Thomas *v.* Welch, (1866) L. R. 1 C. P. 192, 195.

(*q*) See Owen's Patent, (1898) 15 R. P. C. 755; p. 90 *post*.

(*r*) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

(*s*) *Ibid.* s. 19; Hall's Patent, (1888) 5 R. P. C. 306.

(*t*) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.

specification pending an action for infringement, or petition for the revocation of the patent, he is only allowed to do so by way of *disclaimer*, and not by correction or explanation, and he must first obtain the sanction of the Court or a Judge, (*u*) after which the procedure is the same as if no such action or proceeding for revocation were pending. (*v*)

Allowable Amendments.

The Comptroller-General and law officer have an absolute discretion as to granting or refusing leave to amend, and not being a "Court" prohibition does not lie to them. (*x*)

Discretion of Comptroller and law officer.

Leave to apply is no guarantee that the specification, when amended, will not still invalidate the patent. The patentee, it must be remembered, makes the amendment at his own peril. (*y*) Thus, in the case of *Deeley's Patent* (*z*) it appeared that three claims were, in an infringement action, held to have been anticipated, and the patentee then amended by striking out the three claims and entering a disclaiming clause. The defendant in the action thereupon petitioned for the revocation of the patent, and succeeded on the ground that one of the remaining claims was bad for want of subject-matter.

Leave to amend no guarantee of validity.

It is not to be inferred from the circumstance that a patentee has entered a disclaimer, or made any other amendment of the specification, that the patent was necessarily bad before the amendment, for it may well be that the alteration was in fact not requisite, and only made to obviate any doubt that might arise on the specification as originally filed. (*a*)

Amendment no evidence of prior invalidity.

The Act of 1883, which provides that "an amendment shall, in all courts and for all purposes, be deemed to form part of the specification," (*b*) expressly states (*c*) that "no amendment shall be allowed that would make the specification, as amended, claim an invention larger than, or different from, the invention claimed by the specification as it stood before amendment."

Proposed amendments which extend the claim.

A disconformity between an amended complete specification and a provisional specification is just as fatal to the validity of the patent as a disconformity between the original specifications before amendment. (*d*)

Disconformity after amendment.

(*u*) 46 & 47 Vict. c. 57, s. 19; 51 & 52 Vict. c. 50, s. 5; see p. 90 *post*.

(*v*) Hall's Patent, (1888) 5 R. P. C. 306.

(*x*) Van Gelder's Patent, (1889) 6 R.P.C. 22; *Ex parte* Simon, 4 Times Reports 754.

(*y*) Lake, (1887) Griff. L. O. C. 16; 5 R. P. C. 415.

(*z*) (1895) 12 R. P. C. 65, 192.

(*a*) Stocker *v.* Warner, (1845) 1 C. B. 148, 165; 9 Jur. 136, 138.

(*b*) s. 18, sub-s. 9.

(*c*) s. 18, sub-s. 8.

(*d*) Gaulard and Gibbs, (1889) 6 R. P. C. 215; Lane Fox *v.* Kensington

Allowable Amendments.

A patentee is not allowed to amend his specification in such a way as to make the amendment amount to an imputation that certain disadvantages exist in the method of carrying out an invention described and claimed by the specification of a prior patent, when, as matter of fact, there is no evidence before the Comptroller or law officer of the actual existence of such alleged disadvantages, though such allegation might not be an objection to filing the specification in the first instance. (*e*)

Amended specification takes the place of the original.

The Act of 1883 further provides (*f*) that, after an amendment has been allowed, "the amendment shall, in all Courts and for all purposes, be deemed to form part of the specification." The authorities warrant the statement that these words mean (*inter alia*) that the amended specification shall, in all Courts and for all purposes, have the same effect as if it had been filed, in the amended form, on the date of the original, so that a patentee may sue for, and recover, on his amended specification, damages in respect of infringements committed before the amendment; but this statement is subject to the qualification that the patentee must establish, to the satisfaction of the Court, that his original specification was framed in good faith and with reasonable skill and knowledge. (*g*) If a successful plaintiff in an action for infringement is able to satisfy the Court on this point, the account or damages, as the case may be, will be ordered as from the date of the patent. (*h*)

Law officer's decision is final as to fact of the extension of a claim by amendment.

It would also appear, on the authority of *Moser* v. *Marsden*, (*i*) a case decided by the House of Lords, that, though it is open to an opposer before the Comptroller and law officer to raise the question that the proposed amendment would make the claims, as amended, larger than the original claim, yet the decision of the law officer is final on this point, and the Courts will not review it. It is submitted, on the other hand, that in a subsequent action on the patent the amendment is not conclusive and may be questioned on the point as to whether the amended claim embraces something which is not to be found fairly described in the original provisional specification, and so creates a fatal disconformity between the amended complete

Knightsbridge Electric Lighting Co., (1892) 9 R. P. C. 221, 413; see also Vol. I. pp. 190–199 *ante*.

(*e*) Hampton and Facer, (1887) Griff. L. O. C. 13.

(*f*) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.

(*g*) *Ibid.* s. 20.

(*h*) Wenham *v.* Carpenter, (1887) 5 R. P. C. 68; Hopkinson *v.* St. James's and Pall Mall Electric Light Co., (1893) 10 R. P. C. 62.

(*i*) (1895) 13 R. P. C. 24.

specification and the former document. (*k*) That is to say, the decision of the law officer upon the question of amendment is only unreviewable so long as the amendment allowed is within the limits of the provisional specification as originally filed; if the amendment goes outside that, it creates a fatal disconformity to which the Courts would give effect. The older cases usually cited in favour of the proposition that an amendment which widens or alters the scope of the claims is fatal to the validity of the patent must, in so far as they were decided upon the former Acts, be considered as not applicable to the Act of 1883, and in so far as those decided since the Act of 1883 are concerned must be considered as overruled on this point. (*l*)

Allowable Amendments.

It is to be noticed that the question of the legality of a disclaimer or other amendment once allowed by the law officer was not argued in *Moser* v. *Marsden*, (*m*) and it may be that upon argument the House of Lords might review their decision in that case so far as it affects the point under discussion, but it is submitted that the above statements embrace a true exposition of the law on the subject. In *Perry* v. *Société des Lunétiers* (*n*) the objection was taken that an amendment allowed by the law officer had enlarged the claims originally made. The objection, however, failed, and it was consequently not necessary for the Court to decide whether having regard to *Moser* v. *Marsden* the objection could be made at all. It is submitted that it could not; but, if in fact there had been an enlargement of the claim which went beyond the limits of the provisional specification, the patent might have been declared void on the ground of disconformity between the specifications. (*o*)

Before the decision in *Moser* v. *Marsden*, (*p*) the Comptroller-General and the law officers used to be guided in the matter of allowing amendments, which were said by opponents to make the specification, contrary to the provisions of sec. 18, sub-s. 8 of the Act of 1883, as amended, claim an invention substantially larger than or substantially different from

Practice when an amendment is objected to on the ground that it extends the claim.

(*k*) See Vol. I. p. 191.

(*l*) The cases referred to are Ralston v. Smith, (1865) 11 H. L. C. 550; Dudgeon v. Thompson, (1877) L. R. 3 App. Cas. 55; *Re* Gaulard v. Gibbs' Patent, (1888) 5 R. P. C. 189; 6 R. P. C. 225; 7 R. P. C. 367; Van Gelder's Patent, (1889) 6 R. P. C. 22; Farben Fabrik v. Bowker, (1891) 8 R. P. C. 391; Lane Fox v. Kensington and Knightsbridge Electric Lighting Co., (1892) 9 R. P. C. 221, 413.

(*m*) See Dellwick's Patent, (1896) 13 R. P. C. 596.

(*n*) (1896) 13 R. P. C. 664.

(*o*) See Vol. I. p. 191.

(*p*) (1895) 13 R. P. C. 24.

Allowable Amendments.

the invention claimed by the specification as it stood before amendment, by the rule that in the event of doubt the patentee was to have the benefit of the doubt. This rule was based upon the then prevailing notion that the law officer's decision was not conclusive, and consequently if it was wrongly exercised in favour of the applicant it could be set right by the Courts, but, if it was wrongly exercised against the applicant, it was final and not open to review. (*q*) When this ground of opposition is taken against a proposed amendment in future the law officers will probably not be so ready to allow the amendment as formerly, but will require to be satisfied that the amendment will not infect the specification with the vice referred to in sub-s. 8 of sec. 18 of the Act of 1883, before they will grant leave to apply at the Patent Office to make the amendment desired. (*r*)

Example of a proposed amendment which extends the claim.

Walker's Application, (*s*) selected from amongst other cases, (*t*) furnishes a good illustration of an amendment being refused on the ground that no amendment can be allowed which would make the amended specification claim an invention substantially larger than, or substantially different from, the invention as claimed by the specification as it stood before amendment. (*u*)

In *Walker's Application*, (Griff. L. O. C. 22) it appeared that *Walker's* patent was for "improvements in machinery employed for preparing and spinning cotton and other fibrous materials." The complete specification stated that the object of the invention was to support the top clearing rollers, so as to prevent them from rolling off the front rollers, and to keep them always in equal contact with both rollers. The invention consisted principally in an inclined bearer or bearers (slotted or otherwise) on or against which the pivots projecting from the centre of the clearers rested. In one part of the specification it was stated that "the said bearers may either be fixed to any hook, or they may be attached to any other fixing or part of the frame, in which case they form adjustable inclined planes." The claim was for the construction and application to the class of machinery referred to of an inclined bearer or bearers to support the top

(*q*) Bateman and Moore's Patent, (1854) Macr. P. C. 116; Lake, (1886) Griff. L. O. C. 16.

(*r*) See Parkinson's Patent, (1896) 13 R. P. C. 512.

(*s*) Griff. L. O. C. 22: see also Parkinson's Patent, (1896) 13 R. P. C. 509.

(*t*) See also Ralston v. Smith, (1865) 11 H. L. C. 223, 254; Lucas' Patent, (1854) Macr. P. C. 235; Gaulard and Gibbs' Patent, (1889) 6 R. P. C. 215; Heath and Frost's Patent, (1886) Griff. P. C. 311; Parkinson's Patent, (1896) 13 R. P. C. 509; Johnson's Patent, (1896) 13 R. P. C. 659; Vidal's Patent, (1898) 15 R. P. C. 721.

(*u*) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

clearing rollers substantially as set forth. The patentee sought by his amendment (*inter alia*) to insert the word "*adjustable*" before the term "bearer or bearers" wherever the same occurred in the description and in the claim. The Comptroller, however, refused to allow this, holding that the insertion of the word "*adjustable*," as desired, would make the specification claim an invention substantially larger than, or substantially different from, the original specification. (*v*)

Allowable Amendments.

It is competent for a patentee to claim a combination as a whole, and also a subordinate part or parts separately. (*x*) When, however, there is a distinct claim to the whole, it is not allowable for the patentee to amend his specification by striking out that claim and inserting one for a subordinate part alone, since such an alteration would make the amended specification claim an invention substantially different to that claimed by the original. (*y*)

Other examples of allowable and non-allowable amendments.

In a case where certain patentees in their specification described and claimed several parts of an apparatus, and it appeared on the face of it that the intention was to claim the several parts conjointly, an alteration was allowed whereby the words "firstly," "secondly," and "thirdly" were struck out, and the word "or" was substituted for "secondly" and "and" for "thirdly," but the insertion of the words "in combination with" between the second and third claiming clauses was not allowed. (*z*)

When an amendment is required it is because there is some defect in the specification, but that defect must be one which is consistent with the patentee intending to fulfil the condition of the grant by properly describing his invention and the mode of carrying it into effect; and if that condition has been fulfilled no amendment is required or will be allowed. (*a*)

A defect cannot be amended unless it is consistent with the patentee intending to fully specify the invention and mode of carrying it out.

Leave to apply to amend may be refused on the ground that the ambiguity of the proposed amendment, if such be the case, would lead to litigation and be calculated to create uncertainty among persons interested in the patent. (*b*)

A patentee desirous of amending his specification is required to state in writing his reasons for the same, (*c*) but such reasons

Reasons for requiring amendments

(*v*) See note (*t*), p. 68 *supra*.
(*x*) See Vol. I. p. 256.
(*y*) Serrell's Patent, (1889) 6 R. P. C. 101.
(*z*) Bateman and Moore's Disclaimer, (1852) Macr. P. C. 116.
(*a*) See Nordenfelt, (1885) No. 8269, Griff. L. O. C. 18, 21.
(*b*) Parkinson's Patent, (1896) 13 R. P. C. 509, 514.
(*c*) 46 & 47 Vict. c. 57, s. 18, sub-s. 1.

Disclaimer.

are to be stated in writing.

form no part of the specification when amended; (*d*) nor will leave to amend be refused merely on the ground that the reasons given by the applicant in his application are insufficient. (*e*) It is to be noticed that sec. 18, sub-s. 2, of the Act of 1883 does not in terms say that the reasons on the strength of which the applicant or patentee desires to be allowed to amend the specification are to be advertised, but probably because the reasons are considered part of the request, (*f*) it is the practice to advertise the reasons as well.

It will now be convenient to consider separately the different forms of amendment which the law allows.

Disclaimer.—Disclaimer, as defined by Lord *Chelmsford*, is "the renunciation of some previous claim actually or apparently made or supposed to be made," (*g*) and the following remarks of Lord *Westbury* with reference to a disclaimer under the Act of 1835 are applicable to a disclaimer under the Act of 1883 :—

> "The object of the Act authorising disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description in its integrity good and sufficient . . . . then you might, by the operation of a disclaimer, lop off the vicious matter, and leave the original invention as described in the specification, untainted and uninjured by that vicious excess. (*h*) But it never was intended that you should convert a bad specification, in the sense of its not containing the description of any useful invention at all, into a good specification by adding words which would convert what has been properly called in the Court below 'a barren and unprofitable generality' into a specific and definite and practical description. . . . The statute never contemplated that a patentee should have the power, under the form of a disclaimer, of making material additions to the original specification, so as, by the aid of the corrected form of words and the additions so made, to introduce into the specification an accurate and perfect description of an invention which you seek for in vain in the original specification." (*i*)

(*d*) Cannington *v.* Nuttall, (1871) L. R. 5 H. L. App. 205, 208.

(*e*) Ashworth, (1878) No. 3513, Griff. L. O. C. 6, 7.

(*f*) *Ibid.*

(*g*) Ralston *v.* Smith, (1865) 11 H. L. C. 254.

(*h*) *E.g.*, Cochrane's Patent, (1885) Griff. P. C. 304; Ryland's Patent, (1888) 5 R. P. C. 665; Nordenfelt's Patent, (1887) Griff. L. O. C. 18; Allen's Patent, (1887) Griff. L. O. C. 3.

(*i*) Ralston *v.* Smith, (1865) 11 H. L. C. 223, 243.

A disclaimer which extends the ambit of the claims, or makes the specification claim an invention substantially different to that originally claimed, should not be allowed by the Comptroller or law officer, (*k*) though the law officer's decision must now be regarded as final. (*l*)

Disclaimer.

Disclaimers which extend the claim.

When it is said by the opponent that a disclaimer or other amendment will extend the claim, the real question to be decided always is, not whether any particular claim is extended by the amendment, but whether the total grant is extended. Though one particular claim may be extended it may be that it is only made to include something which was originally included in another claim. In such a case the law officer does not refuse leave to apply to make the amendment desired, (*m*) for the object of amendment must be merely to take out and remove part of, or to further explain, what had been claimed before, and the Act did not intend that, by striking out or altering part of the specification, the patentee should be able to give an extended and larger sense to what is left, so as to make it embrace something which it did not embrace before. (*n*)

The words of sub-s. 1 of sec. 18 of the Act of 1883, "by way of disclaimer, correction, or explanation," were meant to refer to disclaiming something which was originally wrongly inserted, or to explaining something which requires explanation, having regard to the statement made in the first instance by the patentee. (*o*)

If there is a claim for A, B, C, D, E, and F, and the patentee by amendment confines it to F, the amended claim is narrower than the original, but it is not different, for it is included in it; (*p*) but if the proposed amended claim is a claim to a combination, one part of which is not mentioned in the body of the specification, though it is shown in a drawing but equally with other features, it may not be allowed, because such a claim would make the specification as amended claim an invention substantially different from the invention claimed by the specification as it stood before amendment. (*q*)

(*k*) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

(*l*) p. 66 *ante*.

(*m*) See Cochrane's Patent, (1885) Griff. P. C. 384; Ashworth's Patent, (1886) Griff. L. O. C. 6; Rylands' Patent, (1888) 5 R. P. C. 665; Nordenfelt's Patent, (1887) Griff. R. P. C. 18; Lake's Patent, (1887) Griff. R. P. C. 16; Morgan's Patent, (1886) Griff. R. P. C. 17; Johnson's Patent, (1896) 13 R. P. C. 660; Dellwick's Patent, (1898) 15 R. P. C. 686.

(*n*) See remarks of Lord Blackburn, on the repealed statute, Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 55.

(*o*) Per Webster, A.-G., Johnson's Patent, (1896) 13 R. P. C. 660.

(*p*) Cochrane's Patent, (1885) Griff. P. C. 305; Dellwick's Patent, (1898) 15 R. P. C. 682; Hattersley and Jackson's Patent, (1904) 21 R. P. C. 238.

(*q*) Hattersley and Jackson's Patent,

Disclaimer.

In the case of an application to reamend a specification which has already been amended the original is not considered but only the specification in its last amended state. This is so because by express statutory provision the amendment is deemed in all Courts and for all purposes to form part of the specification. (*r*)

Disclaimer which turns an ambiguous into a clear specification is allowable, but not so a disclaimer which turns an insufficient into a sufficient description.

A disclaimer which turns an ambiguous specification into a clear specification is allowable. (*s*)

A disclaimer which, on the other hand, turns an insufficient description into a sufficient one will not be allowed when the patent was obtained on the personal application of the real inventor himself, though it might be allowed if the invention was one communicated from abroad, or where the inventor was a foreigner and his specification was mistranslated, and the foreign inventor came and satisfied the Comptroller or law officer that his agent had made a mistake in writing out or translating the description furnished to him by the foreign inventor. (*t*)

In *Ralston* v. *Smith*, (*u*) a case decided by the House of Lords under the repealed Acts, which is not an authority now upon the effect of the law officer's decision with reference to allowing an amendment, but which may be quoted as an instance of a so-called disclaimer really amounting to an extension, a patentee of "improvements in embossing fabrics" claimed the use of grooved, fluted, or indented rollers of metal, wood, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing action on the fabric, and thereby produce an indefinite variety of patterns. Subsequently he disclaimed the use of any pattern rollers with the exception of metal rollers and circular grooves. It appeared in evidence that only circular grooves would produce the effect required, and further that the making the roller and bowl revolve at different speeds was not new at the date of the patent. As Lord *Chelmsford* observed, the rollers were not specially described in the original specification, but were merely involved in the general terms which were used, and the plaintiff had consequently not complied with the condition of the letters patent

(1904) 21 R. P. C. 233; but note the first claim of the specification, and see Hattersley *v.* Hodgson, (1904) 21 R. P. C. 517.

(*r*) See 46 & 47 Vict. c. 57, s. 18 (9); Hattersley and Jackson's Patent, (1904) 21 R. P. C. 233.

(*s*) Johnson's Patent, (1896) 13 R. P. C. 661, 662.

(*t*) See *Ibid.*

(*u*) (1865) 11 H. L. C. 223; see also cases referred to in the footnote (*t*) p. 68 *ante*.

in particularly describing and ascertaining the nature of the invention. When, therefore, by his disclaimer, he confined his claim to circular grooved rollers as his sole invention, though in one sense he might be said to narrow a right, yet he really extended it, because he thereby enlarged his alleged invention sufficiently to enable him to assert a right under the patent which he never could have successfully maintained upon the original specification. (*x*) Disclaimer.

Ralston v. *Smith* may be contrasted with *Seed* v. *Higgins*, (*y*) where a patentee obtained a patent for an improvement in machinery used for sewing-cotton, and his specification appearing to claim the discovery of the application of the principle of centrifugal force for such purpose, he filed a disclaimer, declaring that he intended to claim only the application of centrifugal force in the particular manner described in the specification, and the House of Lords held that the disclaimer was legitimate and saved the patent.

The rule involved in *Seed* v. *Higgins* is that approved of by the Attorney-General in giving his judgment in an appeal from the decision of the Comptroller, in a case (*z*) decided upon the Act of 1883—viz., if on its face the specification is clearly capable of two or more constructions, it is open to a person, applying to amend, to satisfy the law officer or the Comptroller that he desires to limit the claim to one, or more, of two or more constructions to which the specification is open. Rule in Seed v. Higgins.

Thus in the case of *Rylands' Patent*, (1888) 5 R. P. C. 665, the essence of *Rylands'* invention was two modifications in which forms of boxes were constructed, wherein, instead of there being the ordinary hoop-iron, nailed on the flat or side, and so forming an angle with the corner, a groove was cut in the surface of the two sides of the right angle, and in this groove wire or hoop-iron of some kind was placed, and fastened in, the object being to prevent the edges of the wire catching any obstruction, or being caught by any obstruction in the course of transit, and thereby being torn off or injuring other property. It was agreed on both sides that the patentee contemplated fastening the iron by either *nails* or *loops*, but the opposer alleged that to limit the claim, as the applicant desired to do, to fastening the hoop-irons in the grooves by means of *loops* would be to make the amended specification claim an

(*x*) Ralston *v.* Smith, (1869) 11 H. L. C. 255.
(*y*) (1860) 8 H. L. C. 550.
(*z*) In the Matter of Rylands' Patent, (1888) 5 R. P. C. 665.

Disclaimer.

invention larger than, and different to, that described and claimed by the specification before amendment. The Attorney-General, however, did not take this view of the case, and, applying the above-stated principle, granted leave to apply at the Patent Office to make the amendment proposed. So again, in *Ashworth's Application*, (1886) Griff. L. O. C. 6, it was objected that the proposed amendment would make the specification claim an invention different to that claimed by the original specification, but the Comptroller allowed the amendment. The Solicitor-General, in dismissing an appeal from the Comptroller's decision, expressed himself to be of opinion that the amendment only amounted to an explanation as to which of two possible constructions the patentee wished put on his claim, and that the specification, as a whole, before the amendment, indicated that the patentee really intended the construction to which by the alteration he desired to limit his claim.

During proceedings for the repeal of a patent for "improvements in instruments used for writing and marking, and in the construction of inkstands," the patentee filed a disclaimer of three of the claims of his specification. These claims related to pens, and to instruments used for marking with a stamp. Those which remained untouched by the disclaimer were for improvements in pen-holders and pencil-cases, and for the construction of inkstands. It was held by the Court of Common Pleas that the title of the letters patent was satisfied by the specification as amended by the disclaimer. (*a*)

Disclaimer does not operate as a claim to residue.

Prior to the Act of 1883 all the claiming clauses of a specification might be struck out by disclaimer, if there remained in the body of the specification words sufficient to distinguish what the invention was which the patentee claimed. The explanation given by the Court of Appeal (*b*) of the concluding words of sec. 5, sub-s. 8 of the Act of 1883 supports the statement that the law in this particular remains unaltered. It must, however, be remembered that the effect of a disclaimer is merely to strike out from the specification those parts which are disclaimed, and it cannot operate by way of a claim to the residue, nor can what remains of the specification be construed by the disclaimer; (*c*) nor does the reason for a disclaimer form any part of the specification, by virtue of the disclaimer, so as to influence the construction to be put upon it. (*d*) The amended specification must be construed,

(*a*) R. *v.* Mill, (1850) 10 C. B. 379.
(*b*) Siddel *v.* Vickers, (1888) L. R. 39 Ch. D. 92; 5 R. P. C. 416.
(*c*) Per Cresswell, J., Tetley *v.* Easton, (1852) 2 C. B. N. S. 706, 730.
(*d*) Cannington *v.* Nuttall, (1871) L. R. 5 E. & I. App. 205, 228.

without reference to any deleted part, as though it had been originally filed in its amended form, (*e*) but for the purpose of explaining an ambiguity (if any) in the amended specification reference may be made to the original. (*f*)

Correction and Explanation.

Correction and Explanation.—A mistaken method or description of a process may be corrected by amendment—*e.g.*, where a patentee directed that "the last traces" of a substance should be removed from solution by cooling by ice, and the evidence showed that *all* the substance could not be removed by ice cooling, he was allowed to substitute the words "as much as possible" for the words "the last traces." Had the specification directed the removal of "the last traces" by "any well-known means," or "by any means," or "by the best means," the amendment would not have been allowed, as it would then have made an original insufficient into a sufficient description. (*g*) In cases where an error has arisen from mistranslation it is usually necessary to file evidence in the form of statutory declarations.

Corrections and explanations are allowable when they do not exceed

The patentee must in all cases show that there is a real reason for requiring a correction or explanation before he will be permitted to make one. Thus, where an applicant asked for leave to amend his specification by inserting an explanatory statement of the principle on which the invention was based, the law officer, on appeal, refused to allow the amendment, because he thought the principle of the invention was amply described in the original specification, and he was of opinion that no ground had been shown on which the amendment ought to be allowed. (*h*)

Morgan's Patent (*i*) furnishes an instance of an amendment by way of explanation and correction. It appeared that one of the figures in the drawings had been misdescribed, and the figure was clearly included in the provisional specification and covered by the claim of the complete specification. The patentee was allowed to amend by inserting a proper description of the figure, but he was not allowed to add anything to his claim.

(*e*) Reason Manufacturing Co. *v.* Ernest F. Moy, Ld., (1902) 19 R. P. C. 409, 412, 415; Moser *v.* Marsden, (1895) 13 R. P. C. 31; Hattersley *v.* Hodgson, (1904) 21 R. P. C. 517; Jandus Arc Lamp and Electric Co., Ld. *v.* Arc Lamp Co., (1905) 22 R. P. C. 277.

(*f*) Moser *v.* Marsden, (1895) 13 R. P. C. 21, 31; Dudgeon *v.* Thompson, (1877) L. R. 3 App. Cas. 40, 45; Jandus Arc Lamp and Electric Co., Ld. *v.* Arc Lamp Co., (1905) 22 R. P. C. 277.

(*g*) Johnson's Patent, (1896) 13 R. P. C. 663; p. 72 *ante*.

(*h*) Nordenfelt's Patent, (1887) Griff. L. O. C. 18.

(*i*) (1886) Griff. L. O. C. 17.

Correction and Explanation.

the legitimate function of a correction or explanation.

The function of a correction or explanation within sec. 18 of the Act of 1883 is to explain more clearly what was the meaning of the patentee at the time he patented the invention; it is not intended that he should put in subsequently ascertained knowledge, and such an insertion will not be allowed. (*k*)

An explanation which is requisite to remove an ambiguity as to the real meaning of the patentee is justifiable, (*l*) but an extensive amendment which amounts to a rewriting of the specification will not be permitted. (*m*)

Clerical errors: jurisdiction of the Master of the Rolls.

The Master of the Rolls, as keeper of the records, had, prior to the Act of 1883, an original jurisdiction, in cases where he was satisfied that a specification as filed contained clerical errors, to order that such errors should be rectified. (*n*)

Corrections were made, on the authority of the Master of the Rolls, where "October" was written by mistake for "November;" (*o*) where "Charles" was written for "George;" (*p*) where reference numbers were transposed; (*q*) where "recovery" had been written for "covering;" (*r*) where "wire" was inserted for "fire," and the mistake was not discovered for five years; and where there was an apparent error in the drawings attached to the specification. (*s*)

The Master of the Rolls had never authority to permit or order an erroneous claim or statement to be expunged or amended merely in his capacity of keeper of the records, his authority in such capacity to allow corrections being strictly limited to verbal or clerical errors.

But in *Re Berdan's Patent*, (*t*) where a disclaimer had been filed without the consent of the patentee, it was held that the Master of the Rolls had jurisdiction, without bill filed, to order it to be taken off the file. The case was distinguished from *In re Sharp's Patent*, (*u*) on the ground that in the latter the application was not to take an improperly filed document off the file, but to alter an enrolment.

The Act of 1883 does not appear to have taken away this

(*k*) Beck and Justice, (1877) No. 4114, Griff. L. O. C. 10.

(*l*) Ashworth's Patent, (1886) Griff. L. O. C. 6.

(*m*) Nairn's Patent, (1891) 8 R. P. C. 444.

(*n*) Sharp's Patent, (1840) 1 W. P. C. 641, 646; 3 Beav. 245; Johnson's Patent, (1877) L. R. 5 Ch. D. 503.

(*o*) Rubery's Patent, (1837) 1 W. P. C. 649 *n*.

(*p*) Dismore's Patent, (1853) 18 Beav. 538.

(*q*) Redmond's Patent, (1828) 1 W. P. C. 649 *n*; 5 Russ. 44.

(*r*) Nickell's Patent, (1841) 1 W. P. C. 650; 4 Beav. 563.

(*s*) Abel's, (1874) No. 2081.

(*t*) (1875) L. R. 20 Eq. 346.

(*u*) (1840) 1 W. P. C. 641.

jurisdiction of the Master of the Rolls to allow an amendment of merely verbal or clerical errors in a specification, both before and after it has been placed on the file. (*x*)

Correction and Explanation.

In *Re Gare's Patent* (*y*) the Master of the Rolls allowed the correction of a clerical error in a specification which had been filed under the Patent Law Amendment Act of 1852, and gave it as his opinion that the Act of 1883 does not affect the power of the Master of the Rolls, as keeper of the records, to allow the amendment of a clerical error in a specification, which is to be considered as under his authority. The Master of the Rolls expressed the further opinion that so long as the specification is in the Patent Office, and before the patent is sealed, the proceedings of sec. 18 of the Act of 1883 should be the only proceedings taken by any one asking for amendment.

Present practice is to allow correction of clerical errors under s. 18 of Act of 1883, whether the patent is sealed or not

This section also regulates the correction of clerical errors as well as all other matters of legitimate correction after the patent is sealed, for the amendment of a clerical error is included in the term "correction" in sec. 18, sub-s. 1, of the Act of 1883, and consequently it is not necessary to invoke the authority of the Master of the Rolls to rectify a clerical mistake. Sec. 91 expressly gives the Comptroller power to correct clerical errors in, or in connection with, any application for a patent, or in the name, style, or address of a registered proprietor. (*z*)

It is the practice of the Comptroller to allow corrections of clerical errors in the specification under sec. 91 before the patent is sealed, but after sealing to insist on the amendment being filed under sec. 18 and advertised, except in cases of mere misspelling.

Delay may be a bar to amendment.

The amendment of a clerical error in a specification, as also other amendments, may be refused on the ground of delay. (*a*) Thus in *Re Blamond's Patent* (*b*) the Lord Chancellor, though doubting whether he had power under 15 & 16 Vict. c. 83 to order the amendment of a clerical error in the spelling of the patentee's name, refused to do so on the ground that the applicant had shown gross negligence in not applying to rectify the mistake earlier, as the patent was five years old,

(*x*) *Re* Gare's Patent, (1884) L. R. 26 Ch. D. 105; *Re* Morgan's Patent, (1876) 24 W. R. 245; Judicature Act, (1873) s. 17, sub-s. 6.

(*y*) L. R. (1884) 26 Ch. D. 105.

(*z*) See Patent Rules, (1890) r. 16; Form P, Appendix.

(*a*) Blamond's Patent, (1860) 3 L. T. N. S. 800; Lacy's Patent, (1890) 7 R. P. C. 469; Johnson's Patent, (1896) 13 R. P. C. 659.

(*b*) (1860) 3 L. T. N. S. 800.