

THE
LAW, PRACTICE, AND PROCEDURE,
RELATING TO
PATENTS,
DESIGNS, AND TRADE MARKS.

CONTAINING THE
PATENTS, DESIGNS, AND TRADE MARKS
ACT, 1883:

WITH
THE RULES AND FORMS,
AND THE OFFICIAL INSTRUCTIONS, REGULATIONS, AND NOTICES ISSUED
IN PURSUANCE OF THE ACT: AND ALSO THE LAW OFFICERS'
RULES, AND PRIVY COUNCIL RULES:

With full Notes and Comments.

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LONDON:
WILLIAM CLOWES & SONS, LIMITED,
27, FLEET STREET.

1885.

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P R E F A C E.

THE object of the writer in preparing this work has been to endeavour to collect into a small and convenient compass the whole of the materials which may be useful to the legal practitioner in considering questions relating to Patents for Inventions, Designs, and Trade-marks.

The Practice in reference to these subjects—that is to say, the proceedings to be taken by persons desirous of securing exclusive rights in respect of Patents, Designs, or Trade-marks, or by persons opposing the acquisition of such rights by others—will in future depend mainly, and indeed it may be said entirely, upon the “Patents, Designs, and Trade Marks Act, 1873,” and the Rules and Forms and Official Regulations issued and enforced under and by virtue of this statute. Consequently this work contains the Statute at length, with the Rules and Forms now in force, and also the “Instructions” and “Information,” and other official notices that have been issued by the Board of Trade for the benefit of persons making applications, or interested in or affected by applications, in respect of Patents, Designs, or Trade-marks. And the writer has added notes and comments upon the most important points, together with cross-references wherever necessary.

The Procedure in reference to these subjects—that is

to say, the legal proceedings which may have to be taken by persons to enforce their rights, or in opposition to persons claiming rights, in respect of Patents, Designs, or Trade-marks—will be regulated to some extent by the Act and the Rules, and in part also by reference to existing decisions upon previous statutes. The present statute codifies the prior statute law on these subjects, but it does not codify, or make any pretence to codify, the very many existing judicial decisions. The general nature of the proceedings to be taken in actions for infringement, upon applications to rescind letters patent, for compulsory licenses, or to rectify the registers of proprietors of Patents, Designs, and Trade-marks, or upon petitions for extension of patents, is prescribed, and the outlines of such proceedings are indicated very briefly by the Act and Rules; but the questions which must arise from time to time as to the exact details of these proceedings and the rights of litigant parties will have to be determined in many cases by a recourse to reported decisions on analogous points which have already arisen under previous statutes. Consequently this book contains in the notes and comments the substance of the reported decisions upon these points, and the attempt has been made to incorporate or refer to every decision which can be of any real importance on any question of Procedure.

In connection with this the Law Officers' Rules and the Rules now in force in respect of Proceedings before the Privy Council have been inserted and annotated.

The law relating to these three subjects is now somewhat extensive, particularly on the subject of Patents, and is made up almost entirely of judicial decisions and dicta. A summary of the whole of these decisions would

have expanded the work into an unwieldy size. Consequently what has been done has been to enunciate the various leading principles relating to Patents, and to the rights of persons interested as proprietors or otherwise in Patents, and to illustrate these principles by statements of the substance of or by reference to the leading decisions upon the different points. The law, so far as it relates to Designs and to Trade-marks, is much less extensive, and the decisions are far less numerous than the law and the decisions in connection with Patents. Consequently it has been possible to incorporate in the notes substantially the whole of the decisions of material importance on these two subjects.

The cases, and the copies of official documents which have been included, have been brought down to date.

For the preparation of the list of cases and the full Index the writer is indebted to his friend Mr. H. H. Browell, M.A., of Lincoln's Inn, Barrister-at-Law.

S. B.

5 New Court, Lincoln's Inn.
December, 1884.

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(46 & 47 Vict. c. 57).

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CORRECTIONS.



- Page 31, line 5 from bottom, for "declaimer" read "disclaimer."
- „ 42, note (zz), for "Patent," read "Patents."
- „ 92, line 3, for "or," read "of."
- „ 97, line 11, for "to," read "from."
- „ 108, note (s), for "97," read "79."
- „ 111, line 3 from bottom, for "valid," read "liable."
- „ 129, line 11, for "121," read "120."
- „ 134, line 11, for "trade," read "trade-marks."
- „ 168, line 16, for "c. 160," read "c. 100."
- „ 190, line 11, for "licenses," read "assignments."

ADDITIONS.

CASES.

- Page 30 . . . Add reference to *Hearson's Patent*, O. J. Rep. vol. i. p. 213, as note to sub-s. (4) of s. 10.
- „ 34, note (yy) Add reference to *Hearson's Patent* and to *Cropper v. Smith*, W. N. 1884, p. 225.
- „ 37 . . . Add reference to *Re Brandon's Patent*, 9 App. Cas. 590, as note to s. 25.
- „ 39, note (aa) *Newton's Patents* is now reported, 9 App. Cas. 592.
- „ 42, note (zz) *Re Newion's Patents* is now reported 9 App. Cas. 592.
- „ 46, s. 26 . . . Add reference to *Huddan's Patent*, W. N. 1884, 192, as to the right of petitioner to exhibit interrogatories.
- „ 47, s. 26, sub-s. (4) Add reference to *Re Martin's Patent*, 29 Sol. J. p. 148, where the Attorney-General, after consulting the Solicitor-General, *held* that on an application by a licensee for the consent of the Attorney-General to the presentation by him of a petition for the revocation of letters patent, which application was opposed by the patentee and was abandoned, *held* that he had no power to order costs to be paid.
- Pages 60 and 61 Add references to *Cropper v. Smith*, 26 C. D. (C.A.) 700, 33 W. R. 60.
- Page 68, note (n) *United Telephone Co. v. London and Globe Telephone Co.* is also reported in 26 Ch. D. 766.
- „ „ note (p) *Nordenfeldt v. Gardner* is reported in O. J. Rep. vol. i. p. 10.
- „ 78, note (m) Add reference to *Jackson v. Needle*, O. J. Rep. vol. i. p. 174, where Bacon, V.C., granted an interim injunction, but the Court of Appeal dissolved it, putting the defendant upon an undertaking to keep an account of his sales.

- Page 93, note (zz) *Brandon's Patent* is now reported 9 App. Cas 590.
- „ 101, note (r) *Cropper v. Smith* is now reported 26 C. D. (C.A.) 700, 33 W. R. 60.
- „ 103 . . . Add reference to *Le May v. Welch, Margetson & Co.* (App.) 33 W. R. 33; 28 Ch. D. (C.A.) 24, to entitle a “new or original” design to be registered there must be substantial novelty or originality.
- „ 108 . . . Add reference to *Wittman v. Oppenheim*, 27 C. D. 260, as note to s. 51.
- „ 124, note (l) Add reference to *Re Heaton's Trade Mark*, 27 C. D. 570.
- „ 127 . . . Add reference to *Re Price's Patent Candle Co.*, 27 C. D. 681.
- „ 133, note (z) Add reference to *Re Heaton's Trade Mark*, 27 C. D. 570.
- „ 133, note (z) Add reference to *Re Lloyd & Sons' Trade-mark*, 27 C. D. 646.
and page 134
- „ 134 . . . Add reference to *Re Price's Patent Candle Co.*, 27 C. D. 681.
- „ 141, note (s) Add reference to *Wittman v. Oppenheim*, 27 C. D. 260.
- „ 153 . . . Add reference to *Re Lloyd & Sons' Trade-mark*, 27 C. D. 646.
- „ 155 . . . Add reference to *Re Mitchell & Co's., and Houghton & Hallmark's Trade-mark*, 33 W. R. 148; W. N. 1884, p. 217, as to placing on the register a note as to an agreement.
- „ 167 . . . Add reference to *Re Brandon's Patent*, 9 App. Cas. 590, as note to s. 113.

THE
PATENTS, DESIGNS,
AND
TRADE MARKS ACT, 1883.

SUPPLEMENT.

PART I.

Additions and Corrections.

PAGE

2. *Add* to s. 4 a reference to s. 5 of 48 & 49 Vict. c. 63, *post*, p. 9.
7. *Add* to sub-s. 2 of s. 5, a reference to s. 2 of 48 & 49 Vict. c. 63, *post*, p. 8.
11. *Add* to paragraph IV., *Gandy v. Reddaway*, O. J. Rep. vol. ii. p. 49—If there are several varieties of a substance (such as canvas bands) for the user of which a patent is taken out, and only some of such varieties are available for the patent, then, if the specification does not indicate which alone are so available, the patent will be bad, even though it is admitted to be—if it had been so limited—very useful.
- 18, *Add* to ss. 8, 9, and 12, references to s. 3 of 48 & 49 Vict.
- 19, c. 63, *post*, p. 8, whereby extensions of time are allowed
- and with respect to the leaving, accepting, and filing a complete
24. specification.
20. *Add* to s. 10 a reference to s. 4 of 48 & 49 Vict. c. 63, which provides that if an application be not accepted, the specifications and drawings (if any) shall not be open to public inspection or be published.
30. *Add* to sub-s. 7 of s. 18, *Hearson's Patent*, O. J. Rep. vol. i. p. 213. There the law officer said, "As a general rule, and apart from exceptional circumstances, it is proper that when desired a condition should be imposed that no action shall

PAGE

be brought or other proceeding taken in respect of any infringement prior to the 1st of January, 1884. . . . The order in the present case will be:—That the application ought to be allowed, subject to the condition that the applicants shall not bring any action, or take any proceeding in respect of an infringement of the patent prior to the 1st of January, 1884, but this condition is to be without prejudice to the pending action or any question arising therein. I think there should be no costs of the appeal.”

- 30 *Add to sub-s. 10 of s. 18, and to s. 19, Cropper v. Smith* (No. 2)
and 28 Ch. D. 148; 33 W. R. 338, where held that after judg-
34. ment in any action there is no longer as regards such action any “pending proceeding” even though there should be an appeal from such judgment pending.
34. *Add to s. 19, Hiram Codd v. Bratby*, O. J. Rep. vol. i. 209. The plaintiff in this action applied under this section (19) for liberty to apply at the Patent Office for leave to amend the specification of his patent by way of disclaimer, and that in the meantime the trial of the action might be postponed. It appeared that the plaintiff had previously made application to the Comptroller for leave to disclaim, which was refused on the ground that the action was pending, and no leave to disclaim had been obtained from the Court. It was held, that the liberty applied for should be granted upon the terms that the specification when amended should not be given in evidence at the trial of the action, and that no evidence should be given of any infringement prior to the date of the filing of the amended specification; and that the costs of the motion and of the previous application to the Comptroller and thrown away by reason of the amendment be paid by the plaintiff.
38. *Add to sub-s. 5 of s. 25—In W. W. Smith’s Patent*, O. J. Rep. vol. ii. p. 14, a new patent was granted for seven years without conditions, and without requiring a new specification to be filed.
40. *Add to note (i) a reference to Furness’ Patent*, O. J. Rep. vol. ii. 175.
41. *Add to note (q)—“It was laid down in Hill’s Patent* (1 Moore’s P. C. 251), where the patentee was also a manufacturer, that two-thirds was too much to be attributed to the general manufacturing profit, and that one-third was too little to

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be attributed to the patent profits. But there is no specific rule which can be acted upon.”—Judgment of Privy Council: *Duncan and Wilson's Patent*, O. J. Rep. vol. i. 257, where an application for extension was refused chiefly by reason of the state of the accounts, though the invention was “an exceeding ingenious and meritorious one, and useful.”

47. *Add* to sub-s. 5 of s. 26—In *Haddon's Patent*, 54 L. J. C. 126, 33 W. R. 96, a petitioner was allowed to deliver interrogatories to the patentee.
53. *Add* to sub-s. 6 of s. 29—Where the judge decided against the defendant, but the Court of Appeal and the House of Lords held the patent invalid, a certificate (under the Act of 1852) was given as to the costs of the particulars upon which the defendant ultimately succeeded by the judge who heard the action in the first instance: *Cropper v. Smith*, W. N. 1885, p. 111.
- „ Where the plaintiff's case broke down on his own evidence, and the judge dismissed the action with costs, and therefore the defendant put in no evidence, it was held both by the judge and by the Court of Appeal, with respect to the costs of the defendant's particulars (which had not been proved), that neither Lord Cairns' Act (21 & 22 Vict. c. 27) nor Sir J. Rolt's Act (25 & 26 Vict. c. 42) made it obligatory on a Court of Equity to follow the rule as to costs of particulars of objections laid down by the Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83), s. 43, and that the rule which applied to Courts having no discretion as to costs ought not to be followed by analogy by a Court which had discretion as to costs; that the Vice-Chancellor had therefore power in his discretion to give these costs, and that they must be allowed: *Parnell v. Mort, Liddell, & Co.*, 29 C. D. (C. A.) 325; 33 W. R. (C. A.) 481.
- „ As to costs, where parties succeed on some and fail on others of several issues raised by them, see *Badische Anilin, &c., Fabrik v. Levinstein*, 29 Sol. J. (C. A.) 354; *Pooley v. Pointon*, O. J. Rep. vol. ii. 167; *Lawrence v. Perry*, O. J. Rep. vol. ii. 179.
56. *Add* to note (r)—Where articles were manufactured abroad which if manufactured here would have been an infringement of the plaintiff's patent, and were imported and used

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here solely (as the defendant alleged) by way of experiment and to afford instruction to pupils to see whether they could not be improved upon, as certain royalty-paid apparatus in the defendant's possession were too expensive to pull to pieces, &c., this was held a user for advantage, and consequently an infringement: *United Telephone Co. v. Sharples*, 29 C. D. 164; 33 W. R. 444.

59. Particulars of objections delivered by one of two defendants who were partners were available on behalf of the other defendant: *Cropper v. Smith*, 10 App. Cas. 249.
62. Add to note (g) a reference to *Otto v. Steel*, O. J. Rep. vol. ii. 139.
69. Add as note under heading "Referee"—Where any question in an action is sent to a referee, the costs of such reference will usually be made costs in the action: *Badische Anilin und Soda Fabrik v. Levinstein*, 24 C. D. 156; 31 W. R. 913.
71. Add as note to last paragraph a reference to *United Telephone Co. v. Sharples*, O. J. Rep. vol. ii. p. 12—Where two actions were brought the judge at the trial allowed to the plaintiffs succeeding only the costs of one.
74. Add to note (r) a reference to *Pannell v. Mort, Liddell, & Co.*, as cited, *ante*, p. 3.
79. Add to note (r)—Where the evidence of the plaintiffs applying for inspection only amounted to suspicion on their part that the defendants were infringing, and no grounds were stated for such suspicion, an application for inspection of the defendant's mills was refused: *Germ Milling Co. v. Robinson*, O. J. Rep. vol. i. p. 217.
83. Add to note (k)—If the defendant (who has put in a defence) does not appear on the hearing, the plaintiff must prove his specification and the fact of infringement, and is then entitled to judgment, though not to a certificate of validity or to costs on the higher scale: *Peroni v. Hudson*, O. J. Rep. vol. i. p. 261.

A certificate under 15 & 16 Vict. c. 83, s. 43, that the validity of a patent came in question cannot be obtained by a defendant in an action for infringement: *Badische Anilin und Soda Fabrik v. Levinstein*, 29 C. D. C. A. 366.

84. Add to note (nn) references to *Barney v. United Telephone Co.*, 28 C. D. 394; and *Household v. Fairburn* (No. 1), 51 L. T. 498; (No. 2), O. J. Rep. vol. ii. p. 140.

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105. *Add as note to "Invalid Designs"*—A design is not a proper subject of registration under the Patents, &c., Act, 1883, unless there is a clearly marked and defined difference involving substantial novelty between it and any design previously in use. A design for a shirt collar was registered, the advantages claimed for which were—the height of the collar above the stud which fastened it in front, the cutting away of the corners in a segment of a circle, and the absence of a band. A collar was shown to have been previously in use which had no band, and in which the corners were cut away in arcs of circles; but the cutting away was not so wide, and the height above the stud was not so great, as in the registered design. It was held by the Court of Appeal that the registered design was not new or original within the meaning of the Act, and must be removed from the register: *Le May v. Welch*, 28 C. D. C. A. 24; 54 L. J. C. 279; 33 W. R. 33; 51 L. T. 867.
108. *Add to note (u) a reference Wittman v. Oppenheim*, 27 C. D. 260.
116. As to amount of similarity which will prevent a proposed trade-mark being registered: see *Sone & Fleming Manufacturing Co.'s Trade-mark*, 29 Sol. J. 540.
- „ *Add to note (e) a reference to Heaton's Trade-mark*, 27 C. D. 570.
118. *Add to note (m) a reference to Houghton & Hallmark's Trade-mark*, 28 C. D. 666, reported as *Mitchell & Co.'s, &c., Trade-mark*, 33 W. R. 408.
119. *Add to note (n)*—So decided by Kay, J., in *Hayward & Sons' Trade-mark*, W. N. 1885, p. 158.
122. *Add to note (b) a reference to Leonard v. Wells*, 26 C. D. 288—“valvoline” as applied to a particular kind of oil.
125. *Add as note to sub-s. 1 of s. 64*—An application was made for an order upon the Comptroller of Trade-marks to register a mark having the words “Price's Patent Candle Company” in common letters round the upper border, and “National Sperm” in the centre, with the address of the company round the lower border. The Comptroller refused to register the mark, on the ground that there was a mark so nearly resembling this, already on the register, as to be calculated to deceive, and also because it was not a distinctive label within the terms of the Patents, &c., Act, 1883.

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The Court held (a) that the name of the firm printed in common letters not being distinctive, and the words "National Sperm" not being fancy words "not in common use," the label did not fulfil the requirements of s. 64 of the Act; and (b), that the Comptroller would be justified in refusing to register a label so nearly resembling another label already on the register as to be calculated to deceive, until the opinion of the Court should have been obtained authorising him to do so: *Re Price's Patent Candle Company*, 27 C. D. 681; 54 L. J. C. 210.

126. *Add* generally as notes to this page—As to "fancy" words. Single words, &c., may now be registered; but words or expressions to be registered must be of a "fancy" description, e.g. "Asiatic Walnut" is not: *Friedlander's Trade-mark*, 29 Sol. J. 397. "Alpine," as applied to woollen, &c., goods, is: *Trade-mark "Alpine,"* 29 C. D. 877; 54 L. J. C. 727; 33 W. R. 725; 53 L. T. 79; so is "The Lawford" as applied to tennis bats: *Slazenger v. Malings*, W. N. 1885, p. 124.

"Not in common use." This is essential, and therefore in *Re Price's Patent Candle Co.*, 27 C. D. 681, it was held that the words "National Sperm," even if fancy words, being in fact in common use could not be registered.

A single word, e.g. "Valvoline," cannot be registered as a "heading" unless it was so used before the Act: *Leonard v. Wells*, 26 C. D. C. A. 288.

The plaintiff registered a trade-mark with the words "Strathmore Blend," and the whisky became known to many of his customers and in the market as "Strathmore whisky." The defendant afterwards registered a trade-mark, and the name of "Strathmore," for a whisky blended and sold by him. The Court held that the word "blend" described the operation of manufacturing, and was not an essential part of the name of the plaintiff's whisky; that "Strathmore" was a fancy name; that the defendant must be restrained from using the word either as part of his trade-mark or otherwise; and that the defendant could not register the word "Strathmore" in combination with his trade-mark, and that the register must be rectified by striking out the word: *Blair v. Stock*, 52 L. T. 123.

- 128-9. The words in sub-s. 3 of s. 64, "any special and distinctive

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word or words, letters, figures, or combination of letters or figures, or of letters and figures used as a trade-mark before the 13th day of August, 1875, may be registered as a trade-mark under this part of this Act," refer to words when used alone, not in combination with any other device—*per* Selborne, L. C., in *Leonard v. Wells*, 26 C. D. C. A. 288, 295, referring to *J. B. Palmer's Trade-mark*, 24 C. D. 504, 518. See also *per* Fry, L. J., in the same case.

137. *Add* as note to s. 76—The Act does not confer by registration and the lapse of five years an indefeasible title when the thing registered ought not to have been registered: *Leonard v. Wells*, 26 C. D. C. A. 288; *Lloyd & Son's Trade-mark*, *Lloyd v. Bottomley*, 27 C. D. 646; *Wragg's Trade-Mark*, 29 C. D. 551.
141. *Add* to note (s)—*Upmann v. Forester* was followed in *Wittman v. Oppenheim*, 27 C. D. 260: but not by Smith, J., in *Upmann v. Currey*, 29 Sol. J. 735.
151. *Add* as note to s. 85—This section prevents the entry on the register of any memorandum to the effect that the right registered, *e.g.* a trade-mark, is restricted by agreement between the parties: *Mitchell & Co's.*, and *Houghton & Hallmark's Trade-mark*, 28 C. D. 666. Undertakings as to the user of the rights registered may, however, be entered on the register. *Ibid.*
168. *Add* to s. 113 a reference to *Hayward & Sons' Trade-mark*, W. N. 1885, p. 158.
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PART II.

48 & 49 VICT. c. 63.

ARRANGEMENT OF SECTIONS.

SECTION.

1. Construction and short title.
2. Amendment of s. 5 of 46 & 47 Vict. c. 57.
3. Amendment of ss. 8, 9, and 12 of 46 & 47 Vict. c. 57.
4. Specifications, &c., not to be published unless application accepted.
5. Power to grant patents to several persons jointly.
6. Amendment of s. 103 of 46 & 47 Vict. c. 57.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]

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

Construction
and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of
s. 5 of 46 & 47
Vict. c. 57.

2. Whereas subsection two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that subsection mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that :

The declaration mentioned in subsection two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

5 & 6 W. 4,
c. 62.

See Patents Rules 6, 20, and 21, *ante*, pp. 179-183; and Form A 1, *ante*, p. 198.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the Comptroller to extend in certain cases the said times: Be it therefore enacted as follows:

Amendment of
ss. 8, 9, and 12
of 46 & 47
Vict. c. 57.

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

For the provisions authorising the Comptroller to extend time, see Patents Rules 46 and 47, *ante*, p. 187; Designs Rules, 31, *ante*, p. 231; and Trade-marks Rules, 52, *ante*, p. 254. These rules, however, apply only to the several periods of time specified in the different sets of rules themselves. Section 17, sub-ss. 3 and 4 of the principal Act (*ante*, p. 28), also provide for the extension of time in the cases there mentioned.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion

Specifications,
&c., not to be
published
unless applica-
tion accepted.

with such application, shall not at any time be open to public inspection or be published by the Comptroller.

This provision supplements sect. 10 of the principal Act (*ante*, p. 20), which provided that on the acceptance of the complete specification the specification and drawings shall be published.

Power to
grant patents
to several per-
sons jointly.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

See sect. 4 of the principal Act, and notes thereto, *ante*, p. 2.

Amendment
of s. 103 of
46 & 47 Vict.
c. 57.

6. In subsection one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

THE
PATENTS, DESIGNS,
AND
TRADE MARKS ACT, 1883.

46 & 47 VICT. c. 57.

*An Act to amend and consolidate the Law relating to Patents
for Inventions, Registration of Designs, and of Trade
Marks.* [25th August, 1883.]

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

PART I.

PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

2. This Act is divided into parts, as follows :—

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

PART I.

PRELIMINARY.

SS. 1, 2.

Short title.

Division of
Act into
parts.

PART I.
PRELIMI-
NARY.

S. 3.

Com-
mence-
ment of
Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three.

PART II.

PATENTS.

*Application for and Grant of Patent.*PART
II.
PATENTS.

S. 4.

Persons
entitled to
apply for
patent.

4. (1.) Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

For definition of "patent," see sect. 46.

GRANT.

To whom
letters
patent
may be
granted.

Letters patent may be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad (a).

A person may apply for a patent as trustee for another, whether a British subject or an alien (b). The representatives of a person who had made a discovery, but had not himself applied for letters patent, could not themselves apply (c). But now, by sect. 34, they may do so.

"True and
first
inventor."

The applicant for letters patent must, by section 5, be the "True and First Inventor." These words are taken from the Statute of Monopolies, 21 Jac. 1, c. 3, s. 5, and they include various persons other than those who are in strictness the actual inventors.

Communi-
cation
from
abroad.

Thus it has long been settled that a person who first receives from abroad a communication of a new invention may take out a patent for the same, but the cases which have decided this were an extension of the law. "It is difficult to say *à priori*, on what prin

(a) *Re Wirth's Patent*, 12 Ch. D. 303.

Newton's Patent, 14 Moo. P. C. 156.

(b) *Beard v. Egerton*, 3 C. B. 97; 15 L. J. C. P. 270; *Re*

(c) See page 4, note (h); and sect. 34, *post*.

ciple a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor. I have never been able to discover the principle, and although I have often made inquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, 'It has been decided, and you are bound by the decisions.' But it is an anomaly as far as I know, not depending on any principle whatever. It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is, that I must look upon it as a sort of anomalous decision which has acquired by time and recognition the force of law" (d).

Whether, however, such persons will be able in future to take out patents in respect of the communicated invention, is doubtful. Section 5 provides (sub-sect. 2), that the declaration to be made by an applicant must state that he is in possession of an invention whereof "he or in case of a joint application one or more of the applicants claim or claims to be the true and first inventor or inventors." If this section were construed strictly, an importer, merely as such, plainly cannot apply for, and therefore cannot receive a grant of letters patent.

It is suggested, however, that the difficulty may be got over in either of two ways—(a) By joining the foreign inventor with the English applicant, who would make the declaration, varying it somewhat from the statutory form so as to state that the foreigner joined with him in the application, is the first inventor, or (b), by the foreign inventor himself making the application (which under this section he may do) and himself subscribing the necessary declaration.

When inventions are communicated from abroad this should be clearly stated and appear in the application and in the letters patent (e).

The person taking out such a patent may be, as indeed he

**PART
II.
PATENTS.**
—
S. 4.
—

Persons
entitled to
apply for
patent.

(d) *Per* Jessel, M.R., in *Marsden v. Saville Street Co.*, 3 Ex. D. C. A. 203, 205. A person obtaining a patent for an invention communicated to him from abroad is an "inventor" within the meaning of

the statute of James I. *Nickels v. Ross*, 8 C. B. 679.

(e) *Milligan v. Marsh*, 2 Jur. N. S. 1083. See Patent Rules, Form A 1.

PART
II.

PATENTS.

S. 4.

Persons
entitled to
apply for
patent.Person in
public
office.Concur-
rent appli-
cations.

usually is, an agent of the foreign inventor who has had no share in discovering the invention (*f*).

The person taking out the patent is deemed for all purposes connected with the grant of the patent or its validity the actual inventor (*g*).

A communication made in this country by one person to another does not make the latter the "first and true inventor" so as to entitle him to obtain a patent (*h*).

A person filling a public office, such as a referee appointed by Act of Parliament to make inquiries of a public nature, who in the course of his duty and inquiries, makes a discovery, cannot take out a patent for such discovery (*k*).

In the case of concurrent applications for letters patent for the same invention the most expeditious applicant, even though the later in date will, or at least may, get the great seal affixed to the grant to himself (*l*).

In such case it has been held prior to the present statute that letters patent cannot subsequently be granted to the earlier applicant (*m*), and that if a grant be subsequently made to the earlier applicant, on the ground that a part of the invention claimed by him is not within the letters patent already granted, this second grant ought to be dated subsequent to the date of the previous grant (*n*).

But Earl Cairns, L.C., in *Dering's Patent* (*o*) questioned the soundness of this principle, and declined to follow it in the case now cited. Here the applications for provisional protection were made on the same day, and the Lord Chancellor considered that a grant of separate letters patent ought to be made to each applicant

(*f*) *Beard v. Egerton*, 3 C. B. 97; *Wirth's Patent*, 12 Ch. D. 303.

(*g*) See *Plimpton v. Malcolmson*, 3 Ch. D. 531, 582; *Wegmann v. Corcoran*, 13 Ch. D. C. A. 65.

(*h*) *Marsden v. Saville Street Foundry Co.*, 3 Ex. D. C. A. 203; which case also decided that the legal personal representatives of a person who had made an invention but had not taken out a patent for it, could not themselves take out letters patent for such invention.

(*k*) *Patterson v. Gaslight and*

Coke Co., 3 App. Cas. 239.

(*l*) *Ex p. Dyer*, Holroyd, 59; *Ex p. Bates and Redgate*, L. R. 4 Ch. 577; *Ex p. Bailey*, L. R. 8 Ch. 60. Compare *Lee v. Walker*, L. R. 7 C. P. 121, where an action was brought against a patent agent for negligence under such circumstances.

(*m*) *Ex p. Bates and Redgate*, *ubi supra*.

(*n*) *Ex p. Bailey*, *ubi supra*.

(*o*) 13 Ch. D. 393-396; compare *Ex p. Manceaux*, L. R. 6 Ch. 272.

and that thereby they would in effect be made co-proprietors, and neither could restrain or interfere with the other.

By consent of rival applicants letters patent may be granted to each of them, and dated on the same day (*p*).

Now by sect. 13 of the Act it is expressly provided that in the case of rival applications "the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application."

Sometimes in the case of contemporaneous discoveries, a patent has been granted to the discoverers jointly (*q*), and this would seem to be a proper course to adopt whenever the parties are willing.

Where a master and his foreman both made improvements, it was held that the letters patent ought only to be granted on the terms of their being vested in trustees for both (*r*).

The cases of employers of labour and other persons applying for patents in respect of inventions which have in fact been discovered by persons in their employ, and of other persons from whom the applicants have obtained the secret are now expressly provided for in sect. 11.

CO-OWNERS (*s*).

When a grant is made to two or more persons jointly, it was **Co-owners.**

(*p*) *Re Gething*, L. R. 9 Ch. 633.

(*q*) *Per Campbell*, C.J., and Cockburn, A.G., *Heath v. Smith*, 2 Web. P. C. 271.

(*r*) *Re Russell*, 2 D. & J. 130; Compare *Ex p. Scott and Young*, L. R. 6 Ch. 274.

(*s*) Lindley, L.J., in "Partnership," vol. i. p. 69, 3rd. ed., expresses himself thus:—"Cases may arise in which justice may be done by allowing each co-owner [of a chattel] to make what he can, and to keep what he may get. This may occur where the chattel is such that each co-owner can, in fact, enjoy his rights to the full extent, without the concurrence of the other owners (*e.g.*, where the chattel is a patent for an invention). In the case of a patent, belonging to several

persons in common, each co-owner can by law assign his share and sue for an infringement (see *Dunnicliffe v. Mallett*, 7 C. B. 209, and *Walter v. Lavater*, 8 ib. 162; and as to tenants in common of trade-marks, see *Dent v. Turpin*, 2 J. & H. 139), and can also work the patent himself, and give licenses to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses (*Mathers v. Green*, L. R. 1 Ch. 29. The same point was discussed, but not decided, in *Hancock v. Bewley*, Joh. 601; see also *Russell's Patent*, 2 De G. & J. 130; and *Horsley &*

PART II.

PATENTS.

S. 4.

Persons entitled to apply for patent.

Master and workman.

Co-owners.

PART
II.

PATENTS.

S. 4.

Persons
entitled to
apply for
patent.

Assign-
ment.

held in *Mathers v. Green* (t) that any one may use the invention for his own benefit without the consent of the others, or accounting to them for any profits made by his own personal user. But this case cannot be considered to have decided that a co-patentee is not liable to account to his joint owners for any profits made by him by granting licences. And it has been held that the part owner of a dramatic entertainment cannot grant a licence for the representation without the consent of the others, and if he does so he must account for any profits made (u).

Where an assignment had been made by a patentee of a share of a patent, and a share of profits arising from the working of the patent by licensees, it was held that the assignee—in the present case the mortgagee of the assignee—of the share was entitled to an account from the licensees, but that the account must be taken once for all in the presence of all the parties interested, and as the patentee had made other assignments of shares of the patent, and the profits arising therefrom to other persons who were not parties, the action was dismissed with costs (x).

Where a patentee assigned the patent, and the assignees covenanted to use their best endeavours to introduce the invention by granting licences or working it, and that the patentee should be entitled to 5 per cent. of the net profits however arising, and the assignees subsequently assigned the patent to a company formed for working it, it was held that the company was liable to account to the patentee in an action brought by him against the company directly (y).

The assignee of a distinct part of a patent can, however, sue for an infringement of that part without joining one who has an interest in another part, and the damages, if any, recovered will accrue to the former alone (z).

Knighton's Patent, L. R. 8 Eq. 475). The mutual rights of co-owners of a copyright not being partners, have not been decided, but they are probably similar to those of co-owners of patents. (See some observations on the indivisibility of copyright in 4 H. L. C. 992)."

(t) L. R. 1 Ch. 29; 35 L. J. Ch. 1. *Quare*, whether when a patent is vested in trustees upon trust for several persons as tenants in com-

mon or joint tenants, any one of them is at liberty to work the patent on his own account: *Hancock v. Bewley*, Joh. 601.

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

(x) *Bergmann v. Macmillan*, 17 Ch. D. 423.

(y) *Werderman v. Société Générale d'Électricité*, 19 Ch. D. C. A. 246.

(z) *Dunnicliffe v. Mallett*, 7 C. B. N. S. 209; 29 L. J. C. P. 70.

Where a partnership at will was formed between A. and B. for the purpose of working an invention for which a patent had previously been taken out by and registered in the name of A. alone, and the business of such partnership was carried on for some time, it was held that the patent became an asset of the partnership, and each partner acquired a right to practise the invention, and that this right was not taken away by A., the registered owner assigning the patent to third parties, who had notice of the existence of the partnership; but that B. had not thereby acquired a right in the patent itself (a).

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Partners

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner (a).

**Applica-
tion and
specifica-
tion.**

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

(3.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required (β).

(4.) A complete specification, whether left on application or subsequently, must particularly describe and

(a) Patent Rules, 6, 8, 9, 10, 19.

(β) Ibid. rr. 28-30. Forms A, B, and C, in the First Schedule to the Act, replaced by forms A. A 1, B, and C in the Second Schedule to the Patent Rules. See rule 5.

(a) *Kenny's Patent Button-holeing Co. v. Somervell*, 38 L. T. 878; 26 W. R. 786.

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tions.

ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

(5.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

PROVISIONAL SPECIFICATIONS.

Provisional specifications were introduced by the Patent Law Amendment Act, 1852. Their object is only to describe generally and fairly the nature of the invention and not to enter into minute details as to the manner in which the invention is to be carried out (*b*).

Specifica-
tions.

The provisional specification cannot be prayed in aid for the purpose of supplying a defect in the complete specification (*c*).

Where a provisional specification was filed on the 17th of March, and afterwards abandoned by the inventor, who delivered another specification for the same invention on the 10th of April, in respect of which a patent was granted to him on the 12th of October, but dated as of the 10th of April; it was held that there had not been a dedication of the invention to the public by the abandonment of the first provisional specification, but that the patent was valid (*d*).

Language
of pro-
visional
specifica-
tion.

The provisional specification ought not to be vague or expressed in terms too wide or general, and the objections which formerly were often made to the validity of letters patent, on the ground that the title was not sufficiently explicit or connected with the subject-matter, apply equally to provisional specifications which are not precise and clear. "The relation which the provisional specification bears to the complete specification is much the same as that which, before the Patent Law Amendment Act, the title bore to the specification; and the observations of Tindal, C.J., in *Cook v. Pearce* (*e*) are as applicable to the provisional specification now as

(*b*) *Newall v. Elliott*, 4 C. B. N. S. 269; 27 L. J. C. P. 337; 10 Jur. N. S. 954.

(*c*) *Mackellan v. Rennie*, 13 C. B. (N.S.) 52.

(*d*) *Oxley v. Holden*, 8 C. B. N. S. 666; 30 L. J. (C.P.) 68. Compare *Stoner v. Todd*, 4 Ch. D. 58.

(*e*) 8 Q. B. 1064.

they were to the title formerly. That learned judge says: 'The vagueness (he had previously spoken of the vagueness and generality) of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void.' These remarks, as applied to the title of a patent, have a stronger application to the case of a provisional specification under the Patent Law Amendment Act, because the law officer, if he thinks the specification too large, can order it to be amended. And if no objection is made by him, the generality of the specification, to repeat the words of Chief Justice Tindal, affords no grounds for avoiding the patent after it is granted"(*f*).

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tions.

Nevertheless, as appears by the judgment just cited, it was for the law officer, and now it is presumed it will be for the comptroller, to object that a provisional specification is too general, and if he raises no objection on such ground no other person can impeach it.

The provisional specification so far controls the complete specification that the latter must not claim anything different from that which is included in the provisional specification (*g*), and ought not to vary materially in description of the manner of putting the invention into operation, or in the invention claimed from that set forth in the provisional specification (*h*). But there may be considerable variation between the two documents without avoiding the patent (*i*).

Variance
between
provisional
and
complete
specifica-
tion.

TITLE.

By sect. 6 the title "must sufficiently indicate the subject-matter of the invention," and if it does not do so the comptroller may (sect. 7) require it to be amended.

The title hitherto has been, and no doubt in future will be, read as indicating the exact object sought to be retained, and therefore *pro tanto* controlling the specification, consequently there ought to

(*f*) Per Cranworth, L.C., in *Penn v. Bibby*, L. R. 2 Ch. 127, 133. *phone Co. v. Harrison, Cox-Walker, & Co.*, 21 Ch. D. 720.
 (*g*) *Penn v. Bibby, ubi supra.* (*i*) *Foxwell v. Bostock*, 4 D. G. J. & S. 298; *Thomas v. Welch*, L. R. 1 C. P. 192; 35 L. J. C. P. 200.
 (*h*) *Bailey v. Robertson*, 3 App. Cas. 1055, 1061-2; *United Tele-*

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tions.

be no material variation between the title and the specification, or the patent may be void (*k*).

If, however, the specification is consistent with the title (*l*); or if the specification, though on one construction apparently wider than the title, can be read so as to limit it to the title (*m*); or if the specification being in wider language than the title applies only to things *ejusdem generis* with those described in the title (*n*), the patent will be good.

But if the title is, in fact, too wide and general, it cannot be limited or controlled by the specification, and the patent will be void (*o*).

COMPLETE SPECIFICATION.

The principles of law relating to the validity of specifications as depending upon the language used and the information given in and by them may be thus shortly enunciated:—

I. There must be no mis-description of the invention, or the manner whereby it is to be performed, or of the machines, implements, or substances to be employed in effectuating it (*p*).

Language
of a speci-
fication.

The specification must so describe both the nature of the invention and the manner in which it is to be performed, as to enable the patented article or process to be made or carried into operation, and the public thereby to have the benefit of the invention at the end of the term. "To support a patent the specification should be so clear as to enable all the world to use the invention as soon as the term for which it has been granted is at an end" (*q*).

At the same time it must be borne in mind that a specification is often addressed to and intended for scientific persons, skilled artizans, and the like, and when this is so it will be sufficient and

(*k*) *Hill v. Thompson*, 1 Web. P. C. 239; 8 Taunt, 375; *Rex v. Wheeler*, 2 B. & Ald. 345; *Croll v. Edge*, 9 C. B. 479; 19 L. J. C. P. 261; *Electric Telegraph Co. v. Brett*, 10 C. B. 838; 20 L. J. C. P. 123, 130.

(*l*) *Neilson v. Harford*, 8 M. & W. 806; 1 Web. P. C. 331; *Beard v. Eyerton*, 3 C. B. 97; 15 L. J. C. P. 270.

(*m*) *Reg. v. Mill*, 10 C. B. 379; 20 L. J. C. P. 16; *Patent Bottle*

Envelope Co. v. Seymer, 5 C. B. N. S. 164; 28 L. J. C. P. 22; *Oxley v. Holden*, 8 C. B. N. S. 707; 30 L. J. Q. B. 74.

(*n*) *Wright v. Hitchcock*, L. R. 5 Ex. 37.

(*o*) *Cook v. Pearce*, 8 Q. B. 1064; 13 L. J. Q. B. 192.

(*p*) *Neilson v. Harford*, 8 M. & W. 806; *Sturtz v. De la Rue*, 5 Russ. 322; 1 Web. P. C. 83.

(*q*) *Eldon*, L.C., in *Newbery v. James*, 2 Mer. 451.

valid if it describes the invention in such manner as to be understood by such persons, even though the description be not intelligible by the ordinary unskilled public (*r*).

Whether a specification contains a sufficient description can only be ascertained by experiment, and in making the experiment knowledge and means may be employed which have been acquired since the date of the patent (*s*).

II. A specification must not be in any manner misleading.

One of the objects, perhaps the main object, in granting letters patent being to secure that the public shall have the full benefit of the invention at the expiration of the term covered by the letters patent, it is an implied condition of the grant that "the nature of the invention, and the manner in which it is to be performed," shall be described, not only with particularity, but also so as to point out the best and simplest mode whereby the invention can be effectuated. The patentee must make himself acquainted with the knowledge on the subject to which his invention relates, existing at the time of his invention, and frame his specification by reference to such knowledge. Details that are necessary, but none that are unnecessary, should be given. A complicated, lengthy, or expensive process should not be described, whether as being the essential mode or only one mode of carrying the invention into effect if there is another mode which is substantially simpler, shorter, or cheaper. Least of all should stress be laid upon, or the attention be directed to, unimportant details or non-essential operations. The specification must further, of course, be free from ambiguity, and it must, when necessary, distinguish with reasonable clearness what is new from what is old (*ss*).

III. The specification must describe at least one method or process whereby the invention can be put into practical operation (*t*).

IV. If there are various "manners" whereby the invention may be performed, the specification must mention this and indicate that which, all things taken together, is the most useful (*u*).

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tions.

(*r*) See *Bickford v. Skewes*, 1 Q. B. 938; 1 Web. P. C. 214; *Neilson v. Harford*, 1 Web. P. C. 295; *Hinks v. Safety Lighting Co.*, 4 Ch. D. 607.

(*s*) *Betts v. Neilson*, L. R. 3 Ch. 429.

(*ss*) See cases in following notes.

(*t*) *Derosne v. Fairie*, 2 C. M. & R. 476; 1 Web. P. C. 154; *Bailey v. Robertson*, 3 App. Cas. 1055.

(*u*) *Heath v. Unwin*, 2 Web. P. C.

228, 243.

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tions.

V. There must be no concealment—the full knowledge of the patentee must be given frankly and clearly (*x*).

VI. There must be no omission of steps or details in the process or operation patented, or any material part thereof, or of substances to be used in carrying the invention into effect (*y*).

VII. Steps or details in the process or operation which are unnecessary for the purposes of the invention, or which are needlessly complicated when other shorter proceedings are available, must not be described as being, and so as to constitute them a part of, or essential to, the invention. And similarly steps, details, or proceedings which are of minor importance, must not be so described or referred to as to imply that, or cause persons attempting to use the invention to think that such steps, details, or proceedings are of the essence of the invention (*z*).

VIII. There must be no ambiguity or uncertainty in the specification taken as a whole, and having regard to the title and to the drawings, if any (*a*).

IX. The specification must always discriminate that which is new from that which is old—it must, so to speak, indicate the differentiae separating the invention patented from already known inventions or manufactures (*b*).

(*x*) *Rex v. Arkwright*, 1 Web. P. C. 66:—"The specification must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it."—*Per* Buller, J. *Turner v. Winter*, 1 T. R. 607; 1 Web. P. C. 77, 81—as to cheaper materials than those enumerated. *Lewis v. Marling*, 10 B. & C. 26; 1 Web. P. C. 496:—"To support a patent it is necessary that the specification should make a full disclosure to the public. If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad. So, if he says that there are many modes of doing a thing, when in fact one only will do, this will avoid the patent; but if he makes a full and fair communication, as far as

his knowledge at the time extends, he has done all that is required."

(*y*) *Wood v. Zimmer*, Holt, 58; 1 Web. P. C. 82; *Mackellan v. Reunie*, 13 C. B. N. S. 59.

(*z*) *Savory v. Price*, 1 Ry. & Mo. 1; 1 Web. P. C. 83.

(*a*) *Beard v. Egerton*, 8 C. B. 165; 19 L. J. C. P. 36; *Stevens v. Keating*, 2 Ex. 772; 19 L. J. Ex. 57; *Patent Type Founding Co. v. Richard*, Joh. 381; 6 Jur. N. S. 39; *Ralston v. Smith*, 11 H. L. C. 223; *Simpson v. Holliday*, L. R. 1 H. L. 315; *Daw v. Eley*, L. R. 3 Eq. 500, n., 14 W. R. 126; *Wegmann v. Corcoran*, 13 Ch. D. C. A. 65.

(*b*) *Carpenter v. Smith*, 1 Web. P. C. 530; *Newall v. Elliott*, 10 Jur. N. S. 954. Compare *Daw v. Eley*, L. R. 3 Eq. 500, n.; and *Wright v. Hitchcock*, L. R. 5 Ex. 37.

The above rules apply only to matters of real and substantial importance. A specification is to be construed reasonably and so as to support the patent rather than the contrary. Mere slips, whether of misdescription or of omission, too great attention to details and the like, will not vitiate if the specification is reasonably full, clear, and explicit.

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tions.

CONSTRUCTION OF SPECIFICATIONS.

The construction of a specification is a matter of law for the Court and not a question of fact for the jury (c).

The sufficiency of the specification for the purpose intended would seem to be for the jury, not the Court to determine (d).

The explanation and precise meaning of technical terms and other words of art employed in a specification, as in any other document, are matters for the jury (e).

Questions of novelty and the like raised by, or which have to be decided by, a comparison of two specifications, are questions of law for the Court (f).

But where two specifications of different dates, relating to the same external objects, contain terms of art, though the expressions used in both are identical, their construction cannot be declared by the Court to be the same without the meaning and use of the terms of art employed therein, being first ascertained by evidence, and being shewn to be the same at the date of both the specifications (g).

“Where novelty or infringement depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine, or a material part of one machine, imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact which must be left to the jury” (h).

(c) *Bovill v. Pimm*, 11 Ex. 718; *Hills v. London Gaslight Co.*, 27 L. J. Ex. 60.

(d) *Bickford v. Skewes*, 1 Q. B. 938. It appears to be so settled in the United States. *Wood v. Underhill*, 5 How. 1, 4.

(e) *Hills v. Evans*, 31 L. J. Ch. 457; 8 Jur. N. S. 525.

(f) *Thomas v. Foxwell*, 5 Jur.

N. S. 37; 6 Jur. N. S. 271; *Hills v. Evans, ubi supra*; *Bush v. Fox*, 5 H. L. C. 707; *Booth v. Kennard*, 2 H. & N. 84; 26 L. J. Ex. 305.

(g) *Betts v. Menzies*, 1 E. & E. 990, 1020; affirmed in the House of Lords, 10 H. L. C. 117.

(h) *Per Campbell, L.C., in Seed v. Higgins*, 8 H. L. C. 550, 561.

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tions.

Persons for
whom
specifica-
tions in-
tended.

In construing a specification regard must be had to the class of persons to whom it may be presumed to be specially addressed in the case of specifications relating to a scientific or other special subject-matter. "In the case of a specification which is addressed, not to the world at large but to a particular class, for instance, skilled mechanics possessing a certain amount of knowledge, it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanics, and to see what the words of the specification mean when applied to such a subject as skilled mechanics would know, and, as the tribunal has now, by the admission of evidence or otherwise, put itself in a position to understand, and then to say, what the words of the specification mean when applied to such a subject-matter" (i).

A specification, like any other document, is to be construed according to the ordinary and proper meaning of the language used (k). "In construing the specification, we must construe it like all written documents, taking the words and seeing what is the meaning of those words when applied to the subject-matter" (l).

CLAIM.

Claiming
clause.

A complete specification "must end with a distinct statement of the invention claimed." This provision is new. Previously a "claim has not been essential to a specification" (m), and "you may have a perfectly good specification without the word 'claim' or the thing claim in it at all" (n).

"Nevertheless a claiming clause is commonly inserted at the end of a patent, and that is of immense importance in enabling us to construe the specification, and to see, looking at the whole specification, whether a thing is included in it or not" (o). "The real object of what is called a claim, which is now more commonly put in than it used to be formerly, is not to claim anything which is not mentioned in the specification, but to disclaim something. A

(i) Last note. Compare *Neilson v. Harford*, 8 M. & W. 803; 8 Web. P. C. 331; *Heath v. Unwin*, 2 Web. P. C. 236, 245; *Foxwell v. Bostock*, 84 D. G. & S. 298, 10 L. T. 144.

(k) *Elliott v. Turner*, 2 C. B. 446; 15 L. J. C. P. 49; *Simpson v. Holliday*, 13 W. R. 578, per Westbury, L.C.

(l) Per Lord Blackburn in *Clark v. Adie*, No. 2, 2 App. Cas., 423, 436.

(m) *Lister v. Leather*, 8 E. & B. 1034; 27 L. J. Q. B. 295.

(n) Per Lord Blackburn in *Dudgeon v. Thomson*, 3 App. Cas. 54.

(o) *Ibid.*

man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use—he describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says: ‘But take notice, I do not claim the whole of that machine, I do not claim the whole of that *modus operandi*, but that which is new, and that which I claim, is that which I am about to state.’ That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification” (p).

What construction will be given to the express enactment that there must be in future a claiming clause—“a distinct statement of the invention claimed”—cannot be predicated in advance. It is suggested as a first rule that the claim will be read with reasonable strictness. The patentee is now directed to formulate in distinct terms what it is he has invented, and there can be no hardship in requiring that the language used by him shall be clear and explicit, and his rights and privileges in respect of his invention be limited by, if co-extensive with, what he himself states to be his discovery. There is full power to amend (q) in the event of a specification being, whether in the body or claim, too extensive or vague.

It is suggested, in the next place, that in cases of ambiguity and the like, the claim must be read with, and interpreted by reference to, the whole of the specification taken together. This has hitherto been the rule. “You must always construe a claim with reference to the whole context of a specification” (r).

DRAWINGS.

Hitherto drawings have not been required as an essential in any case, but now, “if required,” they must accompany the specification, whether provisional or complete.

What is the precise function and importance of drawings is not fully settled. It would seem, however, that drawings will be

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Specifications.

Claiming
clause.

(p) *Per James, L.J., in Plimpton v. Spiller, 6 Ch. D. C. A. 426. Per Jessel, M.R., in Hinks v. Safety Lighting Co., 4 Ch. D. 607, 612.*

(q) Sect. 18.

(r) *Per James, L.J., in Plimpton v. Spiller, 6 Ch. D. C. A. 412, 427. Compare per Fry, J., in United Telephone Co. v. Harrison, 21 Ch. D. 720, 737-8.*

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SS. 6, 7.**

allowed to explain an ambiguity in the specification (s), or to correct and limit a specification which would otherwise be too vague and general (t), and further, that drawings, when employed, are so far an essential part of the specification, that in construing it they must be looked at and considered, so that, if they shew, and apparently claim, appliances which are old, the patent, by reason thereof, will, or at least may, be rendered void (u).

Reference
of applica-
tion to
examiner.

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller 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 the title sufficiently indicates the subject-matter of the invention.

See Patent Rules, 5, 10, 27-30.

For definition of "comptroller," see sect. 82.

This section and sections 7 and 9, containing the necessary incidental and supplemental provisions, are new, and introduce a new procedure of great practical importance.

The "Examiners" are to be appointed by the Board of Trade (section 83).

Power for
comp-
troller to
refuse
application
or require
amend-
ment.

7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.

(2.) Where the comptroller requires an amendment,

(s) *Hastings v. Brown*, 1 E. & B. 450, 454; see *Clark v. Adie*, No. 1, 2 App. Cas. 315.

(t) *Daw v. Eley*, L.R. 3 Eq. 500, n.
(u) *Hinks v. Safety Lighting Co.*, 4 Ch. D. 607.

the applicant may appeal from his decision to the law officer (*a*).

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(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the application shall be accepted.

(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant (*β*).

(5.) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

Applica-
tion for
patent.

(6.) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so, he may refuse to seal a patent on the application of the second applicant (*γ*).

(*a*) Law Officers Rules, *post*.

(*β*) Patent Rules, 25.

(*γ*) *Ibid.* 13, 15.

For definition of "law officer," see sect. 117.

An appeal from the comptroller to the law officer in case of decisions by him is provided by the following sections: viz., sect. 7 sub-sect. 6, sect. 9, sub-sect. 2, sect. 11, and sect. 18, sub-sects. 3, 6. But there are no general provisions as to appeals from the comptroller in other cases.

Appeals
from
the comp-
troller.

The law officer is, if required on appeal from the comptroller, to hear the applicant and the comptroller, and no doubt they will be allowed to appear personally, or by solicitor or counsel.

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SS. 7, 8.

Applica-
tion for
patent.

As to the practice and procedure on appeals to the law officers, see the rules issued by them, *post*.

The effect of the concluding sentence of sub-sect. 6 is not quite clear, but apparently it implies that in every case of rival applications for a patent for the same invention, the grant of letters patent is to be made to the applicant first in date, subject of course to the provisions contained in sect. 11 of this Act (*x*).

It will be observed, however, that the provision is that the comptroller "may," not "shall," refuse to seal a patent on the application of the second applicant.

Amend-
ments.

The Master of the Rolls, as keeper of the records, had jurisdiction to direct the amendment of a clerical error in a specification (*y*). It would appear that this jurisdiction remains unaltered (*yy*).

By sect. 91 the comptroller is empowered on request to correct clerical errors in connection with applications for a patent, or in the name, style, or address of any registered proprietor of a patent. It is submitted that as well by virtue of this section as from the general authority which the comptroller necessarily has with respect to applications for patents, he has authority (a) to allow clerical and other similar amendments of any kind (not being of substance) in a specification provisional or complete, at least so long as letters patent have not actually been granted, and (b) by virtue of sect. 9, sub-sect. 2, to direct or allow all such amendments as may be necessary to bring the complete specification into accordance with the provisional specification.

Whether the comptroller can (a), even prior to the grant of letters patent, allow material amendments in specifications (except to the extent provided for by sect. 9, sub-sect. 2), or (b) after the grant of letters patent can (except to the extent allowed by sect. 91) permit clerical or other similar amendments, *quare*.

Time for
leaving
complete
specifica-
tion.

8. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

(*x*) Compare the cases cited, *ante*, pp. 4 and 5.

(*y*) *Johnson's Patent*, 5 Ch. D. 503.
(*yy*) *Garc's Patent*, 26 Ch. D. 105.

“Month” is, by 13 & 14 Vict. c. 21, s. 4, “calendar month.”

This section does not provide that the application shall become void if a complete specification be not left within nine months after the application, but only that in such case the application “shall be deemed to be abandoned.” This would seem to imply that the comptroller is at liberty to accept a complete specification if left after the nine months and before the expiration of twelve months, when the application will become void (z).

The publication of a provisional specification which is subsequently abandoned (a), or which is followed by a complete specification, omitting a part of the invention described in the provisional specification (b), is not necessarily such a publication as to invalidate a patent subsequently obtained relating to the same matter—whether this is so or not will depend upon the amount of information given by the provisional specification.

9. (1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification 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.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining

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SS. 8, 9.**

**Time for
leaving
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parison of
provi-
sional and
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specifica-
tion.**

(z) Sect. 9, sub-s. 4. Compare *Re Hersee & Smyth*, L. R. 1 Ch. 518, *Somersel and Walker's Patent*, 13 Ch. D. 397; *Johnson's Patent*,

13 Ch. D. 398, n.

(a) *Ozley v. Holden*, 8 C. B. N. S. 666.

(b) *Stoner v. Todd*, 4 Ch. D. 58.

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whether, and subject to what conditions, if any, the complete specification shall be accepted.

SS. 9-11.

**Complete
specifica-
tion.**

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, other than an appeal to the law officer under this Act, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

For the extent of which a complete specification may vary from the provisional specification, see *ante*, p. 9.

It is submitted that the decision whether of the comptroller or of the law officer is in no manner conclusive or binding as to the validity of a patent, but that notwithstanding such decision any defence is open to a defendant in an action for infringement.

**Advertise-
ment on
acceptance
of com-
plete spe-
cification.**

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings, if any, shall be open to public inspection.

Patent Rules, 25, 26.

**Opposition
to grant of
patent.**

11. (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 of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground.

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to grant of
patent.**

(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.

Patent Rules, 32-41.

Law Officers Rules, *post*.

Compare sect. 18 (4), and sect. 38, *post*.

OBJECTIONS TO GRANT.

The objections which may be made to the grant of a patent are of two kinds: first, objections to the grant of the patent to the particular applicant; and, secondly, objections going to the validity of the patent itself, if and when granted, and therefore to the grant of any patent at all—these latter objections being based on the

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to grant of
patent.

existence of a prior patent or prior specification relating to the same invention.

(1.) The first objection is "on the ground that the applicant obtained the invention from" the person objecting.

This provision read strictly would apply only when the invention, that is substantially the whole secret or discovery, has been obtained by the applicant from the person opposing. This would be both a reasonable and a politic construction. Any wider interpretation will almost certainly lead to numerous unfounded claims. As the law is at present it seems quite clear that a person obtaining hints or suggestions from another, for instance, an agent of an inventor receiving a confidential communication not in a practically useful state, may improve on such hints or suggestions, or such crude communication, and take out for his own benefit a patent in respect of the idea carried into practical effect (c).

Agents.

Persons employed by others who make discoveries while in such employ are entitled to the benefit thereof, and this objection will enable such persons easily to maintain and enforce their rights as against their employers or others attempting to take out patents in respect of the discoveries so made (d).

This provision will, no doubt, provide a satisfactory means for determining to whom a patent ought to be granted when an objector alleges that the applicant obtained the invention from him by fraud or other improper conduct (e); or that the application is under the circumstances a breach of faith or otherwise unfair (f).

Legal
personal
repre-
sentatives.

(2.) The second ground of objection is that the applicant obtained the invention from a person of whom the objector is the legal personal representative.

This taken in connection with sect. 34 introduces new rights—previously the representatives of a deceased person could not take out a patent if their ancestor had not made an application (g).

The other two objections which may be set up against the grant of a patent are—

(3.) That the invention has been already patented on an application of prior date.

(c) *Milligan v. Marsh*, 2 Jur. N. S. 1083; compare *per Tindal, C.J.*, in *Allen v. Rawson*, 1 C. B. 551, 574.

(d) See *Bloxam v. Elsee*, 1 Car. & P. 558; *Russell's Patent*, 2 D. &

J. 130; *Ex p. Scott and Young*, L. R. 6 Ch. 274.

(e) See *Lowe's Patent*, 25 L. J. Ch. 454; *Ex p. Bailey*, L. R. 8 Ch. 60.

(f) *Daines' Patent*, 26 L. J. Ch. 298.

(g) See *ante*, p. 4, note (h).

(4.) That the examiner has reported the pendency of a specification accompanying a previous application bearing the same or a similar title, and appearing to relate to the same invention.

From the objections being so specified it seems necessarily to follow that no objection can now be raised to the grant of a patent on the ground of want of utility, that the manufacture is not new, prior public user, and the like.

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to grant of
patent.**

PRACTICE ON OBJECTION TO GRANT.

The notice of opposition must be given within two months of the advertisements, but probably in a proper case this time would be, if necessary, extended on terms (*h*).

Time.

The comptroller is himself to hear the matter in the first instance. From his decision either party may appeal to the law officer.

**Hearing of
objection.**

It is submitted that the whole case ought to be raised, and all the grounds of objection clearly stated, before the comptroller, and that the parties will not, except under very special circumstances, be allowed to raise a new case or go into new facts before the law officer (*i*).

Prior to the present Act it has been held that a party who did not oppose the sealing of a patent before the law officer could not oppose before the Lord Chancellor (*k*), and it would seem both on principle and from the precise language of the section now in consideration, that persons desirous to oppose before the law officer must previously have opposed before the comptroller.

There appears to be no provision empowering the comptroller to award costs in respect of opposition heard by him (*l*), but the law officers may, by sect. 38, order costs in respect of applications heard by them.

Costs.

The cases which have hitherto been decided on costs in connection with opposition to grant of letters patent, cannot be said to have laid down any clear principle as to awarding or refusing costs, though generally,—(a) where the petition for grant is dismissed

(*h*) See *Brennand's Patent*, 7 Jur. N. S. 690; 4 L. T. N. S. 456.

(*i*) *Vincent's Patent*, L. R. 2 Ch. 341.

(*k*) *Mitchell's Patent*, L. R. 2 Ch. 343.

(*l*) Whether there is any original jurisdiction in such cases to give costs, *quære*—see *Cutler's Patent*, 4 My. & Cr. 510; *Kynoch v. National Arms Co.*, 26 W. R. 22.

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SS. 11,
12.
Evidence.

the dismissal is with costs (*m*); (b) where the opposition is unreasonable and fails, the parties have to pay the petitioner's costs (*n*); and (c) the tendency now is to make the costs depend on the event, and therefore to order the opposition which fails, even if it was reasonable, to pay costs (special circumstances apart) (*o*).

The evidence is to be in the first instance by statutory declarations (Patents Rules, 35, 36). But power is given to the law officers to examine witnesses on oath (sect. 38), and it is presumed that, when justice requires it, *viva voce* evidence will, notwithstanding the rules, be received (*p*).

Sealing of
patent.

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

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases herein-after mentioned, that is to say—

(a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b.) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal repre-

(*m*) *Adamson's Patent*, 6 D. G. M. & G. 420; *Ex p. Yates*, L. R. 5 Ch. 1; *Ex p. Henry*, L. R. 8 Ch. 167. Except where it was a case of first impression, *Ex p. Bates & Redgate*, L. R. 4 Ch. 577; or hardship,

Lowe's Patent, 25 L. J. Ch. 454.

(*n*) *Cutler's Patent*, 4 My. & Cr. 510.

(*o*) See *Re Harrison*, L. R. 9 Ch. 631; *Re Gething*, *ib.* 633.

(*p*) See *Re Gething*, *ubi supra*.

sentative and sealed at any time within twelve months after the death of the applicant.

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**SS. 12,
13.**

Where delay had occurred in sealing a patent by reason of opposition, it was held that at whatever stage the opposition occurred the Lord Chancellor had power to extend the time for sealing the patent (*q*).

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

**Date of
patent.**

Compare sects. 5, 10, 15.

It is presumed that "publication of the complete specification," means the advertisement of the acceptance thereof directed by sect. 10.

Where two patents were applied for on the 20th and 23rd of July respectively, and each patent was sealed and dated as of the day of application, but the patent applied for on the 23rd of July was in fact sealed before that applied for on the 20th of July, it was held that acts done under the patent applied for on the 23rd of July were infringements of the other patent (*r*).

**Concurrent
applica-
tions.**

This section provides that the sealing of one patent shall not in future prevent the sealing of another patent for the same invention on an earlier application (*s*); but it does not confer on the earlier applicant an absolute right to have a patent granted to him if he shall have been guilty of delay, negligence, or other improper conduct.

(*q*) *Somerset and Walker's Patent*, 13 Ch. D. 397.

(*r*) *Saxby v. Hennett*, L. R. 8 Ex. 210. See *Dering's Patent*, 13 Ch. D. 393, as to two patents applied for on

the same day.

(*s*) Compare *Manceaux's Patent*, 18 W. R. 1184; *Ex p. Bates and Redgate*, L. R. 4 Ch. 577; and the cases cited, *ante*, pp. 4 and 5.

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S. 14.

Provi-
sional pro-
tection.*Provisional Protection.*

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

See sects. 5, 7, sub-sects. (3), and (4), 10.
Compare 15 & 16 Vict. c. 83, s. 8.

What is meant by the "acceptance" of an "application for a patent," is not quite clear. Probably, however, this refers to sub-sects. 3 and 4 of sect. 7. If so provisional protection dates, it is presumed, from the date when the comptroller notifies to an applicant that his application is in proper form.

As either a provisional or a complete specification, or both, may be left with the application, this section may have a somewhat different effect according as the one or the other is left.

Applica-
tion aban-
doned.

What will be the effect if an application be abandoned and a new application be made in respect of the same invention? In a case of this kind it was held that there had not been a dedication to the public by the abandonment of the first provisional specification, and that consequently a patent granted on the provisional specification subsequently filed was valid (*t*).

Effect of
provisional
protection.

This section is substantially the same as sect. 8 of the Patent Law Amendment Act, 1852, and Lord Hatherley thus stated the effect of provisional protection as conferred by that section—the person leaving the provisional specification "may use his invention for six months without prejudice to his patent by that user, but he obtains no rights against the public until his patent has been sealed, and even then the patent will not relate back to acts done in the interval. He is only protected against the consequences of his own publication, and thus may employ workmen and obtain machinery without the risk of being betrayed. But that is all, and he has no right or privilege against any other person. If he wishes to have more, he may, under sect. 9, file a complete specifi-

(*t*) *Oxley v. Holden*, 8 C. B. N. S. 666; 30 L. J. C. P. 68.

cation, and then he is absolutely protected for six months, and has a right to proceed as if he had a patent for that period" (u).

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SS. 14-17.

Protection by Complete Specification.

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

Effect of acceptance of complete specification.

See sect. 9, sub-sects. (2) and (3), 10, 13, 18; and as to infringement, sects. 17, sub-sect. (4), 28, 29, 30, 31.

It has been held under the former statutes that the filing of a complete specification does not prevent another person who had previously applied for a patent for a similar invention from obtaining a patent (x), and it is presumed that the decision will be the same in the event of a similar question arising under this section.

Patent.

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

Extent of patent.

See sect. 36.

Hitherto the Channel Islands have been included, but will in future be excluded.

17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date (y).

Term of patent.

(u) *Ex p. Bates and Redgate*, L. R. 4 Ch. 577, 578. (x) *Ex p. Henry*, L. R. 8 Ch. 167. See now section 13, ante.

(y) See *Russell v. Ledam*, 14 M. & W. 574.

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S. 17.

**Term of
patent.**

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

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

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

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

(b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

(a) Patent Rules, 18, 46, 47.

See sect. 25, as to extension, and sect. 24, as to fees.

**Foreign
patents.**

The Act of 1852 provided (sect. 25) that if letters patent are granted in the United Kingdom for or in respect of any invention first invented, and a patent for which is first granted in or by a foreign country, such letters patent should *ipso facto* determine with the expiration of the foreign patent. This section was construed strictly and held not only to determine the English patent with the expiration of the foreign one, but also to prevent the

Privy Council from granting in such cases any extension or renewal of the English patent (z).

No provision analogous to this is contained in the present statute, and it is therefore submitted that the expiration of a foreign patent will not in any manner in future affect an English patent relating to the same invention, or the right of the patentee to obtain an extension thereof—except only if and so far as by the joint effect of sects. 45 and 113, existing English patents may still remain subject to the provisions of this section (zz).

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Amendment of Specification.

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

Amend-
ment of
specifica-
tion.

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

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

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice and being in the opinion of the law officer entitled to be

(z) *Betts' Patent*, 1 Moo. P. C. C. N. S. 49; 9 Jur. N. S. 137; *Hill's Patent*, 1 Moo. P. C. C. N. S. 258; 9 Jur. N. S. 1209; *Poole's Patent*, L. R. 1 P. C. 514; *Winan's Patent*, L. R. 4 P. C. 93; *Johnson's Patent*,

L. R. 4 P. C. 75; *Blake's Patent*, L. R. 4 P. C. 535.

(zz) See *Nordenfelt v. Gardner*, O. J. Rep. vol. i. 10, and cases cited under sections 45 and 113, *post*.

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ment of
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tion.

heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

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

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

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

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

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

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

(α) Patent Rules, 48-56.

(β) Ibid. 47.

(γ) Ibid. 51.

CLERICAL AMENDMENTS.

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Jurisdiction of
M.R.

The Master of the Rolls had an original jurisdiction as Keeper of the Rolls, to allow clerical and other similar amendments arising from mistake or inadvertence, whether occurring in the specification or in the enrolment of the patent. (a) Thus, where "October" was engraved for "November," and "Charles" for "George" (b); where the word "wire" was substituted for "fire" in the original specification, and the mistake was not discovered for five years (c); where numbers by which in a specification reference was made to a plan were transposed (d), and where "recovering" had been written for "covering" (e), the necessary clerical alterations were permitted.

It would appear that this jurisdiction of the Master of the Rolls still remains (ee).

An application to amend even clerical errors may, however, be refused as being out of time (f).

By section 91 the comptroller may correct clerical errors (a) in or in connection with, any application for a patent, or (b) in the name, style, or address of a registered proprietor.

Power of
comp-
troller.

In any case, amendments of this kind and *à fortiori* amendments as to matters of real importance, if and when allowed, may be allowed only upon terms.

Where a patentee was a day too late in enrolling his patent, and the mistake occurred through the fault of his clerk, it was ordered that the enrolment should be amended (g).

Enrol-
ment.

The Master of the Rolls may also, in virtue of his general jurisdiction over the Records, order a disclaimer improperly filed to be taken off the file (h).

Dis-
claimer.

But the Master of the Rolls can amend only the enrolment of a patent, he cannot amend the letters patent themselves—the Lord Chancellor alone can do so (i), and it need scarcely be said that

Letters
patent.

(a) See as to the extent of the jurisdiction of the M. R. in such matters, *Sharp's Patent*, 3 Beav. 245.

1 Phill. C. C. 36; 1 Web. P. C. 650.

(ee) *Gare's Patent*, 26 Ch. D. 105.

(f) *Blamoud's Patent*, 3 L. T.

N. S. 800.

(g) *Adam's Patent*, 21 L. T. 38.

See, however, *Ex p. Beck*, 1 Br. C. C. 578.

(h) *Berdan's Patent*, L. R. 20 Eq.

346.

(i) See 1 Phill. C. C. 44-48;

1 Web. P. C. 660-63.

(b) *Rubery's Patent*, 1 Web. P. C. 649, n.; *Dismore's Patent*, 18 Beav. 538.

(c) *Whitehouse's Patent*, 1 Web. P. C. 649, n.

(d) *Redmund's Patent*, 5 Russ. 44; 1 Web. P. C. 649.

(e) *Nickels' Patent*, 4 Beav. 563;

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this will be done only under special circumstances and as to merely clerical errors and the like.

MATERIAL AMENDMENTS.

**Amend-
ment of
specifica-
tion.**

If amendments are required in matters of substance, this can only be done in the manner and to the extent expressly enacted by this section (*k*).

**Who can
amend.**

As a "patentee" may have leave to amend, it follows that an amendment may be allowed even after grant of letters patent.

**Specifica-
tion.**

Amendments may evidently be permitted in either the provisional or the complete specification, and they may be made either in the body of the specification or in the drawings forming part of it (*l*).

Drawings.

Conditions.

Conditions may be imposed in allowing amendments—(a) when there is no opposition, by the comptroller (sub-section 5), or by the law officer on appeal from him (sub-section 7); and (b) in case of opposition, by the law officer (*m*).

A material amendment now may be by way of

- (1.) Disclaimer,
- (2.) Correction, or
- (3.) Explanation.

**What
amend-
ments
allowed.**

There is no definition or description of these terms, or any indication as to the exact extent to which, or the limits within which, amendments will be allowed, other than the provision in sub-section 8 of this section.

There can be little doubt, however, that amendments will not be

(*k*) See *Sharp's Patent*, 3 Beav. 245.

(*l*) The provisions contained in 5 & 6 Will. 4, c. 83, s. 1, as to the nature of material alterations which will be allowed, were, that the grantee or assignee might (with the leave of the law officer mentioned) enter "a disclaimer of any part either of the title of the invention or of the specification, stating the reason for such disclaimer, or . . . enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the ex-

clusive right granted by the said letters patent."

(*m*) Under the former Statutes conditions were frequently imposed in allowing disclaimers and other amendments, e.g., not to commence or prosecute infringements in respect of prior infringements: see *Nickel's Patent*, *ubi supra*; *Medlock's Patent*, Newton's London Journal, N. S., vol. 22, p. 69; *Tranter's Patent* and *Jones' Patent*, reported in Johnson's "Patentees Manual," 4th ed. p. 182; *Smith's Patent* and *Lucas' Patent*, Macr. Pat. Cas. 232, 234.

allowed for the purpose of "bolstering up" a patent, so as to render that which previously was not a patent good and valid, or which would enlarge the scope or extent of the inventor (*n*). The alterations hitherto allowed by way of disclaimer have been the removal of portions of the specification which rendered the invention an infringement of prior patents. "It is proper that patentees should be allowed to correct errors in their patents by removing from the specifications parts which are not material or substantial, or which they have since discovered not to be new inventions" (*o*).

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**Amend-
ment of
specifica-
tion.**

And sub-section 8 expressly enacts that amendments are not to be allowed which would make the invention "substantially larger than or different from the invention" prior to amendment (*p*).

**Amend-
ment of
specifica-
tion.**

Under the statute 5 & 6 Will. 4, c. 83, it was held that the proper person to enter a disclaimer was the original grantee of the letters patent (*q*), even though he had entirely parted with his interest. It might seem that as the present section speaks only of an "applicant" and a "patentee," in future only the applicant for, or grantee of, letters patent can be the person to formally seek and have leave to amend. Sect. 46, however, gives a wide meaning to the word "patentee."

As to the operation and construction of a disclaimer, it has been decided—

**1. Dis-
claimer.**

(1.) That it has not a retrospective effect: that "from the time of the entry of the disclaimer it shall be taken to be incorporated with the letters patent and specification so as to effect all acts done after that period, but that it shall not have the effect of making parties wrongdoers by relation" (*r*).

(2.) That if a suit be pending at the time of filing a disclaimer, the plaintiff cannot avail himself of it by amending, but must commence a new action (*s*); and so, also, after a disclaimer a plaintiff cannot (usually if at all) enforce against infringers an injunction already obtained by him in an action on the original unaltered specification (*t*).

(*n*) See *per Westbury, L.C.*, in *Foxwell v. Bostock*, 4 D. G. J. & S. 306; *Ralston v. Smith*, 11 H. L. C. 223.

(*o*) *Reg. v. Mill*, 14 Beav. 312.

(*p*) See cases in last two notes.

(*q*) *Spilsbury v. Clough*, 2 Q. B. 466; 1 Web. P. C. 255. Compare *Wallington v. Dale*, 7 Ex. 888.

(*r*) *Stocker v. Waller*, 9 Jur. 136; *Perry v. Skinner*, 2 M. & W. 471. See, however, *Reg. v. Mill*, 10 C. B. 379; 20 L. J. C. P. 16.

(*s*) *Lister v. Leather*, 3 Jur. N. S. 433. See now section 19.

(*t*) *Dudgeon v. Thomson*, 3 App. Cas. 34.

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

(3.) That the disclaimer, when made, becomes part of the patent and specification, so that henceforth the patentee becomes patentee of the undisclaimed part only (*u*).

(4.) "The reason for a disclaimer is no part of the disclaimer itself. The operative part of the disclaimer begins in this way, 'I for this reason wish to disclaim, and do hereby disclaim'" (*x*). It is consequently the language of the operative part of the disclaimer which must be considered, and when this is clear it is not to be controlled by the introductory sentences, if any.

(5.) That a disclaimer may be entered after verdict or judgment adverse to the validity of a patent.

As to amendment by way of "correction" or "explanation," it is presumed that the general principles hitherto applicable to amendments of specifications will apply in future, namely, that a patentee will be permitted to make such, and only such, amendments as be reasonably necessary to "correct" errors or inconsistent statements, or to "explain" ambiguities in his specification.

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

Patent Rules, 56.

See sects. 17, sub-s. (4), 29 and 30.

One case has already been reported (*yy*) under this section, and it was there held (*a*) that the section applies to actions commenced before the Act came into operation; and (*b*) that the leave ought to be granted to the plaintiff to apply to amend by disclaimer only

(*u*) *Clark v. Kenrick*, 12 M. & W. 219.

(*x*) *Per* Lord Westbury in *Cunnington v. Nuttall*, L. R. 5 H. L. 205.

(*y*) See *Lister v. Leather*, 3 Jur. N. S. 433; *Dudgeon v. Thomson*, 3

App. Cas. 34.

(*yy*) *Winter v. Baybut, Madeley, & Co.*, O. J. Rep. vol. i. 76, which case also decided that "judge" used in this section includes the Vice-Chancellor of the County Palatine of Lancaster.

upon the terms of the plaintiff paying to the defendants the taxed costs of the action up to and including the motion for leave to apply; and (c) that proceedings in the action should be stayed pending the application to the Patent Office.

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II.**

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**SS. 19-
22.**

**Restric-
tion on re-
covery of
damages.**

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

The provision in the latter part of this section by implication authorises the giving of damages in the cases and subject to the conditions mentioned.

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

**Advertise-
ment of
amend-
ment.**

Patent Rules, 56.

Compulsory Licenses.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

**Power for
Board to
order
grant of
licenses.**

(a.) The patent is not being worked in the United Kingdom; or

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

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

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for

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II.
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—
SS. 22,
23.
—

payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Patent Rules, 57-63.

Man-
damus.

An application for an ordinary mandamus may be made to any branch of the High Court (z).

Register of Patents.

Register
of patents.

23. (1.) 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 licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed (a).

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

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

(a) Patent Rules, 64-76.

Compare 15 & 16 Vict. c. 83, sects. 35-38.

The provisions in this section differ from the corresponding provisions in the Patent Law Amendment Act, 1852, in not containing the provisions expressly contained in that Act, that until registra-

(z) *Re Paris Skating Rink Co.*, 6 Ch. D. 731.

tion of any assignment, the original patentee was to be deemed exclusive proprietor of the patent (a).

Quære, whether any entries of matters which merely affect provisional specifications will be allowed.

Sect. 85 provides that no notice of any trust expressed, implied, or constructive, shall be entered on any register, or be receivable by the comptroller.

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II.**

PATENTS.

**SS. 23
25.**

Fees.

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

**Fees in
schedule.**

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

(a) Patent Rules, 42-45.

Extension of Term of Patent.

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

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

(2.) Any person may enter a caveat addressed to the Registrar of the Council at the Council Office, against the extension.

(a) *Chollet v. Hoffman*, 7 E. & B. 386; 26 L. J. Q. B. 249.

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Extension
of term of
patent.

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

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

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

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

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

Rules of the Judicial Committee, *post*.

See sect. 28, sub-sect. 2, as to calling of an assessor.

The previous statutory provisions as to extension were contained in 5 & 6 Will. 4, c. 83, s. 4; 2 & 3 Vict. c. 67; and 7 & 8 Vict. c. 69.

The right to have an extension of letters patent depends mainly and primarily upon the question of remuneration—"if the Judicial Committee report that the patentee has been inadequately remunerated by his patent," the term may be extended. By sub-sect. 4, however, the Committee are to take into account not only the merits of the invention, but all the circumstances of the case.

The present statute has made no alteration as regards the amount of information to be furnished to the Privy Council by applicants for extensions, or the amount of profits to be taken into account (*aa*).

REASONS FOR GRANT OF EXTENSION.

I.—Utility.

The invention must be meritorious, but the ingenuity displayed by the inventor in making the discovery is not the sole, or even the most important element in determining whether or not the term of letters patent shall be extended or renewed. The benefit to the public is the first and most important factor (*b*). Consequently the skill exhibited in putting an invention into practical operation, and enabling the practical working of it to be carried on, will be considered by the Privy Council (*c*). Simplicity, also, is an ingredient for consideration (*d*).

The utility or otherwise of an invention must be proved by evidence in the ordinary way. But it is a presumption against the usefulness of an invention that it has become generally known but has been little used (*e*). This is a presumption against utility more or less cogent according to the circumstances, but not conclusive and capable of being rebutted by proof positive of utility, and explaining why the invention has been little used (*f*).

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**Extension
of term of
Patent.**

**Invention
must be
useful.**

Evidence.

(*aa*) *Newton's Patents*, "Times," 9th July, 1884.

(*b*) *Re Derosne's Patent*, 4 Moo. P. C. C. 416; 2 Web. P. C. 1.

(*c*) *Betts' Patent*, 1 Moo. P. C. C. 49.

(*d*) *Muntz's Patent*, 2 Web. P. C. 113.

(*e*) See *per* Lord Chelmsford,

Bakewell's Patent, 15 Moo. P. C. C. 385; and compare *Simister's Patent*,

4 Moo. P. C. C. 164; 1 Web. P. C. 721; *Herbert's Patent*, L. R. 1 P. C.

399; *Allan's Patent*, L. R. 1 P. C. 507; *Hughes' Patent*, 4 App. Cas.

174.

(*f*) Cases in last note.

PART
II.II.—*Remuneration of the Inventor.*

PATENTS.

S. 25.

Extension
of term of
Patent.Remunera-
tion.

Amount.

The main object in granting extensions is to secure that the inventor shall be properly remunerated for his own skill, trouble, and expenses. If he has been so remunerated the application will be refused—if he has not been so, then in the case of a really useful invention the rule is to grant an extension (unless, indeed, the applicant's conduct has disentitled him) for a longer or shorter term, according to the circumstances, and subject it may be to conditions and restrictions.

It is impossible to lay down any definite rules as to what will be sufficient remuneration. Lord Brougham thus expressed himself in a judgment (*g*): "We cannot weigh in golden scales the proportion between manufacturers' profit and patentees', but we must take it in the gross; and applying our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing nor in his favour straining—we must ascertain whether he has, in the eyes of men of ordinary but enlightened understanding, judging fairly between him and the public, had a sufficient remuneration."

Everything depends upon the nature of the invention as to which an extension of the term is sought, and the circumstances of the particular application. In one case—improvements in apparatus in connection with steam-engines for condensing steam described as "of the greatest value, the testimony is unanimous on that subject"—£7000 profits was held insufficient remuneration, and therefore an extension was granted (*h*); whereas in another case £2835 was held to have been sufficient remuneration (*i*).

Accounts.

The accounts presented to the Privy Council should be full and clear, and give all information necessary for enabling a correct judgment to be formed as to what have been gross profits, and what are the various charges which the applicant proposes to set off against these.

If the accounts are not so complete and satisfactory, this may

(*g*) *Muntz's Patent*, 2 Web. P. C. 113, 120.

(*h*) *Poole's Patent*, L. R. 1 P. C. 514. Compare the following cases where the profits made by the patentee were deemed insufficient;

Downton's Patent, 1 Web. P. C. 565; *Perkins' Patent*, 2 Web. P. C.

6; *Carr's Patent*, L. R. 4 P. C. 539.

(*i*) *McInnes' Patent*, L. R. 2 P. C. 51.

alone "be fatal to the application" (*k*)—it is for the petitioner to present "his accounts in such a manner as to enable [the Privy Council] to pronounce that the petitioner has not received sufficient remuneration" (*l*). The Privy Council may, however, in their discretion direct or allow further and better accounts to be produced, and the application to stand over meanwhile (*m*). And they have recommended an extension, subject to a proper account duly verified, being produced to the Attorney-General (*n*).

The patentee should, indeed, from the commencement of his business or dealings, in connection with the patent, keep separate accounts relating thereto. "There can be no difficulty in a patentee beginning from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. He knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original term of his patent. It is not, therefore, so much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent" (*o*).

In estimating profits a patentee may make deductions in respect of the following matters:—experiments (*p*); manufacturer's profits in cases where he himself manufactures the subject of the invention (*q*); expense of litigation properly incurred (*r*); commission on sales (*s*); a reasonable allowance for his own personal skill and supervision where this is necessary (*t*), and in special cases for loss of time in bringing the invention before the public (*u*).

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**Extension
of term of
Patent.**

**Amend-
ment of
accounts.**

**Keeping
accounts.**

**Profits—
Deductions
which
may be
made.**

(*k*) *Trotman's Patent*, L. R. 1 P. C. 118, 124. Compare *Adair's Patent*, 6 App. Cas. 176, 179.

(*l*) *Clark's Patent*, L. R. 3 P. C. 421, 426.

(*m*) *Wield's Patent*, L. R. 4 P. C. 89.

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

(*o*) Per Lord Chelmsford, in *Bett's Patent*, 1 Moo. P. C. C. N. S. 61, cited and approved in 6 App. Cas. 179.

(*p*) *Kay's Patent*, 1 Web. P. C. 568.

(*q*) *Betts' Patent*, 1 Moo. P. C. C. N. S. 49; *Hill's Patent*, 1 Moo. P. C. C. N. S. 258. These profits will, however, be taken into consideration in estimating the amount of the remuneration: *Saxby's Patent*, L. R. 3 P. C. 292.

(*r*) Cases in last two notes.

(*s*) *Perkins' Patent*, 2 Web. P. C. 6. Compare *Poole's Patent*, L. R. 1 P. C. 514.

(*t*) *Carr's Patent*, L. R. 4 P. C. 539.

(*u*) *Newton's Patent*, 14 Moo. P. C. C. 156.

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S. 25.**

**Extension
of term of
Patent.**

**Validity of
Patent.**

On the other hand the following matters must be brought into account as parts of the profits:—profits arising from sales for exportation (*x*); royalties and other receipts in respect of licences (*y*); advantages derived by the patentee from commanding orders as a manufacturer (*z*); profits derived from foreign patents (*z z*).

It may be mentioned here that though on applications for extension the Privy Council on the one hand will not investigate the validity, or otherwise, of an invention, yet, on the other hand, if it clearly appears that the patent sought to be extended is void for want of novelty, or otherwise, the Privy Council will dismiss the application (*a*).

III.—Reasons special to the Applicant.

In a sense all the reasons which the Privy Council take into consideration mainly relate to the applicant himself. “The grounds upon which their Lordships grant extensions of patents have reference to the inventor himself. They are in the first place to reward the inventor for the peculiar ability and industry he has exercised in making the discovery; in the second place to reward him because some great benefit of an unusual description has by him been conferred upon the public through the invention itself; or, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed upon the supposition that the invention is a new and useful invention” (*b*).

**Applicant
not the
original
patentee.**

But in addition as the chief object in granting extensions is to secure that there shall be a sufficient remuneration for the invention of which the public gets the benefit, there is always greater favour shown—or rather there is a tendency to show greater favour—to an applicant for an extension who is himself the inventor than to one whose interest is derived by assignment from the inventor. It is fully settled that an extension may be granted to an assignee whether a private individual, or a company, or

(*x*) *Hardy's Patent*, 6 Moo. P. C. C. 441; *Galloway's Patent*, 1 Web. P. C. 729.

(*y*) *Trotman's Patent*, L. R. 1 P. C. 118.

(*z*) *Johnson's Patent*, L. R. 4 P. C. 75, 82; *Sazby's Patent*, L. R. 3 P. C. 292.

(*z z*) *Newton's Patent*, “*Times*,” 9th July, 1884.

(*a*) *Beats' Patent*, 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; *Hill's Patent*, 1 Moo. P. C. C. N. S. 258; *Sazby's Patent*, *ubi supra*; *McDougal's Patent*, L. R. 2 P. C. 1.

(*b*) *Norton's Patent*, 1 Moo. P. C. N. S. 339, 343; 9 Jur. N. S. 419.

trustees for a third party (c). "But it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use" (d).

Consequently, where the original inventor, or, if dead, his personal representative, is not the applicant, or joined as applicant, the Privy Council may refuse an extension in a case where, if the original inventor had been joined, it would have granted it (e), or their Lordships may, and frequently do, impose terms in recommending an extension to secure some of the benefits thereof by way of annuity or otherwise to the original inventor (f), or to his personal representative if he should be dead (g).

Terms have been so imposed on an applicant who had been partner with the inventor, but the partnership was dissolved and the invention vested in the applicant (h).

But such terms are not imposed as of course—if the original inventor has been sufficiently remunerated, whereas the applicant has by his exertions and expense in bringing the invention before the public entitled himself to an extension, and has not himself been properly remunerated, the extension may be made to him unconditionally (i).

PERSONS TO APPLY FOR GRANT OF EXTENSION.

The proper person to apply for an extension and to receive the new letters patent is the person in whom the subsisting patent is legally vested (k).

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**Extension
of term of
Patent.**

**Conditions
imposed.**

**Legal
owner of
patent.**

(c) *Pettit Smith's Patent*, 7 Moo. P. C. C. 133; *Napier's Patent*, 13 Moo. P. C. C. 543.

(d) *Per Romilly, M.R., Norton's Patent*, 1 Moo. P. C. C. N. S. 344. Compare *Morgan's Patent*, 1 Web. P. C. 737; *Pitman's Patent*, L. R. 4 P. C. 84; *Normand's Patent*, L. R. 3 P. C. 193.

(e) See *Norton's Patent*, *ubi supra*.

(f) *Whitehouse's Patent*, 1 Web.

P. C. 473; *Russell v. Ledlam*, 1 H. L. C. 687, 698; *Markwick's Patent*, 13 Moo. P. C. 310; *Russell's Patent*, 2 Moo. 4 P. C. C. 496.

(g) *Herbert's Patent*, L. R. 1 P. C. 399.

(h) *Normandy's Patent*, 9 Moo. P. C. 452.

(i) *Normandy's Patent*, 9 Moo. P. C. 452.

(k) *Pettit Smith's Patent*, 7 Moo.

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**Extension
of term of
Patent.
To whom
extensions
granted.**

An importer-patentee may apply for an extension, though the Privy Council will scan carefully the merits both of the invention and of the application (*l*).

Extensions have been granted to the following persons, in addition to the original patentee and persons taking directly from him, namely:—

The administratrix of the patentee (*m*).

The agent and trustee for a foreign inventor (*n*).

The trustees of a joint stock company to whom the invention had been assigned (*o*).

The executor of a surviving assignee (*p*).

The assignees of the personal representatives of an assignee of the patent (*q*).

CONDITIONS IN GRANT OF EXTENSION.

**Conditions
imposed in
favour
of—**

The Privy Council in recommending the grant of an extended term of letters patent frequently imposes conditions on the applicant. The conditions which are so imposed are of four main classes:—

**(a) the in-
ventor,**

(a) *Conditions in favour or for the benefit of the inventor*, which have been already considered.

**(b) the
public,**

(b) *Conditions in the interest of the public*.—Thus an extension has been granted upon terms that the patented article shall be sold to the public at a certain fixed price (*r*), or that licenses should be granted to the public upon terms similar to a license already granted (*s*). And where the patentee had by deed granted to a company an exclusive license to use the invention, and covenanted to obtain a renewal of the patent for the same purpose, an application by him for an extension was refused (*t*).

**(c) the
Crown.**

(c) *Conditions in the interest of the Crown*.—The Privy Council frequently imposes as the condition of an extension that the Crown

P. C. C. 133; *Southcorth's Patent*, 1 Web. P. C. 486. See now sect. 46 of the Act.

(*l*) *Berry's Patent*, 7 Moo. P. C. 187; *Claridge's Patent*, 7 Moo. P. C. 394. Compare *Schlumberger's Patent*, 9 Moo. P. C. 1; *Johnson's Patent*, L. R. 4 P. C. 75.

(*m*) *Heath's Patent*, 8 Moo. P. C. C. 217; 2 Web. P. C. 247.

(*n*) *Newton's Patent*, 14 Moo. P. C. C. 156.

(*o*) *Pettit Smith's Patent*, *ubi supra*.

(*p*) *Bolmer's Patent*, 6 Moo. P. C. C. 468.

(*q*) *Poole's Patent*, L. R. 1 P. C. 514.

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

(*s*) *Mallet's Patent*, L. R. 1 P. C. 308.

(*t*) *Cardwell's Patent*, 10 Moo. P. C. C. 488.

or State represented by the various public departments, more particularly the War Office or the Admiralty, and their servants and persons contracting with them, shall have the right to use the invention on favourable terms, and perhaps without making any payment (*u*), and it seems that such a condition "has become now a usual one in cases of inventions which are likely to be required for use by the Government" (*u u*).

It is presumed that this power still remains, though by sect. 27 patents now bind the Crown.

(*d*) *Other persons*.—It seems clear that in addition to the above the Privy Council had authority under the Act of 1852 in proper cases to impose conditions in granting an extended term for the benefit of persons other than those comprised in the above classes (*x*), and it is submitted that by virtue of the express provisions of sect. 25 sub-sect. 5 of the present statute, such conditions may now be imposed.

GENERAL.

The Privy Council had no jurisdiction under the Act of 1852, and it is very doubtful whether they have any jurisdiction now to impose any terms on, or make any recommendation to the Crown with respect to any extended grant of letters patent, except the fact whether or not there shall be any extension, and if so, the length of it (*y*).

An extension may be granted as to, and in proper cases will be restricted to, a part only of the patent (*z*).

It seems that there is no jurisdiction to grant a second extension (*a*).

PRACTICE BEFORE THE PRIVY COUNCIL (*b*).

The application must be by petition. This should set out fully and explicitly the whole of the circumstances in any way material

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**Extension
of term of
patent.**

**(*d*) Other
persons.**

Petition

(*u*) *Pettit Smith's Patent*, 7 Moo. P. C. C. 133; *Lancaster's Patent*, 2 Moo. P. C. C. N. S. 189; *Hughes' Patent*, 4 App. Cas. 174.

(*u u*) *Napier's Patent*, 6 App. Cas. 174. But in *Re Lancaster's Patent* (*ubi supra*) the Privy Council refused to insert a condition in favour of the Crown.

(*x*) E.g. apprentices of the paten-

tee, see *Baxter's Patent*, 13 Jur. 593.

(*y*) *Russell v. Ledsam*, 1 H. L. C. 687, 699.

(*z*) *Napier's Patent*, 6 App. Cas. 174.

(*a*) *Goucher's Patent*, 2 Moo. P. C. N. S. 532.

(*b*) See generally as to this the Rules of the Judicial Committee, *post*.

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26.

Extension
of term of
patent.

Title.

Amend-
ment.

Caveat.

Costs.

to the application. In case of any omission to do so the petition may on such ground alone be dismissed (c).

The title of the petitioner must be strictly proved, even though admitted by the opponents (d).

A petition may, under special circumstances, be allowed to be amended (e).

It is not required that persons opposing should have any interest in relation to the patent.

Every person opposing should enter a caveat even in case of a Government department desiring to object (f), which caveat should be entered in the name of the opposing party (g).

The general rules as to costs are—(1) that the costs of a successful opposition will be allowed (h) unless there has been some impropriety in the manner in which the opposition has been conducted (i); (2) that opponents having no ground for their opposition will be ordered to pay the extra costs (and only those) occasioned by their opposition (k); (3) that when a petition is abandoned the petitioner will usually (l), though not invariably (m), be ordered to pay the costs of the opposition.

Sometimes when there are several opponents a lump sum for costs has been ordered to be paid for division amongst them all (n).

Revocation.

Revoca-
tion of
patent.

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

(2.) Revocation of a patent may be obtained on petition to the Court.

(3.) Every ground on which a patent might, at the

(c) *Pitman's Patent*, L. R. 4 P. C. 84; *Adair's Patent*, 6 App. Cas. 178.

(d) *Galloway's Patent*, 1 Web. P. C. 725.

(e) See *Hutchison's Patent*, 14 Moo. P. C. 364.

(f) See *Pettit Smith's Patent*, 7 Moo. P. C. 133.

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

(h) *Wield's Patent*, L. R. 4 P. C. 89.

(i) *Hosiball's Patent*, 9 Moo. P. C. 378, 394.

(k) *Downton's Patent*, 1 Web. P. C. 567.

(l) *Bridson's Patent*, 7 Moo. P. C. 499; *Hornby's Patent*, ib. 503.

(m) *Milner's Patent*, 9 Moo. P. C. 39.

(n) *Johnson's Patent*, L. R. 4 P. C. 75; *Wield's Patent*, ib. 89.

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

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—

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

Revoca-
tion of
patent.

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

(b.) Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

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

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

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

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

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

(7.) The defendant shall be entitled to begin, and give

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—

Revoca-
tion of
patent.

evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Sects. 44, sub-secs. 3 and 9, 109, 111, 117.

SCIRE FACIAS.

Fiat of the
Attorney-
General.

Proceedings hitherto for the repeal of letters patent have been by *scire facias*, which was a proceeding in form (as regards letters patent) at the suit of the sovereign, but in reality at the instance of a private prosecutor, who obtained the fiat of the Attorney-General sanctioning the procedure.

It was established that the Courts had no jurisdiction over the Attorney-General (except perhaps when the proceeding might be purely vexatious) either to direct him to refuse his fiat or to control his discretion by entering, or directing him to enter a *nolle prosequi* (o). It would seem that the fiat of the Attorney-General is not granted as of course (p).

Persons
entitled to
apply for
revoca-
tion.

It will be observed that the present statute enables certain persons *proprio motu* to apply for revocation of letters patent—a person defrauded by the grant of the patent, a person claiming to be the true inventor, a person alleging to have sold, &c., prior to the date of the patent anything claimed by it.

The circumstances under which proceedings may be instituted by *scire facias* to repeal letters patent (q) are thus stated in Bacon's Abridgment, vol. ix. p. 137:—

(o) *R. v. Prosser*, 11 Beav. 306.
Compare *R. v. Neilson*, 1 Web. P. C.
671, 672.

(p) Compare *R. v. Neilson*, 1

Web. P. C. 671, 672.

(q) Which of course means any letters patent, e.g. charters, and not merely letters patent for inventions.

“The writ of *scire facias* to repeal letters patent lieth in three cases: 1st, When the King by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the first patentee shall have a *scire facias* to repeal the second; Secondly, When the King doth grant a thing upon a false suggestion, he *prærogativa regis* may by *scire facias* repeal his own grant: Thirdly, When the King doth grant anything which by law he cannot grant, he, *jure regis*, and for the advancement of justice and right, may have a *scire facias* to repeal his own letters patent; and the judgment in all these cases is, ‘*Quod prædictæ patentēs dicti domini regis revocentur, &c.*’

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**Revoca-
tion of
patent.**
**Grounds of
scire
facias.**

“Where a patent is granted to the prejudice of the subject, the King, of right, is to permit him upon his petition to use his name for the repeal of it in *scire facias* at the King’s suit; and to prevent multiplicity of actions: for such actions will lie, notwithstanding such void patent: as, where the King grants a patent for holding a fair or a market without a writ *ad quod damnum*, or where such writ hath been deceitfully executed, in such case a *scire facias* lies to repeal the patent.”

Of the three grounds above mentioned for proceedings by *scire facias*, the second, “false suggestion,” is the most obscure. If an untrue statement or “suggestion” is made in letters patent either (a) in the recitals setting forth the reason of the grant, or (b) in that which is expressed as the consideration for the grant, this is a “false suggestion” (r). Whether other matters than these are properly to be included under the expression “false suggestion” is doubtful, but apparently not.

“False
sugges-
tion.”

It is clear, however, that letters patent may be invalid for other reasons than those just mentioned. It therefore follows that if “false suggestion” is limited to the two (a) and (b) classes of matters above stated, it is possible that a person may have a defence to an action for infringement of an alleged patent who nevertheless may be unable to institute proceedings for revocation.

Grounds of
invalidity
of letters
patent.

As to this, however, it will be observed (a) that the section in consideration does not (sub-sect. 3) limit the grounds of revocation upon petition under this Act, to those grounds for which a writ of *scire facias* lay; and (b) that by clauses c and d of sub-sect. 4, the persons therein mentioned may, under the circum-

(r) See *Morgan v. Seaward*, 2 M. & W. 544, 531; 187. 196; *R. v. Wheeler*, 2 B. & Ald. 345.

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tion of
patent.

stances therein stated, petition, and therefore, it would seem, may obtain judgment on establishing their case, for revocation.

As to what will and what will not come within the meaning of the expression "false suggestion," a learned author thus expresses himself (s): "The distinction pointed out by the learned judge between the case of a false recital in the letters patent, and a false statement not recited in the patent by way of suggestion, as an error in the specification, is of the greatest importance. It would appear that a distinction is to be drawn between such an error in the specification as will render a suggestion in the letters patent false, and such an error, in a matter of direction or otherwise, as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility. Other defects in a specification, as insufficiency of description, vitiate by reason of non-compliance with the proviso in the letters patent.

"The two classes of defects above specified may be distinguished, 1st, as false suggestion; 2nd, as insufficient description; the former may be considered as on the record and for the Court, the latter for the jury."

Particu-
lars of ob-
jections.

The section expressly provides that particulars of objections must be delivered with the petition (t).

Staying
proceed-
ings.

It is submitted that the Court has jurisdiction in a proper case to stay proceedings in an action for infringement, pending a petition for revocation (u).

Costs.

As to costs, it is submitted that in every case these should, in the absence of special circumstances, "follow the event" (x).

*Crown.*Patent to
bind
Crown.

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

(s) 1 Web. P. C. 42.

(t) Where the prosecutor on a writ of *scire facias* filed a notice of objections, stating that certain persons not named had used the invention in England before the grant of the patent, the Court refused to order particulars of the names and addresses of such persons, *R. v. Walton*, 2 Q. B. 969. As to "par-

ticulars," see the notes to sect. 29, *post*.

(u) The Court upon terms postponed the trial of a case for a definite period, to await the result of a pending motion in proceedings by *scire facias* to repeal the patent. *Smith v. Upton*, 6 Scott, N. R. 804.

(x) Pending a proceeding in *scire facias* to repeal a patent, the

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

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—
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—
Patent
to bind
Crown.

Prior to this Act it was held that the Crown might use a patented invention without the assent or remuneration of the patentee (y). But this right did not extend to contractors supplying the patented article to the Crown, even though they were indemnified by the Crown (z).

Legal Proceedings.

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

Hearing
with
assessor.

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

(3.) The remuneration, if any, to be paid to an assessor

patentee disclaimed a part. The prosecutor still proceeded, and ultimately failed. It was held that he ought to pay the costs subsequent to the disclaimer: *R. v. Mill*, 14 Beav. 312.

(y) *Feather v. The Queen*, 6 B. & S. 257; 35 L. J. Q. B. 200.

(z) So decided in the House of Lords, reversing the Court of Appeal: *Dixon v. London Small Arms Co.*, 1 App. Cas. 632.

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—

Hearing
with
assessor.

under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

MODE OF TRIAL.

Jury.

In *Sugg v. Silber* (a) it was held that a defendant in a patent, as in any other action in the Queen's Bench Division, could, by giving notice under the Judicature Rules, insist on a trial before a judge and jury, and that there was no power to direct a trial contrary to the wish of either party before a judge and assessors.

Patent actions could, before the Judicature Acts, have been brought and decided in the Court of Chancery, and, of course, in such case they were heard by a judge alone without a jury, and this power has been reserved to the Chancery Division by the Judicature Acts and the Orders made thereunder (b).

Not only has the Court now in every patent action a discretion as to allowing a trial with a jury, but "the action shall be tried without a jury unless the Court shall otherwise direct."

It is submitted that, as a general rule, patent actions are more fit to be tried without than with a jury (c); and though the same reasoning does not necessarily apply to trials of specific issues of fact, it is submitted that except under special circumstances of convenience and the like, the whole of the issues should be tried at one and the same trial (d).

Referees.

The Judicature Acts and the Rules contain provisions for referring matters arising in an action to referees, official or special, and either for trial of questions, and that such referees may inquire and report to the Court (e). Under these provisions a person has been appointed to make experiments for the purpose of informing the Court (f).

(a) 1 Q. B. D. 362.

(b) See Supreme Court Rules, 1883, Order 36, r. 4.

(c) See *per* Lord Cairns, L.C., in *Bovill v. Hitchcock*, L. R. 3 Ch. 417; *per* Selborne, L.C. (sitting for the M.R.), in *Patent Marine Inventions Co. v. Chadburn*, L. R. 16 Eq. 447; and *per* Cockburn, L.C.J., *Sugg v.*

Silber, 1 Q. B. D. 362.

(d) See *Roskell v. Whitworth*, L. R. 5 Ch. 459; *Young v. Fernie*, 1 D. G. J. & S. 353.

(e) See J. A. 1873, ss. 56, 57; Order 34, r. 2.

(f) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 157.

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

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—
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—

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

Delivery
of particu-
lars.

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

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

(5.) Particulars delivered may be from time to time amended, by leave of the Court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant (*ff*); and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to

(*ff*) See *Young v. Rosenthal & Co.*, O. J. vol. i. p. 29, as to costs where the plaintiff proved his particulars of breaches, but failed to obtain judgment on the ground of want of novelty. See also *Needham v. Johnson & Co.*, O. J. Rep. vol. i. p. 50, and *Nordenfelt v. Gardner*,

O. J. Rep. vol. i. p. 61, as to costs where in each case a defence of want of novelty was set up but not proved, but it was held that the respective defendants had not infringed, and were, therefore, entitled to the general costs of the action.

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have been proven or to have been reasonable and proper, without regard to the general costs of the case.

ACTION FOR INFRINGEMENT.

I.—Parties.

Plaintiff.—The original patentee and any person claiming from or under him as assignee of the whole interest in the letters patent may be plaintiff.

Assignee. An assignee may sue to restrain infringement, although at the time of the institution of the action the assignment to him has not been registered, and in such case it would seem that the subsequent registration of the assignment relates back to the date thereof (*g*).

Where there are two assignees and one dies, an action for an infringement during his lifetime descends on the survivor (*h*).

The assignee of a separate and distinct portion of an invention may sue for an infringement of the rights relating to such portion alone, without joining the persons interested in the residue of the invention (*i*).

Co-owners. Probably any co-owner or person interested in an indivisible patent may by himself sue to restrain infringements without joining the other co-owners. But if such person desires to obtain an account from wrongdoers he must usually, if not invariably, make all the co-owners parties (*k*).

Agents. A person employed as general agent of patentees resident abroad and having the sole agency and control of the working of the patent in England, and entitled to a share of the royalties and profits cannot institute an action in the ordinary form in respect of and to restrain infringement (*l*).

Licensee. A mere (non-exclusive) licensee cannot sue for an infringement. But it has been held that an exclusive licensee is entitled to use the name of the patentee in an action for infringement (*m*), and also to sue in his own name in respect of infringements (*n*).

(*g*) *Hassall v. Wright*, L. R. 10 Eq. 509.

(*h*) *Smith v. London and North-Western Ry. Co.*, 2 E. & B. 69.

(*i*) *Dunnicliff v. Mallet*, 29 L. J. C. P. 70; 7 C. B. N. S. 209; *Walton v. Lavater*, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

(*k*) *Bergmann v. Macmillan*, 17 Ch. D. 423.

(*l*) *Adams v. North British Ry. Co.*, 29 L. T. 297.

(*m*) *Renard v. Levinstein*, 2 H. & M. 628.

(*n*) *Hassall v. Wright*, *ubi supra*.

Defendant.—Every person who in any manner is party to or conduces directly or indirectly to an infringement, or is responsible for the persons causing an infringement, is liable for and may be sued in respect of such infringement. Consequently persons concerned in infringements as the servants, workmen, or agents of others directing the acts which are infringements are themselves as much liable as their principals.

The decision in *Adair v. Young* (o) aptly shows the extent of the liability of persons parties to infringements. The facts were as follows:—The action was brought against the master of a ship to restrain him from using pumps which were an infringement of the plaintiff's letters patent; he denied having used any pumps which were an infringement of the patent; it was shewn that the ship was fitted up exclusively with pumps which were an infringement of the letters patent, but had been so fitted up before the defendant (who was not a part owner) had taken command of her; he had nothing to do with putting them on board, and they had never been worked in British waters: it was held by a majority of the Court of Appeal (Brett and Cotton, L.JJ., dissentiente James, L.J.), affirming Bacon, V.C., that an injunction was rightly granted to restrain the master from using the invention on the ground that the defendant, being in command of a ship exclusively fitted up with pumps which were an infringement of the letters patent, was intending to use the patented invention.

In *Sykes v. Howarth* (p) the facts were these:—A patent consisted of the application of cards or strips of leather covered with wire to rollers at "wide distances." The defendant was a person who contracted to clothe rollers, and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer. He was held to have infringed the patent, though he alleged that his business was that of a card-maker only, and did not include the nailer's work; but it was suggested that the decision would have been the other way if he had merely supplied the cards without making the nailer his agent.

In short, whatever constitutes an "exercise," a "putting in operation," or a "user," however slight, of a patented invention, or a "vending" of articles made in accordance therewith, will, if unauthorized, be an infringement, and the persons responsible for such

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Action for infringement.

Agents, servants, &c.

Master of ship.

Person supplying materials.

Any user is an infringement.

(o) 12 Ch. D. C. A. 13.

p. 126; and *United Telephone Co.*

(p) 12 Ch. D. 826; see *Briggs & Co. v. Lardeur*, O. J. vol. i.

v. Dale, 25 Ch. D. 778.

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Action for
infringe-
ment.Custom
House
agents.

proceedings, whether acting on their account or not, will be liable to an action (q).

There must, however, be some actual participation by the defendant himself, or by persons for whose acts he is responsible, to constitute him an infringer, and liable as being such.

Thus in *Nobel's Explosives Company v. Jones, Scott & Co.* (r), the House of Lords held that the defendants, who had acted merely as Custom House agents in getting goods (admitted to be infringements of the plaintiff's patent) landed and stored in this country, had not committed, and were not liable as for, an infringement.

So in *Townsend v. Howarth* (s) it was held that a person who sold the component articles which entered into a patented invention with the knowledge that they were to be used for the purpose for which the patent was obtained, could not be sued as an infringer of the patent, although he sold the articles with an indemnity from all consequences in reference to the patent.

Employ-
ers.

Persons having the control of other parties, such as workmen or servants, will be liable for infringements committed by the latter in the course of their employment, even though contrary to express directions given to them. Thus directors of a company have been held so liable for infringements committed by their company's workmen in violation of orders issued to them (t).

Directors.

Persons having the control of other parties, such as workmen or servants, will be liable for infringements committed by the latter in the course of their employment, even though contrary to express directions given to them. Thus directors of a company have been held so liable for infringements committed by their company's workmen in violation of orders issued to them (t).

Intention to Infringe.

Intention.

Absence of an intention to infringe is no defence to an action in case of infringement. But where the defendant was a retail dealer who unwittingly sold articles which were an infringement of the plaintiff's patent, James, V.C., held that he was not liable for the costs of an action to restrain the infringement if he at once gave full information as to the persons from whom he obtained the articles complained of, and promised not to retail any more (u).

(q) *Caldwell v. Van Vlissingen*, 21 L. J. Ch. 97; *Betts v. Neilson*, L. R. 3 Ch. 429; *Elmslie v. Boursier*, L. R. 9 Eq. 217; *Von Heyden v. Neustadt*, 14 Ch. D. 230; *United Telephone Co. v. London and Globe Telephone Co.*, O. J. Rep. vol. i. p. 117. Compare *Betts v. Willmott*, L. R. 6 Ch. 239; *Société Anonyme des Mfs de Glaces v. Tilghman's Patent Sand Blast Co.*, 25 Ch. D. C. A. 1.

(r) 8 App. Cas. 5. Compare

Upmann v. Elkan, L. R. 7 Ch. 130; *Moet v. Pickering*, 8 Ch. D. C. A. 372.

(s) 12 Ch. D. C. A. 831, n. See *United Telephone Co. v. Dale*, 25 Ch. D. 778; *Same v. London and Globe Telephone Co.*, 32 W. R. 870.

(t) *Betts v. De Vitre*, L. R. 3 Ch. 441.

(u) *Betts v. Willmott*, 18 W. R. 946; *Nunn v. D'Albuquerque*, 34 Beav. 595.

And in *Upmann v. Elkan* (x), Hatherley, L.C., adopting the same principle, held that forwarding agents and warehousemen who had received boxes of cigars bearing forged brands, but were unaware of the forgery and gave all information in their power immediately on being informed thereof, were not liable to the costs of an action brought to restrain the sale of such cigars.

In *Cooper v. Whittingham* (y), which was a case of infringement of copyright, the late Master of the Rolls, however, laid down broadly "that where a plaintiff comes to enforce a legal right and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of his costs—the Court has no discretion, and cannot take away the plaintiff's right to costs," and he therefore ordered the defendants, who were agents and were willing to give an undertaking in any terms which the plaintiffs desired, to pay the costs of the action.

There is also a subsequent express decision to the same effect as the case last cited, *Upmann v. Forester* (z). Here the defendant, who was a china manufacturer, purchased abroad for his own private use a large number of cigars which were consigned to him at the docks here in cases bearing a spurious brand, purporting to be that of the plaintiffs, who were cigar manufacturers. He was not aware that the brand was spurious, nor, except from seeing it on the invoice, that any such brand was in use. Immediately upon the plaintiffs issuing their writ and serving the defendant with notice of motion for an injunction to restrain him from selling the cigars, he stated that he had no intention of selling the cigars, and offered all the relief asked for by the writ, and afterwards at the motion agreed to an undertaking in the terms of the writ, the question of costs being reserved. Chitty, J., nevertheless held that the defendant must pay all the costs of the action.

In the case of assignments of patents, the assignor and subsequent licensees from him will be restrained from afterwards working or using the invention (a); and as to prior licensees from him the rule seems (in the absence of any express reservation in the assignment of their rights) to be this—that if the assignee took the assignment with notice of, he takes it subject to, their licenses, and therefore cannot restrain them, but that if he had no such notice he is entitled to restrain them.

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infringe-
ment.Assign-
ments.

(x) L. R. 7 Ch. 130.

(y) 15 Ch. D. 501.

(z) 24 Ch. D. 231.

(a) *Hassall v. Wright*, L. R. 10
Eq. 509, which, however, was the
case of an exclusive license.

PART
II

II.—Pleadings.

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Action for
infringe-
ment.Rules as
to plead-
ing.

The general rules with respect to pleadings apply equally to actions for infringement and patents as to other actions. The parties, the plaintiff in his statement of claim, and the defendant in his defence, must respectively state their cases and set forth or at least indicate shortly the main allegations of fact intended to be relied upon at the trial. As regards the defence it is generally the wiser plan to plead the whole of the pleas as to which there is any probability at the hearing of giving evidence. If necessary for the avoidance of expense the issues can prior to trial by notice be restricted (b).

Particulars.

The most important matters in connection with pleadings in patent actions are the particulars which have to be furnished—of *breaches* by the plaintiff with his statement of claim, and of *objections* by the defendant with his defence. They may respectively be delivered by order at subsequent times, but if only on the score of costs it is advisable to deliver them with the claim or the defence as the case may be.

Requisites
of particu-
lars.

With regard to the matters to be specified by particulars, it will be observed that the statute does not enact what is to be particularized, except as regards invalidity from want of novelty or otherwise.

The plaintiff's particulars are to be "of the breaches complained of."

The defendant's particulars must be "of any objections on which he relies." And (a) if he disputes the validity of the patent he "must state on what grounds he disputes it," and (b) "if one of those grounds is want of novelty he must state the time and place of the previous publication or user alleged."

What is requisite to be set forth in particulars is consequently—with the exceptions above indicated—to be determined only by reference to judicial decisions (c).

Breaches.

Particulars of breaches.—These will be sufficient if, taken with

(b) See *Borill v. Goodier* (No. 2), L. R. 2 Eq. 195; *Morgan v. Fuller* (1), L. R. 2 Eq. 296.

(c) It seems that, apart from statutes, the Court has in patent, as in other actions, a general power to

order particulars whenever necessary. See *Perry v. Mitchell*, 1 Web. P. C. 269; *Electric Telegraph Co. v. Nott*, 4 C. B. 462; *Wren v. Weild*, L. R. 4 Q. B. 213.

the pleadings, they give the defendant full and fair notice of the case alleged against him (d).

A plaintiff, as a rule, will not be ordered to specify the particular passages and lines of the specification which are alleged to have been infringed (e).

But such particulars may be ordered if the invention is a complicated one, or the defendant on other sufficient grounds requires the information for the preparation of his defence (f).

Where the patent is in respect of numerous improvements the plaintiff must specify which of the improvements have been infringed (g).

In various cases (h) it has been held sufficient for the plaintiff to identify as an exhibit to an affidavit a specific object as being, by user or manufacture, the infringement upon which he relies; but it is submitted that he ought to give details in all cases of complicated inventions (i).

It would seem now settled that the dates of the various occasions when the infringements took place, and the names and addresses of the persons (if any) concerned therein as buyers, &c., should be stated (k).

Particulars of objections.—The general principles as to particulars of breaches apply equally to particulars of objections, but it would seem that the latter are construed somewhat more stringently than the former, and that consequently the defendant is compellable to give more explicit information on various points than is the plaintiff, and is also limited rather more strictly than the plaintiff to the case set up by him in his pleadings and accompanying objections.

Objections on the ground of want of novelty must specify not only the "time and place" as required by the section, but also

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Requisites of particulars.

Specifications.

Improvements.

Identifying specific objects.

Dates, Names, and Addresses.

Objections.

Novelty.

(d) *Needham v. Oxley*, 1 H. & M. 248.

(e) *Electric Telegraph Co. v. Nott*, 4 C. B. 462; *Talbot v. La Roche*, 15 C. B. 310; *Batley v. Kynock* (No. 2), L. R. 19 Eq. 229; and compare *Needham v. Oxley*, *ubi supra*.

(f) See *Lamb v. Nottingham Manufacturing Co.*, cited L. R. 19 Eq. 230, and *Wren v. Weild*, L. R. 4 Q. B. 213.

(g) *Perry v. Mitchell*, 1 Web. P. C. 269.

(h) *Needham v. Oxley*, *Batley v. Kynock*, and *Perry v. Mitchell*, *ubi supra*.

(i) See cases in note (f); and *Jones v. Lee*, 25 L. J. Ex. 241.

(k) See *Murray v. Clayton*, L. R. 15 Eq. 115; *Crossley v. Toney*, 2 Ch. D. 533; *Sykes v. Howarth*, 12 Ch. D. 826. Compare *Flower v. Lloyd*, 45 L. J. Ch. 746; 25 W. R. 17.

PART II. PATENTS. — S. 29. — Requisites of particu- lars. Name of Inventor. Specifica- tions.	whether the defendant objects to the patent generally as not new, or to a part only, and if so what part (<i>l</i>).
Language of specifi- cations.	With regard to this objection, <i>i.e.</i> want of novelty, the Court of Appeal has decided that inasmuch as the legislature has specially enacted what such particulars are to be set forth— <i>viz.</i> , the time and place—no further or more minute particulars can be ordered (<i>m</i>).
Prior user.	When the objection is that the plaintiff is not the first and true inventor the practice now is to require that the name of such inventor should be given (<i>n</i>).
	The practice is now settled, at least in all cases other than those of the simplest and shortest specifications, to require the defendant to state the particular parts of the plaintiff's specification which he says have been previously anticipated, whether by prior specifications or by books, and in the case of books to state the pages (<i>o</i>) considered to be anticipatory.
	As regards prior specifications an order has been made on various occasions (and it is submitted that such order is all that the plaintiff can be entitled to), that the defendant state in his particulars as to each of the previous specifications mentioned by him which of the plaintiff's claims is covered or referred to or anticipated by such specification.
	Considerable latitude will be allowed as to the generality of particulars of objections when the objections are as to the language of the specification or the nature of the invention, <i>e.g.</i> that the specification does not sufficiently describe the nature of the invention (<i>p</i>) or distinguish between what is new and what is old (<i>q</i>), or that it is calculated to deceive (<i>r</i>).
	Where the objection is prior user, it seems to be settled that the names and addresses of the persons alleged to have previously used the invention, and the circumstances of the occasions of such user sufficient to enable the plaintiff to make the necessary enquiries to verify or rebut the same, must be given (<i>s</i>).

(*l*) *Heath v. Unwin*, 10 M. & W. 684; *Russell v. Ledsam*, 11 M. & W. 647.

(*m*) *Flower v. Lloyd*, 45 L. J. Ch. 746; *Plimpton v. Spiller*, 20 Sol. J. 859.

(*n*) See however, *contra*, *Russell v. Ledsam*, 11 M. & W. 647.

(*o*) *Flimpton v. Spiller*, 20 Sol. J.

859.

(*p*) *Jones v. Berger*, 5 M. & G. 208; 1 Web. P. C. 544, 546; *Heath v. Unwin*, 1 Web. P. C. 551, n.

(*q*) *Ibid.*

(*r*) *Neilson v. Harford*, 1 Web. P. C. 295, 324, n.

(*s*) *Galloway v. Bleaden and Carpenter v. Walker*, 1 Web. P. C.

General Requirements.

Particulars whether of breaches or objections must be definite and precise, and therefore such expressions as "elsewhere" (*t*), "among others" (*u*), are objectionable, and have in various cases been struck out (*x*), though there are instances where they have been allowed to remain (*y*).

If the allegation is that of general prior user this may be so stated, *e.g.* "by candlemakers generally in London and the vicinity" (*z*).

But even allegations of general prior user must not be expressed in language too general or vague (*a*).

If particulars are delivered which are objectionable on the ground of vagueness or generality the opposite party may by section 29, sub-section 5, obtain an order directing them to be amended (*b*).

But if this be not done it will be too late to object at the trial to the objections (*c*)—though of course the Court would have power upon terms to adjourn the hearing to enable the plaintiff properly to meet the case proposed to be set up.

The above section contains a specific provision for the amendment of particulars (*d*).

Under the former statute amendments, and even re-amendments (*e*) were allowed when reasonable cause was shown.

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Requisites
of parti-
culars.

Particu-
lars must
be precise.

Amend-
ments.

268, n.; *Palmer v. Cooper*, 9 Ex. 231; *Flower v. Lloyd* (C.A.), 45 L. J. Ch. 746; 25 W. R. 17.

(*t*) *Holland v. Fox*, 1 W. R. 448; *Jones v. Berger*, 1 Web. P. C. 544, 549; *Patent Type Founding Co. v. Richards*, 2 L. T. N. S. 359.

(*u*) *Flower v. Lloyd*, 20 Sol. J. 860; *Birch v. Mather*, 22 Ch. D. 629.

(*x*) See *Galloway v. Bleaden*, 1 Web. P. C. 268, n.; *Fisher v. Dewick*, 1 Web. P. C. 551, n.; *Hull v. Bollard*, 1 H. & N. 134; 25 L. J. Ex. 304; *Flower v. Lloyd*, *ubi supra*.

(*y*) *Curtis v. Platt*, 8 L. T. N. S. 657; *Penn v. Bibby*, L. R. 1 Eq. 548. See also *Tilghman's Patent Sand Blast Co. v. Wright*, O. J. Rep. vol. i. p. 103.

(*z*) *Palmer v. Wagstaffe*, 8 Ex.

840; *Jones v. Berger*, 1 Web. P. C. 544, 549.

(*a*) *Morgan v. Fuller* (No. 2), L. R. 2 Eq. 297.

(*b*) See cases in previous notes; and *Hull v. Bollard*, 1 H. & N. 134; 25 L. J. Ex. 304.

(*c*) See last note and *Neilson v. Harford*, 8 M. & W. 806; *Sykes v. Howarth*, 12 Ch. D. 826.

(*d*) *Quære*, whether it is necessary that, to entitle a party to leave to amend, the new particulars or new issues should be such as he could not with due diligence have discovered earlier? See *Wilson v. Gann*, 23 W. R. 546; *Holste v. Robertson*, 4 Ch. D. 9.

(*e*) See *Penn v. Bibby*, *ubi supra*.

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Requisites
of particu-
lars.Amend-
ments.

Costs.

The costs of amendments are usually made those of the opposite party in any event, and the incidental costs arising therefrom are also often, and if after issue joined are almost invariably, given to the opposite party (*f*).

The rule is thus laid down as to amendments at a late stage of the action—"In granting the defendant in a patent action after issue joined and a day fixed for the hearing leave to amend his particulars of objection, the Court will place the plaintiff in the same position as to discontinuing the action, or disclaiming a portion of his invention, as he would have been if the original particulars of objection had contained the new instances of prior publication proposed to be introduced by amendment; and accordingly all costs incurred by the plaintiff subsequently to the delivery of the original particulars of objection will be ordered to be paid to him by the defendant in case he elects, within a time fixed by the order, to discontinue his action" (*g*).

III. RELIEF.

I.—*Injunction.*

Delay.

The chief branch of relief claimed in a patent action is usually an injunction.

Before the Judicature Acts, in case of great delay in bringing or prosecuting the action for infringement, the Court might refuse an injunction at the hearing and leave the plaintiff to his action for damages (*h*). The plaintiff ought also as soon as conveniently might be after commencing the action to move for an interlocutory injunction, and on this point Page Wood, V.C., laid down:—"With respect to obtaining a perpetual injunction, the rule is established by *Bacon v. Jones* (*i*) that in patent cases, unless the plaintiff takes steps to bring the matter before the Court by motion before the hearing, he will not, in general, be entitled to a perpetual injunction at the hearing. He is therefore not at liberty to wait for the hearing, but the Court requires him to place the matter in course of investigation at the earliest possible period" (*k*).

The decisions upon this point, namely, as to the right of a plaintiff, who has been guilty of delay in commencing or prosecuting an

(*f*) *Edison Telephone Co. v. India Rubber Co.*, 17 Ch. D. 137.

(*h*) *Bacon v. Jones*, 4 My. & Cr. 433, 438.

(*g*) *Ibid.*

(*i*) *Ibid.*

(*k*) *Patent Type Founding Co. v. Walter*, John. 727, 730.

action for infringement, to obtain at the hearing an injunction to restrain further infringement are somewhat contradictory, but it is submitted that the law on the matter is shortly as follows, namely:—

(a) That in the case of an infringement of a patent as of the violation of any other legal right, the injured party is entitled as of course (special circumstances apart) to an injunction to restrain the wrongdoer from further infringing his rights (*l*).

(b) That mere delay in commencing or prosecuting legal proceedings is not of itself any ground of refusing an injunction at the hearing.

(c) That if the delay has taken place under or been accompanied by circumstances from which it might reasonably be presumed that the person seeking relief did not intend to enforce his rights or, if so, at least did not intend to insist on his right to an injunction, and the wrongdoer in reliance on such conduct has expended moneys in connection with the infringements complained of, then the plaintiff will, or at least may be, estopped from insisting on an injunction at the hearing, in respect of matters which have then already occurred. For instance, if the result of the plaintiff's conduct has been the erection of expensive machinery, portions of which, or the working of which, are infringements of the plaintiff's patent, or if the defendant has manufactured or bought, and has in hand quantities of articles made in accordance with the patent, the plaintiff may not be granted an injunction to restrain further working or user of such machinery or the sale of such articles.

(d) But even in the cases last mentioned the plaintiff will be entitled to an injunction to restrain further acts in infringement of patent subsequent to the judgment, except in those cases where the defendant's position is such that the injunction would prevent him from obtaining the benefit of moneys which he had already expended in reliance on the plaintiff's conduct, and on the assumption that he would not be restrained. For instance, the defendant would be restrained from buying and selling other articles additional to his existing stock which would be infringements, though he might not be restrained from getting rid of an existing stock of patented articles, or from using the expensive machinery which he

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**Action for
infringe-
ment.
Relief.
Delay.**

(*l*) So expressly decided by 551; 11 Ch. D. C. A. 146; and by Jessel, M.R., and the Court of Appeal in *Krehl v. Burrell*, 7 Ch. D. Fry, J., in *Fullwood v. Fullwood*, 9 Ch. D. 176.

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**Form of
injunction.**

had erected as above mentioned, unless he could at little expense and inconvenience alter it so as not to be an infringement of the plaintiff's rights.

The injunction, if granted, extends to restraining "the defendant, his agents, servants, and workmen during the subsistence of the plaintiff's letters patent, or any extension thereof, from manufacturing, selling, or disposing of any machine constructed according to the plaintiff's patented invention, or only colourably differing therefrom, or being an infringement of the plaintiff's said patent, and from in any way infringing the plaintiff's said patent."

II.—Account.

**Account or
damages.**

The plaintiff succeeding at the trial will be entitled, whether an injunction is or is not granted, at his option, to either an account of profits made by the defendant or to damages for the injury sustained by him by reason of the infringements, but not to both profits and damages (*m*). However, as the plaintiff may sue different persons in respect of the same infringement, he may, in one action against one person, for example, a manufacturer, obtain an account of profits made by him and in another action in respect of the same matter against another person, for example, the seller or user, obtain damages (*n*).

**Form of
order for
account.**

The usual form of the account which is directed is as follows, with, of course, the necessary alterations according to the circumstances, namely: "Let an account be taken of all roller skates being the same as the skates sold by the defendant to G. as in the pleadings mentioned, or otherwise made in infringement of the said letters patent, which have been manufactured, or sold, or let for hire, by or by the order, or for the use or profit of the defendant, and also the gains and profits made by the defendant by reason of such manufacture, sale, or letting for hire (*o*)."

**What
profits
must be
accounted
for.**

The account of profits will include not only profits actually made by the wrongdoer, but also any benefits the value of which

(*m*) *De Vitre v. Betts*, L. R. 6 H. L. 319.

(*n*) *Penn v. Bibby*, *Penn v. Jack*, *Penn v. Fernie*, L. R. 3 Eq. 308.

(*o*) See *Plimpton v. Malcolmson*, Jessel, M.R., 28th of January, 1876, "Seton," 4th ed. p. 354. In the common law action of *Saxby v.*

Easterbrook, L. R. 7 Ex. 207, the order made was "that the master do assess or take an account of the profits made by the defendants by reason of the infringements by the defendants of the letters patent and patent rights mentioned in the declaration herein."

can be reasonably estimated, which may have been derived by him directly or even incidentally from the infringements, provided a sufficient case as to this is set up in the plaintiff's pleadings and established by his evidence (p).

The plaintiff, however, is not entitled to an account of anything other than what the defendant himself has received, either as profits or as collateral or incidental benefits in cases where an account of such benefits can be claimed. Thus, where the infringer was a manufacturer who had been paid a fixed royalty on articles manufactured by him, the plaintiff was held entitled only to the fixed royalty so paid or payable to the infringer, and not in addition to any allowance for manufacturers' profits, although he himself was a manufacturer, and, therefore, had lost, by reason of the infringements, some profits which as manufacturer he might have made (q); and in the same case it was held that the plaintiff, having succeeded in another action against other infringers who were users and not manufacturers of the articles in question, and been paid in certain cases the royalty which these users would otherwise have paid to the manufacturer-infringer, was not entitled in respect of such instances to be again paid the same royalty by the manufacturer. So also the plaintiff is not entitled, on taking the account, to any allowance for annoyances or trouble not being actual pecuniary loss which he may have suffered by reason of the infringement (r).

It has been held that where it clearly appears that no profits have been made, no account will be directed (s). It is submitted, however, that in such case the plaintiff is, in any event, entitled to nominal damages; and, further, that he may elect, even at the hearing, and though he has not specifically claimed damages, to take a judgment for damages (t).

It is submitted that the account, when directed, must be of all profits or benefits made, and should, therefore—at least in the case of patents, if not of designs and of trade-marks—extend “from the time of the infringement to the time of verdict” (u).

But it has been suggested that a plaintiff in a patent action,

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Infringer
—manu-
facturer.

Annoy-
ance, &c.

No profits
made.

Period
over which
the
account
extends.

(p) *Crossley v. Derby Gaslight Co.*, 3 My. & Cr. 428; 1 Web. P. C. 119; *Househill Co. v. Neilson*, 1 Web. P. C. 697, n.

(q) *Penn v. Jack*, L. R. 5 Eq. 81.

(r) *Ellwood v. Christy*, 18 C. B. N. S. 494.

(s) *Bacon v. Spottiswoode*, 1 Beav. 382; *Bergmann v. Macmillan*, 17 Ch. D. 423.

(t) See *Betts v. Neilson*, L. R. 3 Ch. 429, 441.

(u) *Saxby v. Easterbrook*, L. R. 7 Ex. 207, 209, per Kelly, C.B.

may, by delay in commencing proceedings, lose his right to any account (x); and in a case where this question of delay was considered, the account was directed only for the period of six years prior to action brought (y). In one case of an infringement of a trade-mark the account was limited to the filing of the bill (z); and in another similar case an account was refused (a); although in both cases the plaintiff's right was admitted to be clearly established, and an injunction was, therefore, granted.

The writer ventures to submit that these decisions (unless they are based on the ground that the plaintiff, by his conduct, waived his right to any account), cannot be supported—that the right to an account is as much a legal right as the right to damages, and that, consequently, in any case where the plaintiff, whether in a patent or a trade-mark action, establishes his case, he is entitled, as of course, to an account, at least for the period of six years prior to his action (b).

III.—Damages.

Damages.

As the plaintiff in a patent action can obtain, as the result of an account, only the payment by the defendant of the amount of such profits or benefits as he has actually derived by reason of the infringements—and this may often be very much less than the damages really sustained by the plaintiff—it will frequently be advisable, in the interests of the plaintiff, to take judgment for damages instead of an account. In such case the amount to be awarded will be the actual damages sustained by the plaintiff by reason of the infringements, and they will not be estimated or be limited by reference to the profits which the defendant himself has made. Nothing, however, will be allowed to the plaintiff as compensation for mere personal trouble and annoyance caused to him in connection with the defendant's proceedings (c).

Enquiry.

Where the case is tried before a jury, the damages will usually, though not invariably, be assessed by the jury at the trial, but may, under special circumstances, be assessed subsequently upon an enquiry.

When the trial takes place before a judge without a jury, the

(x) See *Crossley v. Derby Gas-light Co.*, 3 My. & Cr. 428; 1 Web. P. C. 119.

(y) *Ibid.*

(z) *Ford v. Foster*, L. R. 7 Ch. 611, 627.

(a) *Harrison v. Taylor*, 11 Jur. N. S. 408.

(b) See *Fullwood v. Fullwood*, 9 Ch. D. 176.

(c) *Penn v. Jack*, L. R. 5 Eq. 81.

usual rule is to direct an enquiry as to the damages. The Court itself will assess them only in simple cases.

The damages in patent cases will apparently always extend to and be limited to the period of six years prior to action brought (d).

In case of infringement of trade-marks, it has been stated that the enquiry as to damages will be limited to the commencement of the action, or at least to the date when the wrongdoer had notice that he was infringing the plaintiff's trade-mark, the reason suggested for such limitation being that in an action for infringement of trade-mark, fraud on the part of the defendant, that is, knowledge on his part that he is infringing, is necessary (e).

For the purpose of ascertaining the profits or assessing the damages after judgment, the Court may order inspection of the defendant's premises, books, and other documents (f); and may direct the defendant to make affidavits as to documents, as to his dealings with the patented articles, and otherwise and generally to furnish all information reasonably necessary to enable the plaintiff to have the full benefit of his judgment (g), and, if need be, the Court will allow the plaintiff to administer and compel the defendant to answer interrogatories (h).

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Period
over which
damages
extend.

Inspection.

IV.—*Destruction of Articles.*

In addition to the relief already mentioned the Court may order any articles, whether the subject of a patent (i) or a trade-mark (k), or a design (l), or parts thereof, which are an infringement of the plaintiff's rights to be destroyed, either entirely or so far as may be necessary to render them no longer infringements, or to be delivered up to the plaintiff (m). If, however, the articles complained of as being infringements are of such a description, or are so associated with other articles that the destruction or removal of them would be an expense to the defendant and out of all propor-

Action.
Destruction.

Delivering
up of
articles.

(d) See *Davenport v. Rylands*, L. R. 1 Eq. 302.

7 Ex. 207.

(e) See per Romilly, M.R., in *Moet v. Couston*, 10 L. T. 395; per Page Wood, V.C., in *Davenport v. Rylands*, L. R. 1 Eq. 308.

(i) *Betts v. De Vitre*, 34 L. J. Ch. 289.

(f) *Ellwood v. Christy*, 18 C. B. N. S. 494.

(k) *Moet v. Pickering*, 6 Ch. D. 770, 773.

(g) *Murray v. Clayton*, L. R. 15 Eq. 115.

(l) See *MacRae v. Holdsworth*, 2 D. G. & Sm. 496; *Prince Albert v. Strange*, *Ibid.* 717.

(h) *Saxby v. Easterbrook*, L. R.

(m) Which is perhaps the commoner form of order. See last cases, and Seton on Decrees, &c.

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tion to the benefit thereby derived by the plaintiff, the Court may, instead of directing the destruction or removal of them, allow the defendant to retain them upon an undertaking not to use them in such a way as to be an infringement, and upon other terms as to working them, payment of further damages and the like (*n*).

V.—Receiver.

Receiver.

The Court has full power to appoint a receiver in any case where “it shall appear to be just or convenient,” and it is expressly enacted that this power may be exercised on interlocutory application:—Judicature Act, 1875, s. 25; see Order L., r. 6.

It is, however, only under very special circumstances that in actions for infringement such an appointment could properly be made prior to judgment. But when judgment has been given in favour of the plaintiff it may be expedient to appoint a receiver, either as an ordinary incident to such judgment for the purpose of enforcing the same against the equitable property of the defendant (*o*), or for the special purpose of collecting any royalties or other moneys payable to the defendant in respect of the infringements committed by him (*p*).

TRIAL.

Consolidation.

Consolidation.—Where there are numerous actions upon the same patent by the same plaintiff against different persons defendants it is needless expense to have the whole of their actions proceeding concurrently. In such case the Court can (*a*), upon the application of any one of the defendants, consolidate the actions so as to have the questions which are common to all tried once for all in one selected action (*q*); and (*b*) upon the application of the

(*n*) See *Needham v. Ozley*, 8 L. T. 604; *United Telephone Co. v. London and Globe Telephone Co.*, 32 W. R. 870.

(*o*) See *Ex parte Evans Re Watkins*, 13 Ch. D. C. A. 252; *Smith v. Cowell*, 6 Q. B. D. C. A. 75; *Salt v. Cooper*, 16 Ch. D. C. A. 544.

(*p*) See *Nordenfeldt v. Gardner*, *Times*, 28th March, 1884.

(*q*) Order xlix., r. 8. See *Foxwell v. Webster*, 4 D. G. J. & S. 77. In the case of a consolidation order

it would seem that in the event of judgment being given for the plaintiff in the test action: (*a*) the defendant therein is entitled to contribution for his costs from the other defendants, and (*b*) his solicitor (if the same solicitor is employed by all the defendants) is entitled to be paid his costs by each and every of the defendants: *Anderson v. Boynton*, 13 Q. B. 308. See, however, *Davies v. Chatwood*, 11 Ch. D. 244.

plaintiff enlarge the time for taking the next step in the whole series of actions but one selected as a test action (r).

Evidence.—The plaintiff in order to succeed on the trial must, of course, establish his case by sufficient evidence in the usual manner. Whenever necessary or convenient the evidence of experts may be produced. How far in cases of similarity, whether of patents, trade-marks, or designs, the Court can act or ought to act upon its own opinion obtained from the comparison of different articles when such opinion is in conflict with the opinions of experts produced as witnesses, is open to doubt (s).

The Court may and frequently does in the course of an action, sometimes on the application of the parties, and sometimes *proprio motu*, direct a reference as to particular matters or questions to some properly qualified expert. Such reference will generally be for the information and the guidance of the Court. The referee is not a witness and his report merely as such is not evidence.

“Trade Secrets.”—Difficulties frequently arise in the course of patent actions in reference to alleged “trade secrets.” For instance, the defendant besides denying infringement alleges that his process of manufacture is essentially different from that constituting the subject of the patent by reason of some alterations or improvements known only to himself and his employees, and constituting a “trade secret,” and that the main, if not the total, effect produced by his process arises from the trade secret, and that to make known the same to the plaintiff or other persons in the trade would be an extreme hardship upon him. He therefore objects to answer questions as to this trade secret, or to give such inspection of his machinery or mode of manufacture as will disclose it. What is to be done under such circumstances? If, as not seldom happens, the Court is satisfied upon the evidence produced to it that such an allegation of the defendant if not untrue, is at least without sufficient foundation, and that the alleged trade secret either does not exist, or, if it has any existence, it is a matter of no real value, in such case the order for inspection, to answer interrogatories and the like will be made.

In other cases where the Court is not so satisfied, the difficulty is got over by directing a reference as to such alleged trade secret, the referee to report thereon to the Court. This was done by the

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secrets.**

(r) *Amos v. Chadwick*, 4 Ch. D. 869; 9 Ch. D. C. A. 459; *Bennett v. Lord Bury*, 5 C. P. D. 339.

(s) See *Thorn v. Worthing Skating Rink Co.*, 6 Ch. D. 415, n.; *Mitchell v. Henry*, 15 Ch. D. C. A. 181.

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late Master of the Rolls in the case of the *Plating Co. v. Farquharson*, 1879, P. No. 264, 12th of March, 1880. The material parts of the order were as follows:—"This Court doth order that D. be appointed analyst for the purposes hereinafter mentioned and be allowed access to the works of the defendants situate at, &c., at all reasonable times upon giving the defendant two days' previous notice to see the defendant's method of making his solutions and the materials used and also to see the defendants' method of using their solutions in the process of Nickel Plating as ordinarily used by them, and also to be allowed to take samples of the solutions and thereupon to report to the Court upon the facts and his opinions founded upon them. But the said D. is not to disclose his report on the facts or opinion obtained or arrived at by him without the leave of this Court or the Judge."

Hearing in Camera.—It might be convenient if the Court could in cases where such an objection is set up hear the matter in *camerâ* for the purpose of deciding upon the *bona fides* and reality of the allegations, and subsequently so far as might be necessary in order to prevent the disclosure of a real and *bonâ fide* trade secret. But there is no general power in this respect in the Court. Mr. Justice Pearson, however, in a late case allowed the defendant who set up that he used a secret process entirely different from that of the plaintiff's to decline answering any questions in cross-examination which would disclose his secret process, and having come to the conclusion that the patent was valid he gave the defendant leave to state his secret process in *camerâ*, and he further ordered the short-hand writer's notes which would disclose the secret process to be impounded in Court (*t*).

COSTS.

General
 costs of
 action.

The section in consideration (sect. 29, sub-sect. 6) does not contain, nor does the Act elsewhere contain, any enactments as to the general costs of an action. Consequently these costs and the circumstances under which they will be allowed, and the persons by whom they must be paid are matters depending upon the general provisions applicable to costs. These provisions are now summed up in Order LXV. of the Rules of the Supreme Court, 1883. By this order it is provided—

(Rule 1) "Subject to the provisions of the Acts and these Rules,

(*t*) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156.

the costs of and incident to all proceedings in the Supreme Court, including the administration of estates and trusts, shall be in the discretion of the Court or Judge; Provided also that, where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the Judge by whom such action, cause, matter, or issue is tried, or the Court shall, for good cause, otherwise order."

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And by (Rule 2), "When issues in fact and law are raised upon a claim or counter-claim, the costs of the several issues respectively both in law and fact, shall, unless otherwise ordered, follow the event."

The word "discretion" in the above rule means, not an arbitrary but, a judicial discretion to be exercised in accordance with principles acted upon by Judges in the numerous decisions which have come before the Courts. It is fully recognised that where a plaintiff has a legal right (and it is submitted that the same principle holds in the case of an equitable right) and he has been compelled to come to the Courts to protect such right and has been guilty of no misconduct in the course of the litigation he is entitled as of right to his costs of such litigation (*u*).

It is only when the plaintiff's conduct has been, having regard to all the circumstances of the case, altogether vexatious, that he can be deprived whether wholly or in part of his costs.

Very similar observations apply to the qualification in the second rule as to costs in cases where there is a trial by jury, namely, that the successful party may be deprived of his costs, upon "good cause" shewn. As to this the judge may himself deprive the

**Costs in
jury
actions.**

(*u*) "As I understand the law as to costs it is this, that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of his costs—the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts; for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or an oppressive or vexatious mode of conducting the proceedings, or other

misconduct which will induce the Court to refuse costs; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it. It is, for instance, no answer where a plaintiff asserts a legal right for a defendant to allege his ignorance of such right, and to say, "If I had known of your right I should not have infringed it." Per Jessel, M.R., in *Cooper v. Whittingham*, 15 Ch. D. 504; and compare the judgments of Court of Appeal in *Smith v. Watts*, 22 Ch. D. C. A. 5.

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Costs when
infringer
submits.

successful party of his costs without any application being made to him for such purpose (*x*); and in exercising his discretion the judge may take into account the conduct of the parties prior to litigation (*y*). It seems clear, however, that the successful party cannot be ordered to pay the costs of his opponent (*z*).

Subject to the limitations imposed by reason of the discretion vested in the judge, the broad rule in all actions is that the costs are "to follow the event," and this rule holds somewhat strictly in case of actions relating to infringements of patents and similar rights, because such actions relate to rights as such where the plaintiff is entitled, on establishing his case, to proper relief and not merely to matters as to which it is in the discretion of the Courts to say whether or not relief shall be granted.

The above being the general rules as to costs, the question frequently arises, and—notwithstanding various decisions and numerous dicta—cannot be said to be clearly settled in all respects, (a) What are the respective rights and liabilities of the parties as to costs, if an infringer, on being informed of the claim of the injured party, consents to that claim? And (b) What is it which the infringer must express his willingness to do?

It is submitted that the result of the authorities on these points is as follows:—that the wrongdoer, in order to put himself as far as possible in the right, must, immediately on receipt of a communication from the injured party, offer to do all that he will be compellable to do in the event of a judgment in respect of the matters complained of, and that such offer must include the matters (*a*), namely:—

(1.) Payment of such costs (if any) as have then been properly incurred by the other party (*b*).

(2.) Destruction of the articles complained of, or (in cases where removal of marks, &c., is a sufficient and proper relief) the removal from them of everything constituting infringement.

(3.) In cases where the wrongdoer is not himself the manu-

(*x*) *Turner v. Heyland*, 48 L. J. C. P. 535.

(*y*) *Harnett v. Vise*, 5 Ex. D. C. A. 307.

(*z*) *Foster v. G. W. Ry. Co.*, 8 Q. B. D. C. A. 515.

(a) See the cases in the notes following. With regard to the matters numbered 3, 4, and 5, it is

submitted that if the infringer cannot give the names and addresses referred, or if there have been no profits an affidavit by him as to these points will be sufficient.

(b) Where the party submits at once the costs will be taxed on the lower scale: see *Hudson v. Osgerby*, 32 W. R. 566; W. N. 1884, p. 83.

facturer of the articles, or the actual or sole author of that which causes them to be infringements, a statement of the names and addresses of such manufacturers or other authors (c).

(4.) A statement of the names and addresses of the persons, if any, who have received from the wrongdoer, whether as purchasers or otherwise, any of the articles complained of.

(5.) To give an account of profits, and for such purpose to give reasonable inspection of his books and other documents, if and so far as necessary (d).

(6.) If an action is pending, to allow an order to be taken and drawn up in the above terms.

And (7.) To pay the costs of, and incidental to, such order.

A person complaining of an infringement is not bound to give notice before commencing an action. If he should do so, and the wrongdoer should thereupon offer to desist and give all necessary information, &c., it is, perhaps, doubtful whether he is entitled to proceed to action. But the better view seems to be that he is so entitled because (a) he was not bound to give notice, and (b) an order made or undertaking given in an action is in every way more satisfactory than an undertaking outside an action (e).

If an injured party persists in carrying on an action after a proper offer has been made to him by the wrongdoer, he will get no further costs, and he may be ordered to pay costs (f); and this applies however late in the proceedings the offer is made, and even if made after judgment against the wrongdoer, and pending an appeal by him (g).

Taxation.—Costs will, of course, be taxed as between party and

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(c) *Upmann v. Elkan*, L. R. 12 Eq. 140.

(d) *Quære*, whether this is so in case of trade-marks: *Edelsten v. Edelsten*, 1 D. G. J. & S. 185. It is submitted, moreover, that if an account of profits is insisted on and taken, the wrongdoer submitting to account and to give all proper information is entitled (a) to have such account taken at the risk of the other party in all cases, except where profits have admittedly been made, and (b) to have any further

account beyond the admitted profits taken at the risk of the other party: see *Nunn v. D'Albuquerque*, 34 Beav. 595.

(e) See *Geary v. Norton*, 1 D. G. & Sm. 9; *Upmann v. Elkan*, *ubi supra*; *Upmann v. Forester*, 24 Ch. D. 231, 235-6.

(f) See *Colburn v. Simms*, 2 Hare, 543; *Caruncho v. Highmore*, L. J. No. Cases, 1883, p. 15; cases in last note.

(g) *De Vitre v. Betts*, L. R. 6 H. L. 319, 326.

**PART
II.
PATENTS.**

S. 29.

**Action.
Costs.**

**Models,
drawings,
&c.**

**Scientific
witnesses.**

Reference.

Trial.

**Directors
of a Co.**

party (*h*), and the Court has no discretion to give to any party by way of damages, or as a penalty or otherwise, costs as between solicitor and client (*i*).

In taxing the costs the ordinary rules will be followed, and only such costs will be allowed as are necessary for the conduct of the litigation (*k*). Each party is entitled to all such costs as are reasonably necessary to enable him to put his case properly before the Court; therefore models, when requisite, will be allowed (*l*), but not costs of drawings and sections explanatory of the exhibits to the defendant's affidavits, and required only for the purposes of the briefs of his own counsel (*m*).

In connection with scientific witnesses, there will be allowed, not only the expense of their actual attendance at the hearing, but also a moderate fee, such as £7 7s. a day to read up the case for the purpose of giving evidence (*n*).

The costs of any reference directed by the Court for its own information will also usually be made costs in the action (*o*).

As regards preparing for trial, the rule is not to allow any costs relating to the trial incurred prior to notice of trial being given (*p*); but under special circumstances some, if not all, the costs reasonably incurred in anticipation of a trial may be allowed, although the action is dismissed before notice of trial (*q*).

Where an action for infringement was dismissed with costs without calling on the defendant's witnesses, and no certificate was given under section 43 of the Patent Law Amendment Act, 1852, it was held that the defendant was entitled to his costs of preparing objections and of his witnesses in support (*r*).

There are various other points in connection with costs which may be noticed. Directors of a company and other agents who in

(*h*) Except in patent actions when a certificate has been obtained in a previous action under s. 31.

(*i*) *Cockburn v. Edwards*, 18 Ch. D. C.A. 449.

(*k*) *Smith v. Buller*, L. R. 19 Eq. 473.

(*l*) *Batley v. Kynock*, L. R. 20 Eq. 632.

(*m*) *Smith v. Buller*, *ubi supra*.

(*n*) *Smith v. Buller*, *ubi supra*;

Mackley v. Chillingworth, 2 C. P. D. 273.

(*o*) See *Plating Co. v. Farquharson*, *ante*, p. 70; *Radische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 176.

(*p*) *Freeman v. Springham*, 14 C. B. N. S. 197.

(*q*) See *Batley v. Kynock*, L. R. 20 Eq. 632.

(*r*) *Parnell v. Mort*, O. J. Rep. vol. i. p. 4.

any way participate in infringements, may be made parties to an action and rendered liable in damages (s).

Similarly, trustees of a defendant who becomes bankrupt, if, being joined as parties they take active proceedings, may be ordered to pay costs (t).

Where a motion is ordered to stand till the hearing, the costs of such motion will be costs in the action, whether it is dismissed (u) or judgment is given for the plaintiff (x).

If an order for an interlocutory injunction is made, and the costs are made costs in the action, or nothing is said as to the costs, in case the action is ultimately dismissed, the defendant will be entitled to the costs of such application (y).

In case judgment is given against the defendant, and an appeal is presented, the costs of any application to stay proceedings pending an appeal (z), (which application ought to be made in the first instance to the Court below, and not to the Appeal Court), must as a general rule be borne by the applicant, whether an order is or is not made on his application (a).

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

This section provides for the more important of the interlocutory proceedings in the course of a patent action. But it is expressed in language sufficiently wide to apply to, and must be considered as applying to, proceedings at and subsequent to the trial of an action. Its provisions are supplemental and ancillary to, and not in substitution for, the analogous provisions contained in the Judicature Acts and Orders.

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PATENTS.

SS. 29, 30.

Action.

Costs.

Trustees.

Motion Standing over.

Stay of proceeding.

Order for inspection, &c., in action.

(s) *Betts v. De Vitre*, L. R. 3 Ch. 429, 442; *Ibid.* L. R. 6 H. L. 319.

(t) *Watson v. Holliday*, 31 W. R. C. A. 536.

(u) *Betts v. Clifford*, 1 J. & H. 74.

(x) *Mounsey v. Earl Lonsdale*, L. R. 6 Ch. 141.

(y) *Stevens v. Keating*, 1 Mac. & G. 659.

(z) *A.-G. v. Swansea Improvements, &c., Co.*, 9 Ch. D. C. A. 46.

(a) *Merry v. Nickalls*, L. R. 8 Ch. 205; *Cooper v. Cooper*, 2 Ch. D. C. A. 492; *Adair v. Young*, 11 Ch. D. C. A. 136.

PART
II.

INTERIM INJUNCTION.

PATENTS.

S. 30.

Interim
injunc-
tions.Principles
upon
which
granted.

The principles upon which the Court proceeds in patent cases in granting or refusing interim injunctions may be thus summed up:—

(1.) If the patent has been established in an action *bonâ fide* contested, the injunction is as of course (*b*).

(2.) If the patent is an "old" one, and has been in use and unquestioned for a reasonable time an injunction will be granted (*c*).

(3.) In cases coming within these two classes an injunction will be granted, although the defendant may raise such *bonâ fide* doubts as to the validity of the patent that the Court would, in the case of a new patent or one not established in prior proceedings, refuse an interim injunction (*d*).

(4.) If the *primâ facie* right to an interim injunction be shewn, then an order will be made, even though it may be extremely hard upon the defendant, and extend to the shutting up of a new business (*e*). But there can be no doubt that, if the granting of an interim order would under the circumstances inflict damage upon the defendant out of all proportion to any advantage to be derived by the plaintiff, the Court, in its discretion might; and probably would, refuse the order, putting the defendant upon terms to keep an account, especially if the plaintiff was a person of small means, and his undertaking therefore not substantial (*f*).

(5.) In the case of a "new" patent not established in any legal proceedings, the Court will grant an injunction, if the validity of the patent be shewn by sufficient *primâ facie* evidence (*g*), and provided that there are no circumstances of hardship on the defendant sufficient to justify a refusal of an interim order.

(6.) If the patent be a "new" one, and there is not such evidence of its validity, or if, although it is of some long standing, it has not been put into use to such an extent or under such circum-

(*b*) *Neilson v. Harford*, 1 Web. P. C. 373; *Bovill v. Goodier* (No. 2), L. R. 2 Eq. 195; *Plimpton v. Spiller*, 4 Ch. D. 286.

(*c*) *Muntz v. Foster*, 2 Web. P. C. 93; *Electric Telegraph Co. v. Nott*, 2 Coop. 41; *Stevens v. Keating*, 2 Ph. 333; *Dudgeon v. Thompson*, 30 L. T. 244; 22 W. R. 464; *Briggs*

& *Co. v. Lardeur*, O. J. Rep. vol. i. p. 126.

(*d*) *Betts v. Menzies*, 3 Jur. N. S. 357.

(*e*) *Plimpton v. Spiller*, 4 Ch. D. 286; *Flower v. Lloyd*, 36 L. T. 444.

(*f*) See *Rigby v. G. W. Ry. Co.*, 2 Ph. 44; *Morgan v. Seaward*, 1 Web. P. C. 167.

(*g*) *Gardner v. Broadbent*, 2 Jur. N. S. 1041.

stances as to raise a fair presumption of its validity, the Court will usually refuse an injunction and put the defendant upon terms of keeping an account (*h*).

(7.) The right which *primâ facie* the owner of a patent might have to restrain infringements by interim injunctions may be lost by delay in coming to the Court, and *à fortiori* by conduct amounting to acquiescence in what is complained of. The party applying for an interim order must be "prompt and speedy" (*i*), but the rule cannot be stated more definitely—everything will depend upon the attendant circumstances. A delay from November in one year till July in the following was held too long in one case (*k*), whereas three months, part of which was spent in making enquiries, was not too long in another case (*l*).

(8.) When the matter is really doubtful, and when the inconvenience of granting or refusing an interim order—to the defendant if granted, to the plaintiff if refused—are about equally balanced, it is not possible to lay down any positive rule as to what course should be adopted. In such case everything should be considered, and, among other things, the solvency of the parties and the probability or otherwise of the party who may succeed finally being able to recover from his opponent the damages that may be

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injunctions.

Delay.

(*h*) See cases in previous notes; and *Liston v. Norton Bros.*, O. J. Rep. vol. i. p. 114.

(*i*) See *Att-Gen. v. Sheffield Gas Co.*, 3 D. G. M. & G. 304; *Ware v. Regent's Canal Co.*, 3 D. G. & J. 212, 230.

(*k*) *Bovill v. Crate*, L. R. 1 Eq. 388.

(*l*) *Losh v. Hague*, 1 Web. P. C. 200. Shadwell, V.C., thus expressed himself: "On the 23rd of March the plaintiff received some information that there was an invasion of his patent, and some portion of time, it appears, was spent in making inquiries; there was notice given distinctly on the 8th of May. Then some further correspondence takes place and letters between the parties; and then a bill is filed on the 7th of July, and the application is

virtually made. I cannot but think, therefore, that the plaintiff has come in sufficient time."

In *Bridson v. Benecke* (12 Beav. 1, 3), Lord Langdale, M.R., thus stated the law: "I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established, against the party who is alleged to have infringed it, ought to come at an early period. I do not say at the earliest possible period, because that would be putting an application for an injunction or notice, where all parties have an opportunity of being heard, in the same condition as an injunction *ex parte*, which it would not be expedient to do. The rule of this Court is very strict that you must apply in proper time."

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tions.

payable by him, whether as the result of the action or by reason of any undertaking in damages given by him. "There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo*—for that is really what the Court has to do—to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, 'We will not stop a going trade; we will not adopt a course which will result in a very great difficulty in giving compensation on the one side or the other.' We have to deal with it as a practical question in the best way we can. I think, on the whole, that the Master of the Rolls has made the right order, viz. by granting the injunction, and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make, if he should ultimately turn out to be in the wrong; and that it would not be right in this case merely to put the defendant upon the terms of keeping an account, which I conceive might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right" (m).

Ex parte
injunc-
tions.

Injunctions may be granted *ex parte* in actions for infringements of patents, designs, or trade-marks as of other actions. The Courts are, however, disinclined to make such orders, and will only do so in really urgent and pressing cases. This urgency seldom exists as regards actions relating to patents or designs. But in the case of trade-marks, *e.g.* when the infringement consists in the user of forged brands on spirits, wines, cigars, and the like, it is often necessary to apply *ex parte* and before the wrongdoer has notice of legal proceedings—otherwise the whole mischief may be done before a restraining order can be obtained.

Undertak-
ing in
damages.

The rule is now in every case of the interlocutory injunction, and not merely of those which are obtained *ex parte*, to put the person obtaining the order upon an undertaking in damages (n).

Evidence.

Infringement.—Of course on every application for an interlocutory injunction, as for a final and perpetual one (o), there must be sufficient evidence of infringement to justify an order being made. If there is on the evidence before the Court any substantial doubt as to this, the rule is to refuse the injunction and put the defendant upon terms of keeping an account (p).

(m) *Per James, L.J., in Plimpton v. Spiller*, 4 Ch. D. C. A. 289.

(n) *Chappell v. Davidson*, 8 D. G. M. & G. 1; *Graham v. Campbell*, 7 Ch. D. C. A. 491.

(o) See pp. 69 and 70.

(p) *Electric Telegraph Co. v. Nott*, 2 Coop. 41; *Muntz v. Vivian*, 2 Web. P. C. 87; *Plimpton v. Malcolmson*, L. R. 20 Eq. 37.

The evidence of infringement need not be so positive or complete on interlocutory applications as on the final hearing, and may be merely information and belief—unless, indeed, the defendant displaces this by strict proof. Speaking generally, it is not politic on either side on an interlocutory motion to attempt to go fully into, and to completely establish or refute, the fact of infringement. The Court is indisposed to try the question on interlocutory applications, and, as already stated, will usually, in the event of the infringement being seriously contested on what appears to be *prima facie* satisfactory evidence, merely put the defendant upon terms of keeping an account.

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tions.**

INSPECTION.

One of the most beneficial powers possessed by the Courts is the power to order, in the course of the action or at or subsequent to the trial, inspection of the machinery, process, or articles complained of as being infringements of, or employed for the purpose of infringing, the plaintiff's patent. The inspection extends to whatever is material to the conduct of the action. It may be of machinery or processes while quiescent or when in operation, and the Court may, and will when necessary, direct the machinery or process to be put into operation (*q*).

**Of what
inspection
ordered.**

An order for inspection is not as of course. The party applying must produce evidence shewing, in the case of the plaintiff, a *prima facie* right to his alleged patent, and a *prima facie* case of infringement by the defendant (*r*); and further, in the case of either party, shewing by sufficient evidence (*s*) that an inspection of the works, machinery, process of manufacture, or articles which is sought, will be of material importance to himself, whether in carrying on the action or in preparing for the trial, whether he be plaintiff or defendant (*t*).

**Evidence
required
for order.**

If and when necessary an order may be made that specimens of the patented articles, or of the chemical solution or other substances used in the preparation thereof, be supplied to the other

Specimens.

(*q*) Whether experiments will be directed, see *Flower v. Lloyd*, W. N. 1876, p. 169, 230; *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156.

22 L. J. Ex. 26; *Meadows v. Kirkman*, 29 L. J. Ex. 205.

(*s*) *Shaw v. Bank of England*, *ubi supra*; *Batley v. Kynock*, L. R. 19 Eq. 90.

(*r*) *Shaw v. Bank of England*,

(*t*) See Cases in last two notes.

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injunc-
tions.
"Trade
secrets."

side for purposes of analysis (*u*), or to an independent person for him to report on for the information of the Court (*x*).

The difficulty which has already been referred to in respect of alleged "trade secrets" (*y*) may, and often does, arise in respect of inspections. Indeed, whenever the subject-matter in dispute is a chemical process, or the like, or the employment of a combination of machinery or apparatus, it is more than probable that every manufacturer will make alterations and arrangements which he considers improvements, and which he would be unwilling to disclose to a competitor in trade or his agents. In all such cases it seems fair as between the parties that the inspection should be confined to scientific persons, with a direction not to make disclosures to either side (*z*).

INTERROGATORIES.

Interroga-
tories—
what must
be
answered.

If in any action the party interrogated, whether the defendant or the plaintiff when made defendant in a counter-claim, sets up any *bonâ fide* defence to the claim of the opposite party, he may decline to answer interrogatories relating to matters which are subsidiary to such claim, and can become of importance only if it shall be, and after it has been, established (*a*). Thus if the defendant in a patent action denies the fact of infringement he will not be compellable to answer interrogatories as to articles alleged to be infringements now in his possession or sold by him, or as to accounts of profits made by him by means of the alleged infringements (*b*).

But this limitation applies only to interrogatories relating to matters entirely dependent upon the part (or, it maybe, the whole) of the case which is denied, and which will become immaterial if such case be not established. It does not extend further and protect a defendant who denies the plaintiff's title *in toto* or alleges that his patent is invalid from answering fully all interrogatories which are material (*c*).

Subject to the above limitation the broad rule as to answers to

(*u*) *Patent Type Founding Co. v. Walter*, John. 727: see same case at law, 5 H. & N. 192.

(*x*) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156.

(*y*) *Ante*, p. 69.

(*z*) *Flower v. Lloyd*, W. N. 1876, pp. 169, 230.

(*a*) *Parker v. Wells*, 18 Ch. D. C. A. 477.

(*b*) *De la Rue v. Dickinson*, 3 K. & J. 380; *Rolls v. Isaacs*, W. N. 1878, p. 37.

(*c*) *Swinborne v. Nelson*, 16 Beav. 416; *Foxwell v. Webster*, 9 Jur. N. S. 1189; 3 N. R. 103.

interrogatories is that "he who answers at all must answer fully." This maxim is perhaps scarcely applicable, taken literally, to the present system of procedure, but the principle still holds. Consequently the answering party must give a full and complete answer to all interrogatories, which will materially assist the opposite party in making out his case.

It has been held in a patent action that the defendant who has sold or licensed articles manufactured in infringement of the patent must give the names and addresses of the parties to whom articles have been sold or by whom royalties or other moneys have been paid or are payable in respect thereof (*d*), although in a trade-mark case the Court of Appeal held that the defendant was not compellable to answer interrogatories relating to similar matters (*e*).

The defendants in patent actions have usually, if not invariably, been held not bound to answer interrogatories as to the component parts of chemical and other substances employed by them in their processes (*f*), or to give details of substances, e.g. the size of wire employed by them for the purposes of their manufacture (*g*).

When a defendant sets up prior user of the invention claimed by the plaintiff, interrogatories as to particulars of such prior user will be allowed (*h*), but such interrogatories will not be allowed to extend to descriptions of articles in existence prior to the plaintiff's patent, or to the names of the persons to whom such articles were sold (*i*).

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Interrogatories.

Persons to whom articles sold—patent, trade-mark.

Composition of chemical, &c., substances.

Prior user.

(*d*) *Crossley v. Stewart*, 1 N. R. 426; *Orr v. Diaper*, 4 Ch. D. 92.

(*e*) *Carver v. Pinto Leite*, L. R. 7 Ch. 90.

(*f*) See *Simpson v. Charlesworth*, W. N. 1866, p. 255; *Rolls v. Isaacs*, W. N. 1878, p. 37; *Renard v. Levinstein*, 10 L. T. 94.

(*g*) *Daw v. Eley*, 2 H. & M. 725.

(*h*) *Finnegan v. James*, L. R. 19 Eq. 72; *Crossley v. Tomey*, 2 Ch. D. 533; *Birch v. Mather*, 22 Ch. D. 629.

(*i*) *Daw v. Eley*, *ubi supra*.

The report of one of the numerous applications in the case of *Renard v. Levinstein*, 11 L. T. 79, is very useful as shewing the kind of interrogatories which parties to patent actions may be compelled to answer.

What the patentee there claimed was "the treating red aniline dye, or its homologue, so as to transform it into other dyes;" and he stated that the invention was the result partly of a communication from abroad made to him by one De Loire, and partly of invention and discovery made by himself. The defendant filed a concise statement stating briefly the matters in respect of which he required discovery from the plaintiff, accompanied with interrogatories for his examination. The more material of the interrogatories were as follows—the plaintiff, on exceptions to his answers, being ordered to answer substantially the whole of them (the excepted portions of the inter-

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Certificate
of validity
questioned
and costs
thereon.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies,

rogatories as to which an answer was not compelled being as to proportions in which he used the materials and what it was he added, and in what proportions)—namely:

(1.) Whether it was not the fact that no true and pure blue could be produced according to the specification, even by day, and that at night, and by artificial light, the so-called blue of Girard's process was not blue, but purple, or a blue not free from red.

(2.) Whether the plaintiffs had not, since the 4th of July, 1862, made and sold in England some blue dye, manufactured by Girard's process, some materials being added not mentioned in the specification, or not mentioned there for the purpose of making the blue dye. Whether the plaintiffs had not wholly, or to some extent, abandoned making blue dyes strictly in accordance with Girard's process, because blue dyes so manufactured were not saleable, but worthless as blue dyes; and if the plaintiffs had sold in England, since the 4th of July, 1862, any blue dye made strictly according to Girard's specification, the defendant required them to set forth the proportion of the quantity of blue dye so made and sold by them, as compared with the quantity not so made and sold by them since the same date.

(3.) What do the words "red aniline dye of commerce" and "red aniline dye" used in the specification, mean? Whether it was not the fact that there was no one sub-

stance known as "red aniline dye" or "red aniline dye of commerce?" Whether "red aniline dye" meant, as it ought to do, a real dye, and not merely a substance which could be used for preparing dye, whether it was not then a liquid dye? The defendant required the plaintiffs to set forth the nature and chemical composition of every substance they knew of which was, at the date of the specification, sold and known as "red aniline dye." Whether the expressions "red aniline dye" and "red aniline dye of commerce" did not mean any one of the following substances, namely, sulphate of aniline, arseniate of aniline, iodide of aniline, hydrochlorate of aniline, or any salt of aniline of a red colour.

(4.) What did the words "the acid being mixed with a large quantity of water," occurring in the specification mean? What was the proportion of water to hydrochloric acid used in the mixture for violet dye? Would any proportion of water to acid be sufficient, and what was the strength of the acid? The plaintiffs were required to state the lowest and greatest proportions respectively of water to be used in making the mixture. What was the meaning of "hydrochloric acid of commercial strength?" and what was that strength? And did not hydrochloric acid sold in commerce vary very much in strength? and what were the limits of such variation?

(5.) Whether the plaintiffs had

then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

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In order to entitle a patentee to a certificate, the validity of the patent must not merely have come in question in the action, but it must have been really contested at the hearing; consequently the certificate cannot be given if the defendant consents to a verdict for the plaintiff (k).

Certifi-
cate.
Consent
verdict.

Where in an action for infringement there was a plea denying the novelty of the invention, it was held at the trial that the validity of

not for some time manufactured and sold in England blue dye prepared without pure aniline, and whether they did not use, in making the blue dye, acetate of aniline, or oxalate of aniline, or some other and what salt of aniline, formed with an organic acid instead of aniline? Whether the process used by the plaintiffs for making blue dye did not in its essential footing resemble the processes described in the patents of Schlumberger and Gilbee respectively, and differ in essential particulars from Girard's process?

aniline dye used, the strength of the hydrochloric acid used, the quantity of water used, and all other necessary particulars.

(6.) Whether it was not the fact that Girard's specification was altogether, or to some extent, inefficient as regarded the blue dye, and that no true blue dye could be produced from it.

(8.) Whether any, and which, of the homologues of aniline, being used with red aniline dye, and without the use of aniline itself, would produce the violet dye mentioned in Girard's specification. Whether it was not the fact that no homologues of aniline, used without aniline, would produce such violet dye. Whether any, and which, of the homologues of aniline, mixed with red aniline dye, and without the addition of any other ingredient, except hydrochloric acid and water, would produce blue dye, or violet dye. Whether the plaintiffs had ever made or sold any blue dye made without any other ingredient added to the said four ingredients, namely, red aniline dye, a homologue of aniline, hydrochloric acid, and water.

(7.) The plaintiffs were required to set forth how they made out that Girard's specification was sufficient to produce the blue dye, particularly the manner and process of performing the invention, by stating the chemical composition of the red

(k) *Stocker v. Rodgers*, 1 C. & K. 99; *Bovill v. Hadley*, 17 C. B. N. S. 435.

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32.

the patent might be considered to have come in question so as to entitle the plaintiff to a certificate (*l*).

The certificate should be applied for at the trial; the judge has no power to grant it after taxation (*m*).

The certificate, if proved in a subsequent action, should not be given in evidence during the progress of the trial, which might prejudice the defendant's case, but should be proved only in the event of, and subsequent to, a verdict being given for the plaintiff to entitle him to his extra costs (*n*).

Remedy
in case of
groundless
threats of
legal pro-
ceedings.

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

Circulars.

This section in effect gives legislative sanction to the principles laid down by the late Vice-Chancellor Malins, in *Rollins v. Hinks*, and *Axmann v. Lund* (*o*), where it was held that the Court will restrain a patentee from issuing circulars threatening legal proceedings

(*l*) *Gillett v. Wilby*, 9 C. & P. 334.

(*m*) *Gillett v. Green*, 7 M. & W. 347.

(*n*) *Newhall v. Wilkins*, 17 L. T. O. S. 20.

(*nn*) See *Barnett & Foster v.*

Barrett's Screw Stopper Bottling Co., O. J. Rep. vol. i. p. 9; *Household v. Fairburn*, O. J. Rep. vol. i. p. 109.

(*o*) L. R. 13 Eq. 355; L. R. 18 Eq. 330.

against infringers, unless he will undertake to commence proceedings to assert the validity of his patent.

These decisions were very much questioned, if not by implication overruled, by the late Master of the Rolls and the Court of Appeal in *Halsey v. Brotherhood* (p). Here it was laid down that a patent so long as it subsists is *primâ facie* good, and therefore a patentee who issues notices against purchasing from a vendor alleging infringements of his patent is not bound to follow up his notices by taking legal proceedings; and, provided he issues the notices *bonâ fide* in assertion of what he believes, though erroneously, to be his legal rights under his patent, he does not render himself liable to an action by the vendor for damages for injury caused by issuing them. But it was admitted that he may be liable, notwithstanding his *bona fides*, to be restrained by injunction from continuing to issue the notices, if it is proved in the action for an injunction that his allegation of infringement is untrue.

There is a somewhat earlier case of *Wren v. Weild* (q), upon the subject of circulars containing allegations to the effect that articles sold by another person are infringements of patent rights alleged to be vested in the person issuing the circulars. The facts in this case were as follows:—The plaintiffs brought an action, alleging in their declaration that the defendant falsely and maliciously wrote to and told persons who had bought certain machines of the plaintiffs, that the machines were infringements of the defendant's patent, and that the defendant claimed royalties for the use of the machines, and that if they used the machines without paying royalties he should take legal proceedings: the defendant pleaded not guilty: the plaintiffs, at the trial, offered to prove various specifications and machines, existing before the date of the defendant's patent, to shew that the defendant's specification claimed matters that were not new, and also that the defendant had used them: the judge ruled that, as the defendant's patent was still subsisting the evidence was immaterial, and directed a nonsuit. Upon a motion for a new trial it was held, that the ruling of the judge was right; that where a person claims a right in himself which he intends to enforce against a purchaser he is entitled to give the intended purchaser warning of his intention; and that no action lies for giving such preliminary warning, unless it can be shewn, either that the threat was made *malâ fide*, only with the

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Threats of
legal pro-
ceedings.

(p) 15 Ch. D. 514; 19 Ch. D. C. A. 386.

(q) L. R. 4 Q. B. 730. Compare *Dicks v. Brooks*, 15 Ch. D. C. A. 22.

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Threats of
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ceedings.

Circulars
defama-
tory of the
business of
another.

intent to injure the vendor, and without any purpose to follow it up by an action against the purchaser, or that the circumstances were such as to make the bringing of the threatened action altogether wrongful.

The declaration in the last case did not allege that the publication by the defendant was "without reasonable and probable cause," but the judgment was not based entirely (if at all) upon the absence of such an allegation.

With regard to similar circulars containing allegations that what a person is doing by manufacturing or selling certain articles is an infringement of rights (whether patent or not) vested in the persons issuing the circulars (*r*) or allegations disparaging the quality of the articles manufactured or sold by such other person (*s*) or otherwise defamatory to the trade carried on by him (*t*), it is now fully settled that not only can damages be obtained by the injured party, but also an injunction to restrain the further publication of the defamatory circulars at the hearing and also in a proper case and upon sufficient evidence on an interlocutory application (*u*).

It will be noticed that the language of the above section includes only a "person claiming to be patentee." Whether the section will be construed so as to apply to persons not themselves "patentees" (under which term are included by sect. 46 "persons for the time being entitled to the benefit of a patent") but having or claiming to have some other rights, such as licensees and the like, is perhaps doubtful (*x*). If not, it would seem that such persons, on the principles laid down in *Wren v. Weild* and *Halsey v. Brotherhood*, will be under no liability for issuing circulars containing statements of the kind in consideration notwithstanding that it is conclusively shewn that the patent by them alleged to be infringed is in fact and law altogether invalid.

(*r*) *Saxby v. Easterbrook*, 3 C. P. D. 339. Compare *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. 757; *Société Anonyme des Mfs de Glaces v. Tilghman's Patent Sand Blast Co.*, 25 Ch. D. C. A. 1.

(*s*) *Western Counties Manure Co. v. Lawes Chemical Manure Co.*, L. R. 9 Ex. 218; *Thorley's Cattle*

Food Co. v. Massam, 14 Ch. D. C. A. 763.

(*t*) *Thomas v. Williams*, 14 Ch. D. 864. Compare *Clark v. Adie*, 21 W. R. 456, 764.

(*u*) *Burnett v. Tak*, 45 L. T. 743; *Hill v. Hart-Davies*, 21 Ch. D. 798.

(*x*) See cases in notes, p. 54, *ante*.

Miscellaneous.

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SS. 33-8.

Patent for one invention only.

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

Section 116.

Patent Rules, 23.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

Patent on application of representative of deceased inventor.

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

Patent Rules, 24.

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

Patent to first inventor not invalidated by application in fraud of him.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as

Assignment for particular places.

(*y*) See *Vincent's Patent*, L. R. 2 Ch. 341.

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SS. 36-9.

Loss or
destruction of
patent.

effectually as if the patent were originally granted to extend to that place or part only (*yy*).

Section 110.

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

Patent Rules, Second Schedule, Form N.

Proceedings and costs before law officer.

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

See the "Rules Regulating the Practice and Procedure on Appeals to the Law Officers," *post*.

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

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

(*yy*) *Borill v. Finch*, L. R. 5 C. P. 523.

for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

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SS. 39-
41.
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(a.) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(b.) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important (a).

**Publica-
tion of
illustrated
journal,
indexes,
&c.**

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

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

(a) Patent Rules, 31.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject

**Patent
Museum.**

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to such directions as Her Majesty in Council may see fit to give.

SS. 41-3.

Power to
require
models on
payment.

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

Foreign
vessels in
British
waters.

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

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

The provisions in sub-sect. 1 are in effect the same as sect. 26 of the Patent Law Amendment Act, 1852, which to a great extent abolished the principle enforced in *Caldwell v. Van Vlissingen* (z), where an injunction was granted to restrain the owners of a foreign

(z) 21 L. J. Ch. 97; 16 Jur. 115.

vessel from using while in English waters a propeller which was an infringement of an English patent.

It will be observed that the section applies only (a) to the "use" of an invention (b) for the "purposes of the navigation" (c) of a "foreign" vessel, and (d) that the enactment does not exempt from liability the vessels mentioned in the latter sub-section.

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SS. 43-4.

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

**Assign-
ment to
Secretary
for War of
certain in-
ventions.**

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

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

(4.) If the Secretary of State so certifies, the applica-

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Assign-
ment to
Secretary
of State
for War of
certain
Inven-
tions.

tion and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies or such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

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

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

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it.

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

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in

relation to which the Secretary of State has certified as aforesaid.

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

SS. 44,
45.

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

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

Existing Patents (zz).

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

Provisions
respecting
existing
patents.

(2.) Every patent granted before the commencement

(zz) As to how far the Act applies to existing patents see *Nordenfelt v. Gardner*, O. J. Rep. vol. i., p. 10; *Winter v. Baybut*, *Madeley*

& Co., *ibid* p. 76; *Singer v. Stassen*, *ibid* p. 121; *Brandon's Patent*, *ibid* p. 154.

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of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses (a).

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

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

(a) See section 113.

Existing
patents.

It will be observed that by this section the provisions of the Act are applied to all patents without distinction, whether granted before or after the passing of the Act, with the sole exceptions that patents (a) already granted, or (b) to be granted upon pending application, shall remain unaffected by the provisions relating (1) to patents binding the Crown, and (2) to compulsory licences.

This enactment is unqualified, and if so held (and it is submitted that it ought to be so held) it will relieve patents existing at the passing of the Act both (a) from the qualifications expressly introduced by sect. 25 of the Patent Amendment Act, 1852 (a), and (b) from the restrictions imposed by the Privy Council in respect of extensions of patents coming within such section (b).

(a) Which section in substance avoids patents granted in the United Kingdom in respect of inventions first invented in a foreign country, and there patented before the grant of the home patent, at the expiration of such foreign patent—see *Borill v. Goodier* (No. 2), L. R. 2 Eq. 195; *Poole's Patent*, L. R. 1 P. C. 514; *Daw v. Eley*, L. R.

3 Eq. 496, 511; *Winan's Patent*, L. R. 4 P. C. 93; *Blake's Patent*, L. R. 4 P. C. 535; *Holste v. Robertson*, 4 Ch. D. C. A. 9. Compare *ante*, pp. 28-9.

(b) See *Hill's Patent*, 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; and *Winan's Patent* and *Blake's Patent*, *ubi supra*.

Definitions.

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**Definitions
of patent,
patentee,
and in-
vention.**

46. In and for the purposes of this Act—

“Patent” means letters patent for an invention :

“Patentee” means the person for the time being entitled to the benefit of a patent :

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

In Scotland “injunction” means “interdict.”

Sect. 6 of the Statute of Monopolies is as follows:—“ Provided also that any declaration before mentioned shall not extend to any letters patent and grant of privilege for the term of fourteen years or under, hereafter to be made, if the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents, and grants shall not use so as also they be not contrary to the law nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents, or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.”

REQUISITES OF A VALID PATENT.

The description of what constitutes a valid patent contained in the above section is very vague. Consequently the section has been largely supplemented by very numerous decisions. It is not possible here, and indeed it would be beyond the scope, to attempt to set forth a summary of these decisions. But the leading and guiding principles to be extracted from them may be shortly stated in the following propositions.

**Requisites
of valid
patents.**

I. A mere principle cannot be patented.

**I. Prin-
ciple.**

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Requisites
of patents.

This maxim or statement has been enunciated in numerous judgments and is established beyond dispute. But it holds only when and so far as it is applied to a "mere" principle. "A man cannot take out a patent for an idea, but he may take out a patent, if I may say so, for an idea coupled with a practical process of effecting that idea" (c). It will suffice if accompanying the principle stated by the patentee, and the discovery of which probably constitutes the real if not the sole merit of his invention, there is stated some process or mode however crude, if really "usable" as a commercial proceeding, whereby the principle can be made available. Consequently patents have frequently been supported, the essence of which has consisted in the principle enunciated by the patentee rather than in the mode stated by him of rendering his principle practically useful—as in the well-known instance of Watt's steam engine (d), the hot air blast (e), the use of anthracite instead of ordinary coal (f), and many cases of patents for chemical or electrical discoveries.

II. Manu-
facture.

II. A patent must be for some description of manufacture.

The term "manufacture" is used in the Statute of Monopolies. It is to some extent ambiguous, for it may denote either (a) the mode or process of manufacturing, or (b) the result thereof—the thing or product manufactured. It has long been fully established that the word includes both meanings—that is, that a patent will be valid which relates to either a fresh process or mode of production, or to a new thing produced by old or improved machinery or processes.

The difference between these two meanings of the word "manufacture" will often give rise to important consequences in considering the validity of patents and the rights of patentees.

If a patent is for a new product, one not known previously as a commercial commodity, and the patentee describes a practical mode of producing the product, then he acquires a monopoly of such commodity (g).

If on the other hand the patent is for a process or for machinery or other means of carrying such process into operation, then the

(c) *Per Pearson, J., in Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 162.

(d) *Boulton v. Bull*, 2 H. Bl. 463.

(e) *Neilson v. Harford*, 1 Web. P. C. 295.

(f) *Crane v. Price*, 1 Web. P. C.

377. Compare *Muntz v. Foster*, 2 Web. P. C. 93; *Stevens v. Keating*, 2 Web. P. C. 175.

(g) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 171-3, and cases there cited.

patentee has no monopoly as to articles which can be produced by such processes, machinery, or means—they may be produced by any one who can do so by using other means than those described in the patent—but he is entitled to prevent any one using his peculiar process, machinery, or means or trafficking, or using articles produced by means thereof (*h*).

III. The requisites of an invention, in order that it may be patentable, are, that it must be “new within the realm,” and also useful.

When a process or a product is “new” in the sense of being admittedly different to what has been in use or been known before there can be little difficulty in determining whether or not it is “new,” so as to be the subject of a valid patent. But difficulties arise when the process or product in question resembles in certain salient aspects processes or products already in use or known. It is impossible to lay down any definite rules as to what amount of prior information will render a patent void for want of novelty. It is clear however that prior actual knowledge is not necessary to do so—mere suggestions may be sufficient, provided such suggestions have taken such a form that they could be put into practical operation (*i*).

A good illustration of the difficulties attendant upon this question of novelty is shewn by the history of the litigation of *Betts v. Menzies* (*k*). It was an action for an infringement and the main defence was that Betts’ patent was invalid on the ground that his invention had been discovered by Dobbs and been by him set forth in two specifications published long prior to Betts’ patent. There were two trials, both which resulted in verdicts for the plaintiff—the Court of Queen’s Bench directed a verdict to be entered for the defendants—the Exchequer Chamber by a majority affirmed this decision—and finally the House of Lords reversed the decisions below, and directed the verdict obtained for the plaintiff to stand. Lord Westbury said (*l*), “I pass on to the next conclusion, which is involved in the answer of the learned Judges to your Lordship’s question, and that conclusion, I think, is also of great importance to the law of patents, because it results from that opinion that an antecedent specification ought not to be held to be

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of patents.
III. New.

Informa-
tion con-
tained in
prior pub-
lications.

(*h*) *Von Heyden v. Neustadt*, 14 Ch. D. C. A. 230, and cases cited. Ch. D. 720, affirmed in the C. A. W. N. 1883, p. 21.

(*i*) See *United Telephone Co. v. Harrison, Cox-Walker, & Co.*, 21 (*k*) 10 H. L. C. 117.
(*l*) 10 H. L. C. 154.

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of patents.

an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery. Here we attain at length to a certain undoubted and useful rule. For the law laid down, with regard to the interpretation of a subsequent specification, is equally applicable to the construction to be put upon publications or treatises previously given to the world, and which are frequently brought forward for the purpose of showing that the invention has been anticipated. The effect of this opinion I take to be this, if your Lordships shall affirm it, that a barren, general description, probably containing some suggested information, or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding, for want of novelty, a subsequent specification or invention which involves a practical truth, productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical and useful information."

IV. Sim-
plicity.

IV. If it is established that the discovery claimed by a patentee is in reality new and practically useful, the patent will be good, however small or simple may be the actual discovery itself.

Very frequently the chief merit of an invention consists in its simplicity, and in every case undoubtedly the more simple the process is the more useful it will be. All that is required is that there should be a discovery of something materially different from what was already in existence. In reference to this point, Jessel, M.R., thus expressed himself in the case of *Hinks & Son v. Safety Lighting Co. (m)*. "The only material difference between the two patents which was pointed out was this, that one used a round wick and the other a flat wick. On the one hand it was said you can never support a patent by substituting a round wick for a flat wick, as there is no invention in that. On the other hand it was said, Why not? If it is a combination patent, the very essence of a combination patent is that it is a new combination of known parts, and in fact very few machines are now invented which contain any new part. As a general rule, every machine invented is made up of parts which are previously known. A new part of a machine is very uncommon indeed; consequently that is an objection which, *per se*, is not of great weight. But, like every combination which is new, it must have merit, and now how is a Judge to apportion the merit? I do not know. As far as I can

(m) 4 Ch. D. 607, 615-6.

ascertain from the authorities, the merit very much depends on the result produced. Where a slight alteration in a combination turns that which was practically useless before into that which is very useful and important, Judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and, as far as a rough test goes, I know of no better."

V. While it is necessary in order that an invention may be patentable, that the new manufacture to which it relates should consist in the creation of a new and distinct trade, machinery, process or product, it will be sufficient if the invention consists in a substantial improvement in an existing machine, process or mode of using any commodity.

A good case illustrative of the principle here stated, is *Cannington v. Nuttall* (n). The patent in this case was for improvements in the manufacture of glass, and consisted substantially in making various alterations in the processes of manufacture then practised, but as to which the patentee made no claim, and combining these things with an improved furnace, and he described his invention as consisting in "forming the sides of the tank or chamber containing the glass making materials hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or inclose the fused material." It was held that this patent was perfectly good, and Lord Hatherley, L.C., thus expressed himself: "It was suggested in one case, I think, that a tank should be used and placed upon the earth, and fire applied to the sides. But although all these things had been done, yet the glassmakers had not yet got what they wanted; they had not got an effectual mode of getting rid of the pots, and getting rid of the sieges, and making glass without them. Now, said the patentee, I think I have got it; but in the first place I said that my invention consisted in doing that. But that was a wrong expression, because others know that that can be done, and they have tried it; so I had better not speak of my invention as being the removal of the sieges, or the removal of the pots, but my mode of effecting the object is by so placing the tanks as to obviate the bursting of the pots through the extreme heat. I will make that very objection, if it takes place, work its own cure. I will so carry the air around the sides of the tank that when the melted material does burst forth from it, and permeate a portion of the sides of the

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**V. Im-
prove-
ments.**

(n) L. R. 5 H. L. 205.

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tank in consequence of the extreme amount of heat to which the tank is subjected, I will take care that an external cooling apparatus shall be at hand which shall arrest and congeal the fluid, and enable the congealed fluid to operate to the end that we have in view. It is quite apparent, my Lords, that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every new invention—the skill and ingenuity of the inventor are shewn in the application of well-known principles. Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a practical result not yet achieved. And I take it that the test of novelty is this. Is the product which is the result of the apparatus for which an inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view.”

VI. Im-
proved ap-
plication
of existing
machines.

VI. An invention is patentable if it consists in the improved application of existing machines to materials whether old or new.

This is the principle upon which patents for combinations are based. If there be a new and beneficial combination and application of old and well-known machinery, a patent properly limited to and claiming this combination will be valid (o). And “if a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered consisting, for example, of the introduction of some new parts or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented” (p).

Combina-
tion pa-
tents.

“Combination” patents may claim and consist of either (a) merely and solely the combination, or (b) both the combination and something new, whether in the process used or in the respective products in connection therewith.

In the case of the former class of patents it is the combination

(o) *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Harrison v. Anderston Foundry Co.*, 1 App. C. 574; *Saxby v. Gloucester Waggon Co.*, 7 Q. B. D. 305.

(p) *Per Lord Westbury, C.*, in *Foxwell v. Bostock*, 4 D. G. J. & S. 311; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, O. J. Rep. vol. i. p. 98.

itself and alone which is the subject of the patent, and upon the novelty of which the validity of the patent depends, and in such case where "the claim is for a combination and nothing but a combination, there is no infringement unless the whole combination is used" (q).

In the latter case as the patent claims both the combination and also the additional matter alleged to be new, on the one hand the validity of the patent will depend upon the novelty both of the combination claimed and of the additional matter, and on the other hand the patent may be infringed by the user either of the combination or of the other matter claimed as new (r).

VII. But an invention or that which is claimed to be an invention is not patentable, if it consists merely in the user about other, it may be new (already known) materials of existing machinery already employed in connection with other analogous materials or substances.

A leading case on this is *Brook v. Aston* (s), where the plaintiff's patent was held bad. Martin, B., said: "The question therefore is, whether another person can take the same machinery as was patented in 1853 for linen and cotton yarn, and obtain a patent for the application of it to woollen and thread. I quite concur in the judgment of the Court of Common Pleas in *The Patent Bottle Envelope Co. v. Seymer* (t), that the application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes in fact a tool. I am therefore of opinion, that the application of this machinery to woollen yarn is not the subject of a patent."

As illustrations of the limitations in respect of patentable matters enunciated in the above proposition may be mentioned and compared the cases of *Parkes v. Stevens* (u), where it was held that the adaptation of a sliding door to a spherical lamp, sliding doors having previously been applied to cylindrical lamps and to other glazed surfaces, cannot of itself be the subject of a patent, and

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ployment
of mere
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(q) *Per Cairns, L.C.*, 1 App. C. 578. Compare *Bovill v. Keywood*, 7 E. & B. 725; *Thomas v. Foxwell*, 5 Jur. N. S. 37, 39; *Moore v. Bennett*, in the House of Lords, O. J. vol. i. p. 129.

(r) See *Leather v. Lister*, 8 E. & B. 1004, 1031; *Foxwell v. Bostock*,

4 D. G. J. & S. 298; *Clark v. Adie* (1), 2 App. C. 315; *Cropper v. Smith* (C.A.), W. N. 1884, p. 80; O. J. Rep. vol. i. p. 81.

(s) 8 E. & B. 478; 28 L. J. Q. B. 175, 176.

(t) 28 L. J. C. P. 22.

(u) L. R. 5 Ch. 36.

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Murray v. Clayton (v), where it was proved that a machine for which a patent had been granted was shewn to produce work more expeditiously, more economically, and of a better quality than any previous machine; and it was held that the patent could not be invalidated on the ground that the machine was formed by the mere arrangement of common elementary mechanical materials, producing results of the same nature as those previously accomplished by other mechanical arrangements and construction.

PART III.

DESIGNS.

Registration of Designs.

**PART
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Applica-
tion for
registra-
tion of
designs.

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

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

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

(v) L. R. 7 Ch. 570. Compare *Harrison v. Anderston Foundry Co.*, 1 App. Cas. 574; *Clark v. Adie*, (No. 1) 2 App. Cas. 315.

(vv) This section differs materially from the previous statute, 5 & 6

Vict. c. 100, s. 3, in omitting the very important words "or elsewhere." Consequently it would seem that now prior publication to vitiate a design must be publication within the United Kingdom.

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

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

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

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

(α) Designs Rules, 4, 6, 12.

(β) Ibid. 9 and Form E, First Schedule to Designs Rules.

(γ) Designs Rules 5 and Third Schedule.

(δ) Compare *Barran v. Lomas*, 28 W. R. 973.

(ε) Designs Rules, 6-9.

(ζ) Ibid. 16-20.

(η) See sect. 62, sub-s. 4, as to Trade-Marks.

See Sections 54, 60, 61.

DESIGNS.

The only indication of the meaning of "Design," as used in the Act is in the so-called definition in section 60, which however does not state what are the requisites of a "design," but merely limits the expression for the purposes of this Act to designs applicable to the articles, substances, and things therein referred to.

A design may be stated to be some peculiar shape, configuration, or form, given to any article or pattern, or arrangement of lines or the like used on or with an article, and not the article itself. It is this which separates a design from a patent having for its subject a new product. If what is claimed in any particular litigation is an article or thing itself, then the claim to be valid must be based upon a patent—if it is the peculiar shape, pattern, or appearance of the article which is claimed, then this is a claim for a design.

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Erle, J., thus expressed himself in reference to this point (*w*): "It is a combination of means for the purpose of easily admitting air and avoiding a downward draught, and there is a skilful combination of means to produce this result. But the particular shape or configuration is accidental and wholly unimportant, and unconnected with the purpose to be attained. An oblique pane is of no particular use; a square or circular pane, and a straight or curved screw, would produce the same result. If the prosecutor relies on the shape or configuration as producing a useful result, he fails in making out that the defendant has infringed the protected right, because there is no doubt that the shape of the defendant's invention varies materially from that registered by the prosecutor; in the one the pane being nearly square and in the other oblong, and the screw being straight in the one, and crooked in the other. The prosecutor intended to protect a combination of means producing a useful result, and that is within the law relating to patents, and not within statute 6 & 7 Vict. c. 65."

Scanda-
lous.

By section 73 no "scandalous" design may be registered, and by section 86 the same prohibition extends to one which is contrary to law or morality.

Immoral.

The design must be "new or original," and not previously published within the United Kingdom (*x*).

Person
entitled to
register.

The person entitled to register is the "proprietor," who by section 61 is the "author," except when the author has executed the design for another person for good consideration, in which case the latter person is the proprietor; and so a person who acquires a design for good consideration is the proprietor.

Employers.

The employer of a workman who invents a design is "the proprietor" of it (*y*); but persons who purchased a design from abroad (*z*), and who acquired from foreign manufacturers the sole

Pur-
chasers.

(*w*) *Reg. v. Bessell*, 15 Jur. 773, 16 Q. B. 810. Compare per Byles, J., and Wightman, J., in *Harrison v. Taylor*, 4 H. & N. 815; 29 L. J. Ex. 3; 5 Jur. N. S. 1219.

(*x*) As to what will amount to publication, see *Hunt v. Stevens*, W. N. 1878, p. 79. Whether "publication" includes making known in any manner, *e.g.* by the issue of the design in a book or the like, or is limited to publication by

actual user of the design in connection with some article, *quære*—see *Dalglisch v. Jarnie*, 2 Mac. & G. 231, 2 H. & T. 437; and compare sect. 50, sub-sect. 2. The expression in which "before delivery on sale" may perhaps be held to give to "publication," the more restricted meaning.

(*y*) *Lazarus v. Charles*, L. R. 16 Eq. 117.

(*z*) *Ibid.* p. 121.

right to sell articles improved with the design (a) were respectively held not to be proprietors.

Valid Designs.

It has been decided that the following matters claimed as designs under former statutes were good and valid designs, namely :

A brick having on two of its opposite sides a semicircular cavity corresponding with a similar cavity in a brick placed next to it (b).

A peculiar arrangement of six stars in an ornamental chain forming together the ornamentation of a woven fabric (c).

A pattern for woollen cloths in which large and small honeycomb cells were so arranged that the border of the larger cells surrounded an enclosed portion of the smaller cells, though neither the large nor the small honeycomb was new (d).

An arrangement consisting of a dish and cover forming one compound article (e).

A combination of two old and well-known designs, if forming a new pattern or arrangement (f).

But in order that a combination design may be good, the combination must constitute one new design and not be in reality a collection of separate designs (g).

Invalid Designs.

On the other hand, the following claimed as designs have been held to be invalid, and not entitled to protection, namely :—

A mechanical contrivance in connection with a dog-cart phaeton, allowing the hind wheels to be turned more easily (h).

A photograph of a public character (i).

And it was doubted whether a mechanical contrivance within the stem of a parasol for raising or lowering it with one hand (k);

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tions.

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

(b) *Rogers v. Driver*, 16 Q. B. 102.

(c) *Holdsworth v. M'Crea*, L. R. 2 H. L. 380.

(d) *Harrison v. Taylor*, 4 H. & N. 815.

(e) *Fielding v. Hawley*, 48 L. T. 639.

(f) *R. v. Firmin*, 15 "Justice of the Peace," 740, cited in *Harrison v. Taylor*, *ubi supra*; *Norton v. Nicholls*, 1 E. & E. 765.

(g) *Norton v. Nicholls*, *ubi supra*; *Mulloney v. Stevens*, 10 L. T. 190;

Lazarus v. Charles, *ubi supra*. In the use of a combination design, as with a combination patent, it is the combination which is protected, not the separate parts.

(h) *Windover v. Smith*, 32 Beav. 200.

(i) *Adams v. Clementson*, 12 Ch. D. 714.

(k) *Millingen v. Picken*, 1 C. B. 799.

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and whether a label having in it an eyelet hole lined with a metallic ring through which a string was passed for attaching it to packages (*l*) were valid designs.

The question of novelty is for the jury to be decided by visual inspection aided by the evidence of experts where necessary (*m*).

SUB-SECTION 7.

This sub-section contains no provisions, either allowing an appeal from the Board of Trade to, or authorizing the Board of Trade to refer any matter to the Court (*n*).

Jurisdiction of Board of Trade.

It seems therefore to follow that the jurisdiction of the Board of Trade is necessarily final, but it is submitted that in any case this jurisdiction is subject to the general powers of rectification of any register vested in the Court by sect. 90.

Drawings, &c., to be furnished on application.

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

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

(*a*) Designs Rules, 8, 9, 30.

(*β*) Ibid. 13.

Apparently in addition to "representations or specimens" there must, pursuant to sect. 47 sub-sect. 3, be a sufficient written description of a proposed design.

In *Norton v. Nichols* (*o*) Page Wood, V.C., differing from the Queen's Bench in the same case (*p*), held that the registration of a

(*l*) *Margetson v. Wright*, 2 De G. & S. 420.

(*n*) *Harrison v. Taylor*, *ubi supra*. Compare *Mitchell v. Henry*, 15 Ch. D. 181; and *ante*, p. 69.

(*n*) See sect. 62 as to Trade Marks.

(*o*) 4 K. & J. 475.

(*p*) 5 Jur. N. S. 1203.