

A COMPLETE TREATISE

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UPON

THE NEW LAW OF PATENTS, DESIGNS  
AND TRADE MARKS

BEING

THE PATENTS, DESIGNS AND TRADE MARKS  
ACT, 1883,

WITH THE RULES AND FORMS,

FULLY ANNOTATED WITH CASES, &c.,

AND A

STATEMENT OF THE PRINCIPLES OF THE LAW UPON  
THOSE SUBJECTS;

WITH A TIME TABLE AND COPIOUS INDEX, AND AN ABRIDGMENT  
OF THE CUTLERS' CO. ACTS.

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BY

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## PREFACE.

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THE Patents, Designs and Trades Marks Act of 1883 is designed, according to its authors, to consolidate the law relating to those subjects into one statute. This, so far as the statute law was concerned, the new Act has accomplished, by the simple process of repealing all previous enactments, and repealing, amending, adding to, or omitting from their provisions. But that large and important body of law relating to the subjects of the Acts which exists in precedent, and is only to be found in the reports of decided cases, is left unaffected and undigested by it. The Act has therefore not done what some persons expected it would do, that which was accomplished by the Bills of Exchange Act of 1882—the codification of the law. And since all the principles of the law upon the important subjects of Patents and Trade Marks have been essentially not the creation of legislation, but of judicial decision, it is obvious that a large part of the law relating to these subjects is not to be found in the Act.

The writer, in designing the present work, has found it necessary to bear this strongly in mind. In order to prepare a book for the use of practitioners and patentees in working out the new Act, something more was necessary than the Act itself and annotations; such persons are entitled to expect that such a book should contain the whole law upon the subjects upon which it professes to

treat. The writer has, therefore, attempted to do that which the Act has left undone, and to digest the principles of the law upon the subject of Patents, Designs, and Trade Marks respectively, and to state them in a clear but concise manner in the three chapters with which the book commences. If he has succeeded in carrying out his intentions, a perusal of these chapters, or a reference to any particular point in them, will inform or remind the reader of the principles of the law, and enable him to understand and work out the Act itself.

In the Fifth Section of the First Chapter the all important subject of the preparation of the Title of the Patent and of the Provisional and Complete Specifications has been very fully dealt with, and an attempt has been made to formulate the rules which should govern the preparation of those documents.

In the annotations to the Act the first object of the writer has been to render them of practical utility. Where points of doubt arise as to the construction of particular sections it has been his object to solve them where it appeared possible to do so; and where not, to collect all the information material for their solution, and to suggest the reasons *pro* and *con* for their decision. The cases have been carefully examined, and all those of any importance reported up to the present will, it is believed, be found noted in their places.

One of the first subjects upon which a reader seeks information in a work upon a new Act of Parliament is as to the changes in the law. With the object of giving this information authoritatively, the writer has reprinted in this volume the Memorandum endorsed upon the Act upon its first introduction into the House of Commons, giving it a

chapter to itself. The changes in the law will there be found stated in the language of its authors.

It has been a subject for consideration whether, in addition to printing the Rules, which, of course, are essential to the practical working of the Act, it was worth while to increase the bulk and expense of the book by also printing the numerous Forms which have been issued by the Patent Office, considering that the latter are easily obtainable, and at a very cheap price. But forms issued by authority render so much assistance in understanding and carrying out a new Act of Parliament, throw so much light upon the intentions of the legislature, and, therefore add so much to the practical value of a book, that it has been decided to print them.

A Time-Table, or tabular statement of the times within which the various proceedings required by the Act and Rules must be taken, will be found printed immediately before the Index. This is divided into three parts relating to—(1) Patents; (2) Designs; and (3) Trade Marks respectively. By referring to it, the times for doing anything can be found at a glance, collected altogether, without the tedious process of referring to the scattered sections of the Act, and to the various rules governing the subject.

To facilitate reference, cross references to the Act and Rules have been given when it appeared desirable, and a full Index is appended, which will enable reference to any part of the book easy to be made.

To find the Forms it will be necessary to refer in the Index to the head of "Forms" where a complete list of them is set out with a reference to the page upon which they are respectively printed.

A Table of Cases with references to the pages upon which they are cited will be found at the commencement of the book.

The writer desires to say that this book is intended as a Manual of Practice or Practical Treatise upon the New Law introduced by the Act of last Session. It does not propose to compete with or supersede the numerous elaborate Treatises which have been published upon the Law of Patents—to some of which, especially to the excellent work of Messrs. Johnson, the writer desires to express his obligations—and upon the Law of Trade Marks.

In conclusion, may one observation be permitted: the critical examination of the Act and Rules, which the preparation of this work has required the writer to make, has convinced him, notwithstanding all that has been said to the contrary, that skilled assistance is as necessary as ever to the patentee and to the applicant for the registration of a design or a trade mark, to guide him safely through the process of acquiring the exclusive privilege he desires to obtain.

E. MORTON DANIEL.

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# CHAPTER I.

## PATENTS FOR INVENTIONS.

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### SECTION I.

#### THE NATURE OF A PATENT.

LETTERS PATENT are the instrument by which any grant from the Crown is made to a subject. In ancient times, when grants of land or revenues were made by the sovereign, they were generally made by Letters Patent. And from the earliest times down to the present, grants of privilege and dignity were and are always granted by these instruments. When a new peer is made, or a new dignity granted, it is always by Letters Patent.

In the times preceding the Protectorate, the sovereigns of this country, notwithstanding the opinions always held by constitutional lawyers that they were illegal, were in the frequent habit of granting Letters Patent to various persons and corporations, of the exclusive right or privilege of manufacturing and selling articles of ordinary commerce, to be exercised for the profit of the grantees, and securing it to them by giving the power to prosecute; by fine or imprisonment, the infringers of the privilege so granted. This practice reached to a great height during the reign of Queen Elizabeth, and was unsparingly exercised by her successor, until monopolies were granted for the exclusive privilege of manufacturing and selling even the commonest articles of commerce, without the smallest regard to the interests of the public, for the gratification of the favourites of the sovereign, or in return for sums of money paid by the grantees to the sovereign.

These monopolies were very oppressively exercised, and tended greatly in restraint of commerce, and towards the

raising of the prices of articles of everyday use to a very inconvenient degree. They naturally excited very great odium; and in one of the first Parliaments which the necessities of James I. compelled him to call, the subject was energetically taken up. The great Sir Edward Coko was a member of the House of Commons then assembled; and, under his leadership, the famous Statute of Monopolies (the 21 James I., cap. 3) was passed in the form of a declaratory Act, strongly and vehemently alleging the illegality of all monopolies in restraint of trade, and denying the assumed prerogative of the Crown to grant them, and declaring them to be against common law, and to be for ever afterwards null and void and without effect.

From the sweeping provisions of this Act, however, Letters Patent for inventions were expressly exempted, and this exception will be best understood by the words of the Statute itself—(Section 6 of 21 James I., cap. 3):—

“Provided also, and be it declared and enacted, that  
 “any declaration before mentioned” (the declaration that  
 all monopolies for the sole buying, selling, working or using  
 of anything shall be void and of none effect, contained in  
 sections 1 to 5) “shall not extend to Letters Patent and  
 “grants of privilege for the term of fourteen years, or under,  
 “hereafter to be made of *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 patent  
 “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 incon-  
 “venient: the said fourteen years to be accompted from the  
 “date of the first letters patent, or grant 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.”

This section still remains in force, and all patents for



invention which are granted must come within its provisions.

Letters Patent are construed strictly and most favourably for the sovereign, contrary to the principle governing the grants of ordinary persons, which are construed most favourably to the grantee. If they can be interpreted in two ways they shall be taken in the sense the more favourable to the sovereign—(Bacon's Abridgt. Prerogative, F., pt. 2). But where the Letters Patent are capable of being read in different ways, by one of which they would be valid and the other invalid, the construction will be in favour of the validity, because it cannot be presumed that the sovereign intended to make a void and illusory grant—(Bewley's Case, 9 Rep. 131a).

2nd. There must be no misrepresentation to the Crown of the facts upon which the Letters Patent are granted. Thus, if any one of the statements in the application of the inventor for the grant of Letters Patent to him is untrue, the patent is invalid, because it was granted upon a false suggestion to the Crown—(Case of Monopolies, Webst., P. C. 1, 5). But where the mistake is on the part of the sovereign, or his advisers, the Letters Patent are not void.

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## SECTION II.

### WHAT IS PROPERLY THE SUBJECT MATTER OF A PATENT.

We have seen that the 6th section of the Statute of Monopolies only excepted Letters Patent "for the sole working or making of any manner of new manufactures," and therefore anything to be properly the subject of Letters Patent must be a new manufacture. The word "manufacture" is, however, a very large term, and it has been construed to mean not only the article manufactured, but the method *Orane v. Price* (4 M. & G., 580), the process, or the machine by means of which the article is produced

—*Househill Company v. Neilson* (Webs. P. C., 683). It will be easily perceived that this construction of the word covers almost the whole ground of possible invention. In fact patents have been freely granted and upheld for machines, chemical and medical compounds, methods of treating various substances in order to manufacture them into articles of commerce, or to improve them when so manufactured; processes for treating articles while undergoing various stages of manufacture; applications of certain substances to specific purposes to which they have never hitherto been applied; combinations of known existing elements, machines, or parts of machines, so as to produce new effects; and improvements upon and additions to existing machines and processes. In fact, by far the greater portion of the novelty or improvement which the inventive faculty of mankind can produce is proper subject matter for protection for Letters Patent, and what may be patented will be more easily learned from a consideration of what may not be patented, than from a list of the various classes of invention for which Letters Patent may be obtained, which it would be hardly possible to render a perfect one.

Letters Patent will not be upheld for scientific principles not embodied into any practical form—*R. v. Wheeler* (2 B. & Ald. 349); L. J. C. Hope, *Househill Company v. Neilson* (W. P. C., 683).

Nor for a new use of an old invention, because there is no new art which can be made the subject of the patent privilege, the patentee having merely applied an old art to a new use—*Kay v. Marshall* (2 W. P. C., 21).

Nor is the application of an old contrivance proper subject matter for a patent, unless there be ingenuity in the application, because the art or invention is not new.

Nor is the application of a substance hitherto unapplied to a useful purpose, such as a newly discovered grain for

food, or natural substance for manure, proper subject for a patent, because there is no invention, no manner of new manufacture in doing so.

Nor can valid Letters Patent be obtained for schemes in which ingenuity very similar to that which produces inventions—using the word in its patentable sense—is displayed; such as methods of advertising, or calculating, or financial projects, nor for designs in which the novelty resides in mere ornamental effect; for the last of which another and appropriate protection is provided by means of registration of the copyright in the design, a subject which is dealt with in Part III. of the new Act, and the general principles of which are explained in chapter II.

But the above remarks must be taken with the qualification that if any process, method, or machine is, for the objects indicated above, not patentable, it is not on that account rendered incapable of protection by patent. The patents for these things will be perfectly valid if taken out for the method, the process, or the machine itself, and protection is not sought for the idea involved in its use. The method, or process, or machine, forms a new manufacture within the meaning, as construed by the courts, of the 6th section of the Statute of James, and as such is patentable.

For the sake of convenience, however, it may be well to endeavour roughly to classify the inventions for which valid Letters Patent may be granted, and the following is a useful list:—

1. New contrivances applied to new objects or purposes;
2. New contrivances applied to old objects or processes;
3. New combinations of old parts;
4. New methods of applying an old thing;
5. Processes or methods differing from old processes or methods only by the omission of something hitherto believed to be essential;
6. Chemical processes—(Johnson on Patents, 4th edition, p. 18);

To which the editor would add:—

7. The application of materials previously unapplied to any useful purpose, to specific useful purposes, where some ingenuity is required in the application  
—C. J. Tindal in *Muntz v. Foster* (2 W. P. C., p. 103).

It is evident that the first class in this list satisfies the fullest requirements of novelty in the invention. If both the contrivance be new and the purpose be new, the result must be novel, and a new manufacture introduced to the world. The case of an invention for removing the downy fluff which covered cotton lace when it comes from manufacture will serve to illustrate this. The invention consisted in applying the flame of gas in a particular manner for the purpose, which it answered completely. Upon a patent being granted, its validity was contested, and at the trial it was proved (1) that gas had been never so applied before, and (2) that the fluff had never been removed from cotton lace before. So, both the contrivance and the purpose being proved to be novel, the patent was upheld—*Hall v. Jarvis and Boot* (1 W. P. C., 100).

With regard to the second class in the above list—a new contrivance applied to an object before known—it is evident there is a new manufacture, not indeed using the word in the sense of the article produced, but in the sense of the new manner of producing it, that is to say, the new manner of producing the old article is itself a new manufacture. It is doing something which has not hitherto been done; and if the object produced by it is better or cheaper than the same object produced by the means or contrivance before known, there is clearly an invention of value. In a case where the invention was for an improvement in the smelting of iron, and consisted only in the use and application of lime and mine rubbish, in addition to the means ordinarily adopted, the patent was held good, it being laid down “that there might be a valid patent for a “new method (*i.e.*, contrivance) of applying materials

“previously in use.”—(L. C. Eldon, *Hill v. Thompson* (6 Mer., 626, 1 W. P. C., 237).

From the nature of things one would expect that inventions of this class would probably be the most numerous. Intelligent persons engaged in manufacture are naturally led to notice the imperfections in the methods or processes by which they work, and to endeavour to effect their removal. On reflecting upon the nature of the article which they are manufacturing they may conceive the idea of effecting its production by other contrivances or methods, and, after experimenting for a while, succeed in finding simpler means than those hitherto in use. And the fact coincides with the expectation, for, on examining the list of Letters Patent which have been granted, we find that inventions of this class appear most frequently; and any one acquainted with the subject would further tell us that not only are they the most numerous, but that in many instances they are the most important of all inventions.

Passing on to the next, or the third of the classes of inventions—new combinations of old parts—it will be seen that the claim to protection for inventions of this nature rests also upon the ground that by them also is a new manufacture introduced into the world. The old parts may be compared to the letters of the alphabet; the old combination to a word already in use, the new combination to a new word introduced into the vocabulary of the language. By a different arrangement of elements already existing something new is the result, and this is subject matter for a valid patent, provided the other great requirement of the law—that it be useful to the public—be satisfied. The case most generally cited as showing this doctrine upheld in our courts is certainly a strong one.

In the process of smelting iron the hot air blast had been used and the fuel known as stone coal had been used, but never together. A man obtained a patent for the use of them together, and it was found that a considerable

advantage resulted. The validity of the patent was contested on the ground that the alleged invention showed no novelty—the two things used were both as old as the hills. But the court held that the invention consisted in the combination, that the patent was granted for the combination, and, since the combination had been found to be useful, that the patent was a valid one—*Crane v. Price* (1 W. P. C., 408).

The next class of invention is for a new method of applying an old thing. Here, too, it is evident there is a new manufacture, provided the new method produces results different from and superior to those produced by the old. In this consists the test of invention. If the product of the new method of applying the old thing or process is better than that produced before there has been a benefit to the community; there is invention. The case in which a patent was taken out for using charcoal for refining sugar in a particular way when charcoal had long before been used in other ways, illustrates this doctrine. The patent was contested. It was proved at the trial that many advantages had resulted from the particular method of using the charcoal protected by the patent, and it was upheld—*Derosne v. Fairie* (1 W. P. C., 154).

The next class in our list is that of inventions of processes or methods differing only from processes previously known by the omission of a step or steps in them. In this case the claim to patent right rests upon the same ground as in all the others—that there is substantial invention disclosed by the specification.

By the omission of a step, believed before the invention to be essential, the process or method may be very greatly improved, simplified, or cheapened. This was the case with a patent which was taken out for welding iron tubes without the use of a mandril or internal support. Previously to this invention iron tubes were manufactured by turning up the edges of plates of iron round a mandril and ham-

mering them together. By the new process the tubes were produced by turning up the edges of plates until they almost met, and in then drawing them when heated through a die, by means of which the edges became welded together. But welding by means of pressure was old, and the patent was held to be good expressly on the ground of the dispensation with the use of the mandril, whereby tubes could be manufactured longer, more uniformly and cheaper than before—*Russell v. Cowley* (1 Webs. P. C., 457).

The next class is that of chemical processes. Instances in which patents were granted and upheld for them are the following:—

For mixing two or more substances in certain proportions resulting in a compound, useful for medicinal, manufacturing or other purposes, the cases of *Muntz v. Foster* (2 W. P. C., 103), and *Bewley v. Hancock* (6 De G. M. & G. 402).

For purifying coal-gas by a chemical process, the case of *Hills v. The London Gas Co.* (5 H. & N., 312). For the preparation of dyeing materials, the cases of *Steiner v. Heald* (6 Exch., 607), and *Simpson v. Halliday* (5 N. R., 340; L. R. 1 H. L., 315), and for extracting useful manure from sewage water, the case of *Higgs v. Goodwin* (E. B. & E., 529).

The last class in our list of inventions for which Letters Patent may be validly obtained is that comprised under the heading of “the application of materials previously applied to any useful purposes to specific useful purpose, where some ingenuity is required in its application.”

The ground upon which the claim to protection for this class of invention rests is undoubtedly the introduction of a new manufacture to the world. A material has been in existence in the earth and no useful application has ever been made of it. It is the merit of some one to have conceived the idea of applying it to some specific purpose; he makes the experiment; he finds under what conditions the previously valueless material may be usefully employed;

surely he is entitled to a return from the community for the benefit he has conferred upon them, viz.: the bringing into the use, the commerce and the riches of the world, a new element, previously either unknown or disregarded, especially when this return takes the form of a monopoly of the use of the particular material for the purposes to which he has applied it for a limited period. This doctrine has received judicial sanction in the following words of Chief Justice Tindal, when charging the jury in the case of *Muntz v. Foster* (2 W. P. C., 103):—"I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases which have been determined *that where such unknown quantities have from the result of experiments been applied to useful purposes of life, that such application has been considered the ground and the proper ground of a patent.*"

We desire only to add to this section this one remark, that although as a general rule it will be found that all inventions for which Letters Patent have hitherto been granted, come within one of these heads, or perhaps several of them, according to the point of view from which they may be regarded, yet since inventive genius covers the whole ground of human thought and industry, it may not improbably happen that an invention will be made which cannot fairly be brought within any one of them. Now it must not from that circumstance be presumed that this invention is therefore unpatentable. Reference must be made back to the first principles and broad grounds upon which the law relating to Letters Patent rests, and which this classification has been attempting to elucidate but not to confine, and the invention must be examined, in order to see if it be the proper subject for Letters Patent, by these questions—Is it new? Is it useful? Is it a new manufacture? And when they can all be answered in the



affirmative, one may be sure that a valid patent may be obtained.

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### SECTION III.

#### TO WHOM LETTERS PATENT MAY BE GRANTED.

1. The person to whom Letters Patent may be granted must be the true and first inventor of the invention for which they are obtained.\* The person who first introduced an invention within this country was long considered to be its first and true inventor here, and patents used to be indifferently granted to first inventors or first importers. Thus a system grew up of granting Letters Patent to persons upon their representing that they were in possession of a certain invention, and that it had been communicated to them from abroad by such a one, mentioning his name, and an examination of the list of patents, granted for very many years previously to the passing of the recent Act, would show a considerable proportion of the patents issued, granted as communications from abroad. It was the constant habit of patent agents to take out the patents in their own name as communications from their correspondents abroad, a course which possessed some advantages of convenience.

The object which induced our forefathers to construe first introducers of inventions as first inventors is obvious. It was their desire to foster manufactures in this country, and they thus encouraged a man, who from travel abroad had learned processes of manufacture unknown in this country, to introduce them here by giving him a monopoly of their use for a limited period. And this policy has been, to a great extent, successful. But it is evident that by permitting its existence the interests and the rights of the foreign inventors were overlooked.

Before the practice, which was only a comparatively

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\* See, however, section 5, sub-section 2 of the Act and note thereon.

recent one, of requiring the applicant for patent to state from whom he had received the communication arose, a man might obtain a patent by simply stating in effect that he had acquired a knowledge of the invention abroad; and after the practice of requiring the name of the communicant to be stated had become general, there was no guarantee that the communicant was himself the true and first inventor; indeed the applicant for patent was not even required to state his belief that his informant was so. Thus a foreign inventor might be robbed of his right to obtain patent in this country.

No doubt if a person obtained a patent for this country under such circumstances as would show that he did it on behalf of his communicant, the courts could and did compel him to execute his trust by using the privilege he had obtained for the interests of his communicant, or *cestui qui* trust, or to assign it to him when called upon to do so. It was under this protection that foreign communicants so largely made use of the practice of obtaining Letters Patent in the names of their patent agents in this country, and it is to the credit of that body that instances were so seldom heard of any difficulty resulting from it.

The new Act of 1883 has, to a very considerable degree, affected this practice, and the reader is referred to sections 4 and 5 thereof, and to the notes thereon, where he will find the subject fully discussed.

2. A patent may be granted to any number of joint inventors. The reader is referred to section 5, subsection 2, and to the note thereon, where he will find some important questions fully discussed.

3. So long as the person to whom the patent is granted is the true and first inventor, it does not matter whether he be a citizen of this country or a foreigner.

4. If a person has conceived the idea of an improvement, he may employ other persons to work out the details, paying them for their labour, and yet be entitled to take

out the patent in his own name alone; and the patent so obtained will not be afterwards avoided by evidence that the persons employed made suggestions of subsidiary improvements to the primary idea.—*Allen v. Rawson* (Tindal, C. J., 1 C. B., 567; *Minter v. Wells*, Alderson B. directing the jury (1 Webs. P. C., 127). It is evident that the merit of the invention is due to the person conceiving the idea and employing the others to carry it out.

5. If there be several simultaneous inventions both arriving at the same result in *bonâ fides* and in ignorance of each other's labours, the first who takes out the patent is entitled to bar the others from it. This rests upon the principle of public convenience. The object of protection to inventors by Letters Patent is to obtain for the public the benefit of the invention; therefore he who satisfies the other requirements of the law, and who first applies for Letters Patent, thereby making known his invention to the public, is preferred to the person coming afterwards—*Dolland's Case*, cited in *Boulton v. Bull* (2 H. Bl. 469; *Forsyth v. Riviere*, Chit. Prerog. Cas., 182).

6. It is no objection to the validity of a patent if, after it has been granted, it appears that some one had invented the thing before and kept it a secret. In order to avoid the patent there must have been a prior publication of the invention—*Case of Dolland's Patent*, cited in *Boulton v. Bull* (1 W. P. C., 43). Although it is clear that the patentee in this case is not the first inventor in the sense of the first finder out of the invention, yet he is the first to give the benefit of it to the world, so that the law gives him the benefit of the patent.

In pursuance of this principle it has been held that the person "is the inventor and discoverer who finds out and  
"introduces a manufacture which supplies the market, for  
"useful and economical purposes, with an article which was  
"previously little more than the ornament of a museum"—*Stuart, V.C.*, in *Young v. Fernie* (4 Giff., 611).

Lord Westbury, L.C., in the House of Lords, in the case of *Betts v. Menzies* (10 H. L. Ca., 117), said:—“ 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 can ascertain that the antecedent publi-  
 “ cation involves the same amount of practical and useful  
 “ information. . . . It is possible that a suggestion con-  
 “ tained ” (in such a description) “ may lead to the inven-  
 “ tion contained in the other. But it is this latter alone  
 “ which really does add to the amount of useful knowledge:  
 “ it is the latter alone which, by its practical operation,  
 “ confers a benefit upon mankind within the meaning of  
 “ the patent law.”

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#### SECTION IV.

WHAT ARE THE NECESSARY INGREDIENTS OF AN INVENTION  
 FOR WHICH A VALID PATENT MAY BE OBTAINED.

There are three ingredients necessary to support patent granted for the protection of an inventor, and these are invention, novelty, and utility.

1. INVENTION.—The first of these, “ invention,” may be dismissed, after what will have been gathered from what has already been said on the subject, with the remark that to merit this term “ invention ” there must have been an exertion of the inventive faculty. This is apart from the question of novelty ; it is quite possible, indeed it every day happens, that men by a process of reasoning of their own, by the exercise of their own constructive abilities, discover independently things which have been already known or used in the world, and this is “ invention ” in the sense in which the word is used here. It is not of itself sufficient

to support a claim to Letters Patent, because for that purpose, in addition to being actually found out by the claimant, the thing invented must be novel, that is previously unknown, and useful. This is essentially necessary as one of the ingredients of an "invention" used in its patent law sense. It is the actual discovery of something new, or the construction of something new by a ratiocinative process of the mind, aided by experiment and mechanical appliances.

Passing on now to the second ingredient, "novelty," it will be necessary to enter into an enquiry as to what amount of novelty is necessary to support Letters Patent. It is a trite remark "that there is nothing new under the sun"; and no doubt this is perfectly true if the newness referred to is meant to be something completely novel in its whole aspect, entirely new in its inception, execution, and detail. Such novelty does not exist in the world. The mind of man works more slowly; ideas completely carried out to perfection do not come from the human brain, like Minerva springing ready armed from the head of Jupiter; things in actual existence attain form and value by slow degrees and progressive steps, and in no condition can they be said to be in a state of perfection, for improvements are always possible. It is in this sense and this sense only that "there is nothing new under the sun." Yet it is equally true that any intelligent man examining thoroughly any subject, and acquainting himself with all that is previously known about it, will in the vast majority of cases, at the end of his labours, be in a position to add many things to the knowledge relating thereto, already possessed by the world. His critical examination of a process or a machine will have shown him inconveniences in the one and imperfections in the other, for which he perceives the remedy; and although the improvements which may occur to him do not effect a revolution in the whole matter, yet frequently, more frequently than the reverse, it will be found, if his studies have been thorough and painstaking, that they possess

practical value. Some of these improvements, no doubt, are of infinitely greater value than others; some of them mark an epoch in the history of science and manufacture. Amid the numberless improvements and patents of which the steam engine has been the subject, and which have brought it to the highly efficient state in which we know it at the present time, that of James Watt stands out distinctly from all others. His name will be ever associated with the steam engine; and no one is ignorant that he effected the greatest improvements in it, though, comparatively but few, have any idea of what those improvements were; while the names of other numberless inventors, who have contributed in only a less degree than Watt to the perfection of the steam engine, are unknown or forgotten.

Thus it is with invention—a continual progress of improvements, comparatively small, but all tending towards ultimate perfection, and which, though with difficulty appreciated by the outsider, are yet found, upon candid examination by the expert, to be of a substantial character.

Regarded in this way, there is not found to be that clashing between inventors with regard to the same inventions which is sometimes represented as existing. A careful and candid examination of any invention well described will nearly always discover points, and substantial points, of novelty and distinction between them.

It is true that it is unfortunately the habit with inventors, in common with the rest of mankind, to believe themselves entitled to greater merit than they in fact possess, and to claim to have invented more than they have really discovered. It is owing to this tendency that the clashing, so far as it exists, is due.

But a knowledge of the principles upon which the law relating to this subject rests, and a careful study of the matter itself, will tend to obviate this altogether. It cannot be too strongly impressed upon those who are in the habit of advising inventors, that in the vast majority of

cases the person who believes himself to have discovered something has in fact, indeed, done so, and that the effort in preparing the specification, preparatory to obtaining the Letters Patent, should be to discover what this is, to clearly define it beyond the possibility of mistake in the description, and to strictly limit the claim to invention thereto. It should not be the object of a loose description and grasping claims, expressed in general language, to render the ground covered by the invention, and consequently by the patent, as great as possible. It is this that causes the difficulties in patent matters, and brings the protection to inventors by Letters Patent into disrepute with the general public.

2. NOVELTY.—The reasons why novelty is an essential requisite for an invention to be protected by patents are—(1) because no one can be deprived of the right to use a known art or trade; and (2) if an invention be known, there is no consideration from the patentee to the Crown to support the contract under which the Letters Patent are granted to him.

It is sufficient, however, that the invention be novel to the public, for we have seen that the patent will be properly granted to the first applicant, although the invention may be previously known to some one or more persons who may have invented it independently, and who have not made any public use of it—*Dolland's Case* (1 W. P. C., 463). And the circumstance that an invention for which a patent has been granted relates to the same subject, or seeks to attain the same object as another invention for which a patent has previously been obtained, is no objection to the subsequent patent on the ground of want of novelty, so long as the means whereby the two inventions seek to attain the same end can be clearly distinguished from one another. Nor even if the exercise of one invention involves the use of another, for which a patent has previously been granted, in order to effect the object to attain which it is directed, is a

patent granted for the subsidiary invention invalid; because if there is an improvement upon the previous invention a patent may properly be granted for that improvement—*Crane v. Price* (1 W. P. C., 413). If the patent for the preceding invention be still in force it will, of course, not be open to the subsequent patentee to exercise his invention without the permission of the proprietor of that patent; but, on the other hand, the owner of the preceding patent cannot make use of the improvements protected by the subsequent patent without the permission of the patentee. Each patentee and his representative is limited to the use of his own monopoly—that is, what each has himself invented. The proposition of law upon the subject is, that it is open to any one to improve upon anything at present existing, and to obtain the privilege of exclusively using his improvements by a patent, but he cannot by so doing interfere with or abridge the rights already vested in others.

When a patent is in existence for a certain application of a known thing or appliance, which as we have already seen, is the proper subject for a patent, it does not prevent another and subsequent patent for a different application of the same thing or appliance, provided, of course, that the two applications are clearly distinct. The following example will illustrate this doctrine:—

A patent was obtained for packing hydraulic and similar machines, with the object of rendering them at the necessary parts air and water tight. The substance or thing used for the purpose was a lining of soft metal. A subsequent patent was taken out by another inventor for the application of the same substance or material to the purpose of diminishing the friction of parts of machinery in rapid motion, and obviating the generation of the heat excited by the friction. Here were two applications of the same thing—one to render machinery air and water tight, the other to render machinery frictionless. The first patentee maintained that the second patentee infringed his patent, and sued him



for doing so, but the Court held the two applications were substantially different; that the second patentee had made an independent invention, and that his patent was consequently valid—*Newton v. Vaucher* (6 Exch., 859).

The publication of an invention before the date of the Letters Patent by which it has sought to be protected, either (1) in a book or other work in circulation, or (2) by a public use of it anywhere, renders the patent void. The reason for this is, of course, that the public had a knowledge of the invention, or, at least, the means of knowing it, before the date of the patent. But it is necessary that there should have been substantial publication to vitiate the patent, and we will endeavour to ascertain what species of publication does and does not render a patent subsequently granted void—(1) when it takes place by description, and (2) by use.

1. DESCRIPTION.—Of course, if a description of the invention occurs in a specification, filed in pursuance of previously granted Letters Patent, or in a book in circulation in this country before the date of the patent, from which a sufficient knowledge of the invention could have been gained to enable its practice, it follows that there is no invention in the patent law sense of the word, and the patent is absolutely void—*King v. Arkwright* (Dav. P. C., 129); *Hill v. Thompson* (8 Taunt., 875). But a mere general description, whether contained in a prior specification or in a journal or book in actual circulation indicating or shadowing forth an invention which it does not practically explain, will not be sufficient to avoid a patent subsequently granted for the invention carried out in a practical, workable manner. This is the effect of the judgment of the highest tribunal in the kingdom, in the case of *Betts v. Menzies* (10 H. L. C., 117), and, indeed, it is only carrying out the principle upon which patents for inventions are granted. They are granted to reward the introduction into the country of a new manu-

facture. Now, an idea, however described or indicated as being capable of being carried out into actual use, is not a new manufacture; but when the practical carrying out of the idea is effected, a patent is granted and upheld to him who has practically carried it out into a manufacture.

It may be a question whether the principle on which the decision in *Betts v. Menzies* proceeded does not extend to those cases where, after a manufacture or art has been in use in past times, but its practice has been neglected, it is now altogether forgotten. If a man in such circumstances should re-invent the art or manufacture, and succeed in reducing it to a practicable shape, and a patent should be granted to him, would it be upheld if impeached on the ground of want of novelty? It is apprehended that the argument upon which the decision in *Betts v. Menzies* was rested goes to support the proposition that in such a case the patent would be upheld. The re-introduction of a lost manufacture may be as meritorious as the discovery of the new one; and it is difficult to distinguish between the establishment of an art which has been practised ages ago, and long lost to the knowledge of man, and the bringing into operation of one which has been found out for the first time—See Lord Brougham in *Househill Coy. v. Neilson* (1 W. P. C., 717).

It is important also to notice that if the publication be a book, that it be actually published or sold here, or be in a place such as a public library, where reference can readily be made to it, the importation of a foreign book containing a description of an invention would not invalidate a patent subsequently granted for it, unless there had been an actual publication and offer of sale to the public—*Lang v. Gisborne* (Beav 81, 133); *Plimpton v. Spiller* (L. R. 6, H. D., 412).

It does not matter, of course, if the invention be described in the publication whether the patentee derived his

knowledge of the invention therefrom or not—*Stead v. Williams* (2 W. P. C., 142).

2. AS TO PRIOR PUBLICATION BY USE.—The public use of an invention at any time before the date of the Letters Patent by which it is sought to be protected, will render them void when granted. This is because the public use of an invention shows that there was a public knowledge of it; and, since any one seeing it in use might, in the absence of any exclusive privilege relating to it, have used it previously himself, he cannot, by the subsequent grant of a patent, be deprived of the right or privilege of which he is already in possession—*Tennant's Case* (Dav. P. C., 429); *Lewis v. Marling* (1 W. P. C., 490).

It is further not necessary that this use should have been general as well as public in order to avoid the patent. In a case where a man had constructed a peculiar kind of lock, and had it placed on a gate where it was in actual use, open to public inspection for years, and a patent was afterwards obtained for this lock, it was held, on these facts being proved, that the patent was void on the ground of prior use—*Carpenter v. Smith* (1 W. P. C., 530).

It is not necessary that the use of the invention should have been continued up to the time of the patent being granted. If the use at some period before the date of the patent be clearly proved, it will be void; so long as the use has not occurred so many years before, that the invention may be presumed to have been forgotten—*Househill Company v. Neilson* (1 W. P. C., 709).

The prior use of an invention, evidenced by the sale of even one article manufactured according to it before the date of the Letters Patent by which it is sought to be protected, will render them void—*Losh v. Hague* (1 W. P. C., 202).

It is apprehended, however, that the prior secret use of an invention before the date of Letters Patent will not render them, when subsequently granted, invalid—*Dollands'*

*Case* (1 W. P. C., 43),—unless the use be of such a nature as to have enabled the public to have gained such a knowledge of the invention that anyone acquainted with the subject to which it relates could have exercised the invention himself. We have seen that one ground upon which the grant of Letters Patent rests is the full disclosure of the invention, so that anyone may at the conclusion of the period of protection put in practice for himself. In the case of a patent granted after such a limited prior secret use, as we are here speaking of, the public have not gained the knowledge; it is the disclosure of the invention made by the patentee in his specification which renders it public, so that the consideration, in respect of which the patentee is granted his patent, exists.

The fact that experiments have been made with an invention before the date of Letters Patent granted in respect of it does not render them void so long as the experiments have been conducted as such, and not to such a degree as may fairly be considered to constitute a public use of the invention.

In a case in which it was objected that the invention could not be considered as new at the date of the Letters Patent, because the invention had been published and come to the knowledge of the world in the course of experiments which had been made with it before the patent was taken out, it was judicially laid down “that a mere experiment, “or course of experiments for the purpose of producing “a result which is not brought to completion, but begins “and ends in experiments, will not, although known to “several persons, prevent a subsequent inventor, who “brings the invention to perfection, from maintaining a “patent for it.” In this case there had been experiments made before the date of the patent, tending almost, if not entirely, to the same result as that for which the patent was granted, and they were known to many persons, but it was laid down “that if they rested in experiment, and

“ experiment only, and had not obtained the object for which the patent was taken out, the patent would not be invalidated for want of novelty in the invention ”—*Galloway v. Bleaden* (1 W. P. C., 529). And in a case in which it was a question whether a certain description of carriage wheels was novel at the date of the patent, and it was proved that another man had used similar wheels before the date of the patent, it was laid down “ that if the previous use was experimental and had been abandoned, it was no ground for saying the patent was not good ”—*Jones v. Pearce* (1 W. P. C., 122).

Upon this question of previous experiment or partial use and subsequent abandonment, it has always been considered, and justly so, that the abandonment showed that the experiment was unsuccessful, and the invention incomplete; while the fact of the invention protected by the patent being in actual use and infringed, showed that it had taken a step further than the previous experiments had brought it, and supplied the missing link by means of which it was rendered practically useful and successful.

A confidential disclosure of an invention to various persons before the date of the Letters Patent does not render them invalid. It would be hard indeed if this should be the case, and the law accordingly is very clear upon the point, giving ample protection in circumstances of this kind. The leading case establishing this doctrine is one where two pairs of paddle wheels constructed upon an improved method were made some months before the application for the Letters Patent, which were granted for them, by an engineer from the instructions of the inventor under an injunction of secrecy. The wheels were then sent abroad and used in steam boats belonging to a person who had paid the engineer for making them, and who was also in treaty with the inventor for a partnership or for an interest in the invention. On the patent being afterwards granted, it was contested on the ground that the invention at the date of

the patent was not new in consequence of this disclosure. But it was held that this was not such a publication of the invention as would defeat the patent—*Morgan v. Seaward* (1 W. P. C., 194) ; see also *Newall v. Elliott* (4 C. B., N. S., 269 ; 27 L. J., C. P., 337).

But it should be remembered that if an inventor incautiously communicates his invention without any conditions of secrecy to a stranger, through whom, without any intention of fraud upon his part, the invention gets into use, the patent subsequently obtained for it will be invalid—*Earl of Dartmouth v. Darrell* (3 Mod., 77). The reason for this is that then the public will have acquired a knowledge of the invention, and the inventor has nothing to give, no disclosure of anything before unknown to make, as a consideration for the Letters Patent conferred upon him. He has, however unwittingly, made a present of his invention to the public, who cannot be deprived of the rights they have already acquired by Letters Patent granted to the inventor after his invention has become known.

But the inventor is protected against the fraudulent publication (see section 35 of the Act) of his invention by persons who have been employed by him confidentially in carrying it out, and they cannot thus gain a knowledge of the invention and then set it up against their employer. If, indeed, through their conduct the invention has become publicly known to persons innocent of the fraud to any extent, the inventor cannot afterwards obtain a valid patent, except where such publication takes place after the application for a patent in fraud of the true inventor (see section 35 of the Act); nor can the fraudulent publishers derive any advantage. The invention passes into the “public domain,” and, as we have seen, the public cannot be deprived by Letters Patent of the right to use an invention, the knowledge of which they already possess ; but the Courts are always ready to assist and protect an inventor under such circumstances so far as is possible, and

an injunction will be granted to prevent use or publication of an invention the knowledge of which has been gained under such circumstances—*Morison v. Moat* (15 Jur., 787; 9 Hare, 241, on appeal, 16 Jur., 321).

We would only further add now upon this question of novelty that in order for the patent to be valid it is necessary that all that is represented and claimed by the inventor as his own invention should be novel at the date of the Letters Patent. Most inventions are improvements, and many improvements are sometimes included in the same patent; but if any one of these be old, although all the others be new, the patent is invalid for the whole, the new parts as well as the old, until the patent has been amended by the elimination of the old parts—*Hill v. Thompson* (8 Taunt., 375); *Gibson v. Brand* (4 M. & G., 179).

The reason for this is somewhat technical: It is because the consideration for a grant of Letters Patent is what is legally called entire, and if a part fails the consideration cannot support the grant, and the whole fails. The patentee, too, on petitioning for the grant of patent to him, represents that his invention, as a whole, is new, while a portion of it is, in fact, old. He has, therefore, made an incorrect suggestion to the Crown, by whom the patent was granted to him, on the presumption that the representation he made was correct; and thus the patent fails by reason of the false suggestion.

There is a method of curing Letters Patent defective in this respect—new as to part of the subject matter described in the specification, and old as to the rest—by amendment by way of disclaimer and memorandum of alteration, as to which see sections 18 to 21 of the Act.

3. UTILITY.—Turning now to the third necessary ingredient in an invention for which Letters Patent may be properly granted, we find that it must be useful to the public; that is to say, that it must effect the object for which it is intended in a better manner than has been done

before. Questions turning upon the utility of an invention occur more rarely in litigation in patent cases than those turning upon novelty. The reason for this consists in the fact that if a patent is disputed upon this ground it is necessary to raise the matter upon the pleadings, and it requires to be found by the Court or jury as a fact that the invention for which the patent was granted is not useful in order to invalidate it upon this ground. But evidence upon a matter so purely one of opinion can always be found sufficient to satisfy the tribunal before whom the contention is being tried that there is some utility in the invention, and patents have so seldom being successfully contested on this ground that it is now generally hardly thought worth while seriously to insist upon it.

The reason why a patent is void if it does not possess utility is the one which we have so frequently mentioned—the failure of consideration.

The inventor in petitioning for his grant of Letters Patent, used to be required to represent that his invention is “of public utility” as well as novel, and the patent is granted to him in consideration of its being so; if, therefore, the invention was found afterwards to be devoid of utility the consideration upon which the patent was granted fails, and the Crown granted it upon an incorrect suggestion that the patent was novel.

The form of declaration prescribed by the new Act to be made by an inventor on applying for the grant of a patent no longer requires any representation as to utility.

The reason why this representation was required from the inventor, so that a patent would not issue without it, and if incorrectly made the patent granted was void, is to be found in the great principle, as old as the common law itself, that the Crown in an exercise of its prerogative, such as a grant of Letters Patent, must exercise it for the benefit of the public. It is for the benefit of the public that useful inventions be encouraged; it is to their detriment that monopolies



of useless things be granted. Patents for useless things tend to the obstruction and detriment of trade, and are therefore invalid on that ground. It was accordingly judicially laid down in a case where it appeared that a patent had never been worked and was only brought forward to obstruct another person in a course of improvement, that to do so was a fraud upon the Crown—Per Pollock, C.B., *Palmer v. Wagstaffe* (9 Exch., 494).

It is sufficient, however, if the invention is not devoid of utility and it is of some use to the public, provided the Crown has not been deceived as to the extent of its usefulness. It was judicially laid down that it was not for the jury to consider the extent to which the invention was useful, but whether it was of any use or not, and that it was sufficient if there was *some* use—Alderson B., *Morgan v. Seward* (1 W. P. C., 172).

Similarly, where a portion of what is described as the invention turns out to be unnecessary and useless, the inutility of this portion of the invention will not render the patent bad, provided it be not essential. This principle is illustrated by a case in which the invention was for shearing woollen cloths. A certain description of brush was described in the specification for raising the wool, but, in practice, this brush was found to be useless and it was abandoned. It was objected to the patent that, as part of the invention was useless, the whole patent was bad (as we have seen a patent is when one part of it is found devoid of novelty); but it was judicially determined that, as the patentee did not claim the brush as an essential part of the invention, its inutility did not invalidate the patent—*Lewis v. Marling* (5 M. & R., 66 ; 10 B. & C., 22).

But it is important to bear in mind that where several improvements, each capable of being considered as a distinct invention, are comprised within the same Letters Patent, each improvement or invention must be of some utility to the public or the patent will be void. And if any material

misrepresentation has been made when petitioning for the patent as to the utility of the invention, the patent is also void, because then the Crown was deceived when making the grant. Where a patent was granted for making three things, and use of them could not be made at all, the patent was held to be invalid—*Turner v. Winter* (Dav. P. C., 145).

It must also be remembered that it is not enough to satisfy the requirements of the law as to utility, that the article produced be useful, it must be the invention itself that effects the utility. The article produced must be better in quality or cheaper in price—*Palmer v. Wagstaffe* (9 Exch., 494).

Lastly. Patents will not be granted, or if granted by mistake, are invalid, when the invention for which they are taken out are for immoral or illegal purposes. A patent for “housebreaking implement, picking pockets or locks,” is invalid. And this is on the ground of public policy.

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## SECTION V.

### THE TITLE, THE PROVISIONAL AND COMPLETE SPECIFICATION, AND THE CLAIMS.

In applying for a patent (see section 5 of the Act), the applicant has to state (see the form of application in the 1st schedule to the Act) what it is that he is desirous of obtaining an invention for. And this he must do by stating, or by describing in a short and general form, the nature of his invention; this short statement will be repeated in the patent when granted, and becomes the “title” of the invention and patent. As will presently be seen, both care and skill are required in drafting this title.

Accompanying the application there must be left either a provisional or a complete specification. If a provisional specification be sent, it must describe the nature of the invention (section 5, sub-section 3), and subsequently (see section

8) the applicant must leave a complete specification. The complete specification, whether left together with the application, or the provisional specification be first left and the complete specification subsequently, must particularly describe and ascertain the nature of the invention and the manner in which it is to be performed (section 5, sub-section 4).

The new Act in these respects only adopts the practice existing long before, and a great many decisions are recorded, and large amount of learning exists upon the important subjects of the title and the specifications of the invention. It is proposed to shortly state as much of this as will form a practical guide to the practitioner in the preparation of these documents, taking them in their order; 1. The title; 2. The provisional specification; 3. The complete specification; and, 4. The claims.

#### 1st. THE TITLE.

The title is the short and general description in which the inventor, when applying for a patent, summarises, as it were, his invention.

It ought accurately to describe the nature of the invention; it must not be too large so as to include anything more than the patentee has actually invented, and it must not be too narrow so as to exclude any part of the invention—Hindmarch, p. 43. If it be too large, that is if it extends to matters not included in the invention, the patent will be bad, because granted for more than the patentee has invented; if it be too narrow, so as not to cover some portion of the invention, then it excludes by its very terms something which the patentee had a right to obtain protection for, because the scope and powers of the patent are limited by the title.

The title must correspond and agree with the invention described and claimed in the specification—its language may be explained and reduced to a certainty by the specification—*Neilson v. Harford* (1 W. P. C., 312-373);—but the

title must not claim one thing and the specification another — *Oroll v. Edge* (9 C. B., 479). The title should give some idea, and, so far as it goes, a true idea of the invention; it is sufficient if it be consistent with it. Since the title, which was always, under, the old practice, and, will probably, under the new practice introduced by the new Act, be made public by advertisement before the granting of the application, it is obvious that it is highly inadvisable for the title to state what the invention is, even in those probably very few cases where it could be stated so shortly, as to do so would be to inform rivals thereof before any protection has been obtained; while it is necessary that the title should include or cover the invention: it is obvious, therefore, that a good deal of care and skill are required in drafting it. Nothing, perhaps, but the experience of a lawyer or patent agent versed in such matters will be a sufficient guide in doing so; but the above axioms, which are the result of a long series of authorities on the subject too numerous to set out, and the following instances where titles have respectively been held bad and good, will prove the best guide short of actual personal experience, being, as it were, the recorded experience of other persons on the subject.

Before stating these instances, however, it is proper to observe that section 6 of the new Act throws a duty upon the examiner to compare the provisional or complete specification, whichever may have been left with the application with the title, and to see whether the latter sufficiently indicates the subject matter of the invention. A similar duty has hitherto been performed by the law officers by deputy through their patent clerks, and it is apprehended that the work will be more strictly performed by the examiners. If these functionaries perform their duties well, it may be anticipated that but few imperfect and inaccurate titles will escape their vigilance, and that the Comptroller will exercise his powers of requiring amendments in the title when defects therein are brought to his attention by his examiner.

But should any defective title escape the attention of the examiner, or, even if amended, still remain inaccurate, the fact of its having passed the examination will not preclude the objection being taken to the validity of the patent in any subsequent legal proceeding, whether for infringement or otherwise.

The following are cases where the titles have been held defective and the patents bad on that account:—

*Title*—“An improved method of lighting cities, towns and villages.” The invention in reality was for an improved street lamp—*Lord Cochrane v. Smethurst* (1 Stark. R., 205).

*Title* for “Tapering brushes.” But the specification described a brush in which the bristles were of unequal length, and there was no tapering to a point—*The King v. Metcalf* (2 Stark. R., 249).

*Title*—“A new or improved method of drying and preparing malt.” The specification described a process for producing a colouring matter for beer by submitting ordinary malt to a high temperature. The object of the invention, therefore, was not *preparing malt*, but *colouring beer*—*Rex v. Wheeler* (2 B. & Ald., 345).

*Title*—“Improvements in the flageolet whereby the fingering will be rendered more easy and notes produced that were never before produced.” In fact only one new note was produced—*Bambridge v. Wigley* (Parl. Report on Patents, 1829, Appendix, p. 197; cited in “Hindmarsh on Patents,” p. 183); but with this case must be read *Nichols v. Haslam* (8 Jur., 474), where the title was “*Improvements in the manufacture of plated articles*”; but the specification described *one* improvement only, and the patent was held good.

*Title*—“A machine for giving a fine edge to knives, razors, scissors and other cutting instruments.”

but the invention described in the specification was inapplicable for sharpening scissors—*Felton v. Greaves* (3 C. and P., 611).

*Title*—“A new and improved method of making double canvas and sailcloth with hemp and flax, or either of them, without any starch whatever.” The invention was really a new mode of preparing and twisting the hemp or flax for making the canvas and sailcloth—*Campion v. Benyon* (6 Moore, 71; 3 B and A., 5).

The following are cases where objections have been taken to the patents on the ground of defective titles, but the titles have been held good—*Nichols v. Haslam*, mentioned when citing *Bambridge v. Wigley*:—

*Title*—“Improved application of air to furnaces.”

The invention really being the use of a heated blast of air—*Neilson v. Harford* (1 W. P. C., 333, per Lord Abinger).

*Title*—“Certain improvements in copper and other plate printing.” The invention being giving paper, by means of a glazing composition, a surface which rendered the lines of copper-plate engraving more distinct—*Sturtz v. De la Rue* (5 Russ., 322).

*Title*—“Improvements in making bobbin net lace.”

The invention being for a mode of making spots in it—*Fisher v. Dewick* (1 W. P. C., 264, stated by Sir F. Pollock, 8 Q. B., 1036).

*Title*—“Improvements in carriages.” Invention improvements in adapting German shutters to carriages—*Cork v. Pearce* (8 Q. B., 1044).

*Title*—“Improvements in the doors of and sashes of carriages.” The inventor stated his invention was applicable in any position where doors and windows are subject to jar and vibration, as well as to railway carriages—*Oxley v. Holden* (8 C. B., N.S., 707).

Before leaving the subject of the title it should be care-

fully noted that evidence of a design on the part of the inventor to choose *a vague and general title* in order to avail himself, at the time of filing his specification, of an invention not discovered at the date of his patent, such invention being different from that for which the patent was originally taken out, would be evidence of fraud upon the Crown, and avoid his patent—*Cook v. Pearce* (8 Q. B., 1064). It is necessary in advising intending patentees to bear this in mind, for choosing a vague and general title, perhaps, for the purpose above indicated, is a fault to which patentees are somewhat prone.

## 2ND. THE PROVISIONAL SPECIFICATION.

Section 5, sub-section 2 of the Act requires the applicant for a patent to leave with his application either a provisional or a complete specification; and sub-section 3 requires that a provisional specification must describe the nature of the invention. Section 14 enacts that where an application for a patent has been accepted, as it may be when accompanied by a provisional specification (see section 7, sub-section 4) the invention may, during the period between the application and the sealing of the 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 called “provisional protection.”

Provisional specifications and provisional protections were introduced by the Act of 1852. Previously to that Act no description of the invention, other than the mere general reference thereto contained in the patent, was required. But, on the other hand, the date of the patent when granted was not that of the application but the date of the actual sealing, except when the sealing of a patent had been delayed by an opposition, when the Lord Chancellor, in the exercise of his discretion, used sometimes to order the patent, when sealed, to bear the date of the

earliest day upon which it would have been sealed if there had been no opposition (Hindmarch on Patents, p. 537). During all the period that the application for the patent was pending the applicant remained without protection for his invention. This system was found inconvenient, both to the inventor and to the Crown as representing the public, since the publication of the invention, prior to the date of the patent, invalidated it when granted, because, as we have seen, it is the essential element of an invention for which a valid patent can be granted, that it should not have been known before the date of the patent. In many cases it was very difficult for an inventor to experiment and work upon his invention so as to perfect it without great danger of other persons becoming aware of it, and of its thus becoming published, or of these persons in fraud of the real inventor applying for patents themselves. And the absurdity of the Crown granting a patent for the use of an invention of which a mere indication only of its nature had been given by the title was sufficiently obvious. Therefore, the Act of 1852, required, as does the present Act, that an inventor on applying for a patent should deliver, together with his application, a description or specification of his invention. He might, if he chose, as he may still do under the present Act, deliver a full and final description thereof, called the complete specification; or he might, as he may still do, if he chose, deliver a preliminary description, called the provisional specification. If he adopted, or still adopts, the latter course he was and is still, required to subsequently deliver a fuller and final description called the complete specification.

Upon the applicant delivering this provisional specification, the application for patent was, after examination by the law officer, allowed by him, and the applicant then became possessed of provisional protection by the practice under the Act of 1852. Under the present Act, upon the applicant delivering this provisional specification, his application



for patent will be, after examination by a special officer, called the examiner, be accepted by the Comptroller, and, upon such acceptance, the applicant will be possessed of provisional protection. What provisional protection is we have already seen by section 14 of the present Act cited above. It enables the inventor, during the period elapsing between his application and the time when it is necessary to file his complete or final specification (nine months, section 8), to labour to perfect his invention undisturbed by any fear lest the publication of it should interfere with the validity of his patent rights.

It is proposed to endeavour to explain what a provisional specification is or should be, as distinguished from a complete or final specification. The distinction between the two is clearly accentuated by section 5 of the Act. Sub-section 3 says: "A provisional specification *must describe the nature of the invention.*" Sub-section 4 says: "A complete specification *must particularly describe the nature of the invention and in what manner it is to be performed.*" The provisional is to describe the invention so that it may be understood, the complete specification is to describe the invention, not only so that it may be understood, but also carried practically into effect.

"The office of the provisional specification is to describe the nature of the invention, not with minute particulars, but with sufficient precision and accuracy to inform the law officer" (now it is apprehended the Comptroller and his examiners) "what is to be the subject matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes in which the invention is to be worked or carried out. . . . The filing of the provisional specification protects the invention for six months" (now nine months) . . . "The object of this protection evidently is to enable the patentee to perfect his invention by experiments, which, although open and known, will not be a user and publication to

“ the prejudice of Letters Patent to be afterwards granted,  
“ so that he may be in a condition to describe in his com-  
“ plete specification, as the result of his experience, the  
“ best manner of performing the invention. It clearly  
“ appears, therefore, that the complete specification is in a  
“ sense supplemental to the provisional specification, not  
“ going beyond nor varying from it, as to the nature of the  
“ invention; but conveying additional information, which  
“ may have been acquired during the currency of the pro-  
“ visional specification; as to the manner in which the  
“ invention is to be performed,” per Lord Chelmsford, L. C.,  
in *Penn v. Bibby* (L. R. 2 Ch., 127).

“ A provisional specification is not intended to contain a  
“ complete description of the thing so as to enable any  
“ workman of ordinary skill to make it, but only to disclose  
“ the invention, fully no doubt, but only in its rough state,  
“ until the inventor can perfect its details”—Sir Geo.  
Jessell, M. R., in *Stoner v. Todd* (L. R. 4 Ch. D., 58).

Lord Blackburn, in *Bailey v. Robertson* (L. R. 3 App.  
Cas., at p. 1075), said “ Look at the nature of the inven-  
“ tion in the provisional specification and say whether that  
“ which you have been doing, and which you say was a part  
“ of the patent, is fairly within the nature of the invention  
“ you have described in the provisional specification; in that  
“ case you are protected, but if it is a new and separate in-  
“ vention, and a different one, then you are not protected.  
“ I cannot but think that when that is once looked at, it  
“ becomes pretty clear that when the nature of an invention  
“ has been described in the provisional specification in the  
“ way which has been mentioned, if something were found  
“ out during the six months to make the invention work  
“ better—or with respect to the mode in which the operation  
“ may be performed—a thing which is very likely to happen  
“ when in carrying out his invention the inventor finds that  
“ some particular bit will not work so smoothly as he ex-  
“ pected, and that it is necessary to add a little supplement

“ to it—still the nature of his invention remains the same,  
 “ as it is no objection that, in the complete specification  
 “ which comes afterwards, the invention or application is  
 “ described more particularly and in more detail, or even if it  
 “ be shown that there has been more discovery made, and  
 “ so as to make the invention which he has described in  
 “ the provisional specification really workable. If nothing  
 “ more is done than that, I think it is good, but as soon as  
 “ it comes to be more than that, and the patentee says in  
 “ the provisional specification I describe my invention as A ;  
 “ and in the complete specification he says I hereby describe  
 “ A and also B, then, as far as regards B, it is void, because  
 “ the patent was granted for the invention that was de-  
 “ scribed in the provisional specification and does not cover  
 “ the invention that is described in the other.”

The great rule or principle to bear in mind in preparing all specifications whether provisional or complete, is thus expressed in strong and accurate language by gentlemen who possess an experience second to none in preparing these documents—

“ The first thing that a patentee about to specify should  
 “ bear in mind is that he is bound to act with *good faith*.  
 “ There must be no studied ambiguity or equivocal lan-  
 “ guage, no attempt to keep anything secret ; he must make  
 “ a full disclosure of his invention ; and his whole specifi-  
 “ cation must be fair, open, explicit and honest. If he  
 “ acts in any other manner it will bear hardly with him when  
 “ his specification comes to be examined in a court of justice”  
 —Johnson’s Patentees Manual, 4th edition, pp. 112, 113.

Next, and this is a point which requires particular attention when drafting a provisional specification, is the definition of the invention, that is the statement of what the inventor wishes to be understood he has himself newly invented, so as to distinguish it from that which he admits to have discovered before, and does not regard as due to his own labours.

The inventor, or any one called in to aid him, will frequently find some difficulty in doing this with sufficient accuracy. The endeavour must be made to carefully think this out. What is it in my method or contrivance that is new? What have I added to stock of knowledge already possessed upon the subject? When this has been ascertained, then the endeavour must be to express it in clear and accurate phraseology. The purpose or object of the inventor should be sought for. When found it will generally prove to be the object of his invention. And it will generally be advisable to begin the provisional specification by stating the object of the invention. Then it will generally add to the clearness of the description if a short statement of what is now chiefly used is made, and then should follow what the inventor proposes to substitute for it. This may be expressed in a provisional specification in a concise form, not going very greatly into details, which subsequent experiment in working out the invention may considerably modify, and which may safely be left, and is better left, to be explained on the complete specification.

It is also necessary to bear strongly in mind that if the invention, in other words the points of novelty claimed in the complete specification, are not comprehended or covered by the terms of the provisional specification the patent will be invalid. Great care should therefore be bestowed on the provisional specification, to use language which will comprehend all that is likely to work out as the invention proceeds to be developed, as the points of novelty. This is not so easy in many cases to do as at first sight may appear. Inventors very often proceed to apply for patents for inventions, which, for fear of experimenting upon publicly, are not very much worked out, so to speak, and which, in the interval between the application and the delivery of the complete specification, are apt to somewhat change their form. A good deal of consideration and a large amount of knowledge on the subject are required, in order that language may be

selected which will allow for this. In the case of *Bailey v. Robertson* (L. R. 3, App. Cases, 1055), affirming the Scotch Court of Session, the provisional specification described an invention for preserving animal substances in a fresh condition, as consisting in the application of a definite mixture of an aqueous solution of gelatine with an aqueous solution of bisulphite of lime. The complete specification claimed as well, for the same purpose, the application of an aqueous solution of bisulphite of lime alone. And this was held to be not covered by the provisional specification, and the patent therefore invalid. It is probable that had due consideration been given to the matter when preparing the provisional specification it would have been perceived that the solution of bisulphite of lime would probably alone have answered the purpose, and by the insertion of a few words therein, the mistake have been avoided.

Another strong and most unfortunate instance is that of Edison's patent for the telephone, held invalid by Fry, J., because the phonograph was described and claimed in the complete specification, but not disclosed in the provisional specification, although admittedly portions of the provisional specification explained, or might be held to refer to, an instrument like the phonograph. Mr. Justice Fry remarked:—

“ I agree that the provisional specification need not  
“ describe the manner in which an invention is to be carried  
“ into effect. I agree that it need not describe the nature  
“ of the invention otherwise than roughly; but it ought to  
“ do so fairly and honestly; and if Mr. Edison was, at the  
“ time at which this patent was granted, in the possession of  
“ that very remarkable mechanical invention by which speech  
“ could be reproduced, not necessarily at a distance, but in  
“ the same room as that in which it was uttered, I do not think  
“ the provisional specification was an honest statement of the  
“ nature of that discovery”—*United Telephone Co. v. Harrison, Cox, Walker and Co.* (L. R. 21 Ch. D., 720, at pp. 747).

The point of the variance between provisional and

complete specifications is one that has been frequently raised as an objection to the validity of patents when they have been contested in courts of law. The following cases are selected, in addition to the above, as examples; and a consideration of them will enable any one whose duty it may be to draft a provisional specification to understand the view taken by courts of law upon the matter, and guide him sufficiently in his task.

Perhaps the leading case in favour of the validity of the patent, and against the objection is *Newall v. Elliott* (4 C. B., N. S., 269; 27 L. J., C. P., 337), decided in 1858. The title was "Improvements in apparatus employed in laying down submarine electric telegraph wires." The provisional specification described the invention in these terms, so far as affects this portion of the question: "The cable or rope containing the insulated wire or wires is passed round a cone, so that the cable, in being drawn off the coil, is prevented from kinking by means of the cone, and there is a cylinder on the outside which prevents the coil from shifting in its place." In the complete specification the description, after repeating the above description, proceeds:—"When the wire is to be laid down, I place over the cone an apex, or top, which is conoidal, or conical, and round this I suspend several *rings* of iron or other metal by means of cords so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out, when going at a rapid speed, and the combination of these parts of the apparatus prevents the wire from running into kinks." And the inventor claimed—"First, coiling the wire or cable round a tube; second, the supports placed cylindrically outside the coil round the cone; and thirdly, the use of *rings* in combination with the cone as described." Thus the provisional specification having omitted all reference to rings to be used with the cone, the complete specification described and claimed the exclusive use of them. It was held that the

patent was not rendered invalid by the omission to mention these rings in the provisional specification. Mr. Justice Byles said : It was objected " that the provisional specification contained no mention of the rings claimed in the complete specification ; but the office of the provisional specification is only to describe generally and fairly the nature of the invention and not to enter into all the minute details as to the manner in which the invention is to be carried out, otherwise the provisional specification must be as full as the complete specification and drawn with as much care and deliberation." It will, of course, be noticed that the winding of the cable round a cone and preventing the cable from kinking by means of something restraining it on the outside was the essential feature of the invention, and was described in the provisional specification, and that the addition of the rings for the latter purpose was a detail naturally growing out of the first idea, and suggested by actual use. This case, therefore, affords a good illustration of what may be added to the invention in the complete specification within the meaning of the letter and spirit of the law.

In *Wright v. Hitchcock and another* (L. R. 5 Ex., 37), decided in 1870, the title was " Improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The provisional specification stated that " the invention relates to a peculiar manufacture of frills and ruffles, and to a peculiar combination of mechanism," and proceeded to describe it, but made no mention whatever of trimmings. The complete specification stated : " The invention relates to a peculiar manufacture of frills, ruffles or trimmings, and to a peculiar combination of mechanism to be applied to a sewing machine for producing the same. The peculiarity is that the frills are crimped in one direction transversely to the cloth, in a perfectly even and regular manner, and are secured by stitches in lieu of the fabric being puckered or gathered in the ordinary way."

It was objected that the patent was invalid because the title and the provisional specification said only frills or ruffles, while the complete specification enlarged the invention to *trimmings*. But Kelly, C. B., overruled this objection, saying: "A point made is that there is an inconsistency between the provisional and final specification, the word *trimming* being added in the latter. But by whatever name it is described the thing in substance is identical."

In *Foxwell v. Bostock* (4 De G. J. and S., 298; 10 L. T., N. S., 144), decided in 1864, Lord Westbury, L. C., said that the provisional and complete specification of a patent ought not so to differ as that the nature of the invention as described in the one shall be materially different from the nature of the invention as described in the other.

A point or detail contained in a provisional specification may be omitted from, or abandoned in, the complete specification without injuring the validity of the patent; but, of course, another invention must not be substituted in its place. In the case of *Thomas v. Welch* (L. R., 1 C. P., 192; 35 L. J., C. P., 200), decided in 1866, Chief Justice Erle, in deciding this point, made this observation: "It is said that the complete specification is void because it omits some of the inventions put forward in the provisional specification. The provisional specification describes an instrument, and then says that 'this, or *another acting therewith*, acts to hold the work during the insertion of the needle.'" (The invention was for a sewing machine.) "It is said that the complete specification contains nothing corresponding to this second alternative. Assuming this to be so, I do not think the objection ought to prevail. The difference is a slight one, and injured nobody; and it may be that the patentee had something in his mind which he found afterwards would be useless."

By section 10 of the Act, on the acceptance of the



complete specification, the application and the specification, both provisional and complete, shall be open to public inspection. Up to the acceptance of the complete specification they are kept secret. A period of nine months is allowed (section 8) between the date of the application and the necessity for filing the complete specification. It may happen that after an application has been made, accompanied by a provisional specification, it may be advisable to abandon it, and to make another application with another provisional specification, including the whole or part of the same material as the first, in a different form. This may be done without danger of invalidating the patent obtained on the second application, if that be made before the publication of the invention described in the provisional specification, which will not take place until the expiration of the nine months allowed for filing the complete specification, when, if the complete specification be not filed, the application shall be deemed to be abandoned (section 8, subsection 2). Therefore, any time before nine months from the date of the first application, if the invention has not been otherwise published, a second application for the same invention may be made, and a valid patent obtained. This was decided in the case of *Oxley v. Holden* (8 C. B., N. S., 666; 30 L. J., Q. P., 68), decided in 1860 upon the Act of 1852; but which will remain an authority upon the subject. In that case a provisional specification was filed on the 17th March, and afterwards abandoned by the inventor, who, on the 10th April, made another application for the same invention, and, on the 12th October, obtained a patent therefor, dated the 10th April. It was contended that the filing of the provisional specification of the 17th March, and his afterwards allowing it to expire, was a dedication to the public of the invention, and prevented his obtaining a valid patent for the same invention on the application of the 10th April. But the Court of Common Pleas decided otherwise. Erle, C. J., said: "We are of opinion that a

“provisional specification abandoned does not become  
 “public by abandonment. The Act of 1852, section 29,  
 “authorises the publication, but until that event it is not  
 “public. Furthermore, although the first provisional  
 “specification *may afford an objection, either to receiving a*  
 “*second for the same invention, or to granting a patent after*  
 “*the first specification has expired*, there is no principle of  
 “law and no enactment making the patent void if it is so  
 “granted. On the contrary, section 24 of the Act of  
 “1852 enacts that the patent, dated as of the day the  
 “provisional specification was delivered in, shall be of the  
 “same force and validity as if it had been sealed on that  
 “day.” (Section 13 of the Act of 1883 contains the  
 same provision—“Every patent shall be dated and sealed  
 “as of the day of the application.”) “The patent is  
 “dated as of the 10th April. On that day the protection  
 “given under the specification of the 17th March existed,  
 “and the patent is valid by the operation of this section.”  
 All this reasoning is equally applicable to the Act of 1883.

### 3RD. THE COMPLETE SPECIFICATION.

It has been already stated that, under section 5 of the Act, the applicant may, instead of a provisional specification, leave with his application a complete specification.

If, however, a provisional specification be left with the application, the applicant must, within nine months from the date of his application, leave a complete specification or it will be deemed to have been abandoned (section 8). And a complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention and in what manner it is to be performed, and must be accompanied by drawings if required (section 5, sub-section 4), and must end with a distinct statement of the invention claimed (section 5, sub-section 5).

Those who have read the section immediately preceding

will have gathered that the provisional specification is a document, the preparation of which requires careful attention, pains and skill. All these are in a still greater degree required for the drafting of the complete specification. It is the document upon which the validity and life of the patent principally depends, for it is the instrument in which the inventor, in return for the exclusive privilege of using his invention for a limited time conferred upon him by a patent, is bound to so describe and ascertain as his invention as to enable the public—that is all persons acquainted with the subject—to use his invention as well as he himself can use it, after the termination of the period of his exclusive privilege. It has been upon the form and matter of these documents that objections have chiefly been made to the validity of patents, and frequently upheld, and a long series of judicial decisions have been given upon the questions arising thereon, out of which a sort of code, or a series of rules regarding them, can be extracted. It is the subject of this section to state shortly and clearly the effect of these decisions, and the principles and rules which ought to guide the preparation of complete specifications.

1stly. The cardinal principle and rule is to make a frank and full disclosure of the invention, and a clear, accurate, and distinct description and definition thereof.

FALSEHOOD.—“If the specification, in any part of it, be materially false and defective the patent is against law and cannot be supported”—Mr. Justice Buller in *The King v. Arkwright* (Dav. Pat. Ca., 61 ; 1 Webs. Pat. Ca., 64) (A.D., 1785).

“If you think there is any fraudulent concealment in the specification” the patent will be void—Gibbs, C. J., directing the jury in *Bovill v. Moore* (2 Coop. Ch. Ca., 56 ; Dav. Pat. Ca., 361).

CONCEALMENT.—“If there be any studied ambiguity in the specification, so as to conceal from the public that of

“ which the patentee is for a term enjoying the exclusive  
 “ benefit, no doubt the patent itself will be completely  
 “ void ”—Tindal, C. J., directing the jury in *Galloway and  
 another v. Bleaden* (1 Webs. Pat. Ca., 521).

AMBIGUOUS OR MISLEADING.—“ It is incumbent on the  
 “ patentee to give a specification of the invention in the  
 “ clearest and most unequivocal terms of which the subject  
 “ is capable. If it appears that there is any unnecessary  
 “ ambiguity affectedly introduced into the specification, or  
 “ anything which tends to mislead the public, in that case  
 “ the patent is void ”—Ashhurst, J., in *Turner v. Winter*  
 (1 T. R., 602; 1 Webs. Pat. Ca., 77). “ You must not  
 “ mislead people by telling them to do something wrong,  
 “ and leaving them to find out the mistake. . . .  
 “ You must not give people mechanical problems and call  
 “ them specifications ”—Jessell, M. R., in *Plimpton v.  
 Malcolmson* (L. R., 3 Ch. D., 531).

EQUIVOCAL.—“ The specification, if it be equivocal, is  
 “ bad ”—Lord Campbell, C. J. “ If the specification  
 “ upon a fair interpretation be equivocal it is insufficient ”  
 —Coleridge, J., in *Hastings v. Brown* (1 E. & B., 450).

DEFINITE.—A patentee “ is bound clearly to define in  
 “ his specification what it is he claims to be his invention,  
 “ in order that the public may know with certainty what  
 “ they may or may not do without incurring the risk of an  
 “ action for an infringement of the patent ”—Cresswell, J.,  
 in *Gibson and Campbell v. Brand* (4 Scott N. R., 490).

FULL.—“ The specification must give the best informa-  
 “ tion within the knowledge of the patentee ”—Cresswell, J.,  
 directing the jury in *Walton v. Bateman* (1 Webs. Pat.  
 Ca., 613).

ACCURATE.—“ People are not to (be left to) make ex-  
 “ periments at great expense to themselves which shall turn  
 “ out to be bootless and fruitless; but they rely on an  
 “ honest and open and candid exposition by the patentee  
 “ of everything that is necessary for the easy and certain

“ procurement of the commodity for which the patent was  
 “ granted. If the specification be not only difficult to  
 “ understand, but is actually false and incorrect (in the  
 “ statement of proportions of zinc and copper), there  
 “ would be an end at once of the patent”—Tindal, C. J.,  
 directing the jury in *Muntz v. Foster and others* (2 Webs.  
 Pat. Cas., 92).

SUMMARY.—“ 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, but if he makes a full and fair com-  
 “ munication, so far as his knowledge extends, he has done  
 “ all that is required”—Bayley, J., in *Lewis v. Marling*  
 (4 C. & P., 57 ; 10 B. & C., 26).

If the specification omit to mention anything essential  
 for carrying the invention the patent will be invalid. In a  
 patent for trusses the specification omitted to state that  
 the metal of which they were made required tempering  
 with tallow, and the patent was held bad—*Liardet v.*  
*Johnson* (1 Webs. Pat. Ca., 53 ; Bull. N. P., 76). The speci-  
 fication of a patent for a lamp burner omitted to state  
 where the hole for the admission of air was to be. Jessell,  
 M. R., held it insufficient and the patent void—*Hinks and*  
*Son v. Safety Lighting Co.* (L. R., 4 Ch. D., 607).

2ndly. The specification should clearly distinguish what  
 is new from what is old, what the patentee has himself  
 invented from what was known before or invented by  
 others.

“ It is necessary that the patentee should show that he  
 “ has accurately explained the nature of his invention in  
 “ his specification, *separating that which is new from that*  
 “ *which is old*, so as to enable a person of tolerable skill to  
 “ make the thing by means of his specification”—Gibbs,  
 C. J., directing the jury in *Manton v. Manton* (Dav. Pat.  
 Cas., 349).

“ It is necessary in his specification that the patentee  
 “ should state what his invention is, what he claims to be  
 “ new and what he admits to be old, for if the specification  
 “ states simply the whole machinery he uses, and which he  
 “ wishes to introduce into use, and claims the whole of that  
 “ as new, and does not state that he claims either any  
 “ particular part, or the combination of the whole as new,  
 “ why, then his patent must be taken to be a patent for the  
 “ whole of each particular part, and *his patent will be void*  
 “ *if any particular part turns out to be old or the com-*  
 “ *ination itself not new.*”—Lord Abinger directing the  
 jury in *Carpenter v. Smith* (1 Webs. Pat. Ca., 532).

A patent was obtained for “ An improved turning lathe,” all the parts of which, except one, had been anticipated, and the specification claimed “ the improved turning lathe here-  
 “ inbefore described,” without explaining that any part of it was old. On the trial, the jury found that the introduction of the one new part—suspending rods—made the lathe a new machine. But it was held that the patent was void because the specification did not distinguish what was new from what was old, and that the patentee had therefore claimed both—*Holmes v. London and N. W. Ry. Co.* (12 C. B., 881 ; Mac. Pat. Ca., 13).

Where the patented machine or apparatus is entirely new the patentee is not bound to describe and distinguish the different parts, but where the invention consists of a machine which is merely an improvement upon an old machine he must distinguish and describe all the parts which he claims as new—*Dangerfield v. Jones* (13 L.T., N.S., 144).

“ If a specification includes what is old as well as what is  
 “ new the patentee must be taken to claim all unless he  
 “ makes it clearly appear that he does not claim that which  
 is old ”—Coleridge, J., in *Tetley v. Easton and Amos* (2 E. and B., 956).

3rdly. The complete specification must keep within the

limits of the provisional specification and must not introduce anything which is a larger or different invention (see the preceding section and the cases referred to therein upon this point, especially *Bailey v. Robertson*, *United Telephone Co. v. Harrison*, *Cox-Walker and Co.* (Edison's Pat.) and *Newall v. Elliott*).

4thly. The specification is to explain the invention, but it is, of course, impossible to make it intelligible to everyone. The rule, therefore, is that it should be intelligible to persons of ordinary skill and ability, competently acquainted with the particular subject to which the invention relates, so that, by following the directions contained in it, they can produce without difficulty what the patentee describes as his invention.

“ When it is said that the meaning of the specification is that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably competent skill in such matters to make it, for no sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch ”—Lord Ellenborough, C. J., in *Harmar v. Playne* (Dav. Pat. Cas., 318; 11 East, 101).

“ The specification is addressed, not to persons entirely ignorant of the subject matter, but to artists of competent skill in that branch of manufacture to which it relates ”—Lord Denman, C. J., in *Bickford v. Skewes* (1 Web. Pat. Cas., 218; 10 L. J., Q. B., 304).

“ A specification is sufficient if it enables a person of ordinary skill and knowledge of the subject to construct the patented machine or carry on the patented process.

“ You are not to ask yourselves the question whether persons of great skill—a first-rate engineer, or a second-class engineer, as described by Mr. Farey—whether they could do it; because generally those persons are men of great science and philosophical knowledge, and they would upon a mere hint in the specification, probably invent a

“ machine which would answer the purpose extremely well ;  
 “ but that is not the description of persons to whom this  
 “ specification may be supposed to be addressed ; it is  
 “ supposed to be addressed to a practical workman who  
 “ brings the ordinary degree of knowledge, and the  
 “ ordinary degree of capacity to the subject ”—Parke, B.,  
 directing the jury in *Neilson v. Harford* (1 Webs. Pat.  
 Cas., 314).

“ The specification is to be read as addressed to artists  
 “ or persons of competent skill in the branch of manufacture  
 “ or process to which it is applicable. Hence, known  
 “ machines need not be described when the use of them  
 “ is to be made in carrying out the object of the patent.  
 “ For instance, if in an apparatus for improving the making  
 “ of gas, a patentee should not mention or allude to a con-  
 “ denser, yet, if in practice, that is a part of the apparatus  
 “ required for the making of gas it was held\* that everyone  
 “ must know that a condenser must be used. . . .  
 “ Workmen of ordinary skill mean those competent in the  
 “ ordinary business and conducting the particular trade—  
 “ to furnish and construct apparatus for the purpose  
 “ required. The patentee does not satisfy the condition of  
 “ the law if he says men of the greatest science—first-rate  
 “ engineers—could understand him, and would know what to  
 “ do or what direction to give ; that is not enough. The speci-  
 “ fication must be for the benefit of the trade when the patent  
 “ is out ; it is addressed to those engaged in particular depart-  
 “ ments of trade, and who are to be employed in order to  
 “ make apparatus for the purpose, those who are employed  
 “ to make similar apparatus for similar purposes—not com-  
 “ mon labourers or workmen employed under those who  
 “ furnish and construct such apparatus ”—Lord Justice  
 Clerk Hope directing the jury in *The Househill Company*  
*v. Neilson* (1 Webs. Pat. Cas., pp. 687 and 692).

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\* Tenterden, C. J., in *Crossley v. Beverley* (3 C. & P., 513 ; 1 Webs. Pat. Cas., 105).



5thly. The specification must be so full and distinct as to enable any person, competently acquainted with the subject of the invention, to construct the patented machine, or perform the patented process, without the necessity of performing experiments for himself.

“ If the invention can only be carried into effect by  
 “ persons setting themselves a problem to solve, then they  
 “ who solve the problem become the inventors of the method  
 “ of solving it, and he who leaves persons to carry out his  
 “ intention by means of that application of their understand-  
 “ ing does not teach them in his specification that, which in  
 “ order to entitle him to maintain his patent, he should teach  
 “ them—the way of doing the thing, but sets them a problem,  
 “ which, being suggested to persons of skill, they may be  
 “ able to solve. That is not the way in which a specification  
 “ ought to be framed. It ought to be framed so as not to  
 “ call upon a person to have recourse to more than those  
 “ ordinary means of knowledge—not invention—which a work-  
 “ man of competent skill in his art and trade may be pre-  
 “ sumed to have. You may call upon him to exercise all the  
 “ existing knowledge common to the trade, but you cannot  
 “ call upon him to exercise anything more. You have no  
 “ right to call upon him to tax his ingenuity or invention”  
 Alderson, B., directing the jury in *Morgan v. Seaward*  
 (1 Webs. Pat. Cas., 174).

In an action for infringing a patent for blocks for pavement, the Plaintiff claimed as his invention that his block was bevelled both inwards and outwards on the same side as the block, and it was alleged that the Defendant's block was an imitation of the Plaintiff's, as two of the Defendant's blocks were equivalent to one of the Plaintiff's. The specification did *not state at what angle the bevels should be made.* Lord Abinger, C. B., directed the jury that if the specification left it to experiment to determine what was the proper angle for the bevels it was not good; but if any angle was a benefit it would. The jury having found for the

Defendant, the learned judge said that he thought the specification was insufficient—*Macnamara v. Hulse* (1 Carrington and Marshman, 477; 2 Webs. Pat. Cas., 129).

“If, in order to use the invention beneficially at all, experiments were necessary, then the specification would be bad. If it were necessary to use experiments in order to have the benefit of the invention claimed by the specification it would be void; but if in this case it is only necessary to have recourse to experiments *in order to have the full benefit that the subject is capable of*, it appears to me that it would not void the patent . . . . If the simplest form would be productive of benefit it appears to me the specification is good”—Parke, B., directing the jury in *Neilson v. Harford* (1 Webs. Pat. Ca., 317, 318).

6thly. The specification should make it clear whether the invention consists *in the useful application of a principle*, or in a *particular arrangement or combination of parts*. The distinction is very great and must be clearly apprehended. When a man discovers something entirely novel, such as a new mechanical motion, he may be said to have discovered a principle, and he is entitled to protect that, not only in the methods by which he himself applies it, but also in all other methods of doing so. When, on the other hand, he has invented, not something entirely novel, but an improvement only upon what existed before, whether by the addition of something new, or by a new combination of parts, he is entitled to protection for that alone. In the latter case any one else may start from the same point, and, by adding something else new, or by another new arrangement of parts, may produce an independent invention which does not infringe the other. All this, of course, is perfectly obvious, and is the plainest common sense. But in preparing the specification it is necessary carefully to consider the invention, to ascertain if it belongs to the one class or the other, so as to impress the appropriate character upon

its description and especially to frame the proper claim. If the invention prove only to be for an improvement or new combination, and not for a principle in the sense above explained, yet the specification and claims are for an entirely novel invention or principle, the patent will be void, as granted for more than the inventor was entitled to. Many examples exist where patents have been held void in the courts of law through inadvertently claiming too much, some of which will be presently cited. If, on the other hand, the invention be really for something entirely novel, and yet, through excess of caution, the specification and claims only cover the applications of the principle actually used by the inventor and described in the specification, the inventor loses, probably, the greater part of what is his due, because, in such cases, it is generally comparatively easy to contrive a mechanical or other equivalent and so evade the patent. The task of thus distinguishing between these two classes of invention is one of some difficulty and delicacy, in which experience and knowledge of the subject are the only really adequate guides.

It will be safe, however, when approaching the consideration of the question as to which of these two classes an invention properly belongs to bear in mind: First, that from the nature of things, inventions of improvements or new combinations are considerably more numerous than those of entire novelties or principles; and, secondly, that inventors, not unnaturally, generally overrate the merit of their inventions. Another general axiom which it is also desirable to bear in mind was thus expressed by Pollock, C. B., in directing the jury in the case of *Crossley v. Potter* (Macr. Pat. Ca., 256):—"The safest course for patentees  
" to adopt in framing their specifications is, instead of  
" claiming everything, to confine themselves to one good  
" thing; and a jury will always take care that if he be a  
" real inventor no man, under colour of improvement, shall  
" be allowed to interfere with that which is the offspring of

“ their genius.” To show that such a course will secure adequate protection, the following remarks attributed to Lord Hatherley, then Vice-Chancellor Wood, when trying the case of *Curtis v. Platt*, cited in Johnson on Patents (4th Ed., p. 244) are given:—“ Where the thing is “ wholly novel, and one that has never been achieved “ before, the machine itself which is invented, necessarily “ contains a great amount of novelty in all its parts, “ and one looks very narrowly and very jealously upon “ any other machines for effecting the same object, to “ see whether or not they are merely colourable contriv- “ ances for evading that which has been done before.” And an examination of the reports of patent cases will show that, while very few inventors have failed to secure justice to themselves by claiming too little, very many have been disappointed and defeated through claiming too much.

The case of Harrison’s Patent—*Holmes v. London and N. W. Ry. Co.* (12 C. B., 831; Macr. Pat. Cas., 4)—already cited, may be taken as a good illustration of this—so good that it is worth while setting out the facts and judgment a little fully. The patent was for a railway turntable, constructed so that the weight of the load bore upon a central pin instead of upon rollers at the periphery of the table, as formerly in use, and the object was to diminish friction. A central pin had been used before, not for bearing the weight, but as a guide to keep the table in place. The platform was a rigid table, and the whole weight was thrown upon the central pin, and there were (*a*) an upright post terminating in a pivot supporting the table, (*b*) a massive ring encircling the base of the post and carrying friction rollers, (*c*) *vertical suspending* rods attaching the ring to the table, and (*d*) oblique struts carried from the ring to the periphery of the table. At the trial it appeared that of these four elements, three—(*a*), (*b*) and (*d*)—had been anticipated by Handcock’s Patent. Jervis, C. J., directed the jury that *a*, *b*, and *d* appeared old, but

that *c* (the vertical suspending rods) was new and useful, and the combination of these old things with one new formed a new quality, and therefore there would be novelty. The jury found a verdict for the plaintiff in favour of the patent, but leave was reserved to enter judgment for the defendants on the ground that the specification was insufficient. And the Court of Common Pleas held that it was, and the patent therefore void. Jervis, C. J., said:—

“ In order to make his specification good, Harrison should  
 “ have said:—‘ My invention is to suspend the revolving  
 “ ‘ platform on a post with braces, arms, and supports,’  
 “ and then, describing all that was old, should have said,  
 “ ‘ To these I add suspending rods for the purpose of  
 “ ‘ bringing the bearing on to the centre of the table.’ No  
 “ one can read this specification without seeing the patentee  
 “ supposes the arms to be new as well as the suspending  
 “ rods; in short, that all is new except the table, the rails,  
 “ and the catches, which, by means of the suspending rods,  
 “ he converts into a new and improved suspended turn-  
 “ table. That being so, he does comply with the rule  
 “ which requires the patentee distinctly to state what is  
 “ new and what is old. The specification is insufficient.”

In *Brown's Patent, Bovill v. Moore* (Dav. Pat. Cas., 361; 2 Marsh., 211), the specification claimed the whole machine, which was for the manufacture of bobbin lace or twist net. At the trial it was proved that up to the point at which the bobbin in the patentee's machine travelled round a longitudinal thread to form the twist, the operation was the same as in previous machines, but beyond that it was new. And it was objected that the patent should have been for an improvement only, and not for the whole machine. The patent was held void upon that ground. Gibbs, C. J., directed the jury as follows:—“ If a  
 “ patentee has invented an improvement only, then his  
 “ specification by which he claimed the whole will be bad.  
 “ . . . If you think he has invented a machine which

“ consists of a perfectly new conformation of parts, though  
 “ all the parts were used before, yet he will be entitled to  
 “ support his patent for a new machine. . . . If a  
 “ combination of a certain number of parts existed up to  
 “ a given point before, and his invention sprung from that  
 “ point, and added other combinations to it, then his specifi-  
 “ cation, stating the whole machine as his invention, is bad.”  
 This direction was questioned, but upheld by the full court.

The case of Kay's Patent, *Kay v. Marshall* (2 Webs. Pat. Cas., 36; 5 Bing., N. C., 492), and in the House of Lords (8 Cl. & F., 245) is also a very useful one to remember. The inventions claimed were two things—(1), machinery for macerating flax; and (2) machinery for spinning flax. The machinery, or method, of macerating flax was new, and the invention was valuable; but the patent was wrecked because it appeared the machinery claimed for spinning flax was old. If the claim for the spinning machinery had been omitted from the specification, the patent would have been good for the macerating machinery or process; or if the claim, instead of being for the spinning machinery, which was old, had been for the combination of the old spinning machinery with the new machinery or process for macerating, the patent being for what was a new combination would have been valid. Hence, it would seem in this case that a patent for a valuable invention was lost by the manner in which the specification was drafted.

In the case of *Foxwell v. Bostock* (4 De G. J. & S., 298) Lord Westbury, L. C., in holding a patent for an improved sewing machine, void on the ground of the specification being insufficient, made the following observations, which deserve to be studied carefully:—“ The difficulty of the  
 “ plaintiff arises entirely from the manner in which he has  
 “ described his alleged invention. His counsel had no  
 “ difficulty at the bar in describing his improvement. They  
 “ stated it to consist of an arrangement of three cams upon  
 “ one shaft, by the direct action of which the three prin-

“ cipal motions in a needle and shuttle machine, viz., the  
“ needle movement, the shuttle movement, and the feed  
“ movement, are effected ; and the plaintiff’s evidence was  
“ directed to show that this arrangement formed the novelty  
“ and utility of the patent. But this clear and simple  
“ statement is not to be found anywhere in the specifica-  
“ tion. The argument is, that this is not necessary when the  
“ patent is for a combination. But I think that, both on  
“ principle and authority, it is most necessary that the  
“ specification should ascertain the improvement when the  
“ patent is for an improved—that is for a new—combination.  
“ If a combination of machinery for effecting certain results  
“ has previously existed, and is well known, and an im-  
“ provement is afterwards discovered, consisting, for example,  
“ of the introduction of some new parts, or an altered  
“ arrangement in some particular of the existing con-  
“ stituent parts of the machine, such improved arrange-  
“ ment or combination may be patented ; but it would be  
“ contrary to the spirit of the patent law, and of the  
“ decided cases, to permit a patent to be taken out for a  
“ new combination, and the whole machine to be described  
“ and specified as a new invention, without, in any manner  
“ distinguishing or marking the improvement by the intro-  
“ duction or addition of which the improved arrangement  
“ or combination is in reality produced. The term ‘com-  
“ bination of machinery,’ which has become a favourite  
“ word with patentees, is nothing but an extended expres-  
“ sion of the word ‘machine.’ It is the word ‘machine’  
“ writ large ; and as a patent for an improved machine  
“ in the specification of which, the improvement was not  
“ particularly stated and described, would hardly be at-  
“ tempted to be supported, so neither, in my judgment,  
“ can the patent for an improved arrangement or com-  
“ bination be supported in the specification of which there  
“ is nothing to distinguish the new from the old.”

Lord Justice James, when Vice-Chancellor, in *Parke v.*

*Stevens* (L. R. 8, Eq. 358), affirmed on appeal (L. R. 5, Ch. 36); said, alluding to the above remarks of Lord Westbury:—"It is obvious that a patentee does not comply, as he ought to do, with the conditions of his grant, if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new would have to get rid of a large proportion of the specification by eliminating from it all that was old and commonplace, all that was the subject of other patents and other improvements, bringing to the subject, not only the knowledge of an ordinary skilled artisan, but of a patent lawyer or agent."

If, however, a combination only be claimed, a description of the items or elements thereof, and of the way in which the patentee combines them together, followed by a claim restricted to the combination described, will be a sufficient description of the invention, without specifically distinguishing new from old — *Harrison v. Anderston Foundry Co.* (L. R. 1 App. Cas., 574). In such a case the only thing the patentee asserts as new and claims to be his own is the combination, and it may, therefore, be assumed in reading his specification that all is old, except the combination. Such a mode of specifying in such a case, therefore, does not fall within the above remarks of Lord Westbury and Lord Justice James.

Before leaving this subject of combination, or rather of the necessity of clearly distinguishing in the specification whether the invention is for the application of a principle, or for a particular arrangement or combination of parts, there is one other remark to make.

It may, of course, and in fact very frequently does happen—perhaps inventions of these sort are more numerous than any others—that the invention consists, not merely of a new combination of all old parts, but of a combination of several old with some new parts. Then, of course, the patentee may, and ought to claim, not only the combination,



but the several new parts. But he must do this specifically and clearly. The following remarks of Lord Justice James, in *Clark v. Lisle* (L. R., 10 Ch., 667), affirmed on appeal in the House of Lords (L. R., 2 App. Cas., 315), are upon this point:—“It has been strongly contended before us  
 “ that, whenever there is a patent for a combination, the  
 “ patent gives protection, not indeed to every distinct  
 “ thing that enters into the combination, *but to every com-  
 “ bination, arrangement, and aggregate of two or more of  
 “ those distinct things, even although subordinate combina-  
 “ tion is not expressly or impliedly claimed in the specifica-  
 “ tion.* This, in our opinion, is so startling a violation of  
 “ every principle of patent law, that we doubt whether we  
 “ could follow any authority short of the House of Lords in  
 “ applying such a doctrine. A patent for a new combination  
 “ or arrangement is to be entitled to the same protection,  
 “ and on the same principle, as every other patent. The  
 “ patent is for the entire combination, but there is, or may  
 “ be, an essence or substance of the invention underlying the  
 “ mere accident of form; and that invention may be pirated  
 “ by a theft in a disguised or mutilated form, and it will be  
 “ in every case a question of fact whether the alleged piracy  
 “ is the same in substance and effect, or is a substantially  
 “ new or different combination. The principle is really very  
 “ plain, as it seems to me. A combination or accumulation  
 “ of these improvements is a totally distinct thing from a  
 “ combination or accumulation of two of them—as distinct as  
 “ a partnership of A, B, and C is from a partnership of A and  
 “ B. If a man really wants to patent, not only the whole,  
 “ but something less than the whole of what he calls ‘a new  
 “ ‘arrangement, construction, and combination of parts,’ he  
 “ *must clearly show that he claims that something less, of  
 “ course, perilling his patent if that something less is not  
 “ a novelty.*”

7thly. The preceding six rules or canons which have been discussed have all been to show that candour, accuracy, and

clearness must distinguish the specification of a patent to ensure its being held sufficient in a court of law. But if it possess those qualities *it will be construed by a court of law liberally, and in favour of the inventor.*

“The specification ought to be taken as a whole, and fairly and candidly construed, without astuteness to pick holes in it”—Alderson, B.; and—“In the construction of a patent the Court is bound to read the specification so as to support it, if it can fairly be done”—Parke, B., in *Russell v. Cowley* (1 Webs. Pat. Cas., 470).

“A specification should be construed in the sense which the patentee intended, and if any expressions are ambiguous, we should endeavour to give effect to the intention; and, moreover, I think that every patent should be expounded favourably to the patentee. But we ought not to violate the obvious meaning of the language unless it is quite clear that the patentee intended something different from that which the expressions indicate—Pollock, B. (9 Exch., 501).

“It is the duty of the judge to construe a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported, upon a reasonable interpretation of the patent, or, in other words, that a judge is not to be astute to find flaws in small matters in a specification with a view to overthrow it”—Jessell, M. R. (p. 422). “I agree with the Master of the Rolls that the Court ought to be anything but astute to support such an objection”—Brett, L. J., in Court of Appeal, in *Plimpton v. Spiller* (p. 423); *Plimpton v. Spiller* (L. R., 6 Ch. D., 412).

Lord Blackburn said, in the House of Lords, in *Dudyeon v. Thomson* (L. R., 3 App. Cas., at p. 53) :—“The question arises in the present case, whether the particular thing is or is not within the specification. It is said that the tool made by the respondents comes within the specification, and is an infringement of the patent. In such a case, it

“ is the interest of the patentee to give the specification as  
 “ wide a meaning as he can give to it, in order to make it  
 “ take in the thing done by the alleged infringer. It might  
 “ have been that it was the other way, and that the thing  
 “ was known to be old, and then, of course, the patent  
 “ might have been upset by showing that it included an  
 “ old thing. Then the position of the parties would have  
 “ been reversed, and the interest of the patentee would  
 “ then have been to argue that the true construction did  
 “ not include this. But whether it is for the interest of  
 “ one side or the other, I apprehend the duty of the Court  
 “ is fairly and truly to construe the specification—neither  
 “ favouring the one side or the other—neither putting an  
 “ unfair gloss or construction upon the specification for the  
 “ purpose of saving the patent if it said that the patent is  
 “ void, nor putting an unfair gloss or construction upon it  
 “ in order to extend the patent, and make it take in some-  
 “ thing, which you may think was an unhandsome taking of  
 “ the fruits of his invention from the patentee, if it is not  
 “ really an infringement of the patent.”

“ The construction of a specification, or the construction  
 “ of all other written documents, belongs to the Court ; but  
 “ the explanation of the words or technical terms of art, the  
 “ phrases used in commerce, and the proof and results of the  
 “ processes which are described, and in a chemical patent the  
 “ ascertainment of chemical equivalents are matters of fact  
 “ upon which evidence may be given, contradictory testimony  
 “ may be adduced, upon which it is the province and right  
 “ of a jury to decide”—Lord Westbury, L. C., in *Hills v.*  
*Evans* (31 L. J., Ch. 457 ; 4 De G., F. & J., 288).

8thly. Following from the principle of construing speci-  
 fications favourably to the validity of the patent, it has also  
 been decided *that verbal errors in the specification, if, on*  
*reading it carefully the sense of the patentee can be discovered*  
*do not avoid a patent.* Thus, when a French patentee used  
 the word “discolouring” to signify depriving of colour,

and the word "baked" instead of the word crystallized, his meaning being apparent, the specification was not held insufficient—*Derosne v. Fairie* (2 Cr., M. & R., 476; 1 Webs. Pat. Cas., 158); and in *Minter v. Mower* (1 Webs. Pat. Cas., 138), it was held that it was indifferent whether a word used in a specification is the correct description of the thing, provided it describes it so that no man can doubt what it is. But that these decisions do not authorise carelessness appears from the following remarks of Lord Westbury, in *Simpson v. Holliday* (13 W. R., 578; 12 L. T., N. S., 99):—"When it is stated that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected on following out the instructions given for any process of manufacture; and the reason is that such errors cannot possibly mislead. But the proposition is not a correct statement of the law if applied to errors *which are discoverable only by experiment and further inquiry*. Neither is the proposition true of an erroneous statement, amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject."

9thly. And in construing a specification it is not competent to the patentee to call in aid the provisional specification in order to explain or enlarge the meaning of the complete specification—*Mackelcan v. Rennie* (13 C. B., N. S., 52).

10thly. Words in a specification are to be construed in their ordinary and proper meaning, unless there be something in the context to show that a different construction ought to prevail, when they may be explained by evidence—*Elliott v. Turner* (2 C. B., 446; and see also *Hills v. Evans* (*supra* p. 61)).

DRAWINGS.—By section 5, sub-sections 3 and 4, of the

new Act, it is enacted that both provisional and complete specifications must be accompanied by drawings, if required. A great number of inventions cannot be described, at least in the detail required for a complete specification, without the aid of drawings. These drawings, when used, are a part of the specification as much as the verbal portion thereof; and the statement of the law and decisions set out above are equally applicable to them. With regard to drawings, it is necessary to bear in mind that they are subsidiary to the verbal part of the description and not the verbal part to them. Accordingly, it was held in *Clark v. Adie* (L. R. 10, Ch. 667); in the House of Lords (L. R. 2, App. Cas., 315) that a patentee cannot rely upon a drawing as describing a material part of his invention when there was no verbal reference whatever thereto in any other part of the specification.

#### 4TH. THE CLAIMS.

Section 5, sub-section 5, of the new Act requires that "a complete specification must end with a distinct statement of the invention claimed"; in other words, with a claim or claims.

In thus compulsorily requiring claims, legislation has only adopted what had come to be the prevailing practice of summing-up the invention at the end of the complete specification, by adding a declaration that the patentee claimed certain specific points of novelty as being the essence and substance of his invention. It is, of course, obvious that "in particularly describing and ascertaining inventions, and in what manner the same are to be performed," which is what the law always required, as it does still; in most cases a great deal has to be described and referred to beyond what the patentee has himself invented, in order to make them intelligible. In describing a process or machine it would be impossible, or at least very confusing, to stop at every step and say whether it did or did not form part of

the invention. It was much more convenient, and much more perspicuous, at the beginning of the specification, to state the object of the invention, mentioning, perhaps, what had been ordinarily used before; then to describe the process or machine throughout; and finally to conclude by saying that what was claimed as the invention were certain named specific points of novelty. Hence, for many years, claims have been found in almost all well drawn specifications, and a number of legal decisions have taken place upon them.

The chief point to be attended to in drafting the claim, which, perhaps, among all those important matters—the title the provisional and the complete specifications—which the preceding pages have discussed, is the most important of all—is to catch the invention therein. If, in drafting the specification, it is necessary to have a clear idea of what is the exact invention—that is, of what this particular inventor has discovered in this particular instance—it is still more necessary to have it when drafting the claim, so as to be able to express it accordingly with precision. On the one hand, to avoid including anything beyond the boundary of the particular invention, and, on the other, to avoid restricting it to less than it really contains.

The following judicial decisions show the object and effect of the claim:—

“The claim,” said Lord Cottenham, L. C., in *Kay v. Marshall* (2 Webs. Pat. Cas., 39; 1 My. and Cr., 383), “is introduced, lest, on describing and ascertaining the nature of his invention, and by what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as a means of making a machine according to

“ the patentee’s improvements. If, therefore, the specifi-  
 “ cation, as containing the description, be sufficiently pre-  
 “ cise, it cannot be of any consequence that expressions are  
 “ used in the claim which would be too general if they pro-  
 “ fessed to be part of the description.” This was said in  
 1836, in the early days of claims ; but it has always re-  
 mained a correct exposition of the law. Comparatively  
 quite recently, in 1877, Lord Justice James, in *Plimpton v.*  
*Spiller* (L. R. 6 Ch. D., p. 426), said :—“ The real object  
 “ of the claim is not to claim anything which is not men-  
 “ tioned in the specification, but to disclaim something.  
 “ A 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 well known and in common  
 “ use ; he describes new combinations of old things to pro-  
 “ duce a new result, or something of that kind. Therefore,  
 “ having described his invention, and the mode of carrying  
 “ it 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 now about to state.’ That is really the legitimate  
 “ object of the claim, and you must always construe a claim  
 “ with reference to the whole context of a specification.”  
 Jessell, M. R., said, in *Hinks and Son v. Safety Lighting Co.*  
 (L. R., 4 Ch. D., 612) :—“ It has long been the practice of  
 “ patent agents to insert in specifications the distinct  
 “ claim of what is said to be comprised in the patent—  
 “ meaning that nothing else is comprised, that everything  
 “ else is open to the public.”

There is a tendency among inventors to make their  
 claims grasping, or, as it were, speculative and antici-  
 patory, arising from the fear of infringement, and lest  
 the fruits of their labours should be appropriated by one  
 who contrives to approach them nearly enough to do so,

but who manages to keep far enough off to avoid their patent.

But anyone whose duty it may be to draft specifications and claims, must avoid falling into this error. If there be a real invention the law is strong enough to protect it from all attempts at infringements and colourable imitations, and legal tribunals are anxious to apply it in favour of a meritorious inventor against anyone who thus tries to rob him. But if the claims prove to be for more than the patentee has invented then the patent will be lost. Lord Eldon said, in *Leitch v. Thompson* (1 Webs. Pat. Cas., 237 ; 3 Mer., 629) :—“The specification must not attempt to  
 “ cover more than that which, being both matter of actual  
 “ discovery and of useful discovery, is the only proper subject  
 “ for the protection of a patent. And I am compelled to add  
 “ that if a patentee seeks, by his specification, any more than  
 “ he is strictly entitled to, his patent is thereby rendered in-  
 “ effectual, even to the extent to which he would be otherwise  
 “ fairly entitled.”

In *Tetley v. Easton* (Macr. Pat. Cas., 48), Pollock, C.B., in directing the jury said :—“That the law will permit  
 “ an inventor to claim that which he has invented by  
 “ means of successful experiments or otherwise, and which  
 “ he has given to the public, but *not that which is the mere*  
 “ *subject of his speculation or imagination, or of his endeav-*  
 “ *ouring to grasp more than he is entitled to.* I think we  
 “ are bound to give, as far as possible, the fullest effect to an  
 “ invention ; but, on the other hand, we are also bound to  
 “ oppose the endeavours to make a patent grasp at, and  
 “ embrace, a number of matters that were never in the head  
 “ of the inventor.”

In *Stevens v. Keating* (2 Exch. R., 772), Pollock, C. B., in delivering judgment, said :—“The question is whether the  
 “ specification be good or not. Only one alkali (potash),  
 “ and one acid (sulphuric) are mentioned in the specification ;  
 “ but manifestly the inventor does not confine himself to



“ these; if he did the defendant would be entitled to a  
“ verdict, for he has used neither. To what extent then  
“ does the claim go beyond the alkali and acid named? If it  
“ be a claim of all acids and alkalis, it is clearly bad as there  
“ are some which will not answer the purpose. If it be a  
“ claim for those only which will answer the purpose, it is  
“ as clearly bad, in consequence of not stating those which  
“ will answer the purpose, and distinguishing them from  
“ those which will not, and so preventing the public from  
“ being under the necessity of making experiments to  
“ ascertain which of them will succeed, and which will not.  
“ . . . . In any view, therefore, the specification is  
“ defective.”

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## CHAPTER II.

## PRINCIPLES OF THE LAW OF COPYRIGHT IN DESIGNS.

It is said that the French were the first to establish by law copyright in designs, and that, in the years 1737 and 1744, laws were enacted, giving a property in designs to the manufacturers of Lyons, and that, in the year 1787, the benefits of legal protection were fully established in France—Copinger on Copyright (2nd Ed., p. 410). And it is also asserted (*Ibid.*) that the pre-eminence of the French in the art of ornamentation, may be attributed to the efficient protection which natives of that country have so long enjoyed for designs for that purpose. However, this may be, the first Act of Parliament of Great Britain giving protection to the contriver of designs was passed in 1787 (27 Geo., c. 38); and was followed by the Acts 29 Geo. 3, c. 19; and 34 Geo. 3, c. 23, which related only to designs upon linen and cotton fabrics. In 1839, an Act was passed (2 Vic., c. 13), extending the protection of these Acts to designs upon fabrics of animal substances, or of mixed animal and vegetable substances.

But these Acts were all repealed by the Statute passed in the year 1842, the 5 & 6 Vic., c. 100, which, amended by the 6 & 7 Vic., c. 65; 13 & 14 Vic., c. 104; 21 & 22 Vic., c. 70, and the 24 & 25 Vic., c. 73, formed together the law of this country upon the subject. These Acts are now all repealed by the present Act of Parliament, and the provisions of the third part of this Act, contained in sections 47 to 57 inclusive, are substituted in their place.

Up to the coming into operation of the present Act there were two distinct rights of copyright in this country—one copyright in the application of designs for ornamental purposes, regulated by the Act of 1842 (5 & 6 Vic., c. 100),

and the other, copyright in the application of designs for the shape and configuration of articles of utility, regulated by the Act of 1843 (6 & 7 Vic., c. 65). This distinction between ornamental and useful designs is now abolished.

The best explanation of the objects of the legislature in so doing is to be found in the Memorandum printed upon the back of the Bill, which has since become the present Act, upon its first introduction into Parliament. In that Memorandum it was said:—"At present there is a two-  
 " fold classification of designs into ornamental and useful,  
 " and they are registered under separate Acts, which,  
 " however, in their main features are the same. It is often  
 " difficult to determine to which class—useful or ornamental  
 " —a design belongs, while a so-called useful design might  
 " frequently be the subject of a patent were it not for the  
 " cost. Inasmuch as, under the Bill, the first fee on Letters  
 " Patent is to be reduced from £25 to £1 (£10 being  
 " charged for the registration of a useful design), it is pro-  
 " posed to discontinue the distinction between ornamental  
 " and useful designs, and to accept for registration *any*  
 " novel design in the proper sense of the word. Such  
 " useful designs as embrace a mechanical action would be  
 " treated as subject matter for a patent."

The above marks out clearly the principal difference between the law in operation up to the commencement of the new Act, and under the new Act. Under the new Act, any novel design, whether for ornament or for use, will be entitled to registration without distinction.

The only other difference of any great practical importance, is that of the time during which protection was afforded. Under the old law the period of protection varied, in the case of ornamental designs, from nine months (designs applied by printing to shawls or yarn, thread, or warp; Classes VIII. and IX.); to five years (designs applied to articles composed of metal, Class I.); while, in the case of

utility, three years was allowed. Under the new Act, a uniform period of five years' protection from the date of registration (see section 50) is afforded to all designs without distinction of class or character.

Another difference between the old law and that which now supersedes it, which calls for remark, is that what was called provisional registration, is abolished.

Provisional registration was permitted under the Act 13 & 14 Vic., c. 104, now repealed, which provided that designs might be provisionally registered, and that such provisional registration should continue in force for one year (which might be extended to six months more) from the time of registration, during which the proprietor could sell or transfer the right to apply his design to an article of manufacture; but if he sold, exposed, or offered for sale any article to which his design had been applied, until after complete registration, the provisional registration was null and void. Such provisional registrations were granted on the payment of small fees, and could at once be turned into complete registrations by paying the larger fees required for the purpose. However, they are now abolished, and it is not apprehended that anyone will much regret their abolition.

Another alteration in the law requiring attention is that introduced by section 54, that if the registered design is used in a foreign country, and is not used in this country within six months after registration here, the copyright is to cease.

The principles of the law upon the copyright of design remain unchanged by the new legislation. They are very few in number and simple of application, as, indeed, as those relating to patents for inventions. But differing from the latter, owing to the simplicity of designs as compared with inventions, and their generally great inferior commercial value, the legal questions which have arisen, or been litigated, about them are not numerous, and the

reported legal decisions relating thereto are but few in number.

The first principle to be noted is that the protection is given, not to the article of manufacture or the substance to which the design is applied, but to the design. The design is a different thing from the article to which it is applied, and it is the design, and the design only, which is protected (see the definition of "design" given in section 60 of the Act). This is the distinguishing feature in copyright in designs. The protection by patent is given to the article itself produced by the use of the invention patented. The protection afforded by a trade mark is to secure the reputation which has been gained by any manufacturer of particular goods, from being improperly made use of by another through copying his trade mark—the *business* of the owner of the trade mark is protected, not the article he manufactures. But in copyright in designs, it is the design—that is something extrinsic to the article to which it is applied—that is protected. Without the registered design, the article remains, and anyone may use it; with the design he may not. For instance, suppose the design is to be applied to "shawls." The "shawl" is not the design, but the article of manufacture to which the design is to be applied.

The next principle is one in which copyright in designs shares equally with patents for inventions. In order to be entitled to protection, the design, like the invention, must be new at the date of registration. If the design is registered, but it was not new when registered, then registration affords no protection. The authorities upon novelty and publication in patent cases are equally authorities upon questions of novelty and publication in cases relating to copyright in designs, and, it is believed, that there are no reported cases where the decision has turned specially upon the question of the novelty or previous publication of designs.

The next principle to be attended to, is that the proprietor of a design is entitled to be registered as the proprietor thereof, and that he need not necessarily be the inventor or author of the design. Section 61, which repeats the previous legislation on the subject (section 5 of 5 & 6 Vic., c. 100) enacts that "the author shall be considered the proprietor unless he executed the work on behalf of another person for good and valuable consideration, in which case such person shall be considered the proprietor"; and section 47 enacts that "the proprietor is the person who is entitled to register the design." This is different from the law as to patents, which requires that the patent (see section 5) must be granted to the true and first inventor; but which, however, sometimes regards the first importer of an invention into this country as the inventor. If I pay another to contrive a new design for me, I am the proprietor of what he produces, and entitled to register the design as such. If I pay a man to contrive an invention for me, I may, according to the agreement between us, be entitled to an assignment of the patent granted therefor from him when it is obtained, but I am not entitled to obtain the grant of the patent to me for the man's invention. He alone is; but I am entitled to obtain the registration of his design in my own name if I have paid him to make it for me.

And it is important to entertain a clear idea of what copyright in designs is. It is the sole and exclusive right of multiplying copies of a new design.

"When a new design has been created or contrived, its author has an undoubted right in law to the piece of paper or other material upon which the design is delineated, and to the copies which he may make of it. If he simply lends a copy of it to another person, he does not lose his right; and if that person were to threaten to publish it without his permission, he could obtain an injunction restraining such publication. The design is his,

“and he may choose whether he will publish it or not”—See Baron Parke, in *Jefferys v. Boosey* (1 H. L., C. 920). This, no doubt, is copyright; but it is not the copyright which is conferred by the law relating to the registration of copyright. If the design be published—that is, not merely lent to a private individual or individuals, but exhibited or sent into the world upon any article of commerce—then the design, no doubt, none the less remains the author’s, but his control over it is lost. The public have become possessed of it; and although the author might obtain the assistance of the law to prevent another from claiming the merit of the design, by asserting that he was the contriver thereof; yet he cannot prevent the multiplication of the copies, nor can he claim the benefit of any profit which may have resulted from such multiplication. But here the law on the registration of designs steps in, and says in effect to the author of a design: Register your new design, so that there may be no doubt as to what it is; and in return for so registering it, you shall have the exclusive right of multiplying copies of it during the period of registration. If anyone during that time, without your consent, multiplies copies of your designs, or sells them, the law gives you immediate and convenient remedies. It is the privilege which the law confers on the condition of registering, which is the copyright in design to which the definition given above applies, and in which it is used in the Act. “Copyright” (says section 60 of the Act) “means the exclusive right to apply a design to any article of manufacture, or to any substance as aforesaid, in the class or classes in which the design is registered.”

In the notes to Part III. of the Act, comprising sections 47 to 61 inclusive, to which the reader is referred, a great number of points relating to copyright in designs are discussed, and all the more important of the reported cases upon the subject are cited.

## CHAPTER III.

## THE PRINCIPLES OF THE LAW OF TRADE MARKS.

The recognition of property in trade marks by law is comparatively of recent origin. We have seen the right of inventors to property in their invention for a limited period was formally acknowledged by Act of Parliament so long ago as the twenty-first year of the reign of James I.; while, in the year 1742, more than one hundred years later, Lord Chancellor Hardwicke refused the aid of the Court of Chancery to protect a trade mark—the Great Mogul stamp—from infringement, saying:—“It is alleged that the defendant, in using the mark, prejudices the plaintiff by taking away his customers; but there is no more weight in this than there would be in an objection to one inn-keeper setting up the same sign as another”—*Blanchard v. Hill* (2 Atk., 484), showing how little at that time the subject was understood, at least by lawyers. But, as commerce progressed and competition became keen it was perceived that the reputation of individual persons and firms had a great influence upon the value of the articles in which they dealt; and that a species of property did exist in the signs or means by which manufacturers and vendors of goods, indicated to the public that goods were made and sold by them with any reputation they had acquired pledged to them; and that such property required protection by law. In 1816, the defendant having placed on blacking sold by him labels in imitation of those placed on blacking sold by the plaintiffs, an injunction was granted to restrain the infringement—*Day v. Day* (Eden on Injunctions, Edition of 1821, p. 314). In 1824, the case of *Sykes v. Sykes* (3 B. & C., 541; 3 L. J., K. B., 46) was decided. The



plaintiff used to mark shot belts, powder flasks, and other such articles sold by him with the words "Sykes' Patent," and the defendants copied this mark upon their own goods, and it was held they had no right to do so. Abbott, C. J., said:—"It was established that the defendants marked the goods manufactured by them in order to denote that they were of the genuine manufacture of the plaintiff, and although they did not themselves sell them as goods of the plaintiff's manufacture, yet they sold them to retail dealers for the express purpose of being resold as goods of the plaintiff's manufacture. I think that is substantially the same thing." And, in 1838, in *Millington v. Fox* (3 My. & Cr., 338), in which the defendants marked and sold steel with the same words as the plaintiff, although not fraudulently, and, as far as appeared, without any intention to appropriate the plaintiff's trade connection, Lord Cottingham, C., granted an injunction to restrain them from doing so, remarking that the fact of there being no fraudulent intention on the defendants' part did not deprive the plaintiff of the right to the exclusive use of the words in question.

These cases mark the history of the law, proceeding from the first, in which all property in a trade mark was denied; to the two intermediate ones where the plaintiffs were protected from the fraudulent attempts of the defendants to appropriate their trade; and then to the last, in which the right of property to a trade mark was absolutely acknowledged and upheld.

It is important for the clear apprehension of the subject to distinguish between property in invention or patents, in trade marks, and in copyright. These are all distinct in substance and in principle.

Property in invention is conferred upon persons who, having introduced something new into the world, are, upon the fulfilment of a condition—the obtaining of a patent from the Crown—given the exclusive right, during a limited

period, of manufacturing and selling the new thing which they have introduced.

Property in trade marks is the exclusive right, recognised and protected by law, of persons and firms engaged in trade, of using the marks which they have adopted for the purpose of identifying their goods as their own, so long as the manufacture of those goods is carried on by those persons and firms, or by their successors in the business.

Property in copyright is the exclusive right, recognised and protected by law, of authors, or other producers of literary compositions or works of art, to print or otherwise multiply copies of their works.

Property in invention or patents gives the exclusive right to manufacture and use; property in copyright gives the exclusive right to multiply. Property in a trade mark confers no such privileges; it consists in the exclusive right to apply a sign, or device, or *mark* to the article or articles dealt with by the persons who have adopted that mark with reference to those articles; it gives no exclusive right to manufacture, and it matters not how the mark is multiplied or applied so long as it be not applied to those particular articles.

The property in a trade mark consists in the exclusive right to the use of some mark as applied to a particular manufacture—Lord Westbury, L. C., in *Hall v. Barrows* (33 L. J., Ch. 207).

The same learned judge also said in another case:—  
 “The right which a manufacturer has to the use of a trade  
 “mark is the exclusive right to use it for the purpose of  
 “indicating where or by whom, or at what manufactory,  
 “the article to which it is applied was made”—*Leather  
 Cloth Co. v. American Leather Cloth Co., Limited* (35 L. J.,  
 Ch. p. 61); and again, in the same case (33 L. J., Ch. 201):—  
 “There is no exclusive ownership of the symbols which  
 “constitute a trade mark apart from the use and applica-  
 “tion of them; but the word ‘trade mark’ is the desig-

“ nation of marks or symbols when applied to a vendible  
 “ commodity, and the exclusive right to make such use or  
 “ application is rightly called property.”

One more judicial definition may be given, taken from a decision of a Court in the United States of America, a country where the law upon trade marks has been much discussed and considered:—“ A trade mark may consist of  
 “ a name or a device, or a peculiar arrangement of words,  
 “ lines, or figures in the form of a label, which has been  
 “ adopted and used by a person in his business to designate  
 “ goods of a particular kind manufactured by him, and  
 “ which no other person has an equal right to use. The  
 “ right in a trade mark so applied is recognised as property  
 “ which the Court will protect by injunction”—The Supreme Court of Massachusetts, in *Gillman v. Hunnewell* (122 Mass., 8 Lathrop, 139).

Although property in inventions, trade marks, and copyright are thus distinct, they may all, of course, be united in one person for the protection of the same subject. A man may have invented a machine and obtained a patent therefor; he may adopt a trade mark for it, and register it, and he may, although not very probably, adopt so artistic a design for his trade mark as to be entitled to the copyright therein. His property in the invention will expire with the period of the patent, in the copyright with the period of copyright, but the property in the trade mark will continue so long as the machine is manufactured and sold by him or his successors in the business, if kept upon the register.

The above cited decisions, in stating in what property trade marks consists, also define what a trade mark is. As a distinction exists between what are called “old marks,” those in use before the passing of the Trade Marks Registration Act, 1875, viz., the 13th August, 1875, and those first used after that date, it is necessary to endeavour to define what is an old trade mark; the definition of a

new trade mark is to be found in the Act of 1875, amended by the Act of 1883. A definition, or rather enactment, of what a trade mark is, for the purposes of that Act, is found in section 1 of the Merchandise Marks Act, passed in 1862, for the object of preventing the fraudulent use of trade marks, and is as follows:—

The expression "trade mark" shall include any name, signature, word, letter, device, emblem, figure, sign, seal, stamp, diagram, label, ticket, or other mark of any other description used to denote any article to be an article of manufacture, or to be sold by the person using the trade mark. This definition was purposely made very comprehensive for the purposes of that Act. Another definition is one suggested by a very learned writer on the subject, before the passing of the Act of 1875, in a work published in 1874. "A trade mark may be said to be any symbol or name or other indication which, when affixed to goods offered for sale in the market, would convey to the minds of purchasers the impression that those goods were the manufacture of some person or firm, or some particular place. By the expression 'other indication,' is intended such other modes of conveying this impression to the public as may consist of, for instance, any peculiar tying of bundles of goods, or of peculiarly shaped bottles or boxes, or any circumstance connected with the sale of goods which has been always exclusively associated with the plaintiffs' manufacture or business"—Adams on Trade Marks, p. 8.

The definition thus suggested by Mr. Adams may be taken to be an exhaustive and correct definition of an "old mark."

But the Act of 1875, passed for the purpose of establishing a register of trade marks, considerably modified and restricted the definition of a trade mark capable of being registered, and section 64 of the Act of 1883 repeats the definition contained in section 10 of the Act of 1875, with

some slight additions. The following is section 64 of the Act of 1883 (which is printed later on, with notes, to which the reader is referred), the words in the new section which were not in section 10 of the Act of 1875, being indicated by italics:—

“1. For the purposes of this Act, a trade mark must consist of, *or contain*, at least one of the following essential particulars:—

“*(a.)* A name of individual or firm printed, impressed, or woven, in some particular and distinctive manner; or,

“*(b.)* A written signature, or copy of a written signature, of the individual or firm *applying for registration thereof as a trade mark*; or,

“*(c.)* A distinctive device, mark, *brand*, heading, label, or ticket, *or fancy word or words not in common use.* ||

“2. There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, *or of any of them*;

“3. Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures, *or of letters and figures*, used as trade marks before the 13th day of August, 1875, may be registered as trade marks under this part of this Act.”

Since, by section 77 of the Act of 1883, no proceedings can be taken against infringers of a trade mark, unless it has been registered under this Act or that of 1875, the definition of a trade mark, contained in section 64 above, is now conclusive, and in future nothing will be a trade mark which does not come within it, unless used before the 13th August, 1875. With regard to “old marks”—those in use before that date—the case is different, for section 77 provides that no proceedings are to be taken against infringers, unless the mark has either been registered under

the Acts of 1875, 1877, or 1883, or registration thereof has been refused.

It is, therefore, important to bear in mind this difference between "old marks"—those used before the 13th August, 1875—and "new marks"—those first used after that date.

The following, amongst others, were held to be trade marks before the Act of 1875, and, as such, subjects of property, and entitled to the protection of a court of law against infringers:—

A system of numbering spools so as to indicate the quality of the thread wound upon them—*Ainsworth v. Walmsley* (L. R., 1 Eq. 518).

The well-known label of Johan Maria Farina upon Eau de Cologne bottles—*Farina v. Silverlock* (1 K. & J., 509; 6 De G. M. & G., 214).

The words or label "Excelsior White Soft Soap"—*Braham v. Bustard* (1 Hem. & M., 447).

The letters "LJ," as applied to whiskey—*Kinahan v. Bolton* (15 Ir. R., Ch. 75).

The Turkish word "Possendede," meaning "Warranted"—*Gout v. Aleploglu* (6 Beav., 69).

The word "Eureka," applied to shirts—*Ford v. Foster* (L. R., 7 Ch. 611; 41 L. J., Ch. 682).

The letters and names "Crowley," "Crowley Milling-ton," "J H," applied to steel—*Millington v. Fox* (3 My. & Cr., 338).

The word "Ethiopian," and six white lines upon black stockings—*Hine v. Lart* (10 Jur., 106; 7 L. T., 41).

The labels upon the bottles in which Burgess' Essence of Anchovies was sold—*Burgess v. Hateley* (26 Beav., 249); *Burgess v. Hill* (26 Beav., 244).

The mark of a cross, with the letters C B—*Carter v. Carlile* (31 Beav., 292; 8 Jur., N. S., 183).

The mark of an anchor, as applied to wire—*Edelstein v. Edelstein* (1 De G. J. & S., 185; 7 L. T., N. S., 768).

The word "Anatolia," as applied to liquorice—*McAndrew v. Bassett* (4 De G. J. & S., 380; 33 L. J., Ch. 566).

The mark of a crown and the name Seixo—*Seixo v. Provezende* (L. R., 1 Ch. 192; 14 L. T., N. S., 314).

The words "Stephens's Blue-black Writing Ink," in letters of one colour upon a ground of another colour—*Stephens v. Peel* (16 L. T., N. S., 145).

The words "Schweitzer's Cocoatina (registered)" —*Schweitzer v. Atkins* (37 L. J., Ch. 847; 19 L. T., N. S., 6).

The fancy names "Turin," "Sefton," "Leopold," "Liverpool," on tickets, as applied to patterns of woollen cloth—*Hirst v. Denham* (L. R., 14 Eq. 542; 41 L. J., Ch. 752).

The word "Pectorine," applied to a medicine—*Smith v. Mason* (Weekly Notes, 1875, p. 62).

The first principle upon which our courts of law exercise jurisdiction for the protection of trade marks, is that one dealer in goods shall not be allowed to represent that his goods are the goods of another. In other words, to prevent the reputation which one man may have gained from the excellence of the things he sells, to be made use of to his detriment, by another man adopting his name, or the peculiar marks or devices with which his goods have become associated, when dealing with similar goods not of his manufacture.

As a further principle, that the public be protected from the fraud which would be perpetrated upon them by being induced to purchase articles by the representation that they were the production of the person with whose reputation they are acquainted, when, in fact, they are the goods of another person altogether.

And that the person, whose trade mark is infringed, be protected from the injury he would sustain by the profits on the sale of the goods being lost to him through the misrepresentation of the infringer of his right, who would gain

them instead; and from the more serious injury to his reputation from having inferior goods palmed off upon the public as his own.

Lord Langdale, M. R., in *Perry v. Truefitt* (6 Beav., 66; 1 L. T., 384), said, in the year 1842:—"I think that the principle on which the Courts proceed, in granting relief and protection in cases of the sort, are well understood. A man is not to sell his own goods under the pretence that they are the goods of another man; he cannot be permitted to practise such a deception, nor to use the means which contribute to that end. He cannot, therefore, be allowed to use names, marks, letters, or other indicia, by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person."

Lord Cranworth, L. C., in *Farina v. Silverlock* (6 De G. M. & G., 217), in 1856, said:—"I apprehend that the law is perfectly clear, that anyone who has adopted a particular mode of designating his particular manufacture, has a right to say, not that other persons shall not sell exactly the same article better or worse, or an article looking exactly like it, but that they shall not sell it in such a way as to steal (so to call it) his trade mark, and make persons believe that it is the manufacture to which that trade mark was originally applied."

In *Hall v. Barrows* (4 De G. J. & S., 150; 33 L. J., Ch. 204), Lord Westbury, L. C., said, in 1863:—"A trade mark consists in the exclusive right to the use of some name or symbol as applied to a particular manufacture or vendible commodity, and such exclusive right is property. Imposition on the public is necessary for the plaintiff's title, but in this way only, that it is the test of the invasion by the defendant of the plaintiff's right of property; for there is no injury if the mark used by the defendant is not such as is mistaken, or is likely to be mistaken, by the public for the mark of the



“ plaintiff ; but the true ground of the Court’s jurisdiction  
 “ is property.”

In *Wotherspoon v. Currie* (L. R., 5 H. L., at p. 522), Lord Westbury said, in the House of Lords, in 1872 :—“ The  
 “ principle on which the jurisdiction is founded . . . is  
 “ to prevent a party from fraudulently availing himself of the  
 “ trade mark of another, which has already obtained  
 “ currency and value in the market, by whatever means he  
 “ may devise for the purpose, provided the means are  
 “ devised in order to give him a colourable title to the use  
 “ of the word, and provided it be shown, from the manner  
 “ in which he has employed those means, that his object was  
 “ from the beginning to invade the property of the other.”

It is not necessary that there should have been a fraudulent use of the plaintiffs’ mark by a defendant in order to enable him to obtain protection for it, the fact that the defendant innocently used it in ignorance of the plaintiffs’ rights will not prevent the defendant from being restrained from using it. “ I wish to state in the most distinct  
 “ manner that, in my opinion, fraud is not necessary to be  
 “ averred or proved in order to obtain protection for a trade  
 “ mark. . . . A man may take the trade mark of another  
 “ innocently, not knowing it was the trade mark of the  
 “ other ; or he may take it in the belief, mistakenly but  
 “ sincerely entertained, that in the manner in which he is  
 “ taking it he is within the law and doing nothing which  
 “ the law forbids ; or he may take it, knowing it to be the  
 “ trade mark of his neighbour, and intending and desiring to  
 “ injure his neighbour by so doing. But in all these cases it  
 “ is the same act that is done, and in all these cases the injury  
 “ to the plaintiffs is just the same ”—Lord Cairns, L. C., in  
*Singer Manufacturing Co. v. Wilson* (L. R., 3 App. Cas., at  
 p. 391), following *Millington v. Fox* (3 My. & Cr., 352),  
 and *Hall v. Barrows* (4 De G. J. & S., 150 ; 33 L. J., Ch.  
 204).

But it is necessary that the plaintiff should show that

his property has been interfered with, it is not enough to prove that the public has been or may be imposed upon by the use of the trade mark.

In the case of *Batty v. Hill* (1 H. & M., 264; 8 L. T., N. S., 791) both parties were makers of pickles, but Batty had obtained a medal at an exhibition, and Hill had not. Batty used the words "prize medal" stamped on his bottles. Hill did the same, and Batty sought to restrain him from doing so. Wood, V. C., afterwards Lord Hatherley, refused to do so, saying:—"The defendant has  
 "super-added then to his labels, this representation which  
 "the plaintiff has added to his, the difference being that the  
 "representation is true on the part of the plaintiff, false on  
 "the part of the defendant. On that point there arises a  
 "presumption against the defendant, but he must be held  
 "entitled to use those labels, false though they be, if they do  
 "not interfere with the Plaintiff's rights."

It will be perceived that in this case no property of Batty's had been invaded, or any right of his infringed. He could not say that his were the only prize medal pickles, and therefore prevent anyone else from saying that theirs were also prize medal. He had no *property* in the nature of a trade mark in the words prize medal, since all prize medallists could use it.

In the case of *Hirsch v. Jonas* (L. R., 3 Ch. D., 584; 45 L. J., Ch. 364), the plaintiff was a London cigar merchant, who imported cigars made by Genir, of Havannah, in boxes labelled by the latter, at the plaintiff's desire, with a design of "Britannia," and the words "Gloria di  
 "Inglaterra," to which Genir added the words "of Joseph  
 "Genir, manufacturer of cigars, Havannah." Genir used to supply the plaintiff exclusively, but there was no contract to do so, and he had supplied boxes similarly labelled to the defendant. The plaintiff applied to restrain the defendant from selling boxes of cigars so labelled, but Jessel, M. R., refused to do so, holding that the above labels might be a

trade mark, yet the plaintiff had no *property* therein, since he had no contract with Genir securing him the exclusive sale of the latter's cigars.

Therefore, a private person cannot interfere, as of his own right, to prevent a fraud upon the public by the use of a trade mark, unless there has also been an infringement of his own rights. The remedy in such a case is pointed out by the following observations of Sir John Romilly in *Hall v. Barrows* (32 L. J., Ch. 551):—"Lord Loughborough refused the injunction (in *Webster v. Webster*), and stated that fraud on the public is no ground for a plaintiff coming to this Court; that is, as I understand it, by a person who has no interest in the subject matter by which the fraud is committed. And this is in accordance with the principle, that, although the Courts will discountenance and do nothing to assist any false representation, still they do not deal with the general interest of the public at the suit of persons having no property in the subject matter, or the suit must be at the suit of the *Attorney-General*." That is to say the *Attorney-General*, representing the Crown, will in a proper case, on being set in motion by some member of the public, bring his suit to restrain the fraud, and his suit will be entertained.

A trade mark must not contain any misrepresentation; if it contains exaggerated or false statement of the value of the goods or other palpable misrepresentation calculated to deceive the public, the protection of the Courts will not be afforded to it. The principle is that the Courts will not give a man protection against an injury when it cannot do so without affording him greater facilities for practising deception upon others.

In *Pidding v. How* (8 Sim., 477; 6 L. J., Ch., N. S., 345), decided in 1837, the plaintiff sold tea under the name of "Howqua's Mixture," in packages marked in a particular manner, and the defendant imitated them. The plaintiff applied to restrain him from so doing; but it appeared that

the plaintiff had, in his advertisement, made a number of false representations about the origin, composition, and value of his tea, and the injunction, which would otherwise have been granted, was refused.

In *Perry v. Truefitt* (6 Beav., 66; 1 L. T., 384), decided in 1842, the plaintiff was the maker and seller of "Perry's Medicated Mexican Balm," and the defendant began to make up and sell another compound as "Truefitt's Medicated Mexican Balm." The plaintiff applied to restrain the defendant from doing this, but the Court refused to do so, because the plaintiff, on his show cards, made gross misrepresentations as to the origin and substances contained in his composition.

In *The Leather Cloth Co., Limited, v. The American Leather Cloth Co., Limited* (4 De G. J. & S., at p. 148; 33 L. J., Ch., at p. 203), Lord Westbury, L. C., said:—"I cannot receive it as a rule, either of morality or equity, that a plaintiff is not answerable for a falsehood because it may be so gross and palpable as that no one is likely to be deceived by it. If there be wilful false statement, I will not stop to inquire whether it be too gross to mislead."

Similarly where the word "patent" has been used in such a manner as to lead the public to believe that there is a patent in existence, giving the exclusive right of manufacturing the articles to which the trade mark relates, when the fact is, that there is no such patent in force, it has been always held that such a misrepresentation took away the right to have the trade mark protected.

In *Morgan v. McAdam* (36 L. J., Ch. 228; 15 L. T., N. S., 348) the plaintiffs were manufacturers of plumbago crucibles, trading under the name of the Patent Plumbago Crucible Company. There was no patent for the plaintiff's method of manufacturing crucibles, it was a secret the plaintiffs had purchased from the United States. The defendants commenced business under the same name, and

the plaintiffs sought to restrain them from doing so, but the Court refused on the ground of the plaintiffs' misrepresentation that there was a patent. Wood, V. C., said:—"If the Court finds it to be a right founded upon a fraud, and certainly this is such, the Court says it cannot assist a person in carrying on such a fraud."

In *Flavell v. Harrison* (10 Hare, 467; 22 L. J., Ch. 866), the same judge had previously refused an injunction to restrain the use of the words "Flavell's Patent Kitchener," in fraud of the plaintiff, upon the same ground, although the kitchener in that case had been invented, although never patented, by the plaintiff's father and predecessor in business.

In *The Leather Cloth Co., Limited, v. The American Leather Cloth Co., Limited*, just cited, the plaintiffs were held disentitled to protection upon the same ground, and Lord Kingsdown said (11 H. L. C., at p. 544):—"If the trade mark represents the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection never existed, or has ceased to exist."

In *Lamplough v. Balmer* (Weekly Notes, 1867, 293), the plaintiff sought to restrain an imitation of his well-known label, "Pyretic Saline," the defendant using the title, "Balmer's Pyretic Salts." The injunction was refused, because the plaintiff's labels contained the words, "Royal Letters Patent," when he had no patent, although he paid duty, and used the Inland Revenue stamps for patent medicines. And in *Nixey v. Roffey* (Weekly Notes, 1870, 227), the plaintiff used distinctive labels, upon which were the words, "Manufacturer and Patentee," although he held no patent, and his labels were refused protection on that account.

On the other hand, where the word "patent" is used merely as part of the designation of an article known in the market under that name—"patent leather," for in-

stance—and not so as to indicate the existing protection of a patent, there is no misrepresentation, and the use of the word patent in the trade mark does not disentitle it to protection. “In such a case,” said Lord Kingsdown, in *Leather Cloth Co. v. American Leather Cloth Co.*, “no one is meant to be deceived, or is deceived.”

In *Edelstein v. Vick* (11 Hare, 78; 1 Eq. Rep., 413), the plaintiff's successors in business to the original patentees of “Taylor & Co.'s Patent Solid-headed Pins,” continued after the expiration of the patent, to use the word in their labels. The defendant imitated their labels, and was restrained from doing so.

In *Marshall v. Ross* (L. R., 8 Eq., 651; 39 L. J., Ch. 225), the plaintiffs sold thread, manufactured by them, with wrappers containing, amongst others, the words “patent thread.” There was no patent for the thread, but the evidence showed that the word patent had, by long usage, come to denote in the trade the character of the thread, and did not imply the existence of any patent. James, V. C., said:—“The word patent may be used in such a way as not to deceive the public. . . . Here the term “patent has been used in the trade for many years past, and is the name by which thread of a certain class is used by manufacturers; it has, in fact, become a word of art. Here there has been no such misrepresentation, designed or undesigned, as to deprive the plaintiffs of their right to protection.”

It follows, of course, from these cases, that there is no reason why a trade mark should not state, in so many words or by implication, that the article is made according to a patent which has expired, so long as it does not suggest that it still enjoys the protection of a patent; and the law is so stated by Jessell, M. R., in *Cheaven v. Walker* (L. R., 5 Ch. D., at p. 862).

A misrepresentation which is only collateral to the trade mark will not, however, disentitle it to protection; as

where the advertiser of the shirts to which the trade mark "Eureka" was applied, called himself a "patentee," when he did not hold a patent, the word "Eureka" was still protected, because the trade mark itself contained no misrepresentation—*Ford v. Foster* (L. R., 7 Ch. 611; 41 L. J., Ch. 682).

The Trade Marks Registration Act of 1875 dealt with this subject of misrepresentation, and adopted the principle of the above decisions; and the provisions of that Act are repeated in the Act of 1883, in section 73, to which, and to the note thereon, the reader is referred.

Marks containing such misrepresentations are not capable of registration, and, if registered by mistake, can be removed from the register, upon the principle of the cases of *re Hyde's Trade Mark* and *re Palmer's application*, set out and discussed in the note to section 76 of the Act, *supra*.

A *mark*—including within that comprehensive term whatever might have been held capable of protection as an old mark, and whatever may come within the definition of section 64 of the Act of 1883—which might originally have been capable of protection as a trade mark, becomes incapable of being registered and protected in the Courts as such, when, for whatever reason, it has ceased to convey the meaning that the goods to which it is applied are of a particular manufacture—or rather manufactured by a particular firm—and has become merely indicative or descriptive of the particular article to which it is applied. Such *marks* have become mere terms of art, improper to be the exclusive property of anyone; they are, therefore, *publici juris*, open to every one to use.

Such marks may have been first used, and even invented, by someone for the express purpose of distinctively indicating his particular manufacture, and yet the exclusive right of using them may have been lost by his negligence

in not preventing their use by other people, or by his acquiescence in their doing so. It is evident that many names, by which articles are now known in trade, and manufactured and sold by everyone who cares to do so, without anyone being able to hinder him, were once, or might have been trade marks.

Mellish, L. J., said, in *Ford v. Foster* (L. R., 7 Ch. 611 ; 41 L. J., Ch. 682) :—“There is no doubt, I think, that a word, which was originally a trade mark, to the exclusive use of which a particular person, or his successor in trade, may have been entitled, may subsequently become *publici juris*, as in the case recently before us of ‘Harvey’s Sauce.’ It was admitted there, that, although that had been originally the name of a sauce made by a particular individual, it had become *publici juris*, and that all the world were entitled to call sauce ‘Harvey’s Sauce,’ if they pleased. What then is the test by which it is to be decided whether a word, which was originally a trade mark, has become *publici juris*? I think the test to be this: whether the use of the word still continues to deceive the public, or any part of the public; whether the use of it by any other person than the original user may still have the effect of inducing the public to buy goods not made by him, under the supposition that they are his goods. If the word or mark has become of such universal use that nobody can be deceived by the use of it, then no one can be induced, from the use of it, to believe that he is buying the goods of the original owner. If it has become as public of that, then, however hard it may seem to be on the trader, yet practically as the right to a trade mark, is simply a right to prevent the owner of it being cheated by other persons goods being sold as his goods through the fraudulent use of the trade mark; as that is the nature of the right, if that has ceased to deceive anybody the right itself must be gone.”



In the case of *The Wheeler and Wilson Manufacturing Company v. Shakespeare* (39 L. J., Ch. 36), the plaintiffs, a company formed for the purpose of manufacturing sewing machines according to the invention of Messrs. Wheeler and Wilson, and which had acquired the patent rights of those gentlemen, attempted, after the expiration of the patents, to restrain the defendant, who had been their agent, but had ceased to be so, from selling machines, not manufactured by the plaintiffs, as "Wheeler and Wilson's Sewing Machines." But the evidence established that the name, "Wheeler and Wilson," as applied to sewing machines, only meant in the trade, machines of a certain construction, according to the principle of Wheeler and Wilson's expired patents, and not that they were manufactured by them. James, V. C., said:—"It seems to me that the name, 'Wheeler and Wilson,' has come to signify the thing manufactured according to the principle of the patent. That being so, I cannot restrain anybody after the expiration of the patent from representing his article as being the article which was so patented. A man cannot prolong his monopoly by saying:—'I have got a trade mark in the name of a thing which was the subject of the patent.'"

The principle of this decision was approved throughout all the Courts in the case of the *Singer Manufacturing Co. v. Wilson*, reported in the Rolls Court (L. R., 2 Ch. D., 434), in the Court of Appeal (L. R., 2 Ch. D., 448), and in the House of Lords (L. R., 3 App. Cas., 376), in which the use of the word "Singer," as applied to sewing machines, was in question; although in the last tribunal the evidence as to whether the name was really indicative of the plaintiffs' manufacture or of a principle of construction was found insufficient, and the question remitted to the Court below to take further evidence thereon, which, however, it is believed was never done.

In *The Liebig's Extract of Meat Co. v. Hanbury* (17 L. T.,

N. S., 298), the plaintiffs were manufacturers and vendors of Liebig's Extract of Meat, and Baron Liebig had, in 1866, granted them the exclusive privilege of using his name in connection therewith. The defendant prepared meat according to Baron Liebig's recipe, and sold it under the same name as the plaintiffs. An injunction to restrain the defendant from doing so was refused by Wood, V. C., on the ground that the term "Liebig's Extract of Meat" had been in common use for a long time, as descriptive of an article prepared in a well-known manner, published by Baron Liebig so long ago as 1847.

The principle upon this question was very early stated, with his usual clearness, by Lord Westbury, L. C., in *Hall v. Barrows* (4 De G. J. & S., 150; 33 L. J., Ch. 204).

"A name, though originally the name of the first maker, may, in time, become a mere trade mark, a sign of quality, and cease to denote or be current as indicating that any particular person is the maker. In many cases a name once affixed to a manufactured article, continues to be used for generations after the death of the individual who first affixed it. In such cases the name is accepted in the market as a brand of quality, or it becomes *the denomination of the commodity itself*, and is no longer a representation that the article is the manufacture of any particular person."

When a man is the first to use a natural product, and under a patented process, the name of the natural product will not be a trade mark, although any original or fanciful appellation he may adopt would be.

In *Young v. Macrae* (9 Jur., N. S., 322), the plaintiff, Mr. Young, who had introduced the use of "Paraffin oil" under a patent obtained by him, sought to restrain the defendant from using the same name for an oil manufactured by him. The injunction was refused on the ground that the name was not a new one invented by the plaintiff, but was a natural title which must be inevitably applied to the

same article by whatever means produced. In the same case *Wood, V. C.*, said :—“I have not the least doubt that  
 “ if the plaintiff had invented a fanciful and ridiculous name  
 “ —and the more ridiculous the better it is for his purpose—  
 “ and had used it for eight or ten years in his trade, the  
 “ Court would take care that nobody else should use that  
 “ absurd name, for such user could only be a user for the  
 “ express purpose of imitating the plaintiff, and so defraud-  
 “ ing the plaintiff by representing goods manufactured by  
 “ one person to be goods manufactured by another.”

In *The Linoleum Manufacturing Co. v. Nairn* (L. R., 7 Ch. D., 834; 47 L. J., Ch. 430), Fry, J., held that the word “Linoleum,” forming part of a trade mark registered under the Act of 1875, did not form an essential feature of the mark, and refused an injunction to restrain the use of it, holding that the fact that the word had been previously used by the plaintiffs alone, they being hitherto patentees, did not give the plaintiffs an exclusive right in it, and saying :—“Until some other person is making the same  
 “ article, and is at liberty to call it by the same name, there  
 “ can be no right acquired by the exclusive use of a name  
 “ as showing that the manufacture of one person is indicated  
 “ by it, and not the manufacture of another.”

Similarly, in *Condy v. Mitchell* (37 L. T., N. S., 268 and 766; 26 W. R., 269), in an action by the plaintiff to restrain the defendant from using the word “Condy,” an injunction was refused on the ground, amongst others, that the name, “Condy’s Fluid,” had come to be the name of an article of commerce under Condy’s expired patent.

And in *Siegert v. Findlater* (L. R., 7 Ch. D., 801; 47 L. J., Ch. 233), Fry, J., held that the plaintiff was not entitled to the exclusive use of the term “Angostura Bitters,” since that had become the name of an unpatented article, which anyone who could discover the secret recipe, might make and call by its name, although it had hitherto been made by only one firm, because they alone knew the secret; al-

though he granted an injunction to prevent the defendant using the words in such a way as to be calculated to deceive, saying :—“No distinction can arise from using the name “ of a class, so long as the class consists only of one species, “ for then the name of the species and the name of the “ class will be the same.”

The subject of these common marks has received attention in the new Act. To prevent difficulty with regard to marks in which some item or particular is common, but which, taken as a whole, is not so, section 74 enacts that the Comptroller may enter on the register, *as an addition to any trade mark*: (a) in the case of an old mark—one used before 13th August, 1875—*any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures*; and, (b) in the case of a new mark—one not used until after 13th August, 1875—*any distinctive word or combination of words*, though the same is common to the trade, in the goods with respect to which the application is made, providing, however, that the applicant disclaims all exclusive right to such common particular. The section also defines what is a common old mark, by enacting that any device, &c., used before by more than three persons on the same, or a similar description of goods, shall, for the purposes of the section, be deemed common to the trade in such goods. The object of the section is to enable, in the case of old marks, the mark which has been used to be put on the register, with such additions, whether before used or not, as shall render it clear that they are used by the particular person who registers and uses it. Thus, to take any of the above cases in which a device or mark has been held to be common, such as a triangle or an elephant. These may be registered by several persons as parts of, and in addition to, other distinctive elements which will identify each individual, person, or firm; and in regard to new marks, any distinctive word, or combination of words, such as “Linoleum,” or

“Angostura Bitters,” may be registered as additions to marks otherwise distinctive, always, whether in the case of old or new marks, with a disclaimer of any exclusive right to the common element, by the applicant.

The exclusive right to a trade mark can only be claimed for particular classes of goods.

This was decided long before the establishment of the Register of Trade Marks, and is obvious, from a consideration of the nature of a trade mark, the object and effect of which is to identify particular goods as being the production of particular persons or firms. “There can be no right to the exclusive ownership of any symbols or marks universally in the abstract. Thus, an ironfounder who has a particular mark for his manufactures in iron, could not restrain the use of the same trade mark when impressed on cotton or woollen goods; for a trade mark consists in the exclusive right to the use of some name or symbol, as applied to a particular manufacture or vendible commodity, and such exclusive right is property”—Lord Westbury, in the case of *Hall v. Barrows* (4 De G. J. and S., 150), so frequently cited before. Accordingly, when the register was established by the Act of 1875, section 2 of that Act provided that “a trade mark must be registered as belonging to particular goods or classes of goods”; and the new Act of 1883, amending and repealing the preceding Acts, repeats that provision in section 65, to the note upon which the reader is referred.

A trade mark, being property, is, like other property, assignable; but, following from the above principle that it can only be associated with particular classes of goods, is the further principle that it can only be assigned in connection with the goodwill of the business concerned with the goods to which it relates. This again is clear from a consideration of the nature of a trade mark, the object of which is to indicate to the public that the goods with which

they are used, are the product of some particular manufacture which has acquired reputation.

“The right to a trade mark may in general, treating it as property, or an accessory of property, be sold and transferred, upon a sale and transfer of the manufactory of the goods on which the mark has been used to be affixed, and may be lawfully used by the purchaser”—Lord Cranworth in *Leather Cloth Co. v. American Leather Cloth Co.* (11 H. L. C., 523).

This principle was adopted by the Act of 1875, section 2 of which provided that a trade mark, when registered, should be “assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods,” as belonging to which it had been registered, and should be “determinable with such goodwill,” and section 70 of the new Act, to the note upon which section the reader is referred, repeats that enactment.

Upon the owner of a trade mark becoming bankrupt, the property in the trade mark passes, together with the goodwill in his business, to his trustee in bankruptcy, as forming part of his assets—*Hudson v Osborne* (39 L. J., Ch. 79); *Bury v. Bedford*, (33 L. J., Ch. 465; 4 De G. J. & S., 352).

If a man owning a trade mark goes into partnership with other persons for the purpose of carrying on business in the goods with respect to which a trade mark is associated, the trade mark will, if provision is not expressly made to the contrary, become part of the partnership property. Turner, L. J., in *Bury v. Bedford* (4 De G. J. & S., 374) :—“The whole trade is carried into the partnership, and the trade mark is but an element of the trade.”

On the dissolution of a partnership, the trade mark will follow the goodwill of the business. But if each of the partners merely divide the other partnership assets, and all carry on the business subsequently individually, each

may use the trade mark—*Banks v. Gibson* (34 Beav. 566 ; 34 L. J., Ch. 591).

Previously to the establishment of the Register of Trade Marks, by the Act of 1875, it was necessary, in order to give anyone property in the trade mark, that is to say, the exclusive right of using it, that he should have actually transacted business on the goods to which it was applied, that the goods should be actually vendible articles in the market. Lord Westbury, in *McAndrew v. Basset* (4 De G. J. & S., 380 ; 33 L. J., Ch. 566). Following this, it was decided, in *Maxwell v. Hogg* (L. R., 2 Ch., 307 ; 36 L. J., Ch. 433), that no expense, in preparing for the market, or in advertising, would, without publication, give the right. And there is a previous decision, in the case of *Lawson v. The Bank of London* (18 C. B., 84 ; 25 L. J., C. P., 188) to the same effect. But the Act of 1875 rendered this unnecessary for the future, in the case of marks registered under that Act, by providing in section 2, that "registration of a trade mark should be deemed to be equivalent to "public use of such mark," and, section 75 of the new Act of 1883 repeats that enactment.

So that all that is necessary to acquire the exclusive right to a trade mark, which is properly a trade mark, and capable of registration under the Act, is to obtain the registration thereof. It has been already stated that registration is not conclusive of the right to a trade mark, or that the mark registered is properly a trade mark, but that the registration of a mark, which ought not to be on the register, can be expunged—*Re Hyde's Trade Mark* (L. R., 7 Ch. D., 724) ; *re Palmer's Trade Mark* (L. R., 21 Ch. D., 47), set out in the note to section 76.

But in order to prevent the exclusive right to use trade marks remaining vested in persons who do not use them, and the register remaining encumbered with a number of marks associated with goods in which business is not being done, a number of provisions are to be found in the Act of

⊕ This was a copyright case which seemed to include "trade mark"

1883. Section 79, which enacts the provisions of rules 30, 31, 32, and 33, under the Acts of 1875 and 1877, requires that a registered trade mark shall be removed from the register at the end of fourteen years from the date of the registration, unless a fee be paid for a renewal of the registration for another period of fourteen years, and so on, from time to time, at the expiration of every period of fourteen years. This provision secures that the registered owner of a trade mark shall, at all events, do something to keep up his property.

Rule 34 of the rules under the Acts of 1875 and 1877 contained another and more powerful remedy, which, curiously enough, has not been adopted in the new Act, or in the rules made by the Board of Trade under its authority, and, therefore, no longer remains in force. This rule provided, that where, after five years from the date of the registration of any trade mark, the registered owner was not engaged in any business concerned in goods within the same class as the goods with respect to which his trade mark is registered, the Court might, on the application of any person aggrieved, remove any trade mark from the register on that ground.

A very recent instance of the enforcement of this power, under rule 34, under the Acts of 1875 and 1877, occurred in the case of *re* Ralph's trade mark, before Mr. Justice Pearson, on the 17th Nov., 1883, reported in the "Times" of the 19th Nov., 1883; and the "Weekly Notes" of the 24th Nov., 1883, p. 181. It was a motion on the part of Messrs. Taylor and Wilson, that the register might be rectified by removing therefrom the trade mark "Home Washer." It appeared that Mr. Ralph was the owner of a patent which expired in 1882, that he had not carried on the manufacture of the articles associated with the trade mark since his patent had expired, and that Messrs. Taylor and Wilson did, and could not sell it except under the title covered by the trade mark. Mr. Justice Pearson held that



Messrs. Taylor & Wilson were persons aggrieved within the rule, and allowed the motion. Since, under section 77 of the new Act, no proceedings can be taken against an infringer of a trade mark, unless, if a new mark, it has been registered in pursuance of the Act, or of an enactment repealed by this Act; or, if an old mark, it has either been registered or registration refused; it is clear that if the trade mark is not on the register, except in the few cases which will gradually disappear, of old marks not coming within the definition of a trade mark contained in the Act, no protection can be obtained for it. These provisions afford a means of preventing persons holding trade marks which they do not use, to the detriment of other persons.

What has been written in this chapter is for the purpose of stating those general principles of the law of trade marks, which do not appear in that portion of the new Act which relate to that subject, and which the framers thereof assumed would be understood. It does not render a careful perusal of the Act unnecessary to those who would understand the law, it rather renders it the more necessary, for the object of the writer has been to avoid all those subjects which are dealt with in the Act as far as possible, in order to avoid repetition. The Act explains itself, and in it and in the body of the rules will be found a complete exposition of the practice of registering trade marks, and of assigning them, rendering any explanation here unnecessary. In the notes to the various sections a number of highly important points, which, however, do not concern the first principles of the law, are dealt with in their places, and to them the reader is referred.

One other point, however, remains to be dealt with here, and that is, the Merchandise Marks Act of 1862 (25 & 26 Vic., c. 88). This Act, was the first Act of Parliament passed upon the subject of trade marks, and, while all the other Acts passed upon the subject are

repealed and codified in the new Act of 1883, this one is left unaffected.

It was an Act passed long before the establishment of any registry of trade marks, for the object, as its preamble states, of amending "the law relating to the fraudulent marking of merchandise, and to the sale of merchandise falsely marked for the purpose of fraud." It came to be passed principally in consequence of a decision of the Court of Crown Cases reserved, in the case of *Reg. v. John Smith* (D. & B., 566; 27 L. J., M. C., 225), in the year 1858, when it was held that a fraudulent imitation of a trade mark was not a forgery at common law. The prisoner, in that case, was indicted for forgery, and it was proved that he had printed and used a number of wrappers in imitation of those used on Borwick's Baking Powders and Egg Powders, with the name of Borwick in a prominent position, but omitting the signature of Borwick. Bramwell, J., said:—"In the present case, one of these documents is as good as the other; the one asserts what the other does; the one is as true as the other; but the one gets improperly used. But the question is, whether the document itself is a false document. It is said that the wrapper is so like one used by somebody else that it may mislead; but that is not material to the question which we have to decide. The prisoner may have committed a gross fraud in using the wrapper for that which was not the genuine powder, and may possibly be indicted for obtaining money by false pretences, but I think he cannot be convicted of forgery."

It had shortly previously been held also by the Court of Crown Cases Reserved, in *Reg. v. Closs* (D. & B., 460; 27 L. J., M. C., 54), that imitating the signature of an artist of reputation, "J. Linnell," in the corner of a spurious picture, was also not a forgery.

No doubt in both these cases an indictment might have lain for obtaining money by false pretences; but it is

necessary, in such an indictment, to prove that the money was obtained from the belief in the false representation by the person parting with the money; and it was obvious that the person whose interests was most seriously affected—the person whose label or signature was imitated—was, in that view of the case, not the person defrauded, but the person whose money was obtained. And the difficulty in proving this was found so great that a change in the law was thought desirable.

The Merchandise Marks Act of 1862 made the following acts misdemeanours :—

By section 2—

1. Forging or counterfeiting any trade mark with intent to defraud ;
2. Applying any trade mark to articles not of the manufacture of the *person* intended to be denoted by such trade mark ;
3. Applying any trade mark, with intent to defraud, to articles not of the *particular manufacture* intended to be denoted by such trade mark.

By section 3—

4. Applying, with intent to defraud, any trade mark to any case or wrapper in which an article is sold ;
5. Placing, with intent to defraud, any article within a case or wrapper to which any genuine trade mark has been falsely, or any counterfeited trade mark, applied ;
6. Placing any article, with intent to defraud, in a case or wrapper having thereon a trade mark belonging to any other person ;

By section 4 a penalty of the value of the article, and from 10s. to £5, is imposed for—

7. Selling any article knowing that a false trade mark is applied thereto.

A similar penalty is imposed by section 7 for—

8. Making any false statement, with intent to defraud, upon any article to be sold ;
9. Marking any article to be sold, with intent to defraud, with any statement that the article, or the manufacture thereof, or the ornamentation or configuration thereof, is the subject of any existing patent, privilege, or copyright.

A penalty of from 5s. to £5 is imposed by section 8 for—

10. Selling any article with any false statement of quantity, number, weight or measure, or of the place or country where such article was made or produced.

By section 6—

Any person who sells an article bearing a false trade mark is bound to give information where he procured it, under a penalty of £5.

By section 5—

Fraudulent alterations of, and additions to, trade marks are made false trade marks within the Act.

And by section 12, it is made unnecessary to allege in the indictment or to prove any intention to defraud any particular person.

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*Handwritten notes:*  
A.  
M.D. 1874

## CHAPTER IV.

## MEMORANDUM ON BILL ON ITS FIRST INTRODUCTION INTO PARLIAMENT (POINTING OUT THE CHANGES IN THE LAW).

“ This Bill is designed to amend and consolidate in a single measure the provisions of the numerous laws relating to patents, designs, and trade marks, and, at the same time, to simplify procedure, lessen its cost, and increase the protection afforded. Object of Bill.

The law regulating applications for, and the grant of, patents, is thirty years old, dating from 1852; and there are some half-dozen other statutes relating to patents, passed between 1835 and 1859.\* State of existing law. The principal Acts which provide for the registration of ornamental and useful designs, and for conferring copyright therein, are forty years old, having been passed in 1842 and 1848; and there are amending Acts of 1850, 1858, 1861, and 1875. Some of the above statutes contain provisions which have become obsolete or unnecessary, and are confused in arrangement and form.

The Trade Marks Act is comparatively modern, having been passed in 1875; but it contains some unworkable provisions relating to the Cutlers' Company,†

\* A list of all the Statutes will be found in the 3rd Schedule of the Act (Enactments Repealed).

† The Company of Cutlers of Hallamshire, in the County of York, was incorporated by Statute in the reign of James I. (1624), since which time the Company has exercised the privilege of assigning trade marks to persons engaged in the cutlery manufacture of the district. (see the Summary of the Cutlers' Companies Acts, at the end of the Book).

and the definition of a trade mark also requires amendment. The Trade Mark Acts of 1876 and 1877 are short amending Acts.

Acts relating to exhibitions.

In 1865 and 1870 two Acts were passed for the protection of unpatented inventions and unregistered designs from the consequences of use or publication at, or during the holding of, industrial or international exhibitions.

The Bill proposes to consolidate and repeal these Acts also.

Amendments of existing law.

As regards the provisions of the three divisions of the Bill relating respectively to—

Patents,  
Designs, and  
Trade Marks,

the principal alterations in the present system are as follow :—

#### I.—PATENTS.

Fees.

The fees payable at present in order to obtain a patent amount to £25, with further payments of £50 before the expiration of the third year, and £100 before the expiration of the seventh year of the patent. Under the Bill a patent will be obtainable for £4, and, while the amount of the further payments remains unaltered, the payment of the £50 is postponed to the fourth year; so that a four years' patent will only cost £4.

Under the existing Acts it is necessary for an intending patentee or his agent to apply personally at the Patent Office at least seven times, and make four separate payments, using four documents for the application.

Simplification of procedure

By this Bill an applicant or his agent will only have to call twice at the Patent Office, to use three documents, and to make two payments; but applicants may,

if they please, transact their business entirely by post, and thus avoid either personal attendance at the office or the payment of agency fees. This will be best illustrated by the following tabular comparison:—

KEY TO PROCEDURE ON AN UNOPPOSED APPLICATION, WITH PROVISIONAL SPECIFICATION.\*

(i.) *By Applicant or his Agent.*

Under old Acts.	Under Bill.
<ol style="list-style-type: none"> <li>1. Petition, declaration, and provisional specification left at Patent Office.</li> <li>2. Call for certificate of allowance of provisional protection.</li> <li>3. Notice to proceed given.</li> <li>4. Call for certificate of notice to proceed.</li> <li>5. Warrant and Seal bespoken and paid for.</li> <li>6. Call for patent.</li> <li>7. Specification filed.</li> </ol>	<ol style="list-style-type: none"> <li>1. Declaration and provisional specification left at or sent by post to Patent Office. Cl. 5.</li> <li>2. Complete specification, with fee for sealing patent, left at or sent by post to Patent Office. Cl. 8.</li> </ol>

\* As the majority of applications for Letters Patent are by way of provisional protection, these observations refer to applications with provisional specifications in a correct form.

(ii.) *By Patent Office.*

Under old Acts.	Under Bill.
1. Provisional documents entered in register.	1. Provisional documents entered in register.
2. Application advertised in journal.	2. Provisional documents referred to examiner at Patent Office. Cl. 6.
3. Provisional documents sent to law officer.	3. Notification of acceptance sent to applicant or agent by post.
4. Provisional protection allowed by law officer.	4. Complete specification referred to examiner. Cl. 9. 1.
5. Provisional protection advertised.	5. Advertisement of acceptance of complete specification. Cl. 10.
6. Notice to proceed advertised.	6. Notification of acceptance of complete specification sent to applicant or agent by post.
7. Provisional documents again sent to law officer.	7. Patent prepared and sealed. Cl. 12.
8. Law officer's fiat for warrant received.	8. Patent sent to applicant or agent by post.
9. Warrant sent to law officer for signature.	
10. Warrant received from law officer.	
11. Patent prepared and sealed.	



It is also proposed to sell the new application and specification forms ready stamped at the Patent Office, or to send them by post at the price of the fee, *i.e.*, no charge to be made for the blank form itself. Only two stamped forms will be necessary, one a £1 declaration form, and another a £3 form, for the complete specification. The Inland Revenue Department will also arrange to sell these stamps at post offices in the principal commercial centres of the kingdom. At present, persons residing in the country must either employ an agent in London to obtain the stamped forms, or obtain them through a stamp office from the Inland Revenue Department by post.

The Bill provides for enforcing the grant of licenses Licenses. in certain cases, and subject to proper safeguards. Cl. 22.

It is proposed to lay down principles for the guidance of the Court, which has jurisdiction to extend the term Extension of Patents. of a patent. Cl. 25 (4).

In any action for infringement, either party will be empowered under the Bill to require a skilled assessor to be called in, cl. 28; and in any such action a patentee will be able, by leave of the Court to disclaim, and give his disclaimer in evidence, but not in such case to obtain damages without leave of the Court. Cl. 19, 20. Actions for infringement.

The proceeding, by *scire facias*, to repeal a patent is abolished, and power to obtain revocation on petition to the Court substituted. Cl. 26. Scire facias.

The following are the other principal new provisions:—

1. Limitation of patent to one invention made statutory; with a proviso that it shall not be competent in an action or other proceeding to object to a patent on the ground that it comprises more than one invention. Cl. 33. Other new provisions

2. Extension of provisional protection from six to

fifteen months, or from application to sealing of patent, Cl. 14.

3. Extension of first term of a patent from three to four years. Cl. 17 (2). The duration of patents will continue to be fourteen years.

4. Complete specification to contain distinct statement of claims. This will be of very great service for the purposes of indexing and reference. Cl. 5.

5. Deposit of complete specification before the grant of the patent.

This must be made within *nine* months from the date of application with a provisional specification for patent. Cl. 8.

6. Appointment of examiners—

(a.) To examine applications for the purpose of seeing that the invention is subject matter for a patent, and that its nature has been fairly described. Cl. 6.

(b.) To compare complete with provisional specifications for the purpose of seeing that they correspond. Cl. 9.

(c.) To examine amendments and disclaimers. Cl. 18.

7. Appeal to law officer from examiners. Cl. 7, 9, 18.

8. Substitution of Seal of Patent Office for wafer seal now used in lieu of the Great Seal. Cl. 12.

9. Enlargement of time for payment of fees and renewal. Cl. 17 (3), (4).

10. Publication of an illustrated journal of patented inventions. Cl. 40.

11. Discontinuance of register of proprietors;—copies of deeds, &c., hitherto copied therein to be supplied by the parties interested at their own cost.

12. Discontinuance of sending to Edinburgh and Dublin transcripts of Letters Patent and deeds and

certified copies of specifications and disclaimers, but printed copies of the Patent Office publications will be sent to these cities.

13. Transfer of Patent Museum to Department of Science and Art, with power to require models on payment. Cl. 41, 42.

14. The provisions of the separate Acts relating to the protection of unpatented inventions exhibited at industrial and international exhibitions are repealed and re-enacted in the Bill. Cl. 39."

In addition to the points noticed in the Memorandum, the following very important changes in the law are made by the Act:—

Section 25 of the Act of 1852, enacting that a British patent should lapse on the expiration of any foreign patent granted before the date of the British patent is repealed and is not re-enacted. All British patents, therefore, granted after the coming into operation of the new Act will, therefore, be unaffected as to their duration by any foreign patent taken out before the date of the British patent.

Patents may be granted to another person, or other persons than the inventor, jointly with the inventor. Cl. 4.

A patent may be granted to the personal representatives of deceased inventors. Cl. 34.

The Channel Islands are no longer included in the grant of exclusive privilege of using the invention conferred by patent (see form of patent, first schedule D).

A penalty, not exceeding £5, is imposed upon any person representing an article sold by him as a patent article, when no patent has been granted for the same. Cl. 105.

A penalty, not exceeding £20, is imposed upon any person upon assuming or using the Royal arms without the authority of the Queen, Royal Family, or some Government Department. Cl. 106.

## II.—DESIGNS.

" 1. At present there is a twofold classification of designs into ornamental and useful, and they are registered under separate Acts, which, however, in their main features are the same. It is often difficult to determine

Amend-  
ments of  
law as  
respects  
Designs.

to which class a design belongs, while a so-called useful design might frequently be the subject of a patent, were it not for the cost. Inasmuch as under the Bill the first fee on Letters Patent is to be reduced from £25 to £4 (£10 being now charged for the registration of a useful design), it is proposed to discontinue the distinction between ornamental and useful designs, and to accept for registration *any* novel design in the proper sense of the word. Such "useful" designs as embrace a mechanical action would be treated as subject matter for a patent.

2. Additional facilities are provided for the registration of designs, provisional registration being abolished, and complete registration provided for without the necessity of depositing actual specimens of the design on application; but such specimens must be deposited before sale and delivery of goods to which the design is applied. Cl. 47-51.

3. It is proposed to make uniform the various existing terms of copyright by the adoption of a fixed term of five years for all designs. Cl. 50.

4. The provisions of the separate Acts relating to the protection of unregistered designs exhibited at industrial and international exhibitions are repealed and re-enacted in the Bill. Cl. 57.

5. The existing power to register works of sculpture is omitted as unnecessary."

### III.—TRADE MARKS

Amend-  
ments of  
law as to  
trade  
marks.

" 1. The present definition of a trade mark has been extended to include—

- (a) Fancy words not in common use,
- (b) Brands; and
- (c) Single letters as old trade marks. Cl. 64.

2. Power is taken to clear the list of applications for

trade marks of those applications which have not been proceeded with during a reasonable period. Cl. 63.

3. Provision is made for giving notice by advertisement of applications for registration, and for opposition to registration. Cl. 68, 69. These were regulated by rules.

4. Power is given to register a series of marks in every registration. Cl. 66.

5. No alteration will be made in the term for which a trade mark is registered, namely, fourteen years, with renewal; but the provisions for this purpose, now made by rules, are inserted in the Bill. Cl. 79.

6. The provisions of the existing Act regarding the registration of Sheffield (Cutlers' Company) marks have been amended, so as to bring the method of registering marks at Sheffield into harmony with the system of registration in London. Cl. 81.

#### GENERAL.

1. All proceedings relating to the grant of patents, and registration of designs and trade marks, will be under control of an officer, called the Comptroller, acting under the superintendence of Board of Trade. Cl. 83. General Provisions

2. Power is taken to provide a new Patent Office. Cl. 82.

3. Power is taken to join the International Union for the reciprocal protection of patents, designs, and trade marks. Cl. 103."

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## CHAPTER V.

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

[46 & 47 VICT. CH. 57.]

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#### ARRANGEMENT OF SECTIONS.

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##### PART I.

###### PRELIMINARY.

Sect.

1. Short title.
  2. Division of Act into parts.
  3. Commencement of Act.
- 

##### PART II.

###### PATENTS.

###### *Application for and Grant of Patent.*

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5. Application and specification.
6. Reference of application to examiner.
7. Power for Comptroller to refuse application or require amendment.
8. Time for leaving complete specification.
9. Comparison of provisional and complete specification.
10. Advertisement on acceptance of complete specification.
11. Opposition to grant of patent.
12. Sealing of patent.
13. Date of patent.

###### *Provisional Protection.*

14. Provisional protection.

###### *Protection by Complete Specification.*

15. Effect of acceptance of complete specification.

###### *Patent.*

16. Extent of patent.
17. Term of patent.

Sect. *Amendment of Specification.*

- 18. Amendment of specification.
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- 21. Advertisement of amendment.

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- 23. Register of patents.

*Fees.*

- 24. Fees in Schedule.

*Extension of Term of Patent.*

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

*Revocation.*

- 26. Revocation of patent.

*Crown.*

- 27. Patent to bind Crown.

*Legal Proceedings.*

- 28. Hearing with assessor.
- 29. Delivery of particulars.
- 30. Order for inspection, &c., in action.
- 31. Certificate of validity questioned, and costs thereon.
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*Miscellaneous.*

- 33. Patent for one invention only.
- 34. Patent on application of representative of deceased inventor.
- 35. Patent to first inventor not invalidated by application in fraud of him.
- 36. Assignment for particular places.
- 37. Loss or destruction of patent.
- 38. Proceedings and costs before law officer.
- 39. Exhibition at industrial or international exhibition not to prejudice patent rights.
- 40. Publication of illustrated journal, indexes, &c.
- 41. Patent Museum.
- 42. Power to require models on payment.
- 43. Foreign vessels in British waters.
- 44. Assignment to Secretary for War of certain inventions.

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- 46. Definitions of patent, patentee, and invention.

PART III.

DESIGNS.

Sect.                      *Registration of Designs.*

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*Register of Designs.*

- 55. Register of designs.

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- 57. Exhibition at industrial or international exhibition not to prevent or invalidate registration.

*Legal Proceedings.*

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- 60. Definition of "design," "copyright."
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- 69. Opposition to registration.
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Sect.

- 71. Conflicting claims to registration.
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Sect.

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-

[46 & 47 VIC., CHAP. 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.

#### Sect. 1.

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

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

Division of Act into parts.

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

**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. Commencement of Act.

**Note.**—The Patents Rules, printed *infra* in Chapter VI, p. 241, come into operation at the same time (Rule 1).

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## PART II.

### PATENTS.

#### *Application for and Grant of Patent.*

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

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

Note.  
Sec. 4.

**Note.**—*Sub-section 1.* Letters Patent for inventions might always be granted to aliens or foreigners, subjects of countries with which this country is at amity—*Chappel v. Purday* (14 M. & W., 318); *Beard v. Egerton* (3 C. B., 129). The point was once raised whether a patent could be taken out in trust for an alien enemy—*Bloxam v. Elsee* (1 C. & P., 558; 6 B. & C., 169); but was never decided. Probably, in modern times, if objection were made to the grant of a patent to a native of a country with which this country was at war, on that ground it would be overruled; and a patent, if granted, to such a person would be valid.

A patent cannot be granted to a corporation aggregate (such as a public company), nor to a corporation sole (such as the vicar of a living), as such—*Hindmarch on Patents*, p. 357.

A patent can be granted to an infant under 21 years of age.

See, further as to who may or may not be grantees of anything, *Co. Lit.*, 2*b*; *Shep. Touch.*, 234, 235.

A patent taken out for an invention, which has been the result of knowledge obtained in discharge of public duties as a member of an official commission appointed by Government, and communicated to the other members of the commission, is not valid—*Patterson v. Gas Light and Coke Company* (L. R., 3 App. Cas., 239).

A patent may now be granted to the legal representative of a deceased inventor (see section 34).

*Sub-section 2.* Any number of persons who have all been actually concerned in producing an invention may jointly apply for a patent. And any number of persons, one of whom is the inventor (see section 5, sub-section 2, and note thereto).

When a patent is granted to two or more persons, anyone of them may use the invention without the consent of the others, and without accounting to them, or any of them, for the profits so obtained, in the absence of any special agreement to that effect—*Mathers v. Green* (L. R., 1 Ch. 29); see also *Hancock v. Bewley* (Johns., 601), and *re Russell* (2 De G. and J., 130). The present Act makes no change in the law in this respect.

Applica-  
tion and  
specifica-  
tion.

**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.

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention,

whereof he (*a*), or in the case of a joint application, one or more of the applicants (*b*), 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.

Sect. 5.

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

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required (*d*).

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

**Note.**—*Sub-section 1.* By Patents Rules 5 and 6 the forms A, or A1 in the second schedule to the rules (p. 257), are the prescribed forms which must be followed. Rule 22 regulates the recording of applications. Refer to rules 8, 9, and 10 for details of application. It will be seen that the petition or document required up to this Act coming into operation, following the terms of the declaration, and praying for the grant of a patent to the applicant, is dispensed with. All that is required is to send the declaration in form A, schedule 1, stamped with £1, together with a provisional or complete specification to the Patent Office. The declaration is now, in effect the *application*.

*Sub-section 2.* See section 34, providing that where a person dies possessed of an invention without having applied for a patent therefor, the patent may be granted to his legal representative on application made within six months from his decease.

(*a.*) This sub-section raises the important question as to whether *patents of communication* have been abolished or not by the Act. Patents of communication were so called when the patents were obtained by persons being in this country, in their own names, for inventions communicated to them by persons residing abroad. Such patents used to be obtained on the applicant making a declaration that he was in possession of such an invention which had been communicated to him from abroad by such a person (naming him), residing at such a place

**Note.**  
**Sect. 5.**  
—

(naming it) abroad. They were perfectly valid even if obtained without the authority or knowledge of the foreign inventor if not obtained in fraud of him—in which case he was protected by section 10 of the Act of 1852—since, from a very early period in the history of patents, the first introducer of an invention into this country was always held to be the first inventor thereof within these realms—*Edgeberry v. Stephens*—(2 Salkeld, 447); *Carpenter v. Smith* (9 M. and W., 300; 1 Webs. Pat. Ca., 7, 535, per Lord Abinger). This system of patents of communication was found very convenient, and has been largely used in taking out patents in this country for foreigners. When a foreigner desired an English patent, he would direct an agent to apply for it, and the agent would apply in his own name, at the same time handing his foreign employer a document acknowledging that he applied for the patent only as agent for the foreign inventor, and would hold it as trustee for him, and undertaking to assign the patent when granted as and when the foreign employer should direct.

The sub-section requires that, on the application for a patent, the declaration must state that the applicant, or one or more of the applicants, claims *to be the true and first inventor or inventors* of the invention. No patent can, therefore, be obtained without the signed declaration of the applicant to this effect, and the patent will be granted to the person or persons signing the declaration. It is a principle of patent law, that a patent which has been obtained upon an untrue representation is invalid upon that ground. And if a person to whom the invention has been communicated cannot truthfully claim to be the true and first inventor, it would seem that a patent obtained by a declaration to the effect required by sub-section 2, when, in fact, it had been communicated to the inventor from abroad, would be invalid, as having been granted upon an untrue representation.

The question was discussed in the year 1856, in the case of *Stedman v. Marsh* (2 Jur., N. S., 391), when Lord Hatherley, then Vice-Chancellor Wood, observed:—“I apprehend that “any person not being in a confidential position towards the “first inventor receiving from a person abroad an invention, “is entitled, perhaps, not in a strictly moral view, but at all “events according to law, to take out a patent on his own “account for the invention so communicated.” The same learned judge had before him the case of *Milligan v. Marsh* (2 Jur., N. S., 1083) in the same year, arising out of the same litigation, in which the facts were as follows:—Thomas Milligan, the plaintiff, a British subject residing at Lima, in Peru, having conceived an improvement in making pianos, gave to

the son of his London agent, who was then on a visit at his house, a full description and drawings of the invention, marked "private," and requested the son, on his return to London, to take out a patent for him, Thomas Milligan. The son returned to London and delivered the drawings to his father, Thomas Milligan's agent. Thomas Milligan, about the same time, wrote a letter to Marsh, the defendant, his agent, not marked "private," inquiring generally after the invention, and whether a patent for it was being taken out. Shortly afterwards Marsh took out a patent for the improvement in question *in his own name, as for an invention of his own*. Afterwards Thomas Milligan employed another person, Stedman, to make such pianos, on his account. Marsh brought an action for infringement against Stedman. Thereupon Thomas Milligan filed a bill to restrain the action and the use of the patent by Marsh. Marsh insisted that the invention described in Thomas Milligan's communication would not work. The learned judge, in deciding that the motion must stand over to await the result of the action, made the following observations:—

Note.  
Sect. 5.

"The plaintiff will have a full opportunity of defending that action; and if the defendant succeeds in the action on the ground that that communication was not the foundation of the patent here, or not the foundation to such an extent as to prevent him from being the true inventor of the patent taken out in his own name (for I have observed, that though the plaintiff's communication was useless in itself and incapable of application, and although confidential, yet the defendant might use it for his benefit in this way: it might set him thinking, and lead to the discovery by him of a practical way of carrying out the idea which he might lawfully patent for his own benefit); in either of such cases the plaintiff's case would be at an end. There could be no trusteeship of that which the plaintiff says he invented, for it would turn out in such a case that he had invented nothing. . . . The case made is that this was an invention of the plaintiff's communicated to the defendant. In such a case the *Letters Patent being taken out by the defendant, as for an original invention, are void ab initio.*"

In a case of *Renard v. Levinstein* (10 L. T., N. S., 177), before Lord Justice Knight Bruce, in 1864, that learned judge made the following observations:—"One objection has been raised to the patent, 'that the invention being stated to be partly original and partly communicated from a foreign country, it is not distinguished, either in the Letters Patent, or in the specification or otherwise—not distinguished, not defined, not explained what is the nature nor what are the particulars

Note.  
Sect. 5.

“ ‘ of the communication from abroad made by the gentleman  
“ ‘ mentioned, M. Georges de Laire, of the Mint of Paris.’ Now  
“ considering the different consequences that may arise as to  
“ the part of an invention communicated from a foreign  
“ country, and as to the part of the same invention, or set of  
“ inventions, which may be deemed to be in every respect new,  
“ I consider it to be a very serious and arguable question  
“ whether it is or is not incumbent upon the patentee to dis-  
“ tinguish, to define, and to particularise what is new and what  
“ is old, which here is not done. . . . As far as I am con-  
“ cerned the point is full of doubt and difficulty.”

From these dicta (for they do not amount to decisions) of the two learned judges, it would appear that their opinion was that if a patent had been obtained on a representation that the applicant was the inventor when he was only the communicant of an invention, that the patent would be void. It would, therefore, follow that patents of communication have been abolished.

On the other hand, there are strong grounds in support of the contrary view. As already pointed out, it was long ago decided (*Edgeberry v. Stephens* and the other cases *supra*) that the first introducer of an invention into this country was the first inventor within this realm, within the meaning of the 6th section of the Statute of Monopolies; and by section 46 (p. 176) of this Act, the word “invention” is defined to mean “any manner of new manufacture the subject of Letters Patent, and grants of privilege within section 6 of the Statute of Monopolies,” which, as we have already seen, has been held to include an invention introduced for the first time into this country. Suppose, therefore, an applicant for a patent for an invention which has been communicated to him from abroad, declares, as required by sub-section 2 above, that he is in possession of an invention of which he claims to be the true and first inventor, and obtains a patent therefor, will that patent be held invalid on the ground that it was granted on an untrue representation of the applicant that he was the true and first inventor, when, according to *Edgeberry v. Stephens*, he was so? The opinions of the judges in the case of *Mulligan v. Marsh* (2 Jur., N. S., 1083), and *Renard v. Levinstein* (10 L. T., N. S., 177), above cited, tend to show that a patent so obtained would be held to be invalid; but if those cases are carefully examined it will be seen that those opinions are merely dicta, not amounting to decisions. The Patents Rules deal with this question, but only indirectly. By rule 6 (1) an application for patent is to be made either in the forms A or A1 given in the second schedule thereto. Form A1 (p. 258) is the form of application when the invention has been communicated from abroad,



giving the name of the communicator, and goes on to say that the applicant claims to be the true and first inventor thereof, and rule 27 provides that it be adopted in the case of a communication from abroad. It is understood that the form has been settled with a great deal of care. The meaning, of course, is, that the applicant claims to be the inventor within the doctrine of *Edgiberry v. Stephens, &c.* But the question remains, can the applicant truthfully claim to be the true and first inventor—not the true and first inventor within these realms, for that will not satisfy the sub-section—when in fact he is not?

**Note.**  
**Sect. 5.**  
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The question must, therefore, be regarded as one of doubt until set at rest by judicial decision, and what that decision may be it is impossible to anticipate. It will depend upon which of the two conflicting set of reasons above indicated prevails. It is, of course, to be regretted that so important and practical a point should have been left in doubt. Attention was called to it during the passage of the Act through Parliament, but no alteration was made (see the report of a discussion upon the Bill by the Society of Arts, in the Journal of that Society of the 20th April, 1883), from which it will be seen that the opinion that patents of communication were not abolished, was the one which found most favour in the Society,

(b.) Another point in the above sub-section which requires particular notice, is that in the case of a joint application for a patent by two or more persons, it is only necessary for one at least of the applicants to declare that he claims to be the true and first inventor. Whether this effect was intended or not, it is the clear grammatical construction of the phrase, viz., “An application must contain a declaration to the effect . . . . in the case of a joint application that *one or more* of the applicants *claims or claim* to be the true and first inventor or “inventors” of an invention of which the joint applicants are in possession. The effect of this clause will be very important, for it will enable persons who have had no share in making an invention to obtain equal patent rights with a person or persons who have actually made it, by making an application jointly with him or them; and since one of the joint parties of a patent can use it without the permission and without accounting to the others, as pointed out in the note to section 4 sub-section 2, the consequence may be that a person who has had no merit in making the invention may derive the greater part, or possibly the whole of the advantages derived from the patent. This effect will be very convenient where one member of a firm has made the invention, and it is desired that the patent should be granted to the whole firm; but the draftsman of

**Note.**  
**Sect. 5.**

the clause had probably not the doctrine of *Mathers v. Green* (L. R., 1 Ch. 29) in his recollection when he inserted the words, "In the case of a joint application, one or more of the "applicants." The point will probably be litigated whether such an effect of the section was intended; and although the grammatical construction is clear, it may be well to exercise a little caution in advising until it has been decided.

The prescribed form A (p. 257) can easily be adopted to such a case.

(c.) *Sub-sections 3 and 4.* Refer to Chapter I., section 5, 2nd., p. 33, as to the principles which should regulate the drafting and preparation of the provisional specification. Form B (p. 258) is prescribed Pat. Rules 6 (2).

(d.) *Sub-section 4.* Refer *ibid* p. 44, as to the preparation of the complete specification. Form C (p. 259) is prescribed Rule 6 (2). Refer to Rule 31 (p. 246), which requires a concise explanatory statement of the features of novelty to accompany the complete specification. *Drawings.* Refer to Chapter I., pp. 62, 63. The Pat. Rules 28, 29, and 30 (p. 245) regulate the sizes of, and the method of preparing, the drawings. Rule 31 (p. 246) requires an additional drawing of small size illustrating the feature of novelty to be left with the complete specification for the purpose of the illustrated journal required to be published by section 40 (p. 171).

(e.) *The Title.* Although the duty is thus cast upon the Patent Office of examining whether the title sufficiently indicates the subject matter of the invention, yet the fact of the title having satisfied the office will not preclude the objection being taken in any proceedings for the infringement of the patent that the title is misleading, or inaccurate, and therefore void upon that account (see also Chapter I., section 5, p. 29, as to title).

(f.) *Sub-section 5.* Refer *ibid* p. 63, as to the drafting of preparation of the distinct statement of the invention or claims or claim. The provision requires that complete specifications shall end with a distinct statement of the invention claimed as new.

In the first draft of the Bill, which has resulted in this Act, it was proposed to render a claim or claims obligatory in the provisional specification; but this was abandoned, principally upon the representations of the inconvenience and difficulty which would be occasioned by such a provision, made by the Institute of Patent Agents to the President of the Board of Trade.

Hitherto, while not obligatory, it has been the custom, in most well drafted complete specifications, to end them by a

claim or claims, in which the distinctive features of the invention were summarised; and the inventor pointed out what he considered himself to have invented, and therefore "claimed."

Note.  
Sect. 5.

The provision requiring that the complete specification shall end "with a distinct statement of the invention claimed," therefore only renders that obligatory which was the prevailing practice before. The intention is to render the examination of specifications more easy and certain. The practical effect of this new provision will be to render the claims of greater importance than ever, and even more care than before will be necessary to be used in drafting them.

By section 33, *infra*, more than one claim is permitted in a specification.

**6.** The Comptroller shall refer every application to an examiner (*a*), 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 (*b*).

Reference  
of applica-  
tion to ex-  
aminer.

**Note.**—(*a*.) This provision is new. In the first draft of the Bill it was proposed that the examiner should report also whether "The invention was subject matter for a patent;" but this was abandoned on the representations of the Institute of Patent Agents, as to the inexpediency of such an officer as an examiner, deciding upon a question of such difficulty as what was the subject matter for a patent, and the inconvenience likely to be occasioned by such an examination.

A similar examination, to the one now provided for, was, previously to the Act, made by the Patent Clerks of the Attorney and Solicitor-Generals.

See also section 33 *infra* (p. 166), requiring that a patent shall be granted for one invention only.

As to the appointment, duties, and powers of the Comptroller and examiners (see Part V., sections 82, 83, 85, 91, 94, and 95).

**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,

Power for  
Comptroller to  
refuse applica-  
tion or require  
amend-  
ment.

**Sect. 7.** specification, or drawings be amended before he proceeds with the application (*a*).

(2.) Where the Comptroller requires an amendment, the applicant may appeal from his decision to the law officer (*b*).

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

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

(5.) If 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 (*c*).

(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 (*d*).

**Note.**—Rules 11, 12, 13, 14, and 15, *infra* (p. 242), must be read with this section; also rule 18.

(*a.*) *Sub-section 1.* A similar power to that here conferred on the Comptroller, used, under the old practice, to be exercised by the Attorney and Solicitor-Generals. It is to be anticipated that the Comptroller and his examiners will be much more severe than it has been the custom of the law officers hitherto to be.

Section 33 (p. 166) enacts that a patent shall be granted for one invention only. It will be the examiner's duty to carry out this enactment. Refer to Pat. Rules 11 and 14 (p. 242) as to the notice required to be given by the Comptroller.

(*b.*) *Sub-section 2.* Under the old practice there was practically no appeal from the decision of the Attorney or Solicitor-General upon these points.

By the Definition Clause 117, "Law Officer" means Her Majesty's Attorney-General, or Solicitor-General for England. As to the method of appealing, see the rules regulating appeals to the law officers (p. 253). The form of appeal is T (p. 265).

*Sub-section 3.* No provision being made for any mode of

questioning the law officer's decision, his determination as to amendments, and as to conditions upon which the application shall be accepted, will be final. **Note.**  
**Sect. 7.**  
—

(c.) *Sub-section 5.* This provision is new. It will be well, however, for inventors not to rely exclusively upon the examiner and Comptroller, but to watch either themselves, or by their agents, the lists of patents newly applied for, in order to oppose if necessary. See Pat. Rules 15 and 16, p. 243. See also section 13, and note thereon, *infra* p. 133.

(d.) *Sub-section 6.* This provision is new. It appears to cast upon the Comptroller the duty of forming an opinion as to whether the two applications conflict, and to refuse a patent to the second applicant if he should think that they do, and this, whether the first applicant takes any steps upon the notice provided for in sub-section 5 or not. For the method of appeal to law officers, see the rules of those officers (p. 253), made under section 38, *infra* p. 169.

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

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

**Note.**—(a.) *Sub-section 1.* *i.e.*, the applicant may leave a complete specification immediately after receiving notice from the Comptroller, pursuant to section 7, sub-section 4, that his application has been accepted; or he may not do so until nine calendar months from the date of his application. Refer also to Pat. Rule 37 (p. 247.)

(b.) “*Within nine months from the date.*” “Month” means calendar month (13 & 14 Vic., c. 21, section 4). “In computing a month, the day of the month corresponding with that from which the computation began is excluded, so that two days of the same number are not comprised within it”—*Freeman v. Read* (4 B. & S., 174; 32 L. J., M. C., 226). “The rule is to exclude the first and include the last day”—*Young v. Higgon* (6 M. & W., 48; Maxwell on the Interpretation of Statutes, p. 310).

(c.) *Sub-section 2.* Since no publication of the provisional specification will take place until after such abandonment, and no patent will be granted for the invention described in the abandoned provisional specification, it is apprehended that the decision in the case of *Oxley v. Holden* (8 C. B., N. S., 666),

**Note.**  
**Sect. 8.**  
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under the Act of 1852, “that if a patentee files a provisional specification which he abandons, and afterwards files another provisional specification before the time for provisional protection has expired, the abandonment itself will not be a publication, although it may be a ground of objection to the grant of a patent subsequently for the same invention, yet, if the patent is granted, it is not void,” still applies. Therefore, if a patent be granted in a subsequent application for the same invention within the nine months mentioned in this subsection, it would not be invalid upon that ground. “*The application shall be deemed to be abandoned*”—i.e., that application.

Compari-  
son of pro-  
visional  
and com-  
plete spe-  
cification.

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

(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.

**Note.**—These provisions are all new.

**Note.**  
**Sect. 9.**  
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Important questions will probably arise under the clause in sub-section L requiring the examiner to report “whether the invention particularly described in the complete specification is *substantially* the same as that which is described in the provisional specification.” Inventions under the old practice (under 1852 Act) have sometimes developed or altered considerably during the period of six months, and a longer period by three months is now allowed. It is obvious, also, that the term “substantially” is an elastic one. Much will, therefore, depend upon the administration by the Comptroller of this clause. The Comptroller (see Pat. Rules, 11, *et seq.* p. 242) is required to hear the applicant for patent, or his agent, upon the question before finally deciding. The method of appealing to the law officer is regulated by the rules for the purposes (p. 253). The law officer, by the terms of sub-section 3, is bound to hear both the applicant (either by himself, or his agent, or counsel) and the Comptroller upon the question.

The decision of the law officer is, by the terms of sub-section 3, final as against the applicant and the Comptroller; but there is nothing in this or any other section in the Act to prevent the same objection (*i.e.*, that the complete specification covers much more than the provisional) being raised against the validity of a patent in any proceedings taken against an infringer, as was done under the old practice almost invariably. Bearing in mind what a pitfall to inventors this has proved, a very notable instance of which lately is the decision of Mr. Justice Fry upon Edison's Patent for Telephones, in the case of *United Telephone Company v. Harrison, Cox-Walker & Co.* (L. R. 21, Ch. D., p. 721), that that patent was void on the ground that the nature of part of the invention, described in and claimed by the complete specification, had not been sufficiently described in the provisional specification, it appears to be a regrettable omission in the present Act that, since it has provided for such an examination, it was not also provided, that no objection to the validity of a patent on the ground of variance between the provisional and complete specification should be taken in any proceedings against alleged infringers thereof.

The only remark which arises upon sub-section 5 is, that at present, it is difficult to see how the “production or inspection” of the reports of examiners in legal proceedings will ever be “desirable” in the interests of justice.

**10.** On the acceptance of the complete specification the Comptroller shall advertise the acceptance; and the

Advertis-  
ment on  
accep-

**Sect. 10.** application and specification or specifications with the drawings (if any) shall be open to public inspection.

—  
tance of  
complete  
specifica-  
tion.

**Note.**—The advertisement mentioned in this section is the first notification to the public that a patent has been applied for provided for in this Act. The Illustrated Journal of Patented Invention, provided for in section 40, *infra* p. 171, is for the publication of inventions after they have been completely patented. But by Pat. Rule 25 the advertisement is to be in the Official Journal of the Patent Office. Pat. Rule 26 (p. 245) provides for the public inspection; the search or inspection fee is one shilling, No. 32 in the first schedule to the Pat. Rules (p. 256).

The provision that the specification shall be open to public inspection before the grant of patent is new. It is of the greatest importance, because it will enable oppositions to be conducted with "open documents," as it has been called. The policy of this alteration of the law has been very much questioned (see discussion of Society of Arts, reported in their Journal of the 20th April, 1883), and it is obvious it will give the opponent to the granting of a patent a great advantage of which it may be feared improper use will be taken. He may oppose on the ground that he, and not the applicant, is the true inventor of the invention for which the patent he opposes is applied for. Under the now abolished system the provisional specification was kept secret, and if the opponent could not describe the invention disclosed therein, it was obvious at once that he could not be the inventor. Under the new system he need not oppose until he has seen and studied the applicant's complete specification for a period of two months. If he be fraudulently inclined, the opponent has thus every opportunity for the exercise of such inclination. If he alleges he made the invention it will be difficult to disprove, because it is impossible to look into the condition of his mind. No doubt the Comptroller in deciding cases of opposition, and the law officers in deciding those brought before them on appeal, will bear these considerations strongly in mind.

After the acceptance of the complete specification the patentee cannot abandon his application and apply again in respect of the same invention, because it will have been published, *i.e.*, open to public inspection—See note (c) to section 8, *supra*.

Opposi-  
tion 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. Sect. 11.  
—

(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.

**Note.**—Pat. Rules 32 to 41 (p. 246) regulate the practice of oppositions to grants of patents.

*Sub-section 1.*—Compare section 12 of the repealed Act of 1852. Under that section any grounds of opposition might be taken. Here the grounds of opposition are limited to the three above specified. The section does not specifically say that the notice must be in writing, as in the repealed section, but by analogy to similar provisions in other Acts (*e.g.*, The Employers Liability Act, 1880, section 7; see *Moyle v. Jenkins* (8 Q. B. D., 116), there can be no doubt a written notice will be held necessary. Pat. Rule 32 requires it to be signed.

*Sub-section 2.*—Under this sub-section it will be advisable for the applicant, on receiving notice from the Comptroller of opposition having been entered to his application for patent, to apply to that officer for an appointment to hear him upon the matter; and it will be necessary to follow the directions in Pat. Rule 36. If, however, the applicant does not move in the

**Note.** matter, it will, nevertheless, be the Comptroller's duty to con-  
**Sect. 11.** sider and decide the question.

— It will be the duty of the person dissatisfied with the decision of the Comptroller to appeal to the law officer. This he should do as provided by the rules made by the law officers (p. 253). The form of notice is Form T (p. 265).

By section 117, "Law Officer" means the Attorney-General or Solicitor-General for England.

The Act contains no provision as to how these officers are to regulate the performance of the duties cast upon them by this Act between them; neither is there any provision as to their remuneration. Compare section 107 of repealed Act of 1852. But, by section 38, *infra*, power is given to the law officers to make rules of procedure and to order costs to be paid by either party, and some rules have been made (p. 253). No. 11 of such rules empower the law officer to fix the amount of such costs.

*Sub-section 3.*—By the terms of the sub-section, the law officer can decide without hearing the parties, but he is required to hear either or both of them if they desire it. It will, therefore, be necessary for the party if he desires to be heard to indicate his desire to the law officer.

The decision of the law officer will be final upon the point whether the patent shall be sealed to the applicant or not. There is nothing in the Act to prevent the same points which have been urged in opposition to the grant of a patent being raised as objection to the validity of the patent when granted on proceedings being taken for an infringement thereof.

The power of opposing the grant of a patent at two opportunities, at the notice to proceed, and the application for seal under the repealed Act of 1852 (see sections 14 and 15), is abolished.

*Sub-section 4.*—Compare section 22 of repealed Act of 1852. This provision was practically a dead letter under that Act. It does not appear by whom the remuneration to the expert shall be paid, but the law officer apparently has power to order either party to pay it as part of the costs (see section 38, *infra*).

Sealing of  
patent.

**12.** (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the Comptroller shall cause a patent (a) 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. Sect. 12.

(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 hereinafter 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 representative, and sealed at any time within twelve months after the death of the applicant (b).

**Note.**—(a.) For the form of patent see Schedule D to the Act, p. 235.

*Sub-section 3.*—(b.) This provision is adopted from section 21 of the repealed Act of 1852. The practice under that section was to petition the Lord Chancellor, and the production of Probate or Letters of Administration was required. It is presumed, under this Act, application must be made to the Comptroller, supported by an affidavit setting out the facts, and that the production of Probate or Letters of Administration will still be required. Pat. Rule 24 requires this to be done in the case of an application for a patent by the legal representative of a person who has died possessed of an invention under section 34.

**13.** Every patent shall be dated and sealed as of the day of the application (a) : Date of patent. Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification (b) : 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 (c).

**Note.**—(a.) Compare sections 23 and 24 of the Act of 1852.

(b.) Compare section 24 of same.

These two clauses introduce no change into the law, with the exception that the time during the life of a patent, in which

**Note.** no proceedings could be taken for an infringement, was, under  
**Sect. 13.** the old law, only six months, while it may now be fifteen  
 — months, or, in cases of opposition to the grant of patent, even  
 longer.

(c.) This clause is inserted to obviate the effect of the decision of Lord Hatherley, C., in *ex parte Bates v. Redgate* (L. R. 4 Ch. 577; 38 L. J., Ch. 501; 17 W. R., 900; 21 L. T., N. S., 410), upon the practice under the repealed Act of 1852, that the existence of a prior provisional specification was not a ground, in the absence of fraud, on which the Attorney-General ought to refuse to allow a second provisional protection to be granted; and in the event of the later applicant for provisional protection being the first to obtain a grant of patent, his patent was a bar to the grant of a patent for the same invention to the earlier applicant for patent.

This decision, the doctrine of which is now abolished by the above clause, introduced a practice among applicants for patents of "racing for the seal," as it was called, by which later applicants endeavoured to get a patent sealed to them before earlier applicants, and so secured the patent to the exclusion of the latter. The clause was not contained in the first draft of the Bill, and was introduced into the Act principally in consequence of the representations of the Institute of Patent Agents (see the reported transactions of that body).

#### *Provisional Protection.*

Provi-  
sional pro-  
tection.

**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.

**Note.**—Compare section 8 of the repealed Act of 1852.

This provision introduces no change into the law, except the time between the application for patent and the date of sealing may now be so much as fifteen months (see section 9, sub-section 4, *supra*) or more, in the case of an opposed patent; while, under the Act of 1852, it could never be, except in the case of opposed patents, more than five and a half months. And the period between application and acceptance may be so much as twelve months (see section 9, sub-section 4, *supra*); while, under the repealed Act of 1852, the time between the application and the issue of certificate of provisional protection

by the law officer (section 8 of Act of 1852) was rarely so much as one month.

**Note.**  
**Sect. 14.**  
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Having regard to the much greater length of time allowed for passing a patent through the office under the new procedure, and that the life of the patent (fourteen years) remains the same, it will most likely be found to the interest of inventors not to avail themselves of the full time allowed by the Act, but to file their complete specifications as shortly as convenient after the acceptance by the Comptroller, of their applications.

*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  
accep-  
tance of  
complete  
specifica-  
tion.

**Note.**—Compare section 9 of the repealed Act of 1852.

Under the Act of 1852, by filing a complete specification with his application for patent, the inventor obtained full patent rights. Under this section he does not, until his complete specification has been accepted by the Comptroller. Under the Act of 1852, also, the inventor might, in the case of his depositing a complete specification with his application, institute proceedings for infringement for the period between the date of application and date of sealing: under this clause not. This latter proviso was not in the first draft of the Bill.

*Patent.*

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

Extent of  
patent.

**Note.**—Compare section 18 of repealed Act of 1852.

The Channel Islands are omitted from this section, and in the form of patent given in the First Schedule, *infra* p. 235, form D. Therefore, patents under this Act will confer no privileges on the Channel Islands, as, under the old law, they did.

In the first draft of the Bill, and in the second draft of the Bill as amended by the Standing Committee on Trade, &c., of

**Note.** the House of Commons, patents were made to extend to the  
**Sect. 16.** Channel Islands. If protection be desired in the Channel  
 — Islands, application must be made to the proper authorities for  
 a patent therefor, as in the case of the colonies and other  
 dependencies of Great Britain.

Term of  
 patent.

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

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

(3.) If, nevertheless, in any case, by accident, mis-  
 take or inadvertence, a patentee fails to make any pre-  
 scribed payment within the prescribed time, he may  
 apply to the Comptroller for an enlargement of the time  
 for making that payment (*c*).

(4.) Thereupon the Comptroller shall, if satisfied  
 that the failure has arisen from any of the above-men-  
 tioned 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 pre-  
 scribed 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.

**Note—(a).** In spite of the strongest representations,  
 to the effect of the desirability of extending the time of a  
 patent, it remains the same as ever (fourteen years). It will  
 have been noticed that the new Act, by lengthening the time  
 taken to obtain the sealing of patent after the grant, prac-  
 tically lessens, by a not inconsiderable period, the life of a  
 patent.

*Sub-section 2.—(b).* See for the prescribed payments and  
 times the first schedule of the Patents Rules, *infra* p. 255.

The Pat. Rules as to “Certificates of Payment or Renewal”

(p. 247), make an important change in the law to which attention must be paid. Before the coming into operation of the Act the patent itself had to be stamped with an Inland Revenue stamp of the proper amount at Somerset House and left at the Patent Office on or before the last day for so doing; but no notice whatever to the Patent Office was required. Under the new rules (rule 42) the patentee must, *seven* days before the last day for paying the duties or extension fees, give notice to the Comptroller of Patents of his intention to do so. He is no longer required to stamp the patent itself, but a form of certificate of renewal to be obtained, it is presumed, from the Patent Office.

Note.  
Sect. 17.  
—

The changes in the fees payable, are—

Under Act of 1853 (16 Vic., c. 5).	£	Under this Act.	£
On application ... ..	5	On application ... ..	1
On notice to proceed ...	5	On complete specification..	3
On application for seal ...	10		—
On complete specification..	5		£4
	—		—
	£25	On filing complete specifi- tion with application ...	£4
	—		—

Act of 1853, section 2.	£	This Act.	£
At expiration of 3rd year ... ..	50	At expiration of 4th year ... ..	50
At expiration of 7th year... ..	100	At expiration of 8th year, if patent granted in 1884 and after ...	100
		If patent granted before 1884, at end of 7th year ... ..	100

Or as regards all patents in force on the coming into operation of this Act, or granted thereafter, the annual payments set out in the schedule.

(c.) This is an important and welcome amelioration in the law. Under the now superseded practice, if the last day for payment was allowed to slip, the patent lapsed to the public, and there existed no power short of a special Act of Parliament to enable the payment to be received, and the patent renewed. In one instance, at least, such an Act of Parliament was obtained for the purpose—Gardiner's Patent for Railroad Car Springs, dated 1st December, 1863. The Act

**Note.** of Parliament, then specially passed, received the Royal Assent  
**Sect. 17.** 29th May, 1868 (31 & 32 Vic.).

— The practice of obtaining enlargement of time, under the circumstances mentioned in the section, is provided for in Pats. Rules 46 and 47 (p. 248). The fees payable for such enlargement of time are—one month £3, two months £7, and three months £10—Nos. 26, 27, 28, in first Schedule to Pat. Rules (p. 255). The application must be in writing. By analogy to previous practice the Comptroller will probably require proof by affidavits. It should be noticed that the power of the Comptroller is strictly limited to cases of accident, mistake, or inadvertence, and does not include *neglect*.

#### *Amendment of Specification.*

Amend-  
ment of  
specifica-  
tion.

**18.** (1.) An applicant or a patentee (*a*) 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 (*b*), stating the nature of such amendment and his reasons for the same.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner (*c*), 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.

(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 (*d*) the case, subject to an appeal to the law officer (*e*).

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice (*f*), and, being, in the opinion of the law officer, entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions (*g*), 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 (*h*), 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 (*i*).

(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 (*j*). Sect. 18.

(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 (*k*).

(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 (*l*).

(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 (*m*).

**Note.**—This section introduces no practical change in the law.

Compare section 1 of Act of 1835 (5 & 6 Will. IV.,	} Repealed by Act of 1883.
c. 83).	
"      "   5      "   1844 (7 & 8 Vic., c. 69).	
"      "   39      "   1852 (15 & 16 Vic., c. 83).	

The rules for working out this section are Pat. Rules 48 to 56 (p. 248). For fees on Disclaimer, &c., see first Schedule to Pat. Rules (p. 255).

(*a*.) "An applicant or patentee." The meaning of "applicant," is the person to whom the patent was granted; the meaning of "patentee" is the person or persons to whom the patent may have been assigned by the "applicant." This is clear on a reference to section 5 of the Act of 1844, which was specially passed to enable the assignee or assignees, from the original patentee of a patent, to file a disclaimer and memorandum of alteration. The Act of 1883 does not profess to change the previously existing law in this respect, but only to codify it (see Memorandum indorsed upon the Bill at the introduction, repeated at Chapter IV. *supra* p. 103). In Act of 1844, where the original patentee had only partially assigned his patent, he was required to join in the application for disclaimer or memorandum of alteration. This will be still necessary under the present Act, when leave is sought to amend the specification.

(*b*.) "*By way of disclaimer, correction, or explanation.*" The words of the now repealed section 1 of the Act of 1835

**Note.** were “ a disclaimer of any part of either the title of the inven-  
**Sect. 18.** “ tion or of the specification,” or “ a memorandum of any altera-  
 — “ tion in the said title or specification, not being such disclaimer  
 “ or alteration as shall extend the exclusive right granted ” by  
 the patent. The power to amend by way of “ *explanation* ”  
 conferred by this section is therefore new. Although the words  
 are “ by way of disclaimer, correction, or explanation,” yet it  
 is apprehended the pronoun “ or ” will not be construed disjunc-  
 tively, but that leave will be given when necessary to disclaim,  
 and correct, and amend. In the repealed section 1 of the Act  
 of 1835, the words were disclaimer or memorandum of altera-  
 tion, and the practice of the law officer was to permit a dis-  
 claimer and memorandum of alteration, to be filed in one  
 document, upon the same application, and in no case has the  
 propriety of that practice ever been challenged.

(c.) The manner prescribed by Pat. Rule 48 (p. 248). Direc-  
 tions as to advertisement must be applied for at the Patent  
 Office. The law officers, under the old practice, required  
 advertisements, stating that leave had been requested to file  
 a disclaimer and memorandum of alteration to the patent in  
 question, and that any person desiring to oppose such leave  
 being granted should, before a certain date, give notice to  
 the law officer of his intention to do so, to be inserted in two  
 London papers, and in the district where the invention was  
 worked. The nature of such proposed amendment, however,  
 was not required to be advertised, so that in this respect a  
 change in the practice has to be attended to.

(d.) The Comptroller must, therefore, judicially hear the  
 parties upon an opposition to an amendment. The parties, no  
 doubt, will be entitled to be heard by their agents or counsel.

(e.) *Appeal to law officer.* For procedure as to, see the  
 law officers' rules (p. 253). See No. 11 of those rules as to costs.

(f.) *i.e.*, by themselves or by their agents or counsel.

(g.) Note that, while no power is conferred upon the Comp-  
 troller in a case of opposition to impose conditions, the law officer  
 has such power. The law officer having, under section 1 of the  
 repealed Act of 1835, a discretion as to granting or withholding  
 leave to file disclaimer, &c., used to occasionally to impose terms  
 upon patentees as conditions upon which they gave their leave.  
 An instance of this occurred in the Medlock's Patent, the facts  
 of which are reported in an article in Newton's London Journal,  
 Vol. 22, N. S., p. 69, and at Nos. 598 and 604 of Higgin's  
 Digest of Patent Cases. Such exercise of discretion was, in  
 that case, endeavoured to be questioned ; but without success (see  
 No. 604, Higgin's Digest). The decision of the law officer will  
 be final.

A patentee disclaiming after he has obtained an injunction against an infringement cannot enforce the injunction after disclaimer—*Dudgeon v. Thomson* (L. R., 3 App. Cas., 34). **Note.**  
**Sect. 18.**  
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(*h.*) In an unopposed case the Comptroller has power to impose conditions.

(*i.*) If, therefore, the Comptroller in an unopposed case imposes conditions which the patentee is unwilling to accept, he may appeal to the law officer, because, in effect, his application is refused.

(*j.*) In such an appeal to the law officer, the law officer's rules as to procedure, &c. (p. 253), must be followed. The decision of the law officer will be final.

(*k.*) This is a re-enactment of the previously existing law (section 1 of the Act of 1835) prohibiting the disclaimer or alteration from extending the rights granted by the patent.

(*l.*) This is also a re-enactment of the previously existing law (section 39 of Act of 1852).

(*m.*) This sub-section must read together with sections 19 and 20 *infra*. The previously existing provision contained in section 39 of the 1852 Act, was, that no action should be brought upon any patent in respect of which a disclaimer had been filed for any infringement committed prior to the filing of any disclaimer, unless the law officer should certify such action might be brought, notwithstanding the filing of the disclaimer.

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

**Note.**—This section appears contradictory to sub-section 10 of section 18 ; if so, however, it overrides it. The utility and importance of the enactment are obvious. It was made a point of by the introducers of the Bill into Parliament. In the Memorandum upon the Bill when introduced into the House of Commons, which is printed in extenso in this volume, at p. 163, it is stated : “ In an action for infringement, a patentee “ will be able, by leave of the Court, to disclaim and give his “ disclaimer in evidence, but not in such a case to obtain “ damages without leave of the court.”

This, and the following section 20, are important additions to

**Note.**  
**Sect. 19.**  
—

the power of the Court to do complete justice between the parties. They should, however, be not too much relied upon to excuse any carelessness or negligence in the preparation of a specification or in bringing an action, as the Courts will, of course, exercise the large discretion conferred upon them in a very careful manner, and take care that a defendant is not prejudiced by their doing so. As much caution and care is therefore necessary now, as before the enactment of these provisions, to carefully examine into the validity of a patent before commencing proceedings against infringers. It will be as much more advisable now as before the Act, to amend the specification before the commencement of an action, than during its progress.

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.

**Note.**—See note to section 19, and note (*m*) to section 18. “That his original claim was framed in good faith and “with reasonable skill and knowledge.” This appears to be a well meant, but unworkable proviso. And it will puzzle the Courts not a little, to know why a man should be mulcted in damages for infringing (*l*) a patent, which he has been rightly advised is invalid owing to defects in the specification, because the patentee did not make the mistake in bad faith, and he or his advisers were not more than usually stupid in drafting it. And how are the Courts to decide what is reasonable skill and knowledge in framing a claim or drafting a specification? Except as providing ingenious counsel with matter for argument, the proviso appears likely to become a dead letter.

Advertise-  
ment of  
amend-  
ment.

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

**Note.**—In the Official Journal of the Patent Office, and as the Comptroller may direct—Pat. Rule 56 (p. 249).

#### *Compulsory Licenses.*

Power for  
Board to  
order

**22.** If on the petition of any person interested (*a*) it is proved to the Board of Trade (*b*) that by reason of

the default of a patentee to grant licenses on reasonable terms (c)— Sect. 22.

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

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

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

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

**Note.**—These provisions are quite new and mark a considerable change in the law. They are of the barest possible character, and afford no indication of the manner in which they are to be worked—The Pat. Rules Nos. 57 to 63 (p. 249) prescribe the procedure as to compulsory licenses.

(a.) It will be for the Board of Trade to decide who is a “person interested.” No definition is given.

(b.) “Board of Trade.” Pat. Rule 59 provides for a reference to the Comptroller, or to some other person or persons to be appointed by the Board.

(c.) What are “reasonable terms”? That is again left to the absolute discretion of the Board of Trade.

(d.) What are the “Reasonable requirements of the public”? That is left entirely to the discretion of the Board of Trade.

(e.) “Best advantage,” the same.

(f.) This proviso is introduced for the purpose of preventing what it has been stated has sometimes occurred:—Where a patentee cannot work his invention by reason of its involving the use of another patented invention, and where the owner of the latter will not grant his license to use it at all, or only on exorbitant or prohibitive terms.

(g.) The duty cast upon the Board of Trade by this section is a judicial one, and must, in consequence, be exercised judicially. Therefore, it will be incumbent upon the “Board of Trade” to afford the parties interested an opportunity of being heard, and of adducing evidence upon the matter, and to hear and consider the representations of the parties, and the evidence they adduce, and rule 63 so provides. It is apprehended if they act otherwise they can be com-

**Note.** pelled to act judicially (*i.e.*, to hear and determine) by  
**Sect. 22.** mandamus from the Queen's Bench Division of the High  
 — Court of Justice. It is the constant practice to grant the writ (of mandamus) to command the performance by any inferior jurisdiction of any public duty, for which there is no specific remedy—Tapping on Mandamus (chap. 3, p. 12), and cases there cited. See also observations in Brett, L. J., in *Reg. v Local Government Board* (reported L. R., 10 Q. B. D., at pp. 321, 322).

This is no appeal from the judicial decision of the "Board of Trade." The power above mentioned is only to compel the Board to hear and decide judicially.

It is left to the entire discretion of the Board of Trade, whether they will hear the parties by their agents or counsel, or only by themselves.

It is to be anticipated that further rules will shortly be made for working out the powers conferred by this section.

### *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 *prima facie* (*b*) evidence of any matters by this Act directed or authorised 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 (*c*).

**Note.**—Refer to Pat. Rules 64 to 76 (p. 250).

*Sub-section 1.*—(*a.*) Compare sections 34 and 35 of the Act of 1852, requiring two registers—one (section 34), "The Register of Patents"; and the other (section 35), "The Register of Proprietors." Under the new Act there will be but one register, called "The Register of Patents," which is to do the duty of both the former registers.

Section 35 of the 1852 Act contained an important pro-

vision:—"That until entry (in the Register of Proprietors) the grantee or grantees of the Letters Patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such Letters Patent." Under that provision it was held that an assignee could not bring an action for an infringement against third parties until his assignment had been registered—*Chollett v. Hoffmann* (7 E. & B., 686; 26 L. J., Q. B., 249). Upon points arising upon the doctrine of this case, the further cases of *Hussell v. Wright* (L. R., 10 Eq., 509); *Ellwood v. Christy* (17 C. B. N. S., 754; 34 L. J., C. P., 130); *re Green's Patent* (24 Bea., 145); *re Morey's Patent* (25 Bea., 581); *re Horsley and Knighton's Pat.* (L. R., 8 Eq., 475; L. R., 4 Ch. 786); *re Morgan's Patent* (24 W. R., 245) have been decided.

Note.  
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This section of the present Act must read with sections 87, 88, 89, and 90, *infra*, which see. Especially note the clause in section 87, giving the person, for the time being entered in the Register of Patents as proprietor, power absolutely to assign, grant licenses of, or otherwise deal with, the patent rights, and give effectual receipts.

(b.) "*Prima facie* evidence" means that production of the register is conclusive of everything appearing therein, in the absence of evidence impeaching it. By section 89, copies or extracts from the register, sealed with the seal of the Patent Office, are made evidence. It will, therefore, only be necessary, in order to give the *prima facie* proof referred to in the clause, to obtain a copy of the part of the register desired authenticated with the Patent Office seal.

(c.) This sub-section is in substitution for the provision in section 35 of the Act of 1852, which required all such documents to be entered in the Register of Proprietors. In practice, under this provision, the documents were copied into the Register of Proprietors. Now copies must be supplied by the parties, and are filed in the Patent Office. They will be open to public inspection.—Pat. Rule 75 (p. 252), on payment of 1s.; Schedule of Fees (p. 256) No. 32.

### 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

Fees in  
schedule.

**Sect. 24.** paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(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.

**Note.**—See the first schedule to Pat. Rules (p. 255).

*Extension of Term of Patent.*

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

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

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

(3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same; 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 (*f*) in relation to the public, to the profits (*g*) made by the patentee as such, and to all the circumstances of the case (*h*).

(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 (*i*), conditions (*k*) 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 **Sect. 25.**  
the Judicial Committee (*l*).

(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 (*m*).

**Note.**—This section introduces no change into the law, but, simply codifies the previously existing legislation on the subject, contained in the now repealed statutes of 1835 (5 & 6 Will. IV., chap. 83, sec. 4); of 1839 (2 & 3 Vic., chap. 67, sec. 2); and of 1844 (7 & 8 Vic., chap. 69, secs. 2 and 3).

(*a*.) The word patentee includes assignee or assignees from the person to whom the patent is granted (see section 46, *infra*, p. 176).

(*b*.) See sub-section 6.

(*c*.) All facts relating to the patent and to the title of the person applying for an extension of a patent must be fully and fairly stated in the petition; if not so stated, the application runs the risk of being refused—*Re Pitman's Patent* (8 Moore's P. C. C., N. S., 293; L. R., 4 P. C., 84)—or postponed—*Re Hutchinson's Patent* (14 Moore's P. C., 364); see also *re Johnson's Patent* (8 Moore's P. C. C., N. S., 282; L. R., 4 P. C., 75).

(*d*.) See sub-section 5.

(*e*.) A "caveat" is a notice of objection.

(*f*.) "*Nature and merits of the invention.*" There must be inventive merit and a benefit to the public—Lord Brougham *in re Derosne's Patent* (4 Moore's P. C. C., 416; 2 Webster's Pat. Cases, 1); *re Soames' Pat.* (1 Webster's Pat. Cases, 735); *re Muntz's Pat.* (2 Webster's Pat. Cases, 113); *re Betts's Pat.* (1 Moore's P. C. C., N. S., 49; 7 L. T. Rep., N. S., 577); *re Hill's Patent* (1 Moore's P. C. C., N. S., 258). Non-user of a patent is a presumption against utility—Lord Chelmsford *in re Bakewell's Patent* (15 Moore's P. C. C., 385); see also *re Saxby's Patent*, per Lord Cairns (7 Moore's P. C. C., N. S., 82).

(*g*.) "*Profits.*" Meritorious invention, large expenses, and no return—*Re Bates's Pat.* (1 Webster's P. C., 739). Inadequate returns for meritorious invention—*Re Downton's Pat.* (1 Webster's P. C., 565). Expense of litigation, cost of patents, expense of bringing invention into use, and manufacturer's fair remuneration to inventor for his personal loss of time, may be deducted in estimating profit—*Re Galloway's Pat.* (1 Webster's P. C., 724; 7 Jur., 453); *re Carr's Patent*

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(4 L. R., P. C., 539). Accounts must be clear, or application refused—*Re Clarke's Pat.* (7 Moore's P. C. C., N. S., 255). Profits resulting from manufacturing considered—*Re Muntz's Pat.* (2 Webster's P. C., 121); *re Saxby's Pat.* (7 Moo. P. C. C., N. S., 82). Profits made in foreign countries considered—*Re Johnson's Pat.* (8 Moore's P. C. C., N. S., 291). Question, not merely what patentee has received, but what patentee has gained, or ought to have gained with proper management—*Re Trotman's Pat.* (L. R., 1 P. C., 11; 3 Moore's P. C. C., N. S., 488).

(h.) "All the circumstances of the case." Difficulty in introducing invention from want of capital—*Re Downton's Pat.* (1 Webster's P. C., 565). Delay in working—*Re Patterson's Pat.* (6 Moore's P. C. C., 469); *re Norton's Pat.* (1 Moore's P. C., N. S., 339). Negligence in restraining infringement—*In re Simister's Patent* (4 Moore's P. C. C., 164; 1 Webster's P. C., 721). Whether applicant assignee from inventor—*Re Whitehouse's Pat.* (2 Moore's P. C. C., 496; 1 Webster's P. C., 473); *Russell v. Ledlam* (14 M. & W., 574; Exch. Ch. 16 M. & W., 633; 1 H. L. Cas., 687). In these cases extensions granted to assignees on terms of paying annuity to inventor. Whether imported inventions—*Re Soames' Pat.* (1 Webster's P. C., 733).

(i.) *Restrictions.* The Crown is always represented by the Attorney-General at the hearing of applications for extensions of Letters Patent, and occasionally, on his representations, extensions have been granted on the terms of the Crown having a free use of the invention. Section 27, *infra*, may have an effect upon this practice, and other restrictions have sometimes, although rarely, been imposed.

(k.) "Conditions and Provisions." Such as that noticed above in Note (h), when extension granted to assignee on condition of his paying the inventor an annuity during the extended term; that the patented articles should be sold to the public at a certain price—*Re Hardy's Pat.* (6 Moore's P. C. C., 441);—that licenses should be granted on certain terms—*Re Mallett's Patent* (4 Moore's Pat. C. C., N. S., 175; L. R., 1 P. C., 308); see also *re Bodmer's Pat.* (8 Moore's P. C. C., 282); *re Normandy's Pat.* (9 Moore's P. C. C., 452).

(l.) *Rules of Procedure.* No rules have, as yet, been issued by the Privy Council under this section. The existing rules consequently remain in force. They can be obtained on application to the Privy Council Office.

(m.) "Costs" are given to successful opposer—*Westrupp and Gibbins' Patent* (1 Webster's P. C., 554); but not if opposition needlessly prolonged—*Re Muntz's Pat.* (2 Webster's P. C., 122); *re Honiball's Pat.* (9 Moore's P. C. C., 378).

Costs are given to applicant where the opposition has been groundless—*Re Downton's Pat.* (1 Webster's P. C., 567).

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*Revocation.*

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

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

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

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

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

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

(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 (e).

(5.) The plaintiff must deliver with his petition particulars (d) 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 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.

## Sect. 26.

(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 (e).

**Note.**—The proceeding by *scire facias* to repeal a patent, has been practically disused for a great number of years. Letters Patent were granted by the sovereign; and the sovereign could and ought to repeal his grant of anything which should not have been granted. Therefore, we find it laid down by Coke “That when the King granteth anything that is grantable upon a false suggestion, the King by his prerogative *jure regio*, may have a *scire facias* to repeal his own grant,” and that “when the King doth grant anything which by law he cannot grant, he *jure regio*, for advancement of justice and right may have a *scire facias* to repeal his own Letters Patent” 4 Institute, 88. A patent for an invention was always granted upon the representation that the applicant was the true and first inventor; if he were not, the patent was granted upon a false suggestion. A patent could only be granted for a new invention. If the invention were not new the patent was granted for that, which by law, the King could not grant. The proceeding by *scire facias* was one taken in the name of the Crown by leave of the Attorney-General, and the writ was issued out of the Court of Chancery, because it was to cancel an instrument sealed by the Lord Chancellor. The learning upon the subject will be found in Hindmarch on Patents, chap. X., section 6. The proceedings were antiquated and cumbrous, and numerous conditions were required from the prosecutor such as requiring him to obtain the fiat of the Attorney-General, and to give security for the payment to the defendant of his costs in the event of the latter succeeding. And since the pending of a *scire facias* was no objection to a disclaimer being filed, since the Act of 1835, authorising disclaimer the proceeding was always liable to be defeated by a disclaimer being allowed and filed before the suit could be brought to trial. The form of proceeding fell, therefore, into complete disuse, and it is now at length abolished and another and simple one substituted for it by the present section. No change, however, is made in the principles of law, it is the procedure, and the procedure only, which has been altered.

(b.) The Court is Her Majesty's High Court of Justice in England—(section 117, *infra*).

Note.  
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In Scotland the Court is any Lord Ordinary of the Court of Session—(section 111); and the proceeding shall be in the form of an action of reduction at the instance of the Lord Advocate, or of a person having interest, with the concurrence of the Lord Advocate—(section 109). In Ireland “the Court” is the High Court of Justice in Ireland.

(c.) The proceeding by revocation being created by this section, no person except those named in it will be able to avail themselves of it. The class of persons who appear most likely to avail themselves of the proceeding are those named by clauses (c) and (d), because of the provision in sub-section 8.

(d.) This repeats section 41 of 1852 (Act 15 & 16 Vic., c. 83); see also as to particulars of objection the notes to section 29, *infra*.

(e.) This is an improvement upon section 10 of the Act of 1852. It will render the proceeding by petition for the revocation of a patent the appropriate remedy for an inventor whose invention has been robbed from him by another, who has obtained a patent therefor; for it enables the former, upon succeeding in obtaining the revocation of a patent granted to the latter upon that ground, to become the owner of the patent, in the place of the fraudulent patentee.

### *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 (a). Patent to bind Crown.

(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 (b), 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.

**Note.**—(a) This is an important change in the law.

For many years the impression prevailed that a patent did bind the Crown, and the Letters Patent themselves always contained a proviso that, if the patentee or his assigns should

**Note.** not supply for the service of the Crown such articles as might  
**Sect. 27.** be required upon such reasonable terms as should be settled by the  
 — officers requiring the same, the patent should cease, and become  
 void. But, in 1833, in the case of a patent for anchors, the  
 Admiralty used the invention, but did not take the article from  
 the patentee, or pay him any remuneration. He applied to  
 the Queen's Bench for a mandamus to the Admiralty to settle  
 the terms according to the patent; but his application was  
 refused, the judges holding they had no jurisdiction to grant it—  
*Ex parte Perry* (1 A. & E., 319; 6 N. & M., 472). And in 1865,  
 it was held that the Crown might use a patented invention  
 without the assent of, and without remuneration to, the  
 patentee, on the grounds the grant of a patent (1) was simply  
 an exercise of the prerogative; and (2) that the infringement of  
 a patent was a wrongful act or tort, and that no wrongful act  
 can be alleged against the Crown—*Peather v. The Queen* (6 B.  
 & S., 257; 35 L. J., Q. B., 200). But, in 1875, it was held that  
 the right of the Crown did not extend to contractors supplying  
 the patented article to, and indemnified against, the patentee by  
 the Crown—*Dixon v. London Small Arms Co.* (L. R., 10 Q. B.,  
 130; 31 L. T., N. S., 830). This decision was reversed in the  
 Court of Appeal (L. R., 1 Q. B., 381), but was afterwards  
 affirmed, overruling the Court of Appeal, by the House of  
 Lords (L. R., 1 App. Cas., 632), who considered *Peather v.*  
*The Queen* rightly decided, but not to be extended.

The decision of *Peather v. The Queen*, above cited, was  
 much canvassed, and created great satisfaction among the in-  
 ventors, and it was not the practice of the Government  
 to frequently avail themselves of it; its doctrine is now  
 definitely abolished by the above section, with the qualification  
 contained in sub-section 2. This section was not in the first  
 draft of the Bill, and was inserted principally, it is believed,  
 in consequence of the representations made by the Society of  
 Arts.

Section 116, which enacts that nothing in the Act shall  
 abridge or prejudicially affect the prerogative of the Crown  
 in relation to the granting or withholding of any Letters  
 Patent, must be considered in relation with the above section.  
 The principle regulating Crown grants that that which appears  
 from its wording to be a general privilege and a general  
 prohibition, must be read with an exception in favour of the  
 Crown itself—Lord Cairns in *Dixon v. London Small Arms*  
*Co.* (L. R., 1 App. Cas., 641), is, by the above section, declared  
 to be no longer applicable to patents for inventions, so that a  
 patent when granted in ordinary terms will bind the Crown.  
 But there is nothing to prevent the Crown from inserting in

the patent a condition that the Crown shall use the invention without payment, or any other restrictive clause.

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*Sub-section 2.* "On terms to be before or after the use thereof agreed on." The effect of this is that the officers or authorities in the sub-section referred to, may use the invention without having first agreed with, or obtained the leave of the patentee. If it be so used, the remuneration is to be agreed subsequently with the patentee, or, in default of agreement by the Treasury after hearing all parties interested. This provision will provide for the case of an emergency in which the delay of negotiation might be prejudicial to the public service. Security is provided for the inventor by requiring the Treasury to hear his representations.

#### *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 (*a*), specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury (*b*) 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 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 (*c*).

**Note.**—(*a*.) This provision is in addition to the powers already possessed by the Court under section 57 of the Judicature Act of 1873.

(*b*.) The intention appears to be to have patent cases tried without a jury, except in exceptional circumstances. It is apprehended a strong case will have to be made out to induce the Court to order a trial with a jury. Still cases, where the issue is one of fraud, such as may occasionally arise in patent cases, such as whether A stole the invention from B, and fraudulently obtained a patent for it, the appropriate tribunal will still be a jury. Since the coming into operation of the Judicature Rules of 1875, the usual course has been to try patent cases before a judge without a jury.

(*c*.) Apparently by the Treasury.

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Delivery  
of parti-  
culars.

**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 (*a*).

(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 (*b*).

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it (*c*), 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 (*d*).

(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 (*e*).

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

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

**Note.**—This section simply re-enacts the provisions contained in sections 5 and 6 of the Act of 1835 (5 & 6 Will. IV., chap. 83), and 41 and 43 of that of 1852 (15 & 16 Vic., chap. 83).

(*a*.) *The Particulars of breaches* should give defendant full and fair notice of the complaint made against him—*Needham v. Oxley* (1 H. & M., 248); see also *Curtis v. Platt* (8 L. T., N. S., 657). Patent for obtaining pictures or representations of objects. Particulars of breaches charged infringement generally by selling pictures; and further, “that one of such pictures was made and sold by defendant to A. H. C., on 27th April, 1854,” but plaintiff said that he stated this by way of example only, and not so as to preclude himself at trial from insisting on other infringements. These particulars were held sufficient—*Talbot v. Laroche* (15 C. B., 310). Where action for infringement of patent for cartridges, the patented cartridge was made an



exhibit to the particulars of breaches; they were held sufficient—*Batley v. Kynoch* (L. R., 10 Eq., 229; 44 L. J., Ch. 219). Patent for manufacture of pens: the specification described thirteen improvements, referring to them by numbers; the Court ordered plaintiff to give defendant particulars of the number of the improvements of which infringements were alleged—*Perry v. Mitchell* (1 Webster's P. C., 269).

Note.  
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The Plaintiff's particulars of breaches cannot be called in aid of the defects in defendant's particulars of objections—*Palmer v. Couper* (9 Exch., 231).

The plaintiff may be ordered to point out, by reference to the pages and lines thereof, the parts of the specification he alleges to be infringed—*Lamb v. Nottingham Manufacturing Company* (Seton on Decrees, 4th Ed., Vol. I., 349).

(b.) In the defendant's *particulars of objection* a considerable degree of particularity is required, greater even than that required in the plaintiff's particulars of breaches. Under a plea of want of novelty, the Court requires the particulars of objections to give particular instances, because the defendant must know whether, and in what respect, he has infringed—per Jervis, C. J., *Talbot v. Laroche* (15 C. B., 310). Their object is to limit expense to parties, and more especially to prevent patents being upset by some unexpected turn of the evidence—*Fisher v. Dewick* (4 Bing., N. C., 706; 1 Webs. Pat. Ca., 264); the particulars in this case were held insufficient. In *Jones v. Berger* (5 M. & G., 208; 1 Webs. Pat. Ca., 544), the particulars delivered alleged prior user at Nottingham *and elsewhere*. Held insufficient. In *Curtis v. Platt* (8 L. T., N. S., 657), the particulars delivered were:—1. Prior user by certain persons specified and others not named; 2. Prior user by thirteen persons or firms, from 1825 downwards, giving merely the places of residence of the persons referred to; 3. Prior publication in books, &c., with a general reference. Further and better particulars of the second and third heads were ordered to be delivered.

In *Lister and another v. Leather* (8 E. & B., 1004), the particulars alleged that the patent sued upon was not new, having been anticipated by other patent previously granted to the plaintiff's themselves, between 1st January, 1849, and the 20th March, 1850. At the trial the judge refused, under these particulars, to admit in evidence against the plaintiff's a patent granted to them in 1849.

In *Morgan v. Fuller* (L. R., 2 Eq., 296), the particulars were:—

1. Prior user by carriage builders generally;
2. . . . By various carriage builders in or near London,

Note.  
Sect. 29.

Liverpool, Manchester, Southampton, and various other principal towns in Great Britain and amongst other carriage builders, by Messrs. Thorn, of Great Portland Street, London ;

3. Prior user of the mode described in the specification in various mechanical combinations, applied to various matters and purposes ;
4. That "parts" of the combination claimed had not been invented by the plaintiff ;
5. That "parts" of the said combination, if so invented, were not particularly described.

On application made, the defendant was ordered to deliver further and better particulars of objection.

In *Palmer v. Wagstaffe and another* (8 Exch., 840), the particulars alleged a prior user of the invention by plaintiff and other persons mentioned at certain places specified, and by candle makers generally, in London and its vicinity ; and were held sufficient. Baron Alderson said :—“ A defendant may rely “ either on a specified user by certain persons named, or on a “ general user, by all persons at a particular place ; in the former “ case, if he proves a user by any one of the persons named that “ will support his objection ; but if he rests his case on a general “ user, proof of a user by one person will not do. The more “ general the statement is the more the defendant must prove “ under it.”

In *Plimpton v. Spiller* (20 Solicitor's Journal, 859), by Field, J., an objection alleged the surrender of a previous United States patent, and a previous publication of the invention in certain journals of specified dates, and in sketches and drawings in the library of the Patent Office. This held insufficient, and the defendant was required to set out the date of the United States patent, the name of the patentee, the date of the alleged surrender, the pages of publication, and to identify the drawings.

In *Palmer v. Cooper* (9 Exch., 231) the defendant pleaded that the patent was obtained by fraud and misrepresentation. It was held he ought to state in his particulars of objection what the fraud and misrepresentation was.

If the particulars of objection are not sufficiently full, the plaintiff should apply at Chambers for an order for the delivery of fuller and better particulars of objection. If he omits to do so, he cannot object to their generality at the trial. The only question then will be whether the particulars actually delivered include the evidence tendered by the defendant—*Neilson v. Harford* (8 M. & W., 806 ; 1 Webs. P. C., 331) ; *Hull v. Bolland* (1 H. & N., 134).

(c.) That is—insufficiency of specification, obtained by fraud, &c.

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(d.) In *Crossley v. Toney* (L. R., 2 Ch. D., 533); and *Flower v. Lloyd* (20 Solicitors' Journal, 860, by Field, J.); it was held that an order, under the same words, in section 41 of the Act of 1852, was not sufficiently complied with, by giving merely the places of the user, without giving also the names and addresses of the persons alleged to have used the invention. Under that section, the date of the alleged infringement was not required to be given. This omission is now corrected.

(e.) *Leave of the Court or a Judge.* The leave would only be granted, in all probability, upon the terms of having to pay the costs of an adjournment to enable the plaintiff to prepare to meet the amended objections. The Courts always exercised the discretion to amend the particulars—See *Renard v. Levinstein* (13 W. R., 229; 11 L. T., N. S., 505), where payment of the costs of the motion to amend the particulars, and of any extra costs occasioned to the plaintiff by the introduction of the fresh evidence whatever might be the result of the trial were the conditions imposed; and *Daw v. Eley* (L. R., 1 Eq., 38) where permission was refused.

(f.) A defendant was always permitted at any time before trial to amend his particulars of objections upon terms as to payment of costs—*Penn v. Bibby* (L. R., 1 Eq., 548).

(g.) The judge has no power to grant such a certificate after taxation—*Gillett v. Green* (7 M. & W., 347).

The defendant will not be entitled to the costs of his particulars of objections, even in the case of a nonsuit, if the judge has not certified for them—*Honitall v. Bloomer* (10 Exch., 538). The certificate should be as to the determination of each objection of which notice has been given, and not as to the issues—*Tosh v. Hague* (5 M. & W., 387).

If plaintiff gives notice of trial, which is afterwards abandoned, the defendant is entitled to the costs of preparing the particulars of objection, and the evidence in support of them, without the certificate of the judge, as section 43 of the Act of 1852, of which the above sub-section is a copy, referred only to cases where there had been a trial—*Greaves v. Eastern Counties Railway Co.* (1 El. & El., 961).

**§0.** 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 (a) inspection (b) or account (c), and impose such terms and give such directions respecting the same, and the proceedings thereon, as the Court or a judge may see fit (d).

Order for  
inspec-  
tion, &c.,  
in action.

**Note.**  
**Sect. 30.**  
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**Note.**—This section repeats section 42 of the Act of 1852.  
(a.) *Injunction* (interim or interlocutory). The principle on which the Court acts is that where a patent has been granted and there has been an exclusive possession of some duration under it, the Court will interpose its injunction without putting the party previously to establish the validity of his patent. But where the patent is but of yesterday, and upon an application being made for injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will require the plaintiff to establish the validity of his patent before granting him the benefit of an injunction—Lord Eldon, *Hill v. Thompson* (3 Mer., 622).

“The Court can grant an injunction before the hearing when  
“ the patent is an old one, and the patentee has been in long  
“ and undisturbed enjoyment of it, or when its validity has  
“ been established elsewhere, and the Court sees no reason to  
“ doubt the propriety of the result; or when the conduct of  
“ the defendant is such as to enable the Court to say that, as  
“ against him, there is no reason to doubt the validity of the  
“ patent”—Sir Geo. Jessell, M. R., *Dudgeon v. Thomson* (30  
L. T., N. S., 244); *Renard v. Ierinstein* (10 L. T., N. S., 177).  
Knight Bruce, L. J.:—“I think the sufficiency and validity of  
“ the specification is matter of serious doubt. The consequence  
“ is that, with a patent no older than the present, though its  
“ age is no objection to an interlocutory injunction of itself, in  
“ the present stage of the cause there ought to be no injunction.”

In order to obtain an interlocutory injunction on the ground that the patent has not been infringed for many years, the patentee must show actual public user by him of the invention—*Plimpton v. Malcolmson* (L. R., 20 Eq., 37).

Where a patent has been upheld in former litigation, an interlocutory injunction will be granted, notwithstanding fresh facts are brought forward to impeach its validity—*Ducenport v. Jepson* (4 De G. F. & J., 440); *Newall v. Wilson* (2 De G. M. & G., 282).

If plaintiff has been negligent in prosecuting his rights, even though a strong case otherwise is made out, an interlocutory injunction will not be granted—*Bridson v. Benecke* (12 Beav., 1); *Bovil v. Crate* (L. R., 1 Eq. 388).

If the alleged infringement be doubtful, an interlocutory injunction will be refused—*Electric Telegraph Co. v. Nott* (2 Coop. C. C., 41).

In cases, however, where the Court refuses an interlocutory injunction—that is, an injunction restraining the defendant from the use of the invention pending the trial of the Act—it orders the defendant to keep an account of the profits obtained by the defendant from using the invention; and if an interlocutory injunction be granted, an undertaking is required by the Court to abide by any order the Court may make as damages, if it should appear that defendant has sustained any in consequence of the injunction—*Wakefield v. Duke of Buccleugh* (11 Jur., N. S., 523).

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The practical result of the authorities is, that interlocutory injunctions restraining the defendant from using the invention he is alleged by the plaintiff to have infringed, will rarely now be granted unless the infringement is absolutely without colour of excuse, or the validity of the patent has been previously established. In an application for an interlocutory injunction the Court usually orders it to stand over until the trial of the action; requiring the defendant meanwhile to keep an account of his receipts and profits—*Vide* Sir Geo. Jessell, *Plimpton v. Malcolmson* (L. R., 20 Eq., 37).

It is none the less advisable for the plaintiff to apply for such an interlocutory injunction nevertheless, because the order usually made is very much in his favour. After a trial resulting in the plaintiff's favour, an injunction restraining the defendant from infringing the plaintiff's patent will follow almost as a matter of course, upon application being made for it.

Although it is a rule of the Court not to interfere unless the patentee's rights has been actually violated, yet, where the defendant evinces an intention and claims the right to infringe, the Court will grant an injunction, although no actual infringement may be shown—*Frearson v. Loe* (L. R., 9 Ch. D., 48); *Crossley v. Beverley* (1 W. P. C., 119).

*Final Injunction.* If at the trial the plaintiff succeeds, he will be entitled to an injunction restraining the defendant from infringing his patent, and this in addition to his right to recover damages for the infringement, or to have an account of the profits made by the defendant from the infringement. The Court may also order the destruction of machines made in infringement of a patent—*Betts v. De Vitre* (34 L. J., Ch. 289-291); *Tungye v. Stott* (14 W. R., 386); see also *Needham v. Oxley* (8 L. T., N. S., 604); *Plimpton v. Malcolmson* (Seton, on Decrees, 4th Ed., p. 354); *Frearson v. Loe* (L. R., 9 Ch. D., per Sir Geo. Jessell, p. 67).

(b.) *Inspection.* It must be shown, upon an application for an inspection, that it is material and really wanted for the purposes of the cause. If that be shown, the application may

**Note.** be made at any time after action, but it is not a matter of right  
**Sect. 30.** —*Amies v. Kelsey* (22 L. J., Q. B., 81); *Morgan v. Sparrow*  
 — (1 Webs. P. C., 167); *Bocill v. Moore* (2 Cooper C. C., 56 n.).  
 It was decided, upon the construction of section 42 of the 1852  
 Act, which was in precisely similar terms to the present section,  
 that the inspection therein mentioned is an inspection of the  
 instruments or machinery manufactured by the parties with a  
 view to evidence of infringement, and does not refer to an  
 inspection of books, as that is provided for otherwise—*Vidi v.*  
*Smith* (3 Ell. & B., 969; 23 L. J., Q. B., 342); see also *Smith*  
*v. G. W. E. Co.* (3 W. R., 69).

The affidavits in support of the application must be distinct  
 to show that the defendant is using the plaintiff's invention. If  
 they are not distinct, and the defendant swears positively that  
 he does not use the invention, the application will be refused—  
*Meatons v. Kirkman* (29 L. J., Exch., 205); *Shaw v. Bank of*  
*England* (22 L. J., Exch., 26).

Inspection will be granted only where the Court is satisfied  
 that this is really a case to be tried, and that inspection is  
 necessary to enable the plaintiff to prove his case—*Piggott v.*  
*Anglo-American Telegraph Co.* (19 L. T., N. S., 46); *Balley*  
*v. Kynoch* (L. R., 19 Eq., 90).

In *Patent Type Foundry Company v. Walter* (Johns. 727),  
 Wood, V. C., ordered the defendant, a printer, who used types  
 alleged to be made in infringement of the plaintiffs' patent, to  
 deliver a sample of his type to the plaintiffs for analysis. But  
 a similar application was refused by the Court of Exchequer,  
 since it entertained doubts as to whether section 42 of the Act  
 of 1852 enabled them to order articles to be given up for  
 analysis—*Patent Type Foundry Co. v. Lloyd* (5 H. & N., 192).

On an application to inspect *all machines* upon defendant's  
 premises, the Court refused, but ordered the defendant to verify,  
 on affidavit, the *several kinds* of machines sold by him, and to  
 produce one of each class for inspection by the plaintiffs—  
*Singer Manufacturing Co. v. Wilson* (5 N. R., 505; 13  
 W. R., 560).

An order for inspection cannot be granted where the alleged  
 piracy has taken place abroad—*Neilson v. Betts* (L. R., 5  
 H. L., 1).

Laches sufficient to defeat the plaintiffs' right to an inter-  
 locutory injunction is no ground for refusing an order for in-  
 spection—*Patent Type Foundry Co. v. Walter* (Johns., 727).

(c.) *Account.*—Interlocutory. On reasonable evidence of  
 the validity of the patent, and of its having been infringed,  
 being given, the Court will order the defendant, pending the  
 action, to keep an account of all the articles that he sells or

makes upon the principle alleged to be an infringement of the plaintiff's patent, and of the profits arising therefrom, until further order of the Court, on condition that if, in case the verdict and judgment in the action be in favour of the defendant, the plaintiff will pay the defendant the expense of keeping such account—*Vidi v. Smith* (3 El. & Bl., 969).

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*Final Account.* The plaintiff may sue, at his option, for either the damages he has sustained by the infringement of his patent by the defendant, in which case such damages will be assessed by the Court, or for an account of the profits which the defendant has made by selling the patented article, in which case the defendant will be ordered to pay over the amount of such profits to the plaintiff—*Neilson v. Betts* (L. R., 5 H. L., 1); *De Vitre v. Betts* (L. R., 6 H. L., 319); *Sarby v. Easterbrook* (L. R., 7 Exch., 207); *Holland v. Fox* (23 L. J., Q. B., 357); *Ellwood v. Christy* (18 C. B., N. S., 494); *Walton v. Incester* (8 C. B., N. S., 162); *Duceport v. Rylands* (L. R., 1 Eq., 302).

The account extends over the six years immediately preceding the commencement of the action, and there must be no delay in applying for same—*Kernot v. Potter* (3 De G. F. & J., 417). If the plaintiff be an assignee, the account will only be taken from the date of the complete assignment to him—*Ellwood v. Christy* (5 N. R., 312).

It is apprehended that, if the action be in form for damages, yet the plaintiff may, at any time before the actual assessment of the damages, convert his claim for damages into one for an account.

If a person adopts a part only of the patentee's invention, he will be liable to account—*Trotman v. Wood* (16 C. B., N. S., 479).

The account may be taken notwithstanding the pendency of an appeal—*Sarby v. Easterbrook* (L. R., 7 Exch., 207).

Where separate proceedings have been taken against the *manufacturer* and the *user* of the patented article, the plaintiff may have an account of profits against the manufacturers, and also damages against the user—*Penn v. Bibby* (L. R., 3 Eq., 308). As to the way profits are reckoned, see *Penn v. Jack* (L. R., 5 Eq., 81).

(*d.*) The words "impose such terms" are not in section 49 of 1852 Act. The Courts, however, have always imposed such terms as seemed just.

**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

Certificate  
of validity  
ques-  
tioned,

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and costs  
thereon.

certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

**Note.**—This section practically re-enacts the powers conferred by section 3 of the Act of 1835, and section 43 of the Act of 1852, now repealed.

Under section 3 of the Act of 1835 it was held that where the defendant pleaded that the invention was not new, and a verdict was given for the plaintiff, that the validity of the patent might be considered to have come in question under the plea, and the plaintiff was entitled to the certificate to that effect—*Gillet v. Wilbey* (9 C. & P., 334).

Where the defendant, at the trial, consented to a verdict for the plaintiff, without any evidence being given by the former, the Judge refused to certify that the validity of the patent came in question before him, since such certificate might affect third parties, and might, in that manner, be collusively obtained—*Stocker v. Rodgers* (1 C. & K., 99).

A patentee, who has obtained this certificate, is entitled to his full costs, if successful, in any subsequent action for *infringement*, although the *validity* of his patent may not be questioned in such action—*Davenport v. Rylands* (L. R., 1 Eq., 302; 35 L. J., Ch. 204).

The judge has no power to grant this certificate after taxation—*Gillett v. Green* (7 M. & W., 347). It should be applied for at, or immediately after, the trial.

As to what is a sufficient certificate, see *Belts v. De Vitre* (11 Jur., N. S., 11); *Bovill v. Hudley* (17 C. B., N. S., 435; 10 L. T., N. S., 650).

Remedy  
in case of  
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threats of  
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proceed-  
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**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. Sect. 32.  
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**Note.**—This provision is not to be found in any preceding Act of Parliament. It is intended to settle the law upon a question as to which the cases have been somewhat conflicting.

In 1869, in the case of *Wren v. Wield* (L. R., 4 Q. B., 730), some plaintiffs had brought an action, alleging that the defendant wrote to and told persons who had bought machines of the plaintiffs, that such machines were infringements of the defendant's patents; that he, the defendant, claimed royalties for the use of the machines, and that if the plaintiffs used the machines without paying royalties he should take proceedings against them. The plaintiffs, at the trial, offered to prove that the defendant's patent was invalid, by giving in evidence various specifications and machines existing before the date of the defendant's patent, in order to show that the defendant's specification claimed matters that were not new, and by showing also that the defendant had used them. The judge, at the trial, ruled that as the defendant's patent was still subsisting, and not set aside by *scire facias* or otherwise, the evidence was immaterial and inadmissible, and directed a nonsuit. On a motion for a new trial, the Court of Queen's Bench held, in a very elaborate and learned judgment, delivered by Lord Blackburn, that 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 latter warning of his intention, and that no action lies for giving such preliminary warning, unless it can be shown either that the threat was made *malâ fide* with intent to injure the vendor, and without the purpose to follow it up by an action against the purchaser, or that the circumstances were such as to make the bringing an action altogether wrongful.

In 1872, the case of *Rollins v. Hinks* (L. R., 13 Eq., 355), was decided by Vice-Chancellor Malins. The plaintiff, in September, 1871, purchased a number of lamps, manufactured with a burner according to a United States patent, dated 1869, published in this country in August, 1861, and advertised them, as "The American Double Wick Lamp Burner," largely. The defendants were the owners of an English patent, dated 1865, for an invention called "The Duplex Lamp," which also contained a double wick. The defendants published advertisements and notices as follows:—"Duplex Lamps.—Our attention has been directed to an announcement that an infringement of our patent is being made in America for sale in this country.

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“Constant threats of these infringements have been held out to us for some time past, to induce us to make arrangements with our rivals. . . . Whenever an actual sale does occur we shall at once proceed by injunction against the offender, and also sue for damages.” Such circulars were repeated. The plaintiff sold the lamps and invited the defendants to proceed against him for infringement, but they refused to do so. The plaintiff’s customers would not buy his lamps in consequence of the defendants’ circulars. The plaintiff applied for an injunction restraining the defendants from publishing this circular. Malins, V. C., held that there is no presumption in law in favour of a patent, and, therefore, a patentee is not entitled to publish statements of his intention to institute legal proceedings in order to deter persons from purchasing alleged infringements of his patents, if he has no *bond fide* intention to follow up his threats by taking such proceedings, and that the Court will, in such case, restrain him from making such publication; and that a person alleging the invalidity of a patent is not bound to assert his claim by *scire facias*, in order to obtain an injunction restraining the publication of such circulars. This decision was not appealed from, although the correctness of the grounds upon which it was decided were much criticised at the time.

In 1874, in the case of *Aemann v. Lund* (L. R., 18 Eq., 330), Vice-Chancellor Malins, following his decision in *Rollins v. Hinks*, decided that the Court will restrain a patentee from issuing circulars threatening legal proceedings against infringers unless he will undertake to commence proceedings to assert the validity of his patent, and further held that the fact of the plaintiff having been a licensee of the defendants, and had concurred in issuing similar notices, did not prevent the Court from granting the injunction.

In 1876, the patent of Hinks & Son, the defendants in the suit of *Rollins v. Hinks*, above noted, was held invalid by Sir Geo. Jessell, M. R.—*Hinks & Son v. Safety Lighting Co.* (L. R., 4 Ch. D., 607).

In 1880, in the case of *Halsey v. Brotherhood* (L. R., 15 Ch. D., 514), Sir Geo. Jessell, M. R., declined to follow the decision of Malins, V. C., in *Rollins v. Hinks*, following *Wren v. Wield*, *supra*, and held that a patent so long as it exists is *prima facie* good, and therefore a patentee who issues notices against purchasing from a vendor is not bound to follow up his notices by taking legal proceedings; and provided he issues the notices *bond fide*, in assertion of what he believes, although 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 : though he may be liable, notwithstanding his *bonâ fides*, to be restrained by injunction from continuing to issue the notices if it be proved in the action for an injunction that his allegation of infringement is untrue.

Note.  
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This decision was appealed from—*Halsey v. Brotherhood* (L. R., 19 Ch. D., 386), and was affirmed.

In 1883, in the case of *Burnett v. Tate* (45 L. T., 743), it was held by Mr. Justice Kay that when a plaintiff brings an action to restrain a defendant from issuing notices to the plaintiff's customers, that the plaintiff, in selling goods, is infringing the defendant's patent rights, it is for the plaintiff to prove that the defendant's statements are false, and if no *malâ fides* is proved, and no damages could be obtained, the Court will not grant the injunction. If, in a judicial proceeding, the statements are found to be false in fact, an injunction would be granted against continuing them, as that would be acting *malâ fide*.

Another case which may be referred to is *Dicks v. Brooks* (L. R., 15 Ch. D., 22).

The new enactment (section 32 above), as will be noticed, adopts the decision of *Halsey v. Brotherhood*, with an important qualification, which must be carefully noted. According to *Halsey v. Brotherhood*, especially in the judgments in the Court of Appeal, the issue of the circular cannot be restrained if the defendant issued them *bonâ fide*, although erroneously, believing his patent to be valid. This rendered a difficult inquiry into the state of his mind necessary, and the necessity for this inquiry is by section 32, abolished. If he issues such circulars, and his patent is not in fact valid ("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"), the injunction against continuing such threats may be granted, and damages recovered.

It is apprehended that since, from the above cases, it must be taken to be clear law that a patent is *prima facie* to be regarded as valid, the onus of showing that the patent is invalid will rest upon the person who alleges its invalidity, that is to say upon the plaintiff in such an action as is authorised by the above section. So much in *Wren v. Field*, above noted, as decided that the invalidity of the patent was immaterial, is also overruled by the above section, which makes it a defence to show that the patent is invalid.

What is "*due diligence*" will depend upon the circumstances of each particular case, and will be a question of fact for the judge, or for the jury if the trial be by a jury. It is apprehended that it will not be difficult to determine what, in the circumstances of each case, is due diligence or otherwise.

*Miscellaneous.*

**Sect. 33.** **33.** Every patent may be in the form (a) in the first schedule to this Act, and shall be granted for one invention only (b), 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.

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Patent for  
one inven-  
tion only.

**Note.**—(a.) See the form *infra* at p. 235. This form is different from the form which has hitherto been used, but the differences do not appear to be of any substantial importance.

With regard to licenses, the old cases will continue to be authorities, and notwithstanding those of *Chanter v. Dewhurst* (12 M. & W., 823), in which some of the judges were of opinion without, however, deciding the point, that a simple license without covenants need not be under seal, and *Chanter v. Johnson* (14 M. & W., 408), that if a license were not by deed it would require no stamp, it will still be necessary that licenses shall be granted by deed, that is under seal—Hindmarch, p. 239. The words in the form of patent are “consent, license, or agreement of the said patentee under his hand and seal.”

(b.) It was formerly the duty of the law officer to see that patent was granted for one invention only, but their practice has varied as to what they have considered to be one invention, and, no doubt, patents have occasionally been granted for more than one invention, but it was never any ground of objection to the validity of a patent when granted, that such was the case. The present enactment makes no change in the law.

It will render it the duty of the examiner and Comptroller (see sections 6 and 7 *supra*), to see that the provisional and complete specification do not contain more than one invention, and if they do, this section will give the Comptroller authority to require the amendment of the specification, so that it shall not contain more than one invention; but should they omit to do so, and the patent be granted for more, it will be no ground of objection to the patent when granted.

It is apprehended that the practice of the examiners, whose exclusive duty it will be to look after the specification, will be stricter than that of the law officers has been upon this point, and that the Comptroller will support them. This may give rise to a little difficulty in practice, as it is by no means an easy matter to determine whether what is included in a specification is only one *invention* or more. Take for instance an application for a patent for improvements in an existing machine, or a process. Here the improvements may be numerous, and except as all applied to one machine or process unconnected;

and capable of use, either separately or in combination : are they *one* invention, or more than one within the meaning of the section? The examiners and Comptroller may not unnaturally take a narrow view. But, since when the Comptroller requires an amendment of a provisional specification (section 7, sub-section 2), or where he refuses to accept a complete specification unless amended to his satisfaction (section 9, sub-section 2), an appeal is provided to the law officer, and the law officers may be expected to take the same view as at present, it may be anticipated that no great practical inconvenience will result.

**Note.**  
**Sect. 33.**

**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 (*a*).

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 (*b*) that he believes such person to be the true and first inventor of the invention.

**Note.**—(*a*.) This provision is a new one. It obviates the hardship of the old law, under which it was decided, in the case of *Marsden v. Saville Street Foundry and Engineering Company* (L. R., 3 Ex. D., 203), that even in the case of a patent granted to the widow and administratrix of an inventor who had died after completing his invention, but before applying for a patent, leaving his invention described among his papers, that the patent so granted was void.

(*b*.) *Legal representative* means either the person who has obtained Letters of Administration to the estate and effects of the deceased ; or if Letters of Administration have not been obtained, the person entitled to them. As to who are the persons entitled to obtain Letters of Administration to the estate and effects of a deceased person, see Williams on Executors, and Coote's Probate Practice.

Sub-section 2, modifies in the case mentioned section 5, *supra*, which enacts that an application for patent must be made in the form set out in the first schedule ; and that every application must contain a declaration that the applicant claims to be the inventor of the invention for which he desires to obtain a patent. No form for such an application is provided in the Pat. Rules, but rule 24 (p. 241) requires that the application shall be accompanied by an official copy of the deceased's Will or of Letters of Administration.

**Sect. 35.**

—  
Patent to  
first in-  
ventor not  
invalida-  
ted by  
applica-  
tion in  
fraud of  
him.

**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.

**Note.**—This section re-enacts the provisions of section 10 of the repealed Act of 1852.

In *re Vincent's Patent* (L. R., 2 Ch., 341), the sealing of a patent was opposed on the ground of previous public use of the invention. The applicant in reply alleged that such use had been obtained by fraud on him within the meaning of section 10 of the Act of 1852. It was held that the patent ought to be sealed, because the allegation of fraud was one which ought to be tried by a jury, and, by refusing to seal the patent, a trial by a jury would be precluded; while, if sealed, it would not.

Assign-  
ment for  
particular  
places.

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

**Note.**—Section 35 of the Act of 1852 provided “That the grantee or grantees of Letters Patent may assign the Letters Patent for England, Scotland, or Ireland respectively, as effectually as if the Letters Patent had been originally granted to extend to England, or Scotland, or Ireland only.” This section was introduced into the Act of 1852 because, up to the passing of that Act, separate patents were granted on separate applications for:—(1) England and Wales; (2) Scotland; and (3) Ireland. Now the provision is, the patentee may assign for any “place or a part of,” upon the principle that the greater includes the less. A patentee possessing the sole privilege for the United Kingdom, might always have assigned his right to exercise it in any particular place or places in a part or parts of the United Kingdom. The above section somewhat unnecessarily affirms that right.

Loss or  
destruc-  
tion of  
patent.

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

**Note.**—This section re-enacts section 22 of the repealed Act of 1852, which related, however, only to the case of the

loss or destruction of the patent. The new provision also extends to the case of non-production accounted for to the satisfaction of the Comptroller. **Note.**  
**Sect. 37.**

By No. 30 in the List of Fees given in the first schedule to the Pat. Rules (p. 256), the fee payable for a duplicate patent is £2.

**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. Proceedings and costs before law officer.

**Note.**—“*Costs.*” Section 11 of the Act of 1852 contained a similar provision as to costs. Section 47 of that Act entitled the law officers to be paid, as part of the costs provided by section 14, such fees for the hearings in cases of opposition and disclaimer, as the Lord Chancellor and the Master of the Rolls should appoint. By an order of Lord St. Leonards, C., and Sir John Romilly, M.R., dated 1st Oct., 1852, certain fees were appointed; and these fees have continued to be paid to the Crown, and not directly to the law officers, since the payment of fixed salaries. No provision is to be found in the present Act for the fees payable in proceedings before the law officers, unless it be in that part of the above section authorising the law officer to make rules regulating the practice and procedure before them. The law officers have made some rules which will be found printed at p. 253, but they have not up to the present published any list of the fees payable to them.

**39.** The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade (a), 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 (b), 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 (c), shall not prejudice the right of the inventor or his legal personal Exhibition at industrial or international exhibition not to prejudice patent rights.