

and refusals are frequent on account of its absence. The mark must not only be distinctive—*i.e.*, noteworthy in itself—but it must also be distinctive as compared with other existing marks.

The word “device” relates to a picture, such for example as a representation of some real or imaginary animal, or a geometrical or other figure, or crest, or in some cases a portrait (*Rowland v. Mitchell* [1897], 1 Ch. 71; 14 R. P. C. 37). It seems that “device” does not include a word or arrangement of letters however distinctively combined (*ex parte Stephens* [1876], 3 Ch. D. 650). Device.

It has been held in America that “marks” or lines on an article for a useful purpose—such, for example, as marking tobacco or edibles into squares or figures for the purpose of easy and exact subdivision—cannot be claimed as exclusive trade marks (*Dansman v. Ruffner*, 15 U. S. Pat. Gaz. 559). Marks.

It was at one time possible to register pictorial representations of the goods as trade marks to be applied thereto; but the Comptroller will not now accept such pictorial representations as registrable trade marks (see Official Order in *Trade Marks Journal*, No. 570, 27th February, 1889). Representations of goods.

It may be taken that initials printed in the ordinary non-distinctive manner are not registrable as trade marks, but initials arranged as a monogram or design of a sufficiently distinctive character, and especially when combined with some device, are usually accepted by the Comptroller. Initials.

A “brand” is a mark for branding on corks, casks, butter-tubs, and the like. A “brand” is also applied to metal goods in bar and pig form, these goods being generally spoken of as under a particular “brand.” Brand.

“Heading” is a technical name best known in the Manchester trade, and used to designate coloured or other stripes, or combinations of stripes, woven or printed, as headings or narrow borders upon the selvages or ends of piece goods. Registration of such “headings” is now possible only in the case of combination old marks, and even with old marks registration is extremely unlikely. It is certain that no new mark would now be registered Heading.

which consists only of coloured stripes or arrangements of stripes as a "heading" to piece goods. An application for such a mark would be refused for lack of distinctiveness. "Heading" has also been interpreted as an additional and auxiliary label applied above the ordinary label upon which the chief mark is printed, but its recognised and usual meaning is that known in the Manchester trade.

**Label.** "Label" clearly refers to adhesive papers bearing the trade mark and capable of being stuck upon bottles, jars, cases, packets, and the like.

**Ticket.** "Ticket" describes the case of a mark impressed upon a piece of material, such as pasteboard or metal, and loosely attached to the goods. The examples which most readily suggest themselves are the tickets pinned to the wares of a fancy goods dealer or a clothier.

**Invented words.** **Fourthly. — (b) An invented word or invented words.**

**No fancy words under Trade Marks Act, 1875.** The Trade Marks Acts, 1875 to 1877, excluded fancy words from registration. The Patents Act, 1883, permitted the registration of fancy words not in common use.

**Fancy words under the Act of 1883.** A fancy word has always been a favourite form of trade mark, since it is available not only to sight, but to speech, hearing, and memory. As a result of the Act of 1883 so many applications were received for the registration of fancy words, most of them both descriptive and laudatory of the goods, that the Courts were obliged to restrict and narrow the construction of the term "fancy word."

**In re Van Duzer.** In the leading case on the subject (*in re Van Duzer* [1887], 4 R. P. C. 31; 34 Ch. D. 623) it was finally decided that a fancy word, to be capable of registration, must be a word having no meaning at all to the average Englishman, such for example as the word "Acilyton": a word which, as Lopes, L. J., put it, was so obviously inappropriate to the goods as neither to be deceptive nor descriptive. "Melrose" was the word which Van Duzer wished to register as a trade mark for hair restorer; and the Court of Appeal held it to be geographically descriptive and deceptive. On the same day the Court considered *Leaf's Application* ([1887] 4 R. P. C. 31), which was for registration of the word

"Electric" as applied to velveteens. This word the Court considered descriptive, although why is not at the present day very obvious. At all events, both applications were refused on the ground that the words were not fancy words within the meaning of the Act.

These "fancy word" cases were decided in 1887. In 1888 was passed the amending Act, which substituted "invented" words for "fancy" words. Undoubtedly the Legislature intended the Act to relieve the Court of the burdensome consideration of "fancy words." But the Courts at first showed no inclination to part from the traditions and currents of thought set up by their bygone contests with fancy words. The House of Lords has intimated in the "Solio" Case that the decisions before the Act of 1888 afford no assistance in the construction of Sub-sections (D) and (E), but this direction was only given in 1898. In 1890, two years after the amending Act, in *Meyerstein's Application* ([1890] 7 R. P. C. 114), Mr. Justice Kay refused registration of the word "Satinine" for starch, as being descriptive of the effect produced, and no doubt the decision will bear defending; although it should be pointed out that in Sub-section (D) there is no qualification at all attached to "invented" words. This decision strengthened the hands of the Patent Office authorities in their reading of Sub-section (D), which was that it should be qualified by the words attached to Sub-section (E)—viz., that "invented" words should have no reference to the character and quality of the goods. By this mistaken practice all the troubles due to the old "fancy" words clause were revived. The Trade Marks Office proved itself ingenious beyond all computation in discovering hidden references to the character and quality of the goods, in words which to a plain business man were guiltless either of the one or of the other. The Courts showed no inclination to check a practice which was certainly annoying and was rapidly becoming harmful, for in the *Farbenfabriken Application* ([1894] 1 Ch. 645; 11 R. P. C. 84), where the applicants had applied to register the invented word "Somatose," which had been refused, the majority of the Court of Appeal sustained the Comptroller in his refusal.

Act of 1888,  
"Invented  
words."

House of  
Lords on  
bygone  
decisions  
re fancy  
words.

"Satinine"  
Case.

Erroneous  
reading of  
Sub-section  
(D) by  
Patent  
Office.

"Somatose"  
Case.

"Somatose" was intended to be applied to a new ment extract, but because of its alleged derivation from the Greek "*Soma, Somatos*, the body," it was thought to be descriptive, "in that it had reference to the applicability of the goods to the human body" (*per North, J.*). For this reason it was held by the Lower Court and also by the Court of Appeal not to be a proper example of an invented word. This decision, which was given in 1894, is now admittedly mistaken, but of course it rendered the registration of invented words even more difficult than before.

Increasing difficulties in registering invented words.

"*Solio*" Case, Reversal of the former practice.

At this juncture the Eastman Photographic Company came to the rescue of harassed word inventors. This company had applied to register the invented word "*Solio*" as a trade mark for photographic paper (*re Eastman Photographic Co.'s Application* [1898], 15 R. P. C. 476). Anyone might have predicted that in the then existing state of mind of the Patent Office such an application was doomed to failure. Photographic paper is acted on by the sun. The sun is "*Sol*." The suffix "*io*" may mean nothing, or it may be part of the word "*iodine*." Clearly the word "*Solio*" was audaciously descriptive of the character of the goods. Result: prompt rejection. The Court of First Instance and also the Court of Appeal sustained the Comptroller in his refusal to register, but the House of Lords took a different view, and ordered registration. In their judgment the House held that an invented word may be registered although it has reference to the character and quality of the goods; and that the Sub-sections (b) and (c) of Section 64 (Section 10 of 1888) are distinct and alternative. The "*Somatose*" Case was disapproved. Lord Herschell said that the decisions before the Act of 1888 afford no assistance in the construction of Sub-sections (b) and (c) of Section 10 of the Act of 1888; and Lord Macnaghten added that it was no objection to an invented word that it could be traced to a foreign source or that it should contain a covert allusion to the character or quality of the goods. The word need not be wholly meaningless. In short, almost all the long-cherished opinions and traditions of the Comptroller and the inferior Courts on this description of trade mark were put to rout right and left.

House of Lords hold that invented word may refer to character and quality. "*Somatose*" Case disapproved.

Invented word may be traceable to a foreign root and need not be meaningless.

This decision, which was given in 1898, has had its crop of consequences, and several invented words have been both registered and upheld in Court; which would infallibly have come to grief under the earlier practice. Thus "Savonol" has been upheld as an invented word trade mark for soap (*Pield v. Waget* [1900], 17 R. P. C. 266). "Tachytype" for type-composing machines (*re Linotype Co.'s Application* [1900], 17 R. P. C. 380). In the latter case it was held not to be necessary that the word should have been invented by the applicant himself or that there should have been no prior publication.

"Savonol"  
for soap.

"Tachy-  
type" for  
type  
machines.

But although the "Solio" and other decisions based thereon seriously affect a number of authorities on this class of word trade mark, they do not alter the accepted conclusions that (as Lord Shand pointed out in the "Solio" Case) the mere addition of a diminutive or short syllable to a word in ordinary and common use does not make it an invented word. Thus "Soapine" would not, in the writer's opinion, be an invented word for soap, though "Savonol" has been held an invented word for that material. Neither is a word or expression known in the English language but run together or distorted in spelling so as to *look* unlike the original, while preserving its sound when spoken, an invented or registrable word under the sub-section. Thus, neither "Cheapandgood" nor "Phiteesi" is an invented word, nor are they registrable. In *re National Biscuit Co.'s Application* ([1901] 18 R. P. C. 170; [1901] 1 Ch. 550) the word "Unecda" was refused registration as being merely an ordinary expression run together and misspelt. In *Ripley's Application* ([1898] 15 R. P. C. 151) "Pirle" for dyed and finished goods was considered to be the same as "Pearl," which, it was held, would have been descriptive; but note that this was decided before the "Solio" Case; "Electrozone" for electrically treated chemical substances was shown to be a word in ordinary use in America, and to be descriptive and not an invented word (*re British Electrozone Co.'s Application* [1896], 13 R. P. C. 447). Perhaps had the "Solio" Case been decided, Mr. Justice North might not have held, as he did in *Meaby v. Triticine Co.* ([1897] 15 R. P. C. 1), that

"Unecda"  
Case.

"Pirle"  
Case.

"Triticu-  
minu" Case.

"Bovril"  
Case.

the mark "Triticumina" was improperly registered as a fancy word in 1886, although that case, on its own merits, seems not easily reconcilable with the prior decision in the *Bovril Trade Mark* ([1896] 13 R. P. C. 382), in which the word "Bovril" was held to be a fancy word, properly registered as such. It might have been thought that "Bovril" suggested concentrated beef to the ordinary mind much more than "Triticumina" suggested ground wheat. But in the "Bovril" Case the date of registration (1886) and the importance of the business built up had great influence with the Court of Appeal in leading them to sustain the registration.

Selected  
words.

**Fifthly.—(E) A word or words having no reference to the character or quality of the goods, and not being a geographical name.**

Must not  
refer to  
character or  
quality.

We have seen that under the first and second Clauses (A) and (B) provision is made for the registration of personal and firm names and signatures in a distinctive, characteristic, and particular manner; that under the third clause (C) devices, brands, labels, and the like are registrable; and that under the fourth clause (D) "invented" words or expressions are provided for. The fifth clause (E), which we now consider, takes us out of the region of "invented" words, and provides for the registration as trade marks of arbitrarily chosen words or expressions existing in the English, foreign, or dead languages. But it must be noted that the choice of such existing words or expressions is limited. Any word or expression savouring of advertisement, recommendation, or description, or any attempt to register a mere surname apart from its distinctive dress—as provided for in Sub-sections (A) and (B)—is barred. Therefore an application to register "Premier Ebony" as a trade mark for ink would be certain of refusal as referring to quality and as being descriptive. The word "Nectar" has been refused as a trade mark for tea, as having reference to the character or quality of the goods (*re Harrison and Crossfield* [1900], 18 R. P. C. 34).

Names of  
fictitious or  
mythical  
personages

The meaning of the fifth heading—Sub-section (E)—was discussed in the Court of Appeal in *Holt & Co.'s Trade Mark* ([1896] 13 R. P. C. 118). The registered mark

in this case was the word "Tribby" in plain type, and it was contended that this being the name of an individual, although a fictitious one, it was, if registrable at all, only registrable under Clause (A) in a special and distinctive form. But the Court held otherwise, pointing out that Clause (A) was intended for personal or firms' trading names, and that the word "individual" did not apply to an imaginary or mythical personage such as "Hamlet," "Jupiter," and the like. Therefore "Tribby" was upheld as properly registered and as a valid trade mark. "Monkey" for soap, "Lone Jack" for tobacco, "Charter Oak" for stoves, are examples of registrable trade marks under this heading, being neither descriptive, nor geographical. "Ivy" has been registered for soap, and no objection was taken to it in Court (*Goodwin v. Ivory Soap Co.* ([1900] 17 R. P. C. 689). "Red Cap," "Night Cap," and "White Cap" have also been accepted by the Comptroller for soap (*re Hedley's Marks* ([1900] 17 R. P. C. 719).

may be registered.

Examples of selected words as trade marks.

Geographical words are expressly excluded from the category of registrable word trade marks under this heading, and the rule is strictly adhered to. Geographical dictionaries and general gazetteers are ransacked by the Trade Mark authorities, with the result that many words which no one ever dreamt of as possessing a geographical signification have turned out to appear in such a list. For example, the word "Camel," which had been already registered in 1888 in connection with driving belts, was refused extension to another class by the Comptroller, after the Amending Act of 1888, because it was discovered a very small and unimportant parish in Somersetshire bore that name. On appeal this refusal was upheld by the Board of Trade. This excluding clause was intended to prevent in the future the registration of such marks as "Glenfield Starch," "Eton Cigarettes," "Melrose Hair Restorer," "Strathmore Whisky," "Reading Biscuits," "Rugby Portland Cement," and the like.

Geographical words excluded.

The reason is that another manufacturer starting business in the same locality might be embarrassed in describing the place of origin of his goods if the name of the place of origin had been registered as a trade mark by

Reason for exclusion.

a rival manufacturer. Hence a possible discouragement to trade, which it is no part of the public policy to countenance.

Present-day  
reading of  
geo-  
graphical  
prohibition.

But under present practice it is unlikely that a word such as "Camel" would be refused registration because of any faint geographical significance it might be found to possess. The present-day reading of the geographical prohibition is to be found in the decision of the Court of Appeal in *Magnolia Metal Co.'s Trade Mark* (1897, 14 R. P. C. 621). There it was contended that the word "Magnolia" was geographical because evidence showed that there were several places in the United States called "Magnolia." But, as was said by the Court of Appeal: "In our judgment the phrase 'geographical name' in Section 61, Sub-section (c), ought not in general to receive so wide an interpretation. . . . A word does not become a geographical name simply because some place upon the earth's surface has been called by it. For example, we agree with Mr. Justice Kekewich that the word 'Monkey' is not proved to be a geographical name by showing merely that a small, and by no means generally known, island has been called by that name. If, indeed, in its primary and obvious meaning the word has reference to a locality, as the word 'Melrose' in *Van Duzer's Case*, or the word 'Eboli' in *Sir Titus Salt's Case* (Mr. Justice Chitty declining to distinguish the derivative 'Eboline'), it may well be a geographical name within the meaning of the sub-section. Even when the primary signification is not geographical, if the name is really a local name (however little known the locality may be) and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name within the meaning of the sub-section. An instance of this is to be found in the case of the word 'Apollinaris,' given to the water from a spring known as the Apollinaris Spring. So if 'Magnolia' had been the name of the place where the metal was manufactured, we should have been by no means inclined to say that it would not be a geographical name when applied to the articles manufactured in the place having the name."

The geo-  
graphical  
*locus* must  
be of some  
importance.

The name  
must in no  
instance be  
the name of  
the place  
where the  
articles are  
manu-  
factured.



The names of well-known mineral water springs such as "Apollinaris," "Hunyadi Janos," "Friedrichshall," are geographical names and not sustainable as properly registered trade marks (*re Apollinaris Co.'s Marks* [1891], S. R. P. C. 137).

Names of well-known springs.

The substance of the different rulings under present practice as bearing upon geographical significance in words under Sub-section (1) may be summarised thus:—If the Word Mark consists of or contains an undoubtedly geographical name, be it of county, town, village, or locality, such as London, Harrogate, Melrose, Bolton, or Cornholme, it cannot under any circumstances be a validly registrable trade mark. If it is, or affects to be, the place or locality where the article is made, such as "Eton Cigarettes," "Melrose Hair Restorer," "Cornholme Bobbins," the mark is also bad because of its geographical significance. If the Name Trade Mark indicates the name of the natural source from which the goods are obtained, such as "Apollinaris Water," the mark is bad, no matter how unimportant and obscure the place may be. But if the Name Mark selected is not the place of manufacture, but happens to be the name of an almost unknown and obscure place or locality such as Monkey Island, in the Caribbean Sea, or Magnolia, the designation of one or two inconsiderable places in America, or Camel, a small and unknown parish in Somersetshire (although this last illustration may be taken with caution), such coincidences will not bar registration nor invalidate the mark when registered.

Substance of decisions.

It must be remembered that these rules refer to trade marks under the Statute, and have nothing to do with unregistered old and well-established trade marks, or rather trade names, such as "Reading Biscuits," which are upheld under the Common Law, and which will be dealt with separately in a succeeding chapter.

The distinction between registered and Common Law trade marks must be kept in view.

Sub-section 2 of Section 64 provides that in conjunction with one or more of the essential particulars mentioned in the section—*i.e.*, under headings (A), (B), (C), (D), and (E)—there may be registered any letters, words, or figures (meaning numerals), or any combination of these; but the applicant must state the essential particulars of his

Additions to marks.

mark, and must disclaim any right to the exclusive use of the added matter. Sub-section 3 (1) provides that the applicant need not disclaim his own name or place of business; while (2) sets forth that any *special and distinctive* words, letters, figures, or combinations of these used as a trade mark before the 13th of August, 1875, may be registered as a trade mark under this part of the Statute.

These portions of Section 64 should be compared with Section 74, which provides (a) for the entry on the Register, and in combination with *old* marks, of any *distinctive* device, mark, heading, ticket, letter, word, &c., or combinations of these, although the latter may be common to the trade; and similarly (b) for the entry on the Register, and in combination with *new* marks, of any *distinctive* word or words, although the same may be common to the trade. But in either case, just as in Section 64, the applicant must state what are the essentials of his trade mark, and must disclaim the added distinctive devices or letters or words which he acknowledges as common to the trade, saving only his own trade name and address, which need not be disclaimed.

Thus, Section 64 deals with additions to the mark which are neither distinctive nor common to the trade, and which the applicant may or may not disclaim in the exercise of his discretion and at his peril; whereas Section 74 refers to distinctive additions of these separate classes to (a) old marks and (b) new marks, which additions the Comptroller is empowered to enter on the Register although they may be common to the trade, but which additions the applicants *must* disclaim. But notice that, under Section 74, the additions must be "distinctive" to be subject to the obligatory duty of disclaimer. Thus in *Smokeless Powder Co.'s Trade Mark* ([1892] 9 R. P. C. 109) the words "Smokeless Powder" were part of the mark. The applicants to expunge or vary contended that the words "Smokeless Powder" were distinctive and common to the trade, and should have been disclaimed. Chitty, J., held that, apart from the fact that the words formed part of the company's name, the words "Smokeless Powder"

Old word,  
letter,  
and figure  
marks.

Combina-  
tions with  
old marks of  
devices  
common to  
the trade.

Same as to  
new marks.

Common  
matter to be  
disclaimed.

Distinction  
between  
Sections 64  
and 74.

To be  
subject to  
disclaimer  
the common  
matter  
added  
must be  
distinctive.  
"Smokeless  
Powder"  
Case.

were not distinctive words but formed part of the label, and that no disclaimer was necessary, and that the motion should be refused. In *re Trade Mark of Clement & Co.* ([1899] 16 R. P. C. 611) the Court of Appeal held that the words "St. Raphael" written across the label were not an addition to the mark but part of it, and that no disclaimer was required. Another decision on the same point occurred in *re Faulder's Trade Mark* ([1900] 18 R. P. C. 37; W. N. [1901] 235). The mark consisted of the firm's signature with the added word "Silverpan," which was found common or open to the trade. The defendants were sued for "passing off" their goods as and for the plaintiffs' by the use of the word "Silverpan." The defendants moved to rectify the Register by expunging the mark, on the ground that the word "Silverpan" was distinctive within the meaning of Section 74 and should have been disclaimed. Kekewich, J., found that the word though open to the trade was not "distinctive" within the section and not subject to disclaimer. The Court of Appeal held that the word "Silverpan" was at the date of the registration intended to be "distinctive" within the Statute; that it should have been disclaimed on application; and that the mark must be expunged.

"Silverpan"  
Case.

Although the registration of old marks—that is to say, marks in use before the 13th of August, 1875—has already been shortly alluded to; and although the question has now largely lost its importance, a few additional remarks on the subject may prove of interest.

Old marks.

At the date of the coming into force of the present Act many proprietors of existing and old marks found themselves in danger of being shut out from registration altogether. As far as "word," "letter," and "figure" trade marks are concerned, it is evident that the new statutory definitions of a trade mark narrowed the view which traders had been accustomed to take of the limits within which this class of trade marks might be adopted and maintained. Many words, letters, and figures, and combinations of these, not agreeing with the definitions for new marks, were in use before the passing of the Act, and had become so valuable to their owners that to shut

Old marks  
not within  
the defini-  
tions of  
Act of 1883.

them out from registration would have meant the infliction of considerable hardship. A side door was, therefore, opened by Section 64, Subsection 3 (iii.), under which it is provided that "any *special and distinctive* word or words, letter, figure, or combination of letters or figures, or of letters and figures, used as a trade mark *before the Thirteenth day of August, One thousand eight hundred and seventy-five*, may be registered as a trade mark under this part of the Act."

By means of this saving clause an old mark consisting of the particulars set forth, and which would probably be refused as a new mark, may be accepted for registration, provided it fulfils the conditions set forth.

Distinctive-  
ness in old  
marks.

These are that the word or words or combination forming the mark must be "*special and distinctive*," and that the mark was in use before the 13th of August, 1875. As to the interpretation of the term "*special and distinctive*," the practice of the Patent Office and the effect of a number of decisions tend to show that old marks are not by any means so severely criticised in respect of their special and distinctive nature as are new marks. Many labels and marks which have been in use since before the 13th of August, 1875, and which carry on their faces scarcely any features which can be called special and distinctive, are nevertheless now accepted by the Comptroller, and have been sustained by the Courts.

User must  
have been  
within  
United  
Kingdom.

To be effectual the requisite prior user must undoubtedly have been as a *bona fide* trade mark applied directly to goods within the United Kingdom. The mark claimed must always have been used precisely in the form for which registration is sought. No material addition to or subtraction from the mark as used will be permitted. If the old mark has been altered in any way since the 13th of August, 1875, even although the alteration is but slight, the application to register is almost certain of refusal as an old mark. The amount of such prior user is not of much importance, provided that the use has actually taken place and in accordance with the required conditions.

Must be  
registered  
and used  
exactly in  
old form.

Registration of an old mark, where such registration implies the enjoyment of privilege in respect of prior use as an old mark, is confined absolutely to the goods

upon which the mark has been placed, and does not extend to registration as an old mark in respect of other goods to which its use has been extended after the 13th of August, 1875. For this extended use registration as a new mark is requisite. Foreign user is not taken into account, and where goods, whether of British or foreign origin, bearing a certain trade mark, have merely passed through this country on their way to another market, without being exposed here for sale, no privileges are acquired in respect of such prior user in the United Kingdom.

Mere transit of the goods not user.

Under the working of the Act of 1875 a common incident to the registration of old marks was that in many trades different applicants sought to register the same, or practically the same, mark for the same class of goods. Sometimes the applicants were wholly unaware of the existence of the other marks, and cases arose in which several applicants applied in perfectly good faith to register as their own a mark which it turned out had been used by others for an equal or greater length of time in other parts of the country. This was especially the case in devices of a common type, such as anchors, crowns, tridents, &c. Clearly, where ten different manufacturers made ten different applications for the registration of the same mark for the same class of goods, and to which all seemed to have an equal right, it would have been ridiculous to recognise all of the marks, while to have registered one or two only would have been unjust to the others.

Similarity of many old marks.

The Commissioners of Patents under the 1875 Act therefore formulated what was known as **The Three Mark Rule**. This was to the effect that an old mark that is to say, a mark used before the 13th of August, 1875—might be registered by different persons in the same trade up to the number of three, and no more. This indulgence was, however, subject to the qualification that if the mark should prove to have been used before the 13th of August, 1875, by more than three persons, then it should be treated as a mark *common to the trade*, and not capable of registration by anyone; and if any person had obtained registration before the Comptroller became aware of the facts, his registration might be cancelled

Three Mark Rule.

If in use by more than three persons mark now held common to the trade.

Three Mark Rule adopted in Act of 1883.

(*re Hughes and Young's Trade Mark*, 1893, 10 R. P. C. 369). This Three Mark Rule is given effect to in Section 74, Sub-section 3, of The Patents Act, 1883, which expressly provides that any device which was, before the 13th of August, 1875, publicly used by more than three persons for the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods. Even where a word which is capable of being held descriptive of an old and common device mark is attempted to be registered, registration may be refused. Thus in *Theobald's and Blakey's Application* (1893, 10 R. P. C. 369) the word "Anecross" was refused registration because the Court held it to be a colourable imitation of "Anchor," the device of an anchor having been proved common to the trade in *Hughes and Young's Case* (*supra*).

Common marks registrable in combination with other distinctive features.

This does not mean that such a common mark is altogether incapable of registration. A common mark consisting, for example, of a word, such as the word "Selected" in the steel pen trade, or "Parchment" in the paper trade; or a combination of words, such as "Bank of England" in the sealing wax trade; or a device, such as a "siphon and glass" in the mineral water trade, or an "anchor" in the umbrella trade; or a combination of words and a device, such as a "crown" with the words "Best Best" in the iron trade, is still registrable, and many such marks have been registered, but only when accompanied by certain additions, whether of words, letters, figures, or devices, which latter are claimed as the distinctive characteristics, all proprietorship in the common portion of the mark *per se*, being *expressly disclaimed*.

But must be expressly disclaimed.

Comptroller's Rules as to common additions in old and in new marks.

Rule 18 of the "Instructions" issued by the Comptroller runs as follows:

**18.** In the case of a trade mark used before the 13th August, 1875, common or open marks of any kind may be registered in connection with it; but in the case of a trade mark not so used (*i.e.* a new mark) common or open marks consisting of a word or combination of words only can be registered as a part of the mark.

In each case the applicant for entry of such common particular or particulars must disclaim the right to the exclusive use of the same in a note at the foot of the application form, such note to be signed by the applicant or his agent.

An owner of such a combination mark is bound to use the combination as registered, and in no other form.

Disclaimers, whether in new marks or in old, must be made with the application. As was said by Mr. Justice Byrne in *Wright and Crossley's Application* ([1900] 17 R. P. C. p. 399), "I cannot find any ground for distinguishing in reference to disclaimer between new marks and old marks which have to be registered under Section 64, Sub-sections 1 and 2, and to which Section 74 does not apply. It has been decided that the provision that the statement and the disclaimer shall be contained in the application is not merely directory, and that it cannot be waived by the Court on an appeal from the Comptroller" (see *Goodall's Trade Mark* [1889], L. R. 42 Ch. D. 566; and *Meeus' Application* [1891], L. R. 1 Ch. D. 41, 8 R. P. C. 25).

Disclaimer must be made at time of application.

An amendment proposed by the applicant to the Court to meet an objection raised for the first time by the Comptroller, cannot be accepted by the Court (*re Player & Son's Application* [1900], 18 R. P. C. 65). The same case decides that a superfluous application not involving any material change in the mark, and made merely to meet the exacting requirements of a foreign law for a certificate of home registration, will not be accepted.

Amendment on application not entertained by the Court.

Unnecessary applications.

By Section 1 of the Act of 1875 if the owner of a trade mark, whether old or new, failed to obtain registration, he was left powerless, so far as the Statute was concerned, to restrain infringement or claim damages. But quickly recognising that there might be cases in which the owner of an old mark had an equitable claim to protection, although his mark might have been held incapable of registration, the Legislature cured this defect in the amending Act of 1876. The effect of the alteration was that if the proprietor of a trade mark in use before the passing of the principal Act had applied for and had been refused registration, he might, nevertheless, institute proceedings, either for the prevention of wrongful use or damages for the infringement of such trade mark. Therefore, when an owner of an old mark had applied for registration and had been refused, his possession of the Comptroller's

Certificate of refusal to register.

certificate of refusal placed him in a position to sue for infringement of his trade mark in addition to and independently of his Common Law rights.

Section 77. Section 77 of The Patents Act, 1883, preserves this arrangement, and is as follows:-

77. A person shall not be entitled to institute proceedings to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the 13th of August, 1875, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Registration is *prima facie* evidence of right to mark; after five years conclusive.

The registration of a person as proprietor of a trade mark is *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiry of five years from the date of registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of the Act (Patents Act, 1883, Section 76). The lapse of five years from registration is, however, no bar to proceedings brought for the purpose of rectifying the Register.

But wrongful registration may be expunged.

Therefore, if the registration of a mark is and has been wrongful from the first from any cause, it is liable to be expunged from the Register, even after the lapse of five years (*Edwards v. Dennis* [1885], 30 Ch. D. 454; *Hughes and Young's Trade Mark* [1893], 10 R. P. C. 369).

Sheffield marks.

The registration of trade marks for cutlery and goods within the terms of the Cutlers' Company's Acts is governed by special rules (see next chapter).

Particulars debarred from registration.

In addition to pictorial representations of the goods, it may be noted that the following particulars are also restricted from registration either as trade marks or as parts of trade marks: viz.:-

- (a) Names of persons in the possessive case in combination with the names of goods.
- (b) The Royal Arms, or Arms so nearly resembling them as to be calculated to deceive.



- (c) Representations of the reigning Sovereign or any member of the Royal Family.
- (d) Representations of the Crown or the National Arms or Flags of Great Britain.
- (e) Such words as "Imperial," "Royal," and the like, either alone or as essential parts of a trade mark.

It has been said that the subjects and citizens of Foreign States are upon equal terms with British subjects in obtaining the registration of their trade marks in this country. Section 103 of the Act of 1883 further enacts that where a subject of a Foreign State which has become a party to the International Convention for the Protection of Industrial Property (see Appendix A) has made an application for the registration of a trade mark in his own country, he shall be entitled to the registration of his trade mark in this country in priority to other applicants (that is to say, applicants coming after the date of his foreign registration), provided he files his application in this country *within four months* of registration abroad.

Aliens may register trade marks in United Kingdom.

International Convention.

It has been contended that this section, if read literally and taken in conjunction with Article VI. of the International Convention and Paragraph 4 of the Final Protocol thereof, would point to the possibility of the Comptroller being required by a foreign applicant to register a mark under these provisions which could not be accepted by him if proffered as a new mark by a British subject. Many foreign countries will register almost any description of mark which may be presented, and which would, as an original British mark, be certain of refusal here. In practice, however, the Comptroller always refused such foreign applications as did not comply with British requirements, and apparently the Courts were prepared to sustain him in such refusals.

Foreign marks not conforming to British requirements.

In *Carter Medicine Co.'s Trade Mark* (1892) 9 F. P. C. 401, North, J., makes it clear that, in his opinion at least, foreign trade marks, even when registered abroad, should, to ensure registration here, conform to the requirements

*Carter Medicine Co.'s Mark.*

of the British Acts of 1883 to 1901. The same opinion was held in *California Fig Syrup Co.'s Mark* (1888) 6 R. P. C. 126.

British  
declaration  
attached to  
amended  
Convention  
of 1900.

Nevertheless, to do away with any doubts on the question, the British Delegates, in acceding to the amendments made in the Convention at Brussels on the 11th December, 1900, put on record a declaration to the effect that the British Government consented to the maintenance of Article VI. of the Convention and Paragraph 4 of the Protocol in their present form only on condition that all of the contracting States should be at liberty to keep their existing law on the subject. Thus the matter is set at rest, and applications under the Convention to register marks in this country by foreign traders who have already registered abroad must conform in all respects to the requirements of Section 64.

In such States as have given their adhesion to the Convention British subjects have, of course, corresponding advantages.

Having thus passed in review the various definitions of trade marks and the qualifications and circumstances which govern registration, this chapter may be fitly closed by a few words of practical advice upon the choice of a trade mark.

Practical  
advice on  
the choice  
and  
designing  
of trade  
marks.

Glancing at the list of essentials as set forth in Section 10 of the Act of 1888 (repealing Section 64 of the Act of 1883), which must be carefully kept in view when deciding upon a trade mark, it is evident that the two most important divisions are—

1. A distinctive device.
2. An invented word; or a word arbitrarily chosen, but not referring to the goods and not having a geographical significance.

An inspection of the applications advertised in the official *Trade Marks Journal* makes it apparent that in the great majority of cases manufacturers prefer to adopt a distinctive device or picture as their trade mark.

Next in order of popularity appear to be invented and arbitrarily-chosen words.

It is a common indiscretion among manufacturers to design or choose a trade mark, apply it at once to the goods, and seek no protection from registration until the mark has, from its popularity, become a valuable trade property. It then occurs to the user—possibly only after attempts at infringement by others—that it would be advisable to register the mark, and application is made for that purpose. In many cases the response of the Comptroller is to the effect that the mark is not of a registrable nature, or is so similar to another registered mark that acceptance is impossible. Thus the applicant finds himself in this unsatisfactory position, that he must either choose a new mark and regard the time and money spent in advertising and popularising his first mark as thrown away; or he may elect to continue trading under the refused mark, with the consciousness that if it should be infringed or fraudulently imitated by a rival he has only the Common Law remedy to depend upon, and can claim none of the advantages which the possession of a certificate of registration would have conferred upon him.

Use of  
trade mark  
before regis-  
tration.

Therefore, in designing and deciding upon a device or word as a trade mark, it is desirable that an intending user should first of all make himself certain as to its novelty and acceptability.

The Register of Marks is very jealously guarded against the inclusion of fresh marks which may seem in the smallest degree to interfere with marks already registered. Even where the Comptroller is himself of opinion that the mark applied for is admissible, he will frequently ask the applicant to obtain consent to registration from the registered owner of an existing mark, which may in his estimation present some resemblance, however faint, to the proposed mark, and such permission is not easily obtained.

Consent  
of prior  
registered  
owner.

The proper plan is, therefore, to make an application at once and without loss of time for the registration of the intended mark. Two or three weeks will enable the Comptroller to decide whether or not it is a mark which he can accept. If refused, another mark could then be substituted, and if this is accepted the trader may then

proceed to apply it to his goods with some assurance that he is safe in doing so.

Device  
marks  
should be  
bold and  
striking.

In preparing a "device" trade mark the design should be broad and simple, so as to be easily remembered when once seen. It should be striking, characteristic, and "distinctive" both in itself and as compared with other marks. Distinctive design must be apparent, and it may safely be said that simple geometric figures and the like, either alone or in combination, stand but little chance of acceptance. Carefully worked little pictures are not easily recognisable at a distance or at a glance, and a device which is successful as a specimen of the fine arts is not usually the best type of trade mark. As a rule, a device which sticks in the memory has something of the grotesque in it. No attempt should be made to introduce representations of the article to which the mark is to be applied. This would infallibly lead to refusal. Existing trade marks in which such representations occur have either been registered as old marks in existence before the 13th of August, 1875, or they have been applied for and registered before the present rule against such representations took effect.

No repre-  
sentation  
of the goods  
allowed.

It has, however, been held in the Court of Appeal that where the shape in which the product is sold is not a necessary but an arbitrarily-given shape—as, for example, blacklead in the form of a dome, where the lead was also sold in squares and other shapes—a representation of such arbitrarily-chosen shape may be registered as a trade mark (see *in re James's Trade Mark*, 1886, 33 Ch. D. 392; 3 R. P. C. 340).

"*Dome  
Blacklead*"  
Case.

Invented  
and selected  
words.

When inventing, and especially when selecting, a word as a trade mark no attempt should be made to refer either directly or inferentially to the goods themselves, or to their character, qualities, or effect. "Thermos," for example, has been refused as a trade mark for woollen underclothing as being suggestive of warmth. In selected words "Aquarius" has been refused as a trade mark for waterproofs; and many similar examples to the same effect might be given. All words having a geographical significance should also be avoided, as well as any words having too close a similarity to known surnames.

The remaining forms a trade mark may assume are

Same  
marks.

3. The name of an individual or firm, printed or reproduced in some particular and distinctive manner; and
4. The copy of a signature.

It is clear that neither of these types is so useful nor so exclusive as a "device" or "word" trade mark would be. As to the name, it is only the distinctive manner of printing or reproducing it, or, in other words, the device formed from the name, that constitutes the protected mark. The name itself cannot be confined to one individual. Another of the same name might commence manufacturing the same goods, and would have an equal right to register his distinctively printed name, or his signature, so long as neither imitated the distinctive features of that already registered.

To summarise the directions contained in the Official Instructions, together with the prohibitive parts of the Statute, the chief points to be avoided in designing or choosing a trade mark are as follows:

Summary  
of prohibi-  
tive rules  
as to trade  
marks.

1. A "*Device*" Trade Mark should not include any pictorial representation of the goods, nor of the Royal Arms, nor representations of the reigning Sovereign, nor of any member of the Royal Family, nor of the Royal Crown, nor of the Flag or National Arms of Great Britain.
2. In a "*Word*" Trade Mark the word or words, if "invented," may (see Lord Herschell in the "*Suljo*" Case) refer to the character and quality of the goods, but, if selected, should not refer to the character, quality, or effect of the goods. Neither must the word or words constitute a geographical name nor a surname.
3. In a "*Name*" Trade Mark the name must be printed or impressed in a distinctive manner, or must be a signature. It must not be used in the possessive case in conjunction with the names of goods. Thus, "Bunter's Bath Bricks" is unregistrable, even when printed.

stamped, or written in some particular and distinctive manner (see official order in *Trade Marks Journal* No. 570, 27th February, 1880).

4. *Generally.* Even where the goods are patented specialities, it is advisable not to include the words "Patent" or "By Royal Letters Patent" in the registered mark unless accompanied by the number and date of the patent.

Not  
advisable  
to include  
the word  
"Patent"  
in trade  
mark.

The reason is this: Should the patent from any cause cease to exist, the trade mark then contains a statement which is not true and is deceptive, and tends to prolong the patent monopoly (*Morgan v. McAdam* 1866, 36 L. J. Ch. 228; *Bousome v. Vicaham* 1882, 51 L. J. Ch. 397); and in any proceedings by the owner this would be a most effectual weapon in the hand of a defendant (*Cherwin v. Walker* 1877, 5 Ch. D. 850). On the other hand, should the owner on the expiry of the patent cease to use the word "Patent" in his mark without altering the Register, he might be challenged for using his mark in a form different from that registered. In the case of an old mark used since 1856 the employment of the word "Patent," where no patent ever existed for the goods, was held by Rigby, L. J., to be a misrepresentation which debarred the plaintiffs from relief (*Hubbuck v. Brown* [1900], 17 R. P. C. 638), and this though the word "Patent" had been disclaimed.

Such words or phrases as "Registered," "Entered at Stationers' Hall," "To counterfeit this is forgery," &c., must be struck out of all representations of trade marks sent up with applications to register.

CHAPTER III.

PROCEDURE IN REGISTERING A TRADE MARK.

**T**HE mere procedure in registering a trade mark is so simple that a short account will suffice to make it plain. Procedure in registration.

Any individual, firm, company, or corporation capable of acquiring and holding property may register a trade mark. Foreigners have equal rights with British subjects, provided the mark is actually used on goods sold in this country. Persons qualified to register.

The requisite forms for making application to register trade marks are on sale at all the chief post-offices in the United Kingdom. Form "F," which bears a stamp of five shillings, is the form of application for registration. Forms.

One of the representations of the mark should be mounted on this form, and the particulars inserted in accordance with the marginal notes which are printed on the sheet.

All goods in respect of which trade marks may be registered are divided into fifty classes, and the applicant must state the class under which he desires to claim the mark, and also particularise the goods to which the mark is to be applied. This classification will be found in the Trade Mark Rules in Appendix I. Goods.

It is important to note here that an applicant should not claim the mark for goods in which he does not deal or intend to deal. By a recent regulation the Comptroller draws attention to the practice of applying for marks in Class 50 for miscellaneous goods, which, he says, "it is difficult to suppose would be generally dealt with by the same firm." He goes on to say that care should be taken not to include goods for which the mark is not intended, and that evidence may be asked to show that the goods specified are actually made or dealt in by the applicant. Marks registered for miscellaneous goods.

This restraint, which is really applicable to all classes, is directly in the interests of applicants, seeing that registration in respect of goods not traded in may afterwards be Registering marks for goods not traded in.

made the subject of a motion by some aggrieved person to rectify the Register by expunging or limiting the mark, and this notwithstanding that the mark has been five years on the Register. A case bearing directly upon this point is that of *Edwards v. Dennis* (, 1885) 30 Ch. D. 454; and more recently in the House of Lords, in *Bull v. Durnell* (, 1899) 16 R. P. C. 411), the right of aggrieved persons to expunge marks improperly registered for goods in which no trade has been done, was not even questioned. Practically, there is no difficulty in getting the Court to expunge a trade mark registered in this improper manner.

*Edwards v. Dennis.*

Application form.

The application form "F" is signed by the applicant or by his agent duly authorised. If the application is made by a firm the form may be signed in the firm's name by a partner; if made by a company the secretary or other officer, or a director, may sign his own name, adding his proper designation and also the words "For the Company."

Representations of marks.

Two additional representations of the mark must accompany the application form "F," mounted on sheets "G" of equal size with the form "F," and bearing the name and address of the applicant or his agent. In Classes 23 to 35 inclusive (Textile Goods and Materials), four additional representations of the mark must be supplied.

Where the representations of the mark are too large to mount on forms "F" and "G," they may be mounted on linen, and folded and fixed to the forms. The papers, when completed, may be delivered or posted to "The Comptroller, Patent Office (Trade Marks Branch), 25 Southampton Buildings, London."

Acceptance or refusal of mark by Comptroller.

In the course of two or three weeks the applicant will be advised either of the acceptance of his mark or that it has been objected to or refused by the Comptroller. When refusal takes place it is based either on resemblance of the mark to existing marks on the Register, to which the applicant will be referred, or on the ground of non-conformance with the requirements set forth in the last chapter.

Objection of Comptroller.

Sometimes the objection of the Comptroller to register a mark on account of its resemblance to an existing mark



may be got over by obtaining the consent of the owner of the prior mark. When so objected to, and the resemblance seems remote, it is advisable to sound the owner of the prior mark with the view of obtaining his consent to registration, even where this is not suggested by the Comptroller. If the prior owner gives his consent, the Comptroller will in many cases withdraw his objection.

When the mark is accepted by the Comptroller the notice of acceptance calls upon the applicant to furnish a wood block or electrotype for the purpose of illustrating the advertisement of the mark in the official *Trade Marks Journal*. Such a block or electrotype should correspond exactly with the representations accompanying the application, and should not be more than two inches square. If larger an additional charge of two shillings for each additional inch or part of an inch will be made. The largest space available is eight inches by six inches.

Procedure on acceptance.

Block of mark.

Nothing but the actual mark as applied for should appear on the face of the block or electrotype. The number of the application should be written or printed on the side of the block or foundation of the electrotype.

The *Trade Marks Journal* (price sixpence) is published weekly, and contains a print of each mark advertised, with particulars of the class and applicant's name and address. When the mark is not illustrated, as for example in the Cotton Classes, the advertisement refers to a place or places where a representation of the mark can be seen.

*Trade Marks Journal*.

If no opposition to registration is offered within one month from the date of advertisement in the *Journal*, the applicant is called upon to pay the final fee (£1), and the certificate of registration is at once issued. This is the short history of a trade mark application, where nothing is done, either by the Comptroller or by outsiders, to trouble or arrest its progress. But any applicant should be prepared for such a possibility.

Issue of certificate of registration.

The Comptroller's objection to register a mark submitted to him, whether based on the ground of non-conformity to the Rules, or because of resemblance to an existing mark, is frequently accompanied by an invitation to the applicant to appear before him personally or by

Comptroller's action on objecting to application.

representative, and state his case in support of the application. If the applicant does not accept this invitation, or if he fails at the hearing to convince the Comptroller that his mark should be accepted, the mark is absolutely refused. If dissatisfied with the decision of the Comptroller the applicant may appeal to the Board of Trade, and the Board may either decide the matter or, as is their usual course, refer the appeal to the Court.

Appeal to Board of Trade.

Opposition by interested or aggrieved person.

If, on the other hand, the mark should be opposed by a rival trader or by any other aggrieved person who thinks his interests would be imperilled by the registration of the mark, the notice of opposition should be given within one month from the date of the *Journal* containing the advertisement. The time for opposition might, however, be extended by the Comptroller, on good cause being shown, for a period of not more than three months.

Notice of opposition.

Form.

The notice of opposition must state the ground or grounds on which the opponent intends to oppose the registration, and be signed by himself or by his solicitor or agent, and must contain an address for service in the United Kingdom. Form "D," given in the Rules, is to be adopted, with such variations as are called for by the circumstances. This form bears a £1 stamp.

Opposition on prior mark.

When the opponent bases his opposition upon the existence on the Register of a trade mark similar to the mark opposed, the notice must state the date of registration and the number on the Register of such alleged anticipatory trade mark.

Statement by applicant in support of application.

Within one month after receipt of this notice of opposition, or within such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter-statement, in duplicate, of the grounds on which he relies to support his application. If he fails to send this counter-statement, he is considered to have abandoned his application.

Declaration by opponent.

The next step is taken by the opponent, who must leave a declaration or declarations containing the evidence upon which he relies to support his opposition. Such declaration must be filed within two months after the expiry of one month (or such further time, not exceeding

three months, as the Comptroller may allow) from the date of the advertisement of the mark. The opponent must at the same time deliver a copy of the declaration to the applicant.

Within one month from the delivery of the said copy the applicant should leave his declaration or declarations in support of his application and in reply to the opponent's declarations, and should supply the opponent with a copy thereof. Within seven days from the receipt of such copy the opponent may leave further declarations, which should be confined strictly to matters in reply to the statements in the opponent's declarations.

Applicant's  
declaration  
in reply.

This completes the evidence, and no further declarations can be filed by either party, except with the consent of the other or by special leave of the Comptroller. On completion of the evidence the Comptroller, upon the application of either party, and on the payment of the prescribed fee (£1), appoints a time for hearing the case, and gives at least seven days' notice of the appointment to the applicant and opponent.

Completion  
of evidence.

At the hearing, the parties or their representatives attend and state their case fully; the declarations form the groundwork of all that is said, and no opposition is allowed which has not been set forth in, or does not directly spring from, the declarations filed. The decision of the Comptroller is usually signified to the parties in writing, within from one to two weeks from the hearing. Should either of the parties be dissatisfied with the decision he may appeal to the Board of Trade. Notice of the intention to appeal should be left at the Patent Office within one month from the date of the Comptroller's decision. The notice of appeal must be accompanied by a written statement of the grounds of appeal and of the appellant's case in support. In addition to serving the Patent Office with these papers a copy of the notice of appeal and of the appellant's case in support must be sent to the Secretary of the Board of Trade, Whitehall Gardens, London, and also to the other party in the matter.

Hearing  
before  
Comptroller.

Appeal to  
Board of  
Trade.

The Board of Trade then decide whether they will hear the appeal or refer the matter to the Court. If they decide to hear the appeal, seven days' notice of the hearing

is given to the appellant and to the Comptroller and to the respondent. The evidence used at the hearing before the Board of Trade is the same as that used before the Comptroller.

Appeal usually referred to Court.

As a matter of fact, the Board of Trade has of late made it an almost invariable practice to refer the appeal to Court, and this proceeding has much to recommend it, especially where there are equitable reasons why registration should be granted, although a rigid reading of the Act and the Rules would seem to bar registration. The Comptroller and the Board of Trade, however they may wish to help the applicant, generally find themselves, in the absence of any specific ruling on the point, bound to adhere to the strict letter of the Act and Rules, whereas the Court may exercise such discretion as will prevent hardship.

"The Court."

Practically, the Chancery Division of the High Court of Justice is meant by "the Court," and in the case of applications at the Manchester Office "the Court" means also the Lancaster Palatine Chancery Court (Section 26 of the Act of 1888).

Grounds of opposition.

Opposition is often encountered from the owner of another similar registered mark, but this is not always the case. The opponent might enter opposition upon other grounds.

Abandonment of application.

If an applicant abandons his application immediately upon being notified of opposition, he may be called upon to pay to the opponent such costs of the opposition as the Comptroller may think reasonable. But this is the only stage in the proceedings at which the Comptroller has power to award costs. If the matter proceeds to a hearing no costs are allowed to either party.

Costs.

Even if the case is ultimately heard by the Court, and the opponent is successful, no costs are allowed to him in respect of the proceedings below - *i.e.* before the Comptroller and the Board of Trade.

### *Sheffield Marks.*

Sheffield metal goods marks.

The registration of trade marks in respect of goods within the Cutlers' Company's Statutes is regulated by special Rules. The privileges of the Cutlers' Company are recognised and the regulations mainly expressed in Section 81 of the Acts of 1883 to 1901.

The Cutlers' Company was authorised to establish at Sheffield a new Register of Trade Marks, to be called "the Sheffield Register," and to this Register were transferred all trade marks for cutlery and kindred goods which had been registered or entered before the 1st of January, 1880, by persons carrying on business in Hallamshire, or within six miles thereof. The Company is also empowered to enter in the Sheffield Register all trade marks which have been assigned by the Cutlers' Company, and actually used before the 1st of January, 1884, but which have not been entered in either of the other Registers.

Sheffield Register.

Applications for registration of trade marks for metal goods, if made by persons carrying on business in Hallamshire or within six miles thereof, are to be sent direct to the Cutlers' Company. If made by a person outside this area the application is to be sent to the Comptroller, who communicates with the Cutlers' Company. When an application is made direct to the Company they notify the Comptroller of the fact; and if the Comptroller has no objection to make, the application is proceeded with by the Company. As a matter of fact, the Comptroller acts in unison with the Company; and if both are of opinion that the mark may proceed, registration can be effected, and not otherwise.

Metal goods trade marks in Hallamshire.

Any person considering himself aggrieved by refusal of his application by the Company may appeal to the Court.

Aggrieved applicants.

The expression "metal goods" used in the Act is not confined to cutlery, but is explained to mean "all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal."

Definition of metal goods.

When a trade mark has been registered, the period of protection lasts for fourteen years. At the end of that time the registration may be kept in force for another fourteen years upon payment of a renewal fee of £1, and so on from time to time at the expiry of each successive period of fourteen years, so that the registration of a trade mark may be kept in force for an indefinite time. If this renewal fee is not paid, the Comptroller may remove the mark from the Register within three months from the termination of the fourteen years. If the renewal fee is paid before the termination of the three months

Duration of registration.

Renewal.

Restoration  
of mark to  
Register.

an additional fine of 10s. is imposed. But even if the three months should pass without payment, and the mark has actually been expunged from the Register, the Comptroller will restore the mark if a sufficient explanation is forthcoming, and upon payment of an additional fine of £1.

Abandon-  
ment of  
mark by  
disuse &c.

The right to a registered trade mark might also be lost to the proprietor by abandonment, which might mean either total abandonment by prolonged disuse on his own part or abandonment of his exclusive right by acquiescence in the use of the mark by others, to such an extent as to create common and concurrent rights in others. To constitute abandonment the intention to abandon must, however, be shown (*per* Chitty, J., in *Mouson v. Boehm* [1884], 26 Ch. D. 398). Mere non-user of a trade mark for a length of time does not *per se* show abandonment. The period of time during which a trade mark has been disused would, of course, be an element of importance. It has been said (*in re Crossmill* [1889], 60 L. T. N. S. 612) that non-user for eleven years, during which the sale of the goods had ceased, and all labels had been destroyed, amounted to abandonment. In *re Ralph's Trade Mark* ([1883] 25 Ch. D. 194) suspension of business for twenty-one months was held to constitute abandonment. It cannot be said with certainty that the Court would look upon mere disuse of a trade mark, for four or five years for example, as abandonment unless intention to abandon was clearly present.

The inten-  
tion to  
abandon  
must be  
apparent.

Penalty for  
represent-  
ing mark as  
"regist-  
tered."

Under Section 105 of the Act any person who represents a trade mark applied to any article sold by him as "registered," which is not so, shall be liable for every offence, on summary conviction, to a fine not exceeding £5. Even though application to register a mark has been made it is an offence to call the mark "registered" before it actually is so. Though registered abroad it is an offence to call a mark "registered" in this country when actually no registration has been effected here (*MacSymon v. Shuttleworth* [1897], 15 R. P. C. 748). But the use of the words "Trade Mark" alone is not a representation that it is registered (*Sen-Sen Co. v. Britten* [1899], 16 R. P. C. 137).

## CHAPTER IV.

RECTIFICATION OF REGISTER BY THE REMOVAL  
OR LIMITATION OF REGISTERED MARKS.

BY Section 75 of the Act (being Section 17 of the Amending Act of 1888) it is provided that application for registration of a trade mark shall be deemed to be equivalent to public use of the mark, and the date of the application shall be deemed to be the date of the registration. Thus, in instituting proceedings for infringement, the registered proprietor of a trade mark is no longer called upon, as he formerly was, to prove lawful or prescriptive user before he can obtain relief in a Court of Law or Equity for the infringement of his mark. Registration of the mark is now notice to the world, and is equivalent to "lawful user" at Common Law. It must not, however, be inferred that the owner of a mark which has merely been registered, but not put to use at all, could obtain an injunction against someone afterwards using the mark. The essence of Trade Mark Law is entirely against the assumption that anyone should be permitted to harass his neighbours by registering and shelving a mark, only asserting his proprietorship when another, wittingly or unwittingly, uses the mark for trade purposes (*re Ralph* [1883], 25 Ch. D. 194).

Registration equivalent to proof of public use.

But the mark must actually have been used.

The mere element of novelty or even of originality in a trade mark is not an essential to valid registration, as in the case of a patented invention or registered design. In other words, merely to prove that the mark had been used in priority by another trader on the same class of goods and before registration is no reason for removing it from the Register (*Monson v. Boehm* [1884], 26 Ch. D. 398; *Barlow v. Johnson* [1890], 7 R. P. C. 395). The prior or concurrent user might get his mark registered, in spite of

Prior or common use by others.

the previous registration, on showing the circumstances, but he cannot oust the first registered proprietor from the Register merely on the score of his prior or concurrent user unless in the case of fraud or *mala fides*, or by showing himself to be a "person aggrieved" under Section 90. According to American decisions it seems to be a rule there that a mark to be validly registrable should in the first place have been the mark of the applicant, and no other. But the same rule cannot be said to hold good here, although Fry, L. J., in *re Hudson's Mark* (1886) 3 R. P. C. 155, speaking of the Act of 1875 (which in this respect cannot be differentiated from the Act of 1883), remarked that he had come to the conclusion that "the true meaning of the Act was to enable a person who had invented a trade mark which had not previously been used by some other person to obtain registration of that trade mark &c." (see p. 163 of Report). Certainly if it can be shown that the mark was used on the same class of goods prior to registration and concurrently by more than two persons in addition to the registered owner, the mark will be liable to removal from the Register as being common to the trade. This is established practice in old marks (*Wragg's Trade Mark* 1885, 29 Ch. D. 551; *Hughes and Young's Trade Mark* 1893, 10 R. P. C. 369) under the "Three Mark Rule" (see p. 211), and, it is submitted, would hold good in the case of marks not old (*Great Tower Street Tea Co. v. Smith* 1889, 6 R. P. C. 165).

As to mere prior publication of a word which has been registered as a trade mark see Mr. Justice Cozens-Hardy's remarks in *Linotype Company's Application* (No. 2) (1900) 17 R. P. C. 380).

When a person has been placed upon the Register as proprietor of a trade mark this is *prima facie* evidence of his right to the exclusive use of the mark, and after the expiry of five years from the date of registration it is *conclusive* evidence of his right (Section 76). This, however, is upon the assumption that the registration was in the first place good (*Baker v. Ratson* 1890, 8 R. P. C. 89). If not, it is clear that the title can be challenged, even after the expiry of five years. As Jessel, M. R.,

Five years' registration is conclusive of right of owner.

But registration must



remarked in *re Palmer* ([1883] 24 Ch. D. 504), referring to the corresponding Section in the Act of 1875: "The Act only says that after five years the person who has registered a trade mark shall be entitled to the trade mark, but does not say that the mark, as registered, shall be deemed to be a trade mark." As a matter of fact, many trade marks have been expunged from the Register after having been registered for a much longer period than five years.

have been  
*ab initio*  
good.

There are three sections in the Act which provide for rectification of the Register. Section 90 relates to cases wherein any person aggrieved by wrongful or incorrect registration of a mark by another may get the Court to expunge or correct the entry. Section 91 provides for the correction by the Comptroller at the instance of the registered proprietor, of clerical errors, or for the cancelling of the entry, the assistance of the Court not being required. Section 92 provides for the correction by leave of the Court of any entry by way of addition or alteration of any non-essential particular.

Rectifica-  
tion of  
Register,  
Sections 90,  
91, 92.

Section 90 is as follows:—

90. (1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry as the Court thinks fit; or the Court may refuse the application, and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

Expunging  
or varying  
registered  
mark.

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a Register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

Trial of  
issue.

(3) Any order of the Court rectifying a Register shall direct that due notice of the rectification be given to the Comptroller.

Notice of  
order to  
Comptroller.  
Persons  
aggrieved.

The important point to note first is that the applicant under Sub-section 1 must be a "person aggrieved." When the complaint is that the mark ought not to be on the Register at all—that, in short, it cannot properly be

The grievance must not be merely in gross.

Must refer to a party or parties injured or liable to loss.

Defendant must be aggrieved.

Grounds for application to expunge.

anyone's mark—then, as was said in *Rose v. Evans* (1879) 48 L. J. Ch. 618), "any person interested in the same trade is a person aggrieved." But that definition is perhaps a little too wide, for the grievance must not be a mere grievance in gross, and, as was pointed out by Rigby, L. J., in *re Wright, Crossley & Co.* (1898) 15 R. P. C. 377), a similar observation of Lord Herschell in *re Powell* (1894) App. Cas. 8) is not to be taken as justifying the conclusion that the mere fact of a man being in the same trade makes him a person aggrieved within the section. Fry, L. J., in *re Riviere* (1884) 26 Ch. D. 48), said that "any person aggrieved" means any person "who will in all reasonable probability suffer any injury or loss—using these words in a legal and not in a sentimental sense—from the persons claiming to use it." The same learned Lord Justice, in *Apollinaris Co.'s Case* (1891) 2 Ch. 486), said that "whenever one trader by means of his wrongly registered trade mark narrows the area of business open to his rivals, and thereby either immediately excludes, or with reasonable probability will in the future exclude, a rival from a portion of that trade into which he desires to enter, this rival is an aggrieved person."

*A fortiori* a person is "aggrieved" when he is challenged by the registered owner as an infringer, or has his own registration opposed, and he may then, if he has any grounds for doing so, apply to have the mark expunged (*in re Ralph*—1883—25 Ch. D. 194; *in re Wray*—1885—29 Ch. D. 551; *in re Hughes and Young*—1893—10 R. P. C. 369).

When it becomes a question as to whether a mark has been improperly registered or not, the circumstances existing at the date of registration must alone be regarded (*Wood v. Lombart*—1886—32 Ch. D. 247; *Barlow v. Johnson*—1890—7 R. P. C. 395). An application to expunge might be successful upon the ground that opposition to the original registration would have been successful. This was held by Romer, J., in *Eastman Co. v. Griffiths* (1898) 15 R. P. C. 105), the mark "Kodak," registered by the defendants for cycles, being removed from the Register on the application of the plaintiffs, who had previously registered the word for cameras. The evidence

showed some connection between cameras and cycle fittings. But, generally speaking, there is no reason why a mark registered and used in one trade or class of goods should not be registered and used in an entirely different trade or class of goods by an independent proprietor. As Lord Westbury said in *Leather Cloth Co. v. American Leather Cloth Co.* (1865) 33 L. J. Ch. 499, "the use of the same mark in connection with a different article is not an infringement."

The same mark might be registered by another person for different goods.

There are various grounds upon which a trade mark may be expunged or altered. For instance, the finding of the Court may be practically a revision of the Comptroller's discretion in registering the mark at all, as not conforming to the conditions of the Statute and Rules at the time of registration. Or the person registered as proprietor may not be the person entitled to be so registered; or registration may have been procured by misstatement, or without any intention of trading under the mark.

Reasons for expunging mark.

A host of decisions may be consulted in which marks have been expunged from the Register or altered by an order of Court for a variety of reasons. It would be tedious and unprofitable to recapitulate even a tithe of these examples, but one or two salient instances might be given where the mark has been challenged, and in some cases expunged as being too similar to pre-existing marks and for other reasons. The difficulty of drawing any instructive inference from a bare statement of the effect of any decision is enhanced by the necessary absence from any such statement of the age, facts, and evidence which in all cases guide the Courts in comparing the marks and in giving enlarged effect to, or limiting the scope of the older or registered mark.

As regards devices, in *Anglo-Swiss Milk Co. v. McIntosh* (1886) 31 Ch. D. 454; 3 R. P. C. 281 the word "Dairy-maid," with a half-length stencil figure of a woman, was held too similar to a full-length female figure carrying two pails. The plaintiffs' brand had become known as the "Milkmaid." In *Pomril, Limited's Application* (1901) 18 R. P. C. 181 a cider mark consisting of half an apple with the word "Pomril" written across it was held too near to a circular

Device marks expunged for similarity to other marks.

label containing a small central representation of an apple and the words "Apple Brand." In *Worthington's Trade Mark* ([1880] 14 Ch. D. 8; 49 L. J. Ch. 646) a triangular frame enclosing a church as a mark for beer was considered too near the well-known red triangle of Bass. In *Marchal v. McColygon* ([1901] 18 R. P. C. 262) the letters "J. B. D." enclosed in an oval were considered an infringement of the letters "G. B. D." also within an oval. But in *Haines' Trade Mark* ([1888] 5 R. P. C. 669) a pig in outline with accompanying initials was held different from a dog with the word "Stanch." In *Lyndon's Trade Mark* ([1886] 3 R. P. C. 102; 32 Ch. D. 109) a helmeted woman's head was differentiated from a man's head, although the opponent contended that when stamped on cutlery, for example, and on a small scale, one mark could scarcely be told from the other.

Word marks exempted for similarity to other word marks.

As regards word marks, in *Apollinaris Co. v. Herrfeldt* ([1887] 4 R. P. C. 478) "Apollinis" was held to infringe "Apollinaris." In *Steinway v. Henshaw* ([1888] 5 R. P. C. 77) "Steinberg" was held too similar to "Steinway." In *Sluzenger v. Feltham* ([1889] 6 R. P. C. 531) "Demotic" infringed "Demon." In *Eno v. Dunn* ([1890] 7 R. P. C. 311) "Dunn's Fruit Salt Baking Powder" was held too similar to "Eno's Fruit Salt." In *Goodwin v. Ivory Soap Co.* ([1900] 17 R. P. C. 689) it was held that "Ivy" and "Ivory" might lead to confusion. In *Field v. Waget Syndicate, Limited* ([1899] 17 R. P. C. 266), "Savoline" was held an infringement of "Savonol." But in *Talbot's Trade Mark* ([1894] 11 R. P. C. 77) "Emolliorum" was held dissimilar from "Molliscorium." In *Burgoyne's Trade Mark* ([1889] 6 R. P. C. 227) "Oomoo" was held different from "Emu." In *Coleman v. Brown* ([1899] 16 R. P. C. 619) "Vincalis" was held different from "Wincarnis." In *Meaby v. Triticine, Limited* ([1897] 15 R. P. C. 1), "Triticine" was held different from "Triticumina."

Old marks improperly registered.

Among trade marks held to be improperly registered as old marks there occurred the cases of *Baker v. Rawson* ([1890] 8 R. P. C. 89); *in re Palmer* ([1883], 24 Ch. D. 504 ("Braided Fixed Stars")); *in re Hayward* ([1885], 54 L. J.

Ch. 1003 ("Coker Mats"); *Thompson v. Montgomery* [1891], 8 R. P. C. 361 ("Stone Ale"); *in re Royal Baking Powder Co.* [1899], 14 R. P. C. 425 ("Royal Baking Powder"); *Dewar v. Dewar* [1900], 17 R. P. C. 341 ("Dewar's Whisky").

Marks common to the trade: *In re Wragg* [1885], 29 Ch. D. 551 ("Siphon and Glass"); *in re Hyde* [1878], 7 Ch. D. 724 ("Bank of England" on Sealing Wax); *Great Tower Tea Co. v. Smith* [1889], 6 R. P. C. 165 ("Tower Tea"); *Hughes and Young's Trade Mark* [1893], 10 R. P. C. 369 ("Anchor").

Marks common to the trade improperly registered.

Marks improperly registered in classes of goods not traded in: *Edwards v. Dennis* [1885], 30 Ch. D. 454 ("Neptune"); *in re Apollinaris Co.* [1891], 2 Ch. 186 ("Friedrichshall Water"); *Bull v. Dunnett* ([1899], 16 R. P. C. 411 ("Butterfly" for oats).

Marks improperly registered for goods not traded in.

Marks improperly registered by agent without owner's consent: *Ex parte Lawrence & Co.* [1878], 44 L. T. N. S. 98, n.; and by foreign importer's agent, *In re Apollinaris Co.* [1891], 2 Ch. 186.

Marks improperly registered by someone other than principal.

Name marks not registered in distinctive form: *In re Edge* [1891], 8 R. P. C. 207 ("Edge's Filtered Blue"); *in re Giamaelis* [1889], 6 R. P. C. 467 ("Giamaelis' Cigarettes"); *Pirie v. Goodall* [1892], 1 Ch. 35 ("Pirie's Parchment Bank" paper).

Non-distinctive and possessive name marks.

Marks held to be descriptive, or having reference to the character and quality of the goods: *Re Palmer* [1883], 24 Ch. D. 504 ("Braided Fixed Stars," Vestas); *re Arbez* [1887], 4 R. P. C. 143 ("Gem," Air Guns); *re Talbot* [1894], 11 R. P. C. 77 ("Emolliolorum," Saddle Paste); *re Davis* [1897], 14 R. P. C. 903 ("Compactum," Umbrellas); *Burland v. Broadburn Co.* [1889], 6 R. P. C. 482 ("Washerine," Soap); *re Edge* [1891], 8 R. P. C. 207 ("Filtered Blue"); *Meaby v. Triticine Co.* [1897], 15 R. P. C. 1 ("Triticumina," Meal), but this latter is doubtful since the "Solio" Case.

Descriptive marks.

Mark improperly registered, proprietor having no business established: *Re Ralph (supra)* ("Homewasher"); *Bull v. Dunnett (supra)*.

Proprietor having no established business.

Mark exactly similar to mark already registered in other classes of goods held calculated to deceive:

Marks exactly similar to

- other marks in cognate classes. *Eastman Co. v. Griffiths* (1898), 15 R. P. C. 105 ("Kodak" registered for cameras held not registrable for cycles by other traders).
- Deceptive marks. Marks held to be deceptive: *Wood v. Butler* (1886), 3 R. P. C. 81; 32 Ch. D. 247 ("Eton Cigarettes" made in London); *re Hill* (1893), 10 R. P. C. 113 ("Forrest" Watches not made by Forrest).
- Character of alterations on Register. Some of the foregoing were wholly expunged; others had part only of the marks struck out or disclaimed, as in *Buchard v. Brothorn*; or the classes of goods in respect of which the mark had been registered were cut down, as, for example, in *Edwards v. Dennis*; *re Metcalf*; and *Bull v. Donnell* (*supra*); or by entering a disclaimer of certain parts, as in *Baker v. Ransom* and *re Edge* (where the word "Filtered" was ordered to be disclaimed).
- Applicant to expunge cannot have his name substituted for ousted proprietor. Where the applicant to expunge the mark claims to be the real owner, an application to have his name substituted for that of the then registered proprietor is always futile, and the applicant may lose his costs by asking for something which the Court has no power to grant (*re Harness's Trade Mark* (1899), 17 R. P. C. 40). The usual course is to expunge the wrongful entry and let the applicant then make an application to the Comptroller to register the mark in his own name.
- Damages. Damages are rarely obtainable under Section 90, but the successful party almost invariably gets his costs, and the Comptroller also is entitled to his costs if he elects to appear. The Court, however, has entire discretion as to costs, and if the conduct of the successful party warrants such a step, costs may be refused (*Humphries v. Taylor* (1888), 59 L. T. N. S. 820; *re Talbot* (1894), 11 R. P. C. 77).
- Costs. The Court, however, has entire discretion as to costs, and if the conduct of the successful party warrants such a step, costs may be refused (*Humphries v. Taylor* (1888), 59 L. T. N. S. 820; *re Talbot* (1894), 11 R. P. C. 77).
- Appeal. An Order under Section 90 is a Final Order, and an appeal to the Court of Appeal can be heard by not less than three Judges unless the parties consent to be heard by two Judges, in which case notice that the consents have been filed must be given to the Cause Clerk (see Notice, 23rd June, 1899, 43 Sol. Jo. 627).
- Power of Comptroller. Section 91 refers to dealings between the Comptroller and the applicant for, or the registered proprietor of, a

trade mark. On receipt of a request in writing, accompanied by the prescribed fee, the Comptroller is authorised (Sub-section (A)) to correct any clerical error in connection with or in an application for registration of a trade mark. (B) Correct any clerical error in the name, style, or address of the registered proprietor of a trade mark. (C) Cancel the entry or part of the entry of a trade mark on the Register, provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the Register as the proprietor of the said trade mark. (D) Permit an applicant for registration to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the trade mark to be registered.

*to make no important alterations.*

These sub-sections deal with ministerial matters which hardly call for discussion. It is obvious that the power given under Sub-section (C) to the Comptroller to strike a trade mark from the Register at the request of the owner enables the latter to avoid a threatened application to expunge, with its consequent expense. It is a pity that no similar provision exists in the case of Patents.

*Proprietor may delete trade mark from Register.*

Section 92 provides:-

92. (1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular not being an essential particular within the meaning of this Act; and the Court may refuse or grant leave on such terms as it may think fit.

*Registered proprietor may apply to Court to alter mark in non-essential particulars.*

(2) Notice of any intended application to the Court under this section shall be given to the Comptroller by the applicant, and the Comptroller shall be entitled to be heard on the application.

(3) If the Court grants leave the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the Register to be altered in conformity with the Order.

In applications under Section 92 the applicant usually encounters no opposition outside of the Comptroller, and in many instances the Comptroller informs the applicant that he has no intention of appearing in opposition. Under Rule 51 of the Trade Marks Rules the Comptroller must

*Procedure in applying to the Court.*

Copy of order to be left with Comptroller.

Only non-essential particulars can be altered.

Name of proprietors.

Addition of word "limited."

Power of Comptroller to alter registered proprietor's name under Section 87.

No alteration allowed prejudicial to other owners.

Greater difficulty in altering old marks.

have at least fourteen days' notice of the intended application, and, according to the same Rule, if leave is granted the applicant must forthwith supply to the Comptroller some representations of the trade mark altered in the manner proposed. Should the applicant succeed before the Court, he should leave an office copy of the order with the Comptroller, whereupon the desired alteration will be made on the Register.

Alterations can only be made of non-essential particulars. Thus, where the trade mark contained the name of the company who was the registered owner and the name of the company afterwards was changed, the Court allowed the new name to be substituted for the old on the registered marks (*re Stock Owners of New South Wales* [1897], 14 R. P. C. 733). In the same manner, when a company owning certain registered marks became a limited company, leave was given to add the word "limited" to the company's name on the marks (*re Hayward & Sons' Marks* [1896], 13 R. P. C. 729; *re Hollbrooks' Marks* [1901], 18 R. P. C. 447. It was held in *New Ormonde Cycle Co.'s Mark* [1896] 13 R. P. C. 475), where a company, having changed its name, desired to insert its new name on the Register as proprietor, that the Court had no power to make such an order under Section 92, but that the Comptroller had power to do so under Section 87. This decision seems to do away with the necessity of applying to the Court as was done in *re Stock Owners of New South Wales (supra)*.

No alteration is allowed which might prejudice other registered owners or which might go outside of the restrictions of the Act (*re Reiss' Trade Mark* [1888], 5 R. P. C. 291). Non-essential words may be omitted (*Burke's Trade Mark* [1891], W. N. 2); and the name of a proprietor's works may be altered (*re Bremen and Roby's Mark* [1897], 4 R. P. C. 70).

It is more difficult to get the Court to allow alterations in old marks—*i.e.* marks registered as in use before the 13th of August, 1875—than in new. Old marks have certain privileges, and are under corresponding disabilities. It is, therefore, only under exceptional circumstances that



any alteration is permitted (*per* Kekewich, J., in *Henry Clay's Trade Mark* [1892], 9 R. P. C. 449). Necessary alterations are allowed if possible. For instance, the addition of "Limited" to the name of a company which has become limited is always allowed (*Guinness & Co.'s Trade Mark* [1888], 5 R. P. C. 316). An application to omit the words "Trade Mark" from an old mark has been refused (*Phillips' Trade Marks* [1891], 8 R. P. C. 469); but see *re Colman's Marks* ([1891] 8 R. P. C. 209), where leave was given on terms, these being new marks. A similar application to omit the word "Patent" from an old mark was refused (*Adam's Trade Marks* [1892], 9 R. P. C. 174). In *Savin's Trade Mark* ([1895] 13 R. P. C. 21) an application by the registered proprietor of an old mark to strike out a word and substitute his own name in Russian was refused, because to a person not understanding Russian, and to whom Russian letters would appear rather as devices than letters, the alteration might seem a material modification of the mark as originally registered. It seems that had the words struck out and replaced been merely names and addresses in English, the application would have been granted (*re Brown's Marks* [1894], 11 R. P. C. 365). A registered label, the whole label constituting the trade mark, but containing some separate device to which special attention is called by the words "Trade Mark," was said by Fry, L. J., in the *Apollinaris Case* ([1891] 8 R. P. C. 136) not to be registrable because misleading. In consequence of this remark Messrs. Colman applied to remove from their labels (certain of them being old marks) the words "Trade Mark" surmounting a Bull's Head in the corner of the label. Leave was granted, but only upon condition of entering on the Register a statement of the essential particulars of the label, and disclaiming the added matter (*re Colman's Marks* [1891], 8 R. P. C. 209).

Proceedings to rectify the Register are usually taken in the Chancery Division. "The Court" in England is His Majesty's High Court of Justice, or where the mark was applied for in the Manchester Branch Office for Trade Marks "the Court" includes the Palatine Court of Chancery. The Irish Court has held that it has no jurisdiction

Addition of "Limited" to proprietor Company's name.

Striking out of word "Patent."

Alteration of non-essential particulars from one language to another.

Alteration of possibly misleading item in label.

*re Colman's Marks.*

Rectification proceedings usually taken in Chancery.

Jurisdiction of Irish and Scotch Courts.

to order any alteration or rectification of the Register of Trade Marks (*Boyer v. Connell* [1897], 14 R. P. C. 275); but a Scotch Court has jurisdiction to entertain a petition for rectification of the Register (*Cowie v. Herbert* [1897], 14 R. P. C. 436).

Methods of hearing the application.

Evidence is ordinarily given by affidavit, and the deponents may, in the discretion of the Court, be subjected to cross-examination. But frequently the case is taken as an ordinary witness action. Declarations filed by the respondent, the registered proprietor, in matters appertaining to the registration, transfer or alteration of the mark may be put in as evidence by the applicant (*Theobis and Blakey's Mark* [1893], 10 R. P. C. 369). Discovery of documents relating to the grounds of the motion may in some cases be ordered (see *Wills's Trade Mark* [1892], 9 R. P. C. 346).

Discovery.

Appeal.

Appeal from the decision of the Court may be made to the Court of Appeal and to the House of Lords.

CHAPTER V.

TRANSFER AND DEVOLUTION OF TRADE MARKS.

SECTION 70 of the Act of 1883 provides that a trade mark when registered shall be assigned and transmitted in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Registered trade mark wedded to goodwill of business.

The owner of a trade mark cannot therefore legally dispose of the mark to another without at the same time transferring to him the goodwill of so much at least of the business as relates to the goods in respect of which the mark has been registered. As was said by Fry, L. J., in *Edwards v. Dennis* (1885 30 Ch. D. 454), "an assignee has no exclusive right to a trade mark unless the assignment is of a business co-extensive with the trade mark as registered." Trade marks which have been registered as a series cannot be broken up and disposed of piecemeal. They must be assigned and transmitted as they were registered - viz., as a series (Section 66).

Mark cannot be transferred except with goodwill.

Marks in series cannot be broken up.

The reasons for this indissoluble union between a trade mark and the goods or business which have made the mark a readily accepted sign of certain qualities are plain. The reputation of the mark has been made by the goods, and the mark must follow the business in those particular goods - otherwise it might be made an instrument of fraud. This is so far the case that, in *Shipwright v. Clements* (1871 19 W. R. 599), Vice-Chancellor Malins held that if a business were sold without any word being said about the trade mark the mark would be understood and held to pass to the purchaser. This is a rule which holds good in American practice as well as here.

Reasons for tie between trade mark and goodwill.

When the mark is indicative of origin, it must, in the hands of the assignee, indicate what it indicated in the

Mark must indicate in hands of

assignee  
what it  
indicated in  
hands of  
assignor.

hands of the assignor. Thus, as was said by Fry, L. J., in *Pinto v. Bulman* (1891) 8 R. P. C. 181, "it may be assigned if it is indicative of origin, when the origin is assigned with it. It cannot be assigned when it is divorced from its place of origin, or when in the hands of a transferee it would indicate something different from what it indicated in the hands of the transferor."

But although a trade mark may contain the name or initials of the former owner, if the business and goodwill of the former owner has in fact been transferred to the new proprietor, his continued use of the mark with the old name or initials on it is not a deception (*Hall v. Barrows*, 1863, 4 De G. J. & S. 150).

Portion of  
business  
with corre-  
sponding  
marks.

A portion of a business may be sold with the trade marks referring to those goods which are dealt with in that part of the business, and the use of the marks will be restricted to those generally.

On bank-  
ruptcy,  
mark passes  
to trustee.

On the bankruptcy of the owner of a trade mark the mark, together with his other effects, passes to the trustee in bankruptcy as being goods and chattels within Section 15, Sub-section 5, of The Bankruptcy Act, 1869, and the trustee has the power to deal with it as with any other asset. When one of the members of a partnership, otherwise solvent, becomes bankrupt, his individual share or interest in the mark cannot be sold, but will pass to the solvent partner or partners. The reason of this is, that the undivided interest in the trade mark is valueless apart from the goodwill. If the owner of a trade mark, carrying on a business, assumes a partner or partners, the trade mark becomes part of the partnership assets, unless specially reserved by the original owner. The new partner or partners is or are entitled to registration as joint owner or owners with the original proprietor.

In partner-  
ship is part  
of assets.

Right of  
remaining  
partner to  
trade  
marks.

On dissolution of partnership, the mark goes with the goodwill. If one of the partners carries on the old business the trade mark passes to him with the goodwill, the value of the interest in the mark being accounted for to the retiring partner as one of the partnership assets. But if the partners agree to divide the partnership assets and carry on the same business separately, each is at liberty to use

the mark (*Coady v. Mitchell* 1877, C. A. 37 L. T. N. S. 766). But a former partner in a dissolved partnership was, in *Hanson v. Ginn & Harrison* (1892) 9 R. P. C. 186, prevented from allowing a limited company carrying on business, with which he afterwards became associated, to use one of the marks of the former partnership. When a trade mark is designed and used in a joint adventure, neither of the parties has a right to the mark after the adventure is closed (*see Jones's Trade Mark* 1885, 53 L. T. N. S. 11).

But former partners in dissolved partnership may each enter on and use marks.

Trade mark in joint adventure.

On the death of the proprietor of a trade mark the mark passes to his personal representative with the rest of his personal property. The owner may bequeath his trade mark to whomsoever he pleases, but always in connection with the goodwill of the business.

Devolves as personal property.

When a trade mark has thus been assigned or transferred, the new proprietor should at once, in accordance with Section 87 of the Act, get his name put upon the Register in place of that of the former owner. This is done by sending to the Comptroller a formal request to alter the Register, showing the particulars of the transfer and that the mark has been accompanied by the goodwill of the business, the whole of the several statements being verified by statutory declaration.

New proprietor should get his name on Register.  
Form of request.

In the event of the Comptroller refusing to enter an assignment upon the Register the assignee may make an application to the Court for an Order directing registration. In such a case the assignee would be a person aggrieved under Section 90. The facts entitling him to be held a *bona fide* owner of the mark, and the whole nature of the transaction by virtue of which he acquired it, must be embodied in his affidavits supporting the notice of motion.

Where Comptroller refuses to register.

There is no such thing as licensing another to use a trade mark. If the owner of the trade mark permits it to be used in connection with other people's goods he loses his claim to it (see the "Eton Cigarettes" Case, *Wood v. Butler* 1886, 32 Ch. D. 247).

Owner cannot license another to use his trade mark.

## CHAPTER VI.

## ACTION FOR INFRINGEMENT.

Remedies  
for infringe-  
ment.

Action to  
restrain in-  
fringement.

Action for  
passing off.

Criminal  
proceed-  
ings.

Chancery  
Court.

Essential  
that the  
mark  
should be  
registered.

or refused.

WHEN the owner of a trade mark finds that his mark is being infringed the question as to how he will seek his remedy depends upon the nature of the infringement and also upon his own position. If his trade mark has been registered and the infringement is simply a copy of the mark he may bring an action in the Chancery Division for an injunction to restrain the infringement, with a claim for damages or an account of profits. With this claim he may, if he is so advised, and particularly if his mark has been not exactly copied but colourably imitated, claim an injunction and damages in respect of the passing off of the goods by the defendant as and for the goods of the plaintiff. Or he may bring an action for "passing off" and for false representation on the King's Bench side, claiming damages; or in an aggravated case he may institute criminal proceedings under The Merchandise Marks Act, 1887, by summons before a Magistrate or Justice of the Peace or by indictment.

The Chancery Division is the Court in which an action is usually brought when the plaintiff is the proprietor of a properly registered mark which has been infringed. The plaintiff's right to sue is derived from the Statute, Section 77 of which provides that "a person shall not be entitled to initiate any proceeding to prevent or to secure damages for the infringement of a trade mark unless in the case of a trade mark capable of being registered under the Act it has been registered in pursuance of this Act, or of an enactment repealed by the Act, or in the case of any other trade mark in use before the 13th of August, 1875, registration thereof under this part of this Act or of an Act repealed by this Act, has been refused. The Comptroller may, on request and on payment of the prescribed fee, grant a certificate that such registration has been refused."

So far as the statutory right to sue is concerned, the plaintiff must therefore possess either a certificate of registration or, in the case of an old mark which has been refused, a certificate of refusal to register. This particular type of action will be considered first, and incidentally the "passing off" element in such actions, since it is difficult to separate one from the other.

Statutory  
right.

The first thing for the plaintiff to establish is the fact of infringement. The infringement must imitate the mark as registered or the essential particulars of the mark, and must imitate it sufficiently closely to be calculated to deceive, so that goods bearing the infringing mark may be easily mistaken for goods bearing the registered mark. But the first essential is that the registered mark should have been imitated. As was said by Jessel, M. R. "If you come for trade mark and not for actual fraud you can only sue in respect of what you have registered as a trade mark."

Features  
of infringe-  
ment

The infringement may be an exact copy of the plaintiff's mark as registered, or it may consist only of the most salient characteristics of the registered mark, or it may, without being a copy, imitate the general appearance of the plaintiff's mark so as to resemble it. "Resemblance is a circumstance which is of primary importance for the Court to consider, because if the Court finds that there is no reason for the resemblance, except for the purpose of misleading, it will infer that the resemblance is adopted for the purpose of misleading." *per* Wood, V.C., in *Taylor v. Taylor* (1851) 23 L. J. Ch. 255). The studied resemblance may be brought about in labels by arranging the general mass of the printing, colouring, and other general effects in such a manner that, without actually copying a single word or line of the plaintiff's label, the two marks may be almost indistinguishable at a short distance: as, for example, where a pelican on a green ground was substituted for a crane on a similar backing (*Halifax v. Kilburn*, 1 Hyde 270); "Rottgen" with two crosses for "Rodgers" with a star and a cross (*Rodgers v. Holtz*, 5 T. L. R. 678). A mustard-tin label, with grouping, colours, and arms similar to that of the plaintiff's, was held

Resem-  
blance.

Resem-  
blance need  
not be exact  
in detail

Instances  
of careful  
resem-  
blance.

Labels.

to infringe in *Colman v. Parrow* (1897, 15 R. P. C. 198). In words a deceptive similarity may also be created, as, for example, "Condisanitas" for "Sanitas" (*Sanitas Co. v. Condy* 1887, 4 R. P. C. 195, 530); "Steinberg" for "Steinway" (*Steinway v. Houslow* 1887, 5 R. P. C. 77); "Apollinis" for "Apollinaris" (*Apollinaris Co. v. Herffelt* 1887, 4 R. P. C. 178). But there was held to be sufficient difference between "Wincarnis" and "Vincalis" (*Colman v. Brown* 1899, 16 R. P. C. 619). In device marks similarity was held between a bell and a beehive (*Bell Black and Co. v. Bell*, Seb. Dig. 541); a diamond containing a "K" and a diamond without a "K" (*Curtis v. Pope* 1888, 5 R. P. C. 116). But, even if every case adjudicated upon by the Courts were given, it would help but little in assisting the reader to come to a decision on some fresh case brought to his notice. As Lord Watson asked in *Orr-King v. Johnston* (1882, 7 App. Cas. 219): "How can observations of Judges upon other and quite different facts bear upon the present case in which the only question is, What is the result of the evidence?" The plain rule is, that in each case the Court will institute a common-sense comparison of the marks in dispute, guided always by the evidence and by the behaviour of the parties.

Identity of precedents in deciding cases of resemblance.

*Orr-King v. Johnston*.

More physical resemblance not the only guide.

But, although the eye is so powerful a factor in settling trade mark disputes as to colourable imitation or general mutual resemblance, mere physical resemblance of the marks is not always the true guide.

See *Solo v. Procezeno*.

Lord Cranworth, in his judgment in *Solo v. Procezeno* (1866, 4 R. 1 Ch. 192), says: "I do not consider the actual physical resemblance of the two marks to be the sole question for consideration. If the goods of a manufacturer have, from the mark or device he has used, become known in the market by a particular name, I think that the adoption by a rival trader of any mark which will cause his goods to bear the same name may be as much a violation of the rights of that manufacturer as the actual copying of his device." In other words, even if marks placed side by side are easily distinguishable, the one might yet, apart from the other, be an infringement. This principle was followed in *Read v. Richardson* (1881, 45 L. T. N. S. 51), where the beer of the plaintiffs having

Name echo of device.

"Dog's Head Beer" Case.



become well known in the market as "Dog's Head Beer," the defendants were restrained from describing their beer as such and from using any representation of a dog's head on their bottle labels, no matter how unlike the plaintiffs'.

Another example is to be found in *Orr-Faring v. Johnston* (1882, 7 App. Cas. 219). The plaintiff had a mark which he applied to red yarn, an essential feature of the mark being the representation of two elephants. From this the goods had come to be known as the "Two Elephant" yarn. The defendants had also begun to use a ticket upon which two elephants figured. It was not contended that there was any deceptive resemblance between the tickets; nevertheless an injunction issued against the defendants in terms which practically forbade them from representing or alluding to elephants at all in trade marks for this class of goods. This mark was chiefly current in the Indian market.

The infringing use of the mark must be in respect of goods for which the plaintiff uses his mark, and must of course be used in selling goods not of the plaintiff's manufacture. Therefore, if the goods made by the plaintiff are in the lawful possession of the defendant, and all that the latter has done is to place the plaintiff's mark on the goods he is within his rights in doing so, even if he prints the labels himself (*Parina v. Silverlock*, 1858, 1 K. & J. 509; 24 L. J. Ch. 632). The particular mode of applying the infringing mark to the spurious goods is not of importance so long as the goods are sent out in such a manner as to show that they are intended to be sold under the mark. Thus, placing the mark on a case or wrapper or placing a slip among the goods, or even printing the mark on a circular offering the goods for sale, will amount to wrongful use of the mark (*Jay v. Ladler*, 1889, 6 R. P. C. 136). Old cases or bottles or casks bearing the genuine mark must not be used to convey and cover spurious goods (*Barnett v. Leuchars*, 1865, 13 L. T. N. S. 495). In one instance where the plaintiff's old bottles bearing his mark moulded thereon were sent out containing other manufacturer's goods, the defendant having pasted his own labels on the bottles, it was held the use of the bottles constituted an infringement (*Rose v. Loftus*, 1878, 47 L. J. Ch. 576).

*Orr-Faring v. Johnston*,  
Two  
Elephant  
Yarn Label

The in-  
fringement  
must be in  
goods  
similar to  
plaintiff's

Mode of  
applying  
infringing  
mark

Advertisement  
as re-  
fringement.

*Jay v.  
Ladler*.

Old bottles  
re-filled.

Proof of actual deception not necessary.

Noe of fraudulent intent.

Innocent infringer.

Ultimate deception.

In the case of a registered trade mark, to obtain an injunction the plaintiff need not prove that actual deception of customers has taken place (*Paine v. Daniels*, 10 R. P. C. 217; 1893, 2 Ch. 567). Neither is there any necessity to prove fraudulent intent on the part of the defendant, for the principles upon which the Courts of Equity act in the case of trade marks are, that the motives of the infringer are immaterial. He may have acted innocently and without the intention of defrauding anyone (see the remarks of Chitty, J., in *Upstart v. Fooster* 1883, 21 Ch. D. 231). He may even himself have designed the offending mark, and may have intended to use it as his own mark in absolute ignorance of the existence of the mark which he has infringed. All of this matters nothing. The Court's duty is to protect the public, and it is undeniable that as soon as the goods leave the defendant, and pass from hand to hand, they may be made the instruments of fraud by middlemen, and ultimate purchasers may believe that they were originally manufactured by the person entitled to the genuine mark.

Even when the maker, knowing that they are not the goods of the person entitled to use the trade mark, tells this to the immediate purchaser, thinking thereby to clear himself from the charge of fraud, still he is not absolved, because, as the goods pass on from hand to hand, this representation does not pass on with them, and thus the next purchaser or the public at large may be deceived (*Sykes v. Sykes* 1821, 3 B. & C. 511). Consequently all that has to be done is to show that the trade mark has been taken.

*Sykes v. Sykes*.

Jessel, M.R., in *Singer Manufacturing Co. v. Wilson* 1875-7, 2 Ch. D. 434; 3 App. Cas. 376.

This is the gist of a deliverance by Sir G. Jessel, M. R., in *Singer Manufacturing Co. v. Wilson* (1875-7, 2 Ch. D. 434; 3 App. Cas. 376), and summarises the principles of the Court of Chancery in such cases. So that it is not now necessary to show actual deception or intentional fraud, as would be the case in Common law. All that is necessary in equity is to show that the plaintiff has an exclusive right to use the mark, and that the mark has been taken by the defendant (Westbury, L. C., in *Leather Cloth Co.'s Cas.* 1863-5, 1 De G. J. & S. 137).

An innocent infringer will not, however, be so stringently dealt with as a wilful wrongdoer, especially if prompt submission is made. But it is unlikely that he will escape payment of the costs (see Mr. Justice Chitty in *Upjohn v. Forester* 1883', 24 Ch. D. 231; but note Stirling, J., in *American Tobacco Co. v. Guest* 1892, 9 R. P. C. 218, which was the case of an innocent retailer who had made a very small purchase of cigarettes bearing the false mark). In this case the defendants were relieved from the payment of costs. The Court might even in certain circumstances refuse an injunction where the infringement is of a trivial nature committed without the knowledge of the defendants, and especially in cases where the defendants have immediately offered to apologise and pay costs (*Clarke v. Hudson's Executors* 1901', 18 R. P. C. 310).

Practical in the case of innocent infringers.

As a rule, trade mark cases are heard by a Judge without a jury, and even where a defendant in such a case gave notice of trial before a Judge and special jury, it was held that the case must be heard without a jury (*Spratt's Patent v. Ward & Co.* 1879', 11 Ch. D. 210).

Usually tried without jury.

In applying for an interlocutory injunction, promptness in taking action is above all things to be recommended to the plaintiff. Delay is looked upon unfavourably by the Court, unless it can be conclusively shown that such delay was necessary to secure the requisite evidence to establish the plaintiff's case (*Isaacs v. Thompson* 1871', 11 L. J. Ch. 101).

Interlocutory injunction should be promptly applied for.

It is advisable that the plaintiff, before beginning proceedings, should give the infringer notice of his intention to take action, so as to give an opportunity of explanation and submission.

Usually advisable to warn infringer.

The writ should be endorsed with a claim for an injunction to restrain the defendant, his servants and agents, &c., from applying the plaintiff's registered mark of \_\_\_\_\_ to any goods manufactured or sold by the defendant, and from issuing any boxes or cases or the like to which the mark is applied, or from affixing or using any label, ticket, or card containing or bearing the said mark &c. Or the claim might be for damages for the wrongful use or imitation of the plaintiff's trade mark, and for an

Endorsement of writ.

injunction and an order for delivery up and destruction of all goods, documents, articles, or things held to be an infringement of the plaintiff's rights &c. The endorsement must of course be modified to suit circumstances.

Statement  
of claim.

Particulars.

In the statement of claim the plaintiff, claiming as registered proprietor, should, if the nature of the infringement renders it desirable, describe the mark, and should preferably give particulars of registration. He should then allege infringement by the defendant, giving some instances of breaches, plead damage sustained by the wrongful acts of the defendant, and claim an injunction on the lines suggested in the endorsement on the writ, together with damages or an account of profits, with delivery up of the goods or materials which constituted or created the infringement.

Colourable  
imitation.

Passing off.

The statement of claim might be confined to the points indicated where the mark has been absolutely copied, but where the infringement may also be construed as a colourable imitation of the mark or get-up, paragraphs should be introduced into both writ and statement of claim complaining of such wrongful imitation or get-up, and setting forth that by reason of the alleged unlawful acts the defendant has sold and passed off goods not of the plaintiff's manufacture as and for the plaintiff's goods. In such a case the claim for injunction should refer to such wrongful passing off.

Interlo-  
cutory  
injunction.

The plaintiff might, as soon as his writ is issued, apply for an interlocutory injunction. Formerly this was not readily granted except in cases where the clearest proof of the plaintiff's right and the defendant's wrongdoing was forthcoming. But under present practice, and especially where there is strong suspicion of intentional deception on the part of the defendant, the Court is more ready to grant such relief.

The position  
of an  
innocent  
infringer.

Theoretically, the position of an innocent infringer of a registered mark is no better than that of an intentional wrongdoer but practically the Courts will distinguish, especially where the defendant, as soon as the mistake is brought home to him, makes prompt submission, giving an undertaking and offering to pay such costs as the

plaintiff may have incurred. If after such an offer the plaintiff still goes on, the Court will not support him in any merely vindictive proceedings, although it may find itself compelled technically to issue an injunction. In *Millington v. Fox* ([1834] 3 M. & Cr. 338) the defendants, having inadvertently made use of the plaintiff's trade mark, themselves informed the plaintiff of the fact, offering an undertaking, payment of costs, and compensation. The plaintiff applied for an injunction, which was granted, but without costs. In *Colburn v. Simms* ([1843] 2 Hare, 543), which concerned an infringement of copyright, the defendants, after the filing of the bill, offered to submit to an order in the terms of the bill. The plaintiff refused and pressed for an injunction, which was granted, but without costs. In the course of his judgment Wigram, V.-C., said: "If a plaintiff immediately after the suit is commenced is offered and may obtain all he seeks, and still thinks proper to go on with his suit, the Court may give him his decree, but will not give him the costs." In *Upmanu v. Elkam* ([1871] L. R. 12 Eq. 140), where an innocent infringer made full submission before issue of writ, the injunction was granted, but without costs; and in *Carracho v. Highmoor* ([1883] 27 Sol. Jo. 199), where the defendant offered an absolute undertaking in the terms of the endorsement of the writ, on plaintiff pressing for an injunction Chitty, J., granted it, but so far from giving the plaintiff his costs, he ordered him to pay five guineas towards the costs of the defendant. In some cases even the injunction has been refused. Thus, in *Jenkins v. Hope* ([1895] 13 R. P. C. 57), the innocent infringers of a patent offered, after the issue of the writ, to account for profits, to give a perpetual undertaking, and to pay all costs. The plaintiff, notwithstanding, proceeded with his action. The injunction was refused, but the plaintiff was held entitled to his costs down to the date of the offer, and the costs of the hearing. North, J., said the offer of the defendants should have been accepted. See also *Leahy v. Glover* ([1893] 10 R. P. C. 141) and *Rutter v. Smith* ([1900] 18 R. P. C. 49), where an application for an injunction in respect of an isolated sale of an ounce of tobacco under the plaintiff's

Examples  
of practice  
in the case  
of innocent  
infringers.

*Millington  
v. Fox.*

*Colburn  
v. Simms.*

*Upmanu  
v. Elkam.*

*Carracho  
v. Highmoor.*

*Jenkins  
v. Hope.*

*Rutter  
v. Smith.*

*Clarke v. Hudson's Executors.*

trade mark, was refused with costs. In *Clarke v. Hudson's Executors* (1901 18 R. P. C. 310), where the offence consisted in advertising the mark of the plaintiffs in an unauthorised manner (although this appeared to have been done by the printers without authority from the defendants), the offer of the defendants to apologise and give an undertaking and pay costs was disregarded by the plaintiffs, who wished additional terms. Farwell, J., refused an injunction, and only gave the plaintiffs the costs down to and including the writ.

But submit-  
tion by  
defendant  
must be full  
and sufficient  
to give the  
plaintiff his  
right to  
experts.

But if the offer made by the defendant under such circumstances falls short of the terms of the writ, or short of such terms as the plaintiff is entitled to obtain, an injunction will be granted with costs (*McAndrew v. Bassett* 1861, 10 L. T. 65; *Fleming v. Day & Martin* 1886, 55 L. T. 161). In *Stronger v. Pipitt* (1895 12 R. P. C. 439), in which case an apology and an offer to consent to an order in the terms of the writ were made, North, J., when granting the injunction directed that the costs to be paid to the plaintiff should not exceed those of a consent order in chambers.

Determine  
application for  
injunction.

An interlocutory injunction is not usually granted where the plaintiff has unduly delayed (*Isaacs v. Thompson* 1871, 41 L. J. Ch. 191), and in any case an interlocutory injunction, if granted at all, should be subject to an undertaking by the plaintiff to make good any damages suffered by the defendant in the event of the injunction not being sustained.

Defence.

Exclusive  
right to  
plaintiff.

In considering his defence the defendant must first ascertain the title of the plaintiff and his conclusive or non-conclusive right to the sole use of the mark. It will be remembered that according to Section 76 of the Act, mere registration of the mark is *prima facie* evidence of the proprietor's right to the exclusive use of it, while at the expiry of five years such *prima facie* right becomes conclusive as to his right to the exclusive use of the mark, but subject to the provisions of the Act. Evidently, then, a mere denial of infringement, with allegations that the trade mark is not the plaintiff's and that the alleged trade mark is not a trade mark as set out in the form in the Rules of Court of 1883, is very seldom of sufficient

Form of  
defence.

breadth, and in the case of a mark registered for more than five years would apparently plead something which it is incompetent to plead.

If the plaintiff's mark has not been five years on the Register then the defendant may plead against the validity of the registration all the objections to the mark which might be imported into an application to expunge or vary the entry on the Register (*Pinto v. Badman*, 1891, 8 R. P. C. 181). But this case also decides that a claim to rectify the Register should not be put forward by counterclaim. Thus he might contend that the mark was improperly registered in that it did not comply with the requirements of registration under Section 64 of the Act, in addition to the defences permissible even when the mark has been five years registered, as for example that the trade mark has become severed from the goodwill or has been abandoned, or that the plaintiff has been guilty of laches such as delay or acquiescence, or because of estoppel, or that the defendant has a concurrent right of user, or that the plaintiff does not use his mark as registered, or that it is fraudulent or deceptive or contains a misrepresentation, such, *e.g.*, as the word "patent" when there is no patent.

But if the plaintiff's registration is more than five years old the defendant cannot attack the plaintiff's title generally. He cannot, for example, show that the plaintiff's mark is not a trade mark or that it was not competent to be registered as a trade mark under Section 64 (*Apollinaris Co. v. Herzfeldt*, 1887, 4 R. P. C. 478, 183). To do this he must move the Court to expunge the mark from the Register, or to vary it in such a manner as to defeat the action. This must be a separate application, and a motion to expunge or vary cannot be added to the defence by way of counterclaim (*Pinto v. Badman, supra*). The motion to rectify is heard with the action, or on the application for interlocutory injunction, if such is made. In a proper case facilities are given for the introduction of such a motion to rectify. For example, in *Edwards v. Elkam* (1888) 5 R. P. C. 70, Stirling, J., adjourned a motion for interlocutory injunction to enable the defendant to prosecute a counter application to register and to move to rectify the Register.

Where plaintiff's mark has not been five years on Register.

Examples of pleas in defence.

Where plaintiff's mark more than five years on Register.

Limitations of defence.

Application to expunge cannot be by counterclaim.

Registration  
in  
Stationers'  
Hall.

More copyright registration of a trade mark in the Stationers' Hall gives birth to no trade mark rights, and is no defence if the copyrighted mark infringes another trader's mark (*Reinhardt v. Spalding*, 1879, 49 L. J. Ch. 57).

Discovery.

Discovery is granted in trade mark actions as in other causes. But such discovery will not be ordered where it is likely to be oppressive (*re Wills' Trade Marks*, 10 R. P. C. 269; [1892] 3 Ch. 201), nor where names of

Names of  
customers.

customers or correspondents referring to the matters in issue were concerned (*Carrer v. Pinto Leite*, 1871, L. R.

Discovery  
of sales.

7 & 8, 90). Discovery concerning sales, where the defendant

resists infringement, is not usually ordered, and is scarcely material until infringement has been decided. But when an account of profits has been directed, discovery of customers and all goods sold is usually enforced (*Leather Cloth Co. v. Hirschfeld*, 1863, 1 H. & M. 295).

Inspection.

The Court may in its discretion, and if thought desirable for the purpose of obtaining such information or evidence as will assist the course of justice, order inspection. If, therefore, a plaintiff can show reasonable grounds, he may obtain an order to inspect goods which he has strong reasons for believing are marked with the infringing mark.

Applications for an inspection order are made in the Chancery Division by motion or summons, and in the King's Bench Division by summons.

Relief  
granted by  
the Court.

Should the plaintiff succeed in his action, he may obtain all or a part of the relief he asked viz., an injunction to restrain further infringement; delivery up of the goods bearing the infringing mark for destruction if need be, or for erasure of the mark if that can be done; damages, or an account of profits made by the defendant through his wrongful use of the mark.

Damages or  
an account.

It is for the successful plaintiff to elect whether he will have damages or an account of profits. He cannot have both.

Costs.

Costs usually follow the event, unless the successful plaintiff has been guilty of laches, or sometimes where the defendant is an innocent infringer or has been guilty of some technical offence only, as in *Upmann v. Kilbon* (1871 L. R. 12 Eq. 140), the defendants being merely carriers. In this case the plaintiffs, though successful



in obtaining an injunction, obtained no costs. Again, in *Rutter v. Smith* ([1900] 18 R. P. C. 49), where only one sale of an ounce of tobacco passed off as the plaintiff's was proved, Mr. Justice Kekewich characterising the action as trivial, gave judgment for the defendant with costs. Where the case is of great importance and the issues complicated, costs on the higher scale may be given (*Great Tower Street Tea Co. v. Smith* [1889] 6 R. P. C. 165).

Costs governed by circumstances.

Costs on higher scale.

If the right of the successful plaintiff to the exclusive use of his registered trade mark came in question at the trial, he should ask the Court or the Judge to certify to that effect (see Section 77A of the Act). The result of obtaining this certificate is that in any subsequent action for infringement of the registered mark, the plaintiff, 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 subsequent action certifies that he ought not to have the same.

Certificate of validity of plaintiff's claim to trade mark. Costs as between solicitor and client in subsequent action.

Presumably, following patent practice, to get the benefit of such a certificate in a subsequent action the plaintiff must plead it (*Pneumatic Tyre Co. v. Chisholm* 1895, 13 R. P. C. 488); and following the same practice the second action must have been begun subsequent to the giving of the certificate, otherwise Section 77A would not apply (*Automatic Weighing Machine Co. v. Hygienic Society* [1889] 6 R. P. C. 475).

Certificate should be pleaded in subsequent action.

Appeal may be made both in interlocutory proceedings and from the final judgment of the Court of First Instance to the Court of Appeal, and from the latter to the House of Lords. In a case of urgency an appeal on an interim injunction has been advanced in the list on the ground that the defendant's business would be irretrievably prejudiced by the continuance of the injunction (*Claxenby v. White*, L. R. 6 Ch. 89).

Appeal.

Advancement of appeal.

It seems that a refusal to grant an interlocutory injunction should not be appealed against, even where the defendant refuses to submit to an injunction or to give an undertaking, if he at the same time removes the cause of complaint (*Dale v. Smith*, W. N. [1882], 145).

No statutory action for threats by proprietor of trade mark.

But action might be taken as for trade libel or slander.

The section in the Patent Act of 1883 which makes a patentee liable to an action for threats against alleged infringers, does not extend to trade marks. Therefore the proprietor of a trade mark may give notice that his mark is being infringed, and that he intends to take proceedings without rendering himself liable under the Statute to an action for threats, and he cannot be restrained by injunction from so doing (*Colley v. Hort*, 41 Ch. D. 179; .1888 6 R. P. C. 17). But statements not made in good faith and calculated to injure the trade of another or amounting to trade libel or slander of title may be restrained (*Thorley's Cattle Food Co. v. Massam*, 1880, 14 Ch. D. 763; *Coulson v. Coulson* (1887), 3 T. L. R. 740; *Nihamschienen Fabrik v. Singer* (1893), 10 R. P. C. 310; *Royal Baking Powder Co. v. Wright, Crossby & Co.* (1900), 18 R. P. C. 95). It appears from the latter case that even when the statements complained of are untrue and made maliciously the plaintiff must prove special damage. But mere puffing of one's own goods, in however extravagant terms, is not a libel on the goods of rival traders (*Mellin v. White* (1895), App. Ca. 154).

## CHAPTER VII.

COMMON LAW TRADE MARKS, TRADE NAMES,  
AND THE ACTION FOR "PASSING OFF."

THE last Chapter referred mainly to actions taken in respect of registered trade marks, which, on that account, occupy a privileged position under the Statute.

But it must not be supposed that it is only the owners of registered marks who can obtain relief against infringers or imitators. The owner of a mark or of a trade name which is perhaps incapable of registration may nevertheless restrain piracy by the exercise of his Common Law rights. This is a remedy which is alike open to the trader who never has registered his mark, to him whose mark has been refused, and to the proprietor whose mark has been expunged from the Register. The principle upon which the Court goes is that, whether the imitated mark or trade name is registered or unregistered, it will restrain the practice of fraud by one person at the expense of another. In an action for the infringement of a registered trade mark, as touched upon in Chapter VI., there is usually an ascertained tangible mark, and the issue is simply how and in what respect the infringer has invaded the property constituted by the mark. But, as Lord Blackburn said in *Singer Manufacturing Co. v. Loog* (1882) 18 Ch. D. 395; 8 App. Cas. 150, after referring to frauds committed by the infringement of registered trade marks, "There is another way in which goods not the plaintiffs' may be sold as and for the plaintiffs'. A name may be so appropriated by user as to cause it to mean the goods of the plaintiffs, although it is not and never was impressed on the goods so as to be a trade mark properly so called or within the recent Statutes. Where it is established that such a trade mark bears that meaning, I think the use of the name, or one so nearly resembling it as to be likely to deceive, as applicable to goods not the

Owners of  
both  
registered  
and non-  
registrable  
marks may  
restrain in-  
fringement

Same  
trade mark.

plaintiffs', may be the means of passing off those goods as and for the plaintiffs.'" (See also the instructive remarks of Romer, J., in *Singer v. Spence* (1893), 10 R. P. C. 297).

Common  
law trade  
marks.

*Reddaway  
and Co.  
v. Rothson  
Hemp  
Spinning Co.*

An unregistered or unregistrable trade mark or trade name, such as is referred to by Lord Blackburn, was first termed a "Common Law Trade Mark" by Lindley, L. J., in *Reddaway and Co. v. Rothson Hemp Spinning Co.* (1892, 9 R. P. C. 503), and the latest writers have adopted this name in alluding to such a trade mark. In the case just cited the plaintiffs had been in the habit of using the terms "Camel," "Camel Brand," and "Camel Hair," as descriptive of their woven belting, so that, as they alleged, belting so distinguished was known all over the world as the plaintiffs' manufacture, and no other. The defendants, who had not been long in business, began to use the same terms as descriptive of their belting, justifying their action by alleging that their belting was woven from woollen yarns known in the market as "Camel Hair Yarn," and in some instances having an admixture of camel's hair in the yarn. At the Manchester Assizes, in May, 1892, Cave, J., directed a verdict for the defendants. The plaintiffs moved for a new trial, and it was held in the Court of Appeal that there was evidence which ought to have been left to the jury. A new trial was therefore ordered, but before it took place the matter was arranged, the defendants submitting to an injunction.

This result was so far unsatisfactory, in that the point involved had not been the subject-matter of a direct pronouncement by the Courts. But the question was not to rest here. Another firm of rival manufacturers began to use the name "Camel Hair" in connection with their woven belting, and proceedings were taken by Messrs. Reddaway to restrain them. The case went to the House of Lords (*Reddaway v. Rothson*, 13 R. P. C. 218; 1893 A. C. 499). The defendants contended that as the words "Camel Hair Belting" truly described their goods, which were composed substantially of camel hair, they could not be restrained from using these words. But the House of Lords were of a different opinion, and held that when words which were descriptive of an article have come

*Reddaway  
v. Rothson  
Hemp  
Spinning Co.*

to denote the goods of a particular manufacturer, he is entitled to restrain others from using them so as to deceive purchasers, notwithstanding that the words are a description of the goods.

use by  
others will  
be  
restrained.

The result, therefore, was that practically the plaintiff's established their right to the Common Law trade mark constituted by the word "Camel," which was both an unregistered and an unregistrable word, seeing that the Comptroller had pointed out, and the Board of Trade had held, that it was not only a geographical name, but was also, strictly speaking, either descriptive or deceptive.

Another instance of a Common Law trade mark is to be found in the "Stone Ale" Case (*Montgomery v. Thompson* [1891], 8 R. P. C. 361), which was finally decided in the House of Lords in May, 1891. The respondents and their predecessors had for many years carried on business as brewers at the town of Stone. Their ale had become well known in the market as "Stone Ale." Together with other labels they had registered the words "Stone Ale" as a trade mark. The infringer, Montgomery, built a brewery at Stone, and began to sell his liquor as "Stone Ale." On an action being brought by Thompson, Montgomery applied to rectify the Register by cancelling the registration of the word "Stone." Chitty, J., held that Montgomery should be restrained from using "Stone Ale," and refused the motion to rectify.

"Stone Ale"  
Case.

On appeal it was held that the injunction against the defendant was properly granted, but that the registered mark "Stone Ale" must be removed from the Register, thus changing it from a registered into a Common Law mark.

Geographical  
name  
removed  
from  
Register,  
but  
defendant  
restrained  
from  
infringing.

The defendant Montgomery appealed to the House of Lords, but without success, as the Order of the Court of Appeal was affirmed. Thus it will be seen that even where a party has had the registration of his trade mark cancelled, as being at variance with the law which governs the registration of trade marks, he is not left defenceless, but may uphold his right to the exclusive use of the mark at Common Law.

Similar considerations weighed in deciding *Wotherspoon v. Carr* (1872) L. R. 5 H. L. 508, the "Glenfield Starch"

"Glenfield  
Starch"  
Case.

Case, in which, as Lord Westbury said, it was evident "that long antecedently to the operations of the respondent the word 'Glentfield' had acquired a secondary signification or meaning in connection with a particular manufacture - in short, it had become the trade denomination of the starch made by the plaintiffs. . . . The word 'Glentfield,' therefore, as a denomination of starch had become the property of the plaintiffs."

"*Yorkshire  
Relish*"  
Case.

Secret  
recipe.

A person  
making his  
goods from  
a secret  
recipe has  
a right to  
the sole use  
of the name  
so long as  
he preserves  
his secret.

The case of *Porcell v. Birmingham Vinegar Brewery Co.* (11 R. P. C. 720; 1897 App. Ca. 710; 66 L. J. Ch. 763) is also an instance of a trade name becoming a Common Law trade mark by right of long user. The plaintiff had for thirty-four years designated his sauce which was made according to a secret recipe as "Yorkshire Relish." The defendants began to make and sell a similar but not identical sauce of their own manufacture under the same designation, but with their own name and address on the label. The plaintiff obtained an interlocutory injunction to restrain, and thereupon the defendants issued new labels with the name "Hollbrook's" in large letters and "Yorkshire Relish" in smaller letters. The House of Lords, to whom the case was carried, held that "Yorkshire Relish" meant the manufacture of a particular person viz., the plaintiff. That so long as the plaintiff succeeded in keeping the secret of the sauce, he remained in fact the sole manufacturer of "Yorkshire Relish," and that the defendants in selling their goods as "Yorkshire Relish," when they were not so in fact, committed a fraud upon the public and represented that the goods were the goods of which the plaintiff only was the manufacturer. The same principle held good in the earlier "Angostura Bitters" Case, where the defendant was restrained from calling his bitters "Angostura" until he should find out how to make the real "Angostura Bitters," the composition of which was a secret (*Siegel v. Friedlander* 1878, 7 C. D. 801). It should be noted at this point that when a person who has a trade secret employs workmen under an express or implied contract not to divulge the secret, such employes cannot in breach of trust make use of their knowledge and set it up against their employer; neither can such knowledge be acquired and used by

"*Angostura  
Bitters*"  
Case.

Improper  
use of trade  
secret.

another by such breach of trust (*Williams v. Williams* 1817, 3 Mer. 157; *Escoart v. Escoart Hop & Sugar Co.* 1875, L. R. 10 Ch. 276). But this holds good only where a positive breach of trust has occurred.

The "Camel Hair" Case is thus representative of that class of Common Law mark which by original and continued user becomes, even although descriptive, the sole property of a particular manufacturer in respect of goods open to all the world to make but not to sell under that particular designation. The "Yorkshire Relish" Case is an example of a Common Law trade mark becoming appropriated to a manufacturer of certain goods made according to a secret recipe which other people cannot make because they have not the secret.

But there remains a third class of trade mark or name which is especially interesting to inventors. Suppose, for example, that a man invents an entirely new article or product, to describe which he invents an entirely new name, and then (whether the name is registered as a trade mark or not) proceeds to manufacture and sell the new product or article under that name, the question arises—Can he preserve the right to the sole and exclusive use of that invented name which he has constituted his trade mark after the expiry of his patent? The answer is, Generally speaking, he cannot. As was said by Lord Davey in the *Collins, Colburn & Co. v. Manton and Murray*, (1880) 16 R. P. C. 397: "If a man invents a new article and protects it by a patent, then during the term of the patent he has of course a legal monopoly; but when the patent expires all the world may make the article, and if they may make the article they may say that they are making the article, and for that purpose use the name which the patentee has attached to it during the time when he had the legal monopoly of the manufacture. But my Lords, the same thing in principle must apply where a man has not taken out a patent, as in the present case, but has a virtual monopoly, because other manufacturers, although they are entitled to do so, have not in fact commenced to make the article. He brings the article before the world, he gives it a name descriptive of the article—all the world

New trade  
marks  
applied to  
the  
law  
of  
trade  
marks.

The  
trade  
mark  
patent  
law  
of  
the  
United  
States.

A  
new  
class  
of  
trade  
marks  
has  
been  
introduced  
into  
the  
law  
of  
trade  
marks.

may make the article, and all the world may tell the public what article it is they make, and for that purpose they may *prima facie* use the name by which the article is known in the market."

So, then, if a man invents an absolutely new description of floorecloth composed of boiled oil and finely ground cork and other ingredients and patents it, and then invents a new name for it—say "Linoleum"—and sells it in the market under that name, during the fourteen years of his patent monopoly no one else can make "Linoleum" or sell a floorecloth as "Linoleum." Thus the public only know the article as Linoleum and by no other name, so that to give the inventor a monopoly in the name after the patent had expired would be virtually to give him and his successors a monopoly for ever, and this would be against public policy (*Linoleum Co. v. Nairn* 1878, 7 Ch. D. 834). The "Linoleum" Case was followed in the more recent "Vaseline" Case (*re Chasborough Manufacturing Company's Trade Marks* 1901, 18 R.P.C. 191), where the mark "Vaseline" was struck from the Register as being the commonly known name of a patented preparation of petroleum jelly. And, as Lord Davey says, the same principle must hold good in a thing which is unpatented, and which, when the secret of manufacture is out, is open to any one to make. So that, apparently, the man who attaches a distinctive name to an article already known and open to all the world to make is in a more favourable position with respect to his trade name than if he had been the first discoverer or patentee of the new article.

Deputy  
Director  
new  
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But the principle is sound, for in the latter case there is no question of monopoly in the goods, and it is plain that in the case of a newly invented article for which a new name has to be found, such as "Dynamite," "Cellulite," and "Molinate," and which obtains a world-wide fame under that name and that name only, it would never do to set the original maker or patentee with a perpetual right to the only name by which the article is or possibly ever will be known to the public.

Deputy  
Director  
new  
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When a person gives the name of a distinct article the  
of the  
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that he can restrain anyone else from using the same name, except upon goods which actually are produced in that district. In *Berlay v. Hughes* (1898) 15 R. P. C. 290) the plaintiff had for some years sold his cigars under the name "Dindigul." The defendant began to sell his cigars also as "Dindigul," and alleged that the tobacco actually came from "Dindigul." The plaintiff obtained an injunction restraining him from using the name except upon cigars actually made of "Dindigul" tobacco. But compare this with the decision in *Wolfe v. Currie* (1872) 1 L. R. 5 H. L. 508), where it was held that from long user and notoriety the plaintiff's starch had become so widely known as "Glenfield" starch that the defendant, although making his starch at Glenfield, must not sell his goods as "Glenfield" starch. However, this must be looked upon as an exceptional case. The plaintiffs in the "Whitstable Oyster" Case failed to establish any exclusive right to the name "Whitstable" as meaning oysters from their beds, the defendants showing that their beds were also in Whitstable (*Whitstable Oyster Co. v. Hayling Oyster Co.* 1901, 18 R. P. C. 434).

"Glenfield Starch" Case must be regarded as exceptional.

"Whitstable Oyster" Case.

Apart from the absolute copying of the mark of another, a rival trader might adopt a word or mark so nearly resembling that of another as to be calculated to deceive. Thus, in *Smith v. Cannon Co.* (1896) 13 R. P. C. 108) the defendants were restrained from using the word "Stafford" to designate their stoves, as being too near the plaintiff's mark "Tutford"; and the use of "Savoline" has been held to infringe "Savonol" for soap (*Field v. Waple* 1900, 17 R. P. C. 266).

The use of words too similar to the plaintiff's mark will restrain.

But a much more common attempt at deception is where the general appearance of a trader's goods is imitated in such a manner that they can be easily mistaken for the goods of the person who originated that particular get up. Mr Justice Kekewich said, in *Jones v. Halliwell* (1897) 14 R. P. C. 225, that in this class of case "the eye is the ultimate judge guided of course, or assisted rather, by the various facts which are available." Mr Justice Byrne, in *Chick v. Sharp* (1898) 15 R. P. C. at p. 116 observed that the issue depending upon what is called "copying the get up" of the goods, the actual issue is not on the face whether the Judge is bound, or the jury might be persuaded

general "get up"

the copy is so close as to be mistaken for the original.

deceived, but whether (all of the collateral points having been considered) the true conclusion is that the ordinary customer of the retail dealer is likely to be deceived. Merely originating a certain unregistered get-up does not, however, create a monopoly, particularly if it is imitated shortly after its appearance, as in the "Red, White, and Blue Coffee Tin" Case (*Payton v. Snelling* 1899, 17 R. P. C. 48). In *Rowland v. Mitchell* (1896, 14 R. P. C. 37) the plaintiff's wrapper, containing certain printed matter and a portrait of himself, had been imitated by a wrapper of the defendant with different matter similarly arranged and also bearing a portrait, but not of the plaintiff. The Court held the defendant's wrapper was calculated to deceive, and granted an injunction to restrain passing off, with costs. In *Lichby's Extract Co. v. Chemists' Co-operative Society* (1896, 13 R. P. C. 736) the same liability to confound the plaintiffs' with the defendants' tins caused the Court of Appeal to confirm an injunction against passing off which had been granted in the Court below. In the "Sunlight Soap" Case (*Clare v. Beddingfield* 1898, 16 R. P. C. 3), although the Court of Appeal recognised that some parts of the plaintiff's wrapper had been taken, yet the general resemblance between the wrappers was not sufficiently close to constitute passing off, and an injunction was refused.

"Red, White, and Blue Coffee Tin" Case.

A "get-up" may deceive though details are not copied.

Trader's name.

A further feature in attempts to pass off goods as and for the goods of another is to be found in those cases where a trader's name has been taken or imitated. We have seen that a man's own name or that of a firm may be registered as a trade mark, but only in a distinctive dress, and it is this distinctive dress only which he can claim.

A man's right to use his own name.

It is also common knowledge that a man may use his own name in his own business, so long as there is no fraud or misrepresentation and so long as he uses it in such a manner as to avoid confusion between his goods and those of a rival, no matter how long that rival may have been established in business (*Alcock v. Burtess* 1863, 5 D. & M. 41, 296; *Toston v. Toston*, L. R. 12 C. D. 128; and *Alcock v. Jackson* 1898, 15 R. P. C. 109). But, as was said by Hynd, J., in the latter case, a man entering

quoting the title of the book.

a trade in which another person of a like name has established a reputation, has a burden cast on him to distinguish his goods from those of the other person. It was also said in the Court of Appeal in the same case that a man is not bound to use extra precautions to avoid confusion between his goods and those of other persons in the trade, if such confusion arises solely from similarity of name and from the use of features common to the trade. But such a case must be distinguished from the case where the name of a particular trader has in the market come to denote his goods. An example of this latter case is to be found in *Valentine Meat Juice Co. v. Valentine Extract Co.* (1900) 17 R. P. C. 673), where the defendant company were restrained by the Court of Appeal from carrying on business in meat extracts under the name of "Valentine," and from selling goods of this nature under any name including the word "Valentine." The evidence enabled the Court to come to the conclusion that the plaintiffs, who had traded under the name "Valentine" for nearly thirty years, were entitled to say that the name when used on goods of this nature denoted that the goods were of their manufacture. The defendant Valentine was restrained from carrying on any such business *without clearly distinguishing his goods from the plaintiffs'*, but the injunction against the company was, as pointed out, of a more sweeping nature. In *Dewar v. Dewar* (1900) 17 R. P. C. 311) the plaintiffs failed to convince the Court that the term "Dewar's Whisky" denoted only the whisky sold by them, and an injunction was refused, but the circumstances in this case were incomparably less favourable to the plaintiff than in the "Valentine Meat Juice" Case, as the defendants' firm had also been a long time in existence and the plaintiffs' assumption of the particular words complained of had been of comparatively recent origin. The principle of restraining a man from carrying on business in certain goods under his own name seems to the writer to have reached its extreme limit in the recent case of *Cash v. Cash* (1904) 17 R. P. C. 213), where the defendant, although no trade was proved, was restrained from carrying on the business of a manufacturer of trillings &c under his own name

*in Jamieson v. Jamieson.*

A man not bound to use extra precautions to avoid confusion.

But where trader's name and his goods are indissolubly connected in public mind defendant's acts narrowly scrutinised.

"Valentine Meat Juice" Case.

*Cash v. Cash.*

"Chivers' Table Jelly."

Plaintiff must always prove long exclusive user.

Names which have become public property.

Instances of names become *publici juris*.

But where the owners of the name still carry on business it must appear

In *Chivers v. Chivers & Co.* ([1900] 17 R. P. C. 420) an attempt on the part of the plaintiff to show that "Chivers," as applied to table jelly, meant his manufacture only, failed, it being proved that the defendants had been for a long time in business as jam makers and that the plaintiff had only begun his trade in table jelly ten years before the defendants did so. It may be said with regard to all cases of individual name trade marks at Common Law that the plaintiff can only succeed by proving long exclusive use of the name in connection with certain goods, and in addition to such prescriptive right that the name has acquired a secondary meaning which would cause all such goods sold under that name to be mistaken for the goods of the plaintiff.

At this point it seems not out of place to refer to individual name trade marks which by general use have become *publici juris* and open to anyone to use. Many of these are the names of what were once patented articles which have become so associated with the name of the original patentee as to be known generally and to all the world by that name only, such for example as "Corliss Valves" for steam engines, "Galloway Tubes" for boilers, "Worthington Pumps," and many other instances which will recur to the reader. These names are now lost to the original users so far as exclusive right is concerned, so that any boilermaker may make and sell "Galloway Tubes," or any engineer may similarly make and sell "Worthington Pumps" or "Corliss Valves." In other branches of trade "Harvey's Sauce" was, in *Lazenby v. White* ([1871] 41 L. J. Ch. 354), admitted to be common to the trade, and "Worcestershire Sauce" is in the same category. These and other marks similarly situated would have been of enormous value had their original owners sustained their rights in them. The sewing machine industry furnishes other examples of the individual trade name of a patented article which has become wedded to the article itself, becoming public property. In *Wheeler & Wilson Co. v. Shakespeare* ([1869] 39 L. J. Ch. 36), and in *Singer Manufacturing Co. v. Wilson* (2 Ch. D. 434; 3 App. Ca. 376), the Courts declined to continue a patent monopoly

by a claim to the exclusive use by way of trade mark of a name which had become descriptive of the principle of construction (see also *Daimler Motor Car Co., Limited v. British Motor Traction Co., Limited* [1901], 18 R. P. C. 465, concerning the use of the name "Daimler" as descriptive of a system). But although the term "Singer" as descriptive of a principle was thus thrown open to the public, nevertheless it was decided in *Singer Manufacturing Co. v. Spence* ([1893] 10 R. P. C. 297) that the name must not be so used as to be calculated to deceive the public and cause them to buy the machines as and for the manufacture of the Singer Company.

clearly that they are not the manufacturers of the goods.

The principle as to patented articles applies also to articles registered as a design. In *Winer v. Armstrong* ([1899] 16 R. P. C. 167) the plaintiffs in 1885 registered the design of a sewer trap and sold them during the period of registration, and afterwards as "Winer Interceptors." The traps became well known as "Winer Interceptors." In 1898—viz., eight years after the expiry of registration, the plaintiffs took action against the defendants, who had begun to make and sell traps of the same design as "Winer Interceptors." Byrne, J., held that the name had become significant of that particular design of trap and did not necessarily mean that the goods were of the plaintiff's manufacture. The action was therefore dismissed.

The name of a registered design may also become *publici juris*.

As compared with the action for infringement of a registered trade mark, the action for "passing off" does not greatly differ, except in this respect, that registration forms no part of it, and the plaintiff must prove that the conduct of the defendant is such as to deceive or to lead to deception, or in other words that the defendant is trying to pass off his goods as and for the goods of the plaintiff. The plaintiff must therefore either show that the defendant actually represented his goods to be those of the plaintiff, or by the use of a trade mark or a trade name or by get-up led buyers to believe, or was likely to lead them to believe, that the goods he sold were those of the plaintiff. Seeing, therefore, that a registered proprietor of a trade mark can only proceed upon his registered trade mark substantially as registered, it follows that he might fail upon this view of his claim,

No statutory right in action for passing off.

Plaintiff must prove deception or extreme probability of deception.

In action on registered trade mark it is desirable to add claim for passing off.

Particulars.

Further points in defence.

Relief in action for passing off.

Relief in action against person of same name.

and yet, in the opinion of the Court, be entitled to succeed against the defendant upon the score of passing off. Such being the case, a claim in respect of passing off is generally added in actions for infringement of registered trade marks, so that if the action under registration breaks down, the case in regard of passing-off may succeed. Proof of actual damage done to the plaintiff is not in all cases necessary, but it is advisable if possible to adduce evidence of actual deception. Actual comparison of a plaintiff's and defendant's goods is a potent factor in deciding the question but in certain classes of alleged deceptive get-up, a view and comparison by the Judge does not entitle him to dispense with evidence of deception (*London Quinbros Co. v. Larell*, 1900, 18 R. P. C. 74).

In delivering his defence the defendant, in addition to the general denial of the acts imputed, should attack the position assumed by the plaintiff, and deny that the mark or name or get-up in question has any exclusive reference to the plaintiff's goods; that the mark or name or get-up used by the defendant is different from the plaintiff's, and is not used in such a manner as to pass off other goods as and for the goods of the plaintiff; that the defendant has an independent or concurrent right of user; that the plaintiff is barred from relief by some agreement or acquiescence; or delay, or deceptive or fraudulent use, or abandonment; or for any other reason the defendant may be able to allege.

If the plaintiff in a passing-off action is successful, the relief granted is usually an injunction restraining the defendant from passing off or doing anything calculated to pass off his goods as and for those of the plaintiff; delivery up of all goods bearing the deceptive mark or name or get-up for destruction or erasure; destruction of all blocks, papers, documents, &c., furthering such deception; and damages or an account of profits.

The terms of relief and the form of the injunction are of course varied according to the circumstances and merits of the case.

Where the defendant's name and the plaintiff's name are the same, and the action is taken in respect of deceptive

use of the name, so as to cause confusion between the goods of the parties, the injunction as a rule never goes beyond restraining the defendant from using his name in such a manner as to deceive.

Just as an imitation of a well-known trade mark or trade name, placed upon goods, becomes an instrument of fraud by leading the public to believe that they are buying the goods of one person, whereas the goods are really those of another person, so the trading name of an individual or company may be imitated, on a signboard for example, or in advertisements or circulars, in such a manner as to deceive the public into the belief that they are dealing with the individual or firm whose name has been imitated. Except under the terms of The Companies Act, 1862 (25 & 26 Viet. c. 89), there is no such thing as registration of a firm's name in the same sense as trade mark or design registration.

Trading or  
firm name  
on sign-  
board &c.

Suppose, therefore, a firm of cabinet makers consisting of less than seven members (this being the number entitling to registration under The Companies Act, 1862) were to launch a business under the title of "The London and Counties Furnishing Company," there are no means of registering such a name; and if another firm should assume the same or a deceptively similar name, the first company has only its Common Law remedy. Where the name of the company is composed of words in ordinary use, the evidence as to deception or the probability of deception, through the assumption by another company of a similar name, requires to be very convincing before a successful action can be maintained.

It is not enough to say that the defendant's business is represented as being *similar* to the plaintiff's; it must be clear that it is represented as *actually* the business of the plaintiff, or at least the representations must be of such a nature as to convince the Court that the public will be deceived to that extent (*Churton v. Douglas* [1859], Johns. 174; *Holloway v. Holloway* [1850], 13 Beav. 209). As James, L. J., said in *Hendriks v. Montague* ([1880] 17 Ch. D. 638): "All the Court requires is to be satisfied that the names are so similar as to be calculated to

Court must  
be con-  
vinced of  
the  
probability  
of decep-  
tion.

- produce confusion between the two—so calculated to do it that, when it is drawn to the attention of those adopting the name complained of . . . it is not honest of them to persevere in their intention, though originally the intention might not have been otherwise than honest." An injunction may also be granted where the name is such as to suggest an amalgamation with the plaintiff firm (*Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.* [1899], App. Cas. 83). Where direct fraud is ascertained, as in *Pinet v. Pinet* ([1897] 15 R. P. C. 65), where the defendant had assumed the plaintiff's name with the intention to trade in the same or a similar business, the Courts are always ready to assist the plaintiff.
- "Get-up" of shop front or sign, or using a deceptive name or title thereon, where evidently intended to imitate the plaintiff's, will also be restrained (*Burgess v. Burgess* [1853], 3 De G. M. & G. 896, 22 L. J. 675; and *Foot v. Lea*, 13 Ir. Eq. 484). Just as a shop front may be got up so as to prove deceptive, and thereby cause the public to enter and buy, so a public vehicle may be got up so as to deceptively imitate another's property, and thus cause the public to use it under the belief that they are riding in the vehicle the get-up of which has been imitated. But to succeed in such a case the plaintiff must produce evidence to show that members of the public were actually deceived, and, except where the vehicles are absolutely identical, the Judge ought not to substitute a view under Order L., Rule 4, for evidence that the get-up of the defendant's goods is calculated to deceive (*London General Omnibus Co. v. Latell* [1900], 18 R. P. C. 74).
- A peculiar or unusual name distinguishing a shop or place of business is usually protected from imitation. Thus "Uncle Tom's Cabin" as a name for a curiosity shop would probably be maintainable against an imitator. But this would not hold good if the title were simply descriptive, such as "The Antiquarian Stores" (see *Hudson v. Osborne* [1870], 39 L. J., Ch. 79; *Boulton v. Peake* [1868], 13 Ch. D. 513, note; *Bodega Co., Limited v. Owens* [1889], 7 R. P. C. 31).
- Where an amalgamation is suggested.
- Direct fraud.
- "Get-up" of business premises.
- Public vehicles.
- Distinguishing names for business premises.



Where the trading name is the actual name of an individual or of the members of a firm, and this is assumed by a person or association of a different name or names (as in *Pinet v. Pinet, supra*), the fraudulent intention is obvious. But even when the plaintiff's name is itself assumed, or is a fancy title, relief may be obtained as in "The Christy Minstrels" (*Christy v. Murphy*, 12 How. Pr. 77; *Montague v. Moore*, Seton, Fifth Edition, 539); "The Oldfield Lane Doctor" (*Milner v. Reed* [1870], Sebas. Dig. 328); or "Madame Louise" (*Isaacson v. Thompson* [1871], 41 L. J., Ch. 101), where the plaintiff only missed getting an injunction by her own delay.

Fraudulent assumption of name.

Fancy name assumed by plaintiff.

As to registration under the Companies Act of 1862, Section 20 of that Act provides that "No company shall be registered under a name identical with that by which a subsisting company is already registered, or so nearly resembling the same as to be calculated to deceive, except in a case where such subsisting company is in the course of being dissolved, and testifies its consent in such manner as the Registrar requires."

Registration of company names, Companies Act, 1862.

A company cannot, however, under the Companies Acts, legally register and maintain a name similar to the name of an earlier unregistered company (*Hendriks v. Montague* [1880], 17 Ch. D. 638).

Un-registered firm name.

But in any action brought to restrain the registration of a company with a name so nearly resembling that of an existing company as to cause confusion, evidence is admissible for the purpose of ascertaining how the existing company has used its name and what by reason of its connecting that name with its goods the public have come to attribute to that name. Thus, in *Daimler Motor Car Co. v. British Motor Co.* ([1901] 18 R. P. C. 465) the Daimler Motor Car Co. brought an action to restrain the defendants from registering a company under the name of the *Daimler Wagon Co., Limited*, the plaintiffs relying on Section 20 of The Companies Act, 1862, and also on their Common Law right. The Court held that the word "Daimler" meant a particular system, and was used by all persons who manufactured under the "Daimler" Patents, and that

Right of plaintiff company must be established by evidence.

the plaintiffs had failed to establish that the word "Daimler" was so identified with their goods as to cause confusion if used in the name of another company.

Promoting  
company of  
similar  
name  
without  
goodwill.

From *Tussaud v. Tussaud* ([1896] 44 Ch. D. 678), and also from the "Valentine Meat Juice" Case ([1900] 17 R. P. C. 673), it seems that although a defendant may commence and carry on a business similar to that of the plaintiff in his own name, albeit that name is the same as the plaintiff's, he cannot, nevertheless, start a limited company under his name unless he has a reasonably long-established business and goodwill to assign to the company. According to Stirling, J., in *Tussaud v. Tussaud* (*supra*), if it be granted that a private business properly assigned becomes the property of a joint stock company, there seems no reason why "that company might not be registered under the same name as had previously been used in connection with the business."

Examples  
of relief  
granted.

Injunctions have been granted in *Hoby (The Grosvenor Library) v. Grosvenor Library, Limited* (28 W. r. 386); *Accident Insurance Co., Limited v. Accident, Disease, and General Insurance Co., Limited* ([1884] 54 L. J., Ch. 104); *Manchester Brewery Co. v. North Cheshire and Manchester Brewery Co.* ([1899] A. C. 83); *Guinea Coal Co. v. Pall Mall Guinea Coal Co.* ([1869] L. R. 5 Ch. 155, *see v. Haley*).

Exam ples  
of relief  
refused.

But relief was refused in *Army and Navy Co-operative Society, Limited v. Junior Army and Navy Stores, Limited* ([1879] Sebas. Dig. 393); *Australian Mortgage, Land, and Finance Co. v. Australian and New Zealand Mortgage Co.* W. N. ([1880] 6 C. A.); *Merchant Banking Co. of London v. Merchants' Joint Stock Bank* ([1878] 9 Ch. D. 560); *London Assurance v. London and Westminster Assurance Corporation* ([1863] 32 L. J., Ch. 664), *Daimler Motor Car Co., Limited v. Daimler Wagon Co., Limited* ([1901] 18 R. P. C. 465), and in several other cases. The *ratio decidendi* in these cases is that no one can obtain a monopoly in a name which merely describes the nature of the business, the locality of its operations, or a system of construction.

Fraudulent  
partner-  
ship.

A partnership got up between persons of the requisite names, and intended to take fraudulent advantage of the reputation attaching to an old-established business, will

not be permitted to take the name of the older business, although the partners may be of the same names. Thus, in *Croft v. Day* ([1843] 7 Beav. 84) an injunction was obtained against a man of the name of Day who had associated himself with a person named Martin, and began to sell blacking under the firm name of "Day & Martin."

The Court has jurisdiction to protect foreign trading firms from improper assumption of their firm name in this country, even when the foreign plaintiff firm has no agency here. In *Paulhard et Lerassor v. Paulhard Lerassor Motor Co.* ([1901] W. N. 153) the defendants, an English registered company, were restrained from using the names of *Paulhard and Lerassor*, who were well-known motor car manufacturers in Paris.

Foreign  
firms.

## CHAPTER VIII.

## THE CRIMINAL PROSECUTION.

THE MERCHANDISE MARKS ACTS, 1857, 1891, AND 1894.

Offences  
under The  
Merchandise  
Marks  
Act, 1857.

Block for  
forging a  
trade mark.

Offences.

**F**OLLOWING the Merchandise Marks Act of 1862, *The Merchandise Marks Act, 1857*, makes the forgery of trade marks a misdemeanour. To "forge" a trade mark means the making of a spurious trade mark so like an existing mark for the same goods as to be calculated to deceive. The term also means falsifying a genuine trade mark by alteration, addition, erasure, or other change. If these acts are done without the assent of the proprietor of the genuine trade mark, they constitute offences under the Act, and the person charged must prove that he acted without intent to defraud. In this the present Act differs from the former Act of 1862, which threw the onus of proving "intent to defraud" upon the prosecutor. It is also an offence to make any die, block, machine, or other instrument, for the purpose of forging or being used to forge a trade mark.

The following are the offences and punishments as set forth in the Act, so far as trade marks are concerned:—

## OFFENCES.

## 2. (1) Every person who—

Forging a  
trade mark.

Falsely  
applying.

Making  
block or die.

False  
description.

(a) Forges any trade mark; or

(b) Falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive; or

(c) Makes any die, block, machine, or other instrument for the purpose of forging or of being used for forging a trade mark; or

(d) Applies any false trade description to goods; or

- (e) Disposes of or has in his possession any die, block, machine, or other instrument for the purpose of forging a trade mark; or Selling or possessing printing block.
- (f) Causes any of the things above in this section mentioned to be done, General.

shall, subject to the provisions of this Act, and unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

(2) Every person who sells, or exposes for, or has in his possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark or false trade description is applied, or to which any trade mark, or mark so nearly resembling a trade mark as to be calculated to deceive, is falsely applied, as the case may be, shall, unless he proves - Persons offending must prove absence of guilty knowledge, and must assist prosecutor to discover real offenders.

- (a) That, having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark, mark, or trade description; and
- (b) That, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things; or
- (c) That otherwise he had acted innocently; be guilty of an offence against this Act.

PUNISHMENTS AND PENALTIES.

(3) Every person guilty of an offence against this Act shall be liable Punishments and penalties.

- (i.) On conviction on indictment, to imprisonment, with or without hard labour, for a term not exceeding two years, or to fine, or to both imprisonment and fine; and
- (ii.) On summary conviction, to imprisonment, with or without hard labour, for a term not exceeding four months, or to a fine not exceeding twenty pounds, and in the case of a second, or subsequent, conviction, to imprisonment, with or without hard labour, for a term not exceeding six months, or to a fine not exceeding fifty pounds; and
- (iii.) In any case to forfeit to His Majesty every chattel, article, instrument, or thing by means of or in relation to which the offence has been committed.

Definition  
of "trade  
mark."

In Section 3 of the Act it is set forth that the expression "trade mark" used in the Act means a trade mark "registered in the Register of Trade Marks kept under The Patents, Designs, and Trade Marks Act, 1883," and includes any mark protected by law (whether with or without registration) under international arrangements, such for example as the existing International Convention. The term also includes marks registered under the Trade Marks Act of 1875, and of course extends now to the amending Act of 1901, following the Patents Acts of 1883 and 1888.

Innocent  
retailer.

It will be seen that, unlike what has been said with reference to the civil remedy, a distinction is drawn between the case of a person who issues or causes to be issued the infringing trade mark, and of him who merely sells articles bearing the false mark. In the former case the circumstances all point to intentional fraud. In the latter case the seller or dealer might have acted quite innocently. In such a case the Act tells him how he must proceed to prove absence on his part of "intent to defraud." He must show where he got the goods, and from whom he obtained them. He must also show that he had no reason to doubt the genuine nature of the mark, and, in short, not only produce every possible proof of his own innocence, but also assist the prosecutor to discover the real offenders.

If a person should be convicted under this Act, he is not thereby relieved from further civil proceedings.

Misapply-  
ing a  
genuine  
label.

Where a tradesman shifts a genuine label from goods of superior quality to goods of an inferior quality, although by the same maker, such wrongful user of a trade mark would constitute an offence under the Act. Any person untruly representing that a trade mark is registered is liable on conviction to a penalty.

Offences by  
engravers  
and litho-  
graphers.

Innocent  
engraver.

Engravers or lithographers who execute instructions for a block, stamp, or die, well knowing it to be meant for fraudulent purposes, commit an offence under the Act. But an engraver who makes a die or block according to instructions without any such guilty knowledge, and who derives no advantage from the sale of

the goods to which the forged mark is applied, can clear himself on proof of innocence in the same manner as the innocent seller. Such persons should give immediate notice that they intend to rely on this defence; otherwise they may have to pay the prosecutor's costs, although discharged from the prosecution. A defendant may appeal to the Quarter Sessions, and if charged before a Court of summary jurisdiction he may elect to be tried on indictment.

In cases under the Merchandise Marks' Act the defendant is allowed to give evidence upon oath, and his wife may in like manner be sworn and subjected to examination like any other witness. Evidence.

Among the reported cases under the Act there are very few indeed in which the head and front of the offending has been direct imitation of the prosecutor's trade mark. This is owing to the custom that has obtained of taking many cases which would be fitly the subject of criminal prosecution into the Court of Chancery. It may, however, be said that the rules which regulate comparison of the marks and the evidence which would point to intentional imitation and fraudulent intent are much the same as those obtaining in the High Court. Therefore, the magistrate, or the justices on a summary proceeding, or the Court and a jury on indictment, would practically, in a question of fraudulent imitation, have to decide the same issues that would arise in the Higher Courts. Such being the case, the evidence adduced by the prosecutor should be as full and based upon the same principles that would guide the plaintiff seeking an injunction in the High Court, as already explained in foregoing chapters. Rules of evidence in criminal proceedings based upon those in the civil suit.

An excellent example of a case of criminal prosecution under Section 2 of the Act, and founded upon the alleged fraudulent imitation and forgery of registered trade marks, was decided in 1893 at the London Central Criminal Court before the then Common Serjeant (Sir Forrest Fulton), both the traders who labelled and disposed of the goods and the printer of the labels being found guilty and sentenced. The prosecution was instituted by James Epps & Co., *Reg. v. Hughes.*

Limited, and the defendants (Hughes, Morris, and Fairweather) were indicted for conspiracy to defraud. The prisoners pleaded guilty. The evidence showed that Hughes and Morris had applied the forged labels (which were almost exact imitations of Messrs. Epps's registered labels) to packets of cocoa of an inferior quality; while Fairweather had printed the labels, knowing the fraudulent purpose for which they were intended. Morris and Hughes were sentenced to twelve and five months' hard labour respectively, and Fairweather (the printer) to four months' (*London Daily Chronicle*, 24th October, 1893).

*Reg. v.  
Ellinger.*

Another important case, of special interest to the Manchester trade, was decided in the City Police Court, Manchester, in July, 1893. The prosecution originated with Messrs. G. & R. Dewhurst, merchants in Manchester, and the defendants were shippers in the same city. Messrs. Dewhurst were the proprietors of a combination trade mark for piece goods, known to the trade as their "Rupee Combination." This combination consisted of—

1. A green ticket with a border enclosing a lion, and bearing the name of the firm;
2. The firm's signature in blue stamped upon the cloth;
3. A ticket in black and silver, the chief features being a rupee in obverse and reverse;
4. Figures in blue, stamped on the cloth, and showing the length; and
5. A coloured stripe "heading."

Example of  
fraudulent  
imitation of  
combina-  
tion trade  
mark.

The goods were for export to India. The defendants, shipping to the same markets, had imitated the "Rupee Combination" by arrangements of green and black and silver tickets, signature and figures in blue, together with coloured "headings," which, although not identical with, were deceptively similar to the Dewhurst combination. It was pointed out that the items of the infringing combinations, when compared severally with the items of



the Dewhurst combination, showed readily recognisable differences, nor was the actual relative arrangement of the items in all cases slavishly copied, while the name of the actual shipper or consignee was plainly printed on the tickets and on the cloth. Nevertheless, the unmistakable *general* resemblance, coupled with certain damaging evidence as to fraudulent intent, resulted in the conviction of the defendants. An interesting point in this case is that it is one of those which show that in adjudicating upon an alleged imitation or infringement of a trade mark, the nature of the market and the degree of intelligence or civilisation of the ultimate purchasers—in other words, their susceptibility of being deceived—must be taken into consideration. The fact that in this instance the ultimate purchasers were natives of India, who were, according to the evidence, mostly ignorant of English, and incapable of easily distinguishing minor differences where a general resemblance to the genuine mark existed, had a powerful effect in influencing the judgment adversely to the defendants.

Susceptibility of ultimate purchaser to deception.

The innocent retailer is usually tenderly dealt with if he can show that he has taken reasonable precautions or that otherwise he had acted innocently. In *Christie v. Cooper* (Div. Ct. [1900], 2 Q. B. 522) it was held that a person, albeit he had reason to suspect the genuineness of the trade mark, might, nevertheless, have acted innocently in selling the goods, and might therefore be exonerated under Section 2, Sub-section 2, of the Act.

Reasons for exonerating innocent retailer.

Although not strictly connected with trade marks it might be of use to notice one or two instances of applying a false trade description to goods. For example, in *Kirshenboim v. Salmon & Gluckstein* (Div. Ct. [1898], 2 Q. B. 19) cigarettes in fact machine made, were represented as "hand made." It was held to be no defence that the machine made goods were of as good quality as the hand made, and the defendants were convicted. Apparently "false trade description" might be read "incorrect" trade description.

Applying false trade description.  
"Hand made Cigarette" Case.

The false description need not be actually applied to goods. A false description in an invoice referring to the

False description need not be

actually  
applied to  
goods.

goods is within the Statute (*Budd v. Lucas*, Div. Ct. [1891], 1 Q. B. 408; *Coppen v. Moore*, Div. Ct. [1898], 2 Q. B. 300; *Cameron v. Wiggins*, Div. Ct. [1900], W. N. 253; [1901], 1 Q. B. 1). But the mere handing over of two half-pound packets of tea by a salesman in response to a demand by a purchaser, which packets contained less than the full weight, was held not to constitute an "application" to the goods of a false trade description of their weight within the Statute (*Langley v. Bombay Tea Co.*, Div. Ct. [1900], W. N. 141; [1900] 2 Q. B. 460).

Right of  
defendant  
to question  
validity of  
registra-  
tion.

It has been a matter of discussion whether a defendant, prosecuted under the Merchandise Marks Act, can avail himself of the privilege, enjoyed by a defendant in the higher Courts, of questioning the validity of the registration of the mark which he has been charged with fraudulently imitating. *Prima facie* one would think that the criminal charge should not deprive him of that advantage, but the writer is unable to point to any judicial solution of the question.

One of the amendments, made the 14th December, 1900, upon the terms of the International Convention of 1883, was to the following effect:—

Amend-  
ment on  
Inter-  
national  
Convention,  
limited by  
Merchandise  
Marks  
Act, 1887.

*Article X, bis.*—The subjects or citizens of the States parties to the Convention (Articles II. and III.) shall enjoy in all of the States of the Union the protection accorded to native subjects or citizens against dishonest competition, forging, and dishonest use of trade marks abroad.

This Article when adopted was accepted by the British Delegates subject to the following declaration:—

It is to be clearly understood that Great Britain will not be bound to give protection beyond that established by The Merchandise Marks Act, 1887, which is most stringent and complete.

The text of the Convention, with the new amendments (consolidated), will be found in Appendix A. The new Article will prove a useful weapon in the hands of those British manufacturers who have hitherto seen their trade marks forged and fraudulently applied in foreign countries, almost with impunity.

## PART III.

## COPYRIGHT IN DESIGNS.

## CHAPTER I.

## INTRODUCTION.

THE protection of Designs applicable to manufactured articles is by no means a thing of absolutely modern creation. It is true that prior to 1787 no such thing as legal proprietorship in a design existed; but when at that date the Legislature awoke to the desirability of creating such proprietorship, it never ceased from time to time to improve and enlarge upon the original measure, the immediately beneficial effects of which were no doubt at once apparent. The proofs of its interest are to be found in the fact that between 1787 and the date of the present Statute not less than twelve enactments were passed relating to the protection of designs, the bulk of these Acts being indicated in the third schedule of the present Act of 1883.

Originally  
no pro-  
prietorship  
in designs.

The first in 1787 (27 Geo. III. c. 38) seems to have been of a tentative nature seeing that it was limited to expire at the end of the succeeding parliamentary session. By its terms, designs applicable to printed linens, cottons, calicoes, and muslins were copyrightable by their proprietors for two months from the date of first publication.

First  
Designs  
Act, 1787.

In 1794, by an amending Act (34 Geo. III. c. 23), the former Act was made perpetual, and the term of two months was extended to three. By a further Act passed in 1839 (2 Vict. c. 13) the provisions of the original Act were made to include textile fabrics of wool, silk, and hair,

Amending  
Acts, 1794  
and 1839.

Extension to Ireland.	or mixtures of linen, cotton, wool, silk, and hair, the operation of the Act being at the same time extended to
Creation of Register of Proprietors.	Ireland in addition to England and Scotland. An Act of the same year closely following the latter Act created a Register of Proprietors, and gave protection for twelve months from the date of registration. The Act at the same time extended the field of articles to which designs
Metal work designs.	were applicable, and provided that designs in metal work were to be protected for three years instead of for twelve months.
Act of 1842.	Then followed the consolidating and amending Act of 1842 (5 & 6 Viet. c. 100), whereby the definition of designs and the methods of application, whether to the ornamentation or to the moulding or shaping of the article, were particularised. The different goods susceptible of treatment were classified, and, in addition to the recovery of penalties for piracy, the proprietor was given a right of action for damages.
Action for damages.	
Act of 1843. Useful designs.	The Act of 1843 (6 & 7 Viet. c. 65) introduced the feature of "useful designs" in articles of manufacture, the Registrar (whose office had been created by the preceding Act) being empowered to exercise his discretion as to what were "ornamental" and what were "useful" designs.
Act of 1850. Provisional registration.	In 1850 an Act (13 & 14 Viet. c. 104) was passed providing for the registration of designs within the Sculpture Copyright Act, but the chief feature in this Act was the introduction of "provisional registration" of designs.
Acts of 1858 to 1875. Register entrusted to Commissioners of Patents.	Minor Acts followed in 1858, 1861, and 1865, extending and modifying in detail the previous Acts, and by the Act of 1875 (38 & 39 Viet. c. 93) the ministerial powers and duties of the Board of Trade and the custody of the Register were transferred to the Commissioners of Patents, who from the date of that Act administered the Designs Office.
Patents, Designs, and Trade Marks Acts, 1883 to 1901.	Lastly, the whole of these prior Acts then surviving were repealed by the Patents, Designs, and Trade Marks Acts of 1883 to 1901, which, together with the Designs Rules, now regulate and govern the registration of designs.
Formerly two types of design:	The reader will thus note that, prior to the now subsisting Acts of 1883 to 1901, there were two distinct

forms of copyright in Designs--viz., "Ornamental" and "Useful." Ornamental designs referred solely to such designs as are used to beautify articles of manufacture, such as designs for printed calicoes, wall papers, carpeting, and the like, or raised or flat ornaments upon all sorts of goods, or ornamental shapes of manufactured objects. Useful designs, on the other hand, referred to objects whose novel shape or configuration enabled them to fulfil a useful purpose, such, for example, as an ink-bottle moulded with a recess to fulfil the additional function of a pen tray; or a tool whose shape or configuration enabled it to be used for more than one purpose; or a pavement light or prism of such a shape or configuration as to enable it to divert light into cellars.

"Ornamental" and "useful."

Now, however, under the present Act this distinction between Ornamental and Useful Designs is abolished, and a design is registered for the ornament or pattern, or for the shape or configuration, the latter not necessarily meaning a beautiful or artistic shape or configuration.

Distinction now abolished.

As to any *useful effect* that may be brought about by the shape or configuration of a design, registration gives no claim in respect of this. The shape or design must appeal to and be judged by the eye alone, and the Court will disregard all reference to the useful effect, if any such exists.

Utility not considered.

Thus, in *Hetch Foundry Co. v. Walker, Hunter & Co.* (1889) 6 R. P. C. 5544, the Lower Courts, hampered probably by some reminiscences of the extinct Useful Designs registration, instanced the useful effect of the registered design of a kitchen range fire-door as one of the reasons for recognising and maintaining the validity of the registration. But the Judges in the House of Lords, while upholding the decision of the Courts below, expressly pointed out that the *utility* of the design must not be allowed to influence the question in any respect.

*Hetch Foundry v. Walker.*

The propriety of this view has never since been doubted, and in *re Morton's Design* (1900) 17 R. P. C. 117) Mr. Justice Farwell, when the question of utility was raised, said: "What you have to see is whether, tested by the eye, the design is novel or original within the meaning of the

The only test is that of novelty and originality.

Act. That it may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original."

This goes a long way towards clearing the decks for a proper comprehension of the present Act, and makes plain the fundamental principle that under the present Statute the old and familiar differences between ornamental and useful designs, with all the considerations that flowed from these differences, are abolished and done away with.

There must be a recognisable difference from something done before.

Practically speaking, in the eye of the Act a novel and original design simply means something in the decoration, shape, or appearance of an article different to a sufficiently appreciable extent from anything publicly done before in the same article or class of article. Those of the succeeding pages which are devoted to the consideration of actual examples will show how small a difference may constitute a valid and registrable design. By means of these examples it is hoped the significance of the word "design" within the Act may become apparent. To discuss the larger and more abstract meaning of the term is not within the province of these pages.

Following the convenient arrangement of the two preceding divisions of this work, the succeeding chapters will deal successively with the Procedure in Registering Designs, including a reference to the Register; the Persons Qualified to Register; the Subject-Matter of Designs; Novelty; Marking; the Action for Infringement, and the Rectification of the Register.

CHAPTER II.

PROCEDURE IN REGISTERING DESIGNS.

THE procedure in registering designs is simplicity itself, and the scope of this chapter will be limited to bringing together, condensing, and classifying the information scattered throughout the Act, the Board of Trade Rules, and the Comptroller's instructions.

Procedure  
in  
registering.

Stamped forms of application to register, price 10s. in Classes 1 to 12 (except for lace), and 1s. in Classes 13 and 14, and also for lace designs, can be obtained at the chief post-offices of most important towns. Examples of these forms are to be found in Appendix II. By following the marginal instructions on the application form, "E," no mistake need be made by the applicant in filling in the particulars. The only part of the form that calls for the exercise of judgment is that where the applicant is directed to state the nature of the design, and "whether it is applicable for the pattern or for the shape." The latest instructions issued by the Patent Office require that the statement of the nature of the design shall particularise whether it is applicable for "the pattern" or for "the shape or configuration" or for "the ornament," these more extended terms being drawn from Section 60 of the Act. It may be taken that the terms "pattern" and "ornament" are, in many cases, practically synonymous. If any difference is to be recognised, "pattern" may be taken to refer to repeat designs, such as checks, stripes, or combinations of that description, or floral or other repeat devices which are usually employed to decorate window-curtains, calicoes, carpets, wall-papers, and the like; while "ornament" would more fitly apply to ornamental tracery or designs upon metal articles or picture frames, or furniture, or goods, or utensils such as cutlery or china. Lace designs (in Class 9) are classified as "patterns," and the lace design application forms, E<sup>1</sup> and O<sup>1</sup>, which appear in the set of Rules which came

Application  
forms.

Statement  
of nature of  
design.

Pattern,  
shape or  
configura-  
tion, or  
ornament.

Pattern.

Ornament.

Shape or  
configuration.

into operation on the 30th of November, 1893, contain a statement that "the nature of the design is the pattern." It may be noted that these latest application forms for lace request the Comptroller to register the accompanying design "without search." "Shape or configuration" evidently refers more particularly to manufactured objects and articles in the round, and relates to general outline rather than to surface decoration. The term would properly describe a design for a tombstone, or a chair, or a lamp-stand, and each of these might combine ornament with it, as set forth in Section 60.

Short  
description  
of object  
might be  
added.

Copies of  
design.

When thought to be necessary, a short technical description of the article may be added, with the part or parts which are claimed as new or original specifically defined. The form is signed by the applicant or his authorised agent and dated, and is then ready for filing. The application form should be accompanied by three exactly similar drawings, photographs, or specimens of the design. The drawings, photographs, tracings, or specimens should be mounted on foolscap sheets of paper of the same size as Form E (13 in. by 8 in.). Rough sketches or unfixed pencil drawings will not be accepted. When the design refers to the shape or configuration, two or more views of the object may be given, if such should be necessary, to convey a correct impression of the design. Both views should be on the same half-sheet of foolscap. Each drawing or specimen of a design in Classes 13 and 14 should show the complete pattern and a portion of the repeat, and ought not to be of less size than 7 in. by 3 in. When specimen cuttings of the design are furnished instead of drawings, they must be of a nature that will permit of their being pasted into books. The drawings or mounted specimens should be signed by the applicant or his agent.

Signature  
of  
applicant  
or agent.

When the papers have been thus completed they should be delivered or sent by post to—

The Comptroller,

Patent Office (Designs Branch),

25 Southampton Building

Chancery Lane,

London, W.C.



The goods to which designs are applicable are divided into fourteen classes. The following is a list of the classes:—

Classifica-  
tion of  
goods.

1. Articles composed wholly or chiefly of metal not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, *papier mâché*, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including bookbinding of all materials.
7. Paper-hangings.
8. Carpets and rugs in all materials, floorecloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework in muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece-goods.
14. Printed or woven designs on handkerchiefs and shawls.

By Section 58 of the Act the protection afforded to a registered design is restricted to the particular class or classes of goods in which the design is registered.

Same design may be registered in more than one class.

The same design may be registered in more than one class, but for each class a separate application, each with its annexed three representations, will be required.

Registration in sets.

When the design is to be applied to a set, each of the drawings accompanying the application should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Lace designs.

There is a special form, "O," for applications of this nature, and the stamp is £1. For sets of lace designs in Class 9 a special form, O1, is provided.

Convent applications.

Should an applicant be desirous of losing no time in making his application, he may send up the application forms, accompanied by a single sketch, instead of the three careful drawings or photographs required. This fixes the date of the application, and the finished drawings may then be made at greater leisure, and afterwards filed. The sketch and the drawings must, however, agree in showing the nature of the design.

Certificate of registration.

On receipt of an application the Comptroller considers the design, and if he decides to register it he sends a certificate of registration to the applicant, sealed with the seal of the Patent Office.

Objection to register.

The Comptroller might, however, decline to register, and in that case, before exercising the discretionary power given to him by the Acts adversely to the applicant, the Comptroller shall, if so required by the applicant, within one month from the date of the Comptroller's objection, give the applicant an opportunity of being heard personally or by his agent, by sending the applicant ten days' notice of a time when he may be so heard. Within five days from the receipt of this notice the applicant must notify the Comptroller whether or not he intends to be heard.

Hearing.

The decision of the Comptroller consequent upon the hearing is then notified to the applicant.

Appeal from refusal to Board of Trade.

If this decision is a refusal to register, the applicant may still appeal to the Board of Trade. If he intends to do so, he should, within one month from the adverse decision, leave at the Patent Office a notice of his intention to appeal. The form of this notice (Form F) will be found in Appendix II. The notice is to be accompanied

by a statement of the grounds of appeal and of the applicant's case in support thereof. A copy of the notice should at the same time be sent to the Secretary of the Board of Trade, 7 Whitehall Gardens, London. The Board of Trade will then appoint a hearing, and a notice of the time and place of hearing is sent to the Comptroller and to the applicant. After the hearing, the Board of Trade gives its decision, and this is final. The Board might in some cases refer the matter to the Court. There is no provision as to costs.

Final  
decision.

When registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered. During the existence of the copyright in a design, the design shall not be open to inspection except by the proprietor, or by a person authorised by him, or by the Comptroller, or by the Court, and then only in presence of the Comptroller or his representative, and upon payment of the prescribed fee. The person making the inspection is not allowed to make any copy of the design.

Inspection  
of regis-  
tered  
designs.

When the copyright in the design has ceased, the design is open to inspection by anyone paying the prescribed fee, and copies may be freely made.

Inspection  
of expired  
designs.

#### SEARCHES.

Any person wishing to know whether the registration of a particular design marked as "registered" is still in force, and when and by whom it was registered, may obtain the information he requires by producing or sending the design, with its mark and number, to the Comptroller, and paying the prescribed fee. The request for search should be made on Form "X" (see Appendix II), stamped with five shillings.

Searches by  
Comp-  
troller.

A still more valuable provision in the Rules empowers the Comptroller, on payment of the same fee, to make a search among the registered designs for the purpose of finding whether a design produced by the person requesting the search is identical with, or an obvious imitation of, any registered design still in force.

Comptroller's certificate not evidence.

This is a precautionary measure that might be recommended to manufacturers who contemplate the production of a design concerning which they may have any doubt. It must, however, be said that if, even after receiving the Comptroller's certificate that it is *not* an obvious imitation, the owner of a registered design should take action on the ground that it is an obvious imitation, the Comptroller's certificate is not admitted as evidence on the defendant's behalf, and has no weight with the Court.

#### REGISTER OF DESIGNS.

Proprietor entitled to Register.

Upon the issue of the certificate of registration, the name, address, and description of the proprietor of the design, together with the date and number of registration, are entered in the Register of Designs by the Comptroller.

Assignment or licence entered on Register.

When a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design, either exclusively or otherwise, a request for the entry of his name in the Register as such proprietor, or as having acquired such right, should be addressed to the Comptroller, and left at the Patent Office, Designs Branch. This request, which is made on Form "K" (see Appendix II), is stamped with ten shillings in the case of designs in Classes 1 to 12, and with one shilling in the case of designs in Classes 13 and 14. The assignment or licence must be in writing.

Request for entry.

The request should state the name, address, and description of the claimant, and give particulars, with dates and names of the assignment, transmission, or licence by virtue of which the request is made.

Verification by declaration.

The request concludes with a statutory declaration, signed by the claimant, verifying and declaring the truth of the several statements made and particulars given in the request. The Comptroller will then alter the Register in accordance with the request.

Body corporate may be registered.

When the request is made on behalf of a firm or partnership, it should be signed by some one or more members of the firm or partnership, or by his or their

duly authorised agent. A body corporate can be registered as proprietors by its corporate name, and the request may be signed by a director or by the secretary, or by the duly authorised agent of the body corporate.

When an order has been made by the Court to rectify the Register, the person in whose favour the order has been made should forthwith leave at the Patent Office an office copy of such order, whereupon the Register will be rectified or the purport of the order duly entered in the Register as the case may be. Four clear days' notice of every application to the Court for rectification of the Register should be given to the Comptroller.

Duty of person in whose favour order of Court has been made.

The Register of Designs shall be *prima facie* evidence of any matters directed or ordered by the Act to be entered therein.

Register of Designs *prima facie* evidence.

A certificate of any entry on the Register of Designs, for use in legal proceedings, may be had from the Comptroller by making a request on Form "I" (see Appendix II), which is stamped with five shillings.

Certificate of entry.

#### INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

Any person desirous of exhibiting an unregistered design at an industrial or international exhibition, certified so to be by the Board of Trade or by an Order in Council made in pursuance of Section 57 of the Act, should give the Comptroller seven days' notice of his intention to exhibit, and such notice must be given upon Form "L" (see Appendix II), stamped with five shillings. This notice preserves his prior right to make application for registration of the design during six months from the opening of the exhibition. The notice to the Comptroller should include a brief description of the design, and be accompanied by a sketch or specimen. Application for registration should be made within six months of the opening of the exhibition.

Exhibition of unregistered designs.

#### DURATION OF COPYRIGHT.

The *Duration of Copyright* is limited to five years from the date of registration, and there is no provision for extension of this time. An unusual clause for the fostering of native industry occurs in Section 54 of the Act, which

Duration of copyright.

Working clause.

provides that if a registered design is used in manufacture in any foreign country, and is not used in this country within six months of its registration here, the copyright in the design shall cease. This clause is akin to the condition of "working" attached to the grant of many foreign patents.

Copyright extends only to United Kingdom.

It might be thought needless to say that the protection accorded to designs by The Patents, Designs, and Trade Marks Acts, 1883 to 1901, does not extend beyond the limits of the United Kingdom.

A tort created by a British Statute must, to be actionable, have been committed in this country.

Reference, however, may be made to a case (*Potter & Co. v. Braco de Prata Co.* [1891] 8 R. P. C. 218) in which the plaintiffs, who were a British firm, sought to make the defendants (also British subjects) liable for the infringement of certain calico-printers' designs. It was admitted that the designs of the plaintiffs were being copied and sold, but the defendants pleaded that the goods bearing the designs were manufactured and sold in Portugal and Brazil—countries which were not subject to the operations of the Act. The judgment of the Lord President was to the effect that an infringement of a design registered under the Act consists in the production and sale of goods in this country, where they are protected, and nowhere else. No right is secured to a registered design in a foreign country by registration here, except the right under the International Convention (see Appendix A).

The Acts of 1883 to 1901 extend to the Isle of Man, but nothing in the Acts is to affect the jurisdiction of the Courts in the Isle in proceedings for infringement or in any action or proceeding respecting a design, competent in those Courts (see Section 112 of the Act, Appendix F). Copyright in a registered design does not cover the Channel Islands.

#### INTERNATIONAL AND COLONIAL ARRANGEMENTS.

Persons who have applied for registration of a design in any country or colony under the Convention, and who apply for registration in another country within four months thereof, will obtain the date of their original application (see Section 103, and Appendix A, page 431).

CHAPTER III.

PERSONS QUALIFIED TO REGISTER AND TO BE REGISTERED PROPRIETORS.

A PERSON qualified to register a design is the author or inventor of the design unless he produced it on behalf of another person for a good or valuable consideration.

Who may register.

To be precise, the words of Section 61 of the Act which purport to define the proprietor of a design are as follows:—

“The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent but not otherwise.”

The author or purchaser or person buying the right to apply the design.

Section 5 of the old Act of 1842 was much to the same purport, and under that measure it was held, in *Lazarus v. Charles* ([1873] L. R. 16 Eq. 117, 122), that where a person has a workman in his employ, and the workman in the course of his business and employment makes a design which is new and original, the master may register the design as his property; but that persons not the original designers nor the employers of the designer, but merely customers who made a contract with the foreign designer that he should supply them with articles in this country according to the design, were not entitled to register themselves as proprietors here, since they were neither authors of the design nor had they purchased it for a valuable consideration. As Malins, V.-C., said in this case:—“The plaintiffs were not entitled to any merit of

Master and servant.

Exclusive licensees to sell cannot register as proprietors.

*Lazarus v. Charles.*

invention; they only did as anyone else might do; that is, they purchased the articles, but they gave no consideration to entitle them to be the proprietors of the design under the terms of the Act; for the agreement to purchase the articles from the manufacturer can form no consideration within the meaning of the Statute. Therefore they are not the designers of the article, nor are they entitled to be the proprietors by virtue of having purchased a design for valuable considerations. That is, in my opinion, a fatal objection to the plaintiff's title."

Even where an exclusive right to sell was of the essence of a contract between the designer and the customer, the customer was held not entitled to register. In *Jewitt v. Eckhardt* (1878) 8 Ch. D. 404 an American manufacturer purported to sell to the plaintiff the sole right to deal in an article of a new design which was about to be put upon the market, it being stipulated that the plaintiff should obtain the goods exclusively from the manufacturer. Here it was held that the plaintiff, not having under the contract the right to manufacture, had not acquired the right to apply the design and could not be registered as proprietor.

*Jewitt v.  
Eckhardt.*

Agent for  
foreign  
principals.

The agent of a foreign firm selling goods of a particular design in this country for his foreign principals has no claim to be registered as proprietor of the design (*Guillemain's Design* [1886], 55 L. J. Ch. 309).

*Good file*  
mistaken  
and non-  
fraudulent  
registration  
may be  
cured by  
substitution  
of true  
author's  
name.

*Greenall's  
Design.*

Where a design was mistakenly registered by an agent of the designer in his own name instead of that of his principal, but without any fraudulent intent, the Court ordered the principal's name to be substituted for the agent's (*Greenall's Design* [1899], 17 R. P. C. 139). But if the registration were originally fraudulent it seems that in motions to rectify the Register the practice in trade marks would be followed—viz., to strike the design off the Register and let the true designer re-apply in his own name. But how if in the meantime the design had been published? Re-registration by the true author would be futile in such a case, unless the Court were to order that the new registration should be dated the same as the original wrongful entry.



Although in patent practice the first importer of an invention from abroad is considered the true and first inventor, there seems no reason to suppose that a mere first importer of a design from abroad, although not in any fiduciary relationship to the foreign author, could claim to be legally registered as proprietor (*Lazarus v. Charles* [1873], L. R. 16 Eq. 117).

First importer.

An assignee of a registered design steps into the shoes of the registered owner, and may on application to the Comptroller be registered as proprietor (see Form "K" in Appendix II). Holders of licences may also enter a notice of the licence, but neither assignment nor licence can be entered until the original proprietorship has been placed on the Register (*Jewitt v. Richardt, supra*). A bare licensee cannot sue for infringement, nor can the assignee until his name is on the Register (*Woolley v. Broad* [1892], 9 R. P. C. 208). In the latter case, where an unregistered verbal licensee joined with the proprietor in an action for infringement, judgment for the defendants was given so far as the licensee was concerned.

Assignee.

Licensee.

Licensee for sale cannot sue for infringement.

Where the proprietorship is disputed, the onus of proof lies on the party claiming the proprietorship (*Heinrich's Design* [1892], 9 R. P. C. 73).

In disputed proprietorship onus of proof on claimant.

A design is personal property, and on the death or bankruptcy of the proprietor goes to his personal representatives or to the trustee in bankruptcy.

Design is personal property.

To conclude, the persons qualified to be placed on the Register as proprietors may be classified as follows:—

List of persons qualified to register as proprietors.

1. The designer or author of the design.
2. A person on behalf of whom the designer or author has executed the design for a good or valuable consideration.
3. A person who has acquired the design or a share therein for a good or valuable consideration (*i.e.*, an assignee of the whole or a part); or has acquired the right, either exclusively or otherwise, to apply the design to manufactured articles.
4. Any person upon whom may devolve the foregoing property or rights in the design.

## CHAPTER IV.

## SUBJECT-MATTER OF DESIGNS.

Defini-  
tion of  
"Design."

Must be  
capable of  
application  
to some  
article of  
manufac-  
ture.

THE term "Design" is defined in Section 60 of the Act to mean any design applicable to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, stamping, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for sculpture or other thing within the protection of the Sculpture Copyright Act of the year 1814 (54 Geo. III. c. 56).

Thus a design, within the Act, may be some pattern or ornament printed or produced on the flat, such as woven or printed designs on textile fabrics, paper-hangings, floorcloths, or the like; or patterns or designs etched, or stamped, or cast, or embossed, or cut, or otherwise produced on metal articles, or glass, or plastic material, or furniture, or tiles, or worked or woven, as in lace; or it may be for artistic or beautiful shape or configuration, as in a lamp stand, or lamp shade, or iron railing, or gate; or for shape, in which no appeal is made to the sense of beauty, as in a new shape or configuration of grate-door, or oil-can, or cravat, &c. Or, as the Act says, the design may contain two or all of the foregoing elements — *i.e.* ornament, pattern, shape, and configuration.

Design may  
combine  
ornament,  
pattern, and  
shape.

No utility  
necessary.

It will be noted that the section does not make the smallest allusion to utility. It is the design, and the design alone, that is protected. The Court will not look beneath the surface, but must find the reasons for registration

apparent to the eye. If a useful object is attained, well and good; but this consideration will not be allowed to obtrude itself as an element to be taken into account.

In the case of *Herby Foundry Co. v. Walker, Hunter & Co.* (1889: G. R. P. C. 551), already referred to, the design was applied to a kitchen range fire-door, and consisted in casting an "ogee" moulding upon the upper edge of the door, which moulding filled in the gap across the top of the grate when the door was closed, and practically continued the moulding of the same description which already extended along the front of the grate on each side of the grate. Its practical advantages were, that it did away with the usual hinged fall-bar which had before been used to bridge the gap, and also helped to exclude cold air from the top of the grate. The new door was not registered as part of the range, but as an object by itself, the short specification on the application form being, "Range fire-door, with moulding on top: *Shape* to be registered." The defendants (the appellants in the House of Lords) had infringed by using a similar fire-door.

*Herby  
Foundry  
v. Walker,  
Hunter  
& Co.*

Range  
fire-door.

"Shape"  
to be regd.

The Lord Ordinary, in giving judgment for the plaintiffs, and confirming the validity of the registration, laid stress upon the elements of utility; and on appeal the Inner House, confirming the Lord Ordinary, made the same mistake. Finally, on appeal to the House of Lords, the decisions of the Lower Scotch Courts were affirmed, but their error in allowing the question of utility to influence them was strongly insisted upon, and it was laid down that the eye alone must be the judge in dealing with a design. The defendants' fire-door had also a moulding along the top, and that being the plaintiffs' registered design, judgment was given accordingly. As Lord Fitzgerald said towards the conclusion of the case: "In the course of the discussion at the bar one of the learned counsel asked us to put the two things (*i.e.* the two fire-doors) side by side, and said that we should see by a look that the article produced by the appellants was an obvious imitation of the registered design of the respondents. My Lords, I looked at the two things then, and I came to the conclusion that the door of

Utility must  
not be con-  
sidered.

The eye to  
be the  
judge.

the appellants was clearly an obvious imitation of the registered design of the respondents, and from that moment I thought that the argument was at an end."

*Meady v. Trow*,  
Woven  
Basket Case,  
*Compt. v. Spinning*,  
Corset Case,  
Farwell, J.,  
on utility in  
*Meady's*  
*Design*,  
O.R. 318.

The judgment in the above case was resorted to for guidance in *Meady v. Trow* (1892) 9 R. P. C. 333) by the Divisional Court; and in *Cooper v. Spinnington* (1893) 10 R. P. C. 261; Mr. Justice Chitty decided that the utility of the registered corset could not make up for its shortcomings as a design. In the more recent deliverance of Farwell, J., in *Meady's Design* (1900) 17 R. P. C. 117) the necessity of disregarding utility in designs was again insisted upon. Said the learned Judge: "That it (the design) may be useful seems to me to be immaterial, because I think it must be admitted that however useless a novel design may be, it would still be within the meaning of the Act if it were novel or original."

Instance of  
very slight  
subject-  
matter.  
*Walker v. Scott*.

The case of *Walker v. Scott* (1892) 9 R. P. C. 482) is another instance in which a design, while conforming to the requirements of the section, yet had wrapped up in it an essentially useful purpose or result. The design was applicable to a cyclist's oil-can, and consisted in rounding the edges of the can, so that when carried on the person there was no danger of its catching or cutting the clothes or person. The validity of the registration was not questioned by the defendant, and Chitty, J., in giving judgment for the plaintiff, did not seem to doubt its fitness as subject-matter. The design was practically a modified shape of oil-can. It was a change of shape apparent to the eye, and that satisfied the Court. The fact that the change did not mean any added beauty, and that it undoubtedly did enlarge the usefulness of the can, had nothing to do with the question.

A design  
might be  
or some-  
thing also  
patentable.

While thus showing that *utility* does not form a recognised element in a design, it may be advisable at this point to go a step further and glance at a possible confusion between patentable inventions and designs. The judgment of Lord Shand in *Walker v. Falkirk Iron Co.* (1887) 4 R. P. C. 390) is an authority for saying that it may well be that something which is perfectly fit subject-matter as a design might also be fit subject-matter for a patent.

For example, the range-door referred to in that case, by virtue of its useful functions, and in combination with the range, would undoubtedly have constituted a patentable invention, and yet the registration of the door as a design was upheld by the Court.

Nevertheless, such an instance is likely to be rare, and it may be instructive to notice an example where the registration of a design was held to fail, on the ground that it was not properly a design, but a patentable invention. In *Meady v. Tice* (1892 9 R. P. C. 333) a design of basket was registered, the basket being woven in such a manner that the osiers were worked in singly, the butt-ends showing outside; the whole, on being finished off, presenting a very pretty appearance. The jury in the County Court found that the basket was a novelty, but the judge, doubting whether it was fit subject-matter for registration as a design, granted an appeal to the Divisional Court. There it was held that the so-called design was really a method of manufacture, and should have been patented. Again, in *Cooper v. Spurlington* (1893 10 R. P. C. 264) the plaintiff had registered as a design a corset, in which the busks in front, although really fastened together by eyes and studs, had yet, when secured upon the wearer, the appearance of having been laced together. This appearance was obtained by the arrangement and display of certain diagonal lacing which confined the busks in their sheaths. The general appearance was similar to the admittedly more becoming appearance of a laced-up corset. But then, to lace up a corset was a tedious operation, whereas in the plaintiff's corset the busks were secured at once by means of the eyes and studs. It was held by the Court that in a design the eye must be the judge, and although in the registered corset there was undoubtedly something new which might have been patented, nevertheless the *appearance* to the eye was not new, but was precisely the same as the old laced-up corset, which indeed it was designed and intended to imitate. Accordingly, Chitty, J., refused the plaintiff's motion for an injunction.

But a patentable invention might be held subject-matter for design.

*Meady v. Tice.*

*Cooper v. Spurlington.*

A design must be judged from its appearance, not its uses.

Combina-  
tion  
designs.

*Harrison v.  
Taylor.*

A new combination of two or more old patterns or designs might form good subject-matter for registration as a new and original design. There is a case under the old Act of 5 & 6 Viet. c. 100—that of *Harrison v. Taylor* ([1859] 29 L. J. Ex. 3; 4 H. & N. 815), decided on appeal from the Court of Exchequer—in which it was held that the plaintiff's design, which related to a species of double honeycomb fabric, was new and original and formed good subject-matter. The design was formed by combining a large honeycomb fabric with a small honeycomb fabric, the small honeycomb fabric serving as a ground upon which the large honeycomb was displayed. Both the large and the small honeycomb patterns were old, but their combination had not been carried out before.

But the  
combina-  
tion must  
show some  
ingenuity.

*Hothersall  
v. Moore.*

It is probable that when the combination of old elements to produce a new effect involves the exercise of taste and invention, it would not upset the design to analyse it and show where the different combined elements were obtained. But where the combination is a mere mechanical adding of one old thing to another, not betraying ingenuity in the combination, the result is not so likely to be upheld as novel and original. For example, in the case of *Hothersall v. Moore* ([1891] 9 R. P. C. 27) the plaintiff had registered, as a design for dusters, the combination of an old and well-known border with an equally old and well-known fabric as centre-piece. Bristowe, V.-C., held that this did not constitute a registrable design, and dismissed the action with costs.

Small  
change in  
combina-  
tion design.

In *Rollason's Design* ([1898] 15 R. P. C. 441) the finding of the House of Lords was practically, from the nature of the evidence and the anticipatory matter, a finding that the result of a combination of old features, even although the combination itself is not strikingly new, may be a novel design; and in *Rivett v. Grimshaw* ([1894] 11 R. P. C. 351) a combination of a bassinette and maileart was held to be a good registrable design.

Mere slight  
changes in  
style and

In *Le May v. Welch* ([1884] 28 Ch. D. 24; 54 L. J. Ch. 279), a registered design of a collar contained three characteristics

which it was admitted had *separately* appeared in collars prior to the date of the plaintiff's registration. The combination was considered too narrow and trifling to constitute a new design, and in the Court of Appeal Lord Justice Bowen, in delivering his judgment, very properly drew attention to one of the reasons of the Court for declining to maintain the validity of such a registration. "We must not," said his Lordship, "allow industry to be oppressed. It is not every mere difference of cut, every change of outline, every change of length or breadth or configuration, in a simple and familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry, and make the Patents, Designs, and Trade Marks Acts a trap to catch honest traders."

shape of  
common  
article not  
subject-  
matter.

*Le May v.  
Welch.*

In the last case quoted, not only the fitness or unfitness of a combination design as subject-matter for registration, but also the amount of invention or fancy displayed, was inferentially considered. As Lord Justice Bowen said, "there must be a substantial novelty in the design, having regard to the nature of the article." Thus, in *Smith v. Hope Bros.* ([1889] 6 R. P. C. 200), the plaintiff had registered a design for application to a scarf. At the hearing it became apparent that the sole advance upon what was acknowledged to be an old shape of scarf was the introduction of one or two folds or pleats in the body of the scarf. Mr. Justice Stirling dismissed the plaintiff's motion for injunction with costs, and directed that the design should be struck from the Register. The learned Judge referred to the case of *Le May v. Welch* (*supra*), and quoted with approval the remarks of Lord Justices Baggallay and Bowen. It should, however, be mentioned here that, just as the commercial success of an apparently obvious or simple invention has been considered an additional reason for maintaining a somewhat doubtful patent, so the commercial success of a registered design has been allowed to weigh with the Court in upholding the registration, even where the subject-matter has been somewhat narrow. In *Tyler v. Sharpe* ([1893] 11 R. P. C. 35) Romer, J., in upholding

Some in-  
vention  
must be  
apparent.

*Smith v.  
Hope Bros.*

Commercial  
success may  
help to  
sustain  
design.

the plaintiff's design of a water-closet basin, said that, although the design was somewhat slight, he could not help being favourably impressed by the immediate popularity and large sale of the article to which the design was applied.

The question of what constitutes good subject-matter for registration as a design would be incomplete without a reference to the adaptation of existing and well-known things, such as famous objects or buildings, to the purposes of design, as applied to manufactured goods. It seems only reasonable to suppose that if someone adapts a view or picture of some thing, or some personality, whether it be a flower or landscape, a building, or a statesman, and applies that representation or picture to some article of manufacture, he should be allowed to register it as a new design, and should be protected in such a specific adaptation. His right may perhaps be open to cavil if the representation he made use of was common and well known, such as a well-known photograph or engraving, although even this might not affect his right. But suppose the particular representation or view he uses is one produced or procured by himself, it might be asked why such adaptation should not be fit subject-matter for registration as a design for application to certain specified manufactured goods, according to the Act. It used to be said, in text-books upon the subject of designs copyright, that the copy of a photograph of a well-known public character applied to manufactured objects is not a new or original design within the meaning of the Act. The decision upon which this assertion is based occurred in the case of *Adams v. Clementson* ([1879] 12 Ch. D. 714). But this case turned on the old Act of 5 & 6 Vict. c. 100, Section 3, which is differently worded from the corresponding sections of the Act of 1883, and it has been thought by a high authority (Lindley, L. J., in *Saunders v. Wiel* [1892], 10 R. P. C. 29) that the variation in the language of the Act of 1883 was influenced or caused by this very decision of *Adams v. Clementson*. In the latter case the dispute was between two earthenware manufacturers, the plaintiff, Adams, seeking to restrain

Adaptation  
of well-  
known  
objects and  
personages  
as subject-  
matter for  
designs.

*Adams v.  
Clementson.*  
Portrait on  
earthen-  
ware.

*Saunders  
v. Wiel.*  
West-  
minster  
Abley  
spoon  
handles.



the defendant by injunction from infringing the plaintiff's registered design which he applied to plates and other articles of earthenware. The design consisted of a portrait of General Martinez de Campos, copied from a photograph which had been sent to the plaintiff from Cuba. The defendant had received a similar photograph and was applying it to similar goods. In both cases the goods were produced almost entirely for export to Cuba.

Vice-Chancellor Malins decided that this was not fit subject-matter for a registrable design, because the plaintiff had simply taken the photograph and copied it, and the defendant had done the same thing. Accordingly the injunction was refused. It is, however, submitted that this decision has since been subjected to such destructive criticism that there is but little fear of its being repeated or having henceforth any weight as a precedent. A more correct interpretation of the law as it now stands is to be found in the case of *Saunders v. Will (supra)*. Here the plaintiff, a silversmith, had registered in Class 1 a design applicable to the handles of spoons and forks. The design consisted of a view of Westminster Abbey, modelled in relief on the spoon or fork handle. The nature of the design as stated in the application was for the "pattern and shape of spoon or fork handle in metal." The defendants had infringed, and, relying in their defence upon the decision in *Adams v. Clementson*, contended that the design was not one that could be registered. Cave, J., dissented from the judgment in *Adams v. Clementson*, and held that the design was proper subject-matter for registration, and that the defendants had infringed.

In the Court of Appeal the decision of the Lower Court was upheld, and the adverse remarks of Cave, J., upon the decision in *Adams v. Clementson* were strongly endorsed by Lindley and Bowen, L. Jj. As was said by Lindley, L. J.: "What we have to consider is this: whether this registered design—for a design of some sort of course it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Now

A modelled  
view of  
West-  
minster  
Abbey on  
spoon  
handle held  
good sub-  
ject-matter.

Lindley,  
L. J., on  
new and  
original  
designs.

why is it not? Has such a design applicable to metals ever been seen before? If you ask that question you are told this - 'Yes, if you mean by design, public buildings, or if you mean cathedrals and churches, they are common enough'; therefore there is no novelty in the idea. But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey and used it as a design applicable to things in Class I or to any things like it, the answer is, 'No, that is new and never has been published before.' That answer seems to me to bring the plaintiff's case within the Act of Parliament."

Mere substitution of one material for another in the same article does not make it a new design.

It has also been laid down that the mere substitution of one material for another, where the object is the same and to be used for a similar purpose, does not constitute a registrable new design. Thus in *re Bach's Design* ([1889] 6 R. P. C. 376) Bach registered, in Class 4, a fairy lamp-shade produced in the form of a rose and made of vitreous material. It was shown that lamp-shades of a similar design, but made of linen, had been manufactured and sold prior to the registration of Bach's design, and as a result the motion to expunge the design was successful.

Analogous application of old thing bad.

In *Clarke's Design* ([1896] 13 R. P. C. 351) it was held that a design applicable for shape, consisting of two parts, which in conjunction with another part were old, for the purpose of an oil or gas lamp, was not a novel or original design for an electric lamp.

But a new design incorporating an old one may be good.

According to Lord Herschell, in *Harper & Co. v. Wright & Butler* ([1895] 12 R. P. C., at page 491), a design founded upon and even incorporating the whole or part of a previous design is good in its totality.

Slightness of change to constitute subject-matter.

How slight a change may constitute a well-known article subject-matter for a registrable design might be instanced in *Walker v. Scott* ([1892] 9 R. P. C. 482), where the mere rounding of the edges of a well-known oil-can constituted the subject-matter of the design. In *Rollason's Design* ([1898] 15 R. P. C. 411), the coffin plates in respect of which registration had been effected, were exceedingly similar to alleged anticipations both in shape and in ornament. The alleged distinctive feature of Rollason's plates viz., the

Drawing not conclusive as

sunk central flat portions, could not be said to appear in the drawings as sunk. But the House of Lords, having satisfied themselves of the proprietor's intentions, held that there was subject-matter, and sustained the registration. It seems, therefore, that very little difference of appearance will suffice to uphold a registered design. As was said by Lord Herschell in *Rollason's Case*: "Very often a very successful design may be one in which the difference from previous designs can, on analysis, be shown to be very slight, where, nevertheless, the result is to make the one so much more pleasing than the other that it is a successful design. Whilst on the one hand we certainly ought not to give protection to a design in which the variations are trivial and unimportant so that it is substantially the same design as one already registered, on the other hand we ought not to refuse it where the design is practically a different one, which may be more attractive." to form of design.

Another case in which the filed drawing did not seem a fair guide to the section of presser-bar actually claimed by the proprietor occurred in *Farley v. Keighley Iron Works, Limited* ([1896] 14 R. P. C. 169); but here also the plaintiff succeeded. It seems advisable in cases such as those of *Rollason* and of *Farley* that details should be given in the drawing of any point left in doubt by the main illustration.

## CHAPTER V.

## NOVELTY.

Design  
must be  
new or  
original.

Must be  
new with  
reference  
to the  
goods to  
which it is  
applied.

Distinction  
between  
"new" and  
"original."

Novelty  
considered  
with refer-  
ence to  
state of  
prior  
knowledge.

ACCORDING to Section 47 of the Act, a design to be capable of registration must be "a new or original design not previously published in the United Kingdom." The words "new or original" mean, according to Fry, L. J., in *Le May v. Welch* ([1884] 28 Ch. D. 24), that "the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter to which it is to be applied." Or as was said by Lindley, L. J., in *Clarke's Design* ([1896] 13 R. P. C. 351)—"The design must be new or original with reference to the kind of article for which it is registered. . . . A design may be new for a coal-scuttle but not for a bonnet. On the other hand a design for a shade of a gas-lamp can hardly be new if it was old for an oil-lamp." *Per* Chitty, L. J., in *Rollason's Design* ([1897] 14 R. P. C. 909): "There is a distinction between the words 'new' and 'original.' Every design which is original is new, but every design which is new is not necessarily original." Mr. Justice Manisty, in *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), speaks of a new arrangement of well-known parts as constituting a "new" design, but not what the Act of Parliament means by an "original" design. It is questionable, however, whether the Legislature meant as much as they are credited with by the learned Judges mentioned, since in Section 61 the words used are new *and* original.

Novelty in a design must always be considered with relation to the state of knowledge at the date of registration. Thus, in *Morton's Design* ([1900] 17 R. P. C. 117), where the registered design related to the shank of a cuff-link, the state of knowledge as evidenced by prior examples of shanks, and by similar shanks appearing in prior patent specifications, caused the Court to decide that the design was not new or original.

A registered design cannot be maintained as new and original if a similar design has previously been registered in a different class for substantially the same purpose (*Reed & Crosswell's Design* [1889] 6 R. P. C. 471), and the same was held in *Buch's Design* ([1889] 6 R. P. C. 376), and in *Pluckett's Design* ([1892] 9 R. P. C. 436). But this is, generally speaking, only the case where the registrations although in different classes are for application to the same or substantially the same articles. Thus although it was shown that the moulding on the registered design of fire-door in *Walker v. Falkirk Iron Co.* ([1887] 4 R. P. C. 390) was old in furniture and doors for other purposes, that was held not to destroy the validity and novelty of the registered design. In other words a design may be old in fire-irons and yet new in scarf-pins, or old in cathedrals but new in spoons (see *Saunders v. Wiel* in last chapter). But a design old in an oil-lamp cannot be new simply because it is applied to a gas-lamp (*Clacke's Design, supra*).

Not generally new if registered in other class.

Design old in furniture may be new in a kitchen range.

Where a design has been freely exhibited and sold prior to registration, of course novelty has been destroyed and cannot be revived. But there are many instances where a species of *quasi*-disclosure has taken place, in respect of which the question has to be debated whether or not such disclosure amounts to publication. Confidential disclosure to a partner, servant, agent, customer, or friend, for the purpose of obtaining an opinion on the merits of a design, is not publication, so long as it goes no further, and so long as actual business is not done in the goods bearing the design.

Novelty destroyed by prior exhibition.

Confidential disclosure.

In *Heinrichs v. Bustendorff* ([1893] 10 R. P. C. 160) the defendant pleaded that a sample of the writing-table which embodied the design had, before registration, been submitted by the plaintiff to a customer, who had altered and returned it. It was held by Day, J., that this did not constitute publication. But where, as in *Blank v. Footman* ([1888] 5 R. P. C. 653), the inventor of a new lace design had shown and handed a sample of the lace to his agent, and the agent had in turn shown the sample in an alleged confidential manner to two selected customers, who gave orders and kept cuttings from the lace, it was held that

Disclosure for the purpose of doing business destroys novelty.

publication had taken place. It would seem that the mere confidential exhibition of the lace to the three indicated persons would not of itself have constituted publication, but the concluding of an order, and the leaving of the cuttings or samples in the customers' hands, went beyond mere confidential disclosure. Almost the same circumstances caused the registered design to be upset in the older case of *Hunt v. Stevens* (W. N. 1878' 79). An examination of the report of the more recent and very similar case of *Winfield v. Snow* ([1890] 8 R. P. C. 15), and a consideration of the remarks of Hawkins, J., will also help to show how far confidential communication of this description may go without constituting publication. In *re Sherwood's Design* ([1892] 9 R. P. C. 268) the proprietor of the design supplied a customer with two globes in accordance with the design three days before registration was effected. There was a slight difference between the design of globe as registered and the globes as supplied; but it was held that publication had taken place, and the design was ordered to be expunged from the Register.

Premature sale of articles in accordance with design destroys novelty.

Public exhibition.

In *Smout v. Slaymaker* ([1890] 7 R. P. C. 90) a registered design of a fire-screen was ordered to be expunged from the Register upon proof that fire-screens identical in design had been publicly exhibited and sold prior to registration.

Publication by book or specification.

In addition to anticipation by prior user, or sale, or exhibition, or prior registration, a design might be anticipated by prior publication in the United Kingdom by means of a book, or specification, or pamphlet, or newspaper. The principle is precisely the same as that which holds good with reference to prior publication of patented inventions by such means, and the reader is referred to the division of this book on Patents and to the chapter which deals with prior publication.

Substitution of one material for another.

It has already been laid down that the mere substitution of one material for another, where the object is the same and to be used for a similar purpose, does not constitute a registrable new design. Thus, in *re Bach's Design* ([1889] 6 R. P. C. 376), Bach registered, in Class 4, a fairy lamp-shade produced in the form of a rose and made of vitreous material. It was shown that lamp-shades of a

similar design, but made of linen, had been manufactured and sold prior to the registration of Bach's design, and as a result the motion to expunge the design was successful.

The same design may be registered in more than one class; but a design already registered in one class, and put on the market and made public, cannot afterwards be properly registered in another kindred class as a new design. In *Hothersall v. Moore (supra)* the plaintiff had registered his design in Class B instead of in Class A, which was the proper class. His after-registration in Class A was held not to retrieve his error, and the registration in Class A was held invalid from publication, although such publication took place after registration in Class B.

It has not been decided whether registration *per se* without publication would constitute anticipation. The point was raised, but not decided in *Read and Gresswell's Design* (1889) 6 R. P. C. 471). In the writer's opinion registration alone, and without publication, would not constitute anticipation.

Publication in one class will destroy novelty in another class.

Query whether registration *per se* is anticipation.

## CHAPTER VI.

## MARKING THE GOODS.

Goods must  
be marked.

SECTION 51 of the Act provides that before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark or with the prescribed word or words or figures denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Specified  
markings.

In pursuance of this section, the Board of Trade Rules under the Act provide that all goods in Classes 1 to 12 shall during the period of copyright bear the abbreviation "RD" and (except in the case of lace) the number appearing on the certificate of registration. All goods in Classes 13 and 14 (printed or woven designs on textile piece goods and on handkerchiefs and shawls) shall be marked "REGD" without the number.

Object of  
marking.

The object of the section being to protect the unwary by making it plain what goods are and what are not registered, a slight deviation from the strict letter of the Rules will not matter, so long as the goods are marked so as to make it plainly apparent that they are registered. In *Heinrichs v. Bustendorff* ([1893] 10 R. P. C. 160) the plaintiff had marked his tables "REGD" instead of "RD". The defendant pleaded that registration was invalid on that account, but Day, J., brushed this contention aside, saying, "I am of opinion that does not vitiate registration at all." It is better, however, to adhere strictly to the Rules.

Made-up  
goods may  
be marked  
in bulk.

When it is impossible or inconvenient to place the mark actually on the goods, it may be placed on the case, or wrapping, or card. In *Blank v. Footman* ([1888] 5 R. P. C. 653) Kekewich, J., decided that the plaintiff had complied sufficiently with the Act in marking his trimming, when made up in bundles, with the abbreviation "RD" and the number, printed on a paper band surrounding the goods.



But failure to mark the goods at all will undoubtedly (unless the proprietor can show a very strong case) vitiate registration, and the same may be said where the failure is only partial. For example, should a dozen dusters of a registered design be woven in a piece of, say, twelve dusters, it would not be sufficient to affix the mark "REGD" to the piece alone, since that would be marking one only of the twelve dusters comprising the piece. When the piece is cut up, eleven dusters would go forth to the public, perhaps in different directions, without any indication of the design having been registered. This was held, *inter alia*, to vitiate registration in *Hothersall v. Moore* ([1891] 9 R. P. C. 27).

Consequences of failure to mark.

It will be noted that Section 51 concludes with a saving clause, giving relief in case of error if the proprietor can show that he took all proper steps to ensure the marking of the articles. Thus mere inadvertence or blundering on the part of those over whom the proprietor of the design had no immediate control will not necessarily vitiate the registration of the design.

Relief in case of inadvertence.

As was said by Lord Herschell in *Rollason's Design* ([1898] 15 R. P. C. 441): "The section, by its concluding words, leaves an opening to prevent the operation of the section in full stringency, because it provides that the copyright shall not cease if all proper steps have been taken by the proprietor to ensure the marking of the article. In interpreting these concluding words, I think it is necessary to bear in mind the object of the section and to take into account too what the nature of the omission is. The object of the section, as stated in plain terms, is to 'denote that the design is registered': that is to say, to give warning to the public that they are not entitled to copy it by reason of registration. Of course, if there is nothing to give that notice to the public the proprietor would need to make out a very strong case to excuse himself under the concluding words of the section, because he has failed to do that which was essential to the very purpose of the provision contained in the section: namely—to denote to the public that the design was a registered one. Even in that case he might escape the loss of his design by making out a case which would show that it was not due to any fault of his."

Per Lord Herschell — if the public is properly warned of registration that is the main thing.

Wrong  
number  
excused.

In the case of *Rollason's Design* the registered number had been wrongly stamped on certain of the coffin plates as No. 252,908 instead of No. 232,908, the mistake having originated in the stamping die, which had been examined and approved in error by the plaintiff. Nevertheless he was held excused and the registration sustained.

In *Harper v. Wright* (1895 12 R. P. C. 483) the owner put the wrong registered numbers on the articles in addition to the right numbers, but this was held not to vitiate his registration.

Old number  
used by  
mistake.

In *Williamson v. Oppenheim* (1884 27 Ch. D. 260), a manufacturer employed by the proprietor of a design to make the articles for him, and to whom the proprietor had supplied a correct stamping die, used by mistake an old die, which related to an expired design of the same proprietor. Several articles were sold before the proprietor detected the blunder, but it was held that this did not vitiate his registration, it having been made apparent that he had done all in his power to ensure the correct marking of the articles. The question of what constitutes the taking of "all proper steps to ensure the marking" was also considered in the more recent case of *Johnson v. Bailey* ([1893] 11 R. P. C. 21), in which a manufacturer who had registered the design of a teapot, and had prepared moulds and given his workmen injunctions to see that each pot was properly marked, lost his copyright because the workmen allowed the mould to become so worn that the registration mark on the goods was illegible. The Lord Ordinary (Low) decided that such general instructions as the plaintiff had given, when not followed up by personal supervision, did not constitute the taking of "all proper steps to ensure the marking."

Proprietor  
must take  
all proper  
steps to  
ensure  
marking.

Marking  
the wrong  
part in an  
article.

In the still more recent case of *Morton's Design* ([1900] 17 R. P. C. 117) the registered design applied to the shank of a cuff-link. Instead of marking the shank, the proprietor marked the plate of the link. As Farwell, J., pointed out, there was a double misleading in such marking. Not only were the public not informed of what was registered, but they were invited to believe that something was protected which really was not. On these grounds, *inter alia*, registration was cancelled.

The articles are to be marked "before delivery on sale" by the proprietor or, as was decided in *Wedekind v. General Electric Co., Limited* ([1897] 14 R. P. C. 190), by his lawfully authorised agents. In the case referred to, the sale of at least one unmarked telephone transmitter was proved and the action dismissed. The sale of one unmarked article only destroyed the copyright in the older case of *Hunt v. Stevens* (1878 W. N. 79).

Sale of goods unmarked destroys copyright.

In *Woolley v. Broad* ([1892] 9 R. P. C. 429) the sale of lace protected by design registration when the lace was in the brown or unfinished state—without any registration mark, was held to destroy the copyright, although it was shown that the further treatment of the lace by the "finishing" firm to whom it was sold must have destroyed the registration mark.

Sale of goods unmarked in unfinished state.

In a case under the old Act (*Fielding v. Hawley* [1883], 48 L. T. N. S. 639) where the design related to a butter-dish consisting of dish and cover, the dish only was marked, but it was held that this satisfied the Act, the dish and cover together being one article.

Marking separable parts of article.

Mere patterns of the registered goods if not sold need not be marked.

Samples.

It is an offence under the Act (Section 105) to describe an article as "registered" where no registration has been effected. A person is deemed to represent a design as registered if he sells the article bearing any word or mark expressing or implying that registration has been obtained. The penalty for such misrepresentation is that the offender is liable for each offence on summary conviction to a fine not exceeding £5.

Penalty for describing an article as "registered."

Even if sold outside of the limits of the United Kingdom, goods to which a registered design is applied must be marked (*Sarazin v. Hamell* [1863], 7 L. T. N. S. 660), otherwise the copyright will be lost.

## CHAPTER VII.

## ACTION FOR INFRINGEMENT.

No  
Common  
Law right  
in designs.

THERE is no Common Law right in designs such as may exist in unregistered Common Law trade marks or trade names. The right to sue for the infringement of a design rests only in the registered proprietor of the copyright. Legal proceedings in respect of designs are governed chiefly by Sections 58 and 59 of the Act.

Section 58.

Section 58 of the Act provides that during the existence of copyright in any design—

Unlawful  
for any  
unlicensed  
person to  
apply  
design.

(a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply or cause to be applied such design, or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural; and

Unlawful to  
sell articles  
having  
design  
wrongfully  
applied.

(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture, or any substance, to which such design, or any fraudulent or obvious imitation thereof, shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Penalties.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction, provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.

This section is a repetition substantially of Section 7 of the Act of 1842.

Differences  
between  
Clauses (a)  
and (b).

Clause (a) is evidently aimed at the manufacturer or producer of the goods, while Clause (b) seems to deal with the seller. It is not under Clause (a) necessary to bring home to the manufacturer knowledge of the

existence or registration of the design. It is enough that he applies it or causes it to be applied. But under Clause (b) the seller or retailer is only liable if he sells articles bearing the design, knowing that it has been applied without the proprietor's consent.

As to what constitutes an infringement, it was said by Lord Westbury, in *Holdsworth v. McCrea* (1867, L. R. 2 H. L. 380), that "the appeal is to the eye, and the eye alone is the judge of the identity of the two things"; and by Lord Herschell, in *Hecla Foundry Co. v. Walker* (1889, 6 R. P. C. 554), that the eye is the test, and that the question should be determined by placing the designs side by side and asking whether they were the same, or the one an obvious imitation of the other, taking into account the state of knowledge at the time, and in what respects the registered design was new and original, when considering whether variations from the registered design were substantial or not. The same test was proposed to be applied in *Hothersall v. Moore* (1891, 9 R. P. C. 27), and it may safely be said that this test furnishes the means for deciding nine-tenths of all design actions brought into Court.

In *McCrea v. Holdsworth* (1870, L. R. 6 Ch. 418), and in *Oliver v. Thornley* (1896, 13 R. P. C. 490) it was held that to establish infringement it was not necessary that an exact copy should have been made by the defendant. If the appearance is strikingly similar to that of the registered goods that is enough. In *Harper v. Wright* (1895, 12 R. P. C. 433) the design of a stove, the ornament of which was Gothic in style, had been registered. The defendant's stove, although different in detail and even in style, was nevertheless so similar in general appearance to the plaintiff's that it was held to be an "obvious imitation." But it is of course not competent to register any particular *style* of ornament, and, as Lord Herschell said in *Harper v. Wright* (*supra*), if the whole point of the design consists merely of a cathedral window of a particular kind, a design consisting of a cathedral window of another kind would not infringe.

An obvious and fraudulent imitation might be created, and the inference that it was so would be largely augmented,

What constitutes an infringement.

Test of the eye.

Need not be an exact copy.

General resemblance may constitute infringement.

Obvious and fraudulent imitation.

*Grafton v. Watson,*  
*Harper v. Wright,*

where the defendant had instructed his designer to work as closely to the plaintiff's design as possible, and so as to produce the general effect without imitating the details (*Grafton v. Watson* 1881, 51 L. T. N. S. 141; see also *Harper v. Wright, supra*). But it would scarcely be a profitable digression to enter upon a general discussion as to what would constitute a "fraudulent" or an "obvious" imitation of a registered design. As has already been said, the eye is in the main the judge as to what is and what is not an "obvious" imitation, and the circumstances of each case might be examined to determine whether it was also a "fraudulent" imitation. It is conceivable that a design might be held to be an obvious imitation of a registered design, even although in arrangement and detail it is, when narrowly inspected, different, so long as the general effect is the same. *A fortiori*, the defendant will not be allowed to shelter himself behind trifling distinctions and variations from the registered design.

Manisty, J.,  
on  
"obvious"  
and  
"fraudulent"  
imitations.  
*Sherwood v. Decorative Tile Co.*

In *Sherwood v. Decorative Tile Co.* (1887, 1 R. P. C. 207), Manisty, J., says: "Upon the question of *obvious* imitation, you must to a great extent (I do not say entirely) be guided by the eye." And again the same learned Judge remarks: "It may not be easy—I do not say it is impossible—to define in words exactly what is meant by a *fraudulent* imitation. I think the word was introduced for the very purpose of meeting the case of an imitation, not an *obvious* imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. For instance, having before your mind and before your eye the design of another, and introducing into your design some differences, in order if possible to avoid coming within the Act of Parliament."

In the case last quoted the same Judge came to the conclusion that the defendants' design, although not an "obvious," was on the other hand a "fraudulent," imitation.

If manufacturer has applied the design he is liable.

As has already been pointed out, the mere fact of applying or causing to be applied the registered design without the consent of the proprietor, renders the manufacturer of the goods liable to an action.

But  
Section 5  
provides a

The case is, however, different with the retailer of the goods, and to succeed the plaintiff must show that the

defendant knew that the design had been applied without the consent of the registered proprietor. To apprise him of this knowledge the proper course is to serve him with a notice which should show the defendant distinctly and intelligibly that the design had been applied without the plaintiff's consent (*Norton v. Nicholls*, 1859, 1 E. & E. 765, 28 L. J. Q. B. 225; *Smith v. Roberts*, 1888, 5 R. P. C. 611).

refuge for  
innocent  
retailer.

A mere general notice that the retailer is selling goods with a registered design applied, but giving no details, is not a sufficient notice (*Smith v. Roberts, supra*). In the latter case, where the defendants after insufficient notice stopped the sale of goods of the class complained of and immediately upon an inspection of the plaintiffs' design returned all goods to the manufacturer, it was held there was no cause of action, and the case was dismissed with costs. In the course of his judgment, in *Smith v. Roberts*, Bristowe, V.C., said: "I think that the intention of the Act, Section 58, Sub-section (b), is to protect a retail dealer, or dealer selling goods and not being himself the manufacturer of them, from pains and penalties in respect of that which he does not himself know; and if the retail dealer is selling goods as to which he has no knowledge that there is any registration, he is doing that which is no wrong; the wrong is in doing it after having knowledge brought home to him that protection by registration has been given to the goods which he is seeking to sell." In this action it was held that the defendants had not sold with knowledge that the designs were registered, and that there was no intention to sell after acquiring such knowledge. The action was accordingly dismissed, with costs against the plaintiff.

Sufficiency  
of notice to  
retailer.

Intention  
of the  
section is to  
protect  
innocent  
retailer.

*Smith v.  
Roberts.*

In the case of *Sherwood v. Decorative Tile Co.* ([1887] 4 R. P. C. 207), where the sale of one hundred infringing tiles was proved, a penalty of £50 was imposed, although under the Act as it then stood a penalty of £5000 might have been adjudged. In view of this and similar cases, to prevent the possibility of ruinous penalties being imposed, in the amending Act of 1888 the total amount of penalties to be forfeited in respect of any one design was limited to a maximum of £100.

Penalties  
now limited  
in amount  
(Act of 1888)

Trampery  
actions not  
encouraged.

In *Jain v. Grossman* (1895) 12 R. P. C. 537, the defendant purchased and resold one or two powder puffs the design of which had been registered by the plaintiff. The first knowledge he had of the registration of the design was imparted to him over the counter by the plaintiff, whereupon he withdrew the puff which remained in his shop window. He also promised to sell no more, but declined to give a formal undertaking to that effect. On summons for judgment under Order 32, Rule 6, the action was dismissed with costs. Kekewich, J., called it a useless and trampery action.

Manufacture  
without  
sale before  
expiry of  
registration.

Goods having the design applied during the currency of registration, and stored up to await the expiry of registration before being put on the market, may be made the subject of an injunction, and delivery up, and destruction may be ordered (*McClea v. Holdsworth* 1848, 2 De G. & Sm. 496).

Penalty re-  
coverable as  
simple con-  
tract debt.

Injunction.

Jury.

Under the old Act of 1842, the penalty for piracy of a registered design was recoverable by action or by summary proceeding before a magistrate or justices of the peace. But by Section 58 of the present Act, the penalty is recoverable as a simple contract debt in any Court of competent jurisdiction. Thus the plaintiff might sue in the High Court, or if his claim does not exceed £50 in the County Court. Where an injunction is sought or where there is a question of applying to rectify the Register by expunging a design, the Chancery Division would be the most convenient. If trial by jury is desired, or the action is for damages, as under Section 59, the King's Bench Division is more suitable.

Persons  
entitled to  
sue for in-  
fringement.

The registered proprietor is the person entitled to sue; that is to say, any person properly on the Register within the classification set forth in Section 61 - viz., the author; the person on behalf of whom the design was made for a consideration; the assignee of the whole or a part; the holder of a licence, either exclusive or non-exclusive, to *apply* the design and on the Register of Proprietors; or the personal representative of the deceased or bankrupt proprietor.



Therefore although a licensee alone under a patent cannot sue in respect of infringements, although notice of his licence is on the Register, a licensee to apply the design (but not merely to sell articles under the design) has a right to be put on the Register as "proprietor" within the meaning of Section 61, and can therefore alone or together with his co-proprietors sue for infringement. But the licence must be in writing (*Levitt v. Rickard* 1878, L. R. 8 Ch. D. 401) and the licensee on the Register; otherwise he has no cause of action (*Woodley v. Broad* 1892, 9 R. P. C. 208).

Licensee to apply the design.

Licensee to apply design must be in writing.

In *Morris Wilson v. Coventry Machinists' Co.* (1891, 8 R. P. C. 353), North, J., held that it was "a convenient rule that the course of proceedings adopted for patent actions should be followed as regards actions for infringement of registered designs." That rule is now generally followed, and in respect of certain points that will be noted, the procedure in a Design action is the same as that in a Patent action.

Procedure in designs actions similar to procedure in patent actions.

The defendant must be (a) the person who has applied or caused to be applied the design to goods in the class for which the design was registered, for purposes of sale; or (b) the person who exposes such goods for sale, knowing that the design has been applied without the proprietor's consent. The preceding portion of this chapter deals with the notice to be given to anyone who is or may be an innocent infringer.

The defendant.

The writ alleging infringement should be endorsed with a claim for

Endorsement of writ.

- (a) The penalties against the defendant for infringement of the plaintiff's registered design;
- (b) An injunction to restrain the defendant, his servants and agents from infringing the design; and
- (c) Delivery up or destruction of all articles in the possession or under the control of the defendant.

In the event of the plaintiff electing not to proceed for penalties, he may, in lieu of the penalties, claim damages

Damages in lieu of penalties (Section 59).

Interrogatories in penalty action.

for the infringement of his design, under Section 59. But he must not claim both damages and penalties (*Saunders v. Wiel* [1892], 9 R. P. C. 459). It should be noted that the same case decides that when penalties are claimed, interrogatories tending to show that the defendant was liable to such penalties cannot be administered.

Statement of claim.

The statement of claim should recite—

- (a) That the plaintiff is the registered legal proprietor of a design No. \_\_\_\_\_, registered on the \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_, in Class \_\_\_\_\_, for application to (*specify goods*):
- (b) That the defendant has since the said date of registration wrongfully and without the licence or written consent of the plaintiff applied or caused to be applied for the purposes of sale the said design, or an obvious or fraudulent imitation of the same, to goods similar to those in respect of which the design was registered.

The statement of claim should then conclude with substantially a repetition of the claims endorsed on the writ (*supra*).

In the case of a seller of the goods.

If the action is taken against a retailer, the statement under Clause (b) should be to the effect that the defendant has, since the date of registration, wrongfully sold and exposed for sale goods to which the said design, or an obvious or fraudulent imitation thereof, has been applied, the defendant knowing that the same has been applied without the consent of the plaintiff.

Procedure similar to that in patent actions.

Mr. Justice North having given it as his opinion in *Morris Wilson v. Corenty Machinists' Co.* ([1891] 8 R. P. C. 353), that proceedings in Patent actions should be regarded as the model upon which to regulate Designs actions, it is advisable that the statement of claim should be accompanied by particulars of breaches giving, if possible, all known or ascertained instances of infringement, with names, places, and dates. There is no specific obligation under the Statute to give such particulars, but under Order 19, Rule 7, of the Rules of the Supreme Court, they may be ordered, and as a rule they are given.

Particulars of breaches.

In his defence the defendant should, in addition to Defence, denial of infringement, state everything that will assist him to rebut the plaintiff's claim, as for instance—

- (a) That the defendant does not admit that the plaintiff is the registered proprietor of the design set forth by number and date in the statement of claim, or that the design was ever so registered; or, in the alternative, if such registration has been effected, the defendant denies that the plaintiff was entitled to register the said design in such class or at all.
- (b) That the said design was not fit subject-matter for registration, and was not new or original, and that any copyright, registration, or protection alleged to have been obtained for the same is invalid and of no force and effect.
- (c) That the design was published prior to the date of registration.
- (d) That since the date of the alleged registration the plaintiff has sold or delivered on sale articles to which the alleged registered design was applied, without being marked, in accordance with Section 51 of The Patents, Designs, and Trade Marks Act, 1883, with the prescribed mark, words, or figures, denoting that the design was registered, or wrongly or insufficiently so marked, whereby any copyright that may at any time have subsisted in the said design has ceased.
- (e) If the plaintiff possesses any copyright in the said design (which is denied) the defendant has not infringed.

If the defendant is a retailer, a further paragraph should be to the effect that the defendant has not wrongfully sold and exposed for sale any goods to which the plaintiff's alleged registered design has been applied; or, in the alternative, if the defendant has done so, he did it without knowing that the design had been so applied without the consent of the plaintiff.

Defence by  
retailer.

Defendant's  
particulars  
of objec-  
tions.

The defence is preferably to be accompanied by the defendant's particulars of objections. As in the case of the plaintiff's particulars of breaches, particulars of objections are not obligatory under the Statute, but it is better that they should be given. They should set forth in paragraphs any facts or information upon which the defendant may intend to rely, showing for instance—

- (a) That the plaintiff, or the original registered proprietor, was not the author of the design or had not duly acquired it or the right to enter himself as registered proprietor in any of the manners set forth in Section 61. (If the defendant can state who was the author let him do so.)
- (b) That the design was not fit subject-matter for registration, and was not new or original, but was similar to, or a copy or substantially a copy of, a design or designs published or used prior to the date of registration by &c. (*here set forth prior publication or user of similar designs with full particulars*).
- (c) That the design was published prior to the date of registration by &c. (*here set forth all instances of publication by books, prints, specifications, and other matter, and also any instance of prior user*). If it is alleged that the design is of common knowledge, particular instances of prior publication or user need not be given (*Holliday v. Heppenstall* [1889], 6 R. C. P. 320).
- (d) Any instances of sales of unmarked or insufficiently marked goods made by the plaintiff since registration, if such sales have taken place.

Pages or sheets of drawings in books or publications should be given, and full circumstances of prior user, with dates, names, and addresses.

Summons  
for further  
and better  
particulars.

If the defendant's particulars of objections are thought by the plaintiff to be insufficient, he may apply by summons in chambers for further and better particulars,

and if thought fit, following the analogous practice in Patent cases, such further and better particulars will be ordered.

In the event of the defendant desiring to amend his particulars of objections so as to include, for example, some anticipatory matters not cited in the original particulars, he may by summons obtain leave to do so, but the usual terms founded upon similar applications in Patent actions will be imposed—viz., that the plaintiff shall have leave to elect to discontinue, and if he elects so to do that he shall have the costs from the date of the first delivery of the defendant's particulars to the delivery of the amended particulars. This was held in the Designs action of *Morris Wilson v. Coventry Machinists' Co.* ([1891] 8 R. P. C. 353), following the order made in the Patent case of *Edison Telephone Co. v. India Rubber Co.* ([1881] L. R. 17 Ch. D. 137). But the Judge has absolute discretion and may make such an order unconditionally, and his discretion will not be interfered with by the Court of Appeal (*Woolley v. Broad* [1892], 9 R. P. C. 429; *Wilson v. Wilson* [1899], 16 R. P. C. 315).

Particulars may be amended from time to time on terms.

Judge has absolute discretion.

No alleged anticipation of a registered design can be relied on at the trial unless pleaded (*Walker v. Hecla Foundry Co.* [1887], 5 R. P. C. 71). In *Brett v. Grimsdale* ([1894] 11 R. P. C. 351) the defendants were allowed to give in evidence particulars of an alleged anticipation of which the plaintiffs only had notice a short time before the trial. Day, J., held that sufficient notice had been given, and admitted the evidence, but it would be extremely unsafe to consider this as a precedent.

Anticipations to be relied on must be pleaded.

But this rule might be relaxed.

Application for inspection may be made at any time during the course of an action, and in the case of the plaintiff even before delivery of the statement of claim (*Drake v. Muntz Metal Co.* [1886], 3 R. P. C. 43). A defendant may apply at any time after entering appearance (Order L. of the Rules of the Supreme Court, Rule 6). In both cases, as a rule, notice must be given to the opposite party. Applications for such Orders are made in the Chancery Division by motion in Court or summons at chambers; in the King's Bench Division by summons

Order for inspection.

Mere suspicion not enough to justify inspection order.

No order made that may prejudice business of other party.

Where penalties are claimed interrogatories not allowed.

Practice in administering interrogatories.

at chambers (Order LIV. of the Rules of the Supreme Court, Rule 12; Order LV., Rule 15). To obtain an order for inspection the plaintiff must show by affidavit that he has a case to be tried and that inspection is necessary to place the case properly before the Court; otherwise inspection will be refused (*Batley v. Kynoch* [1874-5], L. R. 20 Eq. 632). Mere suspicion will not justify inspection (*Germ Co. v. Robinson* 1884, 1 R. P. C. 217), nor will the Court order a roving inspection (*Cheetham v. Oldham* [1888], 5 R. P. C. 617). As Lord Halsbury, L. C., said in *McDonnell v. Portington* (1890, 7 R. P. C. 472): "The Court is always reluctant to grant inspection where it may be injurious to one side, and where the right depends on a question which has yet to be determined in the cause." Where the party upon whom the Order is sought to be imposed avers that inspection may disclose trade secrets, although this will not prevent the Court from making the Order, precautions may be taken by having the inspection made by some independent person, who will report to the Court, and whose report is private and confidential (*Plating Co. v. Farquharson* [1883], Griff. P. C. 187). Where an Order for inspection has been made the inspectors are usually specified by name, and the notice to be given to the opposite party is also indicated.

Order XXXI. of the Rules of the Supreme Court deals with the practice in discovery and inspection. As it is the rule that in actions for statutory penalties interrogatories by the plaintiff tending to show that the defendant is liable to such penalties are disallowed, in an action for infringement of a design brought for penalties under Section 58 of the Act interrogatories administered to the defendant need not be answered (*Saunders v. Wil* [1892], 9 R. P. C. 459). It seems, from the remarks of Lord Fisher, M. R., in the latter case, that the remedies under Section 58 and 59 are distinct, and the plaintiff must elect under which he is going. In an action for damages under Section 59, apparently interrogatories may be administered.

Leave must be obtained from the Court or a Judge before interrogatories can be delivered by either party.

and the party interrogating must pay at least £5 into Court before delivery. Application may be made by summons at chambers. As a rule, in the Chancery Division leave is only given to the plaintiff to interrogate after he has delivered his statement of claim, and to the defendant after delivery of his defence.

The plaintiff must not seek discovery of the defendant's case, but the defendant may ask anything tending to destroy the plaintiff's claim (*Hoghton v. Postill* 1869, L. R. 4 Ch. 673). A secretary or other officer answering on behalf of a corporate body need only answer as to information acquired in the course of his employment in the company and not as to information acquired apart from his function (*Walsbach Luminous Gas Light Co. v. New Sunlight Luminous Lamp Co.*, 1900, 17 R. P. C. 401).

When interrogatories are answered, they must be answered by affidavit filed within ten days or such other time as the Judge may allow. They must be answered fully, and everything tending to show the fact of infringement must be set out in the answers.

An interlocutory injunction to restrain infringement may be applied for immediately upon issue or service of the writ. If the evidence of infringement is sufficient to convince the Court, and it is apparent that the plaintiff would suffer seriously from a continuance of the wrong, an interlocutory injunction will be granted, or at all events the defendant will be ordered to keep an account. If the injunction is granted, the plaintiff must give the usual undertaking as to damages. But if the title of the plaintiff is questioned, or the defendant is able to show that he has on any ground a good *prima facie* defence, or if the plaintiff has been guilty of undue delay or other laches, no interlocutory injunction will issue.

In accordance with the ordinary rule, costs in Designs actions will usually follow the event. But, as in Patent cases, this rule may be and often is modified by circumstances. Thus, in *Sherwood v. Decorative Tile Co.* (1887) 4 R. P. C. 207, where the Court was of opinion that a good deal of the successful plaintiff's evidence was unnecessary and improper, the defendants were ordered to

Limits of  
interro-  
gatories

Answers  
to interro-  
gatories

Inter-  
locutory  
injunctions.

Costs.

Judge's  
discretion  
as to costs.

pay two thirds only of the plaintiff's costs. And where, as in *Black v. Footman* ([1888] 5 R. P. C. 653), the plaintiffs failed in their action, but succeeded on one issue, they got the costs of that issue. In *Winfield v. Snow* ([1890] 8 R. P. C. 15) only one issue was tried, and the defendants were successful on that, with the result that they got the general costs of the action and of the issue upon which they had succeeded, the costs of the untried issues being reserved. In *Birklin v. Pratt* ([1895] 12 R. P. C. 371) an unsuccessful plaintiff got the costs of the issue of want of novelty, the defendant succeeding on the issue of non-infringement.

Costs in the  
case of an  
innocent  
retailer.

*Smith v.  
Lewis  
Roberts  
& Co.*

The innocent retailer pushed into an action against his will, and after he had done all he could to avert it, usually escapes costs. Thus, in *Smith v. Lewis Roberts & Co.* ([1888] 5 R. P. C. 611) it was held that an innocent retailer who had sold in ignorance of the registered design, but who has neither sold nor threatened to sell after notice given, is entitled to have any action brought against him dismissed with costs; and this was also held in *Jau v. Grossman* ([1895] 12 R. P. C. 537), although the defendant (an innocent retailer), while promising to sell no more of the goods, declined to give a formal undertaking to that effect.

*Jau v.  
Grossman.*

No  
statutory  
provision as  
to threats.

There is no provision in the Designs portion of the Act giving a remedy in the case of threats of legal proceedings issued by the proprietor of a registered design, such as exists in the Patents portion relative to threats emanating from the proprietor of Letters Patent.

Trade libel.

If the threats in respect of a registered design constitute a trade libel or wrongfully interfere with or prejudice a man in his business he has a remedy at Common Law, but not under the Statute.

Appeal.

Either party may appeal to the Court of Appeal and thence to the House of Lords.



## CHAPTER VIII.

## RECTIFICATION OF THE REGISTER.

**S**UB-SECTIONS 1 and 2 of Section 55 of The Patents, Designs, and Trade Marks Act, 1883, provides as follows:—

The Register of Designs.

55. (1) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed; and

(2) The Register of Designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Again, by Section 90, Sub-section 1, it is provided that—

Section 90. Provision for rectifying the Register.

90. (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any Register kept under this Act, or by any entry made without sufficient cause in any such Register, make such order for making, expunging, or varying the entry as the Court thinks fit, or the Court may refuse the application, and in either case may make such order with respect to the cost of the proceedings as the Court thinks fit.

“The Court” means the High Court of Justice in England, or the Chancery Court of the County Palatine of Lancaster when the registered proprietor is within its jurisdiction. In *Bayer v. Council & Co.* ([1897] 14 R. P. C. 275) the Irish Court held that it had no jurisdiction to interfere with the Register; but in *Carie v. Herbert* ([1897] 14 R. P. C. 436) the Court of Session in Scotland (Inner House) did not doubt that it possessed such jurisdiction.

The Court.

Applications to rectify the Register are usually made by motion, and sometimes, but more rarely, by summons, and are generally made on the Chancery side.

Applications to rectify.

The question as to who may be rightly considered a “person aggrieved” within the Statute has already

Persons entitled to make

applicant to rectify.  
"Person aggrieved"

Proprietor registered on Register.

Defendant in action.

Grounds of rectification.

No lawful use of design.

Substitution of rightful owner of the Register.

been considered in Chapter IV, of the portion of this work devoted to Trade Marks; and practically as concerns Designs the issues are the same. In general terms when a person is hampered in his business, or prevented from engaging in it to the fullest legitimate extent, or when his customers are or may be intimidated or hindered from dealing with him by the existence of a design improperly on the Register, then he is a person aggrieved. He is also a person aggrieved if he is the registered proprietor of a similar design for the same or substantially the same goods, and standing on the Register in priority to the design he complains of. Again, he is a "person aggrieved" if he has been sued for infringement of the design. Once he has attained the *locus standi* of a person aggrieved, he may in his application to rectify the Register use all of the grounds upon which the registration of a design may be cancelled, or in respect of which the original registration might have been refused. For instance, he might contend that the person registered as proprietor is not and never was properly so; *e.g.* that he is neither the author, nor purchaser, nor licensee to apply the design to the manufactured articles. Or he may show that the registration of the design is invalid for want of novelty, or from prior user, or publication, or for want of subject-matter; or that goods to which the registered design has been applied have been sold unmarked or improperly marked; or that being a design manufactured and applied abroad it had not been used in this country within six months of its registration here (Section 54). With regard to this section it might be asked whether mere importation of the goods from abroad would constitute "use" within the section?

It will be remembered that in the Trade Marks portion of this work, it was shown that an applicant to expunge an entry in the Trade Marks Registry, even when he has proved to the satisfaction of the Court that the mark is really his own, cannot successfully include in the terms of his motion a request to have his name substituted for that of the originally wrongfully registered proprietor. The mark must be expunged and the proper owner may then make an application for re-registration on his own

behalf. This practice may be defended on the ground that mere prior publication and prior user, especially when wrongful, does not injure the validity of a trade mark at all. Besides, the owner has his Common Law rights to fall back upon, which are non-existent in the case of a design. In a design the prior user and publication by the original wrongful proprietor would be fatal to validity if the design were re-registered by the true owner after ousting the wrongful holder. An assignment from the wrongful proprietor to the true owner would not do, because the title of the assignor would be bad. The only equitable alternative is that the name of the applicant who has proved his right should be substituted for that of the wrongful holder, as specially provided for in the case of patents (see Section 26, Sub-section 8), so as to preserve the validity in the hands of the new owner. This was done in the case of *Grove's Design* (1899) 17 R. P. C. 139, the first of its kind. Kekowich, J., and counsel representing the Comptroller, seemed both to be under the impression that had the original registration been fraudulent instead of being inadvertent (as it was in the case cited) it would have been altogether bad, and nothing could have been done but to strike it off. But surely it is a hard saying that the true author is to be placed in a worse position by the fraud of his supplanter than by his inadvertence. However, the writer may be mistaken in this view of the meaning of the Court, and it is but just to point out that in *Heinrich's Design* (1891) 9 R. P. C. 73, the motion was to rectify the Register by striking out Heinrich's name and substituting that of the applicant. The applicant failed to convince the Court that he was the true author of the design, but there seems at no time to have been any question of the admissibility or propriety of the terms of the motion, though fraud was necessarily alleged.

When a change occurs in the name of a registered proprietor, the Register will be correspondingly altered on application to the Comptroller. Formerly it was the practice to apply to the Court for an order directing the Comptroller to make the alteration. But in *v. New*

*Grove's Design*.  
 Plaintiff assigned with a view to registration.

*Heinrich's Design*.

Power of Comptroller to alter changed name of proprietor on Register.

*Dunlop Cycle Co.'s Mark* (1896 13 R. P. C. 475), which was the case of a limited company having changed its name, North, J., held that it was not competent for the Court to make any such order under Section 92, but that the Comptroller had power to make the alteration under Section 87. It would therefore seem that no application to the Court is necessary.

Application  
to rectify  
Register  
cannot be  
made by  
counter's  
claim in  
action.

Following the practice in Trade Marks, an application to rectify the Register of Designs cannot be made the subject-matter of a counter claim in an action for infringement. It must be separately made by motion or summons. When the Comptroller is made a party to the proceedings as is usually the case, he must have four clear days' notice of the application. The registered proprietor should also be made a respondent to the motion if within the jurisdiction. If without the jurisdiction the registered proprietor should be served by letter with a copy of the notice of motion informing him of the day fixed for hearing. For notice to be given in this manner, under such circumstances, the sanction of the Court is not necessary.

If rectification is ordered, the person in whose favour it is made should leave an office copy of the order with the Comptroller, who will make the necessary alteration in the Register.

Appeal.

An appeal lies from any decision of the Court of First Instance to the Court of Appeal and to the House of Lords.

## PART IV.

## FOREIGN AND COLONIAL PATENTS.

## GENERAL REMARKS

(With a reference to the International Convention).

**I**T frequently happens that an inventor who has protected or patented his invention in this country desires also to obtain patents abroad. It is necessary, therefore, to point out that certain foreign countries will not grant a valid patent if there has been prior publication in this country or in the particular country in which protection is sought. As a rule, publication may be said to take place when a complete and full description and illustration of the invention has been placed before readers here or in such foreign countries.

Prior publication in any country of which may prevent grant of patents in other countries.

Therefore, an invention which has been fully described during the period of Provisional Protection in some widely circulated technical paper—such, for example as *The Engineer* or *Engineering*, which papers are as a rule posted immediately upon publication to subscribers in various foreign countries—would be considered as published here and in such countries.

Mode of publication.

If, however, no such publication has been allowed to take place during Provisional Protection, the publication of the British Complete Specification, which would follow in due course after filing and acceptance, would amount to the same thing. It may be taken for granted that the Patent Office copies of the Complete Specifications are to be seen in most foreign countries of any industrial importance within a short time after publication in London. The British Government presents complete sets of the Patent Office publications to certain British Colonies and Foreign States, including Austria, Belgium, France, Germany, Italy, Japan, Russia, Spain, Sweden, and the

Publication of British Complete Specification.

British Specifications sent abroad as soon as published.

United States of America. The agents in London, through whom the published specifications are transmitted to the respective countries, call for fresh consignments weekly as a rule, in one or two cases monthly, and the parcel for Austria is despatched on an average about once in six weeks. It appears, therefore, that publication of the Complete Specification here is followed so swiftly by publication abroad that, although of course such publication always remains a matter of proof, it would be, generally speaking, unsafe to delay filing the application in those foreign countries which are affected by publication.

Chief countries where prior publication bars foreign patents.

The chief foreign countries in which (saving the terms of the International Convention) valid patents cannot be obtained after the invention has thus been published are America, Austria, France, Germany, and Switzerland.

In Austria and France, and generally in Switzerland, a patent would be issued to the applicant without objection, even after such publication; but of course, if publication has actually taken place, such a patent would only remain good so long as it was unattacked. In Germany, however, patents are rigidly refused if it can be shown that the British Specification, or, indeed, any description which sufficiently ascertains the invention, was published in Great Britain even a day before the date of application in Germany.

Application should either be made before publication or under the Convention.

It will, therefore, be evident that if valid patents are desired in those countries, application should be made if possible before publication of the invention takes place in England, and certainly before any publication within the States named. As a rule it is sufficient to make application before publication of the Complete Specification in this country.

The International Convention of 1883.

But an additional factor bearing upon the question of priority of applications for foreign patents by British inventors now falls to be considered. Readers of this work have no doubt heard of the International Convention or Union for the Protection of Industrial Property. This Convention was signed in Paris in 1883, and was acceded to by the British Government on the 17th March, 1884. One of the chief provisions of the Convention was that if

a subject of any one of the subscribing countries who had made an application for a patent should make application under the Convention in any of the other countries within seven months of the original application, then these additional applications, based upon the original, would receive the original date, thus obviating the possibly hurtful effects of publication if such had taken place in the interim, and causing the different patents to start from an equal date. But since the conference held under the Convention on the 14th December, 1900, some of the original provisions stand altered. During the existence of the old arrangement certain of the signatories had from time to time proposed modifications of the terms of the Convention of 1883, which had for their objects—

- (1) The extension of the time within which subjects and citizens of countries members of the Convention might mutually make applications for the protection of patents, trade marks, and designs in countries other than that in which the original application was made so as to secure the original date.
- (2) The fixing of a common period of time in all of those countries which require patents to be worked within which patents would not be liable to forfeiture because of non-working.
- (3) Regulations as to the registration of trade marks.
- (4) Mutual provisions against dishonest competition by fraudulent use of trade marks and trade names.

Proposed  
amend-  
ments on  
the Con-  
vention.

After a voluminous correspondence, which is to be found set forth at length in the Blue Book containing the papers and correspondence relative to the Conference, published in 1901, price 7½d., the delegates met at Brussels, and the following alterations in the terms of the Convention were agreed to:—

- (1) That the seven months' period of priority for patents be extended to twelve months, and that the three months' period of priority for trade marks and designs be extended to four months.

Amend-  
ments made  
at the  
Convention  
in 1900.

- (2) That patents applied for in the various contracting States by persons admitted to the benefits of the Convention under the terms of Articles II. and III. shall be independent of patents obtained for the same invention in other States, whether parties to the Union or not. In other words, that failure or expiry of a patent in one country shall not affect the corresponding patent in another country.
- (3) That the patentee in each country shall not incur forfeiture for non-working until the expiry of a minimum period of three years commencing from the date of the deposit of the application, and not even then if the patentee can give satisfactory reasons for his failure to work.

The foregoing represent the chief alterations in and additions to the terms of the Convention. The text of these, together with that of the minor alterations, will be found consolidated with the original Convention in Appendix A.

Period when amendments came into force.

According to Article III. of the Convention and Protocol, the new terms were to be ratified, and the ratifications deposited at Brussels, within eighteen months from the date of signature (11th December, 1900), and were to come into force within three months after such deposit, this term being fixed to provide for the meeting of the Japanese Parliament. Thus it will be seen that any Power taking full advantage of the possible delay might not come into line till the 14th September, 1902. At the time of writing (December, 1901), Denmark, Switzerland, and the United States of America have executed the necessary ratifications, and it is anticipated that the remaining Powers will do so forthwith.

Present parties to Convention.

The Powers which are at present parties to the Convention are—Belgium, Brazil, Denmark, Dominican Republic, Spain, United States of America, Great Britain (with New Zealand and Queensland), Italy, Japan, Holland, Portugal, Servia, Sweden, Norway, Switzerland, and Tunis. At the Conference in 1900 the German delegate intimated



that Germany would seek admission to the Union as soon as the ratifications were complete, and similar announcements were made on behalf of Austria and Hungary. Canada is also on the point of adhering to the Convention. With these powerful recruits it seems likely that in a short time every State of any industrial importance will be a member of the Convention. Perhaps such a state of matters may ultimately lead to an International Patent Law.

In addition to the countries actually members of the Convention there are certain countries and colonies with which the British Government has made arrangements for mutual protection of patents, trade marks, and designs under the Patents Acts, 1883-1901. These arrangements derive their terms from those of the Convention, and differ only in this respect, that they are binding only as between this country and the State with which the arrangement may be made. Countries with which such arrangements at present exist are--Paraguay, Uruguay, Mexico, Roumania, Ecuador, Greece (Trade Marks and Designs only), and the Republic of Honduras.

But reverting again to the International Convention, the subject cannot be dismissed without some reference to a defect which at present seriously cripples the usefulness of the Convention. The question is this: Seeing that each country has its own Patent Law, is it clear that the resolutions of the delegates override the various Patent Laws of the respective countries without statutory modifications? In the case of Great Britain clearly not, since the Patent Act of 1901 was passed expressly to give effect to the alterations made in the Convention in December, 1900. In the United States the same answer has been officially given (see page 265 of United States Commissioners' Report on the Revision of The Patents and Trade Marks Acts, 1900), with the additional unsatisfactory feature that no modification has yet been made in the Statutes there to meet the terms of the Convention. On the other hand, it cannot be said positively that the Convention does not override the law in those countries in which no declaration to the contrary has been made. For example, in the Appendices to the Report of the

Extra  
Convention  
countries  
having  
arrange-  
ments with  
Great  
Britain.

Query:  
Does Con-  
vention  
override  
Statutes in  
adhering  
countries?

Committee appointed by the Board of Trade to inquire into the working of the Patent Acts, published in Blue Book form (1901), it is stated in a note on page 16, although without any quoted authority, that the International Convention overrides the Statute in France.

Advice on  
taking  
advantage  
of Conven-  
tion.

On the whole, until the Governments of the different countries which have adhered to the Convention have made satisfactory declarations on this subject, or have recognised the new alterations in and additions to the Convention, by Statute, the writer is of opinion that it would be unsafe to take it for granted that the Convention overrides the Patent Laws of the respective countries, or that inventors should proceed upon the assumption that the new terms of the Convention can be taken advantage of, except with the greatest caution.

Such being the case, the writer has deemed it best, in the succeeding portion of the work, to give a digest of the law and practice in each country without reference to the Convention. The countries which are members of the Convention are distinguished by an asterisk, thus: "Denmark."\* Countries with which the British Government has made mutual arrangements outside of but in the terms of the Convention are marked with a dagger, thus: "Honduras."† Other countries remain unmarked.

As a matter of fact, the terms of the Convention have been hitherto but little taken advantage of by British inventors; but undoubtedly the new features lately imported into it confer advantages which applicants cannot afford to despise or overlook.

Examina-  
tion.

Leaving the Convention and returning to the consideration of the foreign Patent Laws as they stand alone, it should be noted that in certain foreign countries, as for example in Germany, Austria, the United States of America, Switzerland, &c., applications for patents are subjected to a stringent examination both as to novelty and patentability, and the results of these examinations, especially in Germany, are sometimes surprising, and not always satisfactory to the inventor.

Durations  
of foreign  
patents.

The duration of foreign patents varies with the different countries, but in very few cases is the foreign patent allowed to run for a longer term than the full period of the

original home grant. It may have been seen that one of the objects of the amended Convention is to make the respective patents in the different countries independent of each other.

A noteworthy and most important exception to the general rule as to the interdependence of patents in the different countries has recently been made in the case of United States patents by the new Act of 1897. Prior to this date the United States patent, which is granted for seventeen years, expired with any prior foreign patent of a shorter term, for the same invention. For example, when founded upon a prior British patent, the United States patent ran only for the remaining portion of the British term of fourteen years, and this is still the case with all patents applied for before 1st January, 1898. But according to the new Act all United States patents founded upon applications filed subsequently to 1st January, 1898, are not limited by any prior foreign patent, and will in all cases remain in force for the full term of seventeen years.

United States (American) patents.

So far as relates to United States patents applied for before the 1st January, 1898, and therefore limited by the term of any prior foreign patent which may have been obtained for the same invention, it may be worth noting that at one time it was thought that the premature lapsing of the mother patent in Great Britain or elsewhere, by the nonpayment of the renewal fees for example, also voided the United States patent for the same invention. But the decision of Judge Wallace in *Paillard v. Bruno* (38 O. G. 900), affirmed by the more recent finding of Justice Bradley, of the United States Supreme Court, in *Bate Refrigerating Co. v. Gilbert et al.* (40 O. G. 1029), establishes the conclusion that such premature failure of the mother patent does not involve the expiry of the United States patent for the same invention, which will run for the full term of the mother patent, but no longer.

Premature lapsing of foreign patent does not affect United States patent.

No United States patent can be granted to the inventor upon a previous foreign patent which has expired, from whatever cause, even when such cause has been the mere nonpayment of the taxes. This was established in the United States Supreme Court in 1892 in the case of *Huber v. Nelson* (63 O. G. 311), the Court deciding that

the delay in applying for the United States patent until after the foreign patent had expired amounted to an abandonment of the right to a United States patent. But the Act of 1897 disposes of this question so far as concerns applications made after 1st January, 1898.

Difficulty in obtaining full term of patent right in all countries.

The differences of duration of patents in different countries suggest that an inventor who had thoroughly made up his mind concerning the world-wide value of his invention, and who was desirous of obtaining the full term of patent right in each country, might elect to secure his patent first in the countries which grant the longest term of all, and next and successively in the countries which grant shorter terms. For example, the first patents might be taken out in Belgium and Spain, which grant twenty years; the next in Canada, which grants eighteen years; the next in the United States, which grants seventeen; the next in France, Germany, Italy, Russia, &c., which grant fifteen; the next in Great Britain and the Colonies, granting fourteen; and after these in countries where the duration of grant would be for a less or uncertain term. It would not be impossible to carry out such a plan, but it is submitted that the suggestion is more theoretically interesting than practically useful, as unavoidable delays in obtaining the issues of the respective patents might either wreck the whole scheme or exhaust the patience of the applicant.

In the event of its turning out or being provided for that the new terms of the Convention are not repugnant to the Statutes of the different countries, the results aimed at above would happen automatically.

In most important foreign countries, with the notable exception of the United States, annual taxes are payable upon existing patents, and certain countries require the patent to be "worked" at intervals or continuously. These and other requirements are, however, so various that it will be safer for the reader to refer to each particular country in the alphabetically arranged digests which follow.

One of the most valuable of the new terms of the Convention is that which provides a common minimum period of three years in all countries, within which no patent is liable to forfeiture for non-working.

NOTE. — Countries which are members of the International Convention are marked with an asterisk (\*), and those outside of the Convention, between whom and Great Britain a mutual arrangement exists based on the terms of the Convention, are marked with a dagger (†). Other countries are unmarked.

**ALGERIA.\***

Algeria.†

This is a French colony, and is covered by the French Patent Law.

**AMERICA\* (United States).**America  
(United  
States).

(REVISED STATUTES, 1874; TITLE XI. AMENDING ACT,  
APPROVED 3RD MARCH, 1897.)

*Patentee.*—Anyone, of any age, sex, or nationality, who is the true and first inventor or discoverer, or the executor or administrator of a deceased inventor or discoverer, can obtain a patent. A patent may be issued to the inventor, or to and in the name of an assignee of the inventor, or jointly to the inventor and his assignee, but in all cases the *actual inventor*, or if deceased his executor or administrator, must make the application and sign the papers. When it is desired to issue the patent to the inventor's assignee, or to the inventor jointly with the assignee, an assignment should be filed *before the issue of the patent*, containing a request to that effect. A mere importer who is not the inventor, but who has introduced the invention for the first time from another country, is not entitled to apply for a patent. No official of the Patent Office can obtain a patent.

*Duration of Patent.*—United States patents are granted for seventeen years, and since the recent amending Act of 1897 this term is unvarying. A line of demarkation must, however, be drawn between patents applied for *before* 1st January, 1898, and patents applied for *after* that date.

*First.*—As regards patents applied for *before* 1st January, 1898, the Rules under the older Statute hold good, and

America  
(United  
States).

such patents are limited by the full term for which any prior mother patent may have been granted for the same invention in another country. Premature lapse of the mother patent, by nonpayment of renewal fees for example, does not affect the United States patent, which runs for the full term for which the mother patent was granted. To have a limiting effect the foreign patent must have been sealed or issued before the issue of the United States patent. It has been decided by the United States Courts that a patent applied for in the United States *after* the date of a British application, and issued *before* the sealing of the British patent, is not limited by the duration of the British patent, notwithstanding that the British patent is dated as of the date of the application and not of the actual sealing (*Emerson v. Lippert* 1888, 42 O. G. 964).

*Secondly.* As regards patents applied for *after* 1st January, 1898, these are subject to the new Act according to which every United States patent is issued for the term of seventeen years and is unlimited by any prior foreign patent. But this advantage depends on restrictions which the foreign inventor especially must carefully note.

Where a foreign patent is already in existence, no patent for the same invention can be obtained in the United States unless the application upon which the foreign patent was granted was filed less than seven months before the date upon which the application for a patent was made in the United States. But if no foreign patent has been actually granted, and only an application for such foreign patent has been filed and is pending, even where the seven months' grace has elapsed, the inventor may apply for a United States patent, and if he can so expedite matters that the United States patent is issued before the actual sealing or issue of the foreign patent, the rule under the old Statute holds good, and there is no limitation of the United States patent by the previously applied for, but subsequently granted, patent. The practical difficulty is that when the foreign inventor fails to make his United States application within the seven months, the time is usually so short that the foreign patent is likely to be sealed

or issued before it is possible for the United States application to be examined, allowed, and the patent issued. The Comptroller of the British Patent Office has frequently to deal with requests to keep back the sealing of British patents so that United States patents may issue before them. But however obliging he may desire to be, Section 12, Sub-section 3, of the Patent Act plainly directs him to seal the patent "as soon as may be," and (except in the case of opposition or the death of the applicant) the sealing cannot be delayed beyond fifteen months from the date of application. Thus these belated United States applications are in many cases doomed to be abortive. One way out of the difficulty would be for the British inventor to abandon his original application and re-file it so as to gain additional time, but such a course would no doubt be subject to many risks.

America  
(United  
States).

The term of a United States patent cannot be extended except by a special Act of Congress. Such extensions are costly, and are very seldom granted.

*What is Patentable.* The subject-matter of patents in the United States of America is of the same nature as the subject-matter of British patents. Section 1880 specifies "any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereon." This includes chemical processes, combinations in machinery, and other features common to British practice. With respect to purely mechanical processes, it has been held in the United States that processes which consist solely in the operation of a machine, are not patentable (*Risdon v. Medart*, 71 O. C. 751 (1895), since upheld in *Tatous v. firm Hancock Co.*, 75 O. C. 678). But processes of manufacture which involve chemical or other similar elemental action are patentable, though mechanism may be necessary in the application or carrying out of such processes; and of course the mechanism, if new, can be patented as mechanism for this purpose (*id.*).

What is  
patentable.

*Novelty of Invention; Effect of Prior Patent or Publication.* The invention must not have been known

Novelty of  
invention:

**America  
(United  
States).****Effect of  
Prior  
Patent or  
Publication.**

or used by others in the United States before the invention or discovery thereof by the inventor, and must not have been patented or described in any printed publication in the United States or in any foreign country before his invention or discovery thereof, or more than two years prior to his application, and must not have been in public use or on sale in the United States for more than two years prior to his application, unless the same is proved to have been abandoned to the public (Rev. Stat., Sec. 4886, as amended 3rd March, 1897).

Therefore, where an applicant can show that he was the original and first inventor or discoverer, and had not abandoned the invention to the public, the mere fact that the invention had been in public use or on sale in the United States for a period of not more than two years; or that it had been patented or publicly ascertained in the States by another (who was not the true inventor) not more than two years before his application, would not bar the issue of a valid patent to him.

But, as already set forth, any inventor who has applied for a patent in a country other than the United States must either make his application for the United States patent within seven months from the date of his foreign application, or failing this he must obtain the issue of his United States patent before the issue or sealing of his foreign patent.

**Taxes.**

*Taxes.*—There are no taxes or renewal fees payable after the issue of the patent.

**Working.**

*Working.*—It is not necessary to “work” the invention in the United States.

**Procedure.**

*Procedure.*—The application must be accompanied by a Complete Specification and drawings. There is no such thing as Provisional Protection, and the nearest approach, which consists in filing a  *caveat*, is available only to citizens of the United States or residents about to become citizens. The examination of applications is conducted by a staff of considerably over thirty principal examiners, and about one hundred and seventy assistant examiners, divided into



first, second, third, and fourth grades, with a host of clerks and copyists, all grades representing at the end of 1901 a total of six hundred and eighty persons. The applications are arranged in order as received, each being taken in its turn. The time during which an application may be awaiting examination varies from one to six months. Inventions are classified into two hundred and three general classes, which are again split up into more than four thousand sub-classes. At the present time a thorough general revision of the classification is in progress. The examination is very careful and thorough, and the applicant is allowed to reply to all references and objections advanced by the examiner. If the result of the examination proves the applicant to be entitled to a patent, the allowance is granted. The final fee may then be paid, and the patent is printed and issued. All patents are issued upon the third Tuesday after the first Thursday following the day upon which the final fee is received at the Patent Office. In the event of a patent being refused, the applicant may appeal to the Examiners-in-Chief; from them to the Commissioner of Patents; and from the Commissioner to the Court of Appeals of the District of Columbia.

America  
(United  
States).

Under the new Act all applications must be completed and prepared for examination within one year from filing, and where any action, amendment, or enquiry is taken or required, or made by the Office during the pending of the application, the applicant must prosecute his application within one year from such step, otherwise the application will be considered as abandoned. Under the older Statute two years was the period specified.

The new Act also provides that in actions for infringements no account of profits will be ordered or damages recovered in respect of infringements committed more than six years before the issue of the writ or filing of the bill of complaint in such action.

*Models.*—It was formerly the custom to require a model or sample of the invention in all cases, but these are now only rarely required. The Commissioner, however, retains the power to call for a working model, if the

Models.

American  
(United  
States).

specification and drawings fail to make the invention clear, or if the Examiner thinks the invention would be practically inoperative.

Assign-  
ments and  
licences.

*Assignments and Licences.*—An invention may be assigned wholly or in part, and the assignment recorded at any time, either simultaneously with or after application for a patent is made or the patent granted. The assignment may be for the whole or for any specified part of the States. All assignments should be recorded in the Patent Office within three months from date; otherwise they will be void against a subsequent purchaser or mortgagee without notice. The assignment may be drawn in any convenient form so long as the patent or application is identified by description, number, and date. An assignment executed out of the United States should be acknowledged before a United States consul, and his certificate of such acknowledgment is *prima facie* evidence of the execution of the assignment (see Rev. Stat., Sec. 4898). *Licences* relating to patents may be granted, and such licences may be exclusive, general, or restricted. Licences need not be recorded.

Marking  
Patented  
Articles.

*Marking Patented Articles.*—According to the Act, patented articles should be distinctly marked "Patented," together with the date. Where action is taken for the infringement of an invention not so marked "Patented," the plaintiff cannot recover damages, except upon proof that the defendant knew he was infringing a patent, or continued to infringe after having been notified of the existence of a patent.

Importation  
of Patented  
Articles.

*Importation of Patented Articles.*—The patented articles may be imported into the United States without affecting the patent.

Govt.  
patent fee.

*Government Fees.*—The fee on application for a patent is 15 dollars, and on allowance 20 dollars.

**ARGENTINE REPUBLIC.**

Argentine Republic.

(LAW OF 11TH OCTOBER, 1861.)

*Patentee.* The actual inventor or his assignee, or a foreign patentee (if the inventor) or his assignee, may obtain a patent in the Argentine Republic.

Patentee.

*Description and Duration of Patents.* Patents are granted for five, ten, or fifteen years, according to the merit of the invention or the wish of the applicant. A fifteen years' patent can be obtained only for an invention which has not been previously patented elsewhere. When a patent has been previously obtained in another country the duration of the Argentine patent is limited to the duration of the foreign patent, but is restricted to ten years at most. Patents of additions may from time to time be obtained, and these expire with the original patent. Inventions may be protected by natives of the Republic under provisional patents, which are kept secret, and may be extended from year to year, thus acting as a species of *carrot*. Until lately it was assumed that foreigners also had this privilege, and in many instances they have obtained provisional patents; but under recent practice they are being refused to foreigners. There is an official examination as to novelty and patentability. The term of a patent once granted cannot be extended.

Description and Duration of Patents.

*Unpatentable Inventions.*—Pharmaceutical compositions, financial schemes, principles or inventions of a theoretical nature or contrary to law and morals.

Unpatentable Inventions.

*Novelty of Invention; Effect of Prior Patent or Publication.*—To obtain a valid patent the invention should be novel, and should not have received such wide and full publicity in Argentina, or in other countries, as to place the public in full possession of the invention. A foreign patentee may apply for and obtain an Argentinian patent at any time during the existence of his foreign patent. A rigid interpretation of Clause 4 of the Act would suggest that it would be safer for a foreign patentee to file his application in the Argentine Republic before the publication of his specification abroad.

Novelty of Invention; Effect of Prior Patent or Publication.

**Argentine Republic.****Taxes.**

*Taxes.* There are no annual taxes to pay after the issue of the patent, but one half of the application fees is usually paid in successive yearly instalments after the grant of the patent.

**Working.**

*Working.* To keep the patent in force the invention must be worked in the Republic within two years from the date of issue of grant, and the working must not be thereafter interrupted for a longer period than two years, unless under excusable circumstances, which should be reported to the Patent Office. It is advisable, although not obligatory, to obtain a legalised certificate of each working as it is effected. It would seem that importation of the patented goods constitutes working; but where the patent is for a process the process must be worked in the Republic.

**Marking and Importation.**

*Marking and Importation.* There are no provisions regulating the marking or importation of patented articles, but anyone falsely marking his goods "Patented," or otherwise fraudulently representing himself to be a patentee, is liable to a penalty.

**Assignments and Licences.**

*Assignments and Licences.*—Assignments can only be made by notarial act, and after payment of the full amount of fees still due on the patent. An assignment should be registered in the Patent Office to preserve the assignee's rights against third parties. Licences may also be issued under the patent.

**Government Fees.**

*Government Fees.* The fees on a new patent vary from 80 to 350 piastres, according as the patent is taken for five, ten, or fifteen years. Patents of importation are assessed on a scale similar to that in force for new patents and according to the term granted.

**Australia.****AUSTRALIA.**

The Australasian Colonies of New South Wales, Queensland, South Australia, Tasmania, Victoria, Western Australia, and New Zealand have in each case separate Patent laws, and these will be found under their separate headings.

## AUSTRIA

Austria

(Including Bohemia, Bosnia, Herzegovina, and Lichtenstein).

(LAW OF 15TH AUGUST, 1852; TREATY OF COMMERCE, 24TH DECEMBER, 1867, EXTENDING PATENT TO HUNGARY; LAW OF 27TH DECEMBER, 1893, SEPARATING AUSTRIAN AND HUNGARIAN PATENTS; NEW LAW, DATED 11TH JANUARY, 1897, AND OPERATING FROM 1ST JANUARY, 1899.)

Under Article 14 of the reciprocal Treaty of Commerce of 1867 between Austria and Hungary a common Austro-Hungarian patent was formerly granted covering both countries; but under a further Statute of 27th December, 1893, which came into operation on the 1st January, 1894, separate and independent patents are granted in Austria and Hungary. The new Act, which came into force on the 1st January, 1899, deals with amendments of the Austrian Patent Law, and brings it very much into line with the existing German Patent Law.

*Patentee.* Only the true and first inventor or originator of an invention has a right to a patent for the same, but until the contrary is proved the first applicant is deemed to be the true inventor. Where a prior patent exists in another country, an Austrian patent for the same invention can only be obtained validly by the foreign patentee or his legal representative or assignee. A firm or corporation may be the grantee of a patent.

*Duration of Patent.* - Patents are granted for fifteen years, but if based upon a prior patent in another country the Austrian patent is limited by the term of such prior patent. Patents of addition are now granted, these being limited to expire with the mother patent.

*Novelty: Effect of Prior Patent or Publication.* - Prior to the date of application in Austria, the invention must not have been described in a printed publication nor must it have been publicly worked in the Empire. British inventors

**Austria.**

who have applied for a patent at home, and who wish to obtain an Austrian patent, would do well to refrain from giving premature descriptions of their inventions in the leading English technical papers, and to make the Austrian application before the publication of the British Complete Specification. Presentation copies of all published specifications are sent from the Patent Office in London to Austria at short intervals of time, so that publication in Austria may always be relied upon to take place very shortly after publication in this country. Nevertheless, the fact of publication in Austria is always a matter for proof. So far as copies of German Patent Office prints are concerned, valid patents may be obtained in Austria, irrespective of publication there, if applied for within three months from the issue of the German print.

**Taxes.**

*Taxes.* When the patent has been granted (the grant dating from the time when it is advertised as open to public inspection) its continuance is conditional on the payment of an increasing annual tax due at the beginning of each successive year, and progressing from about £3 for the first year to £32 for the last.

**Working.**

*Working.* The patentee must commence to work the patent within three years from the date of grant, and the working must be continued without serious interruption during the existence of the patent, and must be *bona fide*. Proof of the commencement of working, at all events, should as a measure of precaution be noted on the Patent Register.

**Subject-Matter of Patents.**

*Subject-Matter of Patents.* All inventions the subject-matter of patents in Great Britain are patentable in Austria; but under the new law inventions relating to the manufacture of tobacco, salt, and gunpowder, which are Government monopolies, cannot be patented in Austria; nor are patents granted for articles of food or luxury, or for medicines or chemical products; but processes for the production of such articles may be patented. All applications are now subject to examination as to novelty and patentability.

*Assignments.* -When made in England the assignments prepared in Germany should be executed by the assignee before a notary public, whose signature in turn requires to be legalised by an Austrian consul. The assignment must be registered in Austria, and to effect this the assignee should sign a notarial power, also legalised by the consul, authorising an attorney in Austria to effect the registration of the assignment.

Austrian  
Assign-  
ments.

### BAHAMA ISLANDS.

Bahama  
Islands.

(COLONIAL ACT 52 VICT. CAP. 23: 23RD MAY, 1889.)

*Patentee.* -Strictly the true and first inventor, but practically the first importer also, may obtain a valid patent. A corporation cannot alone apply for a patent.

Patentee.

*Duration of Patent.* - Patents are granted for seven years, but extensions can be easily obtained up to a maximum period of twenty-one years.

Duration  
of Patent.

*Novelty: Effect of Prior Patent.* -The invention must not have been publicly known or used within the Bahama Islands. The fact of prior patents having been obtained in other countries will not affect the granting of a perfectly valid patent in the Bahamas, so long as the invention is not public property there at the time of application being made.

Novelty:  
Effect of  
Prior  
Patent.

*Taxes.* No taxes are due after issue of seven years' patents. But in the event of extensions being sought, the Government fee is £10 for the second term of seven years, and £20 for the third term of seven years.

Taxes.

*Working.* Under the original Act it was necessary to work the patent in the Bahamas within three years from date. Now, however, under Section 6 of 53 Vict. c. 2, an amending Act (assented to in March, 1890) repealed the working clause, so that there is now no obligation to work the invention within the colony during the term of patent right.

Working.

**Bahama  
Islands.**  
—  
Assign-  
ments and  
Licences.

*Assignments and Licences.* Assignments require to be in duplicate and in the English language. Any form will serve, and, although not obligatory under present practice, it is desirable to have assignments acknowledged before a notary public whenever possible. Assignments must be recorded in the office of the Registrar of Records. Licences can be granted as in other countries.

General.

*General.* When a prior British patent exists, a certified copy of such patent should accompany the application papers. A printed copy of the specification, certified by the Comptroller, will do. No formal "Letters Patent" are at present issued by the authorities in the Bahamas, the only documents confirming title being the Registrar's certificate of filing and the *Official Gazette* containing a notice of the application. A certified copy of the patent can, however, be obtained for about £6. There are no provisions as to importing or marking patented articles.

Govern-  
ment Fees.

*Government Fees.* £3 on original grant; £10 for first extension of seven years; £20 for second extension of seven years.

**Barbados.**

## BARBADOS.

(Act of 12th DECEMBER, 1883.)

Patentee.

*Patentee.* The true and first inventor, or the first importer, may obtain a valid patent. Corporations or firms in their firm name cannot apply, although a corporation may join with the actual inventor or inventors.

Duration  
of Patent.

*Duration of Patent.* The duration and description of patents are the same as in the Bahamas. Patents are granted for seven years, but they may be extended for two successive terms of seven years each.

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

*Novelty: Effect of Prior Patent or Publication.* The invention must be new in Barbados; *i.e.* must not have been published nor be in general use before the date



of application. The fact of the invention having been patented or published elsewhere will not prevent the grant of a valid patent in Barbados. Barbados.

*Taxes.*—There are no taxes on the seven years' patent. If the patent is extended for the further second and third terms of seven years, fees are payable on such extensions. Taxes.

*Working.*—The invention must be worked in Barbados within seven years from the date of the patent. Theoretically the working should be *bona fide*, but in practice the working requirement can be validly met by importing and offering the patented articles for sale in the colony. A patent for a process should, however, actually be put in operation. Working.

*Assignments and Licences.*—Assignments should be prepared in duplicate in the English language, attested before a notary, and legalised. Licences may be granted. There are no provisions for the registration of either assignments or licences. Assignments and Licences.

*General.*—No formal Letters Patent are issued, and the patentee must be content with the certificate of filing and the notice in the *Official Gazette* unless he cares to pay an extra fee of from £5 to £10 for a certified copy of the patent. The patented goods may be imported in any quantity, and there are no provisions to compel the marking of the goods with the word "Patented." General.

*Government Fees.*—On original grant £3 6s. 8d.; on first extension for seven years £10; on second extension for seven years £20. Government Fees.

## BELGIUM.\*

Belgium

(LAW OF 24TH MAY, 1854.)

*Patentee.*—The true and first inventor, or his assignee, or anyone authorised by the inventor; or the first importer, or a firm or a corporation, may obtain a valid patent so long as no fraud has been exercised in procuring the patent. Patentee.

**Belgium.**

Duration  
and De-  
scription of  
Patents.

*Duration and Description of Patents.*—Belgian Patents are of two kinds—viz., Patents of Invention and Patents of Importation. *Patents of Invention* are granted to applicants who apply for a patent in Belgium before a patent has been issued to them for the same invention in another country. This patent is granted for twenty years. *Patents of Importation* are granted to an importer, or to an inventor who has already obtained a patent or patents in other countries. Such patents are limited, to expire with the prior foreign patent having the longest term, so long as this does not exceed twenty years. *Patents of Addition* for improvements on the original invention may from time to time be tacked on to the original patent, whether of invention or importation, and become part of the original patent, and expire with it.

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

*Novelty: Effect of Prior Patent or Publication.*—So far as *Patents of Invention* are concerned, the invention must not have been published or used openly in Belgium, nor must a patent for the same have been actually obtained in any other country before the date of the Belgian application. Therefore, a patent applied for in Belgium after the date of the British Provisional Protection, but before actual issue of the British Letters Patent, or at least before the filing of the British Complete, would be lawfully a patent of invention lasting for twenty years. *Patents of Importation* can be applied for at any time during the term of the foreign patent, granted that it has not meanwhile come into public and commercial use in Belgium, and also granted that it has not been clearly and fully described in a printed or published work in that country. The official publication of the Complete Specification in those countries where such publication takes place does not affect the validity of Patents of Importation in Belgium.

**Taxes.**

*Taxes.*—Belgian patents are subject to increasing annual taxes. The first tax of 10 francs is paid with the application; the second annuity is increased to 20 francs; and so on, the tax increasing 10 francs annually. If, by inadvertence, the tax should not be paid at the proper

time, one month's grace is allowed without fine, and six months' grace may be obtained by payment of a fine of 10 francs in addition to the tax. Belgium.

*Working.*—The invention must be worked in Belgium Working. within one year from the date of the patent, or within one year of its having been practically or commercially worked in any other country; and so long as the working in any other country continues to be carried on, the working in Belgium must not cease for an entire year at a time. Where the Belgian patent has been taken out *after* the invention has been practically worked abroad, the invention should be worked in Belgium within one year from the date of the patent. The working should be *bonâ fide*. If the invention relates to a marketable article, the article should be made and offered for sale in reasonable quantity; if to a process, the process should be carried out in some manufactory in Belgium. In all cases a certificate of working should be obtained from the proper authorities. The question of "working" patented inventions in Belgium and in one or two other European States is full of uncertainty, expense, and annoyance. The usual course that inventors take is to effect some kind of nominal or perfunctory working of their invention at the lowest cost possible, and then, having received the certificate, they feel at ease. But this compliance with the letter of the law and evasion of the spirit, although it may serve to keep the patent in force, yet leaves it seriously open to attack. The Belgian Courts have declined to pronounce on such matters, and leave it to the Government to annul or maintain a patent according as it may think a patent has or has not been sufficiently worked. However, in the few cases which the Government authorities have taken into consideration, the opinion has been expressed that working cannot be effected by importation, although importation is not prohibited; also that a strictly legal working consists in manufacturing the patented articles in Belgium in sufficient quantity to meet the commercial demand. The Government, however, seldom or never interferes to annul

**Belgium.** a patent or question its validity on account of insufficient working unless called upon to do so by an interested party, and even then reasons for insufficient working might exist which would be held to form a good and sufficient excuse.

Assignments and Licences.

*Assignments and Licences.*—Assignments must be in French, executed in duplicate before a notary public, whose signature, when out of Belgium, must be legalised by a Belgian consul. Assignments must be registered. Licences can also be granted to work the patent in Belgium.

Government Fees.

*Government Fees.*—First tax on application 10 francs; second year 20 francs; and so on to the twentieth year, for which the tax is 200 francs. Patents of Addition become incorporated with the original patent, and no taxes are payable in respect of them except the fees on application. This, however, only applies to Patents of Addition granted to the original patentee.

**Bolivia.**

## BOLIVIA.

(LAW OF 8TH MAY, 1858.)

Patentee.

*Patentee.*—The actual inventor or the true and first importer from abroad.

Duration and Description of Patent.

*Duration and Description of Patent.*—There are two kinds of Patents—viz., *Patents of Invention* (that is, when the original patents are obtained in Bolivia), and *Patents of Importation* granted to a foreign patentee or to an importer. Patents of Invention are granted for not less than ten or more than fifteen years. The term of Patents of Importation is subject to a curious qualification. If the establishment of the industry would involve an outlay of 20,000 pesos, the patent is granted for three years; if the outlay would amount to 50,000 pesos, the term is six years; if to 100,000 pesos, the patent right is for ten years.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been widely or generally published in the press, or have come into general use, either in

Bolivia or elsewhere. An invention already patented in another country may be validly patented in Bolivia, even after the publication of the foreign specification. Bolivia.

*Taxes.*—None after issue of the patent. Taxes.

*Working.*—Patents must be worked in Bolivia within a year and a day from date, but this time may be extended on reasonable cause being shown. A certificate of the working should be obtained from the proper authorities. Working.

*Assignments and Licences.*—Assignments must be in duplicate, in the Spanish language, legalised by a Bolivian consul when executed out of Bolivia. A power of attorney, also legalised by the consul, is required to authorise the recording of the assignment, a step which is absolutely necessary to avoid forfeiture. Licences can be issued. Assignments and Licences.

### BRAZIL.\*

Brazil.

(LAW OF 14TH OCTOBER, 1892.)

*Patentee.*—The true and first inventor may obtain a patent, or a foreign patentee may have his rights confirmed in Brazil. Joint inventors may obtain a joint patent. Patentee.

*Duration of Patent.*—Patents are granted for fifteen years, but they expire with a prior foreign patent for the same invention, if such has been obtained. Patents of addition to the original patent may be obtained during the first year by the original patentee or his legal representative only; after that time Patents of Addition may be obtained by other inventors. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not be known or publicly used in Brazil at the time of application. An inventor who has already obtained a patent elsewhere is protected from the consequences of publication, or use or attempted appropriation of the invention by another applicant in Brazil, if he makes his application within seven months (under the recent Convention amendment, twelve months) from the date of his foreign patent. If an inventor wishes to use or Novelty Effect of Prior Patent or Publication.

**Brazil.** exhibit his invention in Brazil before applying for a patent there, he may do so with safety on obtaining an official permit to that effect.

**Taxes.** *Taxes.* Patents are subject to annual and increasing taxes, commencing with 20 dollars for the first year, increasing to 30 dollars for the second, 40 dollars for the third, and so on, at the rate of 10 dollars per annum until the full term is reached. No extension of the time for payment is allowed.

**Working.** *Working.* - The working of the invention must be effected, proved, and a certificate obtained, before the end of the third year, and such working must not be at any time suspended for a greater period than one year. If the working should be prevented by any circumstances over which the patentee has no control, the Government will condone the omission on proper proof being shown. Importation of the patented goods is not prohibited. The fraudulent marking of patented articles is punishable by a fine of from 100 to 500 dollars.

**Assignments and Licences.** *Assignments and Licences* may be prepared in any convenient form, and must be in the Spanish language. No assignment will take effect until registered in the Bureau of Agriculture, Commerce, and Public Works.

**Government Fees.** *Government Fees.* - The actual Government fees, apart from other unfixed expenses, are represented by the amounts under the head of "Taxes."

### British Guiana.

## BRITISH GUIANA.

(ORDINANCE No. 13 of 1861.)

**Patentee.** *Patentee.* - Patents are granted to the true and first inventor, which term includes the first importer of the invention to the colony.

**Duration of Patent.** *Duration of Patent.* - Patents are granted for fourteen years, subject to the limiting effect of any prior foreign patent. It is, however, not difficult to obtain the extension of a patent for a farther term of seven years.

*Novelty: Effect of Prior Patent or Publication.*—To obtain a valid patent the invention must not, prior to the date of application, have been publicly known or used in the colony. A prior patent in another country, even when published there, will not affect the validity of a subsequent patent in British Guiana, so long as the invention is not publicly known or used there at the date of application.

British Guiana.

Novelty: Effect of Prior Patent or Publication.

*Taxes.*—A renewal fee of 100 dollars is due before the expiry of the seventh year of the patent right. No extension of the time for payment is obtainable.

Taxes.

*Working.*—There is no compulsory working of the invention, and the patented articles may be imported to the colony. The marking of the goods is left to the discretion of the patentee.

Working.

*Assignments and Licences.*—These should be in the English language, and assignments should be made in duplicate in any suitable form. When made in a foreign country they should be legalised by a British consul. Both assignments and licences must be entered in the Register of Patents.

Assignments and Licences.

## BRITISH HONDURAS.

British Honduras.

(LAW OF 10TH SEPTEMBER, 1862.)

*Patentee.*—The true and first inventor, or the first importer, may obtain a valid patent.

Patentee.

*Duration of Patent.*—Fourteen years, subject to the limit of any prior patent for the same invention obtained elsewhere. Extensions may sometimes be obtained.

Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not be published or publicly known, or used in the colony, before the date of application. The existence of a prior home or foreign patent, so long as it is not publicly known in British Honduras, will not affect the validity of a patent there.

Novelty: Effect of Prior Patent or Publication.

British  
Honduras.  
—  
Taxes.

*Taxes.*—A tax of 50 dollars is due before the end of the third year of the patent, and a farther tax of 100 dollars is due before the expiry of the seventh year. The time for making these payments cannot be extended.

Assign-  
ments and  
Licences.

*Assignments and Licences.*—These should be in the English language, and should be entered in the Register of Patents to have effect against third parties.

British  
North  
Borneo.

### BRITISH NORTH BORNEO.

(PROCLAMATION No. 1 OF 1887.) See **Straits Settlements.**

British  
South  
Africa.

### BRITISH SOUTH AFRICA.

Patents may now be obtained throughout the British South African Territories. The Cape Colony Act (No. 17 of 1860) has been adopted in text and practice.

Patentee.

*Patentee.*—Patents are granted to the true and first inventor or to the first importer.

Duration of  
Patent.

*Duration of Patent.*—Patents are dated from the day of application and run for fourteen years.

Novelty:  
Effect of  
Prior Patent  
or Publica-  
tion.

*Novelty: Effect of Prior Patent or Publication.*—So long as the invention is new in British South Africa, publication or patenting in another country will not bar the grant of a valid patent.

Taxes.

*Taxes.*—£10 before the end of the third year; £20 before the end of the seventh year. No extension allowed for making these payments.

Working.

*Working.*—None required, and importation of goods is allowed.

Assign-  
ments.

*Assignments.*—May be prepared in the ordinary British form, and should be witnessed and registered.



**BURMAH.**

Burmah.

Burmah is a province of British India, and is covered by the Indian patent.

**CANADA.**

Canada.

(COLONIAL ACT OF 1886, CAP. 61.)

*Patentee.*—A patent may be obtained by the true and first inventor or inventors, or by his or their assigns or legal representatives. As in the United States, the actual inventor, or, if deceased, his legal representative, must in all cases sign the papers and make the application, but the patent may issue to the inventor alone, or jointly to the inventor and his assignee, or to the assignee alone, a proper assignment and request being filed before the issue. Patentee.

*Duration of Patent.*—Patents are granted for eighteen years, subject to the conditions as to payment of taxes and working; but where a prior patent exists in another country, the Canadian Patent will expire with the said prior patent. A special legislative Act is required to obtain an extension. A *carcat*, which is a species of provisional application, may be filed by an intending applicant so as to secure a date, and such a *carcat* will remain good for a year, but cannot be renewed. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—For the purposes of a valid patent, an invention is considered new in Canada if the invention has not been in public use or on sale in the Dominion for more than one year, without the consent of the original and true inventor. It will be remembered that similar latitude, extending to two years, exists in the United States. If a home or foreign patent exists for the same invention, the Canadian application must be made before the expiry of twelve months from the date of issue or sealing of such prior patent. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—The taxes for the full term of eighteen years may be paid before the issue of the patent. This, however, Taxes.

**Canada.** is very rarely done. The better plan is to pay the amount of 20 dollars for the first six years only at the time of making application, then to pay the renewal tax of 20 dollars before the end of the sixth year, and twenty dollars before the end of the twelfth year. There are no means of prolonging the time for making these payments.

**Working.** *Working.* --The invention must be worked or commenced to be worked in Canada within two years from the date of the patent. The working must not be of a perfunctory nature, but must be sufficiently real and extensive to place goods on the market and supply any demand that may exist for the patented article. If two years should prove too short a period in which to effect this, an enlargement of the time to twelve months may be obtained by presenting a petition for such enlargement. This petition must not be made more than three months before the expiry of the term of two years. After working has been commenced, it must not be discontinued. In order to work an invention continuously, so as to comply with the law, it is a common practice with patentees to arrange with some manufacturer to make or to be ready to make the patented articles, and then to advise that the goods may be had from this manufacturer or agent. Such an arrangement is held by authorities in Canada to constitute a perfectly legal working of the invention within the provisions of the Act.

**Assignments and Licences.** *Assignments and Licences* may be prepared in any manner acceptable to English practice. Every assignment must be registered in the office of the Commissioner of Patents.

**Marking Patented Articles.** *Marking Patented Articles.* --All patented articles must be marked "Patented," together with the date of the patent. Penalties are exacted from those who fraudulently mark their goods "Patented" where no patent exists.

**Importation of Patented Goods.** *Importation of Patented Goods.* --No patented goods must be imported by the patentee, or with his knowledge or consent, into Canada, at any time after twelve months from the date of the patent. The effect of such importation

would be to make the patent void. An extension of the term within which importing may be carried on may usually be had by filing a petition to that effect. Canada.

*Models.*—Before the Canadian patent is issued, it is usual to demand a model, which should to some extent be a working model of the invention. The size should not exceed twelve inches on the longest side. Compositions (except explosive compounds) should be explained by the production of samples of their ingredients. Models.

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### CANARY ISLANDS.

(See Spanish Colonies.)

Canary  
Islands.

### CAPE COLONY.

(Including British Bechuanaland.)

(Act No. 17 of 1860.)

Cape  
Colony.

*Patentee.*—Patents are granted to the true and first inventor, or to the person who first imports an invention into the colony. Patentee.

*Duration of Patent.*—Patents are granted for fourteen years, but where a prior home or foreign patent exists, the term expires with such prior patent. Duration of  
Patent.

*Novelty of Invention; Effect of Prior Patent.*—To obtain a valid patent in the Cape, the only requirement is that application should be made before publication or public use of the invention has taken place within the colony. The existence of a prior patent, or the fact of the invention having been published in another country, does not injure the validity of the grant in the Cape. Novelty of  
Invention;  
Effect of  
Prior  
Patent.

*Taxes.*—£10 is due to be paid before the end of the third year of the term of the patent right, and a further sum of £10 before the expiry of the seventh year. Taxes.

**Cape Colony.**

*Working.*—There is no obligation to work the invention in the colony.

**Working, Assignments and Licences.**

*Assignments and Licences.* These may be prepared in any suitable form, and must be entered in the Register of Proprietors.

**Ceylon.****CEYLON.**

(ACT No. 16 OF 1892.)

**Patentee.**

*Patentee.*—Patents are issued to the actual inventor or to his legal representative or assign. A first importer is not entitled to a patent.

**Duration of Patent.**

*Duration of Patent.*—Patents are granted for fourteen years, and are capable of extension if sufficiently good grounds can be shown. When prior patents exist, the patent in Ceylon is limited by the term of the mother patent.

**Novelty of Invention : Effect of Prior Patent.**

*Novelty of Invention : Effect of Prior Patent.*—When the original application is made in Ceylon, the invention must be new and unpublished in Ceylon or in the United Kingdom. If a British patent has been obtained, application in Ceylon should be made within twelve months from the date of the *actual sealing* of the British Letters Patent, and a valid patent will be issued for Ceylon, granted that the invention has not become publicly known in the colony before the date of application. Where application only has been made for a British patent, the applicant may take out a patent in Ceylon if he makes application there within twelve months from the date of his British application, and the validity of such a patent will not be affected by the fact that the invention has, within such period of twelve months, become publicly known in the United Kingdom and in Ceylon. The specification can from time to time be amended as in Great Britain.

**Taxes.**

*Taxes.*—An annual tax of 50 rupees is payable before the expiry of the fourth, fifth, sixth, seventh, and eighth years; and a tax of 100 rupees before the expiry of the ninth, tenth, eleventh, twelfth, and thirteenth years.

*Working.*—There is no requirement as to working the invention, and no prohibition upon importation. **Ceylon.**  
Working.

*Assignments.*—These may be prepared in any suitable form, and should be entered in the Register of Inventions. The new proprietor's name should also be entered in the address book kept in the office of the Colonial Secretary for the purposes of service. **Assignments.**

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### CHANNEL ISLANDS.

**Channel Islands.**

These islands are no longer covered by the British patent, but a species of protection may be obtained by enrolling a certified copy of the British patent in the Rolls of the Royal Court in Jersey and Guernsey.

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### CHILI.

**Chili.**

(LAW OF 9TH SEPTEMBER, 1840; AMENDED 20TH JANUARY, 1883.)

*Patentee.*—The actual author, or inventor, or first importer. **Patentee.**

*Duration of Patent.*—The duration of patents was fixed by the law of 1840 at ten years, but by the amending Act of 1883 power was given to the President to extend this term up to twenty years, and, as a matter of fact, in practice, this latter term is usually granted. The term of a patent commences at the expiry of the term fixed within which it must be worked. **Duration of Patent.**

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new to, or not known or published in, Chili at the date of application. With this proviso inventions already patented and published abroad may be validly patented in Chili. A regulation exists whereby, in the case of an invention which has been patented abroad, the Chilean application is advertised in the *Official Gazette*, so as to give any person who has begun to practise the invention in Chili an opportunity of opposing the grant. **Novelty: Effect of Prior Patent or Publication.**

Chili.	<i>Examination.</i> —The application is subject to examination as to novelty and utility by a committee of experts.
Examination.	
Taxes.	<i>Taxes.</i> —None.
Working.	<i>Working.</i> —In granting the patent the Government fixes and endorses on the grant a period of time within which the invention must be put to work in Chili. The manufacture should be actually established or taken in hand by that time, and it is submitted that a mere perfunctory working would scarcely avail. An extension of the time for working, of not more than six months, may be obtained on sufficient cause being shown. The term of the patent commences on the expiry of the time allotted for working it. The working must not at any time be discontinued for more than one year.
Assignments &c.	<i>Assignments &amp;c.</i> —These should be in the Spanish language, executed in duplicate, and legalised, when signed abroad, by a Chilean consul. The Minister of the Interior should be advised of the completion of an assignment, and, if he is satisfied that it is a <i>bona fide</i> transaction, he will enter the assignment on the transfer book.
Government Fees.	<i>Government Fees.</i> —A fee of 50 dollars is payable upon application.

**China.****CHINA.**

The Empire of China has no law for the protection of inventions. Some sign of awakening has been shown by the publication of an Imperial Decree on the 5th of July, 1898, authorising the enactment of patent and copyright laws, but no advantage has, so far, been taken of this permission. It is, however, possible to obtain protection by securing a special grant or monopoly from the national authorities, the average cost of which has been estimated at about £500. Another method is to register certified copies of the specification in the Chinese Foreign Office, and also at the Consulate of the country to which the

applicant belongs, and thereafter to advertise full particulars of the invention, together with a notification of the inventor's right of property, in the principal Chinese official newspapers. This latter method is said to confer quite as much protection as the first, and is much less expensive, as it may be done for about £50.

### COCHIN CHINA.

(EXCLUDED UNDER THE FRENCH PATENT.)

Cochin  
China.

### COLUMBIA.

(LAW NO. 35, 13TH MAY, 1869.)

Columbia.

*Patentee.*—The true inventor, first importer, or the owner of a prior foreign patent, may obtain a valid patent in Columbia.

Patentee.

*Duration of Patent.*—Patents are granted for five, ten, fifteen, or twenty years, at the option of the applicant. A Columbian patent will expire with a prior foreign patent.

Duration  
of Patent.

*Novelty: Effect of Prior Publication.*—To be validly patentable the invention should not be known or published in Columbia. Inventions patented abroad may be patented in Columbia at any time during the existence of the prior patent, but not if the invention has in the meantime become known in Columbia.

Novelty:  
Effect of  
Prior  
Publication.

*Unpatentable Inventions.*—No patents can be obtained for inventions relating to cigarettes or the manufacture of cigarettes, this being a Government monopoly.

Unpatent-  
able  
Inventions.

*Examination.*—There is no preliminary examination.

Examina-  
tion.

*Taxes.*—None after the issue of the patent.

Taxes.

*Working.*—The patent must be worked within a year from date, and must not be discontinued during an entire year. There is nothing to prohibit importation.

Working.

**Columbia.**  
Assign-  
ments &c.

*Assignments &c.* should be prepared in Spanish and be made in duplicate. They should be legalised by a Columbian consul. There being no provision in the law for the assignment of patent rights, it is not the practice to register them; but, as a patent is now everywhere recognised as constituting property, it would be quite a proper step to seek registration for documents which deal with such rights.

**Government Fees.**

*Government Fees.*—Ten dollars on application. On grant of a patent a fee is paid, which is arrived at by assessing from 5 to 10 dollars for each year of the term for which the patent is issued.

**Congo  
Free  
States.**

### CONGO FREE STATES.

(LAW OF 29TH OCTOBER, 1886; DECREE OF  
30TH OCTOBER, 1886.)

**Patentee.**

*Patentee.*—Anyone may obtain a patent in Congo, whether the inventor or not.

**Duration  
and  
Description  
of Patent.**

*Duration and Description of Patent.*—Patents are classified as “Patents of Invention” and “Patents of Importation.” Patents of Invention are granted for twenty years. A Patent of Importation expires with the prior foreign patent upon which it is usually founded. Patents of Addition are also granted, which become a part of and expire with the original patent.

**Novelty:  
Effect of  
Prior  
Patent or  
Publication.**

*Novelty: Effect of Prior Patent or Publication.*—The law says nothing as to the effect of prior use or publication upon patents in Congo. The practice is, however, grounded upon that of Belgium, so that it may be taken that inventions which are known or published in Congo at the date of application are not patentable there unless the invention is patented abroad, and even then only upon the conditions annexed to the Belgian law.

**Examina-  
tion.**

*Examination.*—There is no examination.



Congo Free States.

*Taxes.*—None after issue of patent.

Taxes.  
Working.

*Working.*—Working is not compulsory. Patented articles may be imported, and there is no obligation to mark them as such.

*Assignments.*—These must be notified to the Department of Foreign Affairs, and the assignment is advertised in the *Bulletin Officiel* in the same manner as patent grants.

Assignments.

*Government Fees.*—One hundred francs on application.

Government Fees.

**CORSICA.**

Corsica.

(INCLUDED IN FRENCH PATENT.)

**COSTA RICA.**

Costa Rica.

(LAW OF 26TH JUNE, 1896.)

*Patentee.*—The actual inventor.

Patentee.

*Duration of Patents.*—Patents are granted for twenty years. Patents of Addition may also be had.

Duration of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new; but the law specifically provides that patents may be issued to foreigners for the unexpired term of their home patent. It seems that publication of the prior patent specification will not bar the right to a valid patent in Costa Rica.

Novelty: Effect of Prior Patent or Publication.

*Working.*—The patent must be worked in Costa Rica within two years from grant. Importation of the goods is held to constitute working.

Working.

*Taxes.*—None after issue.

Taxes.

*Assignments.*—These should be in duplicate and be legalised by a consul of Costa Rica.

Assignments.

Cuba.

**CUBA.**

Cuba having ceased to be a Spanish colony and the United States having made no attempt to impose its own patent law there, patents in Cuba are unprocureable until a stable Government has been established and the protection of inventions legislated for.

Cyprus.

**CYPRUS.**

(NO PATENT LAW.)

Denmark.

**DENMARK.\***

(LAW OF 28TH MARCH, 1894.)

Prior to the 28th March, 1894, no statutory provision existed in Denmark for the protection of inventors. The Ministry of the Interior had powers to grant equivalent privileges, which were perhaps sufficiently adequate for national industries, but which adopted a harsh attitude towards foreign inventors. Now, however, Danish patents are granted by virtue of an Act passed by the Danish Parliament on the above date, and taking effect from July, 1894. The chief provisions are as follows:—

Patentee.

*Patentee.*—Any person, whether native or alien, may obtain a patent, provided he is the true inventor or the legal assignee of the true inventor. If the applicant is an assignee the assignment must be produced legalised by a Danish consul.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fifteen years from the date of application, and are not subject to limitation by prior patents for the same invention in other countries. Patents of Addition are granted for improvements on the original invention, and these expire with the original patent. The grant of a patent may be opposed by an interested or aggrieved person.

*Novelty: Effect of Prior Patent or Publication.*—At the date of application the invention must not have been publicly used in Denmark, and must not have been fully and intelligibly described in print either in Denmark or elsewhere. Therefore prior publication of the specification of a foreign patent in a foreign country would destroy the validity of a Danish patent for the same invention (*per* Mr. E. Carpmael, *Transactions of the Chartered Institute of Patent Agents*, Vol. 14, p. 30). All applications are subject to examination as to novelty and patentability.

**Denmark.**  
Novelty:  
Effect of  
Prior  
Patent or  
Publication.

*Taxes.*—Patents, to be kept in force, must be sustained by the payment of annual taxes, amounting for the first, second, and third years respectively to £1 8s. 2d. in English money, and thereafter doubling in amount every third year until the end of the twelfth year, when the tax is £16 18s. for each of the last three years. An extension of time of three months within which to pay any overlooked tax may be had on payment of a fine amounting to one fifth of the tax due.

**Taxes.**

*Working.*—The invention protected by the patent must be worked in Denmark within three years from the date of the patent. Under special circumstances the term for working the patent may be prolonged, or exemption from working may be obtained. No authoritative decision has yet been given as to what amount of working will constitute a valid compliance with the Act, but leading authorities are of opinion that working on a small scale will suffice. Importation of the patented goods into Denmark is not permitted under the terms of the Act, but in practice it seems that when a patentee has obtained exemption from the duty of working the invention in Denmark importation of the patented goods is not only allowed but required.

**Working.**

*Assignments and Licences.*—These may be prepared in any suitable terms, and should be registered.

**Assignments and  
Licences.**

*Government Fees.*—Represented in English money, these amount to £3 3s. on application, and consist of the application fee, 20 crowns; the issuing fee, 10 crowns; and the first annual tax, 25 crowns. The succeeding annual taxes have already been detailed.

**Government  
Fees.**

## Ecuador.

## ECUADOR.\*

(LAW OF 18TH OCTOBER, 1890.)

## Patentee.

*Patentee.*—The true inventor or the first importer.Duration  
and  
Description  
of Patent.

*Duration and Description of Patent.*—There are two kinds of patents - viz., *Patents of Invention*, that is when the original patent is obtained in Ecuador; and *Patents of Importation*, granted to a foreign patentee or to an importer. Patents of Invention are granted for not less than ten or more than fifteen years. If the establishment of the industry constituting the subject-matter of a Patent of Importation involves an outlay of 20,000 pesos, the patent is granted for three years; if the outlay would amount to 50,000 pesos, the term is six years; if to 100,000 pesos, the patent right is for ten years.

Novelty -  
Effect of  
Prior  
Patent or  
Publication.

*Novelty; Effect of Prior Patent or Publication.*—The invention must not have been widely or generally published in the Press in Ecuador or elsewhere before the date of application. An invention patented in another country may be validly patented in Ecuador even after publication of the specification abroad.

## Taxes.

*Taxes.*—None after issue of patent.

## Working.

*Working.*—Patents must be worked in Ecuador within a year and a day from date. An official certificate of the working should be obtained.

Assign-  
ments and  
Licences.

*Assignments and Licences.*—Assignments should be in duplicate, in the Spanish language. When executed out of Ecuador they should be legalised by a consul of Ecuador. The assignment should be recorded, or it will be of no effect. Licences and assignments can be prepared in any convenient form.

## Egypt.

## EGYPT.

There is at present no Patent law in force in Egypt, but a system has of late years arisen whereby new inventions, trade marks, and designs may be enrolled at the

Registry of the Commercial Mixed Tribunals in Alexandria. **Egypt.**  
 Under this registration action may be taken against infringers and counterfeiters. The fact of such registration should be advertised in the principal Egyptian newspapers so as to establish further evidence of ownership, and to put traders on their guard.

**FIJI ISLANDS.**

**Fiji Islands.**

(ORDINANCE No. 3 of 1889.)

*Patentee.*—Patents are granted to the true and first inventor or importer. **Patentee.**

*Duration of Patent.*—Patents are granted for fourteen years, limited to expire with any prior patent in another country. **Duration of Patent.**

*Novelty: Effect of Prior Patent or Publication.*—The fact of the invention having been already patented or published in other countries will not prejudice the validity of a patent obtained in Fiji, if unknown there at the date of application. **Novelty: Effect of Prior Patent or Publication.**

*Taxes.*—None. **Taxes.**

*Working.*—None. **Working.**

*Government Fees.*—On application, £5 5s.; on issue of patent, £10 10s. **Government Fees.**

**FINLAND.**

**Finland.**

(DECREE DATED 21ST JANUARY, 1898, AND OPERATING FROM 1ST JANUARY, 1899.)

*Patentee.*—The actual inventor or his representative, or those deriving rights through him. **Patentee.**

*Duration of Patent.*—Patents are granted for fifteen years dating from the grant. Patents of Addition may from time to time be obtained, expiring with the original patent. **Duration of Patent.**

- Finland.** *Subject-Matter of Patents.*—All useful inventions; but no patent will be granted for foods or medicines or for chemical products. Patents may, however, be obtained for processes for the production of such articles.
- Novelty: Effect of Prior Patent or Publication.*—No patent will be granted for an invention which by public use or by description in any publication has become known to persons in Finland versed in the particular industry to which the invention relates. But publication in consequence of an application for a patent made to a foreign Government will not prevent the grant of a valid patent if application is made in Finland within six months from the date of publication.
- Taxes.** *Taxes.*—The patent, when granted, is subject to the payment of progressively increasing annual taxes, beginning with 20 marks for the second and third years, and rising to 70 marks for the last two years. Three months' grace is allowed for the payment of any tax which may have been overlooked, but subject to a fine amounting to one fifth of the tax due.
- Working.** *Working.*—The patentee must work his invention in Finland within three years from the date of grant, and must not thereafter discontinue the working for any one year. If during the first three years or thereafter the patentee should fail to work the invention, he can be compelled to grant licences to work on reasonable terms to persons prepared to undertake the manufacture or exercise of the invention.
- Assignments and Licences.** *Assignments and Licences.*—These must be recorded at the Direction of Industry, otherwise assignments or charges on the patent will be of no effect as against third parties afterwards obtaining and registering similar interests without notice of the prior assignment or charge. In the case of foreigners the assignment and power authorising registration must be legalised by a Russian consul.
- Marking.** *Marking.*—Falsely marking goods as "patented" or advertising them as such when, in fact, no patent exists therefor, is punishable by a fine not exceeding 500 marks.

**FRANCE\* (and Colonies).**France  
(and  
Colonies).(LAW OF 5TH JULY, 1844; DECREE OF 21ST OCTOBER, 1848;  
AMENDING DECREE OF 9TH JULY, 1901.)

*Patentee.*—Although, strictly speaking, only the true inventor or his assignee is legally entitled to a patent, practically anyone, whether the inventor or not, or the first importer, or a firm, or a corporation, may obtain a patent in France. In any case where the patentee is not the inventor, his title to the patent is unquestionable if he can show that he made the application in his own name and with the consent of the inventor.

Patentee.

*Duration of Patent.*—Patents are granted for five, ten, or fifteen years at the option of the applicant. In almost all cases the fifteen years' term is asked for. Patents of Importation for inventions already patented abroad expire with the prior foreign patent which is the first to lapse. Patents of Addition are granted, and become part of the original patent, and expire with it.

Duration of  
Patent.

*Unpatentable Inventions.*—Pharmaceutical compositions and medicines of all kinds, and also financial schemes, cannot be patented in France.

Unpatent-  
able  
Inventions.

*Novelty: Effect of Prior Patent or Publication.*—The invention must be novel, and Article 31 of the French Law says: "No discovery, invention, or application shall be considered as new which in France or abroad, and before the date of the deposit of the application, has received sufficient publicity to enable the same to be worked." It is clear, therefore, that to enable a British applicant to obtain a valid French patent he must make his application in France before the publication of his specification in this country. It must be understood that the French authorities make no examination into the novelty of an invention, and a patent for anything will be granted to any applicant; but of course a patent which did not possess the legal essentials would be of little value to its owner. The mere fact of a prior foreign patent being in existence for the same invention will not invalidate the French

Novelty:  
Effect of  
Prior Patent  
or Publica-  
tion.

France  
and  
French  
Colonies.

patent so long as the invention has not been published, or used, or otherwise made publicly known, before application for a patent in France.

New Rules  
as to  
Preparation  
of Specifi-  
cations.

*New Rules as to Preparation of Specifications.*—In pursuance of the recent Decree of 9th July, 1901, new rules relating to the preparation of the specification and drawings were promulgated on the 3rd September, 1901. Formerly the authorities accepted any specification, however inadequate, and any drawings prepared in any manner the inventor pleased. The specifications were not printed or published, and the administration of patents had scarcely any official recognition. Now, however, by virtue of the latest Decree, a French National Patent Office has been organised, and was opened in Paris on 1st October, 1901. The new rules insist upon the preparation of the specification in a proper and skilled manner. The drawings must be on sheets of fixed sizes which correspond with those of the British patent, and must be executed in clear black lines on Bristol board, so as to be capable of reproduction by photo-lithography. These rules came into effect on the 1st January, 1902. The intention is that in future French specifications will be printed, published, and sold at a small cost.

## Taxes.

*Taxes.*—French patents are subject to the payment of an annual tax of 100 francs. No extension of time for the payment of the tax can be obtained.

## Working.

*Working.*—A French patent must be worked within two years from the date of the *actual signature or issue of the Letters Patent*, and must not cease during any two consecutive years thereafter. Failure to fulfil this condition will render the patent liable to be declared void, unless such failure was caused by circumstances which were beyond the patentee's control. Sickness, poverty, political disturbance, the difficulty of getting the patent taken up by reason of the limited field of use—all of these have been held good as excuses to prevent forfeiture. There are several cases which show that the French Courts are becoming more and more unwilling to accept the mere pretence of working



which is common in the case of most patents. It has been held, for example, that a single act of manufacture of the invention is not enough. No doubt the expense of working is a severe tax upon patentees; but if the patent is at all likely to be of value, proper working should not be neglected. The mere sending of the parts of a machine into France and fitting them together there would not, according to the Courts, be a sufficient working. The whole or a portion of the parts should be made in France, and the readiness of the patentee to supply a demand should be advertised in a French newspaper of standing. The patentee might sometimes find a manufacturer or agent to undertake the working of the invention on reasonable terms. It is advisable in all cases when the working is effected to obtain a certificate to that effect from the proper authorities. So long, however, as it is possible to prove afterwards *that the invention actually was worked*, the mere omission to obtain a certificate will not matter.

France  
and  
French  
Colonies.

*Assignments.*—According to the French Law (Section 4, Article 20) no assignment can be recorded until all the future annual taxes are paid for the full term of the patent. This immediate expense can, however, be avoided by preparing an irrevocable power of attorney, authorising a notary to effect the assignment, and the name of the notary may be left blank. This power is signed by the vendor, legalised by a French consul, and may then be kept by the purchaser. If circumstances should require registration, he has only to fill in a notary's name, who will then be empowered to have the assignment made and recorded.

Assign-  
ments.

*Marking and Importing Patented Articles.*—In France a patentee is not obliged to mark patented articles as such; but if he do so, he must add the words "*Sans Garantie du Gouvernement*," or the initial letters of the phrase, "S. G. D. G." The penalty for omitting this is from 50 to 1,000 francs. France being a member of the International Convention, the patented articles may be imported freely from other countries which are also members of the Union,

Marking  
and  
Importing  
Patented  
Articles.

France  
and  
French  
Colonies.

as is, for example, the case with Great Britain. But the denizens of other countries which are not members of the Union are not allowed this privilege, and importation by a citizen of such a country would involve the forfeiture of his patent.

Govern-  
ment Fees.

*Government Fees.* These are represented by the annual taxes already set forth.

*N.B.* The French patent covers the colonies of Algeria, Cambodia, Cochin China, French Guiana, Guadeloupe, La Réunion, Leguay Islands, Marquisas Islands, Martinique, Miquelon, New Caledonia, St. Pierre, Southampton, and Tahiti.

French  
Indo-  
China.

### FRENCH INDO-CHINA.

(DECREE OF 24TH JUNE, 1893.)

Under this Decree patents are issued in Indo-China upon conditions similar to those set forth in the French Law.

Gambia  
(British).

### GAMBIA (British).

This colony has no Patent law, but protection for a meritorious invention can easily be obtained by special Legislative Act, at a cost of about £50.

German  
Empire.

### GERMAN EMPIRE.

(LAW OF 1ST JULY, 1877.)

Patentee.

*Patentee.* Whoever first applies for a patent is entitled to the grant. Patents are granted to a single applicant, to joint applicants, to a firm, or to a corporation. But if a person who is not the inventor has his application opposed by the true inventor, and the latter succeeds in showing that the applicant obtained the invention from him, the patent will be refused to the fraudulent applicant and granted to the true inventor.

*Duration of Patent.*—Patents are granted for fifteen years from the day following the date of application, and the lapse of a prior foreign patent does not affect the German patent. Patents of Addition are granted, which expire with the original patent.

German  
Empire.  
-----  
Duration of  
Patent.

*Unpatentable Inventions.*—Articles of food, pharmaceutical compositions, and the products of chemical processes. But chemical processes apart from the products are patentable.

Unpatent-  
able  
Inventions.

*Novelty: Effect of Prior Patent or Publication.*—The German Law is very severe in respect to novelty. An application for a patent must be filed before the invention has been described in any printed publication, either in Germany or elsewhere. For example, German applications by British inventors, even when made before the publication of the British Complete Specification, have been refused, because of short descriptions of the invention which have been incautiously published in some English technical papers. Therefore, whoever wishes to secure a German patent must see to it that no publication of his invention shall be allowed to take place until after the deposit of his German application.

Novelty:  
Effect of  
Prior Patent  
or Publica-  
tion.

*Examination.*—All applications are subject to a very strict and thorough examination as to novelty, utility, and patentability. The patent records and technical publications of every country are examined carefully, and any anticipatory matter which can be found is quickly brought to the notice of the applicant. Patentability is also a feature which the Examiners take upon themselves to decide. Although not so drastic in their decisions as they formerly were, the conclusions of the German Examiners are not always of a satisfactory nature. An appeal may be had from the decision of the First Examiner to the Board of Examiners-in-Chief.

Examina-  
tion.

*Taxes.*—Annual progressive taxes are payable on German patents. The first annuity amounts to 30 marks, the second to 50 marks, and thereafter the tax increases at the rate of 50 marks per annum.

Taxes.

German  
Empire.  
—  
Working.

*Working.*—Patents must be put to work within three years from the date of the grant of the patent. If this working is not effected in due time, the Act says not that the patent therefore *becomes void* but that *it may be declared void*. There are, therefore, many cases where failure to work within the appointed time has not been followed by any annulment of the patent. But this depends upon the circumstances. For example, the patentee of a new manufacture of armour-plate was excused because of the difficulty and cost of working such an invention, and in view of the fact that he had offered to license certain makers in Germany. But the patentee of an automatic pencil was deprived of his patent because the Court held that the invention could have been easily worked in Germany. Besides, it was shown that a large demand existed in Germany for the pencil, which was proved by the fact that the patentee had imported enormous quantities of the pencils into Germany. The decisions all show that the provision for working is intended to be met by a real manufacture of the invention being carried on in Germany; that the working should be actual and thorough; and that a mere scamped pretence of working would not satisfy requirements. Therefore, when a patentee cannot himself establish such a manufacture, he should try to arrange with a German manufacturer or agent to make or put himself in a position to make the patented article, and to advertise that fact in the Public Press. Importation of the patented goods is not prohibited, and there is no obligation to mark the articles as "Patented," although this should always be done.

Models.

*Models.*—Models and samples are required in the following classes of invention:—Firearms, spools, spindles and shuttles (in the case of spindles a sectional model should also be supplied), skates, chemicals (except explosives), and dyes.

Assign-  
ments and  
Licences.

*Assignments and Licences.*—To enable an assignment of a German patent to be properly registered at the Patent Office the assignment should be in German, signed by

the assignor before a notary, whose signature should be attested by a German consul. No consideration need be expressed. The assignment should be accompanied by a power of attorney, signed by the assignee, and authorising an agent or attorney in Berlin to register the assignment on behalf of the assignee. This power should also be attested by a notary and a consul, as in the case of the assignment. Licences may also be granted in respect of German patents, and there is a provision in the German law whereby a patentee who refuses to grant licences on reasonable terms, when such licences seem to be demanded in the public interest, may be deprived of his patent.

German  
Empire.

#### USEFUL DESIGNS PATENTS.

An Act for the protection of useful designs in Germany came into effect on the 1st of October, 1891. Such designs patents are granted without any examination. For many articles and novelties which would not warrant the expense of a patent, or which do not possess the elements of patentability, the Designs Act will suit admirably. The full period of protection is six years. Where a Patent of Invention is wished for, but where the chance of obtaining it seems slight, applicants sometimes file an application for a patent and an application under the Designs Act *simultaneously*, including under the latter application a request that the Office will grant the Design Protection only in case of the rejection of the Patent Application. If the patent is refused all is not lost, as the applicant has the Design Application to fall back upon. If the patent is granted, then the Design Application can be withdrawn. There is no obligation to work a patented design in Germany, as must be done in the case of ordinary patents. The design must be new in Germany.

Useful  
Designs  
Patents.

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*Baden, Bavaria, Prussia, Saxony, and Wurttemberg are covered by the German patent.*

Gibraltar.

**GIBRALTAR.**

Gibraltar has no Patent Law, but British patentees may have their patents extended to cover the dependency for the unexpired term of the British patent.

Gold Coast  
Colony.**GOLD COAST COLONY.**

This colony has no Patent Law, but protection may be obtained by way of special Legislative Act at a cost of about £50.

Greece.

**GREECE. +**

Greece has no Patent Law, but a Private Act can be obtained for the protection of a meritorious invention.

Guade-  
loupe.**GADELOUPE.**

Covered by French patent.

Guate-  
mala.**GUATEMALA.**

(LAW OF 17TH DECEMBER, 1897.)

Patentee.

*Patentee.*—All natives of the country and foreigners who have resided for at least one year in the Republic may obtain patents for new inventions. Patents may be granted to non-resident foreigners, where such grant is the only possible means of introducing a new industry into the country, and in such case only where there are International Conventions or Treaties providing for the grant of patents to non-resident inventors. (Guatemala withdrew from the International Convention in 1895, but at present has Treaties with France, Honduras, San Salvador, and Costa Rica, which provide for the reciprocal protection of industrial property.)

*Duration of Patent.*—Patents are granted for from five to fifteen years. Patents of Addition to the original patent may from time to time be obtained either by the original inventor or by another.

**Guatemala.**  
Duration of Patent.

*Novelty: Prior Patent or Publication.*—The invention must be new and must not have been published in Guatemala or abroad prior to the application. The existence of a prior patent or application in another country would not bar a patent in Guatemala, so long as no publication of the invention has taken place.

Novelty:  
Prior Patent or Publication.

*Taxes.*—An annual tax of 30 pesos must be paid within the first ten days of January in each year, to maintain the patent in force. No grace is allowed in the event of oversight in making the payments.

Taxes.

*Working.*—The patent must be worked within a year of grant, and must not be discontinued during any one succeeding year. In practice importation of goods difficult to produce in Guatemala, such as machinery and instruments, is asserted to constitute compliance with the working clause, but the manifest object of the condition in the Act is to cause the establishment of new manufactories and enterprises in the country, and it is difficult to see how mere importation can meet the requirements.

Working.

*Marking.*—No actions in respect of infringements can be brought unless the patented articles legitimately on the market have been marked “patented,” together with the number of the patent.

Marking.

*Assignments.*—A patent may be assigned, but either the assignor or assignee must be bound to pay the annual taxes. Assignments must be registered in the *Diario Oficial*, and should in the case of British subjects be executed before a notary public and legalised by a Guatemalan consul.

Assignments.

## HAWAII.

Hawaii.

(Law of 29th August, 1884.)

*Patentee.*—Only the true and first inventor is entitled to a patent.

Patentee.

<b>Hawaii.</b>	<i>Duration of Patent.</i> — Ten years from date of issue, but limited by the term of any existing prior foreign patent.
<i>Novelty; Effect of Prior Patent or Publication.</i>	<i>Novelty; Effect of Prior Patent or Publication.</i> — The invention should not have been publicly used or published either in Hawaii or elsewhere. But where an invention has been patented elsewhere, a valid patent can be obtained in Hawaii for the invention, granted that it has not been in public use in Hawaii for more than one year.
<i>Taxes.</i>	<i>Taxes.</i> — None after issue of patent.
<i>Working.</i>	<i>Working.</i> — The patentee is not obliged to work the invention in Hawaii.
<i>Assignments.</i>	<i>Assignments.</i> — Assignments should be acknowledged before a notary public, and must be recorded within three months from date of execution.
<i>Government Fees.</i>	<i>Government Fees.</i> — On application 5 dollars are payable. The Commissioner of Patents is paid a fee of 20 dollars for examination, and a tax of 5 dollars is payable on the issue of the patent. No further payments are required.

**Holland.****HOLLAND.\***

Holland has at present no Patent Law; but it is expected and hoped that this state of things will not much longer continue. The Queen in her Address from the Throne in September, 1901, mentioned a new Patent Law as one of the measures intended to be submitted to Parliament.

**Honduras  
(Republic).****HONDURAS † (Republic).**

Honduras has no Patent Law; but the Government will protect inventions of special utility by introducing and carrying a Bill to that effect. The cost of such a grant necessarily varies, but the average expense is about £80.



**HONG KONG.**

Hong Kong.

(ORDINANCE OF 1892.)

*Patentee.*—The patentee, inventor, or proprietor, by assignment or otherwise, of an invention which has already been patented in Great Britain is alone entitled to obtain a patent for the same invention in Hong Kong.

Patentee.

*Duration of Patent.*—The term is limited to expire with that of the British patent. If the British patent is extended, the Hong Kong patent may be similarly extended.

Duration of Patent.

*Novelty: Prior Publication.*—The form of petition (Schedule A) requires the applicant to declare that the invention is not now and has not been publicly used in the colony, but the Act says nothing about novelty, and it may be taken that, whether so used or not, the proprietor of a British patent has a right to a patent in Hong Kong.

Novelty.  
Prior  
Publication.

*Taxes.*—None after issue.

Taxes.

*Working.*—No requirements.

Working.

**HUNGARY.**

Hungary.

(LAW OF 7TH JULY, 1895, OPERATING SINCE 1ST MARCH, 1896.)

*Patentee.*—The true inventor, or his successors, assigns, or legal representatives, may obtain a patent. A firm or corporation may apply for and obtain a patent in its own name if it is the assignee of the inventor.

Patentee.

*Duration of Patent.*—Patents of Invention are granted for fifteen years, dating from the day of application. Patents of Addition are also granted, expiring with the original patent. These can only be obtained by the original patentee. Patents of Improvement on an original patent are granted for fifteen years—during the first year only to the original patentee, and afterwards to him or to others. An application for a Patent of Improvement if made by some one

Duration of Patent.

**Hungary.** other than the patentee during the first year is kept secret, and if at the end of that time the original patentee has not applied for a similar improvement a patent is issued to the subsequent inventor.

**Subject-Matter.** *Subject-Matter.*—Generally speaking, the subject-matter of valid patents agrees with the practice in most other States. But no patent is granted for an invention contrary to law or against public morals, nor for war material, nor medicines, foods, chemical products, and the like, although processes for the production of such things are patentable.

**Novelty. Effect of Prior Patent.** *Novelty: Effect of Prior Patent.* The invention must not have been previously used or published in Hungary or elsewhere so as to have become known to persons versed in the art. Publication of a Patent Specification in another country will vitiate novelty unless there is a reciprocal Treaty in force between Hungary and the State where patent publication took place. The novelty of an invention is not enquired into by the Patent Office.

**Working.** *Working.* - A patent may be revoked unless within three years from the publication of the grant the patentee works his patent in Hungary to an extent adequate to the demands of the country. But no revocation takes place until the patentee has been warned and sufficient time given him to comply with the requirements. Revocation may be avoided by granting licences to those desirous of working the patent.

**Taxes.** *Taxes.* - Besides the tax on application there are annual taxes on the patent, beginning with 40 kronen for the first year, and rising progressively to 500 kronen for the fifteenth year. Thirty days' grace without fine and thirty days with a fine of 20 kronen are allowed for the payment of any annuity.

**Assignments.** *Assignments.*—A patent may be assigned wholly or in part, and licences may be issued by the patentee. Assignments and exclusive licences should be registered in the Patent Office to be of effect against third parties taking without notice.

**ICELAND.****Iceland.**

Iceland (which is a Danish Possession) has no Patent Law, but patents are granted in the same manner and upon the same terms and conditions as in Denmark. (See "Denmark.")

**INDIA.****India.**

(Act No. 5 of 1888.)

*Patentee.*—Patents are granted only to the true inventor, his assignee, or legal representative. The term "inventor" does not include the first importer. Patentee.

*Duration of Patent.*—Patents are granted for fourteen years, and are limited by the duration of any prior foreign patent. Thus an Indian patent founded on a prior British patent will expire with the British patent. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—When a British patent has already been applied for or obtained, an application by the inventor for an Indian patent may be filed at any time within one year from the *actual sealing* of the British Letters Patent. But in such a case the invention must not have been known or publicly used *in India* before the date of the British application. Use or publication in India between the date of the British application and the expiry of one year from the sealing of the British patent will not prejudice the Indian patent, whether such use or publication takes place in India or in the United Kingdom. But in the case of an original Indian application the invention must be absolutely new and unknown in India; and in the case of an application by a foreign patentee *i.e.* a patentee other than British—his application in India must be made within one year from the *actual date* of his prior foreign patent, and before any use or publication of the invention in India. Novelty  
Effect of  
Prior  
Patent or  
Publication.

- India.**  
**Taxes.** *Taxes.*—As is the case in Great Britain, the Indian patent remains untaxed until the end of the fourth year of its existence, when annual taxes of 50 rupees from the fourth to the eighth year, and 100 rupees from the eighth to the thirteenth year, fall due to be paid. Extensions of time of from one to three months may be had, subject to a fine of from 10 to 50 rupees for payment of these taxes.
- Working.** *Working.*—There are no requirements as to working, nor as to importation or marking.
- Assignments.** *Assignments.*—Assignments may be drawn in any usual form, and must be registered at the office of the Secretary of the Government of India. Compulsory licences may in certain cases be applied for and enforced.

**Italy.****ITALY.\***

(LAW OF 31ST JANUARY, 1864, WHEREBY THE SARDINIAN LAW OF 30TH OCTOBER, 1859, WAS EXTENDED TO THE WHOLE KINGDOM.)

**Patentee.**

*Patentee.*—In original applications by subjects the applicant must be the true and first inventor. In the case of inventions already patented abroad the true inventor or his assignee (which term includes an individual, a firm, or a corporation) may obtain a valid patent.

**Duration of Patent.**

*Duration of Patent.*—Patents are granted for from one to fifteen years, as desired by the applicant. In most cases it is advisable to apply in the first instance for a six years' patent, because in that case *two* years are granted within which to work the invention, whereas for a less term *one* year only is allowed. The six years' patent can afterwards be prolonged to the full term of fifteen years, either annually or by terms of years as desired. An Italian patent for an invention which has been already patented abroad expires with the foreign prior patent

which has been granted for the longest term. Patents of Italy. Addition are granted, to expire with the original patent, of which they form a part.

*Novelty: Effect of Prior Patent or Publication.*—When a foreign patent has been already applied for or obtained, a valid patent may be had in Italy for the same invention at any time during the existence of the said foreign patent, even when published and in general use. But in that case the Italian application should be made before the invention has become publicly known or been put to public use in Italy by persons *other than the inventor or patentee*. When an original application is made in Italy, the invention must not have been known or publicly used in the kingdom before the date of application. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—When the patent is applied for and the term of grant fixed, a proportional tax on the number of years agreed upon is calculated and paid, at the rate of 10 lire per annum. In addition to this there are annual taxes of 40 lire for each of the first three years; 65 lire for each of the following three years; 90 lire for the next three years; 115 lire for the tenth, eleventh, and twelfth years; and 140 lire for each of the three last years. Three months' grace without fine is allowed within which to pay these taxes. Patents of Addition are subject only to the payment in advance of a fee of 20 lire. Taxes.

*Working.*—If the term of patent right is less than six years, the patent must be worked in Italy before the expiry of one year from the date of the patent, and must not cease during any one year thereafter. If the term of the patent is for six years or more, then two years are allowed within which to work the patent, and the working must not cease during any two years thereafter. Where the working has been omitted, owing to causes which were beyond the patentee's control, his failure to work may be condoned so as not to entail forfeiture of his patent rights. As a rule, the Italian Courts have shown themselves inclined to favour patentees, but it may be said that lack of means has not been held to constitute a good excuse. When the patent is for a machine, the best plan is to import the machine, preferably in parts. Working.

**Italy** and put it together and operate it in Italy. But a process patent should be worked by going through the process there. In all cases a properly attested certificate of the working should be obtained and filed by the patentee. Importation is allowed, and there are no provisions as to marking patented articles.

**Assign-  
ments.**

*Assignments.*—When a patent is assigned *in toto* the assignee becomes bound to pay the taxes or renewal fees. When only partly assigned, or when assigned in distinct shares or to separate individuals, not having common interests, registration can only be effected upon payment of the whole of the taxes still due in the future upon the remainder of the term of the patent right. It will be remembered that a provision similar to the latter, but applicable to all forms of assignment, exists in the French Law.

**Jamaica.**

## JAMAICA.

(LAW No. 15 OF 27TH MAY, 1891.)

**Patentee.**

*Patentee.*—The intention of the Act is evidently to confine the grant of Letters Patent to the true and first inventor or his authorised attorney. But, with the widening of the meaning of the term “inventor,” it is the custom for assignees and first importers to apply for patents of which they are in no sense the authors. There is, however, no decision to the effect that Letters Patent so granted are invalid.

**Duration of  
Patent.**

*Duration of Patent.*—Patents are granted for fourteen years, and when prior foreign patents exist the patent in Jamaica expires with the foreign patent having the shortest term. As is the case in the United States and in most other countries, a valid patent cannot be obtained for an invention the foreign patent for which has expired. Patents of Addition are granted, which expire with the original patent.

**Novelty  
Effect of  
Prior  
Patent or  
Publication.**

*Novelty: Effect of Prior Patent or Publication.*—The invention should not, at the date of application, have

been introduced into public and common use in Jamaica. **Jamaica.**  
 With this proviso, inventions patented and published in other countries may be validly patented in Jamaica at any time during the term of the foreign mother patent.

*Taxes.*—No taxes are due after issue. **Taxes.**

*Working.* The invention must be worked within two years from the date of the patent. Importation and operation of a patented apparatus have been held sufficient to fulfil the requirements of working in Jamaica. The goods need not be marked. **Working.**

*Assignments.* These should be registered in the office of the Colonial Secretary. **Assignments.**

**JAPAN.\***

**Japan.**

(LAW DATED DECEMBER, 1888, AND OPERATIVE SINCE 1ST FEBRUARY, 1889.)

*Patents.*—Subjects and citizens of those countries which have treaties with Japan containing the "most favoured nation" clause are competent to obtain patents in Japan. The countries at present in that position are Great Britain, United States, France, Spain, Italy, Belgium, Portugal, Germany, Russia, and Holland. The applicant must be the actual inventor, but the patent may be issued to the inventor and an assignee jointly, or to an assignee alone upon a request to that effect by the inventor. Mere importers cannot obtain a patent, nor will a grant be made to a corporation. No official in the Patent Office can obtain a patent. **Patents.**

*Duration of Patent.*—Patents are granted for five, ten, or fifteen years, at the option of the applicant. The term of grant cannot be altered after the issue of the patent. Patents of Improvement may also be had either by the original inventor or by others. A patent may be amended and re-issued. **Duration of Patent.**

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new, and must not have been put to public use or published in Japan or elsewhere at the date **Novelty: Effect of Prior Patent or Publication.**

**Japan.** of application. An invention patented in another country but not published in Japan may also be patented there. But if publication has taken place in Japan (for instance, by the importation of the British Specification) a Japanese patent cannot be obtained, except under the Convention.

**Subject-Matter.** *Subject-Matter.* Generally, the subject-matter of patents in Japan is the same as subject-matter in most other countries, but foods, drinks, and medicines cannot be patented.

**Taxes.** *Taxes.* There are no annual taxes.

**Working.** *Working.* The invention must be *bona fide* and commercially put in practice in Japan within three years from date of grant, and must not be suspended during any period of three years. Commercial importation of the patented goods is forbidden.

**Models.** *Models.* Where practicable models (but not necessarily working models) of the invention must be supplied with the application, or within ninety days of demand. The model should not exceed 1½ inches in length, breadth, or height.

**Assignments.** *Assignments.* Patents may be assigned or mortgaged, and the assignment or mortgage, to be valid against third parties taking without notice, must be registered in the Patent Office.

**Marking.** *Marking.* Patented articles must be marked as such, otherwise the patentee cannot sue for infringements.

## LEEWARD ISLANDS.

**Leeward Islands.**

(Antigua, Anguilla, Dominica, Montserrat, Nevis, St. Christopher, and Virgin Islands.)

(Act No. 12 of 1876, and No. 16 of 1878.)

*Patentee.*—The true and first inventor or first importer.

**Patentee.**

**Duration of Patent.**

*Duration of Patent.* Patents are granted for fourteen years, expiring with any prior foreign patents. Extensions may sometimes be obtained.



<i>Novelty: Effect of Prior Patent or Publication.</i> —Prior publication or patents in another country will not prevent the grant of a valid patent in the Leewards, if the invention is not known or used in the colonies at the time of application being made.	<b>Leeward Islands.</b> Novelty Effect of Prior Patent or Publication.
<i>Taxes.</i> Before the end of the third year a tax of £10 is payable, and before the end of the seventh year a further tax of £20. No prolongation of time is obtainable if these taxes should be missed. The patent must be forwarded for endorsement and the payment of the taxes.	Taxes.
<i>Working.</i> No working is necessary.	Working
<i>Assignments.</i> These may be in any suitable form, and should be recorded in the Register of Proprietors.	Assignments.
<i>Government Fees.</i> In addition to the taxes already mentioned, the fees payable on application and issue of the patent amount to £15, and those to the Attorney-General to about £20.	Government Fees.

**LIBERIA.****Liberia.**

(ACT OF 23RD DECEMBER, 1864.)

<i>Patentee.</i> —The true and first inventor, his legal representatives or assigns.	Patentee.
<i>Duration of Patent.</i> —Twenty years.	Duration of Patent.
<i>Novelty: Effect of Prior Patent or Publication.</i> —The invention, whether sought to be protected by a citizen of Liberia or a foreigner, must not be known or published within the limits of the Republic at the date of application. A prior patent in another country will not prevent the same inventor from obtaining a valid patent in Liberia.	Novelty. Effect of Prior Patent or Publication.
<i>Taxes.</i> —None after issue.	Taxes.
<i>Working.</i> —Patents granted to aliens must be worked within three years of date.	Working.
<i>Assignments.</i> —By Section 8 patents are assignable in law.	Assignments.
<i>Government Fees.</i> —Fifty dollars are payable on application.	Government Fees.

**Luxemburg.****LUXEMBURG.**

(LAW OF 30TH JUNE, 1880.)

**Patentee.**

*Patentee.*—The first applicant or applicants. A firm or corporation may be the grantee of a patent. A patent may, however, be revoked if it can be proved that the grantee has procured the patent in fraud of another person.

**Duration of Patent.**

*Duration of Patent.*—Patents are granted for fifteen years. Patents of Addition are also granted, which expire with the original patent.

**Novelty Effect of Prior Patent or Publication.**

*Novelty: Effect of Prior Patent or Publication.*—The patent must not be known or publicly used in Luxemburg at the date of application. Neither must it have been published or openly worked in any one of the States of the German Customs Union. If these conditions as to novelty hold good, the existence of prior foreign patents will not prejudice the Luxemburg grant.

**Taxes.**

*Taxes.*—There are annual taxes of 10 francs for the first year, 20 francs for the second year, and so on, increasing 10 francs per annum during the term of the patent. Three months' grace is allowed for making payment.

**Working.**

*Working.*—The patent should be worked within three years from date. Importation and operation of a patented machine will satisfy requirements.

*N.B.*—The patent lapses if a patent for the same invention has not been applied for, or is not within three months applied for, in the States with which the Grand Duchy may be connected by treaties of Customs Union; and if such collateral patent expires from any cause, the Luxemburg patent also expires. At present the German patent is the only one answering to the indicated description, so that unless the inventor possesses or intends to apply for a German patent the Luxemburg grant would be of no use to him.

**Madeira Islands.****MADEIRA ISLANDS.**

(COVERED BY PORTUGUESE PATENT.)

**MALTA.**

Malta.

(ORDINANCE No. 13 OF 1889; ORDINANCE No. 5 OF 1893;  
ORDINANCE No. 1 OF 1894.)

*Patentee.*—The true and first inventor or his authorised attorney.

Patentee.

*Duration of Patent.* Patents are granted for fourteen years, limited by the term of any prior patent in another country.

Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been published or openly used either in Malta or elsewhere. A patent in another country will not prejudice the Maltese grant if the invention has not been made publicly known. The publication of the British, American, or German Specification would prevent the obtaining of a valid Maltese patent.

Novelty  
Effect of  
Prior  
Patent or  
Publication.

*Taxes.*—Before the end of the fourth year £4; before the end of the fifth, sixth, and seventh years £5; before the end of the eighth and ninth years £7 10s.; before the end of the tenth, eleventh, twelfth, and thirteenth years £10. The payment of each tax must be endorsed on the Letters Patent.

Taxes.

*Working.*—If the invention is not worked in Malta within twelve months, or if the working is thereafter suspended for a continuous period of twelve months, the patentee may be required to assign his rights, or grant the use of the patent to some competent manufacturer, for a consideration to be determined by a Civil Court. Inquiry from those competent to give an opinion points to the conclusion that importation and sale of the patented articles would satisfy working requirements.

Working.

*Assignments.*—There are no provisions as to assignments, but it may be assumed that these may be prepared in the usual form in the English language.

Assignments.

**MARTINIQUE.**Mar-  
tinique.

(COVERED BY FRENCH PATENT.)

## Mauritius.

## MAURITIUS.

(ORDINANCE No. 16 of 1875.)

*Patentee.* *Patentee.* Patents are granted to the actual inventor, whether native or alien, and to the representative or assigns of the actual inventor. A mere importer cannot obtain a valid patent.

*Duration of Patent.* *Duration of Patent.* Patents are granted for a term of fifteen years, but this term is limited by the duration of any prior patent, whether British or foreign. Extension of the term may be obtained if the Governor in Council thinks that such extension is called for.

*Novelty Effect of Prior Patent or Publication.* *Novelty: Effect of Prior Patent or Publication.*—An inventor who has obtained a British patent may take out a patent in Mauritius within one year from the date of the British patent, although the invention is publicly known and used in Mauritius at the date of application there. But such publication in Mauritius must not have taken place prior to the date of the British patent. There is no examination.

*Taxes.* *Taxes.*—None after issue of patent.

*Working.* *Working.*—There are no requirements as to working, and no provisions as to importation and marking.

*Assignments.* *Assignments* may be in any usual form, and must be registered and transcribed at the Mortgage Office.

*Government Fees.* *Government Fees.*—£10 on issue of the Procureur Général's certificate of protection, and £2 on the sealing of the patent.

## Mexico.

## MEXICO. †

(LAW OF 7TH JUNE, 1890; DECREE OF 27TH MAY, 1896.)

*Patentee.* *Patentee.*—Patents are granted to inventors, or to the improvers of any manufacture or branch of industry, or to their lawful representatives.

*Duration of Patent.* Patents are granted for twenty years, but where prior foreign patents exist the Mexican patent expires with the first or mother patent of the series. Extensions for five years are sometimes granted if the executive thinks fit. Existing ten years' patents, under the old Act, may be extended to the new term of twenty years. Mexico.  
Duration  
of Patent.

*Novelty: Effect of Prior Patent or Publication.* The application must be made before the invention has been publicly worked in Mexico or elsewhere. Publication of the specifications of prior patents by Foreign Patent Offices, or publicity given by International or other Exhibitions, is not considered to constitute publication. Apart from this requirement as to novelty, the existence of prior foreign patents is no bar to the granting of a valid Mexican patent. Patents are granted without examination. Novelty  
Effect of  
Prior  
Patents  
Publication.

*Working.*—By Decree of 27th May, 1896, the law has been so far amended that it is no longer necessary to prove the working of patented inventions in Mexico. Working.

*Taxes.*—By the same Decree the following taxes were imposed: viz., before the expiry of the fifth year 50 pesos; before the expiry of the tenth year 75 pesos; before the expiry of the fifteenth year 100 pesos. Taxes.

*Importation.*—Importation of the patented goods is allowed. In the interest of applicants no importation of the goods should be effected until after the grant of the patent. Importation.

*Assignments.*—A Mexican patent may be assigned at any time and place and in any language, although preferably in Spanish. The documents should be executed before a notary, legalised by a Mexican consul, and must be registered in the Mexican Patent Office. Assignments.

## MOROCCO.

Morocco.

(MOROCCO HAS NO PATENT LAW.)

Natal.

**NATAL.**

(Now including Zululand.)

(LAWS No. 4 OF 1870, No. 5 OF 1871, AND No. 32 OF 1884.)

Patentee.

*Patentee.*—Patents are granted to the true and first inventor. The Act provides that the word “inventor” shall bear the same interpretation which is put upon it in British practice. Therefore it is submitted that the true and first inventor includes the true and first importer to the colony.

Duration of Patent.

*Duration of Patent.*—Patents are granted for fourteen years from the date of application. If prior foreign patents exist, the patent in Natal will expire with that foreign patent which first expires. Extensions of patents may, in some cases, be obtained.

Novelty: Effect of Prior Patent or Publication.

*Novelty: Effect of Prior Patent or Publication.*—The sole essential is that the invention should not be publicly known or publicly used in Natal at the date of application. Prior patenting, or publication, or use elsewhere, will have no prejudicial effect upon the validity of the Natal patent. There is no preliminary examination.

Taxes.

*Taxes.*—Before the expiry of the third year of the patent a tax of £5 is due, and before the expiry of the seventh year a tax of £10.

Working.

*Working.*—There is no obligation to work the patent in the colony, and no provision as to importation or marking.

Assignments.

*Assignments.*—These may be prepared in any usual form, in duplicate, and must be entered in the Register of Proprietors.

Newfoundland.

**NEWFOUNDLAND.**

(CONSOLIDATED STATUTES, TITLE XV., CAP. 54, SEC. 1.)

Patentee.

*Patentee.*—The true inventor or the representative or assignee of the inventor.

*Duration of Patent.*—Patents run for fourteen years, but are limited by the term of any prior foreign patent.

Newfound-  
land.

Duration of  
Patent.

*Novelty: Effect of Prior Patent or Publication.*—A patent may be obtained in Newfoundland for an invention already patented and published abroad, but it must not be publicly known or used in the island. There is no examination as to novelty.

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

*Taxes.*—There are no taxes payable after issue.

Taxes.

*Working.*—The invention should be brought into operation in Newfoundland within two years from date of patent. It is understood that importation and sale of the patented goods will constitute a valid working. There is no obligation to mark the goods.

Working.

*Models and Specimens.*—When the invention relates to a machine, the patent authorities are empowered to demand a model; and in compositions of matter (except explosives) specimens of the ingredients and of the composition may be required. In practice neither models nor specimens are often asked for.

Models and  
Specimens.

## NEW SOUTH WALES.

New South  
Wales.

(ACT 24 OF 6TH DECEMBER, 1852; ACT 3 OF 8TH JULY, 1887;  
AMENDING ACT, 1895; REGULATIONS OF 1898.)

*Patentee.*—The inventor, or his assignee, or nominee, or agent, or the first importer, or a firm or corporation.

Patentee.

*Duration of Patent.*—Patents are granted for fourteen years from the date of the filing of the application.

Duration of  
Patent.

*Novelty: Effect of Prior Patent or Publication.*—The invention should not at the time of application have been published, made, sold, or used in New South Wales. Publication abroad, or the issue of prior foreign patents, will not prevent the obtaining of a valid patent in New South Wales. A preliminary examination is not usual, but it is provided in the Act that it may be ordered.

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

**New South  
Wales.**

*Taxes.*—There are no taxes after the issue of the patent.

**Taxes.  
Working.**

*Working.*—There are no requirements as to working, importation, or marking.

**Assign-  
ments and  
Licences.**

*Assignments and Licences.*—These must be registered in the office of the Examiner of Patents; otherwise they are null and void. The periods within which registration must be effected are as follows:—When executed within the colony, fourteen days; within any of the other Australian colonies, thirty days; other places, ninety days. The documents are prepared in the English language, in any suitable form, and must be in duplicate.

**New  
Zealand.****NEW ZEALAND.\***

(ACT No. 12 OF 1889; AMENDING ACT OF 1897.)

**Patentee.**

*Patentee.*—Patents are granted to the true inventor, or his nominee or assignee, or to the authorised first importer. A company or corporation may be the assignees, but cannot be the grantees of Letters Patent.

**Duration  
of Patent.**

*Duration of Patent.*—Patents are granted for fourteen years from the date of the acceptance of the specification. The Act makes provision for the extension of a patent for seven, and in exceptional cases for fourteen, years.

**Novelty:  
Effect of  
Prior  
Patent or  
Publication.**

*Novelty: Effect of Prior Patent or Publication.*—To obtain a valid patent the invention must not have been published or made publicly known or openly used in New Zealand before the date of application. Subject to this condition, the existence and publication of British or foreign patents will not militate against the validity of the New Zealand patent. The application is not subject to any examination as to novelty or utility.

**Taxes.**

*Taxes.*—A tax of £5 is payable before the expiration of the fourth year of patent right, and a further sum of £10 is payable before the expiry of the seventh year. An extension of time of three months for the payment of these taxes may be had on payment of a fine of £4.



*Working.*—There are now, since 1st January, 1890, no requirements as to working, and none as to importation and marking.

New  
Zealand.  
Working.

*Assignments.*—These may be drawn in the same form as British assignments. The documents are prepared in duplicate, and should be accompanied by a request for entry in the Register of Patents, signed by the assignee.

Assign-  
ments.

## NICARAGUA.

Nicaragua.

There is no Patent Law in Nicaragua, but inventions are protected by special legislative grant if they promise to be of practical utility to the country. The cost of such grant averages from £50 to £60. The terms usually granted are ten years for a Patent of Invention; seven years for a Patent of Improvement; and five years for a Patent of Importation.

## NORWAY.

Norway.

(LAW OF 16TH JUNE, 1885.)

*Patentee.*—Patents are granted to the actual inventor only, or to some one directly deriving his rights from the inventor. Patents of Addition are granted up to within two years from the date of the original grant, and then only to the original patentee.

Patentee.

*Duration of Patent.*—Patents are granted for fifteen years. Such Patents of Addition as may be granted expire with the original patent.

Duration  
of Patent.

*Novelty: Effect of Prior Patent or Publication.*—A valid patent cannot be obtained for an invention sufficiently well known in Norway, to be put in practice by other persons. But publication in print, or the exhibition of the invention in Norway, will not prevent the grant of a valid patent, if the application is made within six months of such publication or exhibition. But notice of such

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

**Norway.** publication or exhibition should be given to the Patent Office. The existence of a foreign patent will be no bar to the grant of a Norwegian patent. There is no preliminary examination as to novelty.

**Taxes.** *Taxes.*—Annual taxes are payable of 10 kroner for the second year, 15 kroner for the third, and so on, increasing 5 kroner per annum. Three months' grace may be obtained to make these payments, but under a fine of one fifth of the tax sought to be paid.

**Working.** *Working.*—Inventions are required to be worked in Norway within three years from date of patent, and must not at any time thereafter be discontinued for an entire year. No proof of working is required by the authorities, but it is advisable to obtain a certificate of working on each occasion. In practice importation and exposure for sale are considered to meet requirements. The writer has been informed by a Norwegian correspondent that mere advertisement of the patented articles in a Norwegian journal is generally considered to satisfy requirements, but this suggestion must be taken with great caution. There is no foundation for it in the Act.

**Assignments.** *Assignments* may be prepared in accordance with the law of the country where the contracting parties are domiciled. They should be legalised by a Norwegian consul, and must be registered at the Patent Office in Norway.

Orange  
River  
Colony.

## ORANGE RIVER COLONY

(Late Orange Free State).

(ORDINANCE No. 10 of 1888.)

As the result of military operations in South Africa the late Orange Free State has become annexed to the British Empire under the title of the Orange River Colony. The British Comptroller of Patents, in a notice under date the 10th November, 1900, announced in the *Patent Journal* that he had been informed by the legal adviser to the military authorities in the colony that for the present no

change of any sort has been made in the existing Patent Law, with the exception that applications may be filed either in English or in Dutch.

Orange  
River  
Colony.

*Patents.* Patents are granted to the actual inventors, whether citizens or foreigners, or to their authorised representatives or assignees. With the inventor there may be associated another or other applicants who are not inventors, or a firm or corporation may be associated with the inventor. In all cases, however, the inventor must join in the application, and must be indicated as such in the application form. Depending upon the liberal interpretation of the word "inventor," patents have in many cases been granted to first importers, but in the absence of any judicial decision on this point it is impossible to say whether such grants would be valid or not, although Article 43 does not read very favourably to the supposititious rights of a mere importer.

Patentee.

*Duration of Patents.*—Patents are granted for fourteen years, but this term is limited by the duration of any prior foreign patent having the shortest term.

Duration  
of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The grant of prior foreign patents, or the publication of the invention in other countries, will not prevent the obtaining of a valid patent in the Orange River Colony, provided the invention is still new and unpublished in the colony at the time of application. By Article 45 of the Ordinance the exhibition or publication or use of the invention in or in connection with an international or industrial exhibition in the colony will not constitute publication in the eye of the law, granted that before such exhibition or publication the inventor has given written notice of his intention to exhibit, and makes application for a patent within six months after the opening of the exhibition. There is no examination as to utility or novelty.

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

*Taxes.*—On or before the expiration of the third year of the patent a renewal tax of £5 is due to be paid, and a similar tax of £10 on or before the expiry of the seventh year. The Letters Patent must be produced to have the

Taxes.

**Orange  
River  
Colony.**

payment of each tax endorsed thereon. An enlargement of the time for making this payment may be had for three months, subject to a fine of £5 in addition to the tax.

**Working.**

*Working.*—No requirements. There are also no provisions as to importation or marking.

**Assign-  
ment and  
Licences.**

*Assignments and Licences.*—Assignments should be in duplicate, signed by the assignor and legalised in the case of non-residents by a notary public. For the purposes of registration the assignment should be accompanied by a power of attorney, signed by the *assignor*, and, if executed by a non-resident, legalised by a notary public, empowering the attorney to record the assignment and pay the fees. Licences may be granted and recorded in a similar manner, and by Article 21, on the petition of any party who has been refused a licence and who is able to show that (a) the patent is not being used in the colony, or that (b) the reasonable requirements of the public are not being served, or that (c) a person is being prevented from using another invention to the best advantage, then the authorities may compel the patentee to grant licences on reasonable terms.

**Govern-  
ment Fees.**

*Government Fees.*—On depositing application, £1 1s. On certificate of allowance, £1 1s. On sealing Letters Patent a sealing fee is fixed which shall not be less than £10 nor more than £50. In practice this sealing fee was almost invariably fixed at £25. The Schedule says that the amount is fixed "according to the importance of the grant." The writer is given to understand that under British administration a moderate fixed fee is likely to be the rule.

**Paraguay.****PARAGUAY.+**

Paraguay has no Patent Law, but inventions may be protected by special Act, the cost of which is usually about from £80 to £100. The documents are in form similar to those employed for Chili.

The Government of Paraguay is credited with being extremely desirous to encourage the introduction of useful

industries into the country. Where the inventor establishes a manufactory in Paraguay concessions in the shape of remission of taxation, land sites, free importation of machinery, &c., are readily made, and in some instances the Government will even advance capital for the installation of plant and for working expenses.

Paraguay.

## PERU.

Peru.

(LAW OF 28TH JANUARY, 1869; DECREE OF 29TH NOVEMBER, 1894; AMENDING ACT OF 3RD JANUARY, 1896.)

*Patentee.*—The true and first inventor or first importer. Patents may be issued to corporations and firms and to aliens as well as natives.

Patentee.

*Duration of Patents.*—The extreme duration is ten years. It is said by the Act of 1896 that the applicant may himself fix the term of grant at from one to ten years. But by a recent opinion of the President of Peru this freedom accorded to the applicant is considered unconstitutional, and in future the Government will fix the term, which will in most cases be ten years, unless there are peculiar circumstances which justify a reduction of that term.

Duration of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been published or publicly used in Peru. Publication abroad, or the existence of a prior foreign patent, will not bar the grant of a patent in Peru.

Novelty: Effect of Prior Patent or Publication.

*Taxes.*—The applicant must pay for the stamps upon the specification, each sheet of the specification and drawings requiring a separate stamp. He must also pay certain expert fees amounting usually to 150 soles, and in addition there is a final fee due on issue of the grant amounting to 50 soles. After the issue of the patent no further taxes or annuities are payable.

Taxes.

*Working.*—The invention must be commercially worked in Peru within two years of grant or within such time

Working.

**Peru.**

for working as may be expressed in the patent. Before the Act of 1896 it was the custom to exact a bond or deposit of £2000 soles to ensure that working should be carried out, but such deposit is no longer required. Importation of the patented goods is not permitted, but in difficult cases it is suggested that to meet the working requirements the parts of the patented machine or article might be imported separately as general machinery and fitted together in Peru. Registration of the working is not necessary, but the working must be proved if the validity of the patent should be afterwards challenged.

**Assignments.**

*Assignments.* These should be prepared in duplicate in Spanish, and in the case of assignments by British or United States patentees should be executed before a notary public and legalised by a Peruvian consul. The assignment should be registered in Peru, and to enable the agent in Peru to effect the registration the assignor must sign a power of attorney addressed to the Peruvian agent before a notary public and legalised by the consul as aforesaid.

**Philippine Islands.****PHILIPPINE ISLANDS.**

Until 28th July, 1898, the Spanish patent could be extended for a small extra fee to the Spanish Colonies. But by a Ministerial Decree, dated as above, the extension of Spanish patents to the Colonies is suspended, so that until some stable Government is established in the Philippines there are no means of protecting inventions in those islands.

**Porto Rico.****PORTO RICO.**

This island has been annexed to the United States, and will in future be subject to the provisions of the Patent Laws of these States.

## PORTUGAL.\*

Portugal.

(LAW OF 21st MAY, 1896.)

*Patente.*—The actual inventor or first importer, the latter covering a firm or corporation. Patentee.

*Duration of Patent.*—Patents of Invention are granted to the actual inventor for any term less than or up to fifteen years, and Patents of Invention to the first importer for a maximum period of ten years. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.*—In the case of Patents of Invention granted to the first inventor the invention must be new in Portugal, but the publication in Portugal of a specification or description arising out of the grant of a patent in another country will not bar the grant of a Portuguese patent if there is a special Convention between Portugal and that other country, or if the application has been made before the expiry of the delay fixed for the right of priority in the International Convention, of which Portugal is an adherent. In the case of applications for Patents of Importation it is only necessary that the invention shall not have been publicly worked in Portugal prior to the application. Novelty: Effect of Prior Patent or Publication.

*Taxes.*—A tax of 3 milreis is payable in advance for each year for which a Patent of Invention may have been demanded. For Patents of Addition a tax of 3 milreis is payable on application. For Patents of Importation a tax of 20 milreis (about £4) is payable on application. At the same time, the applicant must deposit at the General Bank a sum of 500 milreis, which will be returned to him if the patent is refused. When the patent is granted the applicant must make a deposit of from 5000 to 50,000 milreis, and if this final deposit is not made the 500 milreis already deposited become forfeited. This final deposit may, on the patentee establishing a manufactory, be replaced by a mortgage on land, building site, or machinery used in manufacturing the invention. Taxes.

*Working.*—A Patent of Invention must be worked within two years from date, and must not be discontinued during Working.

**Portugal.** any two following years. For Patents of Importation working must be begun within a year from grant, and must not cease during any one following year. The Government may fix the minimum limit of production. Importation of the patented goods must not take place.

**Assignments.** *Assignments.*—These are effected by notarial deed drawn up in Portugal and endorsed on the Letters Patent by the Patent Office. The transfer must be registered in the Department of Industry. Patents of Importation can only be assigned with the consent of the Government.

**Portuguese Colonies.**

**PORTUGUESE COLONIES.**

By a Decree of 28th July, 1898, the extension to or granting of patents in Portuguese Colonies has been discontinued.

**Queensland.**

**QUEENSLAND.\***

(ACT No. 13 OF 13TH OCTOBER, 1884; ACT No. 5 OF 4TH SEPTEMBER, 1886; AMENDMENT ACT OF 1890; RULES OF 1896-7-8.)

**Patentee.**

*Patentee.*—The "Patentee" is defined as the person for the time being entitled to the benefit of a patent. Accordingly, in practice patents are granted to the inventor alone or in conjunction with a capitalist, or to the inventor's assignee, or to the legal representative of a deceased inventor, provided the application is made within six months from the death of the inventor.

**Duration of Patent.**

*Duration of Patent.*—Patents are granted for fourteen years. Preliminary provisional protection for twelve months (limited to nine months for the time for filing the Complete) may be had in Queensland as in Great Britain.

**Novelty: Effect of Prior Patent or Publication.**

*Novelty: Effect of Prior Patent or Publication.*—The invention should not, prior to the date of application, have been published or openly used in Queensland. With this proviso the patenting or publication of the invention in



another country will not bar the grant of a patent in Queensland. There is a preliminary examination. Publication of an unpatented invention in an industrial exhibition held in the colony will have no harmful effect, provided that notice is given to the Registrar of the intention to exhibit, and application for a patent is made within six months from the opening of the exhibition. Queens-  
land.

*Taxes.* A tax of £5 is due before the expiry of the fourth year of the patent, and £10 before the expiry of the eighth year. In lieu of these amounts the taxes may be paid annually as follows: £1 before the expiry of the fourth and fifth years; £1 10s. before the expiry of the sixth, seventh, eighth, ninth, tenth, and eleventh years; and £2 before the expiry of the twelfth and thirteenth years. Taxes

*Working.*—There is no obligation to work the patent. Working.

*Assignments.*—These may be prepared in any usual form, and should be registered in the Patent Office. The Registrar will not record the assignment until the Letters Patent are produced, so that he may endorse the assignment on the back thereof. Assign-  
ments.

## RUSSIA.

Russia.

(LAW OF 20TH MAY (1ST JUNE), 1896.)

*Patentes.*—Patents are granted indiscriminately to Russian subjects and to foreigners; to the true inventor or his legal assignee. Firms and corporations may also obtain patents. If different applications for the same invention are received on the same day the applicants must take a patent in their joint names, and if this suggestion is refused no patent will issue to either until the parties have decided their respective rights at law. Patents of Importation are not now granted. Patentes.

*Duration of Patents.*—Patents are granted for fifteen years, but are limited by the duration of any prior foreign patent for the same invention. Where there are several Duration  
of Patents.

**Russia.**

prior foreign patents of different terms the Russian patent expires with the prior patent of the shortest term. But the premature lapsing of a prior foreign patent by non-payment of fees or the like does not cause premature failing of the Russian patent. This was decided by a Departmental decision of 18th August, 1898 (No. 22166). Patents of Addition may be obtained expiring with the original patent.

**Novelty:**  
**Effect of**  
**Prior**  
**Patent or**  
**Publication.**

*Novelty: Effect of Prior Patent or Publication.* The invention must be new in Russia: *i.e.* not publicly used or published in books or journals with sufficient exactness to instruct persons skilled in the art how to carry the invention into effect. But a distinction appears in practice to be drawn between books and journals and patent specifications and official gazettes, for these are not held to be such publication as will bar a Russian patent. Valid patents may be obtained in Russia after the issue of patents for the same invention in other countries, provided the application for the Russian patent is made by the true inventor or his legal representative.

**Subject-**  
**Matter of**  
**Patents.**

*Subject-Matter of Patents.*—No patents can be obtained for mere abstract discoveries or principles nor for anything contrary to public morals. Chemical products, foods, beverages, and medicines are not patentable; neither are processes nor apparatus for the preparation of medicines. But processes and apparatus for the manufacture of chemical products, foods, and beverages are patentable. War material is not patentable, but weapons capable of being used by private persons as well as by the services are patentable.

**Examina-**  
**tion.**

*Examination.*—Applications for patents are submitted to a Technical Committee, presided over by the Directors of Commerce and Manufactures, or by one of the Sub-Directors. The examination concerns the novelty and subject-matter of the invention. On receiving his certificate of filing, the applicant may publish and work his invention openly in Russia without jeopardising his rights, but he cannot sue infringers until his patent is granted. He may, however, under Article 8 warn infringers that he will

proceed against them in respect of all torts committed between the date of filing and the grant, and in such circumstances his claims might be retrospective. Russia.

*Taxes.*—A tax of 30 roubles is payable on application, and a further 15 roubles in respect of the first year's tax is payable within three months of the allowance of the patent. Afterwards the following yearly taxes are payable: viz., 20 roubles for the second year; 25 for the third; 30 for the fourth; 40 for the fifth; 50 for the sixth; 75 for the seventh; 100 for the eighth; 125 for the ninth; 150 for the tenth; 200 for the eleventh; 250 for the twelfth; 300 for the thirteenth; 350 for the fourteenth; and 400 for the fifteenth year. Taxes.

*Working.* The patent must be worked before the expiry of five years from the date of signature of the patent. Nominal working is not accepted in Russia. The certificate of working, which must be obtained from a Russian official, will not be granted on mere perfunctory working, and if no such certificate is obtained and lodged at the Ministry the patent becomes void. Working.

*Assignments.*—Transfer of a patent must be notified to the Director of Commerce and Manufactures. This notification must be accompanied by the documents establishing the transfer. The assignment is then published in the *Messager Officiel* and in the *Journal du Ministère des Finances* at the cost of the assignee. A stamp duty of one fifth of one per cent. of the consideration is levied on each assignment. Assignments.

## ST. HELENA.

St. Helena.

(ORDINANCE No. 3 of 1872.)

*Patentee.*—The grantee of a British patent, his executors, administrators, and assigns, may obtain letters of registration in St. Helena at any time during the existence of the British patent. Patentee.

<b>St. Helena.</b>	
Duration of Patent.	<i>Duration of Patent.</i> The patent expires with the British patent, or with any extension thereof that may be granted.
Novelty: Effect of Prior Patent or Publication.	<i>Novelty: Effect of Prior Patent or Publication.</i> So long as a British patent has been obtained, a patent in St. Helena is granted as a matter of course, and without regard to publication or public use.
Taxes.	<i>Taxes.</i> —None.
Working.	<i>Working.</i> —No requirements.
Assignments.	<i>Assignments</i> are made in the usual form.
Government Fees.	<i>Government Fees.</i> One guinea is payable to the Registrar on filing the specification.

**St. Lucia,  
St. Vincent,  
Samoa,  
San  
Domingo,  
and San  
Salvador.**

### **ST. LUCIA, ST. VINCENT, SAMOA, SAN DOMINGO, and SAN SALVADOR.**

These countries have no Patent Law, but in all of them protection for an invention can be obtained by special legislative Act, the expense varying from £25 to £200.

**Servia.**

### **SERVIA.\***

Although Servia is a member of the International Union, it has no Patent Law. It is expected, however, that a law will be passed shortly, as the Legislature is at present engaged on the preparation of a Bill.

**Siam.**

### **SIAM.**

There is no available mode of protecting inventions in Siam, but special legislative Acts may be furthered to protect inventions.

**Sierra Leone.**

### **SIERRA LEONE.**

Sierra Leone has no Patent Law, but inventions may be protected under special grant.

**SOUTH AFRICAN REPUBLIC (Late).**  
(See Transvaal.)

South  
African  
Republic  
(See Trans-  
vaal.)

**SOUTH AUSTRALIA.**

South  
Australia.

(Act No. 78 of 21st December, 1877; Act No. 201 of 1881; PATENTS AMENDMENT ACT, 1887.)

*Patentee.*—The true and first inventor or his personal representative or assignee. A corporation may obtain Letters Patent as assignees of the inventor or as the first importers or introducers. There is no decision as to whether "true and first inventor" includes the true and first importer, but in accordance with British practice many patents are taken out by first importers.

Patentee.

*Duration of Patent.*—Patents are granted for fourteen years, limited to expire with the original or mother patent in those cases where prior patents for the same invention exist in other countries. Provisional protection for twelve months may be obtained.

Duration of  
Patent.

*Novelty; Prior Patent or Publication.*—To ensure a valid patent the invention should not at the time of application be known or publicly used in South Australia. Inventions already patented abroad or in the mother country, but not publicly known in the colony, may be validly patented there, but no patent will be granted in respect of a foreign lapsed patent.

Novelty  
Prior Patent  
or Publication.

*Taxes.*—Before the end of the third year a tax of £2 10s. falls due, and before the end of the seventh year a further tax of £2 10s. No prolongation for making these payments is obtainable. The patent should be sent with the tax to have the payment endorsed.

Taxes.

*Working.*—Under Clause 43 of the principal Act patents are liable, upon the application of an interested party, to be revoked by the Governor, if the invention has not been worked before the expiry of three years from date. In practice the working of South Australian patents is generally disregarded, and so far no case exists in which

Working.

South  
Australia.

the power of revocation has been exercised upon this ground. Nevertheless, in the case of valuable inventions it would be wiser for the inventor to comply with the clause.

Assign-  
ments.

*Assignments.*—These may be in any convenient form, and must be filed in duplicate. Stamp duty is payable on the amount of the consideration money at the rate of 5s. per £100. Assignments must be endorsed as “certified as correct for the purposes of the Patent Acts of 1877 to 1887.” This may be signed by one of the parties or by the local attorney or agent acting for the parties. A nominal consideration is professedly not allowed. The actual consideration should be stated, but a nominal consideration of £10 is not questioned. The assignment is registered in the Register of Proprietors.

Spain.

## SPAIN.\*

(LAW OF 30TH JULY, 1878.)

Patentee.

*Patentee.*—Patents are granted to any individual, firm, or corporation making application, whether originators of the invention or not.

Duration  
and Descrip-  
tion of  
Patent.

*Duration and Description of Patent.*—Patents are of two kinds: *i.e.* Patents of Invention and Patents of Importation. Original applicants in Spain can obtain a patent for twenty years. If the invention has been already patented abroad, the patent in Spain is granted for ten years, but application must be made in Spain within two years from the date of the first foreign patent. If the applicant is merely an importer, the patent term is for five years only. Patents of Addition are granted, which expire with the original patent.

Novelty:  
Prior Patent  
or Publica-  
tion.

*Novelty: Prior Patent or Publication.*—The Spanish application should be made before the invention has come into public use in the Spanish dominions. The existence, publication, or working of patents for the same invention in other countries is no hindrance to the obtaining of a

perfectly valid patent in Spain, so long as it is new there. **Spain.**  
The Spanish patent is, however, limited by the duration of the prior foreign mother patent.

*Taxes.*—Patents are subject to the payment of annual **Taxes.**  
taxes amounting to 10 pesetas for the first year, 20 pesetas for the second, 30 pesetas for the third, and so on, increasing at the rate of 10 pesetas per annum. The peseta is equivalent to 10d. of English money. At the present date (1901-2), as a war measure, all taxes have been increased forty per cent.

*Working.*—The invention must be worked in Spain **Working.**  
within two years from the issue of the patent, and must not be discontinued for a year and a day thereafter. The owners of patents are required to prove the first working before the Director of the Conservatory of Arts; subsequent workings need not be so proved. A merely perfunctory pretence of working, such as might serve in certain other countries, will not suffice in Spain. The patented articles should be actually made in Spain. Mere importation and working will not do. The goods may be imported for sale into Spain in any quantity.

*Assignments.*—All assignments made out of Spain must **Assignments.**  
be executed before a notary public, whose signature must be legalised by a Spanish consul. Assignments are registered in the Spanish Patent Office. All mention of consideration should be avoided. The Spanish consul is obliged to charge a heavy percentage on the consideration as stamp duty when legalising the documents. The assignment is good and valid though no consideration is expressed.

## SPANISH COLONIES.

**Spanish  
Colonies.**

By a Ministerial Order of the 28th July, 1898, the extension of Spanish patents to the colonies has been discontinued.

Straits  
Settle-  
ments.

## STRAITS SETTLEMENTS.

(ORDINANCE No. 12 OF 1871.)

Patentee.

*Patentee.*—Patents are granted to the actual inventor or his assignee, to the first importer, or to the patentee or proprietor of a British patent or invention patented in any British possession.

Duration of  
Patent.

*Duration of Patent.*—Fourteen years is the term for which patents are granted, but this term is limited by the duration of any prior patent in another country.

Novelty:  
Prior Patent  
or Publica-  
tion.

*Novelty: Prior Patent or Publication.*—The invention is deemed to be new and patentable if not “publicly used” in the United Kingdom or in any British possession prior to the date of application in the colony. The use of the term “public use” would seem to point to the conclusion that publication of the specification in Great Britain, or publication in a newspaper or book, would not vitiate the claim of the patentee to a patent in the Straits Settlements, provided no public use had taken place. There is no examination as to novelty or utility.

Taxes.

*Taxes.*—None after issue of patent.

Working.

*Working.*—None required.

Assign-  
ments.

*Assignments.*—Assignments must be prepared in duplicate and registered in the Register of Proprietors.

Sweden.

## SWEDEN.

(LAW OF 16TH MAY, 1884, AMENDED BY LAW OF 26TH MAY, 1897, OPERATING FROM 1ST JANUARY, 1898.)

Patentee.

*Patentee.*—An applicant for a patent must be the actual inventor or his assignee. Corporations can only obtain patents as assignees of the inventor.

Duration of  
Patent.

*Duration of Patent.* Patents are granted for fifteen years. Patents of Addition may be had expiring with the original patent.

Novelty:

*Novelty: Effect of Prior Patent or Publication.*—No patent can be granted for an invention which has been



publicly used or published in Sweden. The fact that an invention has been shown at an International Exhibition will not bar a valid patent if application is made within six months from first exhibition. In the case of countries giving a similar concession to Sweden (*i.e.* members of the International Convention), an application in Sweden made within twelve months of the original application elsewhere will be dated as of the same date as the original application. But even if such application has not been made under the Convention, the mere existence of a prior foreign patent will not bar the grant of a Swedish patent if the invention has not been made known in Sweden. Applications are subject to a preliminary examination as to novelty.

**Sweden.**  
Effect of  
Prior Patent  
or Publica-  
tion.

*Taxes.*—An annual tax of 25 crowns is payable on the first, second, third, fourth, and fifth years; 50 crowns on the sixth, seventh, eighth, ninth, and tenth years; and 75 crowns for each of the five following years. Three months' extension of time within which to pay these taxes may be had, subject to a fine amounting to one fifth of the amount of the tax due.

**Taxes.**

*Working.*—The invention should be worked within three years from date of patent, and thereafter the working must not be discontinued for a year. The rules regulating the working are stringent. The time may sometimes be extended to four years in different cases. Importation of the patented goods is allowed, but this does not release the patentee from the obligation of working the invention in Sweden.

**Working.**

*Assignments.*—These should be executed in duplicate and legalised by a Swedish consul. The registration is effected on the request of the assignee.

**Assign-  
ments.**

**SWITZERLAND.\***

**Switzer-  
land.**

(LAW OF 15TH NOVEMBER, 1888.)

*Patents.* Patents are granted to the inventor or to his legal successors or assigns only.

**Patentee.**

**Switzer-  
land.**

Duration,  
and descrip-  
tion of  
Patent.

*Duration and Description of Patent.*—The Swiss Patent Office makes it a rule that it will grant no patents for inventions which do not in themselves represent a visible and tangible marketable article. It follows from this short-sighted policy that patents cannot be obtained for mere new processes or methods of manufacture, although new products of new processes may be protected. To give time for the production of a specimen, or proof of the actual existence of the newly-invented thing or machine, the custom is to make provisional application for a patent in the first instance, which application must contain a full description and illustration of the invention, but need not be accompanied by specimens or proofs of actual existence. This provisional patent lasts for three years. During this term, or at the end of the three years, a definitive patent is granted upon the payment of the tax and on the production of the specimen of the invention, or, in the case of large objects, of photographs of the invention. The specimen might either be the actual thing itself, or it might assume the form of a scale model of the invention. In the case of large apparatus or articles not easy of transport, and where a model would be difficult or expensive to make, photographs of the invention will suffice. These photographs must show, as far as practicable, the parts which are claimed. For example, if the invention is a boiler, or a gas-making apparatus, containing arrangements of tubes, partitions, and parts which are essential to the invention, a mere outside view of the boiler or the apparatus will not do. The claimed arrangements of the tubes or parts should be apparent in the photograph, or it will not be accepted as a proof of existence. Models must be deposited of all inventions relating to the cases or movements of watches, all inventions relating to portable firearms, and for all patented articles composed of combinations of substances which it is difficult to determine. Swiss patents are granted for fifteen years from the date of application. All applications must be completed within six months of date.

Novelty  
Effect of

*Novelty: Effect of Prior Patent or Publication.*—The invention must be new and unpublished in Switzerland at

the time of application. Proof of the published British specification having been at the disposal of the public in Switzerland would probably act as a bar to novelty. Switzerland is, however, a member of the International Convention, so that even after publication of a British specification the Swiss application would be valid if made within six months, or, according to the recent amendment on the Convention, within twelve months, from the date of the application in England. An examination as to novelty and utility is held upon all applications for patents.

Switzer-  
land.Prior Patent  
or Publica-  
tion.

*Taxes.* Patents are subject to the payment of annual taxes of 20 francs for the first year, 30 francs for the second, 40 francs for the third, and so on, increasing at the rate of 10 francs per annum as in Belgium.

Taxes.

*Working.*—The invention must be worked within three years from the date of application. The amount of working which will satisfy requirements has not been fixed by any judicial decision, but it would be unsafe to count upon anything less than a real and commercial carrying into effect of the invention. It must, however, be said that it is now generally held that it is not necessary to actually manufacture the invention in Switzerland so long as the patent is worked in a foreign country, proof of this foreign working being produced and registered in the Swiss Patent Office. But the foundation of this assumption has by no means been made plain to the writer. Importation of the patented goods is not prohibited, but if importation alone is carried on the patentee cannot refuse licences on reasonable terms to Swiss manufacturers; otherwise his patent is forfeited. All articles protected by a Swiss patent and sold in Switzerland must be marked with the Federal Cross and the number of the patent.

Working.

*Assignments and Licences.* If a patent is sold wholly or partly, or if a licence is granted after the filing of the application or after the grant of the patent, such assignment or licence must be registered at the Federal Office of Industrial Property.

Assign-  
ments and  
Licences.

**Tasmania.****TASMANIA.\***

(Act No. 6 of 1893; AMENDED REGULATIONS OF 1896.)

**Patentee.**

*Patentee.* The true and first inventor, which is assumed to include the first importer. Patents are granted to the inventor in conjunction with others who are not inventors. The legal representatives of a deceased inventor may obtain a patent if application is made within six months of the inventor's decease. A corporation may also obtain a patent as assignees of the inventor.

**Duration of Patent.**

*Duration of Patent.* - Patents are granted for fourteen years from the date of acceptance of the application. Provisional protection may be had as in Great Britain.

**Novelty Effect of Prior Patent or Publication.**

*Novelty: Effect of Prior Patent or Publication.*—The invention must not at the time of application have been “publicly manufactured, used, or sold within Tasmania.” Therefore prior publication or use of an invention abroad, and apparently even prior publication alone in Tasmania, will not prevent the grant of a valid patent. Subject to notice given to the Registrar, exhibition of an invention at an “Industrial Exhibition” within or beyond the colony will not amount to public use, if the application for a patent be made within six months from the opening of the Exhibition. The colony has a special arrangement with Great Britain whereby an application made within twelve months of the application in Great Britain has priority over other applicants. The same priority is accorded to citizens of the United States.

**Taxes.**

*Taxes.* At or before the expiration of the third year from date a tax of £15 falls due, and a tax of £20 at or before the expiration of the seventh year. Three months' extension of time for paying these taxes may be had, subject to payment of £1 on the application form and £3 on the grant of extension.

**Working.**

*Working.* No requirements.

**Assignments.**

*Assignments.* Assignments and licences may be granted for the whole or a part of the colony. These should be entered on the Register.

**TOBAGO.**

Tobago.

(COVERED BY PATENT IN TRINIDAD.)

**TONQUIN.**

Tonquin.

(COVERED BY FRENCH PATENT.)

**TRANSVAAL**

Transvaal.

**(Late South African Republic).**

This colony, formerly known as the South African Republic, is now a part of the British Empire. Until the present military occupation has given place to civil administration patents will be granted under the laws of the late Republic. A question put to the Secretary of State for the Colonies by Sir John Brunner in the British House of Commons on 26th February, 1901, as to the extension of the British Patent Law to the Transvaal and Orange River Colony met with the reply that at present "no alteration has been made in the Patent Laws of the late Republics." An important change in practice, as it affects British and American inventors, is that applications may now be filed either in English or in Dutch (see Government Notice No. 123 of 1900, page 1484 of *The British Illustrated Official Journal (Patents)*, No. 612, 19th December, 1900). Answers to enquiries personally made by the writer also point to the conclusion that the unreasonable practice, established by the late South African Commissioners of Patents under the law of 1897 requiring every non-resident applicant to lodge security for £100 in advance to meet the probable costs of a problematic opposition, will not under British auspices be adhered to. Applicants are cautioned in the above Government Notice to comply with the formalities of the Patent Law No. 10 of 1898, which is practically a reprint of Law No. 12 of 1897, with the exception of the correction of a clerical error in Section 54 of the prior Act.

Transvaal  
(late South  
African  
Republic).

According to the latest information new Patent and Trade Mark Bills have already been drafted, and will shortly be submitted to the Legislative Council. If these should become law a number of the defects in the existing administration of Patent matters will be corrected.

Patentee.

*Patentee.* The true and first inventor or, if deceased, his legal representative if the application is made within twelve months of death. Corporations may have patents issued in their names, but the *application* must be made by the inventor. Patents are granted to joint applicants.

Duration of  
Patents.

*Duration of Patents.*—Patents are granted for fourteen years from date of application, but expire with the first prior foreign patent becoming void. No patent will be granted for an invention the subject-matter of an expired foreign patent. Provisional protection is granted for nine months, subject to the filing of the Complete Specification within four months from application.

Novelty  
Effect of  
Prior  
Patent or  
Publication.

*Novelty: Effect of Prior Patent or Publication.*—The application should be filed before any publication or prior use of the invention in the colony. Prior publication elsewhere (such, for instance, as the publication in the *United States Gazette* or the *British Specification*) will not effect novelty in the Transvaal so long as these publications have not entered the colony.

Taxes.

*Taxes.*—At the end of the third year £20; at the end of the fifth year £100; at the end of the eighth year £150; and at the end of the eleventh year £200. Extension of time to pay these taxes may be had up to three months, subject to a fine of £10. (It is to be expected that even if the present law is retained these taxes will be shortly modified to more reasonable amounts.)

Working.

*Working.*—There are no requirements as to working; but if the patent is not worked or made reasonable use of in the colony, so that the wants of the public are not supplied, or if any person is prevented from deriving the full benefit of an invention in his possession, the patentee may be compelled to grant licences on reasonable terms.

*Assignments.* These must be made by way of notarial deed, and must be registered at the office of the Commissioner of Patents. When registration is effected by an agent, he must be provided with a power of attorney from the *assignor* authorising him to record the assignment. Patents may be assigned wholly or in part. Licences may also be granted and recorded. No special form of either assignment or licence is prescribed, and they may be in either English or Dutch.

Transvaal.  
Assign-  
ments.

### TRINIDAD.

Trinidad.

(THE PATENTS, DESIGNS, AND TRADE MARKS ORDINANCES,  
1894 AND 1897.)

*Patentee.*—The actual inventor or the first importer or introducer of the invention into the colony. Joint inventors may obtain a patent, and corporations are included under the word "person," but a corporation alone cannot apply.

Patentee.

*Duration of Patents.*—Patents are granted for fourteen years counting from date of grant. Extensions may, at the discretion of the Governor, be had for a period not exceeding seven years. Provisional protection for nine months may be obtained, and in such a case the Complete Specification may be filed at any time during the period of provisional protection.

Duration  
of Patents.

*Novelty: Effect of Prior Patent or Publication.*—The invention must not have been publicly manufactured, used, or clearly ascertained or described in any publication within the colony. Public use, or the issue of prior patents or publication of specifications elsewhere than in Trinidad, will not affect the validity of a patent there.

Novelty:  
Effect of  
Prior  
Patent or  
Publication.

*Taxes.* None after issue of patent.

Taxes.

*Working.*—There is no statutory obligation to work the patent, but as in Great Britain compulsory licences might be obtained from the patentee on proof that the

Working.

**Trinidad.** invention is not being worked in the colony; or that the requirements of the public are not satisfied; or that any person is prevented from working to the best advantage an invention of which he is possessed. Where a patent is not being worked in the colony, it has been recommended to advertise occasionally in one of the principal papers offering to license suitable persons or to sell the patent.

Assignments.

*Assignments.* These should be in British form, and when made by foreigners should be legalised by a British consul. The assignment should be registered with the authorities in Trinidad. No notice of trust will be entered on the Register.

Amendment: Disclaimer and Revocation.

*Amendment: Disclaimer and Revocation.* Patents may from time to time be amended by explanation or disclaimer and may be revoked on the petition of any person aggrieved.

**Tunis.**

### TUNIS.\*

(LAW OF 22ND RABIA-EL-TANI, 1306; 26TH DECEMBER, 1888;  
 LER RABIA I., 1310; 26TH SEPTEMBER, 1892.)

**Patentee.** *Patentee.*—Patents are granted to whomsoever may apply, or to a firm or corporation.

**Duration of Patent.** *Duration of Patent.* Five, ten, or fifteen years, at the option of the applicant, and dating from application.

**Novelty: Effect of Prior Patent or Publication.** *Novelty: Effect of Prior Patent or Publication.*—An application for a Tunisian patent should be filed before the invention is generally known or in public use either in the Regency or elsewhere.

**Taxes.** *Taxes.* Patents are subject to an annual tax, payable in advance of 100 piastres. No enlargement of time for paying this annuity can be obtained. These annual taxes are due on the rate corresponding to the *delivree* of the patent (Ler Rabia I., 1310).



*Working.* The invention should be put in practice before the expiry of two years from the date of the patent, and the working must not thereafter be interrupted for any two years in succession. Tunis being a member of the International Convention the prohibition against importation of the patented goods is inoperative against patentees who are citizens of States also in the Union, such as the United States and Great Britain for example. All patented goods should be marked with the number of the patent and the words "Sans Garantie du Gouvernement."

Tunis.  
Working.

*Assignments.* As is the case in France, an assignment can only be recorded by paying the full amount of taxes for the term of patent right then unexpired. This immediate expense may, however, be obviated by adopting the plan advised with reference to the French assignment: viz., leaving the assignment unregistered *pro forma*, and causing the parties to the assignment to execute a blank power authorising a notary (whose name can afterwards be filled in) to effect the registration and pay the fees. This power should be legalised by a French consul, and can afterwards be used by the assignee if required.

Assignments.

## TURKEY.

Turkey.

(LAW OF 18TH FEBRUARY, 1879.)

*Patentee.*—Patents are granted to the first inventor or first importer. A firm or corporation may be the grantee of a patent.

Patentee.

*Duration of Patent.* The term of grant is for five, ten, or fifteen years as the applicant may elect.

Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.* The invention, to form the subject-matter of a valid patent, should not have been published or worked in Turkey, and, strictly speaking, should not have been made public abroad. It is, however, the usually accepted opinion, strengthened by a recent pronouncement by the Turkish Minister of

Novelty  
Effect of  
Prior  
Patent or  
Publication.

**Turkey** Commerce, that the mere official publication of the specification of a prior foreign patent would not injure the validity of a subsequent Turkish patent.

**Taxes.** *Taxes.* Patents are subject to an annual tax of 2 Turkish pounds.

**Working.** *Working.* The invention must be worked in Turkey within two years from the date of *application* (see recent Ministerial Regulation), and the working must not thereafter cease for any two successive years, on pain of forfeiture of the patent rights. Importation of patented goods is strictly prohibited, under penalty of forfeiture of the patent. Even the introduction of models of the invention or samples of the goods for exhibition, trial, or other purposes must take place only under permission from the Government. It appears that in some instances patents can be obtained not subject to the working clause, but at an increased cost.

**Assignments.** *Assignments.* When a Turkish patent is assigned, all the taxes due on the unexpired term of patent right require to be paid in advance before the assignment can be recorded. This necessity is sometimes evaded by the plan frequently resorted to in the case of French assignments (see "France"). Assignments should be by notarial deed, and must, when made abroad, be legalised by a Turkish consul.

**Uruguay.****URUGUAY.†**

(LAW OF 12TH NOVEMBER, 1855.)

**Patents.** *Patents.* Patents are granted to the inventor, or to his attorney or assignee.

**Duration of Patent.** *Duration of Patent.* Patents are issued for terms of three, six, or nine years, at the option of the applicant.

**Validity of Patent.** *Validity of Patent or Publication.* To constitute a valid patent the subject-matter should not be publicly known in Uruguay or elsewhere. When prior

foreign patents have been obtained, the owner may, irrespective of publication or public use, obtain a valid patent in Uruguay if he files his application within one year from the date of the first prior foreign patent. Patents of Addition may be obtained. Uruguay.

*Taxes.* Patents are subject to an annual tax of 25 pesos. Patents of Addition are subject to an annual tax of one third of this amount. All taxes are payable in the first ten days of January in each year. Taxes.

*Working.* On the grant of the patent the authorities specify what is, in their estimation, a reasonable time within which the invention must be worked. This may vary from one to three years, according to the nature of the invention. Once commenced the working must not be interrupted for any one year at a time. Working.

*Assignments.* These must be in duplicate in the Spanish language, and must be legalised by a Uruguayan consul. Assignments.

## VENEZUELA.

Venezuela.

(LAW OF 25TH MAY, 1882.)

*Patentee.* Patents are granted to the actual inventor, or to a patentee who has already patented the invention in a foreign country. Patentee.

*Duration of Patent.* Patents are granted for five, ten, or fifteen years, at the option of the applicant, and when a foreign patent exists then for the unexpired term of the foreign patent. Patents of Improvement may be obtained. Duration of Patent.

*Novelty: Effect of Prior Patent or Publication.* A valid patent may be had only in cases where the invention is not publicly known or used in Venezuela, or has not been patented in another country to an inventor other than the applicant. But in the case of an inventor and owner of a foreign patent, he may at any time during the existence of the foreign patent protect his invention in Venezuela for a period coterminous with that of the foreign patent. Novelty.  
Effect of  
Prior  
Patent or  
Publication

**Venezuela.** *Taxes.*— Patents are subject to a tax of 80 bolivares per annum on Patents of Invention and 60 bolivares per annum on Patents of Improvement. Hitherto the practice in Venezuela has been to issue patents upon payment of one half of the taxes for the full term for which the patent was granted, and to permit the other half of the taxes to be paid at any time before the expiry of the first half of the said term. But by a Decree of 25th April, 1898, the President of the Republic has made it obligatory to pay the whole of the taxes in advance for the full term of the patent grant, and this must now be done.

**Working.** *Working.*— A five years' patent must be worked within six months of the grant; a ten years' patent within one year; and a fifteen years' patent within two years of the grant.

As to what constitutes "working," an official announcement of 17th May, 1899, explains that where a patent is being worked abroad under a foreign patent it will suffice to import, sell, advertise, and put the invention in operation in Venezuela, actual manufacture of the patented goods not being required. But in this case certificates from persons using the invention, or in whose possession it is or has been, must be procured and produced to the authorities, together with copies of newspaper advertisements, in the Republic.

**Assignments.** *Assignments.*— Patents may be assigned. The documents should be in Spanish, and when made out of the Republic should be legalised by a Venezuelan consul. Licences may be in any form so long as the existence of the permit is apparent.

**Victoria.**

## VICTORIA.

(Act No. 1031 of 25th November, 1889.)

**Patents.** *Patents.*— Patents are granted to the actual inventor, or to his assignee, or to an importer who has had the invention communicated to him from abroad by the inventor. A corporation may be the grantee of a patent

for an invention communicated to them by the inventor. **Victoria.**  
The legal representative of a deceased inventor may obtain a patent if application is made within twelve months from the death of the inventor.

*Duration of Patent.*—Patents are granted for fourteen years. Inventions may be provisionally protected as in Great Britain, the Provisional being followed up in nine months by a Complete Specification. **Term of Patent.**

*Novelty: Effect of Prior Patent or Publication.* The invention must not be a matter of public knowledge in the colony. But in the case of an applicant who is the owner of a foreign patent, publication or public use prior to application in Victoria will not matter if the Victorian application is made within one year from the date of the prior foreign patent. **Novelty: Effect of Prior Patent or Publication.**

*Taxes.*—Before the expiry of the third year a tax of £2 10s. is payable, and a further tax of £2 10s. before the expiry of the seventh year. An extension of time for making these payments (in no case exceeding six months) may be had on showing sufficient cause and on payment of a fine of £1 in addition to the tax. **Taxes.**

*Working.*—Patentees are not required to work their inventions in the colony, and may import the patented goods at pleasure. **Working.**

*Assignments.*—These are prepared in the form customary in England, and should be entered upon the Register of Patents. **Assignments.**

## WESTERN AUSTRALIA.†

**Western  
Australia.**

(PATENTS ACT, 1888; AMENDING ACT OF 1894; RULES OF 1898.)

*Patentee.*—The true and first inventor or joint inventors, or the assignee of an inventor, or an assignee jointly with the inventor, may apply for a patent. A corporation may **Patentee.**

**Western  
Australia.**

also apply as the assignee of the inventor, the documents being signed by two of the principal officers. The legal representative of a deceased inventor may also apply. A mere importer cannot obtain Letters Patent.

**Duration  
of Patent.**

*Duration of Patent.* Patents are granted for fourteen years. Inventions may be provisionally protected as in Great Britain, the provisional application being followed up within nine months by a Complete Specification. Extension of time to file the Complete Specification may be obtained up to three months on payment of a fine.

The Letters of Registration formerly granted are now abolished.

**Sovelty.  
Effect of  
Prior  
Patent or  
Publication.**

*Sovelty: Effect of Prior Patent or Publication.*—The invention must not have been published or be matter of public knowledge in the colony (*Australian Gold Co. v. Lake View Consols* (1901), 18 R. P. C. 105). Any person who has applied for or obtained a patent in Great Britain or in any other State included in the International Convention is entitled to a patent in West Australia in priority to any other applicant, provided his application is filed in West Australia within seven months, or, according to the recent amendment on the Convention, within twelve months, from the date of such prior application or patent elsewhere, the date given to the West Australian patent being the same as that of the said prior application or patent. The publication of the specification in Great Britain or the United States will not bar the valid grant of a patent in the colony so long as the specification has not been published in West Australia. The exhibition of an invention in an Industrial Exhibition in the colony six months prior to application does not constitute publication if notice has previously been given to the Registrar.

**Taxes.**

*Taxes.*—Before the expiration of the fourth year £5, and before the expiration of the seventh year £10. The payments of these taxes must be endorsed on the Letters Patent, which should be produced for this purpose. Extension of time to pay these taxes may be obtained, subject to a fine of 10s. for one month; 15s. for two; £1 for three; £1 10s. for four; £2 for five, and £3 for six months.

*Working.*—There are no requirements as to working the invention or marking the patented goods. The patentee may import the goods into the colony.

Western  
Australia.  
Working.

*Assignments.*—These may be in any suitable form such as might serve for Great Britain or the United States. The assignment should be in duplicate, both signed, and should be entered upon the Register. The registration fee for either assignment or licence is 10s., and the stamp duty on an assignment is 10s.

Assign-  
ments.

*Note.*—At the moment of going to press information has been received that the West Australian Patents Amendment Bill of 1900 will not be submitted to the King in Council and will not come into operation.

## ZULULAND.

Zululand.

Zululand is now incorporated with the Colony of Natal, and a patent in the latter now covers and is operative throughout all the territory hitherto known as Zululand. Any separate patents now subsisting in Zululand may be allowed to lapse so long as the corresponding patent in Natal is maintained.

## FOREIGN AND COLONIAL TRADE MARKS AND DESIGNS.

**T**RADER MARKS, and in many instances Designs also, can be protected in the bulk of the foregoing countries and colonies. In almost all the principal States and Dependencies this can be done under existing Statutes, and where this is not so, special arrangements or legislative Acts may be furthered to obtain the desired protection.

## APPENDIX A.

### INTERNATIONAL CONVENTION

FOR THE

# Protection of Industrial Property (1883)

AS AMENDED 11th DECEMBER, 1900.

## CONSOLIDATED.

**T**HE International Convention was initiated and concluded by the several assenting Powers for the purpose of affording mutual protection to their respective subjects and citizens in sustaining their rights, chiefly, to the abstract species of industrial property constituted by Patents for Inventions, Copyright in Designs, Trade Marks, and Trade Names. The original text of the Convention is in the French language, and the following excerpt is from the authorised translation.

The opening paragraphs rehearse the names and titles of the subscribing potentates and plenipotentiaries, and are of but slight interest to the general reader. Since the signature several changes have taken place, and it will serve a more useful purpose to give the complete list of the Governments which are now parties to the Convention. These are as follows—America (U. S.), Belgium, Brazil, Denmark with the Faroe Islands, Dominican Republic (San Domingo), France and her Colonies, Great Britain, Holland with East Indian Colonies, Italy, Japan, Norway, Portugal with the Azores and the Madeira, Prussia, Spain, Sweden, Switzerland and Siam. Germany is not a member of the Union yet is an applicant there, and she, also, are on the point of seeking admission.

The countries which are not members of the Convention but which have concluded partial agreements with Great Britain under section 103 of the Patent Act of 1852 are also to be mentioned as follows—Paraguay and Uruguay, Mexico, Honduras, French Guiana, Dutch Guiana and the Netherlands, and the Republic of the Congo.



The text of the Convention consists of nineteen Articles, and is followed by a Final Protocol explaining and qualifying the terms of these Articles. In the following copy the additional matter and amendments agreed to at the Conference of the 14th December, 1900, are introduced into and consolidated with the original text at their proper places. The new additions and alterations are printed in heavier type.

ARTICLE I. contains a list of the original subscribing Powers, which may now be replaced by the list given in the foregoing introduction.

ARTICLE II. --The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens. Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

ARTICLE III. Subjects or citizens of States not parties to the Union who are domiciled or have **effective and genuine** industrial or commercial establishments in the territory of any of the States of the Union shall be assimilated to the subjects or citizens of the Contracting States.

ARTICLE IV. Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated. Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention or by the working of it, by the sale of copies of the design or model, or by use of the trade mark. The above mentioned periods of priority shall be **twelve** months for patents, and **four** months for industrial designs and models and trade marks.

ARTICLE IV, bis. Patents applied for in the various Contracting States by persons admitted to the benefits of the Convention under the terms of Articles II, and III,

shall be independent of patents obtained for the same invention in other States, whether parties to the Union or not. This provision shall apply to patents in existence at the time of its being put in force. The same thing shall apply, in the event of the accession of other States, to patents in existence on either side at the time of accession.

ARTICLE V.—The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture. Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ARTICLE VI.—Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union. That country shall be deemed the country of origin where the applicant has his chief seat of business. If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin. Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

ARTICLE VII.—The nature of the goods on which the trade mark is to be used can in no case be an obstacle to the registration of the trade mark.

ARTICLE VIII.—A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

ARTICLE IX.—All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection. The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country. In States whose legislation does not allow seizure on importation this seizure may be replaced by prohibition of importation. The authorities shall not be bound to effect seizure in the case of goods in transit.

ARTICLE X.—The provisions of the preceding Article shall apply to all goods taken to make the equis of any locality or indication of the place of origin, when such indication is connected with a

trade name of a fictitious character or assumed with a fraudulent intention. Any producer, manufacturer, or trader who produces, manufactures, or trades in such goods, and who is established either in the locality falsely indicated as the place of origin or in the region in which this locality is situated, shall be deemed an interested party.

**Article X. bis.**—The subjects or citizens of the States parties to the Convention (Articles II. and III.) shall enjoy in all the States of the Union the protection accorded to native subjects or citizens against dishonest competition.

**Article XI.** The High Contracting Parties shall, in conformity with the legislation of each country, grant temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised International Exhibitions which have been organised in the territory of one of them.

**Article XII.** Each of the High Contracting Parties agrees to establish a special Government Department for Industrial Property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

**Article XIII.** An International Office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property). This office the expense of which shall be defrayed by the Governments of all the Contracting States shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

**Article XIV.** The present Convention shall be submitted to periodical revisions with a view to introducing improvements calculated to perfect the system of the Union. To this end conferences shall be successively held in one of the Contracting States by Delegates of the said States.

**Article XV.** It is agreed that the High Contracting Parties reserve to themselves the right to make separately, or between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not conflict with the provisions of the present Convention.

**ARTICLE XVI.**—States which have not taken part in the present Convention shall be permitted to adhere to it at their request. Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses and admission to all the advantages stipulated by the present Convention, and shall take effect one month after the despatch of the notification made by the Swiss Government to the other States of the Union, unless a later date has been indicated by the adhering State.

**ARTICLE XVII.**—The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the High Contracting Parties, who are bound to procure the application of the same, which they engage to do with as little delay as possible.

**ARTICLE XVIII.**—The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

**ARTICLE XIX.**—The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

[Here follow the signatures of the respective plenipotentiaries.]

The present additional Act shall have the same validity and duration as the Convention of the 20th March, 1883.

It shall be ratified and the ratifications deposited at Brussels at the Ministry of Foreign Affairs as soon as may be possible, and within eighteen months from the day of signature at latest.

It will come into force three months after the closing of the process-verbal of deposit.

**IN WITNESS** whereof &c.

Done at Brussels in single copy the 14th December, 1900.

## FINAL PROTOCOL.

[TRANSLATION.]

ON proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the Protection of Industrial Property, the undersigned plenipotentiaries have agreed as follows:--

1. The words "Industrial Property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters &c.).

2. Under the word "Patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

3 bis. The patentee in each country shall not incur forfeiture for non-working until the expiration of a minimum period of three years commencing from the date of the deposit of his application in the country in question, and in case the patentee fail to give satisfactory reasons for his inaction.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union from the fact alone that it does not satisfy, in regard to the exact composition of the conditions of the legislation of that State, provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country of origin. With this exception, which relates only to the form of the mark and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconception it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organisation of the special Department for Industrial Property mentioned in Article XII, shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office instituted by virtue of Article XIII, are in no case to exceed for a single year a total sum representing an average of 2000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units: namely

First class. ... ..	25 units
Second class... ..	20 „
Third class ... ..	15 „
Fourth class... ..	10 „
Fifth class ... ..	5 „
Sixth class . . . . .	3 „

These coefficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expenses:

First class	France, Italy.
Second class	Spain.
Third class	Belgium, Brazil, Portugal, Switzerland
Fourth class	Holland.
Fifth class	Serbia.
Sixth class	Chromania, Rumania.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an

1. The Government of the Netherlands, the principal of the Contracting Powers, shall be responsible for the publication of the *Journal* for which it is to contribute the necessary funds.

annual account, which will be communicated to all the other Administrations.

The International Office will centralise information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said Administrations or by Societies or private persons will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next Conference is to be held will make preparations for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present Final Protocol, which shall be entitled together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as, the said Convention.

In witness whereof the undersigned plenipotentiaries have drawn up the present Protocol.

Here follow the signatures of the respective plenipotentiaries and the Kings stating that the present additional Act shall have the same validity and duration as the Convention of the 20th March 1883 (see page 411, ante).

## APPENDIX B.

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### TWELVE SHORT PRECEDENTS OF AGREEMENTS, ASSIGNMENTS, LICENCES, MORTGAGES, &c.,

RELATING TO THE  
WORKING AND DISPOSAL OF LETTERS PATENT  
FOR INVENTION.

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THE following short examples of Agreements, Assignments, Licences, and Mortgages may usefully serve as guides to persons engaged in preparing such documents.

Modern practice is all in favour of abridging and simplifying the intolerable prolixity which many draftsmen still affect. The Author has therefore, in drawing these Precedents, endeavoured to make them as concise as possible.

One notably new feature will be apparent in the examples of Agreements made prior to application: viz., the inclusion of a short description and sketch of the invention spoken of in the Agreement, so that the subject-matter of the Agreement may be identified with the subject-matter of the after application. This course is in all such cases advisable, lest it should be necessary afterwards to seek registration of the document, as such registration would inevitably be refused by the Comptroller if he should be unable to identify the invention referred to in the Agreement with the invention afterwards patented (*re Parnell's Patent* [1888], 5 R. P. C. 126).

With reference to the implied covenants for title &c., and to the position of those who grant loans or make advances under certain Agreements of this nature, it may be of use to the lay reader to glance at the extracts from the Conveyancing and Partnership Acts which appear immediately after the last of the precedents.



**Form 1.**

*AGREEMENT between an Inventor who has been unable from want of means to develop or protect his Invention, and a second party who proposes to furnish the necessary funds in consideration of receiving a share in the Patent to be applied for.*

**An Agreement** made the                      day of                      , 19                      ,  
 BETWEEN **ANDREW BELL**, of No. 15 Leaf Street, in the City of Birmingham, Metal Worker, of the one part, and **CHARLES DENDY**, of No. 56 Horse Square, Birmingham aforesaid, Stockbroker, of the other part.

WHEREAS the said Andrew Bell claims to be the true and first inventor of certain "Improvements in Apparatus for directly recording and transcribing Speech and Sounds," which invention he has not been able, from want of means and opportunity, properly to develop and patent: AND WHEREAS the said Charles Dendy has agreed with the said Andrew Bell to provide and pay a sum of money not exceeding Five Hundred Pounds for the further development and patenting of the said invention, but subject to the conditions and for the consideration hereinafter expressed:

NOW THESE PRESENTS WITNESS and it is hereby agreed between the parties as follows:—

1. The said Charles Dendy shall, upon the signing of this Agreement, advance the sum of £100 for the purpose of purchasing materials, tools, and all necessary adjuncts to enable the said Andrew Bell to proceed with his experiments and trials for the further development of the said invention, and if necessary additional sums will be advanced by the said Charles Dendy from time to time to continue the said experiments and trials, it being hereby agreed that the total sum so advanced shall not exceed £250.

2. If when the said sum of £250 shall have been expended the invention is still not sufficiently developed or advanced to warrant an application for Letters Patent, the said Charles Dendy shall be at liberty to give notice to the said Andrew Bell of his intention to withdraw from this Agreement, and thereupon, within one week after such notice has been given, and when all liabilities incurred in connection with the development of the invention

since the signing of this Agreement, and with the knowledge and consent of the said Charles Dendy, have been discharged by the said Charles Dendy, this Agreement shall cease and determine, and the invention will remain the sole property of the said Andrew Bell, who shall not be liable in respect of any sums expended by the said Charles Dendy in pursuance of this Agreement.

3. If the aforesaid experiments and trials should result in the proper and successful development of the invention, the said Andrew Bell shall forthwith make application for Letters Patent, and shall thereafter and in due course file the Complete Specification and take all necessary steps to obtain the Letters Patent, but all at the expense of the said Charles Dendy.

4. As soon as the Letters Patent shall have been issued and obtained, the said Andrew Bell shall execute a proper assignment conveying one half share in the said Letters Patent and invention, and in all further improvements upon the same devised by him, to the said Charles Dendy, as consideration for the moneys expended and to be paid by him; and if after provision for all outstanding amounts and charges the full sum of £500 shall not have been already expended, then the undischarged balance shall be paid on the execution of the said assignment by the said Charles Dendy to the said Andrew Bell.

5. The said assignment shall contain conditions limiting the mutual rights and liabilities of the co-owners of the Letters Patent, and shall provide that the inventions and patents, however worked or disposed of, shall operate for the mutual benefit of the co-owners, and neither of the co-owners shall be at liberty to work or license the inventions and patent rights for his own benefit alone, but shall account for his share of the profits to his co-owner, the patent or patents being held equally between them as tenants in common, and in like manner the annual taxes which fall due at or before the expiry of the fourth year of the patent or patents shall be paid by the parties hereto in equal shares.

6. In order to identify the invention forming the subject-matter of this Agreement with the invention forming the subject-matter of the patent or patents to be hereafter applied for under the conditions of this Agreement, and so to provide for the entry of this Agreement upon the Register at the Patent Office, if such entry

should hereafter prove to be necessary or desirable in the interests of either of the parties, the following is a short description and sketch of the invention in its present condition:—[*Here insert a brief description and sketch of the invention.*]

7. It is to be understood that this Agreement shall have no effect as regards the obtaining ownership or working of any foreign patents for the invention, and that these may be obtained and dealt with by the said Andrew Bell at his own expense, and without reference to the said Charles Dendy.

8. The duties, liabilities, and benefits undertaken by and accruing to the parties to this Agreement shall extend and apply as far as possible to the executors, administrators, and assigns of either party.

IN WITNESS WHEREOF the within-named parties have hereunto set their hands the day and year first above written.

ANDREW BELL.  
CHARLES DENDY.

*NOTE.*—This document would not be capable of registration until after the patent had been applied for and issued, and then only if the invention indicated in the Agreement was, in the opinion of the Comptroller, the same as that covered by the patent. Registration would, however, only require to be sought in the event of the inventor refusing or failing to execute the assignment provided for in Paragraph 4.

**Form 2.**

*AGREEMENT between an Inventor whose Invention has not yet been protected, and a second party, not a co-Inventor, who is to join with him in applying for a Patent, and acquire one half share in consideration of his defraying the costs of applying for the Patent and paying the Inventor an additional sum of money upon the issue of the Patent.*

**An Agreement** made the                      day of                      , 19                      .  
BETWEEN EDWARD FISHER, of No. 13 Thacker's Row, Preston, in the County of Lancaster, Hairdresser's Assistant, of the one part, and GEORGE HARDY, of No. 35 Thacker's Row aforesaid, Grocer, of the other part.

WHEREAS the said Edward Fisher claims to be the inventor of "An Improved Apparatus for Heating Curling Tongs by Electricity," of which the following is a brief description and sketch, inserted for the purpose of identifying the subject-matter of this Agreement with the subject-matter of the patent to be hereafter applied for, that is to say [*here insert short description and sketch of the invention*]; AND WHEREAS the said George Hardy is desirous of acquiring one half interest in the said invention and in the patent to be hereafter obtained for the same, and the said Edward Fisher has agreed to sell one half share and interest as aforesaid for the sum and upon the conditions hereinafter set forth:

NOW IT IS HEREBY AGREED BETWEEN THE PARTIES AS FOLLOWS:—

1. Immediately upon the signing of this Agreement the said George Hardy will instruct a Patent Agent to make a search to ascertain the novelty of the said invention, and if no anticipatory publication is found, then the parties hereto will make application for a patent in their joint names, and will thereafter and in due course file the Complete Specification, and obtain issue of the Letters Patent. The costs of the search and all the charges incurred in applying for and obtaining the patent will be borne and paid by the said George Hardy as part consideration in respect of this Agreement, and no demand in respect thereof is to be made upon the said Edward Fisher, except that if the search discloses that the invention is not novel, and the matter proceeds no further, then the said Edward Fisher agrees to pay one half of the agent's charges incurred for making the search.

2. Immediately upon the issue of the Letters Patent, and not later than one week thereafter, the said George Hardy will pay to the said Edward Fisher the sum of £100, which, together with the aforesaid search and patent fees, shall constitute the consideration paid by him for the half share in the patent, and the agent who obtains the patent will be instructed to keep the Letters Patent in his hands until payment of this latter sum of £100 has been made.

3. The patent and every extension thereof shall be held and enjoyed by the parties hereto in equal shares as tenants in common, and all renewal fees and expenses connected with the maintenance

of the patent when granted shall be borne equally by the parties. Neither of the parties shall be entitled to work the invention for his exclusive benefit nor to grant licences without accounting to his co-patentee or his representative or assigns for one half share of all net profits derived from such working or licensing. Either of the parties shall be at liberty to sell his share of the patent, and his assignee shall be subject to and be bound by the conditions and restrictions herein set forth.

4. Any further improvements in the invention which may be devised by either of the parties shall be disclosed to the other, and if considered advisable the same shall be patented in their joint names and at their joint expense.

5. Except where the context requires a different interpretation, or where from other causes such interpretation is not reasonable, any expression referring to either or both of the said parties to this Agreement shall extend and be construed to apply also as far as possible to the assigns of the person or persons so designated.

IN WITNESS &c.

*NOTE.—This Agreement would not require registration unless difficulties were to arise in respect of the Partition Clause in Paragraph 3.*

### Form 3.

*AGREEMENT between Joint Inventors and intending Co-applicants for the purpose of defining their respective interests, rights, and powers into and under the Patent to be applied for.*

**Memorandum of Agreement** made this  
day of \_\_\_\_\_, 19\_\_\_\_, BETWEEN ISAAC JENKINS, of No. 17 Tuer  
Street, in the City of Manchester, Cotton Spinner, of the one  
part, and KENNETH LATHAM, of The Hawthorns, Palatine Road,  
Didsbury, near Manchester aforesaid, Engineer, of the other part.

WHEREAS the said parties have jointly invented certain  
"Improvements in Carding Engines," a sketch and description of  
which is contained in the Schedule attached thereto and in respect of

which it is intended by the parties to make joint application for a patent: AND WHEREAS the said Isaac Jenkins has invented the chief portion of the said improvements, while the parts of the invention attributable to the said Kenneth Latham refer to less important details, it has been thought desirable before applying for a patent to define the respective shares and the terms and conditions in and under which the said invention and any Letters Patent obtainable for the same shall be possessed and worked by the parties:

NOW THESE PRESENTS WITNESS AND IT IS HEREBY AGREED AS FOLLOWS:—

1. The property constituted by the invention and Letters Patent to be hereafter applied for shall be considered as divided into three equal parts, of which two parts or thirds shall be the share of the said Isaac Jenkins, and the remaining one third the share of the said Kenneth Latham.

2. All expenses connected with ascertaining the novelty of the invention and obtaining Letters Patent therefor, and all renewal fees and charges connected with maintaining the patent in force when granted, shall be borne and paid by the parties hereto in the proportion of their respective interests: namely, two thirds by the said Isaac Jenkins and one third by the said Kenneth Latham.

3. In the same manner all net profits obtained as royalties or otherwise from the manufacture, sale, use, or licensing of the said invention and Letters Patent shall be shared by the parties hereto in the same proportions: that is to say, two thirds to the said Isaac Jenkins and one third to the said Kenneth Latham.

4. If either of the parties hereto should manufacture carding engines made in accordance with the said invention, a fixed royalty, to be mutually agreed upon, shall be chargeable upon each machine, and this royalty shall be shared between the parties in the indicated proportions.

5. Neither of the parties shall be entitled to grant licences without the consent in writing of the other, but either of the parties may sell his share of the invention and future Letters Patent without the concurrence of the other, and the purchaser

of the share so assigned shall be subject to the same conditions and restrictions and entitled to the same benefits as are imposed upon and secured to the original co-patentees under this Agreement.

6. The conditions of this Agreement shall apply, not only to the parties hereto, but also, as far as possible, to their assigns.

IN WITNESS &c.

SCHEDULE.

*[To contain description and sketch of invention.]*

NOTE.—It would be advisable to follow up this Agreement, after the patent is issued, by a proper deed of partition.

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**Form 4.**

*AGREEMENT for Sale of Patent, between Inventor who has obtained Provisional Protection and Purchaser who arranges to pay the purchase-money in the following instalments: viz., One-third on signing Agreement; one-third on acceptance of Complete Specification; and the remainder on the issue of the Letters Patent.*

**An Agreement** made the                      day of                      , 19                      ,  
 BETWEEN MATTHEW NASH, of No. 12 Prior's Court, in the City of London, Clerk, of the one part, and OLIVER PALEY, of Gracechurch Street, London aforesaid, Advertising Agent, of the other part.

WHEREAS the said Matthew Nash claims to be the inventor of, and has obtained Provisional Protection for, an invention entitled "Improvements in Means for Displaying Advertisements," No. 3698, dated 15th March, 1901, which invention and the patent to be obtained therefor he has agreed to sell to the said Oliver Paley:

NOW THESE PRESENTS WITNESS that in consideration of the sum of £150 paid by the said Oliver Paley to the said Matthew Nash as hereinafter set forth, he the said Matthew Nash DOETH HEREBY AGREE to sell and assign the said invention and Letters Patent to the said Oliver Paley, the purchase-money aforesaid to be paid in the following instalments: that is to say, £50 upon the signing of these presents; £50 upon the acceptance of the

Complete Specification (which the said Matthew Nash agrees forthwith, and at his own cost, to prepare and file); and £50 upon the sealing and issue of the Letters Patent.

PROVIDED that if the said Matthew Nash shall fail to file the Complete Specification in due course, the said sum of £50 paid upon the signing of this Agreement shall be returned by him to the said Oliver Paley, or if the said Complete Specification after acceptance should be successfully opposed, then the said sum of £50 paid at the signing of this Agreement, and also the sum of £50 paid on the acceptance of the Complete Specification, shall be repaid by the said Matthew Nash to the said Oliver Paley, and these sums shall be recoverable as a simple contract debt. PROVIDED FURTHER that upon the sealing and issue of the Letters Patent the said Matthew Nash shall forthwith execute a proper deed of assignment conveying the said invention and Letters Patent to the said Oliver Paley, or otherwise shall execute such further deeds or instruments as may be considered necessary to more fully vest and secure the said invention and Letters Patent in and to the said Oliver Paley, but at the cost of the said Oliver Paley. Any improvements upon the said invention which the said Matthew Nash may devise during the five years following the signing of this Agreement shall be disclosed and submitted to the said Oliver Paley or his assigns, and shall become his property, with the option of protecting the same by a patent if he or they should think fit, but at the cost of the said Oliver Paley or his assigns.

IN WITNESS &c.

NOTE.—*This document need not be registered. The Agreement should be replaced by the deed of assignment provided for, and that deed could be registered.*

### Form 5.

*AGREEMENT for Sale of Patent to Company, made between Patentee and Trustee for Syndicate about to form a Company; agreed consideration, partly cash, partly shares in Company; Patentee to be a Director in Company; Agreement to become void in the event of capital not being subscribed.*

**Memorandum of Agreement** made this  
day of \_\_\_\_\_, 19\_\_\_\_, BETWEEN WILLIAM SCOTT, of Brierfield Hall, Northwich, in the County of Chester (hereinafter called "the Vendor"), of the one part, and GEORGE SCATTERGOOD, of



No. 3 Capstan Street, in the City of Liverpool, Solicitor (hereinafter called "the Trustee"), of the other part.

WHEREAS the said Vendor claims to be the true and first inventor of certain "Improvements in Pneumatic Wheel Tyres," for which he has obtained His Majesty's Letters Patent No. 14,036, under date the 12th February, 1902, and also certain foreign and colonial patents as set forth in the Schedule A hereto; AND WHEREAS the parties whose names appear in the Schedule B hereto, together with the amounts of their respective holdings or interests, and who are hereinafter referred to as "the Syndicate," have duly empowered and appointed the said Trustee to agree to purchase the said invention and Letters Patent (home, foreign, and colonial) from the Vendor, in trust for and on their behalf, for the consideration of £10,000 in cash, together with certain fully paid-up shares, but subject to the conditions hereinafter expressed:

NOW THESE PRESENTS WITNESS that, in pursuance of the said agreement and authorisation, and for the considerations and subject to the conditions herein expressed, IT IS HEREBY AGREED between the said Vendor and the said Trustee as follows:--

1. The Trustee shall upon the signing of these presents pay to the Vendor the sum of £250, being part payment of the aforesaid sum of £10,000, receipt of which sum of £250 is hereby acknowledged by the Vendor, and the Trustee shall thereupon inform the Syndicate of the execution of this Agreement.

2. The Syndicate or their agents shall then take the necessary steps to promote and form a limited company, to be entitled "The Scott Patent Tyre Company, Limited," and shall register the said company in terms of The Companies Acts, 1862 to 1900, the registered office to be in Liverpool as aforesaid.

3. The capital of the said company shall be £50,000, divided into 5000 shares of £10 each, and out of the said 5000 shares 1000 fully paid-up shares shall be allotted to the Vendor, in addition to the sum of £10,000 already referred to, and the Vendor shall be placed upon the board of directors.

4. Immediately upon the registration of the company prospectuses and advertisements will be issued and the subscription of capital invited. If the required amount of capital is subscribed the Vendor shall thereupon execute a proper assignment or assignments duly conveying and transferring the said invention and

patents, both in this country and elsewhere, and also the benefits of any future improvements devised by him upon or in addition to the said inventions and Letters Patent, as beneficial owner, to the said company or their duly appointed trustee, and the Vendor shall upon the execution of the assignment receive the sum of £9750, being the amount of purchase money hereinbefore set forth, less the sum of £250 paid at the signing of this agreement, and shall in addition have delivered to him the certificates representing 1000 fully paid-up shares of £10 each.

5. If sufficient capital should not be subscribed to pay the said purchase money and justify proceeding to allotment, then within three months after the date of the first issued prospectuses or advertisements inviting subscriptions of capital to the company this Agreement shall become null and void, and the Trustee shall forfeit and the Vendor shall retain the sum of £250 paid at the signing of this Agreement.

IN WITNESS &c.

SCHEDULE A.

*(Numbers, dates, and titles of Home and Foreign Patents.)*

SCHEDULE B.

*(Names of members of Syndicate, with amounts of holdings or interest.)*

*NOTE.—This Agreement, together with any subsequent instrument, should be referred to in any prospectus issued, and should also be filed with the Registrar of Joint Stock Companies, pursuant to Section 7 of The Companies Act, 1900.*

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**Form 6.**

*ASSIGNMENT (Absolute) of Invention and Letters Patent by the Patentee to a Purchaser.*

**An Indenture** made the                      day of                      , 19                      .  
 BETWEEN ROBERT SHEDDEN, of No. 29 New Smithhills, Paisley, in the County of Renfrew, North Britain, Iron Turner (hereinafter called "the Assignor"), of the one part, and THEODORE UNDERWOOD, of the Clydebank Shipbuilding Yard, Stobeross, Glasgow, in the County of Lanark, N.B., Marine Engineer (hereinafter called "the Assignee"), of the other part.

WHEREAS the Assignor claims to be the inventor of certain "Improvements in Feathering Paddlewheel Floats," for which he

has obtained Letters Patent No. 12,342, dated 23rd July, 1899: AND WHEREAS the Assignor has agreed with the Assignee for the sale to him, the Assignee, of the said invention and Letters Patent for the sum hereinafter expressed:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement and in consideration of the sum of £1000 paid by the Assignee to the Assignor upon the signing of these presents (the receipt of which sum is hereby acknowledged), he the Assignor, as beneficial owner, doth hereby assign unto the Assignee and his assigns absolutely all those the said invention and Letters Patent and the sole and exclusive benefit thereof, and all rights, powers, emoluments, and advantages whatsoever under or in respect of the said Letters Patent, the Assignor hereby covenanting with the Assignee and his assigns that, notwithstanding anything by him the Assignor done, omitted, or knowingly suffered, the said Letters Patent are now valid and subsisting.

IN WITNESS &c.

NOTE.—*This Assignment should be under seal, and should be registered.*

### Form 7.

*ASSIGNMENT of Half Share of Patent: Co-owners to work the Invention under the Patent independently of each other, but all Licences to be granted under the hands and seals of both.*

An Indenture made the                      day of                      . 19                      .  
BETWEEN RICHARD MASON, of The Phoenix Boiler Works, Pendleton, Manchester, in the County of Lancaster, Boiler Maker (hereinafter called "the Assignor"), of the one part, and THOMAS JOHNSON, of No. 40 MacDonalld Street, Belfast, in the County of Antrim, Ireland, Engineer (hereinafter called "the Assignee"), of the other part.

WHEREAS the Assignor has obtained Letters Patent No. 7326, dated the 12th of July, 1898, for "Improvements in the Construction of Steam Generators," of which he claims to be the true and first inventor: AND WHEREAS the Assignor has agreed to sell one half share of the said invention and Letters Patent to the Assignee for the sum of £600, but subject to the conditions hereinafter set forth:

NOW THIS INDENTURE WITNESSETH that, in consideration of the said sum of £600 paid by the Assignee to the Assignor

at the signing of these presents, and the receipt of which is hereby acknowledged, he the Assignor, as beneficial owner, doth hereby assign and convey one half share of the said invention and Letters Patent absolutely to the Assignee and his assigns, the said assignment being coupled with the following conditions:—

1. Either of the parties may, in carrying out his own business, manufacture and sell boilers made in accordance with the said invention, and under the said Letters Patent, without accounting to the other for profits and royalties derived therefrom.

2. Neither of the parties alone shall be at liberty to grant any licences to third parties to manufacture and sell under the said Letters Patent, but any such licence shall be granted only with the full consent of both parties, and under their respective hands and seals, and all royalties and profits whatsoever accruing under such licence or licences shall be divided equally between the parties hereto, share and share alike.

3. All renewal fees for maintaining the patent in force and the agency or other charges connected with the payment of such renewal fees shall be borne and paid by the parties hereto in equal proportions, and if either of the parties or his assigns should omit or refuse to pay his or their share of such renewal fees and expenses, the same shall remain a charge upon his or their share of the patent, or otherwise shall be recoverable from the party or his assigns by the other party by action at law as a simple contract debt.

4. Either of the parties shall be at liberty at any time to sell his share of the said invention and Letters Patent to a third party, but only after the other party has had the first refusal of the said share at the price for which the said half share is actually and ultimately sold.

5. The terms "Assignor" and "Assignee," and any other terms herein used to describe the parties to this Agreement, shall be understood to include, as far as possible, their assigns, except where such an interpretation is specifically barred.

IN WITNESS &c.

*NOTE.—This Agreement should be under seal and registered.*

## Form 8.

*ASSIGNMENT of a Patent to Trustees in Trust for Purchasers having unequal shares, the Trustees to exploit the Patent, sell the goods, grant licences, draw royalties, distribute profits, call for contributions, and otherwise act generally for the beneficial owners.*

**An Indenture** made the                    day of                    , 19                    .  
 BETWEEN **HIRAM POTTER**, of Newark, New Jersey, in the United States of America, Engineer (hereinafter called "the Vendor"), of the first part; **JAMES STEEL**, of No. 12 Victoria Street, in the City of London, Civil Engineer, **ALFRED MOTTERSHEAD**, of the "Black Bull" Hotel, in the City of Chester, Wine Merchant, and **PHILIP STAPLETON**, of Burnley, in the County of Lancaster, Cotton Spinner (hereinafter called "the Purchasers"), of the second part; and **GEORGE KINGHORN** and **FREDERICK WILSON**, both of No. 133 King William Street, in the City of London, Chartered Accountants (hereinafter called "the Trustees"), of the third part.

WHEREAS the Vendor has obtained Her Majesty's Letters Patent in the United Kingdom for "An Improved Telephonic Transmitter," No. 328, dated 14th January, 1895; AND WHEREAS he has agreed to sell and the Purchasers have agreed to purchase the said invention and Letters Patent for the sum of £5000 in the following shares and proportions: namely—As to the said James Steel, one half share, for which his contribution to the purchase money is £2500, and as to the said Alfred Mottershead and Philip Stapleton, one fourth share each, for which their contributions to the purchase money are respectively £1250 each: AND WHEREAS the Purchasers have requested the Vendors to assign the said invention and Letters Patent to the aforesaid Trustees, in trust for the purchasers, subject to the payment of the purchase money and to the conditions herein expressed:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement and request, and in consideration of the said sum of £5000 paid at the signing of these presents, and the receipt of which the Vendor hereby acknowledges, he the Vendor, as beneficial owner, doth hereby assign and convey to the Trustees the aforesaid invention and Letters Patent, upon trust for the Purchasers as tenants

in common in the shares already set forth: namely, one half share to the said James Steel, and one fourth share each to the said Alfred Mottershead and Philip Stapleton. AND THE VENDOR doth hereby covenant with the said Trustees jointly, and also with each of the Purchasers separately, that, notwithstanding anything by the Vendor done, omitted, or knowingly suffered, the said Letters Patent are now valid and subsisting and not void or voidable. PROVIDED FURTHER and it is hereby agreed and declared as follows:—

1. Except under licence granted by the Trustees, none of the Purchasers or their assigns shall be entitled to make, use, exercise, or vend the said invention and Letters Patent within the United Kingdom.

2. The Trustees shall work and exploit the patent and premises to the best advantage of the Purchasers, and shall, subject to the direction and advice of the Purchasers, or a majority of the Purchasers representing three fourths of the value, manufacture the patented apparatus and grant licences for the manufacture, use, and sale of the invention at royalties to be fixed by the Purchasers or a majority as aforesaid, and all net profits, royalties, and emoluments accruing to the Trustees from and by such manufacture, licensing, and exploiting of the invention and Letters Patent shall form part of the trust estate, and, subject to the payment of all costs and expenses, shall be held by the Trustees in trust for the Purchasers and paid to them in accordance with their respective shares as hereinbefore set forth.

3. The Trustees may, and shall at any time during the continuance hereof, at the request in writing of the Purchasers or their assigns, or such of them as hold a majority in value of not less than three fourths of the entire value of the patent and premises, sell the said Letters Patent, and the purchase-money so obtained, after deducting all necessary costs and expenses, shall be divided among the Purchasers or their assigns in accordance with the amounts of their respective holdings.

4. The Trustees shall, out of the trust estate, pay the renewal fees necessary to maintain the said patent in force, or to obtain and maintain any further patents which may be applied for or bought by or under the direction of the Purchasers, or for any extension or

extensions of the said patent or patents, and, generally, the Trustees shall pay out of the trust moneys all costs, expenses, and liabilities strictly chargeable against the estate.

5. Any proceedings at law or otherwise necessary for the protection and maintenance of any Letters Patent aforesaid, or for the protection and maintenance of the rights of the owners therein, and for the prosecution of infringers pirating the invention or inventions, or slandering the title or titles of such Letters Patent or Patents, shall be taken and prosecuted by the Trustees when required so to do by the Purchasers or by a three fourths value majority of the Purchasers, the costs of such proceedings to be borne by the trust estate, and any moneys recovered in the form of damages or otherwise, or sums paid to compromise actions, shall be paid and accrue to the said trust estate, less costs and charges paid in recovering or obtaining the same or judgments to that effect.

6. The Trustees shall present accounts as between themselves and the respective Purchasers half-yearly, such accounts to be made out as extending from the 1st day of January in each year to the 30th day of June in each year, and from that day to the 31st day of December in each year, such accounts to be presented and a proper balance struck, audited by independent auditors appointed by the Purchasers and settled not less than fourteen days after the termination of the respective periods over which the accounts extend. If on the presentation of accounts it should be found that there is an adverse balance against the trust estate or the respective Purchasers, then the Trustees shall apportion the sum to be paid by each Purchaser, having regard to his (the Purchaser's) share, and shall require him in writing to pay such sum within fourteen days, and if default in payment is made the said sum due shall bear interest at five per cent. per annum, and shall until paid remain a charge upon the defaulting owner's share in the estate.

7. For each half-year or portion thereof, each Trustee shall during the continuance of his trusteeship receive the sum of £100, such payment to come out of the moneys of the trust estate generally and not to be chargeable as a debt against any of the Purchasers particularly.

8. The Trustees or either of them may be removed by the Purchasers, but such power of removal shall be exercised only by a majority representing two thirds in value of the entire ownership.

9. If any difference shall arise between the parties—that is to say, between the Vendor and the Trustees, or between the Trustees, or between the Purchasers, or between the Trustees and the Purchasers—in respect of the construction of this instrument, or of the respective rights, duties, or liabilities of the parties, the same shall, if competent and desirable, be referred to two arbitrators, one to be appointed by each of the parties, and such arbitrators, or their umpire, may accordingly make an award in respect of the said difference, and the costs of or incidental to such reference and award respectively, and the person or persons by whom and in what manner the same shall be paid; and the submission may be made an order of the High Court of Justice upon the application of either party, who may consent or instruct counsel to consent thereto for the other of them, the death of any party not to operate as a revocation of the submission or otherwise be a bar to proceedings in respect thereof.

IN WITNESS &c.

*NOTE.*—Although dealing with a trust, this deed can and should be registered as an Assignment. Registration will not, however, refer to the trusts therein set forth (see Section 85 of the Patent Acts).

### Form 9.

*LICENCE (Non-Exclusive) in consideration of Royalties to be paid Half-yearly.*

An Indenture made the \_\_\_\_\_ day of \_\_\_\_\_, 19\_\_\_\_, BETWEEN HENRY DICKINSON, of No. 4 Saxby Street, Salford, in the County of Lancaster, Mill Mechanic (hereinafter called "the Licensor"), of the one part, and JONX BOOTH (trading as "Jacob Booth and Co."), of The Penelope Works, Burnley, in the same county, Manufacturer (hereinafter called "the Licensee"), of the other part.

WHEREAS the Licensor has obtained Letters Patent No. 393 of the 8th day of January, 1900, for a certain invention entitled "Improvements in Shuttle Tongues"; AND WHEREAS the Licensee has applied to obtain and the Licensor has agreed to grant the Licensee a licence to use the said invention in consideration of the royalties and upon the terms hereinafter set forth:



NOW THIS INDENTURE WITNESSETH that, in pursuance of the said Agreement, and in consideration of the royalties hereinafter reserved and the covenants on the part of the Licensee hereinafter contained, the Licensor doth hereby grant unto the Licensee full liberty, licence, power, and authority to make, use, exercise, and vend the said invention within the United Kingdom and the Isle of Man: TO HAVE, HOLD, EXERCISE, and ENJOY the said licence and premises unto and by the Licensee and his successors in business for and during all the residue now to come and unexpired of the term of fourteen years for which the said Letters Patent were granted: YIELDING AND PAYING unto the Licensor half-yearly, on the 30th day of June and the 31st day of December in each year, for every gross of shuttle tongues manufactured and sold by the Licensee in accordance with the said invention and Letters Patent, the sum of ten shillings as royalty: PROVIDED ALSO that the Licensee shall keep at his usual place of business all proper books of account, and will enter therein all particulars relating to the manufacture and sale by him of the said patent shuttle tongues, and will produce the said books to the Licensor or his authorised agent at all reasonable times for inspection and the taking of copies or extracts therefrom, and will at the end of each half-year aforesaid deliver or send to the Licensor a statement in writing of all essential particulars of the manufacture and sale during such half-year of the said patent shuttle tongues, together with a statement showing the amount of royalties payable to the Licensor, and shall, if required so to do, verify the said statement and particulars by statutory declaration. AND IT IS FURTHER PROVIDED that if the amount of royalties payable under this licence should for any continuous two years fall beneath the aggregate sum of £100, then the Licensor may terminate and withdraw this licence by giving three months' notice to that effect. FURTHER, if, as the result of proceedings at law or otherwise, the aforesaid Letters Patent should in the High Court or in any Court of Appeal be declared null and void, either wholly or in respect of their essential features, this licence shall therefrom cease and determine, and the Licensee shall be at liberty to manufacture the said shuttle tongues without the payment of royalty to the Licensor, notwithstanding that this licence is expressed to be for the full term of patent right. In the event of the Licensee wishing to terminate and withdraw from this licence, he may do

so by giving the Licensor three months' notice to that effect, and nothing in the licence mentioned shall operate as estoppel to prevent the Licensee, after his licence has determined, from challenging the validity of the patent, either as plaintiff or defendant, in any action at law commenced and prosecuted after the termination of this licence.

THE LICENSEE shall stamp all shuttle tongues manufactured by him in accordance with the said invention and Letters Patent or otherwise. The shuttles to which the tongues are applied shall be stamped with the words, "Dickenson's Patent," and also with the number of the patent.

LASTLY, the Licensor shall, during the continuance of this licence, pay the renewal fees necessary to keep the patent in force, and shall, if required, produce the certificate of payment fourteen days before the last day for such payment, or otherwise shall allow the Licensee to pay the said renewal fees, the amount thereof to be deducted from the royalties then or thereafter due to the Licensor.

IF THE LICENSEE should at any time fail to pay the royalties due to the Licensor within three weeks from the end of the half-year in respect of which such royalties are payable, the Licensor may thereupon by notice in writing revoke this licence without prejudice to his right of recovery of any moneys then due to him or to any right of action in respect of breaches of this licence.

IN WITNESS &c.

### Form 10.

*LICENCE (Exclusive, save in respect of Licensor) for a Single County at Rent and Royalties.*

An Indenture made the                      day of                      , 19                      ,  
BETWEEN GEORGE CHAMPTON, of the Tubal Brass Works, Tubal Lane, in the City of Manchester, Brass and Tin Worker (hereinafter called "the Licensor"), of the first part, and FREDERICK PERKINS, of No. 12 Grove Street, Bury, in the same county, Tinsmith (hereinafter called "the Licensee"), of the second part.

WHEREAS the Licensor claims to be the true and first inventor of and has obtained Her Majesty's Letters Patent No. 12,333 of 12th October, 1899, for an invention of "Improvements in Humidifying and Ventilating Apparatus": AND WHEREAS the Licensee has agreed to take, and the Licensor has agreed to grant, an exclusive but (except as hereinafter limited) non-assignable licence to the Licensee to make, use, exercise, and vend the said invention in accordance with the said patent at the rent and royalties and under the conditions hereinafter specified:

NOW THIS INDENTURE WITNESSETH that, in pursuance of the said agreement and conditions, and in consideration of the said rent and royalties reserved, the Licensor, as beneficial owner, hereby grants, and the Licensee agrees to accept, an exclusive licence upon the following terms:—

1. The licence hereby granted shall continue for the full term now to come and unexpired of the aforesaid patent rights, subject to the hereinafter contained conditions as to terminating the licence.

2. For each year during which the licence shall continue, dating from the date of this Indenture, the Licensee shall pay to the Licensor an annual rent of £50, payable in advance, the first payment of £50 being made at the signing of these presents and acknowledged by the Licensor to be so paid.

3. In addition to the said annual payment of £50, the Licensee shall pay to the Licensor for each humidifier manufactured by him during the continuance of this licence the sum of £1 as royalty, such payments to be made half-yearly. The first payment of royalties, if any should be due, shall be made fourteen days after the expiry of six months from the date of this Indenture, and thereafter half-yearly as provided.

4. The Licensee shall keep proper books of account at his usual place of business, and shall enter therein all particulars of humidifying and ventilating apparatus manufactured by him in accordance with the invention and patent, and shall allow the same to be inspected, and copies and extracts made thereof and therefrom, by the Licensor or his authorised agent at all reasonable times, and shall allow the Licensor or his authorised agent at all reasonable times to inspect his works if the Licensor should desire so to do.

The Licensee shall at the end of each half-year furnish true statements showing the number of humidifiers manufactured by him during the half-year then expired, and shall accompany the said statement by an account showing the amount of royalties due to be paid to the Licensor, and shall verify the said statements and accounts by statutory declaration if required so to do by the Licensor. All sums due as royalties from the Licensee to the Licensor shall be paid to the Licensor not less than fourteen days after the expiry of each half-year.

5. Although this Indenture is set forth as an exclusive licence, the Licensor reserves to himself the right to manufacture and sell humidifying apparatus in Lancashire under his patent as aforesaid, but at prices which shall not be lower than those quoted by the Licensee; and all humidifiers sold by the Licensor shall be strictly those of his own manufacture, made at his works in Tubal Lane as aforesaid, or in any other workshop to which he may hereafter remove, or in which he may carry on his business.

6. The Licensee will not during the continuance of this licence manufacture any humidifying apparatus except in accordance with the said invention, and will not, while the licence is in force, dispute the validity of the said Letters Patent, and will do all in his power to detect infringers and assist the Licensor in any proceedings at law or otherwise which the Licensor may institute to protect his patent rights and interests.

7. Each humidifier and ventilating apparatus manufactured and sold by the Licensee shall bear upon the casing, or upon some prominent part of the apparatus, a stamped brass plate, of not less than two inches in length by an inch and a quarter in breadth, bearing the words "Champion's Patent" and the numerals "No. 12,333<sup>99</sup>"; but to this the Licensee may add his name and address as maker. These brass plates will be consecutively numbered, and will be supplied at cost price by the Licensor to the Licensee, the latter binding himself to use only such brass plates as are supplied to him by the Licensor, and no others, and all humidifiers in accordance with the patent identified as having issued from the hands of the Licensee and not bearing a brass plate so supplied shall be chargeable with triple royalty, hereby agreed to represent liquidated damages suffered by the Licensor, unless a reasonable explanation is forthcoming.

8. The Licensor binds himself to maintain the patent in force during the continuance of this licence by the payment of the annual renewal fees, the certificate of each payment of the said renewal fees to be shown by the Licensor to the Licensee not less than fourteen days before the payment shall have become due; and if from any cause the Licensor shall omit or fail to pay any such renewal fee, the Licensee shall be at liberty to pay the same, together with any fine, if such should have been incurred, and shall charge the same against the Licensor, and deduct it from any moneys due to the Licensor at that time or thereafter in the hands of the Licensee.

9. If any rent, royalties, or other sums due from the Licensee to the Licensor should remain unpaid for one month after the time when they shall have become due, or if a breach of any of the conditions herein contained should be committed by the Licensee, the Licensor shall be at liberty to terminate this licence by giving two months' notice, and at the expiry of that time this licence shall cease and determine.

10. If the Letters Patent in respect of which this licence is granted shall, as the result of proceedings at law between the Licensor and third parties, or by revocation or otherwise, be finally declared void, either wholly or as to a material part thereof, then this licence shall forthwith cease and determine, and the Licensee shall be at liberty to manufacture and sell the invention without accounting to the Licensor for rent and royalties; and in any case, if at any time after the expiry of three years from the date hereof the Licensee should wish to terminate this licence, he may do so by giving six months' notice to that effect, whereupon this licence shall cease and determine.

11. The Licensee shall not be at liberty to sell or assign this licence, during its continuance, to another or to others; but in the event of the death or withdrawal from business of the Licensee, this licence shall continue to his representatives and successors in business upon the terms and under the conditions hereinbefore set forth as enjoyed by and binding upon the Licensee himself.

IN WITNESS &c.

NOTE.-- *This licence should be entered in the Register of Patents.*

**Form 11.***Notice by Licensor to Terminate Licence.**(Address and date.)*

IN ACCORDANCE with the power given me under Clause of the Licence dated the            day of           , 19   , granted by me to you in respect of Letters Patent No. 15,342 of 18th December, 1898, for "Improvements in Skates," I hereby give you notice that the said Licence shall, as and from the            day of            next, absolutely cease and determine.

*(Signature)*

To A. B., of

*NOTE.*—*An intimation of this withdrawal should be sent to the Comptroller-General of Patents.*

**Form 12.***Mortgage of a Patent.*

**An Indenture** made the            day of           , 19   . BETWEEN SIDNEY SMITH, of The Hollies, Cleworth Street, Barnstaple, in the County of Devon, Hat Manufacturer (hereinafter called "the Mortgagor"), of the one part, and WALTER PYM, of Newport, Barnstaple aforesaid, Gentleman (hereinafter called "the Mortgagee"), of the other part.

WHEREAS the Mortgagor has obtained His Majesty's Letters Patent No. 1236, dated 24th February, 1901, for an invention entitled "An Improved Filter"; AND, WHEREAS the Mortgagor has applied to the Mortgagee for a loan of £500, to be secured, together with interest thereon, by a mortgage of the said invention and Letters Patent as hereinafter expressed:

NOW THIS INDENTURE WITNESSETH that, in consideration of the said sum of £500 this day paid by the Mortgagee to the Mortgagor (the receipt whereof is hereby acknowledged), the Mortgagor doth hereby covenant with the Mortgagee that he (the Mortgagor) will pay to the Mortgagee, on the            day of            next, the sum of £500, together with interest thereon at the rate of six per cent. per annum.

AND THIS INDENTURE ALSO WITNESSETH that, for the consideration aforesaid, the Mortgagor, as beneficial owner, doth hereby assign unto the Mortgagee all those the said invention and Letters Patent and the sole and exclusive benefit thereof, to hold the said invention, Letters Patent, and premises unto the Mortgagee and his assigns, subject to the proviso for redemption hereinafter contained. PROVIDED ALWAYS that if the Mortgagor shall pay to the Mortgagee the sum of £500, with interest for the same in the meantime at the rate of six per cent. per annum, on the said            day of            next, then the Mortgagee will at any time thereafter, at the request and cost of the Mortgagor, re-assign to him the said Letters Patent and premises; but otherwise if the said sum of £500 or any part thereof shall remain unpaid after the said            day of            next, he the Mortgagor shall pay to the Mortgagee, so long as the said sum or any part thereof shall remain unpaid, interest on the said sum or unpaid part thereof at the rate of six per cent. per annum by equal half-yearly payments on the            day of            and the            day of            . PROVIDED ALSO that if the said Mortgagor shall at the said period, or within fourteen days thereafter, make payment to the Mortgagee of the said interest, and shall perform and observe all the covenants and conditions herein contained and on his part to be performed and observed, then the Mortgagee will not call in the said sum of £500 or any unpaid portion thereof until the            day of            , 19   . PROVIDED ALSO that in such case provided, the Mortgagor shall not before the said            day of            , 19   , compel the Mortgagee to receive the said sum of £500 or the unpaid portion thereof.

AND THE MORTGAGOR doth hereby covenant with the Mortgagee that the said Letters Patent are now valid and subsisting and not void or voidable, and that the Mortgagor will during the continuance of this security pay all fees necessary for the renewal and maintenance of the said Letters Patent at least one month before the day when such renewal fees shall become due, and shall forthwith send or deliver to the Mortgagee the receipt for every such payment; and if the Mortgagor should fail to pay such renewal fee, then the Mortgagee may, if he think fit, himself make payment of the fee, and the amount, together with the expenses,

fine, or other charges, will remain on the security hereof as further moneys advanced. PROVIDED ALSO that until the Mortgagee shall become entitled to exercise the power of sale to be implied herein, the Mortgagor shall be at liberty to use and work the said invention without interference from the Mortgagee, and may also, in the joint names of himself and the Mortgagee, grant licences to make, use, exercise, and vend the same.

LASTLY, it is hereby declared that, except when the context requires a different interpretation, each of the expressions "Mortgagor" and "Mortgagee" shall, wherever used herein, be also applicable, as far as possible, to the assigns of the parties thereby designated.

IN WITNESS &c.

*NOTE.—This Mortgage should be registered.*

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## APPENDIX C.

EXTRACT FROM THE PARTNERSHIP  
LAW AMENDMENT ACT, 1865.

(28 &amp; 29 VICTORIA, CHAPTER 86.)

1. The advance of money by way of loan to a person engaged or about to engage in any trade or undertaking upon a contract in writing with such person that the lender shall receive a rate of interest varying with the profits, or shall receive a share of the profits arising from carrying on such trade or undertaking, shall not, of itself, constitute the lender a partner with the person or the persons carrying on such trade or undertaking, or render him responsible as such.

The advance of money on contract to receive a share of profit not to constitute the lender a partner.

\* \* \* \* \*

5. In the event of any such trader as aforesaid being adjudged a bankrupt, or taking the benefit of any Act for the relief of insolvent debtors, or entering into an arrangement to pay his creditors less than twenty shillings in the pound, or dying in insolvent circumstances, the lender of any such loan as aforesaid shall not be entitled to recover any portion of his principal, or of the profits or interest payable in respect of such loan. . . .

In case of bankruptcy &c. lender not to rank with other creditors.

## APPENDIX D.

EXTRACTS FROM THE CONVEYANCING AND LAW OF  
PROPERTY ACT, 1881.<sup>1</sup>

(44 &amp; 45 VICTORIA, CHAPTER 41.)

*Covenants for Title.*Covenants  
for title to  
be implied.

7. (1) In a conveyance there shall, in the several cases in this section mentioned, be deemed to be included, and there shall in those several cases, by virtue of this Act, be implied, a covenant to the effect in this section stated, by the person or by each person who conveys, as far as regards the subject-matter or share of subject-matter expressed to be conveyed by him, with the person, if one, to whom the conveyance is made, or with the persons jointly, if more than one, to whom the conveyance is made as joint tenants, or with each of the persons, if more than one, to whom the conveyance is made as tenants in common: that is to say—

On convey-  
ance for  
value by  
beneficial  
owner.

(a) In a conveyance for valuable consideration, other than a mortgage, the following covenant by a person who conveys and is expressed to convey **as beneficial owner**: namely—

Right to  
convey.

That, notwithstanding anything by the person who so conveys, or any one through whom he derives title, otherwise than by purchase for value, made, done, executed, or omitted, or knowingly suffered, the person who so conveys, has, with the concurrence of every other person, if any, conveying by his direction, **full power to convey the subject-matter expressed to be conveyed**, subject as, if so expressed, and in the manner in which, it is expressed to be conveyed, and

<sup>1</sup> This Act does not extend to Scotland.

that, notwithstanding anything as aforesaid, that subject-matter shall remain to and be quietly entered upon, received, and held, occupied, enjoyed, and taken, by the person to whom the conveyance is expressed to be made, and any person deriving title under him, and the benefit thereof shall be received and taken accordingly, without any lawful interruption or disturbance by the person who so conveys or any person conveying by his direction, or rightfully claiming, or to claim by, through, under, or in trust for the person who so conveys, or any person conveying by his direction, or by, through, or under any one not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made, through whom the person who so conveys derives title, otherwise than by purchase for value; and that, freed and discharged from, or otherwise by the person who so conveys sufficiently indemnified against, all such estates, incumbrances, claims, and demands other than those subject to which the conveyance is expressly made, as either before or after the date of the conveyance have been or shall be made, occasioned, or suffered by that person or by any person conveying by his direction, or by any person rightfully claiming by, through, under, or in trust for the person who so conveys, or by, through, or under any person conveying by his direction, or by, through, or under any one through whom the person who so conveys derives title, otherwise than by purchase for value; and further, that the person who so conveys, and any person conveying by his direction, and every other person having or rightfully claiming any estate or interest in the subject-matter of conveyance, other than an estate or interest subject whereto the conveyance is expressly made, by, through, under, or in trust for the person who so conveys, or by, through, or under any person conveying by his direction, or by, through, or under any one through whom the person who so conveys derives title,

Quiet enjoyment.

Freedom from incumbrance.

Further assurance.

otherwise than by purchase for value, will, from time to time, and at all times after the date of the conveyance, on the request and at the cost of any person to whom the conveyance is expressed to be made, or of any person deriving title under him, execute and do all such lawful assurances and things for further or more perfectly assuring the subject-matter of the conveyance to the person to whom the conveyance is made, and to those deriving title under him, subject as, if so expressed, and in the manner in which the conveyance is expressed to be made, as by him or them or any of them shall be reasonably required:

On mortgage, by beneficial owner.

Right to convey.

Quiet enjoyment.

(c) In a conveyance by way of mortgage, the following covenant by a person who conveys and is expressed to convey **as beneficial owner**: namely—

That the person who so conveys has, with the concurrence of every other person, if any, conveying by his direction, full power to convey the subject-matter expressed to be conveyed by him, subject as, if so expressed, and in the manner in which it is expressed to be conveyed; and also that, if default is made in payment of the money intended to be secured by the conveyance, or any interest thereon, or any part of that money or interest, contrary to any provision in the conveyance, it shall be lawful for the person to whom the conveyance is expressed to be made, and the persons deriving title under him, to enter into and upon, or receive, and thenceforth quietly hold, occupy, and enjoy or take and have, the subject-matter expressed to be conveyed, or any part thereof, without any lawful interruption or disturbance by the person who so conveys, or any person conveying by his direction, or any other person not being a person claiming in respect of an estate or interest subject whereto the conveyance is expressly made; and that, freed and discharged from, or otherwise by the person who so conveys sufficiently indemnified against, all estates, incumbrances, claims, and demands whatever, other than those subject whereto the conveyance is expressly made; and further, that the person who so conveys and every

Freedom from incumbrance.

Further assurance.

person conveying by his direction, and every person deriving title under any of them, and every other person having or rightfully claiming any estate or interest in the subject-matter of conveyance, or any part thereof, other than an estate or interest subject whereto the conveyance is expressly made, will from time to time and at all times, on the request of any person to whom the conveyance is expressed to be made, or of any person deriving title under him, but, as long as any right of redemption exists under the conveyance, at the cost of the person so conveying, or of those deriving title under him, and afterwards at the cost of the person making the request, execute and do all such lawful assurances and things for further or more perfectly assuring the subject-matter of conveyance and every part thereof to the person to whom the conveyance is made, and to those deriving title under him, subject as, if so expressed, and in the manner in which the conveyance is expressed to be made as by him or them or any of them shall be reasonably required:

- (f) In any conveyance the following covenant by every person who conveys and is expressed to convey **as trustee or mortgagee**, or as personal representative of a deceased person, or as committee of a lunatic so found by inquisition, or under an order of the Court, which covenant shall be deemed to extend to every such person's own acts only: namely--

On conveyance by trustee or mortgagee.

That the person so conveying has not executed or done, or knowingly suffered, or been party or privy to any deed or thing, whereby or by means whereof the subject-matter of the conveyance, or any part thereof, is or may be impeached, charged, affected, or incumbered in title, estate, or otherwise, or whereby or by means whereof the person who so conveys is in anywise hindered from conveying the subject-matter of the conveyance, or any part thereof, in the manner in which it is expressed to be conveyed.

Assurance against incumbrances.

(2) Where in a conveyance it is expressed that by direction of a person expressed to direct **as beneficial**

**owner** another person conveys, then, within this section, the person giving the direction, whether he conveys and is expressed to convey as beneficial owner or not, shall be deemed to convey and to be expressed to convey as beneficial owner the subject-matter so conveyed by his direction; and a covenant on his part shall be implied accordingly.

(4) Where in a conveyance a person conveying is **not expressed to convey as beneficial owner**, or as settlor, or as trustee, or as mortgagee, or as personal representative of a deceased person, or as committee of a lunatic so found by inquisition, or under an order of the Court, or by direction of a person as beneficial owner, **no covenant on the part of the person conveying shall be, by virtue of this section, implied in the conveyance.**

(6) The benefit of a covenant implied as aforesaid shall be annexed and incident to, and shall go with, the estate or interest of the implied covenantee, and shall be capable of being enforced by every person in whom that estate or interest is, for the whole or any part thereof, from time to time vested.

(7) A covenant implied as aforesaid may be varied or extended by deed, and, as so varied or extended, shall, as far as may be, operate in the like manner, and with all the like incidents, effects, and consequences as if such variations or extensions were directed in this section to be implied.

Covenants  
to extend  
to heirs &c.

**59.** (1) A covenant and a contract under seal, and a bond or obligation under seal, though not expressed to bind the heirs, shall operate in law to bind the heirs and real estate, as well as the executors and administrators and personal estate, of the person making the same, as if heirs were expressed.

(2) This section extends to a covenant implied by virtue of this Act.

Effect of  
covenant  
with two or  
more  
jointly.

**60.** (1) A covenant and a contract under seal, and a bond or obligation under seal, made with two or more jointly to pay money or to make a conveyance, or to do any other act to them or for their benefit, shall be deemed to include, and shall, by virtue of this Act, imply an obligation to do the act to or for the benefit of the survivor or survivors of them, and to or for the benefit of any other person to whom the right to sue on the covenant, contract, bond, or obligation devolves.

## APPENDIX E.

## THE STAMP MEDICINES ACT, 1812.

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**A**CCORDING to this Act, where any person prepares and sells medicaments for inward or outward use, alleged to be compounded from some secret recipe, or claims to have an exclusive right or title to the making or preparing of the same, or where such medicaments are exposed for sale under the authority of any Letters Patent, the packet, box, or bottle must bear a Government stamp applied in such a way that the contents cannot be reached without tearing the stamped label or cover. Penalty for non-observance £10 for each offence. (See remarks on "Patent Medicines," page 188. *ante*.)

## APPENDIX F.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS,  
1883 to 1901 (Consolidated).

*The Acts contain 117 Sections with Schedules, and the respective Sections are to the following effect:--*

## PART I. PRELIMINARY.

## Section

1. Short title.
2. Division of Acts into parts. Preliminary; Patents; Designs; Trade Marks; General.
3. Commencement of Act.

## PART II.—PATENTS.

*Application for and Grant of Patent.*

4. Persons entitled to apply for patent. Joint Patentees; Statutory Declarations.
5. Application and specification. Drawings.
6. Reference of application to Examiner.
7. Power of Comptroller to refuse application or require amendment.
8. Time for leaving Complete Specification.
9. Comparison of Provisional and Complete Specifications.
10. Advertisement on acceptance of Complete Specification.
11. Opposition to grant of patent.
12. Sealing of patent. Extension of time.
13. Date of patent. Publication of specification.

*Provisional Protection.*

14. Provisional protection. Invention may be used during provisional term.

*Protection by Complete Specification.*

15. Effect of acceptance of Complete Specification.

*Patent.*

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

*Amendment of Specification.*

18. Amendment of specification.
19. Power to disclaim part of invention during action &c.
20. Restriction on recovery of damages.
21. Advertisement of amendment.



PART II. PATENTS (*continued*).*Compulsory Licences.*

## Section

22. Power of Board of Trade to order grant of licences.

*Registry of Patents.*

23. Register of patents.

*Fees.*

24. Fees in schedule.

*Extension of Term of Patent.*

25. Extension of term of patent on petition to King 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.

32. Remedy in case of groundless threats of legal proceedings.

*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 afterwards acquired.

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.

*Existing Patents.*

45. Provisions respecting existing patents.

*Definitions.*

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

## PART III. DESIGNS.

*Registration of Designs.*

## Section

- 47. Application for registration of designs.
- 48. Drawings &c. to be furnished on application.
- 49. Certificate of registration.

*Copyright in Registered Designs.*

- 50. Copyright on registration.
- 51. Marking registered designs.
- 52. Inspection of registered designs.
- 53. Information as to existence of copyright.
- 54. Cesser of copyright in certain events.

*Register of Designs.*

- 55. Register of Designs.

*Fees.*

- 56. Fees on registration &c.

*Industrial and International Exhibitions.*

- 57. Exhibition at Industrial or International Exhibition not to prevent or invalidate registration.

*Legal Proceedings.*

- 58. Penalty on piracy of registered design.
- 59. Action for damages.

*Definitions.*

- 60. Definition of "design," "copyright."
- 61. Definition of "proprietor."

## PART IV.—TRADE MARKS.

*Registration of Trade Marks.*

- 62. Application for registration.
- 63. Limit of time for proceeding with application.
- 64. Conditions of registration of trade mark. Essential features of trade marks.
- 65. Connection of trade mark with goods.
- 66. Registration of a series of marks.
- 67. Trade marks may be registered in any colour.
- 68. Advertisement of application.
- 69. Opposition to registration.

PART IV. TRADE MARKS (*continued*).

## Section

- 70. Assignment and transmission of trade mark.
- 71. Conflicting claims to registration.
- 72. Restrictions on registration.
- 73. Further restriction on registration.
- 74. Saving for power to provide for entry on Register of common marks as additions to trade marks.

*Effect of Registration.*

- 75. Registration equivalent to public use.
- 76. Right of first proprietor to exclusive use of trade mark.
- 77. Restrictions on actions for infringement, and in defence to action in certain cases.
- 77A. Certificate as to exclusive use and costs thereon.

*Register of Trade Marks.*

- 78. Register of Trade Marks.
- 79. Removal of trade mark after fourteen years unless fee paid.

*Fees.*

- 80. Fees for registration &c.

*Sheffield Marks.*

- 81. Registration by Cutlers' Company of Sheffield marks.

## PART V. GENERAL.

*Patent Office and Proceedings thereat.*

- 82. Patent Office.
- 83. Officers and clerks.
- 84. Seal of Patent Office.
- 85. Trusts not to be entered in Registers.
- 86. Refusal to grant patent &c. in certain cases.
- 87. Entry of assignments and transmissions in Registers.
- 88. Inspection of and extracts from Registers.
- 89. Sealed and certified copies to be received in evidence.
- 90. Rectification of Registers by Court.
- 91. Power for Comptroller to correct clerical errors.
- 92. Alteration of registered mark.
- 93. Falsification of entries in Registers.
- 94. Exercise of discretionary power by Comptroller.
- 95. Power of Comptroller to take directions of Law Officers.
- 96. Certificate of Comptroller to be evidence.
- 97. Applications and notices by post.
- 98. Provision as to days for leaving documents.

PART V. - GENERAL. (*continued*).

## Section

- 99. Declaration by infant, lunatic, &c.
- 100. Transmission of certified printed copies of specifications &c.
- 101. Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.
- 102. Annual reports of Comptroller.
- 102A. Proceedings of Board of Trade.

*International and Colonial Arrangements.*

- 103. International arrangements for protection of inventions, designs, and trade marks.
- 104. Provisions for colonies and India.

*Offences.*

- 105. Penalty on falsely representing articles to be patented &c.
- 106. Penalty on unauthorised assumption of Royal Arms.

*Scotland, Ireland, &c.*

- 107. Saving for Courts in Scotland.
- 108. Summary proceedings in Scotland.
- 109. Proceedings for revocation of patent in Scotland (action of reduction).
- 110. Reservation of remedies in Ireland.
- 111. General saving for jurisdiction of Courts.
- 112. Isle of Man.
- 112A. Jurisdiction of Lancaster Palatine Court.

*Repeal; Transitional Provisions; Savings.*

- 113. Repeal and saving for past operation of repealed enactments &c.
- 114. Former Registers to be deemed continued.
- 115. Saving for existing rules.
- 116. Saving of Crown prerogative.

*General Definitions.*

- 117. General Definitions.

*Register of Patent Agents.*

- 118. Register of Patent Agents.

THE FIRST SCHEDULE.--Forms of Application &c.

THE SECOND SCHEDULE.--Fees on instruments for obtaining patents, and renewal.

THE THIRD SCHEDULE.--Enactments repealed.