

CHAPTER XVI.

AMENDMENT OF SPECIFICATION.

Amend-
ments
before
sealing at
instance of
Comptroller.

THE Provisional Specification might be required to be amended by the Comptroller prior to acceptance under Section 7 of the Act of 1883, and the Complete Specification might similarly be required to be amended under Section 9 of the same Act or under Section 1 of the Act of 1902. The former amendments are rather of the nature of supervisory directions by the Comptroller in the event of the invention not being fairly described, or the title being incorrect, or the drawings inadequate, or the Complete differing from the Provisional Specification—all as set forth in the said Sections 7 and 9. The latter amendments, under Section 1 of the Act of 1902, are those which may be required as a result of examination. If the applicant differs from the Comptroller upon the advisability of these corrections or amendments he may appeal to the Law Officer, whose decision is final. Amendments in the specification might also result from opposition to the grant, as set forth in Chapter XIV.

Amend-
ment by
patentee.

But what is intended to be dealt with in this chapter is the amendment of the specification upon the initiative of the patentee himself.

Reasons
for amend-
ment.

For example, it often happens that after the Complete Specification has been filed, or after the patent has been granted, the applicant or patentee finds that he has claimed something which turns out to be old, or that in some other respect his specification requires amendment.

Section 18,
Sub-
section 1.

Provision for such amendment has been made in Section 18, Sub-section 1, of the Patent Act:—

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

The words in italics show the limits within which amendments must be confined. The amendment may consist of striking out, correcting, or making clear, but it must not in the slightest degree increase the scope of the patent.

Limits of amendment.

The most usual cases of amendment are those in which the patentee has made his original claim too wide; but there are also instances where the amendment may be only of the nature of correction or explanation.

Claim too wide.

In several instances mistakes in the drawings have been allowed to be amended without altering a word in the specification, as, for example, in the case of *re Abel's Patent* (*Lawson on Patents*, 3rd ed., p. 73), the specification of which was found faulty in respect of the drawings during the trial in *Otto v. Linford* ([1881] 46 L. T. N. S. 35), the defects being afterwards corrected by the filing of new drawings. New drawings may also be added to define the amendment (*per Clarke, S.-G.*, in *re Lang's Patent*, [1890] 7 R. P. C. 469; *Good. O. C.* 1st Appendix 17).

Amendment of drawings.

The persons entitled to amend are the applicant or patentee, the term "patentee" meaning (*per Section 46*) the person for the time being entitled to the benefit of the patent. Thus, an assignee may amend, and where a patentee has assigned part of his patent the part-assignee should join with him in amending. Where a patent has been mortgaged the mortgagee should join with the beneficial owner in amending (*re Church's Patents*, [1886] 3 R. P. C. 95). A mortgagee alone could not amend.

Persons entitled to amend.

The expression "from time to time" in Section 18 imports that a specification may be amended and re-amended more than once. But repeated disclaimers are not encouraged, and if the matter goes to the Law Officer on appeal the successful applicant to amend may be refused costs (*re Haldan's Patent*, *Good. O. C.* 62; *Griff. A. P. C.* 12).

Specification may be amended more than once.

The nature of such amendments as are permissible under Section 18 cannot be set down in general terms; but in all cases they must, in accordance with the Statute, only cut down and explain and never add to the scope of the patent. But a description originally insufficient cannot generally be

Nature of amendments.

Insufficient description.

Amendment must not extend patent.

made sufficient (*Johnson's Patent*, [1896] 13 R. P. C. 659), especially where the patent is old or where the amendment introduces subsequent knowledge. The scope of a specification cannot be extended to cover apparatus subsequently brought into use. Thus it was not allowed to extend the application of a steam escape nozzle to a gas engine exhaust (*Beck and Justice's Patent*, Good. O. C. 72; Griff. A. P. C. 10). Where it is clear that a patentee has not prepared his original specification in good faith and with reasonable skill and knowledge, in many cases he cannot, under colour of an amendment, retrieve his shortcomings (*Nordenfelt's Patent*, Good. O. C. 70; Griff. A. P. C. 18); but in *Morgan's Patent* (Good. O. C. 70; Griff. A. P. C. 17) the patentees were allowed to correct a misdescription, and describe more fully a figure of the drawings which had before been insufficiently described. A general claim having been originally made, no amendment which strikes out the general claim and substitutes claims for subordinate parts will be allowed. When a patentee has described and claimed an improved method of manufacture without indicating particular means or machinery, no amendment introducing and claiming particular means or machinery will be allowed (*Nairn's Patent*, [1891] S R. P. C. 444; *Lany's Patent*, [1890] 7 R. P. C. 471).

General claim cannot usually be altered to claims for subordinate parts.

Ambiguous claim may sometimes be corrected.

Clear error may be amended.

When the specification and drawings are clear, but the claim has been drawn in such a manner as to be ambiguous, the claim may be amended so long as the amendment is clearly of a restrictive nature (*Ashworth's Patent*, Good. O. C. 66; Griff. A. P. C. 6). It is evident from the remarks of Webster, A.-G., in *Johnson's Patent* ([1896] 13 R. P. C. 659), that a manifest error made by a British agent in translating or describing a foreign principal's invention may be cured by amendment.

Error in claim.

Where a feature in a claim is apparently set forth as an essential, whereas evidence adduced shows that it could not have been so meant, the defect might be cured by amendment (see *Moser v. Marsden*, [1895] 13 R. P. C. 24).

Claim for combination cannot be made claim for details.

General claims for subordinate features cannot be turned into one claim for a combination; nor can a claim for one feature be enlarged by the addition of another feature so

as to make it a combination claim including both, especially where the proposed addition has not been claimed or has previously been disclaimed (*Hattersley and Jackson's Patent*, [1904] 21 R. P. C. 233). The Law Officer in this case expressed an opinion which does not seem unfavourable to the contention that in certain circumstances separate claims might by amendment be consolidated into one combination claim. *Kelly v. Heathman* ([1890] 7 R. P. C. 343), was quoted as an example. A claim for a combination cannot be altered to a claim for details described in the specification (*Serrell's Patent*, [1889] 6 R. P. C. 103).

An opponent to an amendment cannot obtain a special reference to his patent in the applicant's specification (*Hampton and Facer's Patent*, Good. O. C. 71; Griff. A. P. C. 13). In the same case it was held that the applicant may not impute disadvantages to a method of manufacture of the kind described and claimed by the opponent; and further, that if the applicant accepts the Comptroller's decision he cannot advance further evidence before the Law Officer.

No special reference to opponent's patent.

An application to amend a patent which is nearing its expiration is more narrowly scrutinised than amendments of less mature patents (*Johnson's Patent*, [1896] 13 R. P. C. 659).

Old patents more difficult to amend.

Before the decision of the House of Lords in *Moser v. Marsden* ([1895] 13 R. P. C. 24), to the effect that an amendment once granted by the Patent Office cannot afterwards be contested in a subsequently tried action for infringement, except on the ground of fraud, the Law Officer, in case of doubt, was accustomed to incline in favour of the patentee. Now, however, that *Moser v. Marsden* has established that the propriety of an amendment cannot be questioned in after proceedings, the Comptroller or Law Officer is more strict, and no doubt amendments which might have been accepted with some dubiety previous to this decision would not now be allowed. It has sometimes been contended that to get at the true meaning of an amended specification the text of the unamended specification might be referred to. In delivering judgment in *Moser v. Marsden* (*supra*), Lord Watson compared parts of the

Amendment once granted cannot be questioned except where fraud alleged.

Moser v. Marsden.

amended with the unamended specification, and from this it was argued in *Birmingham Pneumatic Tyre Co. v. Reliance Tyre Co.* ([1902] 19 R. P. C. 312) that it was legitimate to do so for the purpose of getting at the true meaning of the amended specification. But in *Hattersley v. Hodgson* ([1904] 21 R. P. C. 517) Collins, M. R., declined to allow any reference to the unamended specification, basing his ruling on the commercial contract case of *Inglis v. Buttery* (3 App. Cas. 552). Still it is by no means clear that the struck out parts of an amended specification may not for certain purposes be referred to (*per* Buckley, J., in *Klaber's Patents*, [1904] 22 R. P. C. 10).

Reasons for amendment.

Request to amend may be corrected.

Former practice in amending patents under old Act.

Power of Law Officer to impose conditions. Section 18, Sub-section 4.

The reasons given in the "request in writing" to amend must, of course, vary with circumstances. A discovery by the patentee that part of the claimed invention is old, or that the description is not perfectly clear, or that the new parts are not sufficiently differentiated from the old, forms usually the reason for amendment. But if the reason given in the request should turn out to be erroneous the request could be corrected without affecting the acceptance of the amendment. Any reason which gives colour to the deduction that lack of good faith or of reasonable skill and knowledge affected the preparation of the original specification and claims would, however, seriously prejudice the acceptance of the amendment.

After the present Act came into force, when applications to amend were made, it was held that in the case of all patents granted under the Act of 1852, as a general rule, a condition should be imposed that no action should be brought or other proceeding taken in respect of any infringement prior to 1st of January, 1884—the date when the new Act came into force. But as all patents under the old Act have now expired that condition no longer holds good.

As regards patents granted under the present Act, although apparently Sub-section 4 of Section 18 gives the Law Officer power to impose conditions in respect of amendments, and although according to Finlay, S.-G., in *Ainsworth's Patent* ([1895] 13 R. P. C. 76) and in *Allison's Patent* ([1898] 15 R. P. C. 408), the Law Officers recognise

that they have such power, and might under exceptional circumstances use it, nevertheless it was early held by Clarke, S.-G., in *Allen's Patent* (Good. O. C. 64; Griff. A. P. C. 3), that the Law Officer will not as a rule impose conditions, but will leave the Court to deal with the matter under Section 20 of the Act. This section provides that where an amendment by way of disclaimer, correction, or explanation has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, *unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.*

Section 20.

Power of Court to impose conditions in action for infringement.

There is practically no more difficulty in amending the specification of a patent which has been sealed than there is in amending a specification not yet sealed. In the former case the official fee is £3, and in the latter case £1 10s.

Fees on amendment.

The formalities to be complied with in making application for leave to amend may be briefly stated.

The request for leave to amend a specification must be signed by the applicant or patentee, and must contain an address for service in the United Kingdom. When not made in pursuance of an order of the Court or a Judge the request must, where a patent has been sealed, contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. This latter provision is new, and appears in Rule 42 of the Patents Rules, 1903, apparently to obviate such an accident as became apparent in *Brooks and Co. v. Lycett* ([1904] 21 R. P. C. 651), where a patent had been amended under the mistaken idea that the action had been discontinued, whereas it was still pending though asleep. The amendment thus obtained was held invalid.

Procedure in amending.

The amendment or amendments should be shown in red ink on an officially certified copy of the printed specification. If accepted by the Comptroller the request to amend is advertised in the *Official Patent Journal*, and generally in one or two newspapers. For example, if the

Advertisement.

patent relates to knitting machines the Comptroller might require the proposed amendment to be advertised in a district devoted to such an industry; for instance, in Leicester. If to cotton machinery it might be required to be advertised in Manchester. The heading of the advertisement invites opposition from anyone interested.

Persons entitled to oppose amendment.

Decision rests with Law Officer.

According to Section 18, Sub-section 2, "any person" may oppose the granting of the amendment, but practically to entitle an opponent to be heard he must be a person interested or who is threatened or aggrieved or prejudiced by the proposed amendment. His interest must be equivalent to the interest of a person entitled to be heard in opposition to the grant of a patent, and the Law Officer may decide finally whether or not he is entitled to be heard (*per* Smith, L. J., in *Reg. v. Comptroller, ex parte Tomlinson*, [1899] 16 R. P. C. 233; [1899] 1 Q. B. 909; 68 L. J. Q. B. 568). In *Bell's Patent* (Good. O. C. 13; Griff. A. P. C. 10) the opponents contended that the amendment would make the invention the same as that comprised in two prior patents in which the opponents had no interest. Here it was ruled that the opponents were not entitled to be heard on these grounds.

Limit of time for opposing.

Declarations by opponent and applicant.

The time within which opposition to an amendment will be entertained is one month from the date of the advertisement in the *Official Patent Journal*. The notice of opposition bears a stamp of ten shillings. It must contain the full name and address of the opponent, and state the reasons of opposition. The applicant is advised of the opposition by the Comptroller, and thereafter declarations are filed by the opponent in support of his opposition within fourteen days of the expiry of one month from the date of the advertisement. The proceedings and rules as to declarations are identical with those already described with reference to the opposition to the grant of a patent.

Decision.

The decision of the Comptroller is subject to an appeal to the Law Officer, whose decision is final.

Amendment during legal proceedings.

It now remains to consider the question of the amendment of a specification in respect of which legal proceedings are pending, such, for example, as an action for infringement or proceedings for revocation. The plaintiff patentee

sometimes finds on receipt of the defendant's defence and particulars of objections that there are defects in his patent which very greatly minimise his chances of success. His claim, for example, may be so wide as to trench upon the subject-matter of some prior user or prior patent which the defendant cites, or his attention may have been called to some question of disconformity. So he makes up his mind to disclaim the dangerous surplusage. But having submitted himself to the Court he cannot (unless he drops his action and pays the defendant's costs (*Brooks & Co. v. Lycett*, [1904] 21 R. P. C. 651) apply to the Comptroller to amend without getting leave from the Court. Provision for this is made in Section 19 of the Act, which runs as follows:—

Plaintiff wishing to amend must either drop action or obtain leave of Court.

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

Section 19.

The reader will note that the scope of the amendment is more limited than in Section 18. It is to be by way of *disclaimer* only.

By disclaimer only.

When the application is made in due form to the Court—say by summons at chambers—leave to disclaim will as a rule be granted if reasonably good cause is shown. The Judge might, however, in the exercise of his discretion (for example, if he thinks there is absolutely no invention left), refuse leave to apply (*Armstrong's Patent*, [1897] 14 R. P. C. 747; 77 L. T. N. S. 267). But leave is only granted upon conditions, and the Judge has full discretion as to what these conditions shall be. As the Court of Appeal will not interfere with the exercise of the Judge's discretion unless satisfied that injustice has

Leave usually granted.

Sometimes refused.

Conditions within discretion of Court.

Conditions vary in accordance with circumstances.

been done (*Woolley v. Broad*, [1892] 9 R. P. C. 492; *Wilson Bros. v. Wilson & Co.*, [1899] 16 R. P. C. 315; *re Allison's Patent*, [1900] 17 R. P. C. 513) it is necessary to prosecute the application in the first instance with the greatest care. Affidavits of the patentee and others tending to show that reasonable skill and knowledge were exercised in preparing the original specification and claims should be filed. If the Court decides to grant leave to apply to amend, the conditions may be varied in accordance with the circumstances. For instance, in *Furze Vesta Co. v. Bryant & May* ([1887] 4 R. P. C. 71), where little had been done beyond the issue of the writ, it was ordered that the costs of the defendants up to and including the application for leave to amend and consequent upon the amendment should be paid by the plaintiffs in any event. But in *Haslam Foundry Co. v. Goodfellow* ([1887] 5 R. P. C. 28; L. R. 37 Ch. D. 118), where the pleadings had been closed and the action set down for trial before the application was made, the plaintiffs were ordered to pay in any event the costs of the application and the costs of and occasioned by the disclaimer, except so far as the proceedings in the action might be utilised for the purposes of the trial, other costs being reserved. Where application to amend has been made, there being at the time no action for infringement or petition for revocation pending, the application to amend may proceed without the leave of Court under Section 19, notwithstanding that an action for infringement or proceeding for revocation may subsequently have been commenced (*Woolfe v. Automatic Picture Gallery, Limited*, [1902] 19 R. P. C. 425). But an amendment obtained while an action or petition is effectively pending, although dormant, is invalid (*Brooks and Co. v. Lycett*, [1904] 21 R. P. C. 651).

Costs of amendment in action.

The costs in the Patent Office of obtaining or opposing the disclaimer will not be the subject-matter of direction by the Court (*Furze Vesta Co. v. Bryant & May, supra*) unless under exceptional circumstances (*Codd v. Bratby*, [1884] 1 R. P. C. 209). The costs "occasioned by the disclaimer"

do not include any costs which may be incurred by the defendant in opposing in the Patent Office the plaintiff's application to disclaim.

The order giving leave to apply to the Patent Office usually provides that the plaintiff and defendant shall be allowed to make the necessary amendments in their pleadings after disclaimer, and that the action should meanwhile be stayed (*Haslam Foundry Co. v. Goodfellow*, *supra*; followed by Byrne, J., in *Chatwood's Patent*, [1899] 16 R. P. C. 370).

Exceptional circumstances might, however, bring about the imposition of more severe conditions. For example, in *Deeley v. Perkes* ([1896] 13 R. P. C. 581) the House of Lords imposed the additional terms that the plaintiff should not bring or maintain any action for infringement in respect of anything done before the date of the hearing of the appeal. But the circumstances here were very exceptional. One claim only of the original five was proposed to be retained. The patent had been revoked for over a year, and large quantities of guns with the patented parts had been sent out by the defendants and by others in the trade. Kekewich, J., in *Luddington Cigarette Co. v. Baron Cigarette Co.* (*in re Pitt's Patent*, [1900] 17 R. P. C. 745), thought himself bound by the decision in *Deeley v. Perkes* to impose this condition as a common form; but the Court of Appeal, although upholding the order, emphatically repudiated any such idea. Lindley, M. R., said: "I protest altogether against the notion that the order in *Deeley v. Perkes* ought to be regarded as the laying down of a settled form." On appeal the House of Lords were of the same opinion. The exceptional circumstances in this case were, *inter alia*, that out of twenty-two claims twenty were disclaimed. Exceptional circumstances—viz., the dropping of nine claims out of fourteen, delay in seeking amendment, and other points prejudicial to the applicants—led to the imposition of similar conditions in *Allison's Patent* ([1900] 17 R. P. C. 513). In this case Webster, M. R., expressed a doubt whether, when the Court is seised of the matter (as in an action for infringement or petition for revocation), the Law Officers had any jurisdiction to deal with the question of conditions.

Plaintiff and defendant allowed to amend pleadings after disclaimer without leave.

Exceptional conditions sometimes imposed.
Deeley v. Perkes.

Luddington Cigarette Co. v. Baron Cigarette Co.

Lindley, M. R., on conditions of amendment.

Webster, M. R., doubts whether in amendments *pendente lite* Law Officers

have any jurisdiction as to conditions.

In considering the nature of the conditions to be imposed the Court will take into account the age of the patent, the amount of matter disclaimed (in the *Luddington Cigarette Case, supra*, twenty claims were dropped out of twenty-two), the character and cost of the patented article, and other incidental points.

In *Corrigall v. Armstrong Whitworth* ([1903] 20 R. P. C. 523) the plaintiff had been aware of the infringement for nine years, but had delayed taking action although he had carried on correspondence about it. Swinfen-Eady, J., gave leave to amend, but only on terms that no relief be given in the action for any infringements committed prior to the action.

Present practice as to terms.

The present general tendency of the Courts seems to be in favour of imposing terms in the bulk of cases that no action shall be brought or maintained for infringement of the patent in respect of any goods made prior to the date of the order (*Jandus Arc Lamp Co. v. Arc Lamp Co.*, [1904] 21 R. P. C. 115).

Damages very seldom given in respect of infringements before disclaimer.

Damages in respect of infringements committed prior to amendment are scarcely ever awarded, but such damages were given in *Hopkinson v. St. James Electric Light Co.* ([1892] 10 R. P. C. 46), where the invention was exceedingly meritorious and good faith was apparent in the original claim. The claim for such damages should be specially pleaded (*Kane v. Boyle*, [1901] 18 R. P. C. 325). Such damages are never given in cases where the patent has prior to amendment been declared invalid by the Court.

Proposed form of disclaimer not usually considered by Court.

The Court will not, as a rule, enquire into the particulars of the amendment, these being for the Comptroller or Law Officer to consider (*Re Dellwik's Patent*, [1896] 13 R. P. C. 591).

Order of Court giving leave to apply, left with request to amend.

In presenting the request to amend at the Patent Office a certified copy of the Order of the Court should be left with the request. The amendment will then be considered by the Comptroller, and a hearing given to the applicant. The Comptroller's decision is subject to appeal to the Law Officer. The defendant may appear in opposition, and may ask for the imposition of terms by the Comptroller;

Defendant may oppose.

but, as already said, the Patent Office authorities usually leave the defendant to his remedy under Section 20.

In *re Pitt's Patent* ([1901] 18 R. P. C. 478) the opponents, who were also the defendants in an action for infringement, asked the Law Officer to impose larger terms by extending the conditions laid down by the Court to the effect that no action might be brought or maintained in respect of infringements committed *prior to the date of the amendment*. But Carson, S.-G., following Clarke, S.-G., in *re Allen's Patent* (Good. O. C. 64), refused to impose terms in excess of those laid down by the Court.

Law Officer
will not im-
pose larger
conditions
than the
Court.

The Comptroller has no power to award costs in oppositions to amendments, but the Law Officer may give costs to the successful appellant or respondent.

Costs before
the
Comptroller
and Law
Officer.

CHAPTER XVII.

ACTION FOR INFRINGEMENT.

Infringe-
ment.

DURING the fourteen years' term of patent right the privilege of making, using, exercising, and vending the invention is limited to the owner of the patent and his representatives. Any person making or dealing with the patented article in an unauthorised manner is an infringer. Importation from abroad is an offence (*British Motor Syndicate v. Taylor*, [1900] 17 R. P. C. 723), even if the infringing articles are immediately re-exported. But an English merchant who, in pursuance of a contract made in England, delivers a patented article at a foreign port to an English importer does not infringe, seeing there is no actual making, using, exercising, or vending of the invention within the realm (*Saccharin Corporation v. Reitmeyer*, [1900] 17 R. P. C. 606; [1900] 2 Ch. 659). If a person makes a sample of the patented thing merely experimentally he does not infringe, but if he sells it or uses it for profit the case is otherwise (*per* Jessel, M. R., in *Frearson v. Loe*, [1878] L. R. 9 Ch. D. 48; 26 W. R. 138). But the very slightest real use of such an experimental manufacture would constitute infringement.

Importation
is infringe-
ment.

But not
where con-
tract though
made in
England is
executed
abroad.

Experiment
not in-
fringement.

Mere user is
infringer.

A person who merely uses something which is an infringement is liable as an infringer, and it does not matter whether he is an innocent user or not.

User in
foreign
vessel.

Necessary use of an infringing article in a foreign vessel touching at a British port is not an infringement unless the vessel is under the flag of a Foreign State which denies corresponding privileges to British vessels (Patent Act, Section 43).

Sale or
offering for
sale is in-
fringement.

Sale of the infringing article is an offence, and, as in the case of user, the ignorance of the seller is no excuse. Even the mere offering for sale, although no sale is effected, constitutes infringement (*Incandescent Co. v. New Incandescent Co.*, [1898] 15 R. P. C. 81; *British Motor Syndicate v. Taylor*, [1900] 17 R. P. C. 723), in respect of which an

injunction can be obtained. According to a dictum of Lord Alverstone in the latter case, mere possession with a view to sale is infringement.

Advertising an infringing article justifies an action to restrain infringement. Jessel, M. R., in *Prearson v. Loe* (*supra*), laid down that "if a patentee has reasonable ground to apprehend that a man will infringe his right he can come to the Court and obtain an injunction to restrain him from carrying out his intention" (quoted and approved in *Dowling v. Billington*, [1890] 7 R. P. C. 191). Even where the infringement has been slight, say to the extent of one article only, and has been discontinued, an injunction has been granted. As was said by Cotton, L. J., in *Proctor v. Bailey*, [1889] 6 R. P. C. 538: "When a patent is infringed the patentee has a *prima facie* case for an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so." Again, if there has not been any infringement but an intention to infringe has been shown, an injunction will be granted.

Unauthorised advertising is ground for injunction.

But the Court will not countenance harsh proceedings, or proceedings maintained vindictively or obviously to make costs. Therefore where full submission has been made, and it is manifest the defendant has no intention of continuing the infringement — where, in short, the defendant has offered all the plaintiff is entitled to — no injunction will be granted, and the defendant may get costs from the date of his offer (*Proctor v. Bailey, supra*; *Jenkins v. Hope*, [1895] 13 R. P. C. 57).

Harsh proceedings not encouraged.

The sale of a component part (not *per se* protected) of a patented combination, even where the vendor knows that the purchaser intends to use the article for the purpose of infringing the patent, is not an infringement by the vendor of the part (*Sirdar Rubber Co. v. Wallington*, [1905] W. N. 37; *Dunlop Pneumatic Tyre Co. v. Moseley & Sons*, [1904] 21 R. P. C. 274; *Townsend v. Haworth*, [1875] 12 Ch. D. 831 *n.* followed). But a vendor selling all the component parts of a patented combination ready to be put together would apparently infringe (*per Pearson, J.*, in *United Telephone Co. v. Dale*, [1883] 25 C. D. 778).

Infringement of part of combination.

Exhibition
without in-
tent to sell.

Merely showing a machine carrying the patented invention, at an exhibition, without the intention of selling, is an offence (*Dunlop v. British Car Co.*, [1901] 18 R. P. C. 313).

Repair of
patented
invention.

A patented article may be repaired by its purchaser so long as no renewal of the essential parts of the invention is effected. In *Dunlop Co. v. Neal* ([1899] 16 R. P. C. 247; [1899] 1 Ch. 807; 80 L. T. 746), the defendant was held to have infringed because he had fitted a fresh cycle tyre cover to the old inextensible wire rings, the patent being for the combination (see also *Dunlop v. Excelsior Rubber Co.*, [1901] 18 R. P. C. 209, and *Dunlop v. Holborn Tyre Co.*, [1901] 18 R. P. C. 222). But where the defendant had fitted a rubber tyre to a rim the section of which was patented, and which rim had been supplied by the plaintiffs, no infringement was held (*Sirdar Rubber Co. v. Wallington*, [1905] W. N. 37).

Implied
licence by
authorised
seller.

When a patented article has been sold by anyone who does so lawfully, an implied licence attaches to all subsequent sales and resales (*Thomas v. Hunt*, [1864] 17 C. B. N. S. 183). But a patented apparatus taken under a distress from a personal licensee cannot be used without a fresh licence (*British Mutoscope Co. v. Homer*, [1901] 18 R. P. C. 177).

Infringe-
ment by
disregard of
conditions
of sale.

A patented article may be sold on a condition as to use or sale (*Incandescent Co. v. Brogden*, [1899] 16 R. P. C. 179). But such condition would be binding only on those to whose notice the condition had been brought when purchasing (*Incandescent Co. v. Cantelo*, [1895] 12 R. P. C. 272).

Infringe-
ment by
workman.

A workman who has infringed in disobedience to the express orders of his master is liable, and also renders his master liable, for infringement (*Betts v. De Vitre*, [1864-73] L. R. 3 Ch. 429, 442; 6 H. of L. 319; 34 L. J. Ch. 289, 291).

Indirect
infringe-
ment: use
of patent
materials
abroad in
making
imported
product.

In *Saccharin Corporation, Limited v. Anglo-Continental Works, Limited* ([1900] 17 R. P. C. 307; [1901] 1 Ch. 414), a material was imported into this country which had been manufactured abroad by the aid of constituents patented by the plaintiffs. The nature of the constituents was chemically changed by the process of manufacture, and the imported product was not the patented invention. The Court held that the defendants

were indirectly depriving the patentees of the benefit of their invention, and granted an injunction. Carriers who transport infringing articles into this country are liable to be restrained by injunction (*Washburn Manufacturing Co. v. Cunard Co.*, [1889] 6 R. P. C. 398), but mere custom house agents not having possession or control of the goods are not (*Nobel v. Jones*, [1882] 8 A. C. 5).

When the owner of a patent discovers that it is being infringed by manufacture, or use, or sale, or importation, or that the invention is otherwise being dealt with in a manner constituting infringement, he may seek his remedy by instituting an action for infringement. He must not threaten unless he means business. If he does he may find the tables turned by having an action brought against him by the threatened party under Section 32 of the Act. But before commencing proceedings a patentee should always make sure that he is upon firm ground. Therefore, if he has not done so before, let him get a careful search made among the patent and other records to see if in any respect his patent is anticipated wholly or in part. If anything should be found that causes him doubt, let him amend his specification as set forth in the last chapter. Having re-assured himself as well as he can as to the soundness of his patent, he may then, after reasonable negotiation with the infringer (*Lyon v. Mayor of Newcastle*, [1894] 11 R. P. C. 218), issue the writ. The action should by preference be entered on the Chancery side, as the machinery of the Chancery Courts is better fitted than that of the King's Bench Division for the trial of patent actions. The practice also in interlocutory proceedings in patent matters has been much better ascertained and crystallised into recognised precedents, which do not always hold good on the Common Law side. The Vice-Chancellor of the County Palatine of Lancaster has jurisdiction to try patent actions; but County Courts have no such power where the validity of the patent is in dispute (see Section 117, Sub-section 1, and *Reg. v. County Court Judge of Halifax*, [1891] 8 R. P. C. 338; 60 L. J. Q. B. 550).

The writ should be endorsed with a claim for—(1) An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's Patent No. of

Carriers.

Customs agents.

Action for infringement.

Threats.

Clearing for action.

Preliminary negotiations.

Chancery Division for patent actions.

Where the validity of the patent is in dispute, County Court no jurisdiction.

Endorsement of writ.

190 ; (2) Damages, or, in the alternative, an account of profits; (3) Delivery up or destruction of the infringing articles. It is not necessary to ask for costs; but if the plaintiff is in possession of a certificate that the validity of his patent has been questioned in a former action, costs as between solicitor and client should be claimed. If the defendant is neither a British subject nor in British dominions, leave may be obtained to serve him with notice of the writ, and Order XI., Rule 4, indicates the evidence which should be given in support of an application to serve such notice. In conjunction with this Rule the observations of Lords Macnaghten and Davey in *Chemische Fabrik v. Badische Anilin Fabrik* ([1904] 21 R. P. C. 539) as to the nature of such evidence should be carefully read. As to what may constitute domicile, where a Foreign corporation exhibited a car at the National Cycle Show in London, service of the writ upon the person in charge of the stand was held good (*Dunlop Co. v. Actien Gesellschaft &c.*, [1902] 19 R. P. C. 46).

Service
abroad.

Plaintiff.

Co-owner.

Licensee.

Assignee.

Joiner of
assignor.

As to the parties in the action, the plaintiff might be the patentee or the assignee or the mortgagor, either alone or joined with the mortgagee. Co-owners of a patent should join, but one co-owner alone may take action (*Sheehan v. Great Eastern Railway Co.*, [1880] Good. P. C. 425; *Day v. Davies*, [1904] 22 R. P. C. 34). A licensee, whether exclusive or general, cannot sue; neither can an exclusive agent for the sale of a patented article, although it has been said that an exclusive licensee may use the name of the patentee for this purpose (*Renard v. Levinstein*, [1864-5] 2 H. & M. 628; Good. P. C. 400). The assignee and trustee of a bankrupt patentee or legal owner may sue. If the plaintiff has acquired the patent from someone else, and if any of the infringements have taken place during the former proprietorship, it would be advisable to join the former owner as co-plaintiff. Apparently an assignee might sue alone for damages for infringements committed before the date of his assignment if he succeeds to the rights and property of his predecessor in title (*United Horse Nail Co. v. Stewart*, [1888] per Lord Macnaghten on p. 269 of 5 R. P. C.). But it would be wise to join the assignor.

When the plaintiff is an assignee it is not essential that his assignment should have been registered. Section 77 of the Act of 1883 differs from the corresponding section of the Act of 1852, under which *Chollett v. Hoffman* ([1857] 7 Ell. & B. 686) and *Hassall v. Wright* ([1870] L. R. 10 Eq. 509; Good. P. C. 229) were decided. *Ihlee v. Henshaw* ([1886] 3 R. P. C. 15) decided that a legal assignee may sue, although not on the Register. But a mere equitable assignee, for example, a person to whom the benefits of an invention provisionally protected had been assigned before the grant of the patent, cannot sue without joinder of the registered owner (*Bowden's Syndicate, Limited v. Herbert Smith & Co.*, [1904] 21 R. P. C. 438).

Unregis-
tered
assignee
may sue.

Equitable
assignee
may not.

The plaintiff cannot take action for infringement until the patent has been sealed and issued, and then only in respect of infringements committed after the acceptance and publication of the Complete Specification (see Section 13).

No action
till patent
sealed.

The defendant might be the person manufacturing the infringing goods or the user or seller. An importer into this country of goods patented here could be sued, even if a mere carrier (*Washburn Manufacturing Co. v. Cunard Co.*, [1889] 6 R. P. C. 398). A corporation, and also its servants, can be sued for infringement.

Defendant.

The defendant should enter an appearance within eight days. Until he does so no further steps can be taken in the action. If the case is of great urgency leave might be obtained to serve notice of motion with the writ, or an *ex parte* application might be made before appearance for an interlocutory injunction, but exceptionally good cause would require to be shown. After appearance of the defendant the plaintiff might apply for an interlocutory injunction, but this is very seldom granted, since, if the defendant has any defence at all, it would necessitate going into the whole question of the cause of action, which at this stage could not conveniently be done. No interlocutory injunction will be granted if the Court is satisfied that the defendant has no intention of continuing the infringement (*Lyon v. Mayor of Newcastle*, [1894] 11 R. P. C. 218). If the patent is of some age and its novelty has not previously been challenged, and a *prima facie* case of infringement is

Entering
appearance
by
defendant.

Interlo-
cutory
injunction.

Interim
injunction
never
granted
where
defendant
dis-
continues.

Depends on standing of patent and proof of infringement.

Delay.

Offer of defendant to keep account.

Condition in order *re* damages.

Under-taking by defendant in lieu of injunction.

established, the plaintiff is, generally speaking, entitled to an interlocutory injunction (*Shillito v. Larmuth*, [1884] 2 R. P. C. 1; Jessel, M. R., in *Dudgeon v. Thompson*, [1877] L. R. 3 App. Cas. 34). The same may also be said where the validity of the plaintiff's patent has been upheld in a former action (*Heine v. Norden*, [1904] 21 R. P. C. 513), or where the defendant has not ventured to challenge the validity: but in either case a *prima facie* case of infringement must be shown. When the patent is recent, and its validity is disputed, no interlocutory injunction will be granted (*Spencer v. Holt*, [1903] 20 R. P. C. 142; *Holophone, Limited v. Berend*, [1898] 15 R. P. C. 18). Undue delay in bringing an action after knowledge of the infringement will also prejudice the plaintiff's claim to an interlocutory injunction (*Bovill v. Crate*, [1865] L. R. 1 Eq. 388; *North British Rubber Co. v. Gormully Co.*, [1894] 12 R. P. C. 17; *Leonhardt v. Kallé*, [1894] 11 R. P. C. 534), unless there are special circumstances which excuse delay (*United Telephone Co. v. Equitable Telephone Co.*, [1888] 5 R. P. C. 233). A defendant may often avoid being subjected to an interlocutory injunction by undertaking to keep an account pending trial (*Leonhardt v. Kallé, supra*). Where hardship to the defendant would ensue by the stoppage of large works or expensive machinery an interlocutory injunction is not readily granted (*Neilson v. Forman*, [1841] 2 Coop. Ch. Cas. 61).

Any order granting an interlocutory injunction should, and generally does, in the defendant's interests, contain a clause that, in the event of the defendant succeeding in the action to be afterwards tried, any damage suffered by the defendant through the order should be made good by the plaintiff.

Even where the defendant appears and consents to an injunction the Court may still use its discretion. For example, in *Dorer, Limited v. New Townend Cycle Co.*, [1904] 21 R. P. C. 135), Buckley, J., said: "I have recently heard that sometimes in patent cases injunctions are taken by consent upon terms which are arranged between the parties, and then these injunctions are advertised as if they had been granted by the Court in

an opposed matter. That ought not to be done. 'The defendant appearing and undertaking' of course precludes that."

In this case the order was drawn in the form suggested by the Judge.

The writ having been served and appearance entered, it then falls upon the plaintiff to deliver his statement of claim. This is governed by the ordinary rules, but there is an additional statutory obligation upon the plaintiff under Section 29, Sub-section 1, of the Act to deliver at the same or at a subsequent time particulars of breaches, showing the particular instances of infringement of which he complains. In his statement of claim the plaintiff should plead the grant of his patent, identifying it by number, date, and title, and showing the devolution of ownership should the plaintiff be other than the original patentee. He might also plead that the Letters Patent are valid and subsisting (although this is not necessary), and state generally that the defendant has infringed. The concluding claim should be similar to that endorsed on the writ: viz., For an injunction to restrain the defendant, his servants, workmen, and agents, from making, selling, supplying, using, advertising, or offering for sale, or otherwise wrongfully dealing with or in goods made in infringement of the plaintiff's patent; damages or an account; and delivery up or destruction of the infringing articles. If the plaintiff possesses a certificate that the validity of his patent has been challenged in a former action, then he should claim costs as between solicitor and client, and should plead the certificate (*per Chitty, J., in Pneumatic Tyre Co. v. Chisholm, [1896] 13 R. P. C. 488.*)

In the particulars of breaches delivered with the statement of claim all the alleged instances of infringement known to the plaintiff should be set out, with date, place, and name. The purpose of particulars is to let the defendant know exactly what he has to meet at the trial; and if the transactions alleged to constitute infringement are not admitted they must be proved.

The allegations of infringement should be, generally speaking, unqualified. Such words as "in particular" or

Statement of claim.

Particulars of breaches (Section 29, Sub-section 1).

Contents of statement of claim.

Certificate of validity if existing should be pleaded.

Particulars of breaches to contain alleged instances of infringement.

Particulars should, as a rule, be unqualified.

“by way of example and not of limitation” or the like are liable to be struck out (*Haslam v. Hall*, [1887] 4 R. P. C. 203). When the plaintiff's patent contains several claims he should point out the claim or claims alleged to be infringed. Except by leave of the Court, which is not easily obtained, instances of infringement not appearing in the particulars of breaches cannot be proved at the trial (*Henser v. Hardie*, [1894] 11 R. P. C. 421).

Defence.

Contents of defence.

Particulars of objections (Section 29, Sub-section 2).

Particulars of objections should clearly point out and limit grounds for attacking validity of patent.

Scotch practice.

The defendant should deliver his defence within ten days from the delivery of the statement of claim, or within such enlarged time as the plaintiff or the Court may allow. The usual defence is (a) that the defendant has not infringed; (b) that the patentee was not the true and first inventor (but in such case the defendant must be prepared to show who was the true and first inventor); (c) that the patent is invalid from want of novelty or utility or want of subject-matter, or because of disconformity, or from insufficiency, or from other causes. The defendant must also deliver with his defence, and in accordance with Section 29, Sub-section 2, particulars of objections to the patent. The particulars of objections should be divided into paragraphs, and must give full particulars of the grounds upon which the defendant disputes the validity of the patent. Thus, if the defendant pleads prior publication, he must identify the prior specifications or books he depends on. As far as anticipatory specifications are concerned, it must be remembered that where the plaintiff's patent has been applied for and granted since the 1st of January, 1905, no British specification of older date than fifty years back from the date of the plaintiff's patent can be deemed to be an anticipation (Section 2 of The Patents Act, 1902). If the prior anticipatory specification or publication cited by the defendant is very short and simple, he may refer to the whole; but if the prior publication is long and involved, and if it contains matter other than that affecting the plaintiff's patent, then the defendant ought to give the pages, lines, and figures he relies on. According to Scotch practice it is apparently not required that the defendant should give pages and lines of alleged anticipating specifications

(*Rose's Patents Co. v. F. Braby & Co.*, [1894] 11 R. P. C., p. 206, line 28). If the plaintiff's specification has several claims, the defendant should point out the particular claims affected by the anticipatory matter (*London and Leicester Co. v. Higham*, "*Lawson on Patents*," 3rd ed., p. 172; *Harris v. Rothwell*, [1886] 3 R. P. C. 243; *Boyd v. Farrer*, [1887] 5 R. P. C. 33). But apparently he need only do so when the plaintiff's specification is long and involved and the claims numerous. North, J., in *Heathfield v. Greenway* ([1893] 11 R. P. C. 19), said that there must be special grounds for imposing such an order on the defendant. If the plaintiff thinks the particulars of objections are insufficient or too vague, he may apply by summons for further and better particulars. It must, however, be said that under the most recent practice it is becoming increasingly difficult to get the Court to compel the defendant to narrow his particulars of objections to pages and lines of the alleged anticipatory specifications, even when it may appear desirable that this should be done. If the defendant says that it would embarrass him to do so, the Court will seldom interfere. To enable the Judge to come to any decision on his own initiative, he would require to go carefully through all the specifications, which would be almost equivalent to trying the action at this stage of the proceedings, and this he will not do. Therefore when the defendant says that he cannot discriminate parts of the specifications without embarrassing himself in his defence, he is generally allowed to refer to the whole. If at the trial it turns out that he is wrong, he will have to pay the costs (*per Buckley, J.*, in *Edison-Bell, Limited v. Columbia Phonograph Co.*, [1900] 18 R. P. C. 4).

If the defendant relies upon prior user he must, in his particulars, and in accordance with Sub-section 3 of Section 29, tell when, where, and by whom such prior user was effected; and if the article or part of it can be produced so much the better. If the defendant relies on general common knowledge he need plead no specific instances of prior publication or user (*Holliday v. Heppenstall*, [1889] 6 R. P. C. 320); but he must be prepared to prove such a general and common trade knowledge and user as will bring it within this category.

Should indicate the claims attacked.

Present practice in applications for further and better particulars.

Prior publications.

Prior user as an objection.

No particulars need be given of general common knowledge.

Holliday v. Heppenstall.

Prior specifications cited are part of common knowledge.

Disconformity.

Non-utility. Insufficiency.

Denial that plaintiff is true and first inventor.

Fraudulent obtaining from real inventor.

Defence of prior grant.

Circumstances under which prior grant might be pleaded.

A specification indicated in the particulars of objections may be referred to at the trial on the question of the state of public knowledge (*Sutcliffe v. Abbott*, [1903] 20 R. P. C. 50; see also *English and American Machinery Co. v. Union Boot Co.*, [1894] 11 R. P. C. 367). If he pleads disconformity the defendant must point out exactly where the Complete Specification differs from the Provisional (*Heathfield v. Greenway*, [1893] 11 R. P. C. 17); see also directions of Cotton, L. J., in *Crompton v. Anglo-American Brush Co.*, [1887] 4 R. P. C. 200). If he pleads non-utility or insufficiency he ought to point out the portion he is prepared to prove inoperative, or the exact parts of the specification he contends to be insufficient (*Heathfield v. Greenway, supra*; *Crompton v. Anglo-American Brush Co., supra*). As a rule particulars of non-utility are not ordered.

Where the defendant denies that the plaintiff is the true and first inventor it is not customary to order the defendant to state who is, unless fraud is alleged. The plea is usually an idle one. The meaning of it generally is that the prior patentee or prior user (cited in another paragraph) is the first inventor. No other evidence than this on the bare plea would be admitted at the trial.

If the plaintiff is accused of having wrongfully obtained the invention from another, the name and address of the alleged true inventor must certainly be given. The more exact and full the defendant is in his particulars of objections the less he is likely to be subjected to applications by the plaintiff for further and better particulars.

A further defence of comparatively recent origin is the defence of prior grant of a patent to another for the same invention. This defence is not often used, but the circumstances under which it might be raised are as follows:—Suppose that, prior to the plaintiff's application, someone else had, say six or eight months before, filed an application for the same or substantially the same invention. This application not having been published or made known at the time the plaintiff protected his invention, the plaintiff might complete his application, and obtain his patent, unconscious of the fact that the prior applicant had obtained his patent in advance. The result would be that two grants were in existence for

the same thing. Now suppose the second grantee were to take action against an independent party for infringement, the defendant who wished to avail himself of the existence of the prior grant would be wholly unable to make use of the ordinary defence of prior publication, seeing that there had been no prior publication, the first grantee's specification not having been published when the plaintiff made his application. In this dilemma recourse is had to Section 26 of the Act, which says (Sub-section 3) that every ground on which a patent might, at the commencement of this Act, be repealed by *Scire Facias* shall be available by way of defence to an action for infringement. Now *Scire Facias*, to repeal Letters Patent, formerly lay in the case, *inter alia*, of a subsequent grant to another person of a patent already granted to someone else for the same invention. The defendant may therefore, by way of defence, plead the prior grant, since he could not plead prior publication, and such a plea has succeeded (*Rose's Patents Co. v. F. Braby & Co.*, [1894] 11 R. P. C. 198; *Mica Insulator Co. v. Electrical Co., Limited*, [1898] 15 R. P. C. 489). It is true that in *Rose's Patents Co. v. F. Braby & Co.* (*supra*) the head-note of the report does not make it plain that prior grant was the rock upon which the plaintiff's patent split, but a careful study of the report shows that in fact it was so. The patent of the plaintiff Rose was held invalid owing to the prior patent of Robinson, which was dated eight months prior to the plaintiff's patent, although Robinson's specification was not published until two months after the plaintiff's application. It is open to the plaintiff, in his reply, to attack, and if possible to destroy, the validity of the prior patent so as to remove it from his path, and this was done in *Brooks v. Lamplugh* ([1897] 14 R. P. C. 597). In this case the patent pleaded as a prior grant was owned by one of the interested parties. The question might be asked whether the plaintiff should be allowed by the Court to attack the validity of a patent belonging to a third person not a party to the action and having no notice?

It is doubtful whether particulars of such prior grant would be ordered by the Court. The point was raised

Section 26,
Sub-
section 3.

Query
whether
particulars

of prior grant would be ordered.

but not settled in *Birmingham Tyre Syndicate v. Reliance Tyre Co.* ([1900] 17 R. P. C. 277). Personally the writer is inclined to think that if it were a question of serious embarrassment to the plaintiff particulars would be ordered. These claims of the plaintiff, against which the alleged prior grant is directed, must certainly be specified (*Birmingham Tyre Syndicate v. Reliance Tyre Co., supra*).

Defence under Statute of Monopolies.

The defences indicated practically exhaust the grounds by which a defendant may seek to justify his conduct. Other points have been raised, but without avail. In *Badische Fabrik v. Thompson* ([1904] 21 R. P. C. 473) the defendants, while admitting the validity of the patent, pleaded that the patentee did not, and never intended to, manufacture in this country, and only made use of his patents to prevent others from doing so, and that he exacted exorbitant prices for the dyestuffs. The contention did not impress the Court.

Amendment of particulars of breaches and of objections.
By summons and sometimes at trial.

The particulars of breaches and the particulars of objections may be amended from time to time by leave of the Court or a Judge (see Section 29, Sub-section 5). The application is usually made by summons at chambers, but if the advisability of so amending should have been just then discovered, the application might be made at the trial of the action. For example, in *Badische Anilin Fabrik v. Société Chimique* ([1897] 14 R. P. C. 875) the defendants were allowed to introduce a new objection at the trial. The Court of Appeal, by Order LVIII, Rule 4, of the Rules of the Supreme Court, has jurisdiction to amend particulars of objection, introducing fresh evidence on the appeal (*Shoe Machinery Co. v. Cutlan*, [1895] 12 R. P. C. 530; 65 L. J. Ch. 44; *Pirrie v. York Street Flax Spinning Co.*, [1894] 11 R. P. C. 429), but such amendments are not readily granted. Whether in the Court of First Instance or in the Court of Appeal it must be shown by affidavit that the new evidence could not, even with the exercise of great diligence, have been discovered before (*Moss v. Malings*, [1886] 3 R. P. C. 373; *Pirrie v. York Street Flax Spinning Co., supra*).

In Court of Appeal.

Conditions of amendment.

In acceding to an application to amend particulars the Judge has absolute discretion as to what conditions he may

impose (*Woolley v. Broad*, [1892] 9 R. P. C. 208; *Wilson v. Wilson*, [1899] 16 R. P. C. 315). But, as a rule, the party seeking to amend must pay to the other side all the costs of and occasioned by the application to amend. Where a defendant asks leave to amend his particulars of objections the conditions are usually those originated in *Baird v. Moule* ([1876] L. R. 17 Ch. D. 139, note), and sanctioned in *Edison Telephone Co. v. India Rubber Co.* ([1881] L. R. 17 Ch. D. 137), under which the plaintiffs were allowed to elect within a given time whether they would discontinue the action, and giving them, if they did so elect, their costs since the delivery of the original particulars of objections, the defendants to pay the costs of the application in any event. The order in *Ehrlich v. Ihlee* ([1887] 4 R. P. C. 115) also provided that the costs of and subsequent to the amendment being made at that stage in the proceedings (the action having been set down) should be the plaintiff's in any event. If the plaintiff elects not to discontinue, the order will simply be that leave to amend is granted, the defendant to pay the costs of the application and all costs occasioned by the amendment (*Parker v. Maignen*, [1888] 5 R. P. C. 207).^s

*Baird v.
Moule.*

*Edison Tele-
phone Co. v.
India
Rubber Co.*

Seeing that by the common form of order the plaintiff in the event of discontinuance gets the costs between the original particulars of objections and the proposed amendment in the ordinary case of one amendment, it might be asked how the plaintiff would fare in the event of repeated amendments? Suppose that an amendment were made by the defendant, and that the plaintiff, having considered it, elected not to discontinue, but went on. Afterwards, suppose the defendant applied to make a second amendment. Should the plaintiff obtain an order giving him, in the event of discontinuance, the costs between the original particulars of objections and the second amendment, or only between amendment No. 1 and amendment No. 2? The Court of Appeal, in *Wilson v. Wilson* ([1899] 16 R. P. C. 315), decided that in such a case the costs given to the plaintiff in the event of discontinuance should only be those between amendments Nos. 1 and 2, and not between the original particulars of objections and amendment No. 2. Smith, L. J.,

Form of
order in the
case of
repeated
amend-
ments.

*Wilson v.
Wilson.*

differentiated this case from that of *Ehrlich v. Ihlee* ([1887] 4 R. P. C. 115), which was relied on by the appellants, by pointing out that in the latter case no issue had been joined on the first amendment to the objections; in fact, from the report it appears that no prior amendment had ever been made by the defendants, but only two deliveries of further and better particulars on orders obtained by the plaintiffs. In *Wilson v. Wilson*, however, issue had been joined on the first amendment, the plaintiffs thus adopting and recognising the amendment as no more hurtful to their case than the original particulars of objections had been. The two cases were therefore clearly differentiated.

Notice of trial.

Notice of trial given by a defendant consequent to the non-delivery of a reply by a plaintiff is not "a proceeding in the action," which by Rule 1 of Order XXVI. prevents the plaintiff from discontinuing his action under that Rule by a notice served after the receipt of the defence.

Inspection.

By Section 30 of the Act an inspection order may be granted to either party in an action for infringement. An application for such an order may be made by summons at chambers. A plaintiff to obtain an inspection order must show that an inspection is necessary to place his case properly before the Court (*Piggott v. Anglo-American Telegraph Co.*, [1868] 19 L. T. N. S. 46), and he must file affidavits supporting these contentions and setting forth the grounds. Mere suspicion and personal belief will not do (*Germ Milling Co. v. Robinson*, [1884] 1 R. P. C. 217). The defendant may resist such an order on general grounds, and particularly if he practices any particular course of manufacture or secret process or trade secret which he does not wish publicly known. But even in such a case the Court might appoint an expert, sworn to secrecy, to inspect the defendant's works and report to the Court (*Plating Co. v. Farquharson*, [1879] Griff. P. C. 187). The Court might also order the taking of samples of the defendant's manufacture.

Procedure and grounds for inspection order.

Ex parte orders.

Usually an application for an order for inspection is only made after notice given to the other side; orders on *ex parte* applications are made only under very exceptional

circumstances. The solicitors of the parties may arrange for an inspection without obtaining an order, and the costs of such inspection, *if shown to be necessary*, may be allowed to the successful party (*Ashworth v. English Card Co.*, [1904] 21 R. P. C. 353).

Inspection
without
order.

In actions for infringement, as in other actions, interrogatories may be administered on either side by leave obtained from a Court or a Judge (Rules of the Supreme Court, Order XXXI., Rule 1). Five pounds at least must be paid into Court as security for costs before delivery of interrogatories is allowed.

Interroga-
tories.

The interrogatories proposed to be administered must be exhibited to the Court in making application. If sufficient reasons can be shown, the party interrogated may refuse to answer. Either of the parties may appeal, but appeals are rarely successful unless there has been an absolute miscarriage of justice.

Interrogatories are rarely resorted to when an application for further and better particulars would be the proper procedure. But where the particulars have been held to be sufficiently full, interrogatories will not be allowed as an indirect means of amplifying such particulars (*Hoffman v. Postill*, [1869] L. R. 4 Ch. 673). See also Farwell, J., in *General Electric Co. v. Safety Lift Co.* ([1903] 21 R. P. C., on p. 114).

Province of
interroga-
tories.

Interrogatories are often a useful means of shortening proceedings at the trial by getting either party to admit questions of fact that would otherwise require to be proved in Court—questions relating to infringement and the like. All interrogatories must be strictly relevant to the issue, and all “fishing” interrogatories, or questions tending to incriminate the person answering, need not be replied to.

The distinction between interrogatories as delivered by the plaintiff and by the defendant has been said to consist in this: that a plaintiff is not entitled to a discovery of the defendant's case, but a defendant may ask questions tending to destroy the plaintiff's claim (*Hoffman v. Postill, supra*).

Questions depending on the construction of the patent need not be answered, but interrogatories addressed to the plaintiff as to whether certain modifications were not

What inter-
rogatories
may and
may not be
answered.

necessary to make his patent operative were ordered to be answered (*Rylands v. Ashley*, [1890] 7 R. P. C. 175). A body corporate may be interrogated through a member or officer of such body; but no member or officer can be compelled to answer concerning information acquired in any capacity apart from his then relationship to the company (*Welsbach Incandescent Gas Light Co. v. New Sunlight Co.*, [1900] 17 R. P. C. 401).

Replies to interrogatories.

The replies to interrogatories must be made in affidavit form within ten days or within such extended time as a Judge may allow. According to Wood, V.-C., in *De La Rue v. Dickinson* ([1857] 7 E. & B. 738; Good. P. C. 164), everything showing or merely tending to show the fact of infringement must be set forth in the answer to the full extent of the interrogatories. In *Ashworth v. Roberts* ([1890] 7 R. P. C. 451) interrogatories as to whether defendant had not hardened and tempered wire in a certain indicated manner and substantially as set forth in plaintiff's specification were ordered to be answered. In *Lister v. Norton* ([1885] 2 R. P. C. 68) interrogatories as to whether the defendants had sold their imitation sealskins to certain customers named were ordered to be answered. But if the defendant admits infringement and sales generally, sales to named persons need not be admitted. In *Saccharin Corporation v. Haines* ([1898] 15 R. P. C. 344) interrogatories requiring the defendants to say if they had sold a certain description of saccharine, where it was made, and from whom they obtained it, were ordered to be answered. In *Bemo Jaffé v. Richardson* ([1893] 10 R. P. C. 136) the interrogatories were framed on the statements in the plaintiff's specification, but did not refer to the specification. North, J., decided that they must be answered. General admissions in reply to specific questions are to be discouraged. In *Wilson v. Wilson* ([1902] 20 R. P. C. 1) the defendants were allowed to admit generally that they had done the acts suggested in the interrogatories. At the trial the defendants contended that their general admissions were subject to a reservation of their own upon the construction of the plaintiff's patent. When this became apparent, Lord

Interrogatories framed on plaintiff's specification.

Names of customers.

General admissions to interrogatories.

Halsbury said: "I do hope we shall have no more admissions in this form. If you mean to make an admission you had better make one in plain terms" (see p. 14 of Report).

Discovery of any documents in the possession or power of either party may be had by order of the Court or a Judge. Summons for discovery by defendant must stand over till after defence is delivered (*Woolfe v. Automatic Gallery*, [1902] 19 R. P. C. 161).

Discovery of documents.

Communications passing between a party and his patent agent cannot be pleaded as privileged from discovery or production, even where the patent agent is also the party's solicitor (*Moseley v. Victoria Rubber Co.*, [1886] 3 R. P. C. 351; 55 L. T. N. S. 482).

Communications with patent agent not privileged.

Documents referring to matters in a former action and relevant to the issues in the action then proceeding—such, for example, as affidavits, notes of evidence, and the like—might in some cases be ordered for production (*Bown v. Sanson*, [1888] 5 R. P. C. 510); see also remarks of Cotton, L. J., in *Thomson v. Hughes* ([1890] 7 R. P. C. 187).

Documents in former action.

When the action comes on for trial the plaintiff, if the validity or ownership of the patent is disputed, should prove his title and produce the Letters Patent. The construction of the specification, like that of any other written document, is left to the Court. Patent actions are generally tried without a jury (Section 28), although by the same section the Court has power to direct that it shall be tried with a jury. Under Section 28 the Court may, if it thinks fit, and at the request of either party, call in a specially qualified assessor to assist at the trial of the action.

Proof of title and production of Letters Patent.

Mode of trial.

Assessor.

If infringement is not admitted the plaintiff should first prove this.

Proof of infringement.

The evidence of expert witnesses is frequently advisable, as was said by Lindley, M. R., in *Brooks v. Steele* ([1896] 14 R. P. C. 73), "to explain technical terms; to show the practical working of the machinery described or drawn; to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention had been used by an alleged infringer,

Expert evidence.

Expert must not construe specification.

and the real importance of whatever differences there may be between the plaintiff's invention and what is done by the defendant." But the evidence of an expert witness on the construction of a specification may be ignored (*Edison-Bell Phonograph Co. v. Smith*, [1894] 11 R. P. C., at p. 404). The proper function of expert witnesses is to indicate all points requiring consideration, but their actual opinion whether there is infringement or not is immaterial. Questions as to what are and what are not mechanical equivalents may be referred to expert witnesses (*per Smith, L. J.*, in *Ticket Punch Register Co. v. Colley*, [1895] 12 R. P. C. 171, see p. 186, line 8). The construction of the specification is not admissible evidence from an expert.

Evidence on mechanical equivalents.

Evidence as to insufficiency.

When insufficiency is alleged against a specification the evidence of an intelligent workman of approved skill and knowledge in the specific art meets with more favour from the Court than the evidence of a professional expert witness.

Adjournment on surprise evidence.

The object of the particulars delivered with each party's pleadings is to prevent surprise, and to ensure that each shall know exactly what he has to meet. But where evidence of the nature of a surprise is let in at the trial, as, for instance, in *Barcroft v. Smith* ([1896] 14 R. P. C. 172), where unwary cross-examination elicited proof of an anticipation of the plaintiff's patent which not did appear in the particulars of objections, the surprised party should apply for an adjournment if the new proof is of a serious nature. Otherwise, if he takes a verdict, the Court of Appeal will not allow him to adduce evidence in rebuttal.

New trial on ground of surprise.

The granting of an adjournment on the ground of surprise is always a matter for the discretion of the Court. A new trial on the ground of surprise cannot be obtained unless there is an affidavit alleging surprise (*per Lord Esher* in *Haggenmacher v. Watson*, [1897] 14 R. P. C., at p. 634, line 6).

Action may be remitted to a referee.

When an action involves abstruse scientific questions or exhaustive examination of documents, the Court may, under The Arbitration Act, 1889, remit the action to a referee or arbitrator.

Estoppel.

The defendant may in certain circumstances be estopped from denying the validity of the plaintiff's patent. This

is so if the defendant has submitted to judgment in a previous action for infringement of the same patent (*Goucher v. Clayton*, [1864-5] Good. P. C. 214); or if he has worked the patent in partnership with the plaintiff (*Muntz v. Grenfell*, 2 Web. P. C. 88); or if he, being the original patentee, has sold the patent to the plaintiff, and is acting in breach of the assignment (*Chambers v. Urichley*, [1864] 33 Beav. 374; Good. P. C. 112; *Oldham v. Langmead*, [1789] 3 T. R. 439; Good. P. C. 342). But it seems that if the defendant is a bankrupt patentee whose trustee in bankruptcy has assigned the patent to the plaintiff, the defendant is not estopped from denying the validity of the patent (*Cropper v. Smith*, [1884] 2 R. P. C. 17; 10 App. Cas. 249).

Assignment by bankrupt's trustee not estoppel.

If satisfied of the validity of the plaintiff's patent and that infringement has been established, the Court will grant an injunction and damages, or an account of profits, with costs, and sometimes delivery up or destruction of the infringing goods. An injunction only holds good while the plaintiff's patent is in force, and if the patent should be declared invalid in some subsequent action the injunction comes to an end (*Daw v. Eley*, [1865] L. K. 3 Eq. 496; Good. P. C. 160). Goods manufactured during the term of patent right, and stored away ready to throw upon the market as soon as the patent lapses, are infringements, and are within the terms of an injunction, and pursuable even after the expiry of patent right (*Crossley v. Beverley*, [1829] Good. P. C. 136; 3 C. & P. 513; 9 B. & C. 63). Should a defendant commit any breach of the injunction, the plaintiff should move for committal for contempt, and in the case of a body corporate for sequestration of the goods of the defendant company and committal of the directors (*Spencer v. Ancoats Rubber Co.*, [1888] 6 R. P. C. 46). It seems that the successful applicants are entitled to costs on the higher scale, and in some cases to costs as between solicitor and client.

Results of judgment for plaintiff.

Effect of result of subsequent judgment on injunction.

Mere manufacture without sale is infringement.

Committal for breach of injunction.

Breach by corporation.

Though delivery up of the infringing goods to the successful plaintiff may be ordered, the plaintiff cannot sell these for his own profit. They remain the property of the defendant (*Vavasour v. Krupp*, [1870] L. R. 9 Ch. D. 351). But the defendants cannot set off the value of such

Goods delivered up are not plaintiff's property.

Only
infringing
part
delivered
up.

delivered-up goods as against damages or profits payable by them to the plaintiffs (*United Telephone Co. v. Walker*, [1886] 4 R. P. C. 63; 56 L. T. 508). When part only of the defendant's apparatus constitutes the infringement, that part only is required to be delivered up or destroyed (*Edison-Bell Phonograph Co. v. Smith*, [1894] 11 R. P. C. 389; *Howes v. Webber*, [1895] 12 R. P. C. 465).

Damages.

Not merely
loss of
profit.

In assessing damages the true measure is not always merely the loss of profit the plaintiff may have sustained, or the gains the defendant may have made, but in such assessment other circumstances may be taken into account (*Pneumatic Tyre Co. v. Puncture Proof Co.*, [1899] 16 R. P. C. 209; *American Braided Wire Co. v. Thomson*, [1890] 7 R. P. C. 152). But the ordinary rule of law against over-remoteness of damage holds good in patent as in other actions (*Boyd v. Tootal Broadhurst*, [1894] 11 R. P. C., at p. 184). Although a patentee has obtained damages against a manufacturer for infringement, he may also proceed against a purchaser of the infringing goods (*Penn v. Bibby*, [1866] Good. P. C. 371; L. R. 3 Eq. 308; 36 L. J. Ch. 277). In an inquiry as to damages the plaintiff is entitled to have the damages assessed down to the date of the inquiry. Damages, or a payment by way of royalty, are usually preferred to an account of profits, as the taking of such accounts is always attended with great difficulty, and is a work of such trouble and expense that the Courts have always advised against it (*Siddell v. Vickers*, [1892] 9 R. P. C. 152; *Automatic Retort Co. v. Mayor of Salford*, [1897] 14 R. P. C. 450).

Different
persons
liable.

Account of
profits.

Costs.

Shorthand
notes.

The successful party as a general rule gets the costs of the action. But taxed costs by no means cover the successful litigants' actual expenses. Only a tithe of the heavy fees paid to professional expert witnesses is allowed by the Taxing Masters. The cost of shorthand notes are usually not allowed; but in the Court of Appeal, in the absence of a direction to the contrary, the costs of an appeal include the costs of the shorthand writer's notes of the judgment (*re Medland*, [1889] 41 Ch. D., at p. 493; *re De Falbe, Ward v. Tyler*, [1901] 1 Ch. D. 523). It seems that an agreement of solicitors as to shorthand notes is

not binding. The costs of shorthand notes have been allowed in taxation between solicitor and client as a necessary expense in the action (*Osmonds v. Mutual Cycle Co.*, [1899] 2 Q. B. 488; see also Notes to Order LXV., Rule 27 (9), of the Rules of the Supreme Court). If solicitors agree, it should be to the effect of making the costs of the shorthand notes costs in the action, and the Judge should be informed of this arrangement and consent at the commencement of the hearing. The costs of inspection of apparatus, the subject-matter of the action, will not be disallowed merely because the inspection has been arranged between the solicitors of the parties without an order for it having been obtained under Rule 3 of Order L. of the Rules of the Supreme Court (*Ashworth v. English Card Co.*, [1904] 21 R. P. C. 353). Where the case is heavy the costs of three counsel may be allowed, and the Court will not, as a rule, interfere with the discretion of the Taxing Master in allowing items unspecified in the Rules of the Supreme Court (*re Burroughs Wellcome's Marks*, [1904] 22 R. P. C. 164).

Between
solicitor
and client.

Costs of
inspection
without
order.

Three
counsel.

Section 29, Sub-section 6, of the Patent Act is to the effect that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

Costs of
particulars
must be
certified for
by Judge.

Accordingly a successful plaintiff or defendant should, on the delivery of judgment, apply for a certificate that his particulars of breaches or particulars of objections are reasonable and proper, or have been proven. If the action has been tried out, and the particulars gone into, the Judge will have little difficulty in making up his mind whether he ought to grant or withhold such a certificate, or what portions of the particulars are entitled to such a certificate; but even where there has been no trial, or no sufficient trial of the action, such certificates may be asked for and are sometimes granted. Thus, in *Pneumatic Tyre Co. v. Chisholm* ([1896] 13 R. P. C. 488), a certificate

Practice in
granting
certificates
of costs in
particulars
of breaches
and
objections.

Costs
certifi-
cates in
particulars
of
objections.

Practice in
granting
certificates.

of the plaintiffs' particulars of breaches was granted although the action was undefended. In *Allen v. Oates* ([1898] 15 R. P. C. 304) a certificate was granted only in respect of these particulars of breaches relied on at the trial. As touching particulars of objections a certificate was granted in *Chamberlain v. Mayor of Bradford* ([1900] 17 R. P. C. 493) in respect only of those particulars referred to at the trial. "These particulars of objections which the defendant has raised as affecting the validity of the plaintiff's patent will only be allowed if the patent is declared invalid. If the defendants win on non-infringement only, the certificate of their objections ought to be strictly limited to this issue of non-infringement" (*per* Vaughan-Williams, L. J., in *Pilkington v. Massey*, [1904] 21 R. P. C. 712). In *Wilcor & Gibbs v. Jones* ([1897] 14 R. P. C. 523), where the plaintiffs discontinued after delivery of defence, a certificate of the particulars of objections was refused on the ground that the Court had not been granted an opportunity of testing whether the particulars were reasonable and proper or not. But in *Chamberlain v. Mayor of Huddersfield* ([1901] 18 R. P. C. 454), where the plaintiffs applied for leave to discontinue after the pleadings were closed, one of the conditions of leave was the payment of the costs of the defendants' particulars of objections as if certified. In *American Steel Co. v. Glover* ([1902] 19 R. P. C. 111) the plaintiffs appeared, but withdrew when the action came on for trial. The defendant asked for a certificate of their particulars of objections, but Farwell, J., refused (see also Buckley, J., in *Acetylene Co. v. United Alkali Co.* ([1902] 19 R. P. C. 233). In *Pegamoid, Limited v. British Leather Cloth Co.* ([1901] 18 R. P. C. 317), where the plaintiffs gave up their case after cross-examination of their chief expert, the defendants were allowed to continue the cross-examination for the purpose of proving their particulars of objections and obtaining a certificate.

General
principles
upon which
certificates

The cases are various and sometimes apparently conflicting, but the broad rule to be deduced is that, where the Court has had no opportunity of judging of the

reasonableness of the particulars, a certificate will seldom be granted, and the Court will not enter into a sort of half trial of the action in order to see whether or not the particulars of objections are reasonable (*per Romer, L. J., in Wilcox & Gibbs v. Janes, supra*). Where the particulars have been gone into, a certificate will be granted in respect of the whole or of those portions which the Court may think reasonable and proper; or refused, either wholly or in respect of those portions which the Court may think too remote or trifling. Thus, out of ten heads of particulars five might be allowed and five disallowed, and a certificate will be given only in respect of those allowed. Where the plaintiff submits to have his action dismissed without being heard, it has been held that the proper course was to reserve the question of costs and of the certificate of particulars of objections until the matter had been before the Taxing Master (*Mandelberg v. Morley, [1893] 11 R. P. C. 1*).

of costs for particulars are granted.

If the validity of the plaintiff's patent has been impeached by the defendant and has not been destroyed at the trial, the plaintiff should apply under Section 31 of the Patent Act for a certificate that the validity of the patent came in question. This section enacts that "in an action for infringement of a patent the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same."

Certificate that validity of patent has been challenged.

"Any subsequent action" means any action started after the certificate in the earlier action has been granted. This was held in *Automatic Weighing Machine Co. v. International Hygienic Society* ([1889] 6 R. P. C. 475), and in *Pneumatic Tyre Co. v. Leicester Pneumatic Co.* ([1898] 15 R. P. C., at p. 168). In any subsequent action a plaintiff who has a certificate granted in a former action must plead the certificate and ask for solicitor and client costs (*Pneumatic Tyre Co. v. Chisholm, [1896] 13 R. P. C. 488*).

"Subsequent action."

Certificate of validity should be pleaded.

Instances
in which
certificate
has been
given.

If the validity of the patent has been challenged by the defendant in his defence, a certificate will be granted although validity is not contested at the trial (*Fabriques Chimiques v. Caspers*, [1897] 15 R. P. C. 94). Even where the defendants did not appear at the trial a certificate was granted, validity having been raised in their particulars (*Acetylene Co. v. Midland Acetylene Syndicate*, [1900] 17 R. P. C. 534, and see *Saccharin Corporation v. Sitos*, 17 R. P. C. 536, s.; *Welsbach v. Krumm*, [1901] 18 R. P. C. 211). But in *Webb Lamp Co. v. Atkinson* ([1902] 19 R. P. C. 599), where the validity of the patent was impeached on eleven prior specifications set out in the defence, the defendants did not appear at the trial. Nevertheless, Buckley, J., refused to grant the plaintiffs a certificate of validity.

Query,
whether
certificate
may be
granted
in respect
of good
claims in
bad patent?

Where one or more of the claims of a patent have been held bad, a certificate has been granted in respect of the remaining good claims (*Badische Aniline Fabrik v. Société Chimique*, [1897] 14 R. P. C. 892; *Haslam v. Hall*, [1887] 5 R. P. C. 1). But under present practice it seems doubtful that a certificate of the validity of the patent having been called in question can be granted in respect of a patent declared invalid; certainly never where all of the claims have been held invalid (*Acetylene Co. v. United Alkali Co.*, [1902] 19 R. P. C. 213, where Buckley, J., plainly stated that such a certificate cannot be given where the patent is held invalid, and flatly declined to follow *Haslam v. Hall, supra*). Even when the patent has expired before the trial a certificate may be granted (*Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, [1897] 14 R. P. C. 757; *Kane v. Boyle*, [1901] 18 R. P. C. 325).

Certificate
in expired
patent.

No appeal
on certi-
ficate.

No appeal lies against the granting or withholding of a certificate, the same not being a judgment or order within Section 19 of The Judicature Act, 1873.

Certificate
in Judge's
discretion.

The granting or refusing of a certificate is always a matter for the Judge's discretion, and even where a certificate has been granted, the Court or a Judge in a subsequent action is not bound to give solicitor and client costs to a successful plaintiff (*Automatic Weighing Machine Co.*

v. National Exhibitions Association, [1891] 8 R. P. C., at p. 352). Apparently such costs are not given where validity is not disputed in a subsequent action (*Saccharin Corporation v. Dawson*, [1902] 19 R. P. C. 169; *Edison-Bell v. Waterfield*, [1902] 19 R. P. C. 329).

Of course, where the patent has been declared invalid in the Court below and this is reversed by the Court of Appeal, the latter Court will grant a certificate (*Fawcett v. Homan*, [1896] 13 R. P. C. 398).

Court of Appeal may grant certificates.

Costs on the higher scale are not often given. There is no rule as to the particular circumstances which would justify the giving of such costs in patent actions; but, generally speaking, where the action has involved the consideration of important and abstruse scientific issues, costs on the higher scale will be given (*Muirhead v. Commercial Cable Co.*, [1894] 12 R. P. C., at p. 64; *Heidemann v. Smokeless Powder Co.*, [1898] 15 R. P. C., at p. 325). In cases which come within The Public Authorities Protection Act, 1893, a successful defendant public authority gets costs as between solicitor and client (*Chamberlain and Hookham v. Mayor of Bradford*, [1900] 17 R. P. C. 762). But the acts done by the public authority must be plainly within the scope of their public duties. Thus in *New Conveyer Co., Limited v. Edinburgh Gas Commissioners* ([1904] 21 R. P. C. 147), solicitor and client costs were refused to the successful defendants by the Inner House of the Scottish Courts of Session on the ground that the adventurous infringement of patents for the manufacture of gas did not arise out of the exercise of public duties.

Costs on higher scale.

Public Authorities Protection Act.

Although no appeal lies as to costs generally, nevertheless, where costs on the higher scale have been given for certain stated reasons by the Judge of First Instance, appeal might be had to review whether such alleged reasons did actually exist, and thus practically an appeal against the allowance of costs on the higher scale may be said to lie.

Appeal re costs on higher scale.

When an appeal against the judgment in the action is contemplated, application may be made for a stay of execution pending appeal. Stay of injunction is seldom granted, especially where the plaintiff gives an undertaking

Stay of execution on appeal.

Stay of enquiry.

(*Pilkington v. Yeakley Vacuum Hammer Co.*, [1901] 18 R. P. C., at p. 459). Indeed, it may be said that as a rule stay of an injunction is never granted unless there are good reasons, such, for example, as that the public or the public service might suffer or be prejudiced, in which case a short stay might be had, but only on condition that the defendant keeps an account. An application to stay enquiry as to damages pending appeal by the defendant is as a rule granted on terms (*Anti-Vibration Lighting Co. v. Crossley*, [1904] 22 R. P. C. 157), but may, in the discretion of the Judge, be refused (*Evans v. Hoskins*, [1904] 21 R. P. C. 675; *Hyam v. Terry*, 29 W. R. 32 followed). A stay as to costs is seldom granted. If refused in the Court below, an application for a stay pending appeal might be made to the Court of Appeal.

Appeal is a rehearing.

Rule 1 of Order LVIII. of the Rules of the Supreme Court enacts that "all appeals to the Court of Appeal shall be by way of rehearing, and shall be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding, other than such notice of motion, shall be necessary. The appellant may, by the notice of motion, appeal from the whole or any part of any judgment or order, and the notice of motion shall state whether the whole or part only of such judgment or order is complained of, and in the latter case shall specify such part."

Interlocutory orders concerning injunctions are appealable without leave.

By The Judicature Act, 1894, Section 1, Sub-section (b), interlocutory orders or judgments are not appealable without leave, except, *inter alia*, in cases concerned with the granting or refusing of an injunction &c. As almost every patent action concerns an injunction, it follows generally that all interlocutory matters in patent actions are appealable without leave. From an interlocutory order appeal must be made before the expiration of fourteen days. From a final judgment, appeal must be made in three months. In the case of a final order the notice is fourteen days; from an interlocutory order the notice is four days.

Halsbury, L. C., on the duties of the Court of Appeal.

The hearing upon appeal is a rehearing, and the Court of Appeal will approach the matter "without any presumption that the judgment in the Court below was right. The Judges of the Court of Appeal ought to

consider the case impartially, and should in no sense be influenced by the judgment of the Court of First Instance. It is not within their competence to say that they would have given a different judgment if they had been the Judge of First Instance, but because he has pronounced a different judgment they will adhere to his decision" (*per* Lord Halsbury, L. C., in *Riekmann v. Thierry*, [1896] 14 R. P. C., at p. 116).

The Court of Appeal should have copies of the professional shorthand writer's notes of evidence in the Court below. Fresh evidence may be admitted by leave of the Court of Appeal, but such leave is not readily granted. It must be evidence not known to or available by the applicant at the trial below (*per* Lindley, L. J., in *Hinde v. Osborne*, [1885] 2 R. P. C. 45). Thus, where a defendant in the Court below rested his defence on non-infringement only, and did not challenge the validity of the plaintiff's patent, he was not allowed to raise this issue in the Court of Appeal (*Hinde v. Osborne, supra*).

From the decision of the Court of Appeal an appeal may be made to the House of Lords within one year.

Papers for
the Court
of Appeal.
Fresh
evidence.

Appeal to
House of
Lords.

CHAPTER XVIII.

REVOCAION OF PATENTS.

Scire Facias
abolished.

Meaning
of "The
Court."

THE old action of *Scire Facias* having been abolished by the Act of 1883, revocation of a patent is now obtained by petition to the Court. "The Court" means the High Court of Justice in England, the Court of Session in Scotland, and the High Court of Justice in Ireland. With regard to the Court of the County Palatine of Lancaster, its jurisdiction has been enlarged by Section 3 of The Chancery of Lancaster Act, 1890, so that revocation matters affecting parties within its jurisdiction may now be undertaken by that Court.

Persons
entitled to
petition for
revocation.

A petition for revocation may be presented by—

1. The Attorney-General for England or Ireland, or the Lord Advocate in Scotland, or any person authorised by them.
2. Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.
3. Any person alleging that he, or a person under or through whom he claims, was the true inventor of the subject-matter or a portion of the subject-matter of the patent.
4. Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

Fiat of
Attorney-
General
or Lord
Advocate.

Under Paragraphs 2, 3, and 4 a person may present his petition as of right; but upon other grounds he must obtain from the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, his fiat or leave to

present the petition. This fiat is not issued as a matter of course; but even where the applicant can present his petition under Paragraphs 2, 3, and 4, it is sometimes better to fortify the petition with the fiat of the Attorney-General or Lord Advocate, so as to decrease the possibility of the petition failing upon the ground of insufficient *locus standi* (*Dege's Patent*, [1895] 12 R. P. C. 448; *Morgan's Patent*, [1888] 5 R. P. C. 186).

In *Morgan's Patent* (*supra*), Chitty, J., held that, granted the petitioner is qualified to present the petition himself under Paragraphs 2, 3, and 4, the patent may be attacked on any other ground, such as disconformity, insufficiency, or the like.

Petitioner's grounds.

To obtain the fiat of the Attorney-General, the following papers should be sent to the patent clerk:—

Procedure in obtaining fiat of Attorney-General.

- (a) A memorial to the Attorney-General asking his authority, and stating all the circumstances.
- (b) A statutory declaration verifying the statements in the memorial.
- (c) Two copies of the proposed petition and of the particulars proposed to be delivered with it.
- (d) The certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
- (e) A certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is in a position to pay the costs of the petition if unsuccessful.

An application for the Attorney-General's fiat may be heard *ex parte*, or directions may be given to advise the patentee of the application, so that both parties may be heard. The granting or withholding of the fiat is within the discretion of the Attorney-General. There is no power to give costs on these applications (*Welch's Application, re Martin's Patent*, Griff. P. C. 320); but by consent the costs may be made costs in an action for infringement agreed to be taken by the respondent against the applicant within a given time (*Vickers's Application, re Siddell's Patent*, Griff. P. C. 320).

Application for fiat.

Costs.

In Scotland
by action of
reduction.

Section 109 of the Patent Act provides that—

“Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.”

Scottish
decisions
on “persons
having
interest.”

For instances of persons “having interest” see *Worthington Pump Co. v. Weir* ([1894] 11 R. P. C. 657), and *Montgomerie v. Peterson* ([1894] 11 R. P. C. 221, 633). In this latter case it was held by the Court of Session that the owner of an invalid patent may yet obtain the revocation of another patent.

Fraud.

The petitioner who alleges the patent to have been obtained in fraud of his rights must prove positive fraud. “To be in fraud of his rights it must be done either with the intention of depriving the principal of his rights or must be insisted upon so as to deprive the principal of his rights” (*per* Cotton, L. J., in *Avery’s Patent*, [1887] 4 R. P. C. 327). Where it was found, as in *Norwood’s Patents* ([1895] 12 R. P. C. 214), that the invention was not that of the patentee, but that the patent had been taken out with the intention of depriving one of the petitioners of his rights, the patent was revoked (see also *Gale’s Patent*, [1891] 8 R. P. C. 438). In *Marshall and Naylor’s Patent*, ([1900] 17 R. P. C. 553) a servant had, at the request of his master, invented a tap to perform specific functions. The servant worked out the invention, made the models, and perfected the tap, all in his master’s time and with his master’s tools. The master had no share in the actual invention of the tap. Ten pounds was paid to the servant for extra time and trouble, and the master, in conjunction with a co-director, patented the tap. On petition for revocation by the servant on the ground of fraud the patent was revoked.

Fraud by
master on
servant.

Substi-
tution of
true
inventor as
patentee
(Section 20,
Sub-
section 8).

When a patent is revoked on the ground of fraud, the successful petitioner, if he is the true inventor, can have a patent granted to him for the invention, as of the date of revocation, but expiring at the same time as the original

revoked patent would have expired. Thus, in the case last cited, application was made under Sub-section 8 of Section 26 of the Patent Act to issue the patent for the remainder of the term to the successful petitioner, the servant. In lieu of this, the Court may declare the defendant trustee for the plaintiff in respect of such patents, British or foreign, as the defendant may have obtained (*Richmond v. Wrightson*, [1904] 22 R. P. C. 25).

Wrongful
patentee
made
trustee for
plaintiff.

Apart from fraud, where the petitioner claims that he is the true inventor of the invention patented by the respondent, he must show very conclusively that the alleged prior invention is practically identical with the respondent's, and that it was by a specification, by public user, or by other means, published in this country. To prove that he invented, but did not publish or publicly use the invention afterwards independently invented and patented by the respondent, would not avail, any more than it would avail as an anticipation in an action for infringement. If the petitioner founds his petition on a prior specification, the respondent may advance evidence of prior knowledge to limit the petitioner's claim, or bind him to the particular devices described and illustrated (*Walker v. Hydro-Carbon Syndicate*, [1884] 2 R. P. C. 3). As the words of the sub-section are "true inventor" and not "true and first inventor," which include "importer," it has been suggested that a patentee who had imported an invention from abroad might be liable to have his patent revoked by the actual inventor. But it is difficult to see why a first importer to whom a grant has been legally made should have his patent revoked on such a ground.

Proof of
priority
of true
inventor.

Query as to
imported
invention.

The next in order of those who may petition for revocation of a patent are persons who have publicly made, used, or sold the invention prior to the date of the patent. Thus, in *Haddan's Patent* ([1885] 2 R. P. C. 218) the petitioner proved that he had publicly made and sold an infant's food as described by the patentee some years prior to the date of the patent, and consequently the patent was revoked. In *Scott's Patent* ([1902] 20 R. P. C. 257) the petitioners proved prior use in the course of their business of a condenser which was held to be within the terms of the

Prior
public user.

Use in private house.

first general claim of the specification. In *Taylor's Patent* ([1896] 13 R. P. C. 482) the petitioner proved the use in his private house of a fireplace similar to the patented invention of the respondent, and the patent was thereupon revoked. The Court will be satisfied with such substantial anticipation as would serve as a successful defence in an action for infringement. In *Edmond's Patent* ([1889] 6 R. P. C. 355) apparatus was claimed for the manufacture of hollow arched or "Paragon" umbrella ribs. The petitioner showed that the same machinery had for some time previously been used in the production of solid umbrella ribs. The mere application of this old apparatus for the manufacture of hollow ribs was held by Pollock, B., to be unpatentable, and the patent was revoked.

Analogous prior user.

Particulars of objection.

Particulars of objection to the patent must be delivered with the petition exactly as is done by the defendant with his defence in an action for infringement. Proof of these objections only, and no others, will be allowed at the hearing of the petition. Particulars may be amended from time to time by leave of the Court or a Judge, as in actions for infringement.

Certificate of reasonableness of particulars not provided for.

It does not appear from Section 26 of the Patent Act that the Judge has any power to give a certificate of the reasonableness of the particulars, but, on the other hand, there is no such prohibition against the Taxing Master allowing costs on the particulars without such a certificate as exists in Section 29.

Additional grounds for revocation.

The petition and particulars may include as grounds for the revocation of a patent, insufficiency of description, disconformity between the Provisional and Complete Specification, want of subject-matter or invention, and prior grant, in addition to prior use or publication, fraud, and the other grounds already treated of (Section 26, Sub-section 3).

Pharmacy Act.

The fact that the patent was taken out to evade the provisions of the Pharmacy Act is not a ground for revocation (*Vaisay's Patent*, [1894] 11 R. P. C. 591).

Petitioner cannot plead estoppel on

A defendant in an infringement action in which certain of the patentee's claims have been held bad cannot, in the event of his petitioning for revocation, set up that the

patentee is estopped by the former judgment from denying that the said claims are bad (*Deeley's Patent*, [1895] 12 R. P. C. 192). All persons having an interest in the patent must be made respondents (*Avery's Patent*, [1887] 4 R. P. C. 152).

respondent's patent.

Under Section 19 of the Act, during proceedings for revocation a patentee may obtain leave to amend his patent, subject to such terms as to costs and otherwise as the Court or a Judge may impose, the hearing of the petition being meanwhile postponed. The usual conditions are those imposed by Byrne, J., in *Chatwood's Patent* ([1899] 16 R. P. C. 371), where the applicants were ordered to pay in any event the costs of the application and of the petition up to and occasioned by the disclaimer, except only so far as the proceedings in the matter might be utilised for the purpose of the hearing of the petition, should the same be heard. In the event of the petitioner electing not to proceed with the petition, the respondents were to pay all the costs of the proceedings. This order differs from the older order in *Goulard and Gibbs's Patent* ([1888] 5 R. P. C. 189), chiefly in providing for the utilisation, without expense to the applicant, of such parts of the proceedings as can be utilised if the petition goes on. In a proceeding for revocation of a patent the Court of Appeal will not review the exercise by a Judge of the discretion given to him by Section 19 of the Act as to the terms and conditions of an order for revocation, where the Judge has exercised his discretion with a full knowledge of all the circumstances of the case (*Geipel's Patent*, [1904] 21 R. P. C. 379).

Respondent may amend bad patent.

Conditions of amendment.

It will be noted that Section 19 admits of amendment by disclaimer only.

At the hearing of the petition, which is similar to that of an infringement action, the respondent begins, the petitioner follows, and the respondent concludes. Unless the evidence is taken by affidavit, which seldom happens, the hearing is treated as a witness action, and is entered in the witness list. The petition must not go into the witness list till it is capable of being heard (*Borrowman's Patent*, [1902] 19 R. P. C. 159). When the evidence is by

Order of procedure at hearing.

affidavit the party who has the right to begin (generally the respondent) should file his evidence-in-chief first (*per* Chitty, J., in *Gale's Patent*, [1891] 8 R. P. C. 438). Apparently an order for revocation cannot be made in chambers; it must be made in Court (*Clifton's Patent*, [1904] 21 R. P. C. 515).

Revocation order should be noted on Register.

When an order of revocation has been made, the order is taken to the Comptroller at the Patent Office by the successful petitioner, and a note of the revocation is placed on the Register. There is no actual or formal cancellation of the grant.

Costs.

The successful petitioner gets his taxed costs from the respondent, and if unsuccessful must pay costs. There is no way of cancelling the grant otherwise than by petition, and this sometimes works great hardship. A patentee who has obtained a patent for an invention which he has independently made, and who has throughout acted honestly and in perfect good faith, is liable to find himself suddenly served with a petition for revocation. Although he may from the first recognise the hopelessness of his position, and may be perfectly willing to consent to the revocation of his patent, nevertheless the petition must go on and the costs must be incurred. It really seems worth suggesting that some amendment should be made to the Act, whereby an innocent patentee desirous of resigning his patent should be able, by some simple and inexpensive formality, to get the grant revoked without incurring the sometimes ruinous expense of even an unopposed petition. It has been suggested that a way out of the difficulty would be for the patentee to disclaim or strike out everything in his specification, thus leaving nothing for the petitioner to go upon.

Hardship of present regulation as to revocation.

Appeal.

Revocation of a patent may be stayed pending appeal to the Court of Appeal and the House of Lords.

CHAPTER XIX.

ACTION TO RESTRAIN THREATS.

ALTHOUGH it has been maintained that Section 4 of the Statute of Monopolies gave a right of action and a claim to treble damages at Common Law to any person "hindered, grieved, disturbed, or disquieted by pretext of any monopoly or letters patent," and although it is clear from the remarks of Mathew, J., in *Peck v. Hindes* ([1898] 15 R. P. C. 113) that such a right of action existed and exists, it is nevertheless true that no use was ever made of this alleged remedy, with the result that before the Act of 1883 a patentee might almost with impunity send out circulars threatening legal proceedings on account of alleged infringements of his patent. He was then under no direct compulsion to bring any action in furtherance of his threats, and unless the party aggrieved could prove that these threats were injurious, untrue, and made maliciously and in bad faith, he had no remedy so long as the patentee could make out any case that he had, or believed he had, reasonable ground for uttering such threats.

Redress for threats under Statute of Monopolies.

Patentee's threats formerly not actionable by Statute.

Now, however, Section 32 of the Act of 1883 provides that—

Redress for threats under Act of 1883, Section 32.

"Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damages, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase

to which the threats related was not, in fact, an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.”

Threats must now be backed by action.

The object of the section is not to prevent a patentee from threatening at all if he sees his patent infringed. This he may do, but he must do it in good faith, believing his patent is valid, that it has been infringed, and intending, if satisfaction is not given him, to take action *forthwith* to enforce his threat, if, indeed, he has not already taken action.

Grounds for threats.

The threat should not be made upon suspicion merely, but must be in respect of something done, something being done, or something intended to be done (*per* Lindley and Kay, L. J., in *Johnson v. Edge*, [1892] 9 R. P. C. 142).

A general warning not a threat.

As Bowen, L. J., put it in *Challender v. Royle* ([1887] 4 R. P. C. 363; L. R. 36 Ch. D. 425): “A merely general warning to pirates not to pirate and to infringers not to infringe,” coupled with an intimation that the patentee has a patent which he means to enforce, is not in itself an actionable threat. But it depends on the manner in which even such a general statement is circulated, and on the class of persons to whose notice it is brought. Thus, a general notice that violations of a certain patent were rife, and that parties were warned not to infringe, sent out by the patentee as wrappers for his goods and addressed as circulars to customers of a rival manufacturer of similar wares, was held under the circumstances to constitute an actionable threat (*Johnson v. Edge, supra*). So a general complaint to the piano trade of infringements by foreign manufacturers, capable of being construed as referring to the plaintiffs, who had a branch in England, was held to be an actionable threat (*Herrburger v. Squire*, [1888] 5 R. P. C. 581). As to the possible effect of general advertisements see also the remarks of Bowen, L. J., in *Skinner v. Perry* ([1892] 10 R. P. C., at p. 8). The gist of the decisions and *obiter dicta* in the matter may be summed up in this,

But may be made so by circumstances.

that, although *prima facie* a mere general advertisement or circular is not in itself an actionable threat, still the manner in which it is put forward or distributed, the circumstances which surround it, and the ascertainable evidence of *mala fides* or malice will all be considered and weighed.

Threats or a threat—for only one threat has led to the granting of an injunction (see *Webb v. Lerinstein*, [1898] 15 R. P. C. 78)—may be by letters (*Willoughby v. Taylor*, [1893] 11 R. P. C. 45; *Barrett v. Day*, [1890] 7 R. P. C. 54), and may be in a correspondence expressed to be carried on “without prejudice” (*Kurtz v. Spence*, [1888] 5 R. P. C. 161), or by solicitor’s letter (*Crampton v. Patents Co.*, [1888] 5 R. P. C. 393; *Combined Weighing Machine Co. v. Automatic Machine Co.*, [1889] 6 R. P. C. 502). Such letters may be sent to the principals or to their customers (*Dowson v. Drosophore*, [1895] 12 R. P. C. 95). Even although the alleged threatener may not have expressly referred to his patent, if it is evident he has it in his mind such a letter may be an actionable threat (*Douglass v. Pintsch*, [1896] 13 R. P. C. 673). A verbal threat is also actionable, although it may be more difficult to prove (*Kurtz v. Spence, supra*); and in a complaint of a verbal threat the name of the person to whom the threats were made should be given, as in slander cases (*Dowson v. Drosophore*, [1894] 11 R. P. C. 536; *Lycett v. Brooks*, [1904] 21 R. P. C. 656). A letter from a patentee answering enquiries as to a new invention and expressing the opinion that it was an infringement of his patent, and that he was prepared to stop its sale, was held a threat (*Skinner v. Perry*, [1892] 9 R. P. C. 406).

The remedy of a threatened party or a party capable of showing himself to have been aggrieved by threats is to be sought in an action claiming an injunction against the continuance of the threats, and also claiming damages. In *Kurtz v. Spence* ([1886] 3 R. P. C. 368), Chitty, J., held on a summons that the plaintiff could not question the validity of the defendant’s patent in his Statement of Claim, but the Court of Appeal in the same case ([1887] 4 R. P. C. 427), confirming Cotton and Bowen, L. JJ., in *Challender v. Royle* ([1887] 4 R. P. C. 363), held that he could (see also *Herrburger v. Squire*, [1888] 5 R. P. C. 581); and it is now settled

One threat enough.

By letter.

Solicitor’s letter.

To customers.

Verbal threat.

Reply to enquiry.

Remedy of persons threatened.

Threatened persons may challenge validity of patent.

Particulars
of threats.

practice that such can be done. The plaintiff must give particulars of the threats complained of; and where these have been verbal statements made by the defendant's servants or agents, the names of the persons by and to whom the threats were spoken must be given (*Dowson v. Drosophore*, [1894] 11 R. P. C. 536). If in his statement of claim the plaintiff attacks the validity of the defendant's patent, he must deliver particulars of objections showing upon what grounds he disputes the patent, and giving the specific instances of prior publication or prior user, or disconformity, or other grounds upon which he depends.

If patent
attacked,
particulars
of objection
required.

Defence.

If the plaintiff does not challenge the validity of the patent the defendant (although not bound to do so) must almost of necessity, by way of counterclaim, assert infringement of his patent and the validity thereof, seeing that, according to the section, no injunction or damages can be obtained by the plaintiff if the defendant succeeds in showing that, in fact, the defendant has a valid patent, and that the plaintiff has infringed it. By his counterclaim the defendant might also claim an injunction and damages for infringement (*Appleby's Twin Roller Chain Co. v. Eadie*, [1899] 16 R. P. C. 318). In support of his plea of infringement the defendant must deliver particulars of breaches just as if he were a plaintiff in an action for infringement. The plaintiff may, in his reply, deny infringement, and attack the validity of the patent, delivering, at the same time, particulars of objections just as a defendant would do in an infringement action. To this the defendant may put in a rejoinder (*Dowson v. Drosophore*, [1895] 12 R. P. C. 95).

Counter-
claim for
injunction
and
damages.

Dual nature
of action.

The action would thus assume the dual character of an action for restraint of threats combined with an action for infringement. Both issues may be tried in the same action, the questions of validity and infringement first, and if the defendant fails in these then the threats issue (*Herrburger v. Squire*, [1888] 5 R. P. C. 581).

Threats
condoned
if im-
mediately
followed
by action.

But, as will be seen, the section provides that the prohibition against making threats does not apply if the person threatening commences, and prosecutes with due diligence, an action for infringement of his patent. This

suggests an inquiry as to what is "due diligence." That, again, depends on circumstances (*per* North, J., in *Colley v. Hart*, [1890] 7 R. P. C. 101). An action commenced, but discontinued from the necessity of amending the specification, was in the circumstances held to have been commenced and prosecuted with due diligence (*Peck v. Hinde*, [1898] 15 R. P. C. 113). Even where an action has been commenced with due diligence, although afterwards discontinued or dismissed, the alleged infringer may, after the withdrawal of the action, take proceedings against the patentee in respect of the threats, and may, if malice or *mala fides* is found, obtain damages (*Bishop v. Inman*, [1900] 17 R. P. C. 749). The time from which due diligence may be reckoned is from the issue of the threat (*Challender v. Royle*, [1887] 4 R. P. C. 363; *Haskell v. Hutchison*, [1904] 21 R. P. C. 497). Three months has been considered a fair period for the exercise of due diligence (*Colley v. Hart*, *supra*). In *Herrburger v. Squire* ([1888] 5 R. P. C. 581) fourteen months was held too long a delay; but in reckoning time the circumstances of each case must always be considered.

Due diligence.

As to the expediency of pressing to trial two separate actions, one for restraint of threats by the threatened party, and another for infringement of his patent by the party threatening, the Lord Chancellor and Lords Justices Cotton and Fry, in *Automatic Machine Co. v. Combined Weighing Machine Co.* ([1889] 6 R. P. C. 367), expressed the strongest disapproval of such a course. Said the Lord Chancellor: "My attention has been called to the frequency of the practice of reduplicating actions and increasing unnecessary costs by trying the same action in two different forms, one to restrain threats and the other upon the patent itself. I confess I regard with very great jealousy expedients by which an action is made to cost twice as much as it need, because it is brought in two different forms."

Separate actions discouraged.

The best plan appears to be that if the plaintiff in a threats action does not attack the validity of the defendant's patent, the defendant, by counterclaim, may raise the issues of infringement and validity, and let these be fought out in the threats action. Failing this, and also if infringement

Procedure advisable in threats actions.

and validity have been put in issue, should it be expedient that the defendant should protect himself under the section by bringing and prosecuting an action for infringement "with due diligence," he may do so, and then arrange with the other side or get an order of the Court that the threats action may be stayed until the infringement action has been tried out. Of course, if he succeeds in establishing infringement and validity, the threats action is gone.

Example of
apparent
delay held
to be due
diligence.

If the parties have been in correspondence for a long time, and the threatened parties at last take action for restraint, a cross action taken by the patentee after inspection has been held to have been taken with due diligence, although three years had passed since the initial threat (*Eddin v. Pneumatic Tyre Agency*, [1893] 10 R. P. C., at p. 316). But this is only in consonance with the remarks of North, J., in *Colley v. Hart* (*supra*), as to the modifying influence that circumstances may exercise in enabling the Court to rule what is and what is not due diligence. Thus, if it is evident that the action is not taken *bonâ fide* but only to comply technically with the section, or if it is evident that the action would never have been taken had not the patentee's hand been forced by the threats action, the Court might declare that there was no due diligence (*Appleby's Twin Roller Chain Co. v. Radie*, [1899] 16 R. P. C., at p. 330; see also Cotton, L. J., on *bonâ fides* in respect of such actions, *Challender v. Royle*, *supra*).

Example
where due
diligence
held absent.

Prosecution
of the
action.

"Prosecuted" with due diligence does not necessarily mean that the action must have been prosecuted to a trial, much less to a successful issue (*Colley v. Hart*, *supra*), and where the patentee has threatened several persons, it is enough if he brings an action against one of them, although that one may not be the plaintiff in the threats action (*Challender v. Royle*, *supra*). But in *Bishop v. Inman* ([1900] 17 R. P. C. 749), where the first action was withdrawn and a second action was dismissed for want of prosecution, the jury found that though the threats were made *bonâ fide*, and the first action was brought *bonâ fide*, nevertheless the first action was not prosecuted with due diligence, and the second action was neither brought *bonâ fide* nor prosecuted with due diligence, and damages were awarded in respect of both series of threats.

One action
will do.

Action not
brought
bonâ fide.

In *Waite v. Johnson* ([1900] 18 R. P. C. 1) a patentee brought an action for infringement, which was dismissed on the plaintiff's default. The patentee then issued a threatening circular, and within five days was served with a writ in a threats action. The patentee immediately brought a second action for infringement. A motion for interlocutory injunction by the plaintiff in the threats action was dismissed, the Court holding there was no evidence to show that the second action brought by the patentee was not being prosecuted with due diligence.

The person who threatens is the person who must bring the action. He cannot substitute as plaintiff another who is the real owner of the patent in virtue of which he threatened (*Kensington Electric Co. v. Lane-Poa*, [1891] 8 R. P. C. 277; [1891] 2 Ch., at p. 577).

The threatener must take action.

So long as the action is commenced in respect of the patent owned by the party who has used the threats, the particulars of breaches need not necessarily refer to the specific parts or modifications of the invention ear-marked by the threats. Thus, in *Lycett v. Brooks* ([1904] 21 R. P. C. 656) the threats referred in two instances to a certain saddle called "L 16," and in one instance to three saddles called respectively "L 5," "L 14," and "L 16"; but in the action brought to justify the threats, infringement of these types was not alleged. The plaintiffs, in their action to restrain threats, alleged *mala fides*, but Warrington, J., held that the infringement action as brought satisfied the substance of the section.

Breaches alleged need not coincide with subject-matter of threats.

It is only with difficulty that an interim injunction can be obtained in a threats action. The plaintiff would require to show conclusively that he was not infringing the defendant's patent.

Interim injunction.

Damages are measured by the actual loss sustained by reason of the threats. These may be assessed by the Court or an enquiry as to damages may be instituted. Loss of profits under a contract repudiated because of the threats has been assessed as damages (*Hoffnung v. Salsbury*, [1899] 16 R. P. C. 375).

Measure of damages.

In threats actions as in other actions appeal may be made to the Court of Appeal and also to the House of Lords.

Appeal.

CHAPTER XX.

PROLONGATION OF PATENTS.

Patentee may petition for prolongation.

SECTION 25 of the Act of 1883 refers to the extension of the term of a patent, and provides that a patentee may present a petition to His Majesty in Council, praying that his patent may be extended for a further term; but such petition must now be presented at least *six months* before the time limited for the expiration of the patent.

Grounds for prolongation.

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

“Patentee” means those entitled to benefit of patent.

As the term “patentee” includes, under Section 46, any person who is for the time being entitled to the benefit of the patent, it follows that not only can the original patentee present a petition for extension, but also the executor or administrator of a deceased patentee, or an assignee of a patentee who has sold his interest. An assignee is not, however, to be placed on the same favourable footing as the original patentee, and if the patentee has been paid a reasonable sum for his patent the assignee cannot be favourably considered because he has made a bad bargain (*Hopkinson’s Patent*, [1896] 14 R. P. C. 5). A mortgagee ought to be a party to the petition (*Church’s Patents*, [1886] 3 R. P. C. 95), and should in fact join with the patentee.

Position of assignee.

Mortgagee.

Statement in petition must be full and exact.

In presenting a petition for extension, the applicant must state fully and fairly everything relating to the patent, and be prepared with complete sets of profit and

loss accounts, so that approximately exact results of the working under the patent may be laid before the Committee (*Saxby's Patent*, [1870] Good. P. C. 565; *Bett's Patent*, [1862] Good. P. C. 548; *Duncan and Wilson's Patent*, [1884] 1 R. P. C. 257; *Lane-Fox's Patent*, [1892] 9 R. P. C. 411). Anything savouring of suppression or designed confusion will most certainly result in the throwing out of the application (*Clarke's Patent*, [1899] 16 R. P. C. 433; *Henderson's Patent*, [1901] 18 R. P. C. 449; *Ferranti's Patent*, [1901] 18 R. P. C. 518).

Profit and loss accounts must be full and exact.

It is much better to state an even apparently damaging fact plainly than to try to suppress it, for there is no tribunal more impatient of want of good faith than the Judicial Committee.

Bona fides of petitioner.

A petition for the extension of a patent requires to be presented within six months before its expiry; otherwise there is no jurisdiction to entertain the petition (*Adam's Patent*, [1898] 16 R. P. C. 1); but the petition must not be presented too much in advance of the six months, or it may be put back as premature. It appears that an opponent cannot have extension of time to oppose simply because he did not see the advertisement in time (*Hopkinson's Patent*, [1896] 13 R. P. C. 114).

Time for presenting petition.

It must be "prosecuted with effect": *i.e.* some definite step must have been taken by the Judicial Committee before the patent expires.

Prosecuted with effect.

The Rules at present to be observed in proceedings before the Judicial Committee of the Privy Council for the prolongation of patents came into force on the 1st of January, 1898. These Rules are to the following effect:—

Rules.

1. A party intending to apply by petition under Section 25 of the Act shall give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers.

Advertisements.

If the applicant's principal place of business is situated in the United Kingdom, at a distance of fifteen miles or more from Charing Cross, he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from

Advertisements in local journals.

Charing Cross, he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

Particulars
in advertise-
ments.

The applicant shall in his advertisements state the object of his petition, and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that *careats* must be entered at the Council Office on or before such day so named in the said advertisements.

Presenta-
tion of
petition.

2. A petition under Section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

Affidavits of
advertise-
ments.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the first of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

Papers to be
lodged at
Council
Office.

3. A party presenting a petition under Section 25 of the Act must lodge at the Council Office eight printed copies of the specification; but if the specification has not been printed, and if the expense of making eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only would be deemed sufficient.

Accounts.

The petitioner shall also lodge at the Council Office eight copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance sheet for the use of the Solicitor to the Treasury, and shall upon receiving two days' notice give the Solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance sheet at the hearing or from which the materials for making up the said balance sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

Careat of
opposition.

4. A party intending to oppose a petition under Section 25 of the Act must enter a *careat* at the Council Office before the day on which

the petitioner applies for a time to be fixed for hearing the matter thereof, and having entered such *caveat* shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

The petitioner shall serve copies of his petition on all parties entering *caveats* in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

All parties intending to oppose a petition shall within three weeks after such copies are served upon them respectively lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

Papers
lodged by
opponents.

5. Parties shall be entitled to have copies of all papers lodged in respect of any petition under Section 25 of the Act at their own expense.

Copies.

All such petitions and all statements of grounds of objection shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance sheets of expenditure and receipts shall be printed in a form convenient for binding along with such petitions.

Forms.

6. Costs incurred in the matter of any petition under Section 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

Costs.

7. The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under Section 25 of the Act as they shall consider to be just and expedient.

Relief from
compliance
with
require-
ments.

8. The Lords of the Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition under Section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee.

Attorney-
General to
be heard
for Crown.

The opponent is not required to show such personal interest as in the case of opposition to the grant of a patent or amendment of a specification before the Law Officer.

Interest of
opponent.

It is advisable that the opponent should state fully all the particulars of objections to the extension in the *caveat*; but in *Stewart's Patent* ([1885] 3 R. P. C. 7) evidence of

Opponent's
particulars
of
objections.

prior user, not included in the particulars, was admitted, although this resulted in the loss of their costs by the opponents, who were successful.

Free hand
of Attorney-
General.

The Attorney-General may give evidence of objections on behalf of the Crown, irrespective of the particulars (*Church's Patents*, [1886] 3 R. P. C., at p. 101).

Parties may
appear
personally.

At the hearing, the petitioner and opponent may appear, either personally or by counsel. The Attorney-General is always present to watch the case in the interests of the Crown, and may interpose, even although no *caveat* has been entered. The rules of evidence are the same as in Courts of Law.

Merits of
invention
considered.

In examining the request for extension, the Judicial Committee will take into consideration the merits of the invention as regards the public, and the remuneration obtained from it by the patentee or his representative or assignee.

Points to be
proved by
petitioner.

The three chief points to be proved by the petitioner are—

1. The merit of the invention.
2. That every possible effort has been used to make the invention commercially successful.
3. That, without any fault of his own, the petitioner has been unable to reap a sufficient reward.

Advantage
to public.

As far as merit is concerned, the chief thing to make plain is the great utility of the invention to the public (*Currie and Timmis's Patent*, [1897] 15 R. P. C. 63).

Foreign
patents.

Where foreign patents have been obtained for the invention this should be stated, and the accounts should show the expenditure and receipts in connection with these (*Newton's Patent*, [1884] 1 R. P. C. 177; *Adair's Patent*, [1881] L. R. 6 App. Cas. 176). The fact that foreign patents have been allowed to lapse, or have expired by effluxion of time, is a point against, though not fatal to, prolongation (*Semet & Solvay's Patent*, [1894] 12 R. P. C. 10).

Deductions
from profits.

Where a certain profit has been made, deductions from this will be allowed for personal expenses of the petitioner during the periods when he devoted himself exclusively to the pushing of the patent (*Hazeland's Patent*, [1894] 11 R. P. C. 467).

It seems that law expenses incurred by the patentee in maintaining his patent rights are not allowed to be deducted from the profits (*McLean's Patent*, [1898] 15 R. P. C. 418). Deduction of law expenses not allowed.

Although it is scarcely the function of the Judicial Committee to try the validity of the patent for which extension is sought, still they will not grant extension where the patent is obviously bad. Therefore evidence of anticipation by the opponent will be received and given effect to (*Cocking's Patent*, [1885] 2 R. P. C. 151). If the validity is only doubtful the patentee will get the benefit of the doubt. Validity of patent.

As a rule, no extension is granted for a longer period than seven years, but in rare instances extensions of ten and even fourteen years have been granted. Periods of extension.

Under present practice, if the petitioner is successful a new patent is directed to be sealed for the period of prolongation allowed. Issue of new patent.

The new Letters Patent are sealed and dated as of the date of expiration of the original patent. No new specification requires to be filed.

The petition ought to bear on its face the whole history of everything relating to the matter (*per Lord Hobhouse in Stanfield's Patent*, [1897] 15 R. P. C. 17).

The amount of profits derived from foreign patents should be carefully and fully stated (*Barff and Bower's Patent*, [1895] 12 R. P. C. 383). Profits on foreign patents.

In *Peach's Patent* ([1901] 19 R. P. C. 65) the invention had been communicated from abroad. The petition was made by the patentee and assignees. As the accounts contained no information as to the remuneration of the foreign inventor, prolongation was refused; an application for adjournment to prepare further accounts and obtain information from the foreign inventor was also dismissed. Remuneration of foreign inventor.

When the original inventor has been adequately remunerated, and has no further interest in the patent, the assignees, although they may have lost by the transaction, are not in the more favourable position of the patentee (*Hopkinson's Patent*, [1896] 14 R. P. C. 5). In the petition in *re Finch's Patent*, [1898] 15 R. P. C. 674), the patentee had absolutely assigned his patent for a sum of money to the petitioners, and would have derived no Assignees.

Prolongation must benefit original inventor.

further benefit from the prolongation. Lord Macnaghten, in refusing prolongation, referred to what had been said in the *Barff-Bower Patent* ([1895] 12 R. P. C. 383) by Lord Watson: "There is no case in which this Board has granted an extension of a patent to an assignee which did not directly or indirectly tend towards the benefit of an original inventor who would, had there been no assignment, have been in a position to claim an extension himself." This case is identical with the *Barff-Bower* and *Hopkinson Cases* (*supra*). Here, as Finch only received sixty pounds for his invention, he might well have pleaded insufficient remuneration had he been in a position to petition; and the petitioners, had they been well advised, would have joined Finch in the petition, with arrangements for further remuneration from the extension. *A fortiori*, an assignee is not granted prolongation when the patentee himself could not ask it on the ground of insufficient remuneration, as in *Hopkinson's Patent* (*supra*), where the patentee had received nearly £20,000 in cash and shares.

Where a patentee assigns to a company, not being able himself to bring out the patent, the company may share in the benefits of prolongation (*Davies's Patent*, [1893] 11 R. P. C. 27).

Conditions sometimes imposed.

Prolongation may be granted coupled with conditions, such, for instance, as the granting of licences on reasonable terms, as in *Lyons's Patent* ([1894] 11 R. P. C. 537).

Delay in exploiting patent.

Delay in pushing the patent and getting it on the market during the earlier portion of the patent right may cause refusal of prolongation (*Dolbear's Patent*, [1896] 13 R. P. C. 203; *Pieper's Patent*, [1895] 12 R. P. C. 292; *Henderson's Patent*, [1901] 18 R. P. C. 449). But this might be capable of explanation, for even where the invention had never been brought into actual use, through illness and other causes, the patent was prolonged (*Roper's Patent*, [1887] 4 R. P. C. 201).

Invalid patent not prolonged.

The question was discussed, but not decided, whether a patent could be prolonged of which one of the claims was admittedly bad (*Burlingham's Patent*, [1898] 15 R. P. C. 195). No doubt where the validity of the patent is

obviously unsustainable, prolongation will not be granted; but where there is any doubt the Committee will leave that question to be decided in another Court (*Kay's Patent*, Good. P. C. 516).

In order that the Judicial Committee may have full information on the subject, a petitioner for prolongation, where there is any question as to validity, should himself refer to prior patents within his knowledge and trenching in any manner on the subject-matter of his patent (*Livet's Patent*, [1892] 9 R. P. C. 327).

Petitioner should show validity of patent.

An application for an adjournment to supplement defective accounts is not ordinarily granted (*Yates and Kellett's Patent*, [1887] 4 R. P. C. 150).

Defective accounts.

By Section 25, Sub-section 7, of the Act, the costs in proceedings for prolongation are in the absolute discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

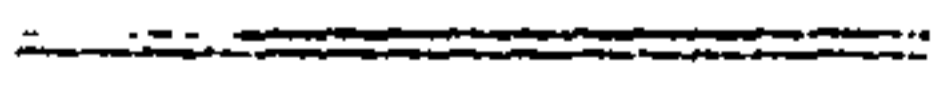
Costs.

A successful opponent will usually get his taxed costs. Very often when there are several opponents, as in *Hopkinson's Patent* ([1896] 14 R. P. C. 5), to simplify matters the Committee awards a lump sum to be divided among the opponents (*Ferranti's Patent*, [1901] 18 R. P. C. 518).

Costs of opponents.

If the petition is abandoned, those who have entered *careats* of opposition will generally get their costs.

Abandoned petition.



CHAPTER XXI.

ASSIGNMENTS OF PATENTS.

Patents
assignable
in whole
or part.

THE form of grant being to the patentee, his executors, administrators, and "assigns," it follows, from the terms, that a patent is assignable. Not only is it assignable as a whole, but any part or share of the patent may be dealt with, or the right to use a distinct and separate part of the invention may be bought and sold (*Dunncliffe v. Mallet*, [1895] 7 C. B. N. S. 209). Further, by a direct provision in Section 36 of the Act, a patent may be assigned for any place in or part of the United Kingdom, and such district or divisional assignments are by no means uncommon.

District
assign-
ments.

By deed.

An assignment should be by deed (*per* Lindley and Bowen, L. J., in *Stewart v. Casey*, [1891] 9 R. P. C. 9); for the grant itself being under seal, it follows, as a rule of law, that things which are created by deed can only be assigned by deed.

When not
under seal.

If, however, an instrument not under seal purports to be an assignment of a patent, it is submitted that it would act as an agreement to assign, and specific performance could be enforced on this ground. At all events such an agreement would act as an equitable assignment (*Fletcher's Patent*, [1893] 10 R. P. C. 252). An equitable assignee, however, is not in so favourable a position as a legal assignee, as he cannot sue infringers in his own name and is liable to have his title defeated by a subsequent legal assignee taking without notice (*Actien Gesellschaft v. Temler*, [1900] 18 R. P. C. 6).

Executory
assign-
ments.

An assignment of a patent to take effect upon the happening of a certain event would operate as an assignment without further assurance upon the happening of the event (*Cartwright v. Amatt*, [1799] 2 Bos. & P. 43).

If a patentee, or the proprietor of a patent or of a share in a patent, should become bankrupt, his interest or share passes to the trustee in bankruptcy.

Passes to trustee on bankruptcy.

In drawing an assignment, any form of words which clearly transfers the proprietorship of the patent from the assignor to the assignee will serve.

Form of assignment.

The usual course is first to indicate the patent grant, distinguishing it by number, date, and title. If the assignor is himself an assignee, the devolution of title should be set forth.

Next come the words purporting to assign the patent, together with the rights and powers of the patentee, the consideration being here set forth.

The covenant for title is implied, in accordance with The Conveyancing Act, 1881, if the assignor describes himself as the "beneficial owner" or "trustee." Next should follow a covenant for the validity of the patent, so far as the acts of the assignor are concerned, for there is no implied warranty of validity (*Hall v. Conder*, [1857] 2 C. B. N. S. 22, 533). If the assignor in contracting to sell his patent gives a warranty of validity, and it is afterwards found that the patent is bad, the assignee may claim rescission of the contract and the return of the money paid, together with damages. But rescission of the contract will not be ordered if the parties cannot be restored to their original positions (*Berchem v. Wren*, [1904] 21 R. P. C. 683). It is sometimes considered prudent to insert in the assignment an express covenant as to any improvements upon the patent which may thereafter be made by the assignor (see *Pneumatic Tyre Co. v. Dunlop*, [1896] 13 R. P. C. 553; *London Hosiery Co. v. Griswold*, [1886] 3 R. P. C. 251). If this were not done, a patentee or assignor might immediately afterwards produce an invention which might entirely supersede the invention he had sold.

Covenant for title.

No implied warrant of validity.

Future improvements on patent.

When the assignment deals with a share of a patent only, or is an assignment for a specified district, it is advisable to make provision for the payment of the annuities; otherwise an assignee might find himself compelled, for his own sake, to pay the annuities which would keep the patent in force, not for his benefit alone, but

Provision for annuities.

for the benefit of others upon whom he would have no claim for contribution.

Limitation
of co-
owners'
rights and
duties.

In all cases where there are several co-owners of a patent, it is advisable to make specific arrangements as to the payment of their proportions of the annual renewal fees by the owners, and to embody the arrangement so made in a written instrument. The mutual rights and duties of the co-owners should also be laid down and limited in the same instrument.

Rights of co-
patentees.

A co-patentee or joint owner or assignee might himself, and without the concurrence of the others, manufacture the invention, grant licences, or make profits without accounting to the other owners (*Mathers v. Green*, [1865] L. R. 1 Ch. 29; 34 Beav. 170; Good. P. C. 298). This might fall hardly on the others, as a manufacturer capable of turning out large quantities of the patented goods might, so long as he was owner of a small share in the patent, do so with impunity, and without paying a farthing to his co-patentees. They, on the other hand, might be unable to get the manufacture taken up by others, so that the owner of, say, one-sixth of a patent might be making large profits, while the holders of the remaining five-sixths were making nothing.

Agreements
between co-
patentees.

To prevent this, an agreement should be made binding the present or future co-owners to account to each other for the profits made by them respectively, and to act in concert when granting licences. With regard to the latter, however, it should be said that in *Mathers v. Green (supra)* an unreversed portion of the judgment of the Court of Appeal held that where one of several joint patentees grants a licence, he is bound to account for the profits to his co-patentees. But although this ruling was not specifically reversed, the Lord Chancellor, in the beginning of his judgment, expressed himself against this part also of Lord Romilly's finding in the Court below. The point is therefore doubtful.

Assignment
to trustees.

In the event of the co-owners objecting to the quasi-partnership brought about by such an agreement as has been indicated, the patent could be assigned to trustees for the owners, the trustees being authorised to grant licences

for the benefit of the owners, keep accounts of all profits, and distribute them in the proportions of ownership. The trustees would also be empowered to pay the renewal fees as they fall due, to provide for all current costs and expenses, and to institute or defend any proceedings at law in respect of the patent or trust.

A patent may be assigned to a body corporate in its corporate name, and such body corporate is entitled to be registered as the proprietor of the patent.

A patent assignable to a body corporate.

An action for infringement of a patent may be brought by the assignee, and the assignees of a bankrupt patentee may bring it. Where a distinct portion of a patent has been assigned, the assignee of that portion can act alone in bringing an action for infringement of this part of the invention. This was laid down by Erle, C. J., in *Dunnicliff v. Mallett* ([1859] 7 C. B. N. S. 209, 227).

Infringement action by assignee.

All assignments should be entered in the Register of Patents.

Entry on Register.

A patentee may mortgage his patent, in which case he remains the patentee and proprietor, and is entitled to take action against infringers in his own name (*Van Gelder v. Sowerby Bridge*, [1890] 7 R. P. C. 208). He need not join the mortgagee as co-plaintiff. There is no provision for entering a mortgagee on the Register as proprietor; but the equitable assignee is entitled to have a notification of his equitable right entered on the Register.

Mortgagee.

A few short precedents of Assignments of Letters Patent will be found in Appendix B, commencing at page 458.

Forms of assignment.

CHAPTER XXII.

LICENCES.

Nature of
licence.

BY a Licence the patentee relaxes the prohibition contained in the grant of Letters Patent against the public in favour of a certain person—viz., the licensee—whereby the licensee is allowed to exercise the privilege originally granted exclusively to the patentee.

Species of
licences.

Licences may be classed as *Exclusive*, *General*, and *Restricted*.

Exclusive.

An *Exclusive* Licence is a licence which is granted to one person or firm only. The patentee may reserve the continued use of the invention to himself personally, or he may exclude himself and his assigns. The exclusive licence may be for a fixed period, or it may be terminable by notice, or upon the happening of a contingency, or it may be for the full term of the patent and without power of revocation, in which case it amounts to, and for some purposes is treated as, an absolute assignment.

General.

A *General* Licence is a licence which is granted to several different licensees.

Restricted.

A *Restricted* Licence may be described as a licence to use only a part of the invention, or to use it only for a certain purpose or within a certain district.

Implied
licence
to resell.

A licence to a manufacturer to make a patented article implies a licence to those who purchase the goods from him to resell to the public without direct authority from the licensor (*Thomas v. Hunt*, [1864] 17 C. B. N. S. 183).

Licence not
assignable.

A licence is a personal right granted to the licensee, and cannot, therefore, be assigned or transferred by him (*Bower v. Hodges*, [1853] 22 L. J. C. P. 194), unless the licence is granted to the licensee and his assigns, or unless a power of assignment or transfer is specifically granted in the instrument. But if a licensee assigns his licence and the licensor accepts royalties from the assignee he is

estopped by such acceptance from disputing the validity of the assignment (*Lawson v. Macpherson*, [1897] 14 R. P. C. 696). Even in the absence of payment and receipt of royalties the terms of the judgment in *Lawson v. Macpherson*, taken in conjunction with the ordinary rules of law, warrant the conclusion that other circumstances, such as acquiescence or *laches* on the part of the licensor, would have the same effect. Sub-licences cannot be granted by a licensee, unless the power to do so is expressly conferred.

Acquiescence
in transfer
of licence.

A patented article used by a licensee under his licence cannot be seized under a distress and used by another to whom the licence does not extend (*British Mutoscope v. Homer*, [1901] 18 R. P. C. 177).

Seizure of
licensed
article
under
distress.

Licences should be under hand and seal (see form of Patent grant), although this is not essential if the licence has been kept and worked under (*Chanter v. Dewhurst*, [1844] 12 M. & W. 823; 13 L. J. Ex. 198); but a licence of a less formal nature, even when granted by word of mouth, would be perfectly good as betwixt licensor and licensee (*Crossley v. Dixon*, [1863] 10 H. L. 293), especially if royalties have been paid and accepted. Such an oral licence could not of course be registered in the Patent Office.

Form of
licence.

Oral
licence.

The terms of a proposed licence should be very carefully scanned by the intending licensee: otherwise in the event, for example, of the cancellation or voiding of the patent, he may find himself estopped from questioning the validity of the patent, although all the world besides may use it (*African Gold Co. v. Sheba Gold Co.*, [1897] 14 R. P. C. 660). Generally speaking, the mere relationship of licensor and licensee implies that the taker of the licence, while the licence remains in force, admits the validity of the patent, and is therefore estopped or hindered from denying a matter already stated or admitted by him. Consequently estoppel might take effect even where the licence was not under seal, or merely in the form of a letter, or even where the licence is verbal. As a rule such estoppel would exist only while the licence remained in force, or until the patent had been declared void in legal proceedings between the licensor and third parties, although even then if the licensee still continued to work the

Terms of
licence.

Licensee
estopped
from
questioning
validity of
patent while
licence in
force.

invention without formally revoking the licence he might possibly be liable for royalties. The delivery of the defendant's defence in an action taken by the licensor against his licensee cannot be taken as a notice to determine the licence (*Cheetham v. Nuthall*, [1893] 10 R. P. C. 321).

Con-sequences of licence for full term of patent.

Where more than the ordinary covenants have been imported into the instrument, or where the licence is for the full term of the patent, or where the taker of the licence agrees not to question the validity of the patent, the fettering of the licensee might be correspondingly severe, and complete estoppel set up.

Deter-mining licence.

In the absence of such restrictive terms in the licence, a licensee who wishes to discontinue should give immediate notice in writing to the licensor, and at the same time cease to use the invention (*Redges v. Mulliner*, [1892] 10 R. P. C. 21; *Crossley v. Dixon*, [1863] 10 H. L. 293).

Licensee released from licence may afterwards challenge patent.

Where the relationship of licensor and licensee has been thus properly determined estoppel is gone, and the licensee may afterwards dispute the validity of the patent—that is to say, if he again commences to manufacture under the patent he will require to be dealt with as an ordinary infringer, and not as being estopped under his former licence. When the licence is coupled with an interest so as to be more than a bare licence, it is of the nature of a grant and is not revocable at will, unless the defendants have been guilty of breaches (see *Ward v. Livesey*, [1888] 5 R. P. C. 105; *Guyot v. Thomson*, [1894] 11 R. P. C. 541).

Points to be considered in granting and accepting licences.

A rehearsal of the indicated possible difficulties points to the conclusion that, as it is to the interest of the licensor to bind the licensee as much as possible by the terms of the instrument, it is on the other hand to the interest of the licensee to decline to accept anything that may too greatly hamper him in the future. Therefore the question of estoppel consequent upon recitals and statements in a licence, and actual or implied admissions on the part of the licensee, should be carefully considered before acceptance of the licence. In ordinary circumstances the most prudent course is to provide for discontinuance of the licence on reasonable notice or on the patent being declared invalid, and expressly to bar admissions of the validity of the patent.

Again, from the point of view of the licensor it may be said that equal caution is required, lest, in seeming to guarantee more than can be substantiated, the question of failure of consideration should leave the licensee at liberty to dispute the licence.

Further, if the licence is exclusive, and no rent reserved, the licensor might well object to be too stringently bound by covenants for title and for validity, seeing that his only advantage from the licence will depend upon the enterprise of the licensee. At the same time he should have power of revocation for breaches of covenants or in case the royalties do not reach a reasonable minimum figure per annum within a given period, otherwise an interested manufacturer might take an exclusive licence for the express purpose of locking the patent up.

Safeguards
for licensor.

In the case of an exclusive licence, the payment of the renewal fees by one or other of the parties should be expressly provided for. In the absence of such provision neither would be bound to pay these, and the responsibilities of the licensee might continue, although the patent had lapsed.

Payment of
renewal fees
should be
provided
for.

An instance of this occurred in the case of *Mills v. Carson* ([1892] 10 R. P. C. 9). Here an exclusive licence was granted to the defendants by the patentee for the then unexpired term of patent right for the consideration of £100 per annum. Nothing was said in the licence, nor was there any other arrangement as to who should pay the renewal fees. Neither of the parties paid the next renewal fee, so that the patent lapsed. The licensee then declined to pay the next instalment of annuity to the plaintiff. On action being taken by the patentee's assignee, it was held by the Recorder, by the Divisional Court, and by the Court of Appeal, that nothing having been said in the deed about the payment of those fees, the licensee had no right to throw the onus of payment upon the patentee, and that he must pay and continue to pay the annuity prescribed in the deed for the term of years for which the patent would have lasted had it not been allowed to lapse. An ordinary licensee cannot sue alone in respect of infringements, but may join with the patentee. Even in the case of an *exclusive* licensee, his right to sue alone

Unless pro-
vided for no
obligation
to pay taxes
on either
party.

*Mills v.
Carson.*

Mere
licensee
cannot sue
for infringe-
ments.

has never been expressly admitted by the Court, although it would seem he may use the patentee's name for this purpose (*Renard v. Levinstein*, [1864-5] 11 L. T. N. S. 79, 505). The proper course is to make the patentee co-plaintiff.

When licence may be virtual assignment.

When the licence, in addition to being exclusive, is irrevocable, and no payments are being made under it, the licence is virtually an assignment, and it seems reasonable to submit that the licensee may sue for infringements without making the licensor a party, although even this has never been directly decided. It would seem from an observation of Lindley, L. J., in *Guyot v. Thomson* (*supra*), that such a licence is not a conveyance within the meaning of The Conveyancing and Law of Property Act, 1881, Section 7.

Licensee may vary article if within limits of patent.

So long as a licensee fairly produces the patented article he is not liable to an action for infringement or for departure from the terms of the licence, though he may deviate from a defining drawing and deposited pattern in a point not within nor of the essence of the invention (*Dunlop Co. v. Buckingham & Adams Cycle Co.*, [1901] 18 R. P. C. 423; see also *Dunlop Co. v. Cresswell et al.*, [1901] 18 R. P. C. 473).

Covenants by licensee.

The licensee usually covenants to pay the royalties and other sums agreed upon, to keep proper books of account, to allow inspection and the taking of extracts, and to make periodical returns, verified by statutory declaration, if required. He should also agree to stamp, number, or otherwise distinguish the goods where this is possible.

Covenants generally.

All questions as to mutual assistance in litigation, detection of infringements, the patenting of improvements, terms of revocation of licence, settlement of disputes by arbitration, &c., may be set forth in the instrument according to the arrangements of the parties.

Fraud by licensor.

Where it is apparent that the licensor has acted fraudulently, all royalties and sums paid to him under the licence are recoverable.

Entry of licences on Register.

Licences should be entered on the Register of Patents, and a registration fee of ten shillings is payable thereon. When the licence is by deed, and no premium or fixed sum is payable on the making, the consideration being therefore

uncertain, it must bear a stamp of ten shillings under The Stamp Act, 1891. Where a fixed sum is paid, an *ad valorem* stamp is required, whether the licence is by deed or otherwise. Where the licence contains a provision for the payment of a minimum royalty, the revenue authorities require the payment of duty upon the gross minimum royalty reserved, although the licence may contain power for either of the parties to terminate the licence at any time.

One or two simple forms of Licences will be found in Appendix B, page 458.

Forms of Licences.

COMPULSORY LICENCES.

Up to the 18th December, 1902, petitions for the grant of Compulsory Licences were made under Section 22 of the Act of 1883. The privilege was but little taken advantage of. From 1883 to 1897 only three applications appear to have been made, and none of these reached a hearing. After that date, however, a few petitions were heard, and the reports of these are the only examples of practice at present available.

Old provisions re Compulsory Licences.

By Section 3 of The Patents Act, 1902, the hearing of these petitions is taken out of the hands of the Board of Trade and is relegated to the Judicial Committee of the Privy Council. Section 22 of the Principal Act being repealed. At the present time the petition is still presented to the Board of Trade, which acts as a species of filter before the petition is referred to the Judicial Committee. The duties of the Board are to consider the petition and to endeavour to adjust the differences between the parties. If this cannot be done, the Board, if satisfied that a *prima facie* case has been made out, refers the petition to the Judicial Committee. If the petitioner satisfies the Judicial Committee that the reasonable requirements of the public have not been met, or if it is proved that the patent is worked mainly or exclusively abroad so as to defeat the reasonable requirements of the public, or so as to prejudice existing industries or prevent the establishment of new ones, then the Committee have the power to order Compulsory Licences, or, if they think fit, to revoke the patent. The awarding of costs is in the discretion of the Committee.

Practice now in force.

Functions of Board of Trade.

Reference to Judicial Committee.

Restraint of trade.

Petitioner's
interest.

According to Sub-section 1 of Section 3 of the Act of 1902, "any person interested" may present the petition, and Rule 69 of the Patents Rules, 1903, provides that the petition shall show clearly the nature of the petitioner's interest and the grounds upon which he claims to be entitled to relief. As the terms of the new rule do not essentially differ from those of the old rule it is to be presumed, in the absence of reports of proceedings under the Act of 1902, that the decisions under the former section will act as a guide as to what interest is required to give the petitioner *locus standi*. Exactly what interest is necessary can scarcely at present be defined. Where the complaint is that the reasonable requirements of the public with respect to the invention have not been satisfied, it would seem that the different divisions of the public, political or otherwise, should be considered; and that, for example, a Liberal journal has a right to be placed in as favourable a position as a Conservative journal with regard to an invention for rapidly effecting changes in evening editions (*Hulton and Bleakley's Petition*, [1898] 15 R. P. C. 749). A petitioner who asserts that the patent is not being worked in the United Kingdom should prove himself or some other co-petitioner to be in a position forthwith to manufacture in accordance with the patent (*Continental Gas Gluhlicht Petition*, [1898] 15 R. P. C. 727).

Grounds of
petition.

It would seem that any member of the public who can show that the non-working of the patent or the non-supply to the public, or the withholding of licences on reasonable terms, prejudicially affects his business, has sufficient interest to entitle him to petition.

Procedure
under
Rules 69
to 75.

The procedure governing the presentation of petitions for compulsory licences to the Board of Trade may be gathered from Rules 69 to 75 of the Patents Rules, 1903. These Rules are as follows:—

Petition for
grant of
compulsory
licence or
revocation
of patent.

69. A petition to the Board of Trade for an order under Section 3 of The Patents Act, 1902, shall show clearly the nature of the petitioner's interest and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order, and the name and address of the patentee and any other person who is alleged in the petition to have made default.

70. The petition and an examined copy thereof shall be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any documentary evidence in support, and the petitioner shall simultaneously with or as soon as may be after the leaving of such petition deliver to the patentee and any other person who is alleged in the petition to have made default, copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

Petition and evidence left at Patent Office.

71. The persons to whom such copies are delivered by the petitioner may, within fourteen days after being invited to do so by the Board of Trade, leave at the Patent Office the affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and the petitioner may within fourteen days from the date of such last-mentioned delivery leave at the Patent Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply.

Opponent's evidence.

Evidence in reply.

The times prescribed by this Rule may be altered or enlarged by the Board of Trade, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

72. No further evidence than as aforesaid may be left by either side at the Patent Office except by leave or requisition of the Board of Trade and upon such terms, if any, as the Board may think fit.

Closing of evidence.

73. The Board of Trade shall consider the petition and the evidence, with a view to satisfying themselves whether a *prima facie* case has been made out for proceeding further with the petition, and if they are not satisfied they shall dismiss the petition.

Board of Trade may dismiss petition.

74. If they are so satisfied, they shall consider whether there is any probability of an arrangement being come to between the parties, and if it appears to them that there is any reasonable probability that such an arrangement can be come to, they may take such steps as they consider desirable to bring it about, and in the meanwhile may defer the reference of the petition to the Judicial Committee of the Privy Council.

Arrangement between parties.

75. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties, and are satisfied that a *prima facie* case has been made out by the petitioner, they shall refer the petition to the Judicial Committee, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing Rules, and with certified copies of all entries in the Register of Patents relating to the patent in question, and any

Reference to Judicial Committee.

other information in the possession of the Board which it appears to them may be of service to the Judicial Committee in ascertaining what persons should be made parties to the proceedings before the Committee, and the Board shall give written notice to the parties that the petition has been referred to the Judicial Committee.

Proceedings
before
Judicial
Committee.

The proceedings before the Judicial Committee are regulated by the Privy Council Rules, 1903, which are as follows:—

RULES TO BE OBSERVED IN PROCEEDINGS BEFORE THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL UNDER THE PATENTS ACT, 1902, SECTION 3.

Application
for hearing.

I. On receiving written notice from the Board of Trade that a petition has been referred to the Judicial Committee of the Privy Council, the petitioner shall, after satisfying the requirements of Rules II. and IV., apply to the Judicial Committee to fix a time for hearing the petition.

Formalities
to be
observed by
petitioner.

II. (a) No application to fix a time for hearing the petition shall be made unless the petitioner shall have previously given notice to the patentee, to the opponents, and to any other person claiming an interest in the patent as exclusive licensee or otherwise, that the petition has been referred to the Judicial Committee, that it is his intention to apply to the Judicial Committee on a specified day (which day shall be not less than four weeks from the date when the notice was served or sent) to fix a time for hearing the petition, and that any person desiring to be heard before the Judicial Committee at the time so fixed must enter a *caveat* at the Council Office on or before the day so specified.

Service of
petitioner's
notice.

(b) The said notice shall be served in the usual way, but where the person to be served resides or has his principal place of business outside the United Kingdom, it may be sent to him by post in a registered envelope.

Formalities
to be
observed by
respon-
dents.

III. (a) Any person claiming an interest in the patent as exclusive licensee or otherwise, whether he has received the notice prescribed by Rule II. or not, shall, if he desires to be heard before the Judicial Committee, enter a *caveat* at the Council Office on or before the day specified by such notice, provided always that, if he has not received the said notice, or if he resides or has his principal place of business outside the United Kingdom, he may apply to the Judicial Committee to extend the time for entering his *caveat* on the ground that the time limited by such notice is insufficient.

(b) Every *caveat* shall specify the caveator's address for service, which address shall be within four miles of the Council Office.

IV. An application to the Judicial Committee to fix a time for the hearing of the petition shall be accompanied by eight printed copies of the specification, and by an affidavit of the petitioner showing the persons to whom, and the manner in which, the notice prescribed by Rule II. has been given.

Application to fix time of hearing.

V. The time for hearing a petition shall be fixed by an Order of the Judicial Committee, and shall be not less than four weeks from the day on which the application for fixing the same is made. The petitioner shall, immediately after the issue of such Order, give public notice thereof by advertising the same once at least in the *London Gazette* and in the *Times*, and in such other newspaper or newspapers (if any) as the Judicial Committee may direct. After completing such advertisements, the petitioner shall forthwith lodge an affidavit thereof at the Council Office.

Advertisement of hearing Order.

VI. The statements contained in the affidavits required by Rules IV. and V. may be disputed upon the hearing.

Statements in affidavits may be disputed.

VII. The petitioner shall be entitled to be served by the caveators, not less than three weeks before the day of hearing, with notice of the grounds of their respective objections, if such grounds are different from or additional to those taken by them in the proceedings before the Board of Trade. Copies of all objections, or additional objections, so served as aforesaid, shall be lodged at the Council Office not less than fourteen days before the day fixed for the hearing.

Objections of respondents to be served on petitioner.

VIII. (a) All petitions and other documents lodged at the Council Office shall (unless the Judicial Committee otherwise direct) be printed in the form prescribed by the Patents Rules of the Board of Trade which are in force for the time being, and the parties shall furnish as many copies of the documents lodged by them as shall be required by the Judicial Committee

Documents to be printed.

(b) Parties shall be entitled to have copies of all papers lodged in respect of the petition at their own expense.

IX. No solicitor or agent shall be entitled to conduct proceedings under this Act before the Judicial Committee unless he is a solicitor or agent admitted to practise before the Privy Council in accordance with Her late Majesty's Order in Council of the 6th March, 1896. Such solicitor or agent shall be allowed the same fees, and the same Council Office fees shall be chargeable in respect of proceedings under this Act, as are prescribed by the general Rules applicable to proceedings before the Judicial Committee.

Persons entitled to conduct proceedings before Committee.

X. Applications to the Judicial Committee to fix a time for hearing the petition and on other matters of procedure shall be addressed in the first instance to the Registrar of the Privy Council, who shall take their Lordships' instructions thereon and

Application to fix hearing.

communicate the same to the parties. In cases of doubt the Registrar may, or, if so requested by any of the parties, he shall, enter the application for hearing before their Lordships' Board.

Relaxation
of Rules.

XI. The Judicial Committee may excuse the parties from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice and otherwise as they shall consider to be just and expedient.

Evidence
furnished
to Board of
Trade may
be used
before
Committee.

XII. (a) Any affidavits, statutory declarations, or other documentary evidence which may have been furnished to the Board of Trade, or any copies thereof which may be referred by the Board to the Judicial Committee, may be received in evidence in proceedings under this Act before the Judicial Committee, subject to such cross-examination of any of the deponents as may be permitted by the Judicial Committee. The Judicial Committee may require the production of any original documents copies of which are tendered in evidence under this Rule.

(b) The parties may tender before the Judicial Committee such further documentary or other evidence as they may be advised.

Reference
for report.

XIII. The Judicial Committee may refer any matters in connection with proceedings under this Act to be examined and reported on in the same manner as matters may be referred by them under Section 17 of the Act 3 & 4 Will. IV. c. 41 (Judicial Committee Act, 1833).

Privileges
of counsel
appearing
for Crown.

XIV. The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition. Counsel on behalf of the Crown is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Committee.

Costs.

XV. Costs incurred in the matter of any petition under this Act shall be taxed by the Registrar of the Privy Council or other officer deputed by the Judicial Committee to tax the same, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

The Act of 1902 will be found consolidated with the Principal Act in Appendix C, page 499.

Provisions
for
revocation.

It should be noted that the provisions for revocation of the patent as a result of a petition for compulsory licence under Sub-sections 3 and 5 of Section 3 of The Patents Act, 1902, are new. By Sub-section 4 of Section 3, on the hearing of any petition under the section, not only the patentee, but any person claiming an interest in the patent as exclusive licensee or otherwise, may be made party to the proceeding.

The repealed section of the Principal Act made no express provision for the intervention of interested third parties (other than the patentee) as opponents to the petition, but it has been the practice to allow licensees so to appear (*Gormully and Jeffery, re Dunlop's Patents*, [1899] 16 R. P. C. 641). The mere fact that a patentee had granted a licence, even when such licence was exclusive, never, however, influenced the Board against granting additional licences (*Hulton and Bleakley's Petition*, [1898] 15 R. P. C. 749), and probably will not influence the Judicial Committee.

Interested parties other than patentee.

The provision in Sub-section 5 of Section 3 for ordering compulsory licences or revoking the patent where it is not worked in the United Kingdom are, it will be noticed, always subject to its being proved that the reasonable requirements of the public are not being satisfied. The sub-section does not make it obligatory that a foreign patentee, for example, should work his British patent in the United Kingdom, or even that he should grant licences. As the next Sub-section (6) indicates, if the reasonable requirements of the public are met (*e.g.* by sufficient importation and sale at a reasonable price), so long as no native industry is unfairly prejudiced or fettered, no actual working of the invention in this country will be required. It remains to be seen what view the Judicial Committee will take of the "reasonable requirements" phrase, but it may be presumed that no arbitrary pressure will be put upon a foreign patentee to compel him to work his invention in the United Kingdom.

Satisfaction of reasonable requirements of public.

A consideration of Sub-section 9 as to the discretion of the Judicial Committee in awarding costs makes it plain that before presenting his petition the petitioner should make every effort to obtain a licence from the patentee upon reasonable terms. This was also the rule under the repealed section (*Levinstein's Petition*, [1898] 15 R. P. C. 732).

Reasonable efforts to arrange with patentee should be made before petitioning.

Since the coming into force of Section 3 of The Patents Act, 1902, up to the time of going to press, only two petitions for compulsory licences have been made, and both of these were settled before the hearing. There are therefore no reports of hearings under the new procedure at present available.

CHAPTER XXIII.

AGREEMENTS.

AGREEMENTS, either conclusive or of a preliminary or executory nature, sometimes play an important part among documents affecting the working and proprietorship of patents and inventions.

Agreement
prior to
application.

Inventor
and
capitalist.

Registra-
tion.

Joint appli-
cants or
patentees.

Agreements may be made either before or after an application for the grant of a patent, and may be for divers objects. For example, if a poor inventor should make an application in conjunction with a person who has had no share in evolving the invention, but whose functions will be those of paying the expenses of obtaining the patent and of introducing the invention commercially, such an arrangement should form the subject-matter of an agreement prior to the application being made; for if this is not done, the mere presence of the co-applicant's name on the patent would vest him with equal proprietary rights, which it might be difficult to disprove if he should afterwards refuse to enter into the intended agreement. Other reasons for agreement might arise in the case of a money loan from someone to pay the cost of the patent and afterwards to introduce it, the lender to acquire a share in the patent. Such pre-application agreement should distinctly identify the invention (*per* North, J., in *Parnell's Patent*, [1888] 5 R. P. C. 126); otherwise the Comptroller might refuse to register it (if this should afterwards become necessary) on the ground that he had no means of verifying the representation that the invention mentioned in the agreement was the same as that afterwards protected.

In the case of joint applicants or patentees, an agreement might be made between them, either before or after the grant of the patent, which will limit and define the respective rights of the parties, so that no one should

have an undue advantage over his co-patentees. Such severance of joint ownership would prevent the share of any deceased co-patentee from passing by survivorship to the surviving patentee (*National Co. v. Gibbs*, [1899] 16 R. P. C. 339).

Severance of joint ownership.

A share in an invention, and in the patent to be afterwards obtained, may be purchased even before application is made for a patent, and an agreement may be based upon this sale, in which the inventor binds himself to assign a share in the patent as soon as it shall have been issued; but care must be taken clearly to identify the invention referred to in the agreement with the invention protected or patented.

Agreement for share of patent.

Legally, until the Letters Patent are actually sealed and issued, there is no vendible property existing: therefore an absolute assignment by deed of a patent for which application only has been made is not effectual. All that can be done is to make an agreement to assign when the patent is issued, and specific performance of such a contract will always be enforced (*per* Farwell, J., in *Jandus v. Johnson*, [1900] 17 R. P. C. 361), or, if conditional to do so on the sealing of the patent, the happening of that event would cause the agreement to operate as an assignment (*Cartwright v. Amatt*, [1799] 2 B. and P. 43).

No property in patent till sealed.

When a sole licensee agrees to sell his rights, and the Letters Patent are afterwards assigned to another party subject to the rights of the licensee, the concurrence of the assignee of the Letters Patent is not necessary in completing the sale of the sole licence (*Frentzell v. Dougill & Meyer*, [1904] 21 R. P. C. 641).

Agreement to sell sole licence.

The question of the registrability of agreements of the foregoing nature will be referred to in the following chapter on the Register of Patents.

As a groundwork for drafting Agreements relating to letters Patent the reader is referred to the short precedents which are to be found in Appendix B, at page 458.

Forms of Agreements.

CHAPTER XXIV.

THE REGISTER OF PATENTS.

Object of
Register.

WHEN a patent is sealed the Comptroller causes it to be entered by its date, number, and title, together with the name of the patentee, in the Register of Patents, which is a book kept at the Patent Office and containing particulars of everything affecting the existence and proprietorship of each patent so entered. Thus, the Register contains entries of assignments, licences, amendments, extensions, revocations, payments of renewal fees, and other incidents in the life of a patent.

Registra-
tion of
assign-
ments.

Assignments, whether of the whole or of a part of a patent, or assignments of a patent for a limited or local field only, are all competent to be placed on the Register by the assignee, who is registered as absolute proprietor or as proprietor to the extent of the interest provided for in the deed. An assignee is not compelled to register his assignment, but if he fails to do so he runs the risk of having his claim defeated by someone else who does register (*per* Lindley, M. R., in *New Irion Co. v. Spilsbury*, [1898] 15 R. P. C., at p. 571).

Registra-
tion
necessary
to protect
assignee.

Register as
evidence.

The Register is *prima facie* evidence of any matters inscribed therein (Section 23, Sub-section 2).

Trusts not
entered.

No notice of any trust, express, implied, or constructive, will be entered on the Register (*Haslett v. Hutchinson*, [1891] 8 R. P. C. 457), but registration of an assignment containing trusts would not be refused. For example, it was held in *Stewart v. Casey* ([1891] 9 R. P. C. 9) that on the true construction of Sections 23, 85, and 87 of the Patents Act of 1883 (and the Patents Rules of 1883), Section 85 only excludes from the Register simple notices of trust, and not documents affecting the proprietorship of a patent, whether by creating trusts or otherwise; and that equitable

Equitable
assign-
ments.

assignments of a patent, or of a share in a patent, may be entered on the Register as documents affecting the proprietorship.

Documents dated before the sealing of Letters Patent, but after the date of application, will be accepted for entry on the Register, but only after the sealing of the patent.

Documents dated before sealing.

In the majority of cases documents referring to dealings with an invention before application has been made for a patent are not capable of being entered on the Register at any time. The reason is that the Comptroller would have great difficulty in satisfying himself, except in rare instances, that the invention referred to in the document sought to be registered was the same as that afterwards protected and patented. For example, suppose that the invention referred to in the document was described simply as "Improvements in Prime Movers," without any further particularisation or means of identification, and that the application afterwards made had precisely the same title, it will be easily seen that this title might serve for fifty different inventions, and that the invention contemplated in the document might have been for an improvement in the cut-off valve of a steam engine, while the application, although bearing the same title, might refer to an entirely different part of, and be applicable to, an entirely different class of motor.

Documents dated before application.

Instance of non-registrable document.

Still, it is evident from the words of North, J., in *Parnell's Patent* ([1888] 5 R. P. C. 126), that where the invention referred to in the document and the invention afterwards patented are *unquestionably* the same, registration will not be refused. Therefore, in such an agreement a sketch and description of the invention should be attached so as to identify it with the subject-matter of the application to be afterwards made.

The pre-application document must identify invention.

An agreement to be capable of registration must be in writing, and therefore agreements by word of mouth cannot be registered. Further, the agreement must be complete, for an incomplete agreement can give no legal or equitable title to the ownership of a patent (*Fletcher's Patent*, [1893] 10 R. P. C. 252; *Haslett v. Hutchinson*, [1891] 8 R. P. C. 457).

Registrable matter must be in writing.

Mortgages.

No mere mortgagee can be entered as proprietor of a patent, but it seems that a notification of his interest may be entered on the Register, the mortgagor remaining on the Register as legal owner.

Assignments by deed.**Equitable assignments.**

An assignment of a patent must be by deed, and the assignee, by virtue of such a legal assignment, can get himself placed on the Register as owner of the patent. Nevertheless, as intimated in the last chapter, other documents not constituting legal assignments under seal, but operative as equitable assignments, may be entered on the Register (under Section 23 of the Act, in combination with the Patents Rules, 1903) as affecting the proprietorship of the patent (*Stewart v. Casey*, [1891] 9 R. P. C. 9): that is to say, that although an equitable assignee cannot, on that account alone, get himself put on the Register as proprietor, nevertheless the recording on the Register of his equitable right and interest acts as a protection, in so far as it gives notice to others of his claim in equity to have the proprietorship altered at law.

Alteration of proprietor's name.

The Comptroller has power under Sections 78 and 87 to alter the name of a corporate body or patentee entered as proprietor on the Register as and when such alteration of name arises by operation of law. Thus, a company altering its designation, or a woman changing her name by marriage, or a man by deed poll, can have the alteration made on the Register (*ex parte New Ormonde Cycle Co.*, [1896] 13 R. P. C. 475).

Correction of clerical errors.

Clerical errors in the name or address of a registered proprietor of a patent may be corrected under Section 91 of the Act on request in writing addressed to the Comptroller, and accompanied by the prescribed fee.

Varying the Register by order of Court.

Power is given to the Court by Section 90 to make, expunge, or vary entries in the Register on the application of any person aggrieved. The Court may direct an issue to be tried for the decision of any question of fact, and may award damages and costs to the party aggrieved. The application may be made by summons or notice of motion. When the registered proprietor against whom the application is directed is domiciled in Scotland or Ireland,

it has been contended that the Courts there have no special jurisdiction in such cases, and the proceedings are generally instituted in the High Court. However, it is well to note here that although the Irish Court, in *Bayer v. Connell* ([1897] 14 R. P. C. 275), disclaimed jurisdiction, the Court of Session in Scotland, in *Cowie v. Herbert* ([1897] 14 R. P. C. 436), was of opinion that it had jurisdiction to entertain a petition for rectification of the Register. If the registered proprietor is a foreigner domiciled abroad, the accepted course is to serve the Comptroller with copies of the summons or notice of motion with an intimation of the date of hearing, which will apparently be transmitted by the Comptroller to the foreign proprietor (*La Compagnie Générale &c.*, [1891] 8 R. P. C. 446).

Jurisdiction
of Scottish
and Irish
Courts.

Service
abroad.

An appeal lies from the Court of First Instance to the Court of Appeal.

Appeal.

It is the duty of any person in whose favour an order of extension or revocation of a patent has been made to carry the order to the Patent Office, and see that the purport of the order is duly entered on the Register (Patent Rule 60).

Entry of
order in
Register.

When a person becomes entitled to a patent, or to an interest therein, by agreement, or by transmission, or by operation of law, he should forward a request to the Comptroller for the entry of his name on the Register as complete or partial owner of the patent.

The request should be made according to Form "L," and should be signed by the person requesting to be registered as proprietor.

Form of
request to
enter on
Register.

A body corporate may be registered as proprietor in its corporate name, and in such a case the request should be signed by an authorised agent or by the secretary or other proper officer.

Body cor-
porate.

The request—on Form "L" in the case of an assignment and on Form "M" in the case of a licence—should be accompanied by the original assignment, licence, or other document, and by an attested copy of the same, which is retained by the Comptroller.

Documents
to accom-
pany
request.

Collateral documents.

If the assignment or other instrument should refer to a document or documents affecting the title and not in the possession of the Comptroller, the original or an official or attested copy must be left with the Comptroller.

Certified extracts.

Certified extracts from the Register are furnished by the Comptroller on payment of a small fee, and the Register is open to the inspection of the public every weekday. Thus a proposing purchaser or licensee can satisfy himself concerning all registered dealings with the patent.

Rectification by Court.

Where rectification of the Register has been ordered by the Court, the order directs due notice of the rectification to be given to the Comptroller, who will thereupon amend the Register.

Any person desiring to have due notice given him of any application or request to alter the Register may advise the Comptroller of his desire, whereupon the Comptroller will notify him as and when occasion arises.

CHAPTER XXV.

MISCELLANEOUS.

OFFENCES AND PENALTIES: PATENT MEDICINES: PATENT AGENTS.

Offences and Penalties.

SECTION 105 of the Act of 1883 provides that "Any person who represents that any article sold by him is a patented article when no patent has been granted for the same, shall be liable for every offence, on summary conviction, to a fine not exceeding five pounds."

Falsely representing an article as patented.

A person shall be deemed to represent that an article is patented if he sell the article with the word "Patent," "Patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed, or otherwise applied to the article.

It is apparently not an offence under this section to continue to mark an article as "Patent" after the patent has expired, but the number and year of the patent should be added so as not to deceive the public (*Ransome v. Graham*, [1882] 51 L. J. Ch., at p. 903).

Expired patent.

Where an invention has been provisionally protected only, it is an offence to mark it as "Patented" (*Reg. v. Wallis*, [1885] 3 R. P. C. 1; *Reg. v. Crampton*, [1886] 3 R. P. C. 367). In such a case the best course is to mark on the article "Patent applied for, No. . ." Where a Complete Specification has been accepted by the Patent Office, the applicant is declared by Section 15 to have "the like privileges and rights as if a patent for the invention had been sealed," except the right to sue infringers. It is submitted that this gives him the right to stamp his goods "Patent." At all events, in *Reg. v. Townsend* ([1896] 13 R. P. C. 265) the prosecution failed as against an applicant who had done so.

Inventions provisionally protected.

Complete Specification accepted.

Use of
Royal
Arms.

The succeeding section (106) forbids the use, except under authority, of the Royal Arms, or of arms deceptively similar thereto, in the carrying on of any business or calling, and so as to lead to the belief that the said business or calling is being carried on under royal or official authority or patronage. The maximum fine on summary conviction is twenty pounds.

False entry
on Register.

By Section 93 of the Patent Act any person making a false entry in the Register of Patents, or producing in evidence any writing falsely purporting to be a copy of any entry therein, is guilty of a misdemeanour.

Patent Medicines.

Offence to
describe
stamp
medicines
as patent.

What are popularly known as "Patent Medicines" are distinct from patented inventions, and the term is a misnomer, which it is apparently no longer legal to use in the way of business. Under The Stamp Medicines Act, 1812, stamps, for application to any particular proprietary medicine, may be had from the Secretary of Stamps and Taxes, Inland Revenue, Somerset House, London. The applicant is required to pay for the preparation of the plate from which his stamps are to be printed, and this plate is kept in the custody of the Secretary, and used only for the purpose of printing the stamps which the owner may require.

As has been said, such stamped proprietary medicines have hitherto been marked, known, and sold as "Patent Medicines," although not the subject of Letters Patent. Now, however, it is clear that, strictly speaking, anyone describing and selling medicines of this description as "Patent Medicines" might be liable to a penalty. In *Pharmaceutical Society v. Piper* ([1893] L. R. 1 Q. B. 686) Collins, J., distinctly held that patent medicines meant "Medicines the subject of Letters Patent."

Patent Agents.

Registra-
tion of
Patent
Agents.

Under the Supplementary Patents Act of 1888 it was provided that after the 1st of July, 1889, no person shall be entitled to describe himself as a Patent Agent,

whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a Patent Agent. Any person contravening the section is liable on summary conviction to a fine not exceeding twenty pounds. The term "Patent Agent" means exclusively an agent for obtaining patents in the United Kingdom. The passing of this Act was a most necessary recognition of the importance to the public of the Patent Agent's profession. Up to the date of the Act there had been no means whatever of excluding incompetent persons from practising, much to the detriment of the public. In forming the Roll it was of course impossible to shut out many with very slender claims to admission. But it may fairly be said that the great body of the profession as it now exists has attained a very high standard of efficiency. Admission to the Roll is now only to be obtained after proof of proper professional training as a pupil under a registered Patent Agent, and after passing very searching qualifying examinations, which are held from time to time under the Register of Patent Agents Rules, 1889 to 1891.

Penalty for false description as "Patent Agent."

Admission to Roll by examination.

It seems that, by the very narrow interpretation of the Act of 1888, an unregistered person can only be convicted if he has expressly described himself as a "Patent Agent." To call himself a "Patent Expert" was held not to be an offence (*Graham v. Eli*, [1898] 15 R. P. C. 259). A person *bonâ fide* in business as a Patent Agent before the commencement of the Act is entitled to registration, but if he continues to practise without being registered he commits an offence (*Starey v. Graham*, [1899] 1 Q. B. 406; 16 R. P. C. 106). An annual fee is payable by all registered agents. A person who omits to pay this fee is struck off the Roll, and if he continues to practise is liable to prosecution (*Institute of Patent Agents v. Lockwood*, [1894] 11 R. P. C. 374; [1894] App. Cas. 347). In the latter case it was held that the Patent Agents Rules under the Act of 1888 were neither unreasonable nor *ultra vires*, but were of the same effect as if they were contained in the Act; and in *Starey v. Graham* (*supra*) the Divisional Court held that if the Rules of 1889 had been repealed as contended by the appellant they were revived by the Rules of 1891.

Persons entitled to registration.

Annual fee payable.

Rules of 1889.

Rules of
1889.

The Register of Patent Agents Rules of 1889, as amended by the Rules of 1891, are the Board of Trade Rules now in force which relate to the admission and regulation of Patent Agents.

Rules of
1903.

By Rule 81 of the Patents Rules of 1903 the Comptroller is authorised by the Board of Trade to refuse to recognise or to communicate with any person as Patent Agent whose name has been struck off the Roll for malpractices.

Chartered
Institute of
Patent
Agents.

The Institute of Patent Agents, which was intended to constitute a representative body of the Patent Agents of the United Kingdom, was formed in 1882, and was incorporated by Royal Charter in 1891. The Fellows of this Institute have alone the privilege of styling themselves Chartered Patent Agents. The transactions of the Institute are published annually in a volume edited by the Secretary.

CHAPTER XXVI.

FOREIGN AND COLONIAL PATENTS, AND THE INTERNATIONAL CONVENTION.

THE International Convention and the enabling Patents Act of 1901 have already been shortly referred to in Chapters I. and II. The 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 international rights, chiefly to the abstract species of industrial property constituted by Patents for Inventions, Copyright in Designs, Trade Marks, and Trade Names. The original 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 as originally concluded 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 or wrongful appropriation of the invention in a foreign country, if such had taken place in the interim, and causing the different patents to start from an equal date. But at the conference held under the Convention on the 14th December, 1900, some of the original provisions were 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—

The International Convention of 1883.

- (1) The extension of the time within which subjects and citizens of countries, members of the Convention, might mutually make applications for

Proposed amendments on the Convention.

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.

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.
- (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 party 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, page 450.

The Convention is of importance to the British inventor who, having protected his invention in this country, desires also to obtain patents abroad. As the Digest of Foreign and Colonial Laws which appeared in former editions of this book has not been included in the present edition, a few words of general advice may not come amiss. If the British inventor takes advantage of the terms of the International Convention he may file a foreign application, based upon his British Complete Specification, at any time within twelve months from the date of his British application. But let it be noted that this applies only to those countries which are parties to the Convention or with whom the British Government has made reciprocal arrangements.

The Convention as affecting British Inventors.

If on the other hand the applicant lets his opportunity slip, by allowing the twelve months to elapse without making a foreign application, there are still certain countries, some of them members of the Convention, in which patents may be obtained (a) before the publication of the Complete Specification in this country, and (b) after the publication of the Complete Specification and the issue of the British patent.

Patents obtainable independently of the Convention.

As a guide to those inventors who adopt the wiser course of filing their foreign applications within twelve months of the British application in accordance with the Convention, or in virtue of reciprocal arrangements made with the British Government in terms of the Convention, a list of the countries and colonies in which they may so apply is appended. The advantage of making application under the Convention is that the foreign patent is dated as of the date of the original British application. The full term of the foreign patent is granted independently of the lapsing of the British patent from whatever cause. Publication, or the prior application of another person for the same invention in the foreign country

Advantages of applying under the Convention.

after the date of the British application, would have no hurtful effect. A common minimum period of three years is fixed within which no foreign patent is forfeited for non-working in those States where working the patent is a statutory requirement.

In the following list of countries, those which are adherents to the International Convention are marked with an asterisk (*), and those outside of the Convention, but between whom and Great Britain a reciprocal arrangement exists, are marked with a dagger (†):—

List of countries adhering to Convention.

America (U.S.),* Belgium,* Brazil,* Cuba,* Denmark,* France,* Germany,* Honduras,† Italy,* Japan,* Mexico,* New Zealand,* Netherlands,* Norway,* Paraguay,† Portugal,* Queensland,* Serbia,* Spain,* Sweden,* Switzerland,* Tasmania,† Tunis,* Uruguay,† Western Australia.†

The principal countries in which a valid patent may be obtained after the publication of the Complete Specification in Great Britain but before the Complete has been introduced abroad (and in some cases even after the Complete has made its appearance abroad and after the sealing of the British patent) are—

Countries in which patents may be obtained apart from Convention under varying conditions.

Argentine Republic, Bahamas, Belgium* (for patents of importation), British Guiana, British Honduras, British South Africa, Canada (if application is made within twelve months from actual sealing of British patent), Cape Colony, Ceylon (if application is made within twelve months of actual sealing of British patent), Chili, Columbia, Costa Rica, Ecuador, Hong Kong, India (if application is made within twelve months of actual sealing of British patent), Italy,* Jamaica, Luxemburg, Natal, Newfoundland, New South Wales, New Zealand,* Norway,* Orange River Colony, Peru, Portugal* (patents of importation), Queensland,* Russia, South Australia, Spain,* Straits Settlements, Switzerland,* Transvaal, Trinidad, Turkey, Venezuela, Victoria, West Australia.†

It will be noticed that some of these countries are adherents to the Convention. Of course, it must be understood that the above does not exhaust the list of countries in which the British inventor may obtain

patents. There are other States which, like Austria, for example, are neither members of the Convention nor adherents to any special arrangement, and in which patents can only be obtained under their own laws and before any publication has taken place in Great Britain. Any patent agent will supply a complete list of such countries, or the reader is directed to former editions of this work, in which digests of the laws of each foreign country are set out.

In America it is possible, apart from the Convention, to obtain a valid patent after the twelve months and after the filing of the Complete in this country if the U.S. application is made before the acceptance and publication of the British Complete, and if the sealing of the British patent can be delayed until after the issue of the U.S. patent. But this is usually almost a physical impossibility, as the British patent is sealed as soon as may be after the expiring of the period for opposition. Formerly it was possible for an astute applicant to delay the sealing of his British patent by getting up a bogus opposition and so delaying the grant. But that can no longer be done with impunity (see *A. B.'s Application*, [1902] 19 R. P. C. 403).

In all of these countries, under the conditions of the second list, the patent would be dated as of the day of application abroad, and not from the date of the original British application as would be the case under the Convention. This, of course, subjects the applicant to additional risks, and the patent being granted not independently of but subject to the British patent, the patentee is left to fulfil the conditions of "working" proper to each country, and the length of grant is in most cases determined by the life of the British patent, except in America, where the patent is always granted independently of other patents for seventeen years without renewal taxes or without any conditions as to working.

In most foreign countries patentable "subject-matter" is the same as in Great Britain, except that in France pharmaceutical compositions and medicines of all kinds cannot be patented. In Germany articles of food, drinks, pharmaceutical compositions, and the products of chemical processes cannot be patented, although chemical processes

Disadvantages of non-Con-vention patents.

Subject-matter in foreign countries.

are patentable. In Switzerland no patents are granted for inventions which do not in themselves represent a visible and tangible marketable article. Therefore new processes and methods of manufacture are unpatentable, although the products of new processes may be patented. In America processes which consist solely in the operation of a machine are not patentable (*Risden v. Medart*, [1895] 71 Off. Gaz. 751; since upheld in *Travers v. Gem Hammock Co.*, 75 Off. Gaz. 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. It used to be the Office rule in America never to allow the inclusion in one patent of claims for a process and claims for apparatus to carry out the process, no matter how interdependent these might be. Two separate patents were always required. But in *U.S. v Allen*, [1904] Off. Gaz., vol. cix., p. 549, the Supreme Court decided that the Patent Rule 41, which forbade such inclusion, was *ultra vires* and invalid. In accordance with this decision henceforth claims for a process and claims for the apparatus necessary to carry on the process may be included in one patent.

New American Office Rule as to process with apparatus patents.

Conditions for keeping foreign patents in force.

With the exception of the United States most foreign countries require the payment of annual taxes to keep the patent in force, and certain countries require the patent to be "worked" at stated intervals or continuously. These and other onerous requirements are, however, so various, and changes in practice are so frequent, that the inventor is advised to consult some experienced patent agent who is in daily contact with matters affecting foreign patents.

The text of the Convention as amended in 1900, together with the qualifying Final Protocol, will be found set out at length in Appendix A, page 450.

PATENTS RULES, 1903 TO 1905

(CONSOLIDATED.)

NOTE.—The repealed Rules of 1903 are omitted, and the substituted and added matter from the Rules of 1905 is printed in heavier type.

BY virtue of the provisions of The Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Board of Trade do hereby make the following Rules:—

SHORT TITLE.

1. These Rules may be cited as “The Patents Rules, 1903.”¹ Short title.

2. These Rules (*i.e.* the Rules of 1903) shall come into operation from and immediately after the 12th day of January, 1903.² Commencement.

3. In the construction of these Rules—

“United Kingdom” includes the Isle of Man. Interpretation.

“Foreign Application” means an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order in Council for the time being in force the provisions of Section 103 of the Act of 1883 as amended by any subsequent Act have been declared applicable.

“Convention Application” means an application in the United Kingdom under the provisions of Section 103 of the Act of 1883 as amended by any subsequent Act.

Save as aforesaid, in the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Rule 3 of 1905.

¹ The Rules of 1905 incorporated herewith may be separately cited as “The Patents Rules, 1905.” or the Rules may be cited as “Consolidated.”

² The Rules of 1905 came into operation on the 1st of January, 1905.

FEES.

First
Schedule.

4. The fees to be paid under the said Acts shall be those specified in the List of Fees in the First Schedule to these Rules.¹

SEALING OF PATENT AND PAYMENT OF FEE.

Sealing of
patent and
payment of
fee.Rule 12 of
1905.

4a. If the applicant for a patent desires to have a patent sealed on his application, he must, on or before the last day on which a patent can lawfully be sealed, pay the prescribed sealing fee; and if such fee be not paid, no patent shall be sealed.

First
Schedule.Rule 13 of
1905.

4b. To the fees specified in the First Schedule to the Patents Rules, 1903, shall be added the fee specified in the First Schedule hereto [i.e. *the sealing fee of £1 on Form X*].

FORMS.

Second
Schedule.

5. The forms contained in the Second Schedule to these Rules may, as far as they are applicable, be used in any proceedings under the said Acts or under these Rules, and so far as they relate to the same subject-matter shall be substituted for the forms in the First Schedule to the Act of 1883.²

Second
Schedule.Rule 14 of
1905.

Claims.

5a. To the forms contained in the Second Schedule to the Patents Rules, 1903, shall be added the Form X contained in the Second Schedule hereto; and in the Form C contained in the first mentioned Schedule the following direction shall be added in a marginal note, namely:—"In the preparation of the claim or claims careful attention should be paid to the terms of Rule 4 of the Patents Rules, 1905. Any unnecessary multiplicity of claims or prolixity of language should be avoided."

Rule 12 of
1905.

5b. The prescribed sealing fee should be paid by leaving a the Patent Office Form X in the Second Schedule to these Rules, duly stamped.

¹ The Rules of 1905 imposed an additional sealing fee of £1.

² The Rules of 1905 add a new Form X for the payment of the sealing fee. The forms are not printed in this book, as they may be purchased duly stamped in any post-office.

APPLICATIONS FOR PATENTS.

6. In the case of an application for a patent by the legal representative of a person who has died possessed of an invention, the probate of his will, or the letters of administration granted of his estates and effects, or an official copy of such probate or letters, shall be produced at the Patent Office in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

Application by representative of deceased inventor.

7. Every application for a patent shall be accompanied by a statement of an address (hereinafter referred to as "the address for service") to which all notices, requisitions, and communications of every kind may be sent by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant until a substituted address for service shall be furnished by him to the Comptroller. The Comptroller may in any particular case require that the address for service be in the United Kingdom.

Address for service.

8. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Order of recording applications.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

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

One invention.
Rule 5 of 1905.

Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings, or any of them, so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

Applications for separate patents by way of amendment.

Split-up applications to bear original date.

Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the said Acts and by any Rules thereunder for the time being in force

Date may be altered to give time for procedure.

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

Power of Comptroller to post-date.

Rule 6 of 1905.

9a. If after the leaving of any Complete Specification the Examiner reports that the nature of the invention is not sufficiently disclosed and defined to enable him to make the investigation prescribed by Sub-section 1, and the Comptroller has required amendment of the specification and drawings, or either of them, the application shall, if the Comptroller at any time so direct, bear such date, subsequent to its original date and not later than the date when the requirement is complied with, as the Comptroller may consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.

Claims.

Rule 4 of 1905.

9b. The statement of the invention claimed, with which a Complete Specification must end, shall be clear and succinct as well as separate and distinct from the body of the specification.

Provisional report in case of complete anticipation.

Rule 7 of 1905.

9c. When the Examiner, in prosecution of the investigation prescribed by Sub-section 1, finds that the invention claimed in the specification under examination has been wholly claimed or described in one or more specifications within the meaning of the sub-section in question, he shall, without any further prosecution of the investigation, make a provisional report to that effect to the Comptroller.

If the provisional report of the Examiner made under this Rule be not reversed or altered, it shall be deemed a final report, and the application shall be dealt with as provided by

Sub-section 6. If, however, such provisional report be reversed or altered, the investigation prescribed by Sub-section 1 shall be continued, and a further report shall be made to the Comptroller, and the specification shall be dealt with as provided in Sub-section 5 or Sub-section 6, as the case may require.

9d. The time within which an applicant may leave his amended specification under Sub-section 2 shall be two months from the date of the letter informing him that the invention claimed has been wholly or in part claimed or described in any specification or specifications within the meaning of Sub-section 1.

Time for leaving amended specification.

Rule 8 of 1905.

In any special case the Comptroller may, if he think fit, enlarge the time prescribed by this Rule.

Extension of time.

9e. When the applicant for a patent has been informed of the result of the investigation of the Examiner, made under the provision of Sub-section 1, and the time allowed by Rule 8 for amendment of his specification has expired, the Comptroller, if he is not satisfied that no objection exists to the specification on the ground that the invention claimed therein has been wholly or in part claimed or described in a previous specification within the meaning of that sub-section, shall inform the applicant accordingly and appoint a time for hearing him, and shall give him ten days' notice at the least of such appointment. The applicant shall as soon as possible notify the Comptroller whether or not he desires to be heard. The Comptroller shall, after hearing the applicant, or without a hearing, if the applicant has not attended a hearing appointed or has notified that he does not desire to be heard, determine whether reference ought to be made in the applicant's specification to any, and, if so, what, prior specification or specifications by way of notice to the public.

Hearing by the Comptroller under Sub-section 6.

Rule 9 of 1905.

Decision with or without hearing.

9f. When under Sub-section 6 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows and shall be inserted after the claims:—

Reference to prior specification.

Rule 10 of 1905.

Reference has been directed in pursuance of Section 1, Sub-section 6, of The Patents Act, 1902, to the following specification of Letters Patent No. granted to .

Reference
under
Rule 7.

Where the reference is inserted as the result of a provisional report under Rule 7, a statement to that effect shall be added to the reference.¹

Appeal to
Law
Officer.

APPEAL.

Rule 11 of
1905.

9g. Every decision of the Comptroller under the foregoing Rules shall be subject to an appeal to the Law Officer.

Extension
of time for
leaving and
accepting
Complete
Specifica-
tion.

10. An application for extension of time for leaving or accepting a Complete Specification shall be made on Form Ū or on Form V, as the case may require, and shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary.

Notice and
advertise-
ment of
acceptance.

11. On the acceptance of a Provisional or Complete Specification the Comptroller shall give notice thereof to the applicant, and shall advertise the acceptance of every Complete Specification in the official journal of the Patent Office.

Inspection
of Complete
Specifica-
tion.

12. Upon such acceptance in the case of a Complete Specification, the application and specification or specifications with the drawings, if any, may be inspected at the Patent Office upon payment of the prescribed fee.

APPLICATIONS UNDER THE INTERNATIONAL CONVENTION.

Convention
Applica-
tions.

13. Every Convention Application shall contain a declaration that foreign application has been made for protection of the invention to which such Convention Application relates, and shall specify all the Foreign States or British Possessions in which such foreign applications have been made, and the official date or dates thereof respectively. The application must be made within twelve months from the date of the first foreign application, and must be accompanied by a Complete Specification, and signed by the person or persons by whom such first foreign

¹ Rule 7 corresponds to Rule 9c in the present Consolidation.

application was made. If such person, or any of such persons, be dead, the application must be signed by the legal representative of such dead person, as well as by the other applicants, if any.

14. Every Convention Application, in addition to the specification left therewith, must be accompanied by a copy or copies of the specification, and drawings or documents filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such Foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the Comptroller. If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto, and verified by statutory declaration or otherwise to the satisfaction of the Comptroller.

Foreign specification &c. to accompany Application.

15. If the Complete Specification left with the application be not accepted within twelve months from the date of the first foreign application, it shall, with the drawings, if any, be open to public inspection at the expiration of that period.

Public inspection.

16. Save as aforesaid and as provided by Rule 52, all proceedings in connection with a Convention Application shall be taken within the times and in the manner prescribed by the said Acts or these Rules for ordinary applications.

Proceedings.

17. For Rule 17 of the Patents Rules, 1903, the following Rule shall be substituted:—

All documents and copies of documents, except drawings, sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written, typewritten, lithographed, or printed in the English language (unless otherwise directed) in large and legible characters with deep permanent ink upon strong white paper, and, except in the case of statutory declarations and affidavits, on one side only, of a size of approximately thirteen inches by eight inches,

Size &c. of documents.

Rule 15 of 1905.

leaving a margin of at least one inch and a half on the left-hand part thereof, and the signatures thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

At the top of the first page of a specification a space of about two inches should be left blank.

DRAWINGS ACCOMPANYING SPECIFICATIONS.

Rule 16 of
1905.

Drawings.

18. For Rules 18 to 24 of The Patents Rules, 1903, the following Rules shall be substituted:—

As the drawings are printed by a photo-lithographic process, the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of such process, and calculated to give the best results in the interests of inventors, of the Office, and of the public. The following requirements should, therefore, be strictly observed, as non-compliance therewith will be certain to cause delay in the progress of an application for a patent.

General.

Rule 17 of
1905.

19. Drawings, when furnished, should accompany the Provisional or Complete Specification to which they refer, except in the case provided for by Rule 24. No drawing or sketch such as would require the preparation for the printer of a special illustration for use in the letterpress of the specification when printed should appear in the specification itself.

Require-
ments as
to paper.

Rule 18 of
1905.

20. Drawings may be made by hand or lithographed, printed, &c. They must be made on pure white, hot-pressed, rolled, or calendered strong paper of smooth surface, good quality, and medium thickness without washes or colours, in such a way as to admit of being clearly reproduced on a reduced scale by photography. Mounted drawings must not be used.

Size of
drawings
and
arrange-
ment of
figures.

Rule 19 of
1905.

21. Drawings must be on sheets which measure thirteen inches from top to bottom and are either from eight inches to eight and a quarter inches or from sixteen inches to sixteen and a half inches wide, the narrower sheets being preferable.

If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be continued

on subsequent sheets. There is no limit to the number of sheets that may be sent in, but no more sheets should be employed than are necessary, and the figures should be numbered consecutively throughout and without regard to the number of sheets. The figures should not be more numerous than is absolutely necessary. They should be separated by a sufficient space to keep them distinct.

22. Drawings must be prepared in accordance with the following requirements:—

- (a) They must be executed with absolutely black ink.
- (b) Each line must be firmly and evenly drawn, sharply defined, and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines should be as few as possible, and must not be closely drawn.
- (d) Shade lines must not contrast too much in thickness with the general lines of the drawing.
- (e) Sections and shading should not be represented by solid black or washes.
- (f) They should be on a scale sufficiently large to show the invention clearly, and only so much of the apparatus, machine, &c., should appear as effects this purpose. If the scale is given, it should be drawn, and not denoted by words.

Drawings
to be
suitable
for repro-
duction.

Rule 20 of
1905.

Reference letters and figures, and index numerals used in conjunction therewith, must be bold, distinct, and not less than one-eighth of an inch in height. The same letters should be used in different views of the same parts. Where the reference letters are shown outside the figure, they must be connected with the parts referred to by fine lines.

23. Drawings must bear the name of the applicant (and, in the case of drawings left with a Complete Specification after a Provisional Specification, the number and year of the application) in the left-hand top corner; the number of sheets of drawings sent, and the consecutive number of each sheet, in the right-hand top corner; and the signature of the applicant or his agent in the right-hand bottom corner. Neither the title of the invention nor any descriptive matter should appear on the drawings.

Drawings
to bear the
name of
applicant
&c. but no
descriptive
matter.

Rule 21 of
1905.

Copies of drawings.

Rule 22 of 1905.

24. A facsimile or "true copy" of the original drawings must be filed at the same time as the original drawings, prepared strictly in accordance with the above Rules, except that it may be on tracing cloth and the reference letters and figures should be in black-lead pencil.

Marking of originals and true copies.

The words "original" or "true copy" must in each case be marked at the right-hand top corner, under the numbering of the sheet.

Delivery of drawings.

Rule 23 of 1905.

24a. Drawings must be delivered at the Patent Office, so as to be free from folds, breaks, or creases which would render them unsuitable for reproduction by photography.

Provisional drawings used for Complete Specifications.

Rule 24 of 1905.

24b. If an applicant desires to adopt the drawings lodged with his Provisional Specification as the drawings for his Complete Specification, he should refer to them in the Complete Specification as those left with the Provisional Specification.

STATUTORY DECLARATIONS AND AFFIDAVITS.

Form &c. of statutory declaration and affidavit.

25. The statutory declarations and affidavits required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject. Every statutory declaration or affidavit shall state the description and true place of abode of the person making the same, and shall be written or printed bookwise and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

Manner in which, and persons before whom, declaration or affidavit is to be taken.

26. The statutory declarations and affidavits required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

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

- (B) In any other part of His Majesty's Dominions, before any Court, Judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and
- (c) If made out of His Majesty's Dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, or before a Judge or Magistrate.

INDUSTRIAL OR INTERNATIONAL EXHIBITIONS.

27. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, may, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller notice on Form O of his intention to exhibit, publish, or use the invention, as the case may be. For the purpose of identifying the invention in the event of an application for a patent being subsequently made the inventor shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

Industrial
or inter-
national
exhibitions.

EXERCISE OF DISCRETIONARY POWERS BY THE COMPTROLLER.

28. Before exercising any discretionary power given to the Comptroller by the said Acts or these Rules adversely to the applicant for a patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

Exercise of
discre-
tionary
powers by
Comp-
troller.
Notice of
hearing.

Notice by applicant.

29. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.

Comptroller may require statement &c.

30. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Decision to be notified to parties.

31. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and to any other person who appears to him to be affected thereby.

OPPOSITION TO GRANTS OF PATENTS.

Notice of opposition.

32. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (hereinafter called "the opponent") intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.

Copy for applicant.

Evidence in support of allegation that invention has been obtained from opponent.

33. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification, the opposition shall be deemed to be abandoned.

Attendance of declarant before Comptroller.

34. Where the ground of an opposition is that the applicant has obtained the invention from the opponent,

or from a person of whom such opponent is the legal representative, the Comptroller may request or allow any person who has made a statutory declaration in the matter to which the opposition relates to attend before him at the hearing of the case and make oral explanations with respect to such matters as the Comptroller may require.

35. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice.

Particulars
of prior
patent.

36. Except in the case provided for in Rule 33, statutory declarations need not be left in connection with an opposition, but the opponent may, within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the applicant's Complete Specification, leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Opponent's
evidence.

37. Within fourteen days from the delivery of such copies the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent copies thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Applicant's
evidence.

Evidence
in reply.

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

Applicant's
evidence if
opponent
does not
leave
statutory
declara-
tions.

Opponent's
evidence.

39. Within fourteen days from the delivery of such copies the opponent may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the applicant copies thereof, and within fourteen days from such delivery the applicant may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the opponent copies thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Evidence
in reply.

Closing of
evidence.

40. No further evidence shall be left on either side except by leave, or on the requisition, of the Comptroller.

Hearing.

41. On completion of the evidence, if any, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If either party does not desire to be heard he shall as soon as possible notify the Comptroller to that effect; if either party desires to be heard he must leave Form E at the Patent Office. The Comptroller may refuse to hear either party who has not left Form E prior to the date of hearing. If either party intends to refer at the hearing to any publication other than a specification mentioned in the notice of opposition, he should, unless the same has been referred to in a statutory declaration already filed, give to the other party and to the Comptroller five days' notice at the least of his intention, together with details of each publication to which he intends to refer. After hearing the party or parties desirous of being heard, or if neither party desires to be heard, then without a hearing the Comptroller shall decide the case and notify his decision to the parties.

Notice of
intention
to refer to
additional
evidence.

Decision.

AMENDMENT OF SPECIFICATION.

Request for
leave to
amend.

42. A request for leave to amend a specification must be signed by the applicant and shall contain an address for service in the United Kingdom. When not made in pursuance of an Order of the Court or a Judge

the request must, where a patent has been sealed, also contain a statement that no action for infringement nor proceeding for revocation of the patent is pending. The request must be accompanied by a duly certified copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner, if any, as the Comptroller may in each case direct.

43. Where a request for leave to amend is made in pursuance of an Order of the Court or a Judge, an office copy of the Order shall be left with the request at the Patent Office.

Leave by
Order of
Court.

44. A notice of opposition to the amendment shall be on Form G, and shall state the ground or grounds on which the person giving such notice (hereinafter called "the opponent") intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy, which copy shall be transmitted by the Comptroller to the applicant.

Notice of
opposition.

Copy for the
applicant.

45. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant copies thereof.

Opponent's
evidence.

46. Upon such declarations being left, and such copies being delivered, the provisions of Rules 37, 40, and 41 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Further
proceed-
ings.

47. If the opponent does not leave statutory declarations in support of his opposition, the applicant may (if he desires so to do), within two months from the date of the first advertisement of the application for leave to

Applicant's
evidence if
opponent
does not
leave
statutory
declara-
tions.

amend, leave at the Patent Office statutory declarations in support of his application, and on so leaving shall deliver to the opponent copies thereof.

Further
proceed-
ings.

48. Upon such declarations being left, and such copies being delivered, the provisions of Rules 39, 40, and 41 shall apply to the case, and further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Require-
ments on
amend-
ment.

49. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 17 to 23.

Advertise-
ment of
amend-
ment.

50. Every amendment of a specification shall be advertised forthwith by the Comptroller in the official journal of the Patent Office, and in such other manner, if any, as the Comptroller may direct.

REGISTER OF PATENTS.

Entry of
grant.

51. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and calling of the patentee as the grantee thereof, and the title of the invention, together with the address for service.

Entry in
respect of
Convention
Applica-
tion.

52. The patent granted on any Convention Application shall be entered in the Register as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

Alteration
of address.

53. If a patentee send to the Comptroller on Form R notice of an alteration in his address, the Comptroller shall cause the Register to be altered accordingly, and may require the altered address to be in the United Kingdom.

54. Where a person becomes entitled to a patent, or to any share or interest therein, by assignment, or by transmission, or other operation of law, a request for the entry of his name in the Register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

Request for entry of subsequent proprietorship.

55. Such request shall be on Form L, and shall in the case of individuals be made and signed by the person requiring to be registered as proprietors, or by his agent duly authorised, to the satisfaction of the Comptroller, and in the case of a body corporate by its agent, authorised in like manner.

Form and signature of request.

56. Every such request shall state the name, address, and calling of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be, and the particulars of the assignment, transmission, or other operation of law, by virtue of which he claims to be entered in the Register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Particulars to be stated in request.

57. Every assignment, and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall, unless the Comptroller in his discretion otherwise directs, be produced to him together with the request, and such other proof or title as he may require for his satisfaction.

Production of documents of title and other proof.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the Comptroller.

58. There shall also be left with the request an attested copy of the assignment or other document or copy above required to be produced.

Copies for Patent Office.

Body
corporate.

59. A body corporate may be registered as proprietor by its corporate name.

Entry of
Orders of
the Privy
Council or
of the
Court.

60. Where an Order has been made by His Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an Order has been made for the revocation of a patent or the rectification of the Register under Section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such Order has been made shall forthwith leave at the Patent Office an office copy of such Order. The Register shall thereupon be rectified or the purport of such Order shall otherwise be duly entered in the Register, as the case may be.

Entry of
date of pay-
ment of fees
on issue of
certificate.

61. Upon the issue of a certificate of payment under Rule 68, the Comptroller shall cause to be entered in the Register a record of the date of payment of the fee on such certificate.

Entry of
failure to
pay fees.

62. If a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, there shall be duly entered in the Register a notification of such failure.

Entry of
notification
of licence
or other
document.

63. An attested copy of every licence granted under a patent, or of any other document purporting to affect the proprietorship of a patent, shall be left at the Patent Office with a request on Form M that a notification thereof may be entered in the Register. The accuracy of such copy shall be certified as the Comptroller may direct, and the original document shall at the same time be produced and left at the Patent Office if required for further verification.

Hours of
inspection
of Register.

64. The Register of Patents shall be open to the inspection of the public on every week day except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days and the times following:—

- (a) Christmas Day, Good Friday, the day observed as His Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

- (b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office; or
- (c) Times when the Register is required for any purpose of official use.

65. Certified copies of any entry in the Register, or certified copies of or extracts from patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from Registers and other books kept there, may be furnished by the Comptroller on payment of the prescribed fee.

Certified copies of documents.

PAYMENT OF FEES FOR CONTINUANCE OF PATENT.

66. If a patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.

Payment of fees for continuance of patent.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

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

Enlargement of time for payments.

68. On due compliance with the terms of Rule 66, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

Certificate of payment.

COMPULSORY LICENCES AND REVOCATION OF PATENTS.

69. A petition to the Board of Trade for an order under Section 3 of The Patents Act, 1902, shall show clearly the nature of the petitioner's interest and the

Petition for grant of compulsory licence or revocation of patent.

ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order, and the name and address of the patentee and any other person who is alleged in the petition to have made default.

To be left
with
evidence at
Patent
Office.

70. The petition and an examined copy thereof shall be left at the Patent Office accompanied by affidavits or statutory declarations in proof of the allegations contained in the petition, together with any other documentary evidence in support, and the petitioner shall, simultaneously with or as soon as may be after the leaving of such petition, deliver to the patentee and any other person who is alleged in the petition to have made default copies of the petition and of such affidavits or statutory declarations and other documentary evidence in support.

Opponent's
evidence.

71. The persons to whom such copies are delivered by the petitioner may within fourteen days after being invited to do so by the Board of Trade leave at the Patent Office their affidavits or statutory declarations in answer, and if they do so shall deliver copies thereof to the petitioner; and the petitioner may within fourteen days from such last-mentioned delivery leave at the Patent Office his affidavits or statutory declarations in reply, and if he does so shall deliver copies thereof to the patentee or any other person alleged in the petition to have made default, such last-mentioned affidavits or statutory declarations being confined to matters strictly in reply.

Evidence
in reply.

The times prescribed by this Rule may be altered or enlarged by the Board of Trade, if they think fit, upon such notice to parties interested and upon such terms, if any, as they may direct.

Closing of
evidence.

72. No further evidence than as aforesaid may be left by either side at the Patent Office except by leave or on requisition of the Board of Trade and upon such terms, if any, as the Board may think fit.

Power of
Board of

73. The Board of Trade shall consider the petition and the evidence, with a view to satisfying themselves

whether a *prima facie* case has been made out for proceeding further with the petition, and if they are not so satisfied they shall dismiss the petition.

Trade to
dismiss
petition.

74. If they are so satisfied, they shall consider whether there is any probability of an arrangement being come to between the parties, and if it appears to them that there is any reasonable probability that such an arrangement can be come to, they may take such steps as they consider desirable to bring it about, and in the meanwhile may defer the reference of the petition to the Judicial Committee of the Privy Council.

Arrange-
ments
between
parties.

75. If the Board are not of opinion that there is a reasonable probability of any arrangement being come to between the parties, and are satisfied that a *prima facie* case has been made out by the petitioner, they shall refer the petition to the Judicial Committee, with copies of any affidavits, statutory declarations, or other documentary evidence which may have been furnished under the foregoing Rules, and with certified copies of all entries in the Register of Patents relating to the patent in question and any other information in the possession of the Board which it appears to them may be of service to the Judicial Committee in ascertaining what persons should be made parties to the proceedings before the Committee, and the Board shall give written notice to the parties that the petition has been referred to the Judicial Committee.

Reference
of petition
to Judicial
Committee.

GENERAL.

76. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected if and on such terms as the Comptroller may think fit.

Power of
amend-
ment &c.

77. The times prescribed by these Rules for doing any act or taking any proceedings thereunder, other than the times for lodging evidence referred to in Rule 33 or in the procedure in these Rules relating to compulsory licences and revocation of patents, may be enlarged by

General
power to
enlarge
time.

the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Power to dispense with evidence.

78. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Hours of business.

79. The Patent Office shall be open to the public every week-day except Saturday between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the day observed as His Majesty's birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office.

Leaving documents.

80. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

AGENCY.

81. With the exception of the signing of the following documents—namely, applications for patents, requests for leave to amend applications, specifications, or letters patent, authorisations of agents, notices of oppositions, requests for issue of duplicate letters patent, notices of abandonment of or of intention not to proceed with applications, surrenders of letters patent, and petitions for compulsory licence and revocation of patent—all communications to the Comptroller under the said Acts and these Rules may be signed by and all attendances upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require it, resident in the United Kingdom. The Comptroller shall not be bound to recognise as such agent, or to receive further communications from any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents, kept under the provisions of The Patents, Designs, and Trade Marks Act, 1888, relating to the Registration of Patent Agents, and not since restored. In any particular case the Comptroller may, if he think fit, require the personal signature or presence of an applicant, opponent, or other person.

Agency.

REPEAL.

82. All general Rules relative to patents heretofore made by the Board of Trade under The Patents, Designs, and Trade Marks Acts, 1883 to 1901, and in force on the Twelfth day of January, 1903, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or in any application or other matter then pending.

Repeal.

Dated the 12th day of January, 1903.

Rules of
1903.

Dated the 20th day of October, 1904.

Rules of
1905.

G. W. BALFOUR,
President of the Board of Trade.

FIRST SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.

	£	s.	d.	£	s.	d.
1. On application for Provisional Protection	1	0	0	5	0	0
2. On filing Complete Specification	3	0	0			
3. On notice to seal patent	1	0	0			
<i>or</i>						
4. On filing Complete Specification with first application	4	0	0	5	0	0
5. On notice to seal patent	1	0	0			
6. On appeal from Comptroller to Law Officer. By appellant				3	0	0
7. On notice of opposition to grant of patent. By opponent				0	10	0
8. On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
On application to amend specification:—						
9. Up to sealing. By applicant				1	10	0
10. After sealing. By patentee				3	0	0
11. On notice of opposition to amendment. By opponent				0	10	0
12. On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
13. On application to amend specification during action or proceeding. By patentee				3	0	0
14. On application to the Board of Trade for a compulsory licence. By person applying				1	0	0
15. On opposition to grant of compulsory licence. By opponent				1	0	0
On certificate of renewal:—						
16. Before the expiration of the fourth year from the date of the patent and in respect of the fifth year				5	0	0
17. Before the expiration of the fifth year from the date of the patent and in respect of the sixth year				6	0	0
18. Before the expiration of the sixth year from the date of the patent and in respect of the seventh year				7	0	0
19. Before the expiration of the seventh year from the date of the patent and in respect of the eighth year				8	0	0
20. Before the expiration of the eighth year from the date of the patent and in respect of the ninth year				9	0	0
21. Before the expiration of the ninth year from the date of the patent and in respect of the tenth year				10	0	0
22. Before the expiration of the tenth year from the date of the patent and in respect of the eleventh year				11	0	0

On certificate of renewal (*continued*):—

	£	s.	d.
23. Before the expiration of the eleventh year from the date of the patent and in respect of the twelfth year -	12	0	0
24. Before the expiration of the twelfth year from the date of the patent and in respect of the thirteenth year	13	0	0
25. Before the expiration of the thirteenth year from the date of the patent and in respect of the fourteenth year	14	0	0

On enlargement of time for payment of renewal fees:—

26. Not exceeding one month -	1	0	0
27. „ two months -	3	0	0
28. „ three months -	5	0	0
29. For every entry of an assignment, transmission, agreement, licence, or extension of patent -	0	10	0
30. For duplicate of letters patent - each	2	0	0
31. On notice to Comptroller of intended exhibition of a patent under Section 39 -	0	10	0
32. Search or inspection fee - each	0	1	0
33. For office copies - every 100 words (but never less than one shilling)	0	0	4
34. For office copies of drawings (cost according to agreement)			
35. For certifying office copies, MSS. or printed - each	0	1	0
36. On postal request for printed specification -	0	0	8

On request to Comptroller to correct a clerical error:—

37. Up to sealing -	0	5	0
38. After sealing -	1	0	0
39. For certificate of Comptroller under Section 96 -	0	5	0
40. For altering address in Register -	0	5	0
41. For enlargement of time for filing Complete Specification, not exceeding one month -	2	0	0

For enlargement of time for acceptance of Complete Specification:—

42. Not exceeding one month -	2	0	0
43. „ two months -	4	0	0
44. „ not exceeding three months -	6	0	0

G. W. BALFOUR,

President of the Board of Trade.

12th January, 1903.

Approved—

H. T. ANSTRUTHER,

H. W. FORSTER,

Lords Commissioners of His Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

- A. Form of Application for Patent.**
- A1.** " " " communicated from abroad.
- A2.** " Application for Patent under International and Colonial arrangements.
- B.** " Provisional Specification.
- C.** " Complete " "
- C1.** " Postal request for Printed Specification.
- D.** " Opposition to Grant of Patent.
- E.** " Notice that Hearing will be attended.
- F.** " Application to amend Specification.
- G.** " Opposition to Amendment of Specification.
- H.** " Application for Grant of Compulsory Licence or Revocation of Patent.
- H1.** " Petition for Grant of Compulsory Licence or Revocation of Patent.
- I.** " Opposition to Petition for Grant of Compulsory Licence or Revocation of Patent
- J.** " Application for Certificate of Payment or Renewal.
- K.** " Application for Enlargement of Time for Payment of Renewal Fee.
- L.** " Request to enter Name upon the Register of Patents.
- M.** " Request to enter Notification of Licence or other Document in Register.
- N.** " Application for Duplicate of Patent.
- O.** " Notice of Intended Exhibition of Unpatented Invention.
- P.** " Request for Correction of Clerical Error.
- Q.** " Certificate of Comptroller.
- R.** " Notice for Alteration of an Address in Register.
- S.** " Application for Entry of Order of Privy Council in Register.
- T.** " Appeal to Law Officer.
- U.** " Application for Extension of Time for leaving a Complete Specification.
- V.** " Application for Extension of Time for Acceptance of Complete Specification.
- W.** " Patent.
- X.** " Notice of Desire to have Patent Sealed.

FORM W.

FORM OF PATENT.

EDWARD VII., by the Grace of God, of the United Kingdom of Great Britain and Ireland, and of the British Dominions beyond the Seas, King, Defender of the Faith, Emperor of India: To all to whom these presents shall come greeting:

WHEREAS

hath declared that he is in possession of an invention for

that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as "the said patentee") hath by and in his Complete Specification particularly described the nature of his invention:

And whereas We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted

on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned :

Provided that these our Letters Patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our Letters Patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these Letters Patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at or upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our Letters Patent, and all privileges and advantages whatever hereby granted, shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, We do by these presents, for us, our heirs and successors, grant unto the said patentee that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be made patent and to be sealed as of the

one thousand nine hundred

and

[Here is to be inserted the name of the Comptroller-General.]

*Comptroller-General of Patents, Designs,
and Trade Marks.*



PART II.

TRADE MARKS.

CHAPTER I.

INTRODUCTION.

THE custom of a maker of vendible goods adopting a distinctive mark to affix to his merchandise is very ancient. Origin of trade marks.

Among communities where reading was a rare accomplishment shops and taverns were invariably distinguished not by the names of their owners, but by their signs, and the same appeal to the eye of the unlearned was made for the purpose of distinguishing goods. Antiquarians point to such distinctive makers' marks upon objects identified with various periods in the world's history, and there is no doubt that in the most remote times a workman whose goods had acquired favour by reason of his skill and care marked his products so as to show their origin. From 1300 A.D. to 1600 A.D. it is certain that both in this country and on the Continent the use of merchants' marks was general. Mediæval merchants' marks. These were probably used to distinguish one trader's goods and bales from those of another, so as to prevent confusion in carriage and handling by assistants wholly illiterate. At Charlton, once a centre of the ancient wool industry, a number of leaden seals were recently discovered, dating from the fourteenth century, and formerly used in packing bales of wool. Most of these carried a distinctive mark, one of them (by way of example) bearing the device of a goat together with the letters "M.S." Such marks were hereditary, and, these being the days of one man one mark, a merchant regarded his mark with as much legitimate pride as did the noble

his coat-of-arms. They are to be found carved on buildings and tombs, and even Mother Church was not above complimenting a merchant who had been a liberal donor to her funds by allowing him to place his mark in memorial windows among the blazoned shields of knights and nobles who had done likewise. Such a practice is alluded to in the following extract from "Piers Plowman's Creed," written about the end of the fourteenth century:—

"Wyde wyndowes y-wrought
Y-wryten ful thykke
Shynea with shapen sheldes
To shewen aboute
Wyth merkes of merchauntes
Y-medeled betwene."

Early
recognition
of trade
marks at
Common
Law.

At an early period in our own history the Common Law began to take note of and punish fraudulent imitations of makers' marks, and to recognise and protect the right of the producer or merchant to have his distinctive mark reserved exclusively to himself.

*Southern v.
How, temp.
Elizabeth.*

The first recorded case, although in all probability not the first dealt with by the Courts, is that of *Southern v. How* (*Popham*, 144), which occurred in the reign of Elizabeth, and in which damages were given to a clothmaker or clothdealer—it is not clear which—on proof of piracy of his distinctive mark. It is true that in after cases—as, for example, in *Blanchard v. Hill* ([1742] 2 Atk. 484)—the Courts, suspicious of creating anything that seemed to savour of monopoly, for some time hesitated to declare that there was any actual right of property in a trade mark; but early in the last century this ceased to be a matter of doubt. For example, in the year 1824, in *Sykes v. Sykes* (3 B. & Cr. 541), the danger to the public was first recognised of allowing an improperly applied trade mark on goods, which did not deceive the first purchaser, to go forth to the world, and in changing hands deceive some *ultimate* purchaser who had not the knowledge of the first buyer; while some years later, in *Millington v. Fox* ([1838] 3 My. & Cr. 338), the necessity of proving fraudulent intention under the Common Law on the part of the defendant was done away with. These decisions show

*Blanchard
v. Hill.*
Gradual
recognition
of right of
property in
trade
marks.

*Sykes v.
Sykes.*
Danger of
ultimate
deception of
purchaser.

Proof of
fraudulent
intention
not
necessary.
*Millington
v. Fox.*

that it had become apparent that the exclusive possession of a distinctive trade mark was in no sense a monopoly likely to be injurious to the public, but was in reality a protection to them. Trade mark not a monopoly.

It was of advantage to the trader, because he was thereby enabled to reap with more certainty the custom to which his skill and enterprise entitled him. It was also a protection to the public, because in buying an article which bore a well-known mark they were more certain of getting something which possessed acknowledged and approved qualities. A protection to the public.

The accepted principles upon which the Courts now proceed in trade mark cases are best expressed in the following deliverance of Bacon, V.-C., in *Ransome v. Graham* ([1882] 51 L. J. Ch. 827):—"A manufacturer who produces an article of merchandise which he announces as of public utility, and who places upon it a mark by which it is distinguished from all other articles of a similar kind, with the intention that it may be known to be of his manufacture, becomes the exclusive owner of that which is henceforth called his 'trade mark.' By the law of this country (and the like law prevails in most other civilised countries) he obtains a property in the mark which he so affixes to his goods. The property thus acquired by the manufacturer, like all other property, is under the protection of the law, and for the invasion of the right of the owner of such property the law affords a remedy similar in all respects to that by which the possession and enjoyment of all property is secured to the owners." Bacon, V.-C., on trade marks and their ownership.

It will be noted that the learned Vice-Chancellor in the foregoing quotation speaks only of a "manufacturer" adopting a trade mark for the goods he has made. It must, however, be said that, although this is perhaps the most common ownership of a trade mark, there are many instances where the mark is adopted and applied by those who are not actual makers of the goods to which the mark is attached. Thus one person may weave calico and another may print or bleach or pack it, and a trade mark might be applied by the printer or bleacher or packer, and be registered by him and recognised as his alone. Persons entitled to acquire and use trade marks.

(*re Sykes*, [1880] 43 L. T. N. S. 626); or the mark might be applied by a mere middleman, who has no share whatever in the manufacture or treatment of the goods, such as an exporter or importer, who merely sells or buys (*Ralli v. Fleming*, Ind. L. R., 3 Calc. 417; *re Apollinaris Co.*, [1891] 2 Ch. 186; 8 R. P. C. 137); or by a person who has selected the goods (*re Australian Wine Importers Co.*, [1889] 6 R. P. C. 311; 41 Ch. D. 278; *Leahy v. Glover*, [1893] 10 R. P. C. 141). In all of these cases the mark belongs to the middleman, and the actual manufacturer, who supplies him with the goods to which the mark is affixed, has no claim to any share in it.

Trade marks applicable to natural products.

But, apart from manufactured goods, trade marks might be used to distinguish substances which are natural products, such as moulders' sand, coal, mineral waters, mineral oils, fruit, and the like. Even the name of a natural product may be appropriated as a trade name to an individual if he alone has exclusive access to the natural product (*Apollinaris Co. v. Norrish*, [1875] 33 L. T. N. S. 242; *Radde v. Norman*, [1872] L. R. 14 Eq. 348).

Trade marks not registrable before 1875.

Previous to 1875 no means existed for acquiring and protecting trade marks by registration. It was occasionally the practice to enter a trade mark at Stationers' Hall; but this conferred no protection whatever. Therefore in bringing an action against an infringer it was necessary to depend entirely upon the Common Law right, and to prove prescriptive user before the plaintiff's right to take action was admitted.

Merchandise Marks Acts, 1862 and 1887.

Trade Marks Registration Acts, 1875 to 1877.

Patents, Designs, and Trade Marks Acts, 1883 to 1901.

The Merchandise Marks Act, 1862, had for its main object to subject infringers of trade marks to the operation of the Criminal Law, and the same is the case under The Merchandise Marks Act, 1887. But before the latter date registration had been provided for by The Trade Marks Registration Acts, 1875 to 1877, and at the present time registration is governed by The Patents, Designs, and Trade Marks Acts, 1883 to 1901.

Registration of trade marks is granted to aliens, and the rights of aliens in their marks are protected in the English Courts as rigorously as if they belonged to British subjects.

CHAPTER II.

ON THE NATURE AND DEFINITION OF
A TRADE MARK.

PASSING over in the meantime the definitions of trade marks as set out in The Merchandise Marks Acts, 1862 and 1887, and as in The Trade Marks Act, 1875, the present statutory definition of a trade mark is to be found in Section 64 of the Patents Act as amended by the Act of 1888. The definition as it now stands is as follows:—

Definition
of trade
marks.

64. (1) For the purposes of this Act, a trade mark must consist of, or contain at least one of, the following essential particulars:

- | | |
|--|-----------------------------------|
| (a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or | Distinctive reproduction of name. |
| (b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or | Signature. |
| (c) A distinctive device, mark, brand, heading, label, or ticket; or | Device, brand, &c. |
| (d) An invented word or invented words; or | Invented word. |
| (e) A word or words having no reference to the character or quality of the goods, and not being a geographical name. | Selected word. |

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the

Additions
and
disclaimers.

trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the Register.

(3) Provided as follows:—

Not necessary to disclaim name or address.

(i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

Old word, letter, and figure marks.

(ii) Any special or 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 this Act.

Section 74 of the Act, which must be considered in conjunction with Section 64, and which deals with the somewhat complicated question of “added matter” in old and new marks, and the duty of disclaimer by the applicant, will be explained in the latter part of this chapter.

Definitions amplified.

The foregoing definitions under Section 64 are sufficiently clear to speak for themselves, but a short reference to each head may prove of advantage.

Name marks.

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

Secondly.—(b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark.

The first and second heads are practically one and the same, and may be treated together.

Name *per se* not a registrable trade mark.

By itself, and apart from any distinctive manner of printing or impressing, a name may constitute a trade mark—not a registrable trade mark—but still a species of

property which can, under the Common Law, be made good against all the world, with the exception of *persons of the same name*. For it is clear that, although a manufacturer of the name of Smith may have carried on business as a sewing machine maker for many years, and may have made his name famous in connection with sewing machines, he cannot on that account prevent another person of the same name from establishing a similar business, and selling machines under his own name, so long as the later manufacturer takes care to distinguish his goods from those of his older and better-known rival in business. Smith would have his remedy if Jones were to manufacture sewing machines and sell them under the name of Smith, because it would be reasonable to imply that such a course showed fraudulent intent on the part of Jones to take improper advantage of the fame acquired by Smith. The rule, therefore, is that whilst as against persons bearing a different name a manufacturer's Common Law right in his "name trade mark" is absolute and exclusive, nevertheless as against persons bearing the same name no such exclusive right can be set up. Cases that may be referred to on this point are *Burgess v. Burgess* ([1853] 3 De G. M. & G. 896), *Faber v. Faber* ([1867] 49 Barb. 357), *Jamieson v. Jamieson* ([1898] 15 R. P. C. 169), and *Turton v. Turton* ([1888] 42 Ch. D. 128).

Common
Law
remedy
against
fraudulent
use of name.

It must, however, be said that in some cases, even as against persons of the same name, a manufacturer would have his remedy, and a rival may be restrained from the free use of his own name, especially if any fraudulent or unfair conduct in connection with such use can be brought home to him. Take, for example, the case of *Pinet v. Pinet* ([1897] 15 R. P. C. 65), where it was found that the defendant had changed his name to Pinet for an impliedly fraudulent purpose. Even when the defendant's name is in fact the same as the plaintiff's, if it can be shown that he has not taken sufficient care to distinguish his goods from the plaintiff's the defendant may be restrained. Thus, in *Brooks v. Brookes et al* ([1899] 16 R. P. C. 523) the defendant was enjoined from using his own name (albeit it differed in spelling from the plaintiff's) in any such manner as to

Restraints
upon the
use of a
man's own
name.

confound his cycle saddles with those of the plaintiff. Indeed it might be said that of late the Courts have shown a disposition to go even further than this, and say that where a man sets up a business under his own name he may, in certain circumstances, be restrained from using his own name at all or in a certain way in connection with specific goods which have become specifically identified with the name of an old-established firm of the same name, although no fraud is proved. In *Valentine v. Valentine* ([1900] 17 R. P. C. 673) the defendant company were enjoined from using their corporate name "Valentine" in connection with "Meat Extract," a well-known commercial article, and indeed the only article they manufactured. In *Cash v. Cash* ([1902] 19 R. P. C. 181) the defendant was restrained from using his own name in connection with certain goods which had become specifically identified with the plaintiff's name, such as "Cash's Frillings," or "Cash's Woven Names and Initials," &c., although he was not restrained from trading in other small-ware goods under his own name so long as he clearly distinguished his goods from those of the plaintiff. The order in the Court below had practically restrained him from using his own name at all in this class of trade; but this was modified by the Court of Appeal. Apparently the Court will not restrain a person absolutely from carrying on business in his own name, although there are conceivable circumstances where even this might be done. In *Holloway v. Holloway* ([1850] 13 Beav. 209) a brother of the plaintiff had to submit to an injunction, because it was held that he used his own name in such a manner as to imply a fraudulent intent to pass off his pills and ointment as of the plaintiff's manufacture.

Burgess v. Burgess (*supra*) was decided upon similar lines, although within more restricted limits, the defendant being restrained from using any sign or intimation capable of confusing the two establishments in the public mind. These and other cases may be submitted as showing that the mere name of an individual or firm, although not registrable *per se*, is a trade mark maintainable at Common Law, but subject to this disadvantage, that the owners cannot always prevent others of the same name from using

it also for the same class of business, so long as such others use it honestly and in such a manner as to clearly distinguish their goods.

However, as has been said, a mere trade name, *per se*, and without any distinctiveness in its get-up, never was, and is not now, registrable in itself as a trade mark. It must, as the present Act says, be printed, impressed, woven, or otherwise produced in *some particular and distinctive manner*—that is to say, in some ornamental, fanciful, or peculiar fashion; and it is clear that a copy of a written signature comes under this description, since any one written signature is distinctive from another written signature. But the written signature must be the personal trading name of the individual or firm, not merely the fancy trading name. Thus a written signature of “The Tip-top Tea Coy.” would be bad. But a trade name distinctively printed or a written signature complying with the requirements and registered in this distinctive manner is then good against all the world—that is to say, *in its distinctive dress*. Except as regards the copy of a signature, the name registered in its distinctive dress need not be the actual name of the individual or firm applying for registration; that is to say, the trading name of “The Tip-top Tea Coy.” might be registered if printed or produced in some particular and distinctive manner.

Name only registrable when reproduced in distinctive manner.

Signature.

Signature must be actual name.

Thirdly.—(c) A distinctive device, mark, brand, heading, label, or ticket.

Device, brand, &c.

It will be noticed that each variety of mark set forth is subject to the qualification of distinctiveness. Applications for registration of marks under this heading are closely tested in respect of the essential feature of distinctiveness, 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.

Distinctiveness.

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).

Device.

But a well-known or a notorious portrait or picture might not be “distinctive” as a registered device for application to goods, especially if it had been used by others in connection with the same class of goods, although never as a mark placed on the goods. For instance, a copy of Gainsborough’s portrait, “The Duchess of Devonshire,” was held not distinctive as a trade mark applied to millinery goods, it having been used pictorially and for the purposes of advertisement in other businesses of the same nature prior to registration (*Louise v. Gainsborough*, [1902] 20 R. P. C. 61).

It seems that “device” does not include a word or arrangement of letters however distinctively combined (*ex parte Stephens*, [1876] 3 Ch. D. 659).

Marks for
subdivision.

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 (*Dausman v. Ruffner*, 15 U. S. Pat. Gaz. 559).

Representations of
goods.

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).

Initials.

It may be taken that initials printed in the ordinary non-distinctive manner are not registrable as trade marks. Even when arranged as a monogram or design alone or in combination with some device the registrability of initials seems doubtful (per Jessel, M. R., in *Lucke v. Webster*, [1879] unreported).

Brand.

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.”

Heading.

“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 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" refers to adhesive or other papers bearing the trade mark and capable of being secured to bottles, jars, cases, packets, and the like. Label.

"Ticket" describes the case of a mark impressed upon a piece of material, such as pasteboard or metal, and loosely or firmly attached to the goods. Sometimes the term "label" or "ticket" is used indifferently to describe the same attachment. The examples of "tickets" which most readily suggest themselves are the tickets pinned to the wares of a fancy goods dealer or a clothier. Ticket.

Fourthly.—(d) An invented word or invented words.

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. 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 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 "Aeilyton"; 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

Invented words.

No fancy words under Trade Marks Act, 1875.

Fancy words under the Act of 1883.

In re Van Duzer.
Definition of "fancy words."

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.

Act of 1888
"Invented
words."

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 Courts 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

House of
Lords on
bygone
decisions
re fancy
words.

"Satinine"
Case.

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

register the invented word "Somatose," which had been refused, the majority of the Court of Appeal sustained the Comptroller in his refusal. "Somatose" was intended to be applied to a new meat 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 fanciful 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.

"Somatose"
Case.

Increasing
difficulties
in regis-
tering
invented
words.

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's Photographic Co.'s Application*, [1898] 15 R. P. C. 476). Any person 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 upon 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, and for this reason the application was refused. The Court of First Instance and also the Court of Appeal sustained the Comptroller in his refusal to register, but the House of Lords were of a different opinion, and ordered registration. In their judgment the House took a revolutionary view of the question as compared with the existing practice, and 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 (*d*) and (*e*) 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 (*d*) and (*e*) 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

"Solio"
Case.
Reversal of
the former
practice.

House of
Lords hold
that in-
vented word
may refer to
character
and quality.

"Somatose"
Case dis-
approved.

Invented
word may
be traceable

to a foreign root and need not be meaningless.

covert allusion to the character or quality of the goods. The word need not be wholly meaningless. In short, almost all of 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.

“Savonal” for soap.

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 (*Field v. Wagel*, [1900] 17 R. P. C. 266).

“Tachytype” for type machines.

“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. But before taking this as an accepted ruling the reader should consider the later case of *Hommel v. Gebrüder Bauer* ([1904] 22 R. P. C. 43). Here the word “Hæmatogen”

Limited prior use of registered word.

was applied by the plaintiff to a proprietary medicine and registered as an invented word. But on proof that the word had been invented seven years previously by a German chemist, and had been used in one or two scientific publications as describing a new scientific product, both before and after registration, the action was dismissed and the mark removed from the Register. According to Vaughan Williams, L. J., in this case, if the word has a primary meaning even when limited to the members of one learned profession, it is difficult to establish that in a particular trade it has lost its primary meaning and acquired the secondary meaning indicating the goods of a particular maker. “Tabloid,” as applied to small medicinal tablets, was upheld as having been a distinctive fancy word not known or in common use at the date of registration in 1884 (*Burroughs, Wellcome & Co.’s Marks*, [1904] 21 R. P. C. 217). But the word “Bioscope” for cinematographic apparatus was struck off as having been used to describe such apparatus before registration, and therefore not an invented word (*Warwick Co. v. Urban*, [1904] 21 R. P. C. 240). “Electrozone” for electrically

“Tabloid” Case.

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. 477).

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. "Absorbine," which was registered as a trade mark for an absorbent ointment, was removed from the Register as not being an invented word within the Statute (*Christy v. Tipper*, [1904] 21 R. P. C. 755). 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* ([1902] 19 R. P. C. 281) the word "Uneeda" 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; probably 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 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 by the Court of Appeal to be a fancy word not in common use at the date of registration, and not descriptive, and therefore properly registered. It

Limitation of general application of "Solio" judgment.

Syllabic terminations or misspellings.

"Uneeda" Case.

"Pirle" Case.

"Triticumina" Case.

"Bovril" Case.

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.

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).

Must not refer to character or quality.

Names of fictitious or mythical personages may be registered.

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 "Trilby" 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 "Trilby" 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. 699). "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).

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 that 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.

Geo-
graphical
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, or as an essential particular of a trade mark, by a rival manufacturer. Hence a possible discouragement to trade, which it is no part of the public policy to countenance.

Reason for
exclusion.

Present-day
reading of
geo-
graphical
prohibition.

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.

Names of
well-known
springs.

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. 651). 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 64, Sub-section (e), 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 such connection 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 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] 8 R. P. C. 137; *Grand Hotel Co. of Caledonia Springs v. Wilson*, [1904] 21 R. P. C. 117).

The substance of the different rulings under present practice, as bearing upon geographical significance in words under Sub-section (e), may be summarised thus:—If the Word Mark consists of or contains an undoubtedly geographical name, reasonably well known, 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. *A fortiori*, 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 still 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 unregistrable, 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, such coincidences will not bar registration nor invalidate the mark when registered.

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.

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 mark, and must disclaim any right to the exclusive use

Substance
of decisions.

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

Additions to
marks.

Old word,
letter,
and figure
marks.

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.

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.

Meaning of
"distinctive"
in
Section 74.

These portions of Section 64 should be compared and read together 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. In either case, just as in Section 64, the applicant must state what are the essentials of his trade mark, and must disclaim any right to the exclusive use of the added matter save only his own trade name and address, which need not be disclaimed.

Sections 64 and 74, as amended by the Act of 1888, and their interdependence, have been considered by the Courts in several important cases. Apart from the provisions as to old marks under the heading (a), and the provision giving effect to the "three mark rule" in Sub-section 3 of Section 74, it almost seems as if the remainder of Section 74 is unnecessary in view of Section 64 as amended by the Act of 1888. Section 64 says distinctly that the applicant must state the essential features of his mark, and must disclaim the added letters, words, or figures which he does not consider essential. Section 74 (Sub-section 2) repeats the latter part of Sub-section 2 of Section 64 verbatim, the only apparent difference being that in (b) of Sub-section 1 of Section 74 the word "distinctive" is used to qualify the phrase "word or combination of words" which might appear as matter added to a new mark. As a matter of fact, the discussions in Court of these two sections and their differentiation have all raged round this word "distinctive." The term as used in the section does not mean unique or novel, or for the first time distinctive in itself,

i.e. something which in itself could be registered as a trade mark, for such a conclusion is negatived by the phrase in (c) Sub-section 1 of Section 74, "though the same is common to the trade." It is clear, as Chitty, J., pointed out in *Burland v. Broxburn Oil Co.* ([1889] 6 R. P. C. 482), that if common to the trade it cannot be "distinctive" in that sense, for then it might be an essential particular. The real meaning as imputed by this section is "distinguishing" as compared with the goods of other makers, or "descriptive," which sometimes carries the same qualification, and if so it cannot be an "essential particular" of the mark, and would be liable to disclaimer under Sub-section 2 of Section 64. For these reasons it might well be maintained that Section 74 (saving the clauses as to old marks or the three mark rule) is already covered by Section 64.

The decided cases bear out this contention, for wherever the added words or combination of words have proved to be mere harmless, non-distinguishing, or non-descriptive (in the sense that anyone might use the same descriptive term), or non-geographical words, they were held to be "non-distinctive," and therefore not subject to disclaimer; and exactly the same result would have followed under Section 64. Thus in *Smokeless Powder Co.'s Trade Mark* ([1892] 9 R. P. C. 109) the words "Smokeless Powder" were part of the label. 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" were not "distinctive" words—*i.e.* not "distinguishing" words (though common to the trade)—were not so in fact, because they were so common to the trade; that they were part of the applicant's trade name and formed part of the label, and that no disclaimer was necessary, and that the motion should be refused. In *re Trade Mark of Clement & Cie.* ([1899] 16 R. P. C. 611) the Court of Appeal held that the words "St. Raphael" written across the label were not a "distinctive" or distinguishing, or descriptive or geographical, addition to the mark, but were part of it, and that no disclaimer was required. But

"Distinctiveness" as interpreted by the Court.

"Smokeless Powder" Case.

"Silverpan"
Case.

here again it should be noted that "St. Raphael" formed part of the name of the registering company. Another decision under the same sections, but as amended by the Act of 1888, occurred in *re Faulder's Trade Mark* ([1901] 18 R. P. C. 535). The mark consisted of the firm's signature with the added word "Silverpan," which was found common or open to the trade to this extent, that other makers had, prior to registration by Messrs. Faulder, described their goods as prepared in silver pans. The defendants had been sued for infringement of the mark and 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 in a measure 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 registration intended to be "distinctive" within the Statute, that it should have been disclaimed on application, and that the mark must be expunged. If the test that has been proposed is applied to this latter case, it will be found to hold good. The evidence showed that others besides the plaintiffs had used so-called silver pans in boiling jam, before the date of registration, that they had said so in their advertisements, and would therefore have been justified in using the words in describing their manufacture. In addition to this the term was clearly descriptive and "distinguishing," as seeking to distinguish the plaintiffs' goods from those of others by the superior mode of manufacture. Therefore the word was "distinctive" within the section. Besides, being descriptive and consisting of two ordinary English words run together, it was clearly unregistrable as a trade mark *per se*. Unaided by some such test as the writer has ventured to suggest, a consideration of the various cases is apt to leave a somewhat confused impression on the mind, and some of the most able Judges have remarked upon the extreme difficulty of deciding what should or should not be disclaimed in the

case of labels and marks having accompanying or superimposed added matter or words or combinations of words. Perhaps it will assist the reader if a selection of reasonably typical cases is put before him. These would include the following:—*Burland's Trade Mark*, [1889] 6 R. P. C. 482 ("Washerine"); *Smokeless Powder Co.'s Trade Mark*, [1892] 9 R. P. C. 109 ("Smokeless Powder"); *Clement's Trade Mark*, [1899] 16 R. P. C. 611 ("St. Raphael"); *Faulder's Trade Mark*, [1901] 18 R. P. C. 535 ("Silverpan"); *Royal Baking Powder Co.'s Application*, [1902] 19 R. P. C. 261 ("Royal").

Typical
"distinctive"
additional
cases.

In *Burland's Case* the word "Washerine" appeared on the label in conjunction with the firm's signature. Held, that it was a "distinctive" word, being also descriptive and not registrable *per se* as a "fancy" word, and therefore subject to disclaimer.

"Washerine."

In *Faulder's Case* the word "Silverpan" was registered in conjunction with the firm's signature. Held, that the word was distinctive (*i.e.* distinguishing) and descriptive and not in itself registrable as a trade mark, and should have been disclaimed.

"Silverpan."

In the *Smokeless Powder Co.'s Case* the company had registered a label carrying the design of a target and the words "Smokeless Powder Co., Ltd." Held, that the words "Smokeless Powder" were not descriptive (non-distinguishing), were a part of the applicants' trade name, and need not be disclaimed.

"Smokeless Powder."

In *Clement's Case* the words "St. Raphael" appeared written across the ornamental device, and also appeared on a separate label of directions. Held, that as to the ornamental label the words were non-distinguishing, non-geographical, not an addition to the mark but part of it, and need not be disclaimed. *Per Romer, L.J.*, that the separate direction label was an addition within Section 64, and was not *primâ facie* "distinctive" (*i.e.* "distinguishing") under Section 74, and need not be disclaimed. At this point, let it be remembered, the learned Lord Justice was speaking of the unamended Section 64 of the Act of 1883, which said nothing about disclaimer. *Per Lindley, M.R.*: "I am not going to lay down any general

"St. Raphael."

principle for distinguishing what are parts of the mark or what are additions to it. I can easily see that there may be cases in which it is extremely difficult to say which is which." *Per Romer, L.J.*: "I desire to say this, that this judgment will in no way, I think, give rise to any idea that it would sanction the registration of words which in themselves would not constitute a proper trade mark merely because some flourishes were colourably put around them to try and make out a distinctive label—a compound label—when in fact what was really sought to be registered and intended to be registered were the words alone."

"Royal
Baking
Powder."

In the *Royal Baking Powder Co.'s Case* the company applied to register what they called "a distinctive label" consisting of a device portion with the superimposed words "Royal Baking Powder," and another part containing directions for use together with the words "Royal Baking Powder." The Comptroller required the applicants to disclaim all the added matter except their own name and the devices. On reference to the Court it was held that the direction portion of the label was "added matter" which should, under Section 64 as amended by the Act of 1888, be disclaimed, and this disclaimer extended to the words "Royal Baking Powder" on the device portions. It appeared that what the applicants were really seeking to reserve to themselves was the phrase "Royal Baking Powder," which they meant to be "distinguishing" and which they could not register *per se*. So in *Faulder's Case* the plaintiffs were really seeking to secure the unregistrable word "Silverpan." It therefore appears that the warning of Romer, L.J., just quoted in *Clement's Case*, was by no means uncalled for.

An essential
particular
is not added
matter.

Of course if the added word or combination of words is novel, unique, and capable of registration *per se* as a trade mark, that is to say complies with all of the requirements of Section 64, then it is not "added matter," but is an "essential particular" of the label or mark, and being pointed out in the application as such is not subject to disclaimer. Any such essential particular of a label, if taken by another, would justify an action for infringement. But, generally speaking, a registered

label containing letterpress can only be infringed by imitating the label, not by appropriating the letterpress. As was plainly laid down in *Hudson's Marks* ([1885] 3 R. P. C. 155), and in *Atkin's Mark* ([1886] 3 R. P. C. 164), no one by registering descriptive words in common use as an addition to a device can under the Statute acquire any right to the exclusive use of such words.

To crystalise the foregoing matter into plain directions to an applicant for a mark of this compound nature at the present day, in considering the mark the questions should always be asked—Is the added matter “distinctive” within the Statute, *i.e.* does it distinguish or point to the character of the goods as compared with those of other manufacturers?; or, if not “distinguishing” in this sense is it, or at any time was it, *prima facie* distinguishing, or has it acquired or is it open to be contended that it has acquired a distinguishing significance in the trade?; or is it descriptive or eulogistic?; or geographical?; or an invented word not fulfilling the requirements of Section 64?; or not registrable in itself as a trade mark? If the answer to any one of these questions is in the affirmative, then, generally speaking, the added matter should be disclaimed. When a device label is accompanied by printed instructions for use, this portion should be disclaimed. The applicant can no longer shelter himself under the plea that *the whole label*, including added matter of this nature, is the “essential particular.” This contention was waived aside by the Court in the *Royal Baking Powder Co.'s Case* (*supra*). In *Clement's Case* (*supra*) the directions portion of the label was saved by the date of registration. The amendments as to disclaimer now incorporated in Section 64 did not then exist.

Practical directions as to disclaimer.

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

Old marks not within the definitions of Act of 1889.

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 them out from registration would have meant the infliction of considerable hardship. A side door was, therefore, opened by Section 64, Sub-section 3 (ii), 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 *bonâ 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.

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.

Must be registered and used exactly in old form.

More 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**

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.

Common
marks
registrable
in com-
bination
with other
distinctive
features.

But must
be expressly
disclaimed.

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 (*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 *Thewlis and Blakey's Application* ([1893] 10 R. P. C. 369) the word "Ancross" 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*).

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*.

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 Bryne in *Wright and Crossley's Application* ([1900] 17 R. P. C. 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).

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.

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,

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

Disclaimer must be made at time of application.

Amendment on application not entertained by the Court.

Unnecessary applications.

Certificate
of refusal
to register.

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 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 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.

Registra-
tion 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).

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

Particulars
debarred
from regis-
tration.

- (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 (*re König & Ebhardt*, [1896] 13 R. P. C. 449).
- (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.

Inter-
national
Conven-
tion.

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
marks not
conforming
to British
require-
ments.

foreign applications as did not comply with British requirements, and apparently the Courts were prepared to sustain him in such refusals.

*Carter
Medicine
Co.'s Mark.*

In *Carter Medicine Co.'s Trade Mark* ([1892] 9 R.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 of the British Acts of 1883 to 1901. The same opinion was held in *Californian 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 14th 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 character of 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. In a doubtful case the Comptroller 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 representation of the goods allowed.

"Dome Blacklead" Case.

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).

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—

Name
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 words or words, if "invented," may (see Lord Herschell in the "*Solio*" 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, 1889).

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; *Ransome v. Graham*, [1882] 51 L. J. Ch. 897); and in any proceedings by the owner this would be a most effectual weapon in the hand of a defendant (*Cheavin 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.

THE 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. Representation of mark.

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 which follow the last chapter of this portion of the work at p. 382. 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. This restraint, which is really applicable to all classes, is Classification of goods.

Marks registered for miscellaneous goods.

Registering
marks for
goods not
traded in.

*Edwards v.
Dennis.*

directly in the interests of applicants, seeing that registration in respect of goods not traded in may afterwards be 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 *Batt v. Dunnett* ([1899] 16 R. P. C. 411). The right of aggrieved persons to expunge marks improperly registered for goods in which no trade was done, has been not even questioned. (See also *Suter, Hartmann's Marks*, [1901] 19 R. P. C. 42.)

Even where the owner of the registered mark actually deals in certain goods included in the registration, if he does not apply the mark to such goods his registration may afterwards be limited to the actual use he makes of it (*Hart's Mark*, [1902] 19 R. P. C. 569).

Practically, there is no difficulty in getting the Court to expunge or limit a trade mark registered in this improper manner.

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."

Representa-
tions of
marks.

Three 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."

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.

Acceptance or refusal of mark by 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.

Objection of Comptroller.

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 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

Issue of certificate of registration.

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 an applicant should be prepared for such a possibility.

Comp-
troller's
action on
objecting to
application.

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 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 inter-
ested 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 "J," 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.

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.

Statement
by
applicant in
support of
application.

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.

Declaration
by
opponent.

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

Hearing
before
Comptroller.

Appeal to
Board of
Trade.

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 by Board.

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.

The registration of trade marks in respect of goods within the Cutler's 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 Act of 1883. Sheffield metal goods marks.

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, 1889, 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.

Definition
of metal
goods.

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."

Duration of
registra-
tion.

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 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.

Renewal.

Restoration
of mark to
Register.

Abandon-
ment of
mark by
disuse &c.

The inten-
tion to
abandon
must be
apparent.

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 right 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 (*re Grossmith*, [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.

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).

Penalty for representing mark as "registered."

A misrepresentation that a mark is "registered," when in fact it is not so, might also cause refusal to register in the event of application being made to the Comptroller. But if such misrepresentation has been made under a *bonâ fide* mistake the Court will generally order the application to be proceeded with (*Altman's Application*, [1904] 21 R. P. C. 753).

CHAPTER IV.

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

Registra-
tion equiva-
lent to proof
of public
use.

BY Section 75 of the Act (being Section 17 of the Amendment 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).

But the
mark must
actually
have been
used.

Prior or
common
use by
others.

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 by the applicant or by another trader on the same class of goods and prior to registration is no reason for removing it from the Register (*Mouson 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

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. 283), 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). But where the substance of the mark has been commonly used for advertising or pictorial purposes (although never actually applied to goods) by others in the same trade prior to registration, the mark is liable to be expunged (*Louise v. Gainsborough*, [1902] 20 R. P. C. 61). In *Verity's Trade Mark and Hall and Woodhouse's Application* ([1901] 19 R. P. C. 58) the applicants had registered a "Badger" for beer in 1875. In 1882 they extended their business to aerated waters but did not apply the mark to such goods, although it

American
rule *re*
originality
of mark.

Prior
publication
of word
mark.

Advertise-
ment may
destroy
distinctive-
ness.

Mere advertisement not user.

was advertised generally in their circulars. In 1901 they applied to extend the mark to aerated waters, but the application was refused because of *Verity's* registration of a "Badger" for such goods in 1888. The applicants' motion to expunge *Verity's* entry and put their own mark on the Register was dismissed, the Court holding that mere advertisement did not constitute prior user which would oust *Verity* and entitle the applicants to registration.

Five years' registration is conclusive of right of owner.

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. Rawson*, [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., 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.

But registration must have been *ab initio* good.

Rectification of Register. Sections 90, 91, 92.

There are three sections in the Act which provide for rectification of the Register. Section 90 relates to cases wherein any persons 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.

Section 90 is as follows:—

Expunging or varying registered mark.

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.

(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.

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 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 Rivière* ([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." An extreme illustration of a merely "sentimentally" aggrieved person is to be found in *Ellis & Co.'s Marks* ([1904] 21 R. P. C. 617), where the Society of Friends applied to remove from the Register the word "Quaker" for use on fermented liquors or spirits. Lord Justice Fry, in *Apollinaris Co.'s Case* ([1891] 2 Ch. 186), 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

Persons aggrieved.

The grievance must not be merely in gross.

Must refer to a real or probable injury or loss.

in the future exclude, a rival from a portion of that trade into which he desires to enter, this rival is an aggrieved person."

Defendant
in an
action is
aggrieved.

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 of the plaintiff or opponent expunged (*re Ralph*, [1883] 25 Ch. D. 194; *re Wragg*, [1885] 29 Ch. D. 551; *re Hughes and Young*, [1893] 10 R. P. C. 369).

Grounds for
application
to expunge.

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. Lambert & Butler*, [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, and therefore fitted in with the remarks of Fry, L. J., in the *Apollinaris Co.'s Case* (*supra*). 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. 199), "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.

Reasons for
expunging
mark.

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.

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. Metcalf* ([1886] 31 Ch. D. 454; 3 R. P. C. 28) the word "Dairymaid," with a half-length stencilled 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 mark for cider consisting of half an apple with the word "Pomril" written across it was held too near to a circular 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. As to colour in marks it may be said in passing that Romer, L. J., in *Bass, Ratcliff & Gretton's Marks* ([1902] 19 R. P. C. 539), stated that "It is wrong to say that in the case of old marks the question of colour can be wholly disregarded—the question must be left open for further consideration." In *Marechal v. McColgan* ([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

Device marks expunged for similarity to other marks.

Question of colour in marks.

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 expunged for similarity to other word marks.

As regards word marks, in *Apollinaris Co. v. Herrfeldt* ([1874] 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 *Slazenger 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. 682) it was held that "Ivy" and "Ivory" might lead to confusion. In *Field v. Wagel Syndicate, Limited* ([1899] 17 R. P. C. 266) "Savoline" was held an infringement of "Savonol." In *McCaw v. Nickols* ([1903] 21 R. P. C. 15) "Securine" was held to infringe "Seccotine." But in *Talbot's Trade Mark* ([1894] 11 R. P. C. 77) "Emolliolorum" 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 "Triticamina."

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 ("File Label"); *re Palmer*, [1883] 24 Ch. D. 504 ("Braided Fixed Stars"); *re Hayward*, [1885] 54 L. J. Ch. 1003 ("Coker Mats"); *Thompson v. Montgomery*, [1891] 8 R. P. C. 361 ("Stone Ale"); *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 improperly registered.

Marks common to the trade: *Re Wragg*, [1885] 29 Ch. D. 551 ("Syphon and Glass"); *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 improperly registered for classes of goods not traded in: *Edwards v. Dennis*, [1885] 30 Ch. D. 455 ("Neptune"); *re Apollinaris Co.*, [1891] 2 Ch. 186 ("Friedrichshall Water"); *Batt v. Dunnett*, [1899] 16 R. P. C. 411 ("Butterfly" for Oats); *Anglo Swiss Milk Co. v. Pearks, Gunston & Tee*, [1904] 21 R. P. C. 261 ("Milkmaid Brand" for Butter).

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, *re Apollinaris Co.* ([1891] 2 Ch. 186).

Marks improperly registered by some one other than principal.

Name marks not registered in distinctive form: *Re Edge*, [1891] 8 R. P. C. 207 ("Edge's Filtered Blue"); *re Gianaclis*, [1889] 6 R. P. C. 476 ("Gianaclis' 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 Arbenz*, [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. Broxburn Co.*, [1889] 6 R. P. C. 482 ("Washerine," Soap); *re Edge*, [1891] 8 R. P. C. 207 ("Filtered Blue"); *Mcaby v. Triticine Co.*, [1897] 15 R. P. C. 1 ("Triticumina," Meal), but this latter is more than doubtful since the "Solio" Case.

Descriptive marks.

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

Proprietor having no established business.

Mark exactly similar to mark already registered in other classes of goods held calculated to deceive: *Eastman Co. v. Griffiths*, [1898] 15 R. P. C. 105 ("Kodak," registered for cameras, held not registrable for cycles by other traders).

Marks exactly similar to other marks in cognate classes.

Marks held to be deceptive: *Wood v. Lambert & Butler*, [1886] 3 R. P. C. 81; 32 Ch. D. 247 ("Eton" Cigarettes made in London); *re Hill*, [1893] 10 R. P. C. 112 ("Forrest" Watches, not made by Forrest).

Deceptive marks.

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 *Burland v. Broxburn*; 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 *Batt v. Dunnett* (*supra*); or by entering a disclaimer of certain parts, as in *Baker v. Rawson* 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 is also 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.

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 to make unimportant alterations.

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.

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 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.

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 which might prejudice other registered owners.

Greater difficulty in altering old marks.

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 was afterwards 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 Holbrooks' Marks*, [1901] 18 R. P. C. 447). Generally speaking, alterations in firm style, business appellations, addresses, and statements that may by lapse of time or change of circumstances have become inaccurate, are allowed to be corrected; and the Comptroller will not always instruct counsel to appear on his behalf if suitable undertakings are given (*re Davenport's Mark*, [1904] 21 R. P. C. 726). 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 Ermen 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); and in *Maw's Mark* ([1902] 19 R. P. C. 260) the word "Thompson" was struck out and "Sons" inserted in an old mark. 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); and *Maw's Mark* (*supra*). In *Cockle's Mark* ([1903] 20 R. P. C. 353) an old label mark was allowed to be altered by changing the address and adding "Great Britain" beneath "London." 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). But in the later case of *Bass's Marks* ([1902] 19 R. P. C. 529) Romer, L. J., disapproved of any general application of the dictum of Fry, L. J., in the *Apollinaris Case* (*supra*), and

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.