

machinery that the machine be put to work (*q*), and in the presence of persons named in the order (*r*).

The number of inspections to be allowed ought to be named in the order (*s*).

Inspection by defendant of plaintiff's machines.

In *Russell v. Cowley* (*t*) the order provided for inspection of the plaintiff's machine by defendant, as well as for the inspection by the plaintiff of the machine of the defendant. This order was by consent. A similar course was pursued in *Davenport v. Jepson* (*u*). It does not appear from the report whether or not that order was by consent, but on the principle laid down in the judgments in *Brown v. Moore* (*v*), and *The Patent Type Founding Co. v. Walter* (*x*), that the inspection is for the purpose of enabling the Court to have the case properly tried, and to assist the Court in forming a right conclusion at the trial, it would seem that if it were necessary to the defendant's case that he should have an inspection of the plaintiff's machine, an adverse order for inspection would be made. A plaintiff, however, cannot in an action for infringement be compelled to produce a specimen of the patent article to enable the defendant to prepare his defence (*y*).

It has been held that the Court does not direct a forcible inspection. The usual form of an order was only to permit inspection; obedience could be enforced only by the ordinary process of contempt (*z*). But now, by the Supreme Court Rules, 1883, Order L, Rule 3, cited above, the Court may authorize any person, for the purpose of inspection, to enter any land or building in the possession of any party.

The inspection might, under the old practice, be ordered at common law before the delivery of the pleadings in the action (*a*). And where a plaintiff, on the application of the defendant, was ordered to deliver better particulars of breaches, the plaintiff was allowed to inspect the machines at the defendant's factory, and to examine the defendant *viva voce* (*b*). And now, by Order L, Rule 3, of the Supreme Court Rules, 1883, cited above, it would seem that an order for inspection may be made at any stage of the action. "The Court or a Judge" being empowered to grant inspection, the order may be made either on motion in Court or on summons at Chambers (*c*).

(*q*) *Russell v. Cowley*, 1 Webst. P. C. 458; *Beardsell v. Schwann*, "Seton on Decrees," 3rd ed., p. 910; *Davenport v. Jepson*, "Pemberton on Judgments," 3rd ed., p. 236; *Morgan v. Fuller*, "Seton on Decrees," 4th ed., p. 347; *Bovill v. Moore*, 2 Coop. C. C. 56.

(*r*) *Russell v. Cowley*, 1 Webst. 458.

(*s*) *Heathfield v. Braby*, "Seton on Decrees," 4th ed., p. 1661.

(*t*) 1 Webst. P. C. 459.

(*u*) "Pemberton on Judgments," 3rd ed., p. 236; *s.c.* 1 N. R. 308.

See also *Russell v. Crichton*, 15 Dec. of Court of Session, p. 1270.

(*v*) 2 Coop. C. C. 56, cited above.

(*x*) *Johnson*, 728.

(*y*) *Crofts v. Peach*, 1 Webst. P. C. 268.

(*z*) *East India Co. v. Kynaston*, 3 Bligh, 153, 163, 166.

(*a*) *Amies v. Kelsey*, 22 L. J. (N.S.) Q. B. 84.

(*b*) *Jones v. Lee*, 25 L. J. (N. S.) Ex. 241.

(*c*) Judicature Act, 1873, s. 39; *Frearson v. Loe*, 26 W. R. 138.

We have seen that undue delay is a bar to an application for an interlocutory injunction. In the *Patent Type Founding Co. v. Walter* (d) it was urged that such delay would be likewise a bar to a motion for inspection, on the ground that the inspection could be of no use for the injunction, as that could not be granted by reason of the laches, and it was too soon to ask for inspection for evidence for the hearing, because the cause was not at issue. But Sir W. P. Wood, V.C., after citing the rule laid down by Lord Cottenham in *Bacon v. Jones* (e) to the effect that a plaintiff ought, in a patent case, to bring his cause to a hearing in a state in which the Court can adjudicate upon it, held that the delay was no bar to the inspection, and that it was reasonable and right for a plaintiff to come on an interlocutory motion and ask inspection, with a view to assist the Court in arriving at a right conclusion at the hearing.

Delay no bar to inspection.

As to the proper mode of applying for inspection, see Supreme Court Rules, Order L, Rule 6.

Orders for inspection may be made in Chambers (f), subject, however, in the Chancery Division, to the provisions of Order LV, Rule 15, and in the Queen's Bench Division to the provisions of Order LIV, Rule 12.

DISCOVERY.

By the Supreme Court Rules, 1883, Order XXXI, Rule 1, the plaintiff or defendant may in every cause or matter (other than certain specified actions which do not include patent actions), by leave of the Court or a Judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties.

On applying for such leave it is sufficient to state the general scope and object of the interrogatories (g), and the Judge will not decide as to the relevancy of particular interrogatories (h). The costs of discovery by interrogatories or otherwise must be secured by the party seeking discovery (i).

The Rules of the Court of Chancery as to discovery (which Rules regulated the discovery to be obtained under the Judicature Rules (k), for which the Supreme Court Rules, 1883, are now substituted) were thus stated by Lord Romilly, M.R. :—

“A fundamental principle is to be found in all the decisions on this point, which is usually thus stated: that a defendant who submits to answer must answer fully. That is, that if a *prima facie* case for relief be made by the bill, calling for an answer, the defendant may, if the circumstances of the case will permit it, bring forward any fact or

Defendant answering must answer fully.

(d) Johnson, 728.

(e) 4 My. & Cr. 433.

(f) Supreme Court Rules, 1883, Ord. L, Rule 3.

(g) *Hall v. Liardet*, W. N. 1883, 165.

(h) *Hall v. Liardet* (No. 2), W. N. 1883, 175, corrected *Ibid.* p. 194.

(i) Supreme Court Rules 1883, Ord. XXXI, Rules 25 to 27.

(k) *Anderson v. Bank of British Columbia*, 2 Ch. D. 644; *Saunders v. Jones*, 7 Ch. D. 435; *A.G. v. Gaskill*, 20 Ch. D. 519.

series of facts, by way of plea, to dispute the right of the plaintiff to call upon him to answer either the whole bill or some particular portion of it; but that if he be unable or decline to adopt this course, he must, technically and categorically, answer every statement in the bill to which he is interrogated which can assist the plaintiff in making out his title to relief" (l).

Must answer everything tending to show fact of infringement.

In accordance with this principle, the defendant, in a suit to restrain infringement of a patent, is bound to set forth in his answer to the full extent of the interrogatories everything showing or merely tending to show the fact of infringement (m). Thus, in a suit against defendants who were alleged to be selling, under the names "Nelson's Patent Refined Isinglass," and "Nelson's Gelatine Isinglass," articles made in infringement of the patent, the defendants were compelled to answer questions as to when they first manufactured, and to whom by name they first sold, any and what quantity of the article sold by them under the above names, and what were the processes of manufacture. They were also compelled to set forth an account of all articles manufactured and sold by them since the date of the specification under the name of "Nelson's Gelatine Isinglass," &c., and the quantities thereof respectively, and the names and addresses of the persons to whom sold, and at what prices, and the profits which the defendants had realized thereby (n).

Names of customers.

So also, where the bill alleged that the defendant had sold looms made in violation of a patent, and had received royalties for their use, the defendant was ordered to set forth the names and addresses of the persons, whether resident in England or abroad, from whom such royalties were received in respect of machines made in England, on the ground that the answer might lead to very important discoveries as to the infringement (o). A defendant will not be allowed to refuse to answer an interrogatory as to the names of his customers merely on the ground that they might thereby be exposed to actions (p). And where a number of persons had formed themselves into an association for the purpose of supporting each other against a patentee seeking to restrain them from infringing his patent, it was held that a member of the association against whom the patentee had filed a bill must give the names of the members of the association, but that he was not bound to disclose its proceedings unless they were shown to be connected with the matters in question in the suit (q). Again, where the defendant was

(l) *Per* Lord Romilly, M R., *Swinborne v. Nelson*, 16 Bea. 416, 417. See also *Elmer v. Creasy*, L. R. 9 Ch. 69; *Saull v. Browne*, L. R. 9 Ch. 364.

(m) *De la Rue v. Dickinson*, 3 K. & J. 388, 391.

(n) *Swinborne v. Nelson*, 16 Bea. 416. This decision as to profits is at variance with the decision in *De la*

Rue v. Dickinson, 3 K. & J. 388, cited below. From statements of counsel in the latter case, it appears that *Swinborne v. Nelson* was appealed.

(o) *Crossley v. Stewart*, 1 N. R. 436; *s.c.* 7 L. T. (N. S.) 848.

(p) *Tetlev v. Easton*, 18 C. B. 643.

(q) *Bovill v. Cowan*, W. N. 1867, 115.

charged with infringing a patent for making an aniline dye, it was held that he was bound to answer whether he used the ingredients mentioned in the plaintiff's specification, whether he added anything else, and whether the additions made any difference in the process (r).

But the rule that a defendant who elects to answer must answer fully has been dispensed with where it has been seen plainly that the point raised is one which must be determined at the hearing, and that the discovery will be unnecessary for the purpose of the hearing, and useless if the decision be in one way (s).

But defendant need not answer questions which may become unnecessary if trial ends in his favour.

Thus, in the case of *De la Rue v. Dickinson* (t), which was a suit to restrain infringement of a patent for the manufacture of envelopes by machinery, the plaintiff required the defendants to set out an account of machines in their possession, and a discovery from whom the same were procured, and whether they were purchased or hired, and, if purchased, the consideration of the purchase; an account of envelopes manufactured by any machine used by the defendants, and discovery of the persons to whom such had been sold; also accounts of the sales of such envelopes, the profits made by defendants, the stock in hand of such envelopes, and an account of moneys received by and due to the defendants for such envelopes. Lord Hatherley, when V.C., refused to enforce an answer to these interrogatories, observing that they assumed the fact of infringement, and would be obtained under the decree at the hearing, if that fact were established as a matter of course, provided the fact of infringement were then established, while, on the other hand, if the fact were not established at the hearing, the discovery required would be utterly immaterial (u).

And in *Moore v. Craven* (x) it was laid down by Lord Hatherley, C., that although, where discovery is a matter of indifference to the defendant, the Court does not weigh in golden scales the question of materiality or immateriality, still, where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst on the one hand it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other it is bound to protect the defendant against undue inquisition into his affairs.

Therefore, in a suit to restrain infringement of a patent for making dyes, where the interrogatories after requiring the defendant to set forth the particulars of various ingredients therein named, which

(r) *Renard v. Lerinstein*, 10 L. T. (N. S.) 94. See also *Rolls v. Isaacs*, W. N. 1878, 37.

(s) Per Lord Hatherley when V.C., *Swabey v. Sutton*, 1 H. & M. 514, 516.

(t) *De la Rue v. Dickinson*, 3 K. &

J. 388. Compare *Elmer v. Creasy*, L. R. 9 Ch. 69, 73; and see now *Parker v. Wells*, 18 Ch. D. 477.

(u) See also *Lea v. Saxby*, 32 L. T. (N. S.) 731; and Supreme Court Rules, 1883, Ord. XXXI, Rule 6.

(x) L. R. 7 Ch. 94, 96, n.

particulars the defendant did set out in his answer, also required him to state the name and address of each person who sold, and each person who delivered, each of the said ingredients at the defendant's premises, and the sum paid by him and any agent or clerk of his, and the use the defendant had made of each of the substances, and fully to account for each packet and parcel of the same, and the application, use, and disposal thereof, and the defendant declined to answer the latter part of the interrogatory, exceptions to the answer were overruled (*y*).

And the defendants to a suit charging infringement of a patent for making cartridges were held entitled to refuse to state the size of the wire used by them in making their cartridges, and the names of the persons from whom, and the places from which, they had purchased their wire (*z*).

And where a patentee of a new material for protecting stone, wood, and the like, sought to restrain infringement by the defendants, who used under their own patent a liquid in which the resinous part of gum euphorbia was employed, and required the defendants to state whether they used a composition in which euphorbia gum was an ingredient, and "not being a composition prepared exactly in accordance with their own specification," and if so to set forth the ingredients of such composition, an objection to the interrogatory was allowed (*a*).

So also, in *Crossley v. Stewart* (*b*), the defendant was not required to set out the names and addresses of persons resident *abroad* to whom he had sold looms manufactured *abroad* in alleged infringement of plaintiff's patent.

And in *Rolls v. Isaacs*, cited above, the defendants were held to be not bound to answer an interrogatory asking not merely as to certain vessels mentioned in the particulars of breaches, but also as to the names and owners of the ships to which the defendants had, since the date of plaintiff's patent, applied any composition in which euphorbia gum was an ingredient, and requiring them to state how and in what manner the gum entered into the composition, and when and by whom the same was manufactured, and by whom applied or used.

The plaintiff is not entitled by interrogatories to get at the names of defendant's witnesses, or to inquire into defendant's case merely for the purpose of finding out how defendant intends to prove it (*c*).

The principle laid down in *Moore v. Craven* was cited with approval by the Lords Justices in the case of *Carver v. Pinto Leite* (*d*), where the Court refused to compel a defendant in a suit to restrain infringement of trade mark to disclose the names of his customers, or the prices at

(*y*) *Simpson v. Charlesworth*, W. N. 1866, 255.

(*z*) *Daw v. Eley*, 2 H. & M. 725.

(*a*) *Rolls v. Isaacs*, W. N. 1878, 37.

(*b*) 1 N. R. 436; *s.c.* 7 L. T. (N. S.) 84ⁿ.

(*c*) *Daw v. Eley*, 2 H. & M. 730, 731.

(*d*) L. R. 7 Ch. 90, 97.

which the goods marked with the mark complained of had been sold to them or bought from anybody else.

But where ship-owners had shipped goods bearing counterfeits of the plaintiff's trade marks, it was held that an action would lie against them for discovery of the names of the consignors of the goods (e).

The decision in *Crossley v. Stewart* (f), where discovery of the names of defendant's customers and licensees was enforced, appears at first sight to be overruled by *Carver v. Pinto Leite*. But the cases are perhaps reconcilable by the consideration that the latter was a suit to restrain infringement of trade mark, in which case the mere knowledge of the names of persons who have bought goods under the spurious mark is not in general material to the plaintiff before he has obtained a decree and is proceeding to take his account of profits, while, on the other hand, in a patent case, the discovery of the names of purchasers from the defendant or licensees may, as was said in *Crossley v. Stewart*, lead to very important inquiries and discoveries as to the infringement of the patent (g). Discovery of this nature has been enforced on interrogatories administered under the Common Law Procedure Act, 1854 (h); and where the infringement was admitted, and the only question was the validity of the patent, a motion to strike out of the interrogatories so much as asked the names and addresses of the persons to whom the defendant's machines had been sold was refused (i).

The principle of *De la Rue v. Dickinson* will not, however, extend to excuse defendants from answering fully on the ground that, if the plaintiff fails in proving the validity of the patent, such answers will be useless to him, and therefore, where defendants to numerous separate bills filed by a patentee moved before answer to consolidate the suits and to try the question of the validity of the patent in one suit, they undertaking to be bound by that decision, but not undertaking to be bound as to the infringement, it was held that the application was premature, and the defendants could not be absolved from giving discovery, but without prejudice to any proceedings for consolidating the suits after answer (k).

Where a defendant, being required to state whether he was not making water-gauges identical with those patented by the plaintiff, and to set forth in what particulars they differed from those of the plaintiff, stated that he had for many years before the date of the patent applied to water-gauges the same mode of treatment as that described in the plaintiff's specification, and that he now made water-gauges which, save

(e) *Orr v. Diaper*, 4 Ch. D. 92.

(f) 1 N. R. 436; s.c. 7 L. T. (N. S.) 848.

(g) And see further *Leather Cloth Co. v. Hirschfeld*, L. R. 1 Eq. 299; *Davenport v. Rylands*, L. R. 1 Eq. 302, 308.

(h) 17 & 18 Vict. c. 125, ss. 51, 52, 53.

(i) *Tetley v. Easton*, 18 C. B. 643.

(k) *Foxwell v. Webster*, 3 N. R. 103; 2 Dr. & Sm. 250.

so far as his own method or process adopted before the patent was similar to that described in the plaintiff's specification, differed from the water-gauges there described, but that it was impossible, without ocular demonstration, to show in what they differed, the answer was held sufficient (l).

Trade secrets.

If the plaintiff be otherwise entitled to discovery, the mere fact that the disclosure asked may, if given, make the plaintiff acquainted with the defendant's trade secrets has been said to be no ground for refusing it. The Court will be able at the proper time to protect the defendant from any improper disclosure of his secret. If the defendant in such a case might say, "I deny any infringement, I will give you no further discovery," there would be no use in filing a bill at all" (m).

Discovery not enforced beyond what necessary to prove plaintiff's case.

The Court, however, will not carry the discovery farther than is necessary for enabling the plaintiff to establish his case, and therefore, in *Renard v. Levinstein*, cited above, although the defendant was compelled to answer whether he used the ingredients mentioned in the specification, whether he added anything else, and whether the addition made any difference, he was not compelled to disclose in what proportions he used the specified materials, or the nature and quantities of the addition.

And a defendant was allowed to refuse in cross-examination to answer questions tending to disclose his alleged secret process, but the Court having during the arguments formed an opinion that the plaintiff's patent was valid, gave leave to the defendant to describe his secret process if he should think fit to do so, in order that the Court might come to a conclusion on the question of infringement; and the defendant having elected to disclose his secret process, the hearing of the evidence and arguments was continued *in camera*, and directed the shorthand notes which would disclose the secret process to be impounded in Court (n).

Where a plaintiff had filed several bills against previous infringers, and had succeeded in such suits, it was held that in a subsequent suit the defendant might be required to state whether his process were the same as that used by some one who had been a defendant in one of the former suits (o).

Interrogatories as to prior user notwithstanding particulars of objections delivered.

A defendant may be compelled to answer interrogatories requiring particulars of the prior user alleged by him (p), and this even though particulars of objections literally complying with the statutory requirements have been delivered (q).

(l) *Crossley v. Tomey*, 2 Ch. D. 533.

(m) Per Lord Hatherley, C., *Renard v. Levinstein*, 10 L. T. (N. S.) 94.

(n) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 158.

(o) *Bovill v. Smith*, L.R. 2 Eq. 459, 461.

(p) *Finnegan v. James*, L. R. 19 Eq. 72; *Crossley v. Tomey*, 2 Ch. D. 533, contrary to what was formerly held; *Bovill v. Smith*, L. R. 2 Eq. 459; *Daw v. Eley*, 2 H. & M. 725.

(q) *Birch v. Mather*, 22 Ch. D. 629.

But a plaintiff cannot require a defendant to state the names of the persons to whom the defendant alleges he sold articles similar to the patented article before the date of the patent. Such a question is a mere fishing question to help the plaintiff to get at the defendant's witnesses and see what he can make of them (*r*). Nor can a defendant be required to set forth a description of all machines similar to plaintiff's made or used by him prior to the patent (*s*), but he may be asked whether the machines mentioned in his objections are in existence, and the names and addresses of the alleged prior users (*t*). Limits of the discovery.

Where interrogatories are delivered by a defendant, the plaintiff must answer such interrogatories fully, and it has been said that such interrogatories are on a different footing from those for the examination of a defendant, in this respect, that a plaintiff is not entitled to a discovery of the defendant's case, but the defendant may ask questions tending to destroy the plaintiff's claim (*u*). Interrogatories for examination of plaintiff.

A plaintiff may be compelled to answer interrogatories as to the meaning and effect of his specification, and therefore the plaintiffs, owners of a patent for making blue and violet dye, were compelled to answer interrogatories administered by the defendant, asking in effect—

Whether it was not the fact that no blue dye could be produced according to the specification.

What was the meaning of a certain expression, "red aniline dye," used in the specification.

What was the chemical composition of the substance known at the date of the patent as "red aniline dye."

Whether they had not used material not mentioned in their specification.

Whether they had not wholly or to some extent abandoned their patented process, and what was the last sale of dye made by their own process; and what quantity of blue dye had been made and sold by them strictly according to the patent, as compared with the quantity made by them not according to the patent.

What was the meaning of an expression, "the acid being mixed with a large quantity of water," and whether any quantity would do.

What was the meaning of "hydrochloric acid of commercial strength," what was that strength, and did not hydrochloric acid as sold in commerce vary much in strength, and what were the limits of such variation.

(*r*) *Daw v. Eley*, 2 H. & M. 755.

(*s*) *Daw v. Eley*, cited above.

(*t*) *Birch v. Mather*, 22 Ch. D. 629.

(*u*) *Hoffmann v. Postill*, L. R. 4

Ch. 673. See also *Minet v. Morgan*, L. R. 8 Ch. 361, 364; *Commissioners of Sewers v. Glasse*, L. R. 15 Eq. 302; *Benbow v. Low*, 29 W. R. 265.

Exceptions to an answer refusing to answer these questions were allowed, the defence being that the specification was insufficient, and that the invention as therein described was not useful (*x*).

So also, in *Hoffmann v. Postill*, cited above, exceptions were allowed to an answer by which the defendants refused to answer questions as to certain specifications prior to plaintiff's specification, which tended to show that such prior specifications anticipated plaintiff's invention.

But a plaintiff need not answer matters which are clearly immaterial to the defendant's case, and therefore it was held that the plaintiffs need not set forth the particulars of certain legal proceedings which had taken place in Saxony against infringers of their patent, which proceedings the defendant alleged had been unsuccessful (*y*).

Reports, &c., obtained by defendant as to infringements.

Where a defendant company had been warned by a plaintiff that he considered they were infringing his patent, but there was no threat of litigation, and the company obtained from their officers reports and letters as to the alleged infringement, it was held in an action which was subsequently commenced that these reports and letters were not privileged, and production of them was enforced (*z*).

ACCOUNT.

Account in Court of Chancery.

The Court of Chancery, in addition to granting an injunction restraining infringement of a patent, was accustomed (although before Lord Cairns' Act unable to give damages) to grant the further relief of an account of profits, in order that the remedy might be complete (*a*). But if the plaintiff was not entitled to an injunction, as, for instance, if the patent had expired before (*b*), or during (*c*) the litigation the account could not be granted unless in cases of fraud (*d*).

After Lord Cairns' Act it was held that although the patent had expired pending the litigation, so that there could be no injunction, the plaintiff might have damages, though he could not have an account (*e*), but not if the bill were filed immediately before the expiration of the patent, and no application for an injunction was made (*f*).

May now be had in all Divisions of the High Court.

Now, however, that all the jurisdiction exercised by the old Courts of Chancery and Common Law is, by the Judicature Act, 1873, sect. 16, transferred to the High Court of Justice, these questions

(*x*) *Renard v. Levinstein*, 11 L. T. (N. S.) 79.

(*y*) *Hoffmann v. Postill*, L. R. 4 Ch. D. 673; and see Supreme Court Rules, 1883, Ord. XXXI, Rule 6.

(*z*) *Westinghouse v. Midland Railway Co.*, 48 L. T. (N. S.) 98; affirmed *Ibid.* 462.

(*a*) *Baily v. Taylor*, 1 R. & M. 73, 75.

(*b*) *Smith v. London and South-*

Western Railway, Macr. P. C. 209; *s.c. Kay*, 417.

(*c*) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.* See, however, *Fox v. Dellestable*, 15 W. R. 194.

(*d*) *Crossley v. Derby Gas Co.*, 1 Webst. 119.

(*e*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 307.

(*f*) *Betts v. Gallais*, L. R. 10 Eq. 392.

cannot arise, and an account may be had in any Division of the Court (*g*), and every Division may grant damages for infringement, and this whether the action be commenced before or after the expiration of the patent.

It is now settled, in opposition to earlier cases (*h*) that a plaintiff must elect between an account of profits or damages, and that he cannot have both: "The two things are hardly reconcilable, for if you take an account of profits you condone the infringement" (*i*). The rule applies generally and without distinction to every case of infringement (*k*). Plaintiff cannot have both account of profits and damages.

But although a plaintiff cannot have both account of profits and damages against the same defendant, he may have both remedies, though against different persons, in respect of the same article.

Thus, in *Penn v. Bibby*, and *Penn v. Jack* (*l*), a plaintiff obtained in one suit an injunction against the manufacturer of the patented article, and in another suit an injunction against a person who had used the same article, having purchased it from the manufacturer above mentioned.

An account of profits was granted against the manufacturer, and damages against the person using, and Lord Hatherley, then Sir W. P. Wood, V.C., said: "It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, and I do not see why the article should not be followed in every man's hand until the infringement is got rid of. So long as the article is used there is continuing damage." In such a case, however, if the plaintiff is paid by the wrongful user of his invention a sum equal to the ordinary royalty which he has been accustomed to demand from his licensees, he cannot, in respect of the same article, recover any further sum from the manufacturer (*m*).

The account of profits may extend not only to direct profits, but also to collateral benefits derived by him from using the patented invention. Extent of account of profits.

Thus, where a defendant company had made and sold gas-meters in infringement of plaintiff's patent, and had also used them in carrying

(*g*) See Supreme Court Rules, 1883, Ord. XV, Rule 1. *York v. Stowers*, W. N. 1883, 174. The order for the account is to contain the necessary inquiries and directions usual in the Chancery Division. See Order XV, Rule 1.

(*h*) *Hill v. Evans*, 4 D. F. J. 288, 309; L. R. 6 H. L. 321, note 2; *Betts v. De Vitre*, 11 Jur. (N. S.) 217; *Elmslie v. Boursier*, L. R. 9 Eq. 223.

(*i*) Per Lord Westbury, *Neilson*

v. Betts, L. R. 5 H. L. 1, 22. See also *Watson v. Holliday*, 30 W. R. 747.

(*k*) *De Vitre v. Betts*, L. R. 6 H. L. 319. See also *Holland v. Fox*, 3 E. & B. 977, *Vidi v. Smith*, 3 E. & B. 969, as to the practice of Courts of Common Law under the corresponding section of the Act of 1852.

(*l*) L. R. 3 Eq. 308.

(*m*) *Penn v. Jack*, L. R. 5 Eq. 81, 86.

on their works, an account was directed, not only of what profit had been received, but of what benefit had been derived from the use of such gas-meters (*n*).

Where a defendant alleged that he had made no *profit* by the use of the patented apparatus, but it appeared that such use had been the cause of *saving* to the defendant in his manufacture, it seems that the plaintiff is entitled to claim something on account of the pecuniary value of that saving (*o*).

But if such an account be desired, it must be alleged in the pleadings and proved (*p*).

An account of profits will not be directed if it is clear that no profits have been made (*q*).

Under the corresponding section of the Act of 1852 (*r*) it was held in the Courts of Common Law that no retrospective account of profits made before action would be ordered before final judgment (*s*). Nor would such an account be ordered where at the trial there had been a verdict with damages; the plaintiff's loss up to that time is considered to be compensated by the damages (*t*).

The Court had, however, power to order, pending the action and before the trial, an account of profits to be kept, but in such a case the plaintiff was required to give *prima facie* evidence of infringement and of profit being made by the defendant, and he must waive his claim for damages, and to undertake, in the event of the verdict being against him, to pay the expenses of keeping the account (*u*).

The amount due under an account of profits is not a demand in the nature of unliquidated damages within sect. 31 of the Bankruptcy Act, 1869 (sect. 37, Bankruptcy Act, 1883), and is provable in the infringer's liquidation (*x*).

Plaintiff not entitled to account of his own loss.

In taking an account of profits the plaintiff is only entitled to an account of the profits which have been made by the defendant. He is not entitled to any account of the loss which he has sustained by reason of the infringement (*y*).

Inspection not ordered as taking account.

It was held by the Court of Common Pleas, under the Act of 1852, sect. 2, that the Court would not, on taking an account, order an inspection of the manufactures and warehouses of the defendant, in

(*n*) *Crossley v. Derby Gas Light Co.*, 1 Webst. 119.

(*o*) *Househill Co. v. Neilson*, 1 Webst. 697, note *r*.

(*p*) *Bacon v. Spottiswoode*, 1 Bea. 382, 387. As to the practical difficulties of taking such an account, see *Crossley v. Derby Gas Light Co.*, 3 My. & Cr. 428.

(*q*) *Bergmann v. McMillan*, 17 Ch. D. 423.

(*r*) 15 & 16 Vict. c. 53, s. 42.

(*s*) *Vidi v. Smith*, 3 E. & B. 969; *s.c.* 1 Jur. (N. S.) 16.

(*t*) *Holland v. Fox*, 3 E. & B. 977.

(*u*) *Vidi v. Smith, ubi sup.*

(*x*) *Watson v. Holliday*, 30 W. R. 747, affirmed 31 W. R. 536; 52 L. J. Ch. 543.

(*y*) *Ellwood v. Christy*, 18 C. B. (N. S.) 494, overruling *Walton v. Lavater*, 8 C. B. (N. S.) 191. See also *Penn v. Jack*, L. R. 5 Eq. 81.

order to see if he had any articles in course of manufacture in violation of the patent (z).

In the prosecution at Chambers of the inquiry as to damages, a defendant will be compelled to disclose the number of machines made by the defendant since the patent, and the names and addresses of the persons to whom they have been sold, and it is no objection to such a disclosure that the plaintiff might attack those persons and so injure the business of the defendant (a). But interrogatories may be ordered.

Where the plaintiff obtained a verdict in an action for infringement, and a rule to enter the verdict for defendants was discharged, and the defendants appealed, and subsequently an order was made for an account of profits which was not appealed against, it was held that the defendants' books must be produced, and that interrogatories might be administered notwithstanding the pendency of the appeal (b). And books may be produced and administered.

But where it appeared that the discovery given by the account would enable the plaintiff to take proceedings against the customers of the defendants, and that the defendants, if ultimately successful, might find that in the meantime their business had been ruined, the proceedings under the account were stayed till the hearing of the appeal, the appeal being advanced (c).

Where a defendant had filed an affidavit as to his profits it was ordered that if the plaintiff did not succeed in surcharging him to the extent of one-sixth beyond the amount admitted in the affidavit, the plaintiff should pay the costs of the inquiry before the Master (d). Where plaintiff did not surcharge defendant to extent of one-sixth, plaintiff ordered to pay costs of inquiry.

If a plaintiff lies by and does not prosecute his rights against the defendant, the delay, if unexplained, may affect his right to an account of profits (e), and in actions to restrain infringements of trade mark, it has been held that where there is undue delay in taking proceedings the account will only be granted as from the commencement of the action (f). Delay in suing may affect account of profits.

In trade mark cases where the trade mark is used by the defendant in ignorance of the plaintiff's rights, the account of profits or compensation will only be directed as from the time when the defendant became aware of the prior ownership (g). And if a man buys goods for a third party believing them to be genuine, when in fact they are spu- Account of profits in trade mark cases.

(z) *Ellwood v. Christy*, cited above.

(a) *Murray v. Clayton*, L. R. 15 Eq. 115, 120.

(b) *Saxby v. Easterbrook*, L. R. 7 Ex. 207.

(c) *Adair v. Young*, 11 Ch. D. 136.

(d) *Ellwood v. Christy*, 18 C. B. (N. S.) 494, 498.

(e) *Crossley v. Derby Gas Co.*, 1 Webst. 120; *Harrison v. Taylor*, 11 Jur. (N. S.) 408.

(f) *Ford v. Foster*, L. R. 7 Ch. 627; *Beard v. Turner*, 13 L. T. (N. S.) 746.

(g) *Edelsten v. Edelsten*, 1 D. J. S. 185, 199. See also *Ellin v. Slack*, L. J. Notes of Cases, 1880, p. 15.

rious, it is not until he has been told that they are so that he can be considered guilty of any fraud, or liable to render any account (*h*).

Same rule does not apply in patent cases.

But the principle does not apply in patent cases. In the case of a trade mark "the article is open to all the world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture, but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee" (*i*). And where the defendant had purchased in open market the article complained of, in ignorance of the process of its manufacture, and of the fact of infringement, the inquiry as to damages was nevertheless ordered to extend to the sale within six years of the filing of the bill (*k*).

Damages, form of inquiry.

From the above considerations it results that the proper form of the inquiry as to damages in a patent case is, "what damage the plaintiff has sustained," not "what damage, if any," he has sustained (*l*).

Assessment of damages.

In a simple case, as, for instance, of a licence having been granted, and of a fixed and definite royalty having been received, the Court has the means of forming a judgment as to the injury sustained by the plaintiff, and will not send the parties to a jury. In such a case the Court would simply ascertain the amount sold by the defendant and fix the wrongdoer with that (*m*).

Where licence granted.

Where no licence.

But where no licences have been granted, or where for any reason there is extreme difficulty in the assessment by the Court itself, the Court will send the patentee before a jury. A jury composed of persons of business-like habits, and accustomed to deal with difficulties of this description, are more fit arbiters than the Court can be in dealing with such a question (*n*).

Plaintiff cannot claim manufacturing profit and royalty.

Where the plaintiff has been in the habit of granting licences he will not be allowed to claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty, and if he has received this royalty from the user he cannot have anything further from the manufacturer.

This was decided in the case of *Penn v. Jack* (*o*), in which the principle on which the Court acts in the assessment of damages for infringement of patent, where the Court is able itself to assess them, was considered; and in that case the plaintiff had obtained an injunction against the defendants, who were manufacturers, to restrain them from using and selling his invention of "an improvement in the bearings or

(*h*) *Per* Lord Romilly, M.R., *Moet v. Causton*, 10 L. T. (N. S.) 396.

(*i*) *Per* Sir W. Wood, V.C., *Davenport v. Rylands*, L. R. 1 Eq. 308.

(*k*) *Davenport v. Rylands*, *ubi sup.*

(*l*) *Davenport v. Rylands*, L. R. 1 Eq. 308.

(*m*) *Betts v. De Vitre*, 11 Jur. (N. S.) 10.

(*n*) *Ibid.* See also *Penn v. Jack*, L. R. 5 Eq. 81, 83.

(*o*) L. R. 5 Eq. 81.

bushes for the shafts of screw and submerged propellers," with a decree for payment of damages sustained by the plaintiff "by reason of the user or vending of the said invention." The plaintiff, who was not in the habit of manufacturing the patent article, but was accustomed to grant licences for its use at a royalty of 2s. 6d. per horse-power for each ship in which the invention was to be used, claimed to be paid not merely the ordinary royalty which he had been in the habit of accepting from the trade, but also, and in addition, the profits which the defendant's firm had made on the various items of material and labour expended in fitting the propeller shafts with the invention in the cases where it had been used by the defendants. This claim, however, was not allowed, and Lord Hatherley, then V. C. Wood, said :—

"It has been contended that the plaintiff has lost more than this 2s. 6d. per horse-power ; he is said to have lost a profit besides. But he has himself estimated that profit at 2s. 6d. per horse-power. If he had fitted these ships with his invention himself, he would no doubt have had to run risks of bad debts, of bad materials, of losses upon contracts arising from the rise and fall of timber, from strikes and the like ; and he would have expected to make a profit sufficient to cover these risks ; but he has shown that he considers he may as well hand over the right to everybody else on being paid 2s. 6d. per horse-power. He might prevent any ship-builder from using this invention at all, and there would then be the chance of business being brought to his yard ; but, taking everything into consideration, he finds he can afford to surrender all profit from fitting these ships, and all chance of profit from being employed to build ships himself, upon being paid this royalty."

And although the Court will assume that every sale of the patented article without licence is a damage to the patentee, it will not assume that the defendant's profit is the measure of the plaintiff's loss, or that the plaintiff would have been employed to make every machine in which the patented article has been used without licence (*p*). Defendant's profit not necessarily measure of plaintiff's loss.

But the principles above stated will not necessarily apply if a patentee has been in the habit of charging a higher royalty to infringers than to ordinary licensees (*q*), nor can a plaintiff be compelled to accept from a litigant the same royalties as he has accepted from other persons (*r*). Plaintiff may charge more to infringers than others.

If there has been a verdict against the patent, it would seem that in a subsequent action for infringement the defendant would be allowed, in reduction of damages, to go into evidence to show to what extent persons have acted upon the faith of the former verdict (*s*). Effect of former verdict against patent in reduction of damages.

(*p*) *Penn v. Jack*, L. R. 5 Eq. 84 ;
and see *Ellwood v. Christy*, 18 C. B.
(N. S.) 494.

(*r*) *Penn v. Bibby*, L. R. 3 Eq.
310, 312.

(*s*) *Per Lord Loughborough, Arkwright v. Nightingal*, 1 Webst. P. C. 61.

(*q*) *Penn v. Jack*, L. R. 5 Eq. 87.

Annoyance and vexation to plaintiff not taken into account.

The annoyance and vexation to the plaintiff of the necessity of a law-suit to establish his rights is not to be estimated in the assessment of damages; the compensation for such annoyance and vexation, though possibly inadequate, is to be found in the costs of the suit (*t*).

Damages may be awarded, though not specifically prayed in the action (*u*).

If the plaintiff by his bill prays in the alternative for an account of profits or damages, and the case having been tried by a jury, no issue as to damages was submitted to the jury, the Court will not send an inquiry as to damages to Chambers, but will grant the account of profits. In such a case if the plaintiff desires damages it would seem that he ought to lay the matter before the jury for assessment (*x*).

The account and also the inquiry as to damages extends to the sale of the articles complained of within six years of the commencement of the action (*y*). This, however, will be subject to the provisions of sects. 13 and 17 (4) (*b*). But where the plaintiff was assignee of a patent, the account of profits was only ordered from the date of the registration of the assignment (*z*).

If damages are granted in substitution for an injunction, the Court may assess the damages accrued after as well as before the issue of the writ (*a*); and by the Supreme Court Rules, 1883, Order XXXVI, Rule 58, where damages are to be assessed in respect of any continuing cause of action, they shall be assessed down to the time of assessment.

The orders for account or for damages usually provide that the defendant shall pay the amount found due within a definite time after the filing of the certificate of the finding (*b*). But sometimes this is left to be dealt with on further consideration (*c*).

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, 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

(*t*) *Penn v. Jack*, L. R. 5 Eq. 84, 86; but *qu.* see the charge of the Lord Justice Clerk to the jury, *Househill Co. v. Neilson*, 1 Webst. 697, note *r*.

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

(*x*) *Needham v. Oxley*, 8 L. T. (N. S.) 604.

(*y*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 308.

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

(*a*) *Fritz v. Hobson*, 14 Ch. D. 543.

(*b*) *Plimpton v. Malcolmson*, "Seton on Decrees," 4th ed., p. 354; *Cunningham v. Colling*, *Ibid.* 355; *Young v. Fernie*, *Bovill v. Crate*, *Needham v. Oxley*, "Pemberton on Judgments," 3rd ed., pp. 235, 236.

(*c*) *Davenport v. Rylands*, "Pemberton on Judgments," p. 300; *Betts v. Noel*, "Seton on Decrees," 4th ed., p. 355.

solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

These provisions are, in substance, a re-enactment of the Act of 1852, sect. 43, which was in lieu of the Act of 1835, sect. 53, under which, upon a similar certificate being granted in the first trial, a plaintiff could, in a subsequent "suit or action touching such patent," recover treble costs. This latter enactment was repealed by 5 & 6 Vict. c. 97, which repealed in general terms all previous Acts giving double or treble costs, but the cases decided under it as to the certificate will probably be useful as guides to the interpretation of the present section.

In *Stocker v. Rodgers* (*d*) it was held that the certificate ought not to be granted if the verdict were for the plaintiff by consent, no evidence being offered. But where the validity of the patent has in part come in question, as, for instance, where there was a plea that the invention was not new, and the defendant was prevented by the state of the pleadings from raising the further objection that the patent was illegal, it was held that, as the verdict on the plea of want of novelty was for the plaintiff, the certificate might be granted (*e*).

Certificate not granted if verdict by consent.

The Act of 1852, sect. 43, required that the certificate should be given by "the Judge before whom the trial was heard," and therefore, where the Court below had on the trial dismissed the action on the ground that the patent was invalid, and this decision was reversed on appeal, the Court of Appeal thought that the safer course was that application should be made for the certificate to the Judge of the Court below, and accordingly gave leave to apply to him for that purpose, and did not themselves grant the certificate (*f*).

The present section removes this difficulty. The certificate may be given by "the Court or a Judge," that is, may be given in Chambers (*g*), and "Court," by the interpretation clause (sect. 117 (1)), means the High Court of Justice; but by the Supreme Court Rules, 1883, Order LVIII, Rule 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, and may therefore, it is presumed, certify under this present section. The Act of 1852 provided that the certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent. There is no corresponding provision in the present Act in reference to proceedings for revocation.

May now be given by Court of Appeal.

"In any subsequent action for infringement." This section applies only to a second action for infringement, and therefore does not entitle a patentee to recover the full costs of a first trial (*h*), nor apparently

Section applies only to second action for infringement.

(*d*) 1 C. & K. 99.

(*e*) *Gillet v. Wilby*, 1 Webst. 270; s.c. 9 C. & P. 334.

(*f*) *Otto v. Linford*, Appendix, *post*.

(*g*) Judicature Act, 1873, s. 39.

(*h*) *Penn v. Bibby*, L. R. 3 Eq. 308.

will it entitle a patentee who has succeeded in establishing his patent against one defendant to his costs as between solicitor and client in an action against another, a licensee, for royalties (*i*).

Onus on defendant in second action to show why plaintiff should not have full costs.

“*Full costs, charges, and expenses,*” &c. The result of the section appears to be that the *onus* is on the defendant in the subsequent action to show that the plaintiff ought not to have the full costs (*k*).

But Court has discretion.

The Court, however, has a discretion to refuse these costs, and they would be refused where the first action was collusive, or the Judge considered the case an improper one (*l*).

Refused if first action collusive.

Or not conclusive.

And full costs will be refused where, although the certificate was given in the former action, that action has not been conclusive between the parties, as where a verdict having been found for the plaintiff a new trial was directed, but was never had owing to the action having been compromised (*m*).

But plaintiff entitled to full costs though validity of patent not contested in second action.

But the plaintiff will be entitled to his costs as between solicitor and client in a subsequent suit to restrain infringement, even though the defendants in the subsequent suit have not questioned the validity of the patent (*n*).

Under the express words of the Act of 1852, sect. 43, the certificate was required to be actually given in evidence at the subsequent trial (*o*). These words are not contained in the present section.

Decree in second action should direct the taxation as between solicitor and client.

The practice of the Court of Chancery being to tax costs as between party and party, in the absence of special directions to the contrary, it was held in *Lister v. Leather* (*p*) that the decree or order under the 43rd section of the Act of 1852 should contain an express direction for the taxing-master to tax the plaintiff's costs as between solicitor and client.

For form of certificate under this section and sect. 29 (6), see “*Seton on Decrees*,” 4th ed., p. 1661, and *Lofts v. Agate*, “*Pemberton on Judgments*,” 3rd ed., p. 235.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars advertisements or otherwise threatens

(*i*) See *Bovill v. Hadley*, 17 C. B. (N. S.) 435. Tho 5 & 6 Wm. 4, c. 53, s. 3, applied to every subsequent action touching the patent.

(*k*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 309. See also remarks of Willes, J., in *Bovill v. Hadley*, 17 C. B. (N. S.) 439.

(*l*) *Davenport v. Rylands*, L. R. 1 Eq. 309.

(*m*) *Betts v. De Vitre*, 11 Jur. (N. S.) 9.

(*n*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 308.

(*o*) *Bovill v. Hadley*, 17 C. B. (N. S.) 435. See also *Newhall v. Wilkins*, mentioned in “*Chitty's Statutes*,” 4th ed., vol. iv, p. 1194.

(*p*) 4 K. & J. 425.

any other person with any legal proceedings or liability in respect of any alleged manufacture use sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

“If the alleged manufacture,” &c., “was not, in fact, an infringement,” &c. In *Halsey v. Brotherhood* (q) it was held by the Court of Appeal, on the authority of *Wren v. Weild* (r), that a patentee who issued notices against purchasing certain articles, alleging they were infringements of his patent, was not liable to an action by the vendor for damages, provided he issued the notices *bonâ fide*, and in the belief that the articles complained of were infringements of his patent. And it was further held that such a patentee was not liable to be restrained by injunction from continuing to issue the notices unless they were proved to be untrue, so that the further issue of them would not be *bonâ fide*; and Lord Coleridge, C.J., said (s): “If the statement” (as to infringement) “is made in defence of the defendant’s own property, although it injures and is untrue, it is still what the law calls a privileged statement; it is a statement that the defendant has a right to make unless, besides its untruth and besides its injury, express malice is proved, that is to say, want of *bona fides* or the presence of *mala fides*.” The statements were not actionable if they were made with reasonable and probable cause (t). If, however, the statements were not mere allegations of piracy, which is matter of law, but went on to allege, and allege untruly, matters of fact, an action, it seems, would lie. “A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts” (u).

In *Rollins v. Hinks* (x), and *Axmann v. Lund* (y), Malins, V.C., had held that a patentee issuing notices as above was liable to be restrained by injunction if he had no *bonâ fide* intention of bringing an action against the vendor of the articles to assert the validity of his patent.

(q) 19 Ch. D. 386, affirming decision of Jessel, M.R., 15 Ch. D. 514.

(r) L. R. 4 Q. B. 730.

(s) 19 Ch. D. 388.

(t) See Judgment of Baggallay, L.J., 19 Ch. D. 390.

(u) *Dicks v. Brooks*, 15 Ch. D. 22. See Judgment of Bramwell, L.J., pp. 39, 40.

(x) L. R. 13 Eq. 355.

(y) L. R. 18 Eq. 335.

But in *Halsey v. Brotherhood*, Jessel, M.R., dissented from this view, and held there was no law in this country to compel a man to assert such a right by action. The person might desist, and then there would be no occasion for the action, or he might not be worth suing.

It appears, then, that the above section makes a considerable alteration in the law as to threats of legal proceedings in patent cases. The question of the *bona fides* of the patentee will apparently henceforth be immaterial, and the sole question, when he declines to bring an action, will be aye or no is the statement as to infringement true. If it is not true, it would seem that the plaintiff may obtain an injunction and damages, whether the statement were or were not made *bona fide*.

The question whether the statements of the patentee are in fact true might be tried in the action in which damages or an injunction was sought by the party aggrieved (*z*), and if the statements were in fact not true, the plaintiff to obtain an injunction was bound to make out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement be untrue (*a*). In such a case the injunction would be granted, because after the statements had been, in the presence of the patentee, proved to be false, it would be malicious and fraudulent to continue them (*b*).

In such an action the burden of proof that the patentee's statements are false lay on the plaintiff (*c*). On the question whether the patentee's statements as to infringement could be justified, the patent, if it had not been repealed by *scire facias*, was assumed to be valid (*d*).

These rules, it is presumed, will still apply.

"*Provided that this section shall not apply,*" &c. This proviso will, it is submitted, be satisfied if the patentee brings an action for infringement, even though it be against a different person from the person aggrieved by the patentee's threats, provided it be not a collusive action.

If such an action is brought by the patentee, it would seem that, if it is prosecuted with due diligence, there is no ground for the Court to interfere against him merely because he has not applied for an interlocutory injunction in his action (*e*).

In an action against a patentee for falsely alleging infringement, the defendant may be ordered to deliver particulars showing in what respect plaintiff's machines are alleged to infringe defendant's patent,

(*z*) *Halsey v. Brotherhood*, 15 Ch. D. 518, Judgment of Jessel, M.R.; and *Burnett v. Tak*, 45 L. T. (N. S.) 743.

(*a*) *Per* Jessel, M.R., *Halsey v. Brotherhood*, 15 Ch. D. 523.

(*b*) *Per* Kay, J., *Burnett v. Tak*, 45 L. T. (N. S.) 743.

(*c*) *Burnett v. Tak*, cited above;

and see *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. (N. S.) 757, 759.

(*d*) *Per* Baggallay, L.J., in *Halsey v. Brotherhood*, 19 Ch. D. 390, overruling the *dicta* of Malins, V.C., on this point in *Rollins v. Hinks*, cited above.

(*e*) *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. (N. S.) 757.

and pointing out, by reference to pages and lines of defendant's specification, which part of the invention therein described he alleges to have been infringed (*f*).

A patentee who has agreed to grant a licence will not be allowed, pending the settlement of disputes as to the validity of the agreement and the form of the licence, to publish advertisements and circulars which will have the effect of deterring usual customers or the public from dealing with the licensee (*g*).

But the owners of English and foreign patents for the same invention, who have granted to a foreign firm a licence for the use of it in the foreign country and not elsewhere, will not be restrained at the suit of the foreign licensees from issuing circulars warning the trade that the importation into England and sale of articles made abroad according to the invention is an infringement of the English patent (*h*).

Miscellaneous.

33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only (*a*), but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. Patent for one invention only.

(*a*) If by inadvertence more than one invention is included, the application may be amended and separate patents may be applied for, but all must bear date of the first application. Patents Rules, 1883, r. 23.

The form in the first schedule does not contain any condition avoiding the patent if the specification is insufficient which has hitherto been contained in all letters patent. But the use of this form is not obligatory, and under sect. 116 the Crown may, if it is found necessary, insert such a condition in the patent.

The words referring to "one claim" appear to have been inserted here by error.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative. Patent on application of representative of deceased inventor.

(2.) Every such application (*a*) must be made within six

(*f*) *Wren v. Weild*, L. R. 4 Q. B. 213.

(*g*) *Clark v. Adie*, 21 W. R. 456; affirmed on appeal, *Ibid.* 764.

(*h*) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 1.

months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

(a) Patents Rules, 1883, r. 24.

This section alters the law. In *Marsden v. The Saville Street Foundry and Engineering Co.*(i) it had been held that the legal personal representative of a person who had made an invention, but had not taken out letters patent, could not take out such letters patent.

Patent to first inventor not invalidated by application in fraud of him.

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

This section substantially re-enacts sect. 10 of the Act of 1852. Under that Act it was held that where, on an opposition to the sealing of a patent on the ground of previous public user of the invention, the applicant alleged that such user took place in consequence of a fraud which, under the Act, would destroy its effect, such a question ought to be tried by a jury, and that the patent ought to be sealed, so that an opportunity for such trial might be given (k).

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

The corresponding section (sect. 35) of the Act of 1852 was that a patentee might "assign the letters patent for England, Scotland, and Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only."

On this section it was said by the Court of Common Pleas that the Legislature appeared "to consider and treat the grants for England, Ireland, and Scotland, although in future they might be technically contained in one instrument under the Great Seal, as separate and separable grants in substance and operation" (l).

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the

(i) 3 Ex. D. 203.

(l) *Bovill v. Finch*, L. R. 5 C. P.

(k) *Re Vincent's Patent*, L. R. 2 533. See *post*, sect. 110.
Ch. 341.

comptroller may at any time cause a duplicate thereof to be sealed (a).

(a) See Patents Rules, 1883, *post*, Second Schedule, Form N.

This section is a re-enactment in effect of sect. 22 of the Act of 1852.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court. Proceedings
and costs
before law
officer.

The power to the law officers to examine witnesses on oath is new. Under the old practice the Lord Chancellor had, in case of opposition, power to examine witnesses *vivâ voce* (m).

“*The law officer may order costs,*” &c. The comptroller has no power as to costs.

It was held by Lord Eldon, in *Ex parte Fox* (n), that where the opposition failed but was not unreasonable no costs would be given. But in the later case of *Re Cutler's Patent* (o), Lord Cottenham, C., ordered the party who had lodged an unsuccessful *caveat* against the grant of letters patent to pay to the patentee the taxed costs occasioned by the *caveat*, and this notwithstanding the opposition was alleged to be reasonable. And this appears now to be the rule (p), and *a fortiori* when the conduct of the opponents is open to suspicion (q).

And where objections were filed to the sealing of a patent, but were afterwards withdrawn, the opponent was ordered to pay the costs (r). But where the opponent's affidavits were only filed on the morning of hearing, and he was not allowed to use them, and the opposition failed, Lord Campbell, C., said it was not a case for costs (s).

Where a patent was refused on the ground of previous dedication of the invention by the inventor to the public (t), the petition for patent was dismissed with costs (u).

(m) *In re Gething*, L. R. 9 Ch. 633.

(n) 1 Webst. P. C. 431; *s.c.* 1 V. & B. 67.

(o) 4 My. & Cr. 511.

(p) *Re Harrison*, L. R. 9 Ch. 632; *Re Gething*, L. R. 9 Ch. 634.

(q) *Ex parte Scott and Young*, L. R. 6 Ch. 277.

(r) *Re Copley's Patent*, 8 Jur. (N. S.) 106; *Re Ashenhurst's Patent*, 2 W. R. 3.

(s) *Re McKean's Patent*, 1 D. F. J. 2, 4.

(t) Not now a ground of opposition. See sect. 11 (1), *ante*.

(u) *Re Adamson's Patent*, 6 De G. M. & G. 410; *s.c.* 25 L. J. Ch. 456.

So also where the application was refused on the ground that the invention was the same as in an existing patent (*x*).

Where, however, the opposition succeeded, but the case was one of first impression, no costs were given (*y*).

As between rival applicants for patents, the applicant who failed was ordered to pay costs (*z*). But in a case between master and servant the servant's patent was sealed, but as there appeared to have been some unfairness on the part of the latter the master's patent was refused, but without costs (*a*).

Where the law officer reported in favour of the patent, but terms were imposed on the patentee, no costs were given (*b*).

The taxation of costs in cases of opposition to patents has been conducted on the principles on which taxation of costs between party and party in Chancery suits was conducted, and a petition that the applicants might be allowed all costs, charges, and expenses reasonably incurred in consequence of the opposition to the patent was dismissed with costs (*c*). The law officer may now fix the amount of the costs or direct how it is to be ascertained (Law Officers' Rules, *post*, r. 11).

Exhibition at industrial or international exhibition not to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

(*a*.) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so ; and

(*b*.) The application for a patent must be made before or

(*x*) *Ex parte Yates*, L. R. 5 Ch. 1.

(*y*) *Ex parte Bates and Redgate*, L. R. 4 Cr. 577, 580.

(*z*) *Ex parte Henry*, L. R. 8 Ch. 171.

(*a*) *Re Lowe's Patent*, 25 L. J. Ch. 456.

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

(*c*) *Re Cutler's Patent*, 4 My. & Cr. 511.

within six months from the date of the opening of the exhibition.

A re-enactment, with modifications, of the provisions of 28 Vict. c. 3, and 33 & 34 Vict. c. 27. As to proceedings by intending exhibitor of unpatented invention, see Patents Rules, 1883, *post*, r. 17.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by Courts of Law, and any other information that the comptroller may deem generally useful or important. Publication of illustrated journal, indexes, &c.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as Her Majesty in Council may see fit to give. Patent Museum.

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

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or prepara- Foreign vessels in British waters.

tion of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2.) But this section shall not extend to vessels of any foreign State of which the laws authorize subjects of such foreign State, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State.

Substantially a re-enactment of sect. 26 of the Act of 1852, which altered the law as laid down in *Caldwell v. Vanvlissengen* (*d*), where an injunction was granted restraining subjects of the Kingdom of Holland from using on board their ships, within the dominions of England, without licence of the plaintiffs, certain propellers made according to the plaintiffs' patent.

Assignment
to Secretary
for War of
certain in-
ventions.

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to Her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application

(*d*) 9 Ha. 415.

for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Substantially a re-enactment of 22 Vict. c. 13.

Existing Patents.

Provisions
respecting
existing
patents.

45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

(3.) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the

commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

Sect. 113, *post*, repealing the previous Acts, enacts that the repeal shall not affect "any application pending," or "interfere with the prosecution of any proceeding in respect thereof (*g*), and any such proceeding may be carried on as if this Act had not been passed;" and sub-sect. (3) above provides that the present Act shall, except in the particulars mentioned in sub-sect. (2), viz., the provisions binding the Crown and the provisions as to compulsory licences, extend to all patents granted before the commencement of this Act, or on applications then pending. The result, therefore, is that pending applications for patents will be completed under the old law, but that the patents, when granted, will (except in the particulars mentioned in sub-sect. 2) be subject to the present Act.

Existing patents will (except in the above particulars) be subject to the new law.

And all patents applied for after the commencement of the Act will, of course, be subject to the new law in all respects.

By the Act of 1853 duties of 50*l.* and 100*l.* were payable before the end of the third and seventh years, and the patent was made subject to a condition avoiding it if these fees were not paid. Existing patents are, as to fees, to be subject to the present Act (see sub-sect. 3), under which the 50*l.* duty is to be paid before the end of four years, and the 100*l.* duty before the end of seven years, from the date of the patent, and "in lieu of the fees of 50*l.* and 100*l.*" certain annual fees may be paid (*post*, p. 209, and Patents Rules, 1883, r. 43, and First Schedule, *post*, p. 228). No difficulty arises where the 50*l.* duty has not been paid before the commencement of the Act. In that case the patentee has the option of paying the duties by annual instalments, or, as hitherto, in two sums. But the annual fees are made payable only in lieu of the 50*l.* and 100*l.* duties. When, therefore, the patent is three years old at the commencement of the Act, and when, consequently, the 50*l.* duty has been paid, there is no right to pay the remaining duty by instalments, and the 100*l.* must be paid in one sum as hitherto, before the end of the seventh year.

It would seem also that another effect of sub-sect. (3) will be that the provisions of this Act as to amendment (sect. 18) and extension (sect. 25) will apply to all patents, whether existing at the commencement of the Act, or granted on applications then pending, or granted on applications after the commencement of the Act.

Pending applications for disclaimer or extension would seem to be

(*g*) *Thereof*. that is, apparently, the several matters mentioned in sect. 113 (*a*).

on the same footing as pending applications for patents, and will, if it is submitted, be carried on under the provisions of the old law.

An important question may arise as to how far existing patents and patents granted on pending applications will be affected in regard to sect. 25 of the Act of 1852, which is repealed by the present Act and not re-enacted. By that section it was provided that where letters patent "are granted in the United Kingdom for or in respect of any invention first invented in any foreign country, or by the subject of any foreign Power or State, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force; or when more than one such patent or like privilege is obtained abroad immediately upon the expiration or determination of the term which shall first expire or be determined of the several patents or like privileges. Provided always that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted, or was in force, shall be of any validity."

Sect. 113, *post*, provides that the repeal effected by the present Act shall not affect the past operation of any of the enactments repealed.

It may well happen that there may be, at the commencement of this Act, English patents posterior in date to foreign patents for the same invention, but which foreign patents have expired or otherwise determined. In such cases it would seem that under the above provision of sect. 113 those English patents are void, and that advantage may after the Act be taken of that fact in any proceeding respecting the patent.

But if the foreign patent is in force at the commencement of this Act, then it would seem that the effect of sub-sect. (3) above is to substitute the present Act for the repealed Acts, and that in such a case the English patent will not fail, even though the foreign patent may subsequently expire or be determined. The position of such an English patent is therefore improved by the present Act.

In view of the possible application above suggested of the provisions of the 25th section of the Act of 1852 to certain existing patents, the following short statement of the effect of the decided cases may be useful.

Under that section it was held :—

That it did not apply at all to the case of an English patent obtained

before any foreign patent was taken out, whether the patent were granted to an Englishman (*h*) or to a foreigner (*i*).

That where the English patent was subsequent to the foreign patent, and the latter ceased or became void, the English patent became void also (*k*), and this whether the English and foreign patentees were or were not independent inventors (*l*).

That, even if the foreign patent were void *ab initio*, the 25th section would apply, and that the existence of a void foreign patent was not equivalent to there being no foreign patent (*m*).

That if the foreign law required a formal declaration of *déchéance* in order to determine a patent, the English Court would consider the English patent in force until that declaration were actually obtained (*n*).

That, when certain parts of the English patent were identical with the foreign patent, it did not follow as a necessary result that when the foreign patent was determined the rest of the English patent which was not identical was void also (*o*).

That, for the purposes of the 25th section of the Act of 1852, the date of the patent and not the date of the sealing was to be regarded (*p*).

That the defence of invalidity of the patent on the ground of the expiry of a previous foreign patent must be raised by the pleadings (*q*).

Where the original term of the foreign patent has expired, but the patent has been prolonged, a question may arise whether there has been such a break in the continuity of the foreign patent as to constitute a cesser within this section and the preceding sub-section. There has been no decision on the point, and of course the question must depend on the law of the foreign country and the manner in which the prolongation there is granted; but in *Johnson's Patent* (*r*), which, as appears from the judgment, was an application to prolong an English patent after the expiration of the original, but during the extended term of an American patent for the same invention, it seems to have been assumed that the American patent must be treated as having been originally granted for the extended term, and that there had been no expiration or determination of the original patent within the 25th section of the Act of 1852.

Upon applications for prolongation of the term of a patent, the Judicial Committee of the Privy Council were in the habit of acting on the spirit of the 25th section of the Act of 1852, and would refuse a prolongation

(*h*) *Re Betts' Patent*, 1 Moo. P. C. C. (N. S.) 49; *Re Poole's Patent*, L. R. 1 P. C. C. 515.

(*i*) *Winan's Patent*, L. R. 4 P. C. C. 93; *Blake's Patent*, L. R. 4 P. C. C. 535.

(*k*) *Daw v. Eley*, L. R. 3 Eq. 497.

(*l*) *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 258; 9 Jur. (N. S.) 1210.

(*m*) *Daw v. Eley*, L. R. 3 Eq. 511.

(*n*) *Ibid.* 495, 510.

(*o*) *Ibid.* 512.

(*p*) *Holste v. Robertson*, 4 Ch. D. 9.

(*q*) *Bovill v. Goodier* (No. 2), L. R. 2 Eq. 195.

(*r*) L. R. 4 P. C. C. 75, 80.

even if the English patent were prior to the foreign patent, in cases where—

The foreign patent had only a short time to run (*s*): or

One of two or more foreign patents had by the patentees themselves been allowed to expire (*t*).

Definitions.

Definitions
of patent,
patentee, and
invention.

46. In and for the purposes of this Act—

“Patent” means letters patent for an invention:

“Patentee” means the person for the time being entitled to the benefit of a patent:

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning Monopolies and Dispensations with Penal Laws and the Forfeiture thereof”), and includes an alleged invention.

In Scotland “injunction” means “interdict.”

“Patentee.” This definition allows an assignee (as under the old law) to apply for leave to amend a specification (sect. 18) or for extension (sect. 25). Under the Act of 1835 a grantee of a patent might disclaim, even after wholly (*u*) or partially (*v*) assigning his interest. But the definition above will apparently prevent this in future.

PART III.

DESIGNS.

Registration of Designs.

Application
for registration
of designs.

47. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

(2.) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed (*a*), and must be left at, or sent by post to, the Patent Office in the prescribed manner (*β*).

(*s*) *Newton's Patent*, 15 Moo. P. C. P. C. C. 93; *Blake's Patent*, L. R. 4 176; *Hill's Patent*, 1 Moo. P. C. C. P. C. C. 535.

(*N. S.*) 258; *Normand's Patent*, L. R. (*u*) *Wallington v. Dale*, 7 Ex. 888.

3 P. C. C. 193. (*v*) *Spilsbury v. Clough*, 1 Webst.

(*t*) *Winan's Patent*, L. R. 4 255.

(3.) The application must contain a statement of the nature (γ) of the design, and the class or classes of goods in which the applicant desires that the design be registered (δ).

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade (ϵ).

(7.) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(α) Designs Rules, 1883, *post*, r. 4.

(β) *Ibid.* r. 12; all communications may be signed by agents, r. 6.

(γ) *Ibid.* r. 9, and Form E, First Schedule to Designs Rules, *post*.

(δ) *Ibid.* r. 5 (for the classes see Third Schedule to Designs Rules, *post*).

(ϵ) *Ibid.* rr. 16–20.

(1.)

“*Proprietor.*” In the Act of 1861 (*w*) there was an express enactment that the Designs Act should extend to any proprietor, whether or not a subject of Her Majesty. That Act is now repealed, and there is no corresponding provision in the present Act, but since the word “proprietor” is there used without any limitation, it is presumed that a foreigner may, subject to the provisions of sect. 54, register a design equally with a British subject; and see *post*, sects. 60 and 61.

“*New or original design.*” The interpretation clause (sect. 60) does not throw much light on the meaning of the word “design” *per se*, since it merely says that “design” in the Act means a “*design applicable,*” &c. We are therefore thrown back on the cases under the old Acts.

In *Harrison v. Taylor* (*x*), Byles, J., thus defined a “design”: Definition of design.
 “I think ‘design’ imports, among other things, variations on old forms in respect of size, configuration, colour, and other qualities; but where size may introduce novelty in some parts of a design, it may not do so in other parts. Configuration may constitute a new design, for where there is alteration of proportions that may be a new design;” and in the same case, Wightman, J., said: “I apprehend a design to be not a project or invention, but a picture or drawing—something which the inventor has for the first time produced.”

(*w*) 24 & 25 Vict. c. 73, s. 1.

(*x*) 5 Jur. (N. S.) 1219; s.c. 4 H. & N. 815.

Combination designs.

A new and original combination may be a design within the Act, as the result of simultaneously applying two old and known designs to the ornamenting of a button (*y*).

So also, a honeycomb pattern consisting of a combination of a large honeycomb and a small honeycomb arranged to form a large honeycomb stripe on a small honeycomb ground, both the large and small honeycomb pattern being previously well known, but the combination being new, was protected (*z*).

And a figure of six-pointed stars on an Albert chain arranged in a particular manner, and shaded, was a good design as applied to a woven fabric (*a*).

If a combination design be registered, it is the combination which is protected, and not the separate parts (*b*).

Must be one design, and not a multiplicity of designs.

But in order that a combination design may be good, the result must be one design, and not a multiplicity of designs. And therefore a design for a shawl which had five peculiarities, each of which was in itself old, was not a design which could be registered under the old Acts. What is protected is not the article of manufacture, but the design applicable to the article of manufacture, and this was not a case of several designs going to make up one design, but of several designs applicable to one article of manufacture (*c*).

And where there were four old designs applied respectively to three ribbons and a button, and the three ribbons were then united so as to form a badge, this was held by Lord Hatherley, then V.C., not to be a design within the Act (*d*).

And something novel must be introduced into the combination.

In *Lazarus v. Charles* (*e*), Malins, V.C., observed that the cases of *Harrison v. Taylor* and *R. v. Firmin* had given an exceedingly liberal interpretation to the Act, and said that he would follow them with great reluctance unless something novel were introduced into the combination; and he held that a mere combination of two old card-baskets into one basket, making a double basket, could not be registered.

A copy of a photograph of a public character is not a new or original design which can be registered (*f*), nor was the use of an arch under the body of a carriage for the purpose of enabling the wheels to pass under the carriage during the turning of the carriage, when the novelty was that the arch proposed was only larger than that formerly used for the same purpose (*g*).

Article in two parts may be registered.

But an article in two parts, such as a butter-dish consisting of a dish

(*y*) *R. v. Firmin*, cited *Harrison v. Taylor*, 3 H. & N. 304; *Norton v. Nichols*, 1 E. & E. 765; s.c. 5 Jur. (N. S.) 1203.

(*z*) *Harrison v. Taylor*, 4 H. & N. 815; s.c. 5 Jur. (N. S.) 1219.

(*a*) *Holdsworth v. McCrea*, L. R. 2 H. L. 380.

(*b*) *Ibid.*

(*c*) *Norton v. Nicholls*, 1 E. & E. 765; s.c. 5 Jur. (N. S.) 1203.

(*d*) *Mulloney v. Stevens*, 10 L. T. (N. S.) 190.

(*e*) L. R. 16 Eq. 117.

(*f*) *Adams v. Clementson*, 12 Ch. D. 715.

(*g*) *Windover v. Smith*, 32 Bea. 200; 9 Jur. (N. S.) 397.

and a cover, is one article of manufacture, and the design may be registered (*h*).

The question whether a design is new and original is for the jury, and is to be decided from the evidence of experts, and principally from eyesight (*i*). Question of originality is for jury, and is matter of eyesight.

There is little or no analogy between patents and designs (*k*), and therefore, where the design was for a combination of large and small honeycomb patterns, and it was shown that a pattern called "hopsack" pattern had been used in the same way, the Court of Exchequer Chamber, reversing the decision of the Court below, refused to follow the analogy of the case of *Brook v. Aston* (*l*), where it was held that there could be no patent for a mere application of old means to a new purpose, and held the honeycomb combination to be a good design (*m*). Nor is the proprietor of the design bound to distinguish what is new from what is old (*n*), nor to describe it with the same nicety and accuracy as is required in the specification of a patent (*o*). No analogy between patents and designs.

"Not previously published," &c. The question of novelty of a design is not necessarily the same as the question of publication in the United Kingdom. If the design has been previously so published, of course the design cannot be registered; but even if the particular design may not have been so published, the case of *Lazarus v. Charles* and the other cases cited above show that the Court will sometimes take upon itself to say that a particular design does not contain a sufficient element of novelty to entitle it to registration. Novelty distinct from publication.

Under the 4th section of the Act of 1842, which required the design to be registered "before publication thereof," a doubt was expressed whether the term "publication" was limited to publication of the design itself or to publication after the design had been embodied and introduced into some fabric (*p*). What is publication.

Where the plaintiffs, before registering their designs, had placed them in the hands of their travellers, who took them about for the purpose of obtaining orders, it was held that the designs had been published, so that they could not be registered (*q*).

(2.)

As to correction of clerical errors in, or in connection with, an application for registration of a design, see sect. 91 (*a*), *post*, p. 189; and as to amendments, see Designs Rules, 1883, r. 30, *post*. In certain cases the comptroller has a discretion as to evidence, *Ibid.* r. 29.

(*h*) *Fielding app. v. Hawley resp.*, 48 L. T. (N. S.) 639.

(*i*) *Harrison v. Taylor*, 4 H. & N. 815; *s.c.* 5 Jur. (N. S.) 1219.

(*k*) *Harrison v. Taylor*, 4 H. & N. 815; 5 Jur. (N. S.) 1219.

(*l*) 8 E. & B. 478.

(*m*) *Harrison v. Taylor*, cited above.

(*n*) *McCrea v. Holdsworth*, L. R. 6 Ch. 420, *per* Lord Hatherley, C.

(*o*) *Holdsworth v. McCrea*, L. R. 2 H. L. 385, *per* Lord Cranworth.

(*p*) *Dalglish v. Jarvie*, 2 Mac. & G. 231.

(*q*) *Hunt v. Stevens*, W. N. 1878, 79.

(3), (4.)

A design may be registered as applied to single articles in a class, or as applied to a set of articles for a class. See Designs Rules, 1883, First Schedule, *post*.

(7.)

The provisions of this sub-section seem to be subject to the general powers given to the Court by sect. 90, *post*, as to rectification of any register kept under this Act.

The sub-section differs from the corresponding provisions as to trade marks in Part IV in not giving authority to the Board of Trade to refer the appeal to the Court; see sect. 64 (5), *post*, and notes thereto. See also notes to Designs Rules, 1883, *post*, r. 16.

The provisions of the repealed Act of 1850 (*r*) as to provisional registration are not re-enacted in this Act.

See further as to effect of registration, sect. 58, *post*.

Drawings, &c.,
to be furnished
on application.

48. (1.) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings photographs or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design (*a*).

(2.) The comptroller may, if he thinks fit, refuse any drawing photograph tracing representation or specimen which is not, in his opinion, suitable for the official records.

(*a*) Designs Rules, 1883, *post*, rr. 8, 9.

(1.)

“*Exact representations or specimens.*” The privilege of registering a pattern was expressly conferred by the Act of 1858 (*s*), under which it was held that if the pattern consisted of different parts, each of which separately might have been registered as a design, the registering the pattern was a claim only to the combination shown in the pattern, and not to the separate parts (*t*).

Under the special words of the Act of 1858 it was held that if a pattern were registered, there was no need of a written description, which was in certain cases required by the other Acts (*u*). In the present Act, however, the “specimen” is only to be instead of a copy of the design. It is presumed, therefore, that a description sufficient

(*r*) 13 & 14 Vict. c. 104.

(*s*) 21 & 22 Vict. c. 70, s. 5. In *Norton v. Nicholls*, 4 K. & J. 475, Wood, V.C., held that the registration of a specimen was registration of a copy within the 5 & 6 Vict. c. 100,

s. 15, contrary to the opinion of the Court of Queen's Bench in the same case, 5 Jur. (N. S.) 1203.

(*t*) *Holdsworth v. McCrea*, L. R. 2 H. L. 380.

(*u*) *Ibid.*

to satisfy sect. 47, sub-sect. (3), will be necessary, whether a specimen is or is not furnished to the comptroller. And from the Designs Rules, 1883, r. 9, and the marginal note to Form E, *post*, it appears that all that is required is a statement whether the design is applicable for the pattern or the shape, and as to the means by which it is applicable.

Exact representations or specimens, if not furnished on the application to register, must be furnished to the comptroller before the articles to which the design is to be applied are offered for sale. See sect. 50 (2), *post*.

49. (1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered. Certificate of registration.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

See *post*, sect. 96.

Copyright in Registered Designs.

50. (1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration. Copyright on registration.

(2.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

(1.)

“*Copyright*” is defined *post*, sect. 60.

(2.)

“*Before delivery on sale.*” These words remove the doubt as to the meaning of “*publication*” expressed in *Dalglish v. Jarvie*, cited *ante*, p. 143. See also *post*, p. 268.

“*Shall cease.*” See *post*, sect. 51.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or Marking registered designs.

figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Under the corresponding provisions in the Act of 1842 (*y*), where the words were that no person should be "entitled to the benefit" of the Act unless the register mark was placed on "every" article of manufacture to which the design should be applied, it was held that the provisions of the Act were imperative, and that there was no equity in the Court to relieve against the Statute (*z*), and where it was shown in one case (*a*) that two articles, and in another (*b*) that one article, had not been stamped with these marks, the plaintiffs could not establish their copyright, and an injunction was refused. And it was necessary that this mark should be placed on all the articles, whether sold abroad or in this country (*c*).

A book of copies of registered designs was under the old Acts held not to require the registration mark (*d*).

Every portion of the article containing the design which is published and put forth by the manufacturer as such must contain the prescribed mark, and therefore, where a manufacturer of wall papers sold as patterns small pieces containing the whole design, but not marked as required by the Act, it was held that he was not protected, and could not maintain an action for infringement (*e*).

But if the article itself is in two parts it is sufficient if one part be marked with the prescribed marks (*f*).

If during the progress of manufacture part of the registered mark on the article becomes illegible, it seems that this will not deprive the proprietor of the protection of the Statute (*g*).

"Unless the proprietor," &c. This provision is new.

Inspection of registered designs.

52. (1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorized in writing by the proprietor, or a person authorized by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on pay-

(*y*) 5 & 6 Vict. c. 100, s. 4.

(*z*) *Peirce v. Worth*, 18 L. T. (N. S.) 710; W. N. 1868. 217.

(*a*) *Peirce v. Worth*, cited above.

(*b*) *Hunt v. Stevens*, W. N. 1878, 79.

(*c*) *Sarazin v. Hamel* (No. 1), 32 Bea. 145; s.c. (No. 2), *Ibid.* 151; 9 Jur. (N. S.) 192.

(*d*) *Branchardière v. Elvery*, 4 Ex. 380; 18 L. J. (N. S.) Ex. 381.

(*e*) *Heywood v. Potter*, 1 E. & B. 439.

(*f*) *Fielding app. v. Hawley resp.*, 48 L. T. (N. S.) 639.

(*g*) *Fielding app. v. Hawley resp.*, *ubi sup.*

ment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee (*a*).

(*a*) Designs Rules, 1883, *post*, r. 33.

This and the next section re-enact, with modifications (the most important of which is the power given to the Court to authorize an inspection), sect. 17 of the Act of 1843.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design (*a*), and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Information as to existence of copyright.

(*a*) Or in respect of any design identical with it, or of which the design produced is an obvious imitation. Designs Rules, 1883, *post*, r. 35.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

Cesser of copyright in certain events.

Register of Designs.

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

Register of designs.

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

(*a*) Designs Rules, 1883, rr. 21-28.

See *post*, sects. 87, 88, 89, 90, 91, 93.

"Assignments," &c. See note under Designs Rules, 1883, r. 22, *post*, p. 266.

Fees.

Fees on registration, &c.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct (a).

(a) Designs Rules, 1883, *post*, First Schedule.

Industrial and International Exhibitions (a).

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

57. The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; nameiy,—

- (a.) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and
- (b.) The application for registration must be made before or within six months from the date of the opening of the exhibition.

(a) Designs Rules, 1883, *post*, r. 36, Form L.

A re-enactment, with modifications, of the provisions of 22 Vict. c. 3, and 33 & 34 Vict. c. 27, applying to designs.

Legal Proceedings.

Penalty on piracy of registered design.

- 58.** During the existence of copyright in any design—
- (a.) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in

which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

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

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

A re-enactment, with modifications, of sect. 7 of the Act of 1843. An important modification is that in clause (b) the word "knowing" is substituted for the more complicated provisions of the old Act.

Clause (a), it will be noted, deals with the manufacturer, and clause (b) with the retailer; and the latter is only liable if he sells the article knowing that the design has been applied without the proprietor's consent.

Distinction between the manufacturer and retailer.

See also sect. 59.

If a design be registered as applied to any particular thing, it seems that it cannot be claimed apart from that thing (h).

Design registered for particular thing cannot be claimed apart from that thing.

"Such design or a fraudulent or obvious imitation." The words "such design," without the words "fraudulent imitation," will prohibit anything which is substantially the same design. A fair imitation, that is to say, "something to which the idea of the original design has been applied," is not prohibited. "Fraudulent imitation" is more than this—it is "imitation with knowledge, . . . conscious imitation, the man having the design before him" (i).

In this Act the words "or obvious" have been added after the word "fraudulent" in the corresponding sentence of the Act of 1843.

On the question whether a design has been infringed, "the appeal is to the eye, and the eye alone is the judge of the identity of the two things" (k), and this is a question for the jury (l).

On question of infringement of design, the appeal is to the eye.

But it is not necessary, in order to establish a case of infringement, that every detail should be actually copied. It is sufficient if the thing

(h) *Barran v. Lomas*, 28 W. R. 973.

See also *Barran v. Lomas*, 28 W. R. 975.

(i) *Ibid.* pp. 974, 975.

(l) *McCrea v. Holdsworth*, L. R. 1 Q. B. 264.

(k) *Per Lord Westbury, Holdsworth v. McCrea*, L. R. 2 H. L. 388.

complained of is to all appearance the same as the registered design, and identical for the purpose for which it is made (*m*).

(*a*.) "*For purposes of sale.*" Under corresponding words in the Act of 1843, sect. 7, an injunction was granted by Knight Bruce, V.C., to restrain not merely the sale but the manufacture of articles to which the design was applied during the continuance of the registration, and this although it was not intended that they should be sold till the term of protection had expired. And the articles complained were ordered to be given up to the plaintiff for the purpose of being destroyed (*n*).

(*b*.) "*Consent.*" Where, under the Act of 1843, written notice that the proprietor's consent had not been given was required, it was held the notice must show distinctly that the plaintiff's consent has not been given (*o*).

"*Who may recover.*" Under the old law (Act of 1842, sect. 8) the penalty could be recovered by action or by summary proceedings before Justices of the Peace. On similar words in the corresponding section of the Copyright (Works of Art) Act (*p*) it was held that process before a magistrate to enforce the penalty was of a criminal nature, and not for a debt (*q*). It will be observed that in this sub-section the penalty is recoverable only by action, and is made a simple contract debt.

Action for
damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

See sect. 58.

A substantial re-enactment of sect. 9 of the Act of 1842, adding, however, the words "or obvious" after "fraudulent."

(*m*) *McCrea v. Holdsworth*, L. R. 6 Ch. 419.

(*n*) *McCrea v. Holdsworth*, 2 De G. & Sm. 499; s.c. 12 Jur. 820. See the form of the decree also in "Pemberton on Judgments," 3rd ed., p.

231. See also *Crossley v. Beverley*, 1 Webst. 119, a patent case.

(*o*) *Norton v. Nicholls*, 1 E. & E. 765; 5 Jur. (N. S.) 1203.

(*p*) 25 & 26 Vict. c. 68, s. 6.

(*q*) *Ex parte Graves*, L. R. 3 Ch. 642.

It is no answer to an action to recover penalties for an infringement that a design has been registered under a wrong class (*r*).

The publication and sale of a book of registered designs is not a licence to the purchaser to sell articles to which the designs had been applied (*s*).

It is sufficient in the pleadings to allege that the design and the proprietorship have been duly registered, and it is not necessary expressly to allege that all the provisions of the Act have been complied with (*t*).

“*Knowing that the proprietor,*” &c. Therefore, before suing a retailer for infringement of a design, the plaintiff must give him notice that the proprietor’s consent has not been obtained, unless it can be proved from other sources that the retailer had already knowledge of the fact (*u*).

Definitions.

60. In and for the purposes of this Act—

“Design” means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

Definition of
“design,”
“copyright.”

“Copyright” means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

This definition is taken nearly *verbatim* from the 3rd section of the Act of 1842, omitting in the present Act, after the words “applicable to,” the words “the ornamenting of.” The Act of 1842 dealt only with ornamental designs. “Useful” designs were dealt with by the 6 & 7 Vict. c. 65, which, by the 2nd section, gave protection to a new and original design for any article of manufacture having

(*r*) *Lowndes v. Browne*, 12 Ir. L. R. 293.

(*s*) *Branchardière v. Elvery*, 4 Ex. 380; *s.c.* 18 L. J. (N. S.) Ex. 381.

(*t*) *Sarazin v. Hamel* (No. 1), 32 Bea. 145; *s.c.* 9 Jur. (N. S.) 192.

(*u*) See remarks of Jessel, M.R., *Halsey v. Brotherhood*, 15 Ch. D. 517.

reference to some purpose of utility, so far as such design should be for the shape or configuration of such article, and that whether it should be for the whole of such shape or configuration, or only for a part thereof.

Questions arose under the old Act as to whether a particular arrangement was or was not a "useful design" within the latter Act, or whether it was not properly an article of manufacture the subject of a patent (*x*). These questions cannot now arise, there being no distinction in the present Act between ornamental and useful designs.

But it was said under the old Act, and there appears to be nothing in the present Act to the contrary, that if the invention was not merely a good "useful" design, but was also a proper subject of a patent, there was nothing to prevent an inventor from having a concurrent right to take out a patent, or to take the smaller protection given by the Designs Act (*y*).

"*Shape or configuration.*" It has been considered doubtful whether a mechanical contrivance in the stem of a parasol (*z*), or a design for a protector label, which consisted in making in the label an eyelet-hole and lining it with a metallic substance (*a*), could be considered designs for "shape or configuration."

On the other hand, a design of a new form of brick with corresponding apertures in the sides, so that passages were formed when the bricks were laid together through which ventilation could take place, was held under the old Act a good design for "shape or configuration having reference to some purpose of utility" (*b*).

It was also held that a mere combination of parts for a useful purpose, independently of shape or configuration, was not within the Act (*c*).

"*Copyright.*" Under the Act of 1843, sect. 3, the proprietor had the sole right to apply the registered design, "provided the same were done within the United Kingdom of Great Britain and Ireland." This limitation was repealed by the Act of 1858, and is not contained in the present Act.

See also sect. 58, *ante*.

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or

(*x*) *Millingen v. Picken*, 1 C. B. 799; *Rogers v. Driver*, 1 Q. B. 103; *R. v. Bessell*, 16 Q. B. 810; *Margelton v. Wright*, 2 De G. & Sm. 420; *White v. Toms*, 37 L. J. (N. S.) 204.

(*y*) *Per Erle, J., and Coleridge, J., Rogers v. Driver*, 16 Q. B. 108.

(*z*) *Millingen v. Picken*, 1 C. B. 799.

(*a*) *Margelton v. Wright*, 2 De G. & Sm. 421.

(*b*) *Rogers v. Driver*, 16 Q. B. 103.

(*c*) *R. v. Bessell*, 16 Q. B. 810.

valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

This section is substantially the same as sect. 5 of the Act of 1842, under which it was held that where a person has a workman in his employ under him, and the workman makes a design which is new and original, that design becomes the property of the master; but that persons who were not the original designers, nor the employers of the actual designer, but who had merely purchased the design abroad, were not proprietors within the Act (*d*). So also, where an American manufacturer purported to sell to the plaintiff the sole right to sell an article newly designed and about to be manufactured, it being stipulated that the plaintiff should obtain the articles exclusively from the manufacturer, it was held that the plaintiff, not having under the contract the right to manufacture, had not acquired the right to apply the design, and could not be registered as proprietor (*e*).

See also notes under Designs Rules, 1883, *post*, r. 22.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

62. (1.) The comptroller may, on application (*a*) by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. Application for registration.

(2.) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner (*β*).

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered (*γ*).

(*d*) *Lazarus v. Charles*. L. R. 16 Eq. 116, 121.

(*e*) *Jewitt v. Eckhardt*, 8 Ch. D. 404.

(4.) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade (δ), who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid (ϵ).

(α) Trade Marks Rules, 1883, rr. 7-13. Applications and all communications may be made by or through agents. *Ibid.* r. 8 and Form F.

(β) *Ibid.* r. 11. In certain cases a specimen may be deposited, r. 13.

(γ) *Ibid.* rr. 13, 14.

(δ) *Ibid.* rr. 20-24.

(ϵ) *Ibid.* rr. 23, 44.

(1.)

Applications for registration of marks for cutlery, if made by a person carrying on business in Hallamshire, or within 6 miles thereof, are to be made to the Cutlers' Company (see sect. 81 (3), *post*), who may enter the mark in the "Sheffield Registry" established by that section, and thereupon notice is to be given to the comptroller, who is to enter the mark in the Register of Trade Marks (see sect. 81 (6), *post*, p. 176).

A foreigner may register a trade mark if in use and intended to be used in this country, but not otherwise (f).

(2.)

As to correction of clerical errors in or in connection with an application for registration of a trade mark, see sect. 91 (α) *post*, and Trade Marks Rules, 1883, Form A.

(4.)

Under the Act of 1875 it was held that if the applicant is a person who is for the time being entitled to the exclusive use of a trade mark in accordance with law, and the trade mark is one within the definition of the Act (*post*, sect. 64), he was entitled to registration *ex debito justitiæ*. The burden of proof lay on the applicant, but if he produced such proof as would, in the opinion of the Court, entitle him to an injunction, the words in sect. 5 of that Act, "if satisfied of the justice of the case" (g), were not to be construed as meaning to give the Court a discretion whether the nature of the trade mark was such as to make it inconvenient that the applicant should exercise the right of property which he was proved to have (h). Subject to the

(f) *Re Riviere's Trade Mark*, 49 L. T. (N. S.) 504.

(g) These words are not in the present Act.

(h) *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 497, Judgment of Lord Blackburn.

discretion given by the 86th section, it is submitted that this will also be the rule under the present Act.

In *Re Farina* (i) it was said by Hall, V.C., on an opposition by the owner of a mark already on the Register, that the question whether registration should be refused or not depended on whether the party opposing registration would, independently of the Trade Marks Registration Act, have been entitled to restrain the use of the proposed mark by the applicant.

“*Conditions.*” Registration may be granted subject to an undertaking to use or not to use the mark in a particular way (j), or in a particular place (k), and a notice of the undertaking will be placed on the Register (l).

(5.)

If registration is refused by the comptroller, and if the Board of Trade on an appeal should refuse to refer the appeal to the Court, and should confirm the comptroller’s decision, the applicant’s remedy will be under sect. 90, *post*, but a question may arise whether the applicant will be allowed to avail himself of that section until he has exhausted his remedies under this present section.

The sub-sects. (4) and (5) refer to unopposed cases ; opposed cases are dealt with in sect. 69, *post*.

The Act contains no provisions as to the costs of proceedings before the comptroller or the Board of Trade.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, the application shall be deemed to be abandoned. Limit of time for proceeding with application.

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

- (a.) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or
- (b.) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or
- (c.) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

(2.) There may be added to any one or more of these

(i) 26 W. R. 261.

(j) *Re Whiteley’s Trade Mark*, 29 W. R. 235 ; *Re Farina*, Seb. Dig. p. 405 ; *Re Sykes & Co.’s Trade Mark*, 29 W. R. 235.

(k) *Re Rabone, Brothers, & Co.*, Seb. Dig., p. 395.

(l) See cases cited in the two previous notes.

particulars any letters words or figures, or combination of letters words or figures, or of any of them.

(3.) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five (a) may be registered as a trade mark under this part of this Act.

(a) The day of the passing of the Act of 1875.

A re-enactment, with considerable alterations, of sect. 10 of the Act of 1875.

This section must be read in connection with sect. 73, *post*.

In *Orr Ewing v. Registrar of Trade Marks* (m), Hall, V.C., said that the device the registration of which is applied for must be looked at as a whole, and that if it appears to be such as in the ordinary course of business would be distinguished from other devices, it should be registered. Commenting on these words when the case was under appeal to the House of Lords (n), Earl Cairns, C., said: "To some extent, no doubt, this is true, but I apprehend the first duty cast upon the Court is to ascertain whether some one or more than one of the essential particulars of a trade mark as defined by the Act is found to exist, so that the mark may be described with one or more than one essential particular or particulars which distinguish it." And in that case it was held that certain devices of lions, demi-lions, and elephants, with the name and address of the firm added, which had been put into the second class by the Manchester Committee of Experts (o) were "distinctive devices" within the Act, and that the registrar ought to proceed with the application to register them as cotton marks, although elephants, lions, and demi-lions had been, in fact, in common use in the trade as marks for cotton goods (p).

(b.) The words, "applying for registration thereof as a trade mark," are new.

(c.) "*Brand fancy word or words not in common use.*" These words are in addition to the corresponding section of the Act of 1875. Under that Act it was held that the word "AEILYTON" could not be registered as a new mark (q).

(2.)

The words "Filtre Rapide" in combination with a written signature were allowed to be registered, though the words "Rapid Water Filter" were already on the register (r).

(m) 8 Ch. D. 798.

(n) 4 App. Cas. 484.

(o) Trade Mark Rules, Aug. 1876, Rule 59.

(p) See also *Re Dugdale's Application*, 49 L. J. (N. S.) Ch. 303.

(q) *Ex parte Stephens*, 3 Ch. D. 659.

(r) *Re Maignan*, 28 W. R. 759.

(3.)

“*Special and distinctive word or words.*” Where the first producer of an article of manufacture has identified it with a particular name, whether his own name or a name which is a word descriptive of the article itself, such name becomes a trade mark (*s*), as, for instance, “Singer” (the name of the original maker), as applied to sewing-machines (*t*); “Harvey,” as a name for a sauce (*u*); “Turin,” “Sefton,” “Leopold,” or “Liverpool,” as names for cloth (*x*); and “Eureka” for shirts (*y*).

And the name of a place may become a trade mark, thus: “Anatolia” (*z*), as applied to liquorice; “Glenfield,” as applied to starch (*a*); “Cormac Springs” (*b*), “Radstock,” as applied to collieries within the parish of that name (*c*); “Apollinaris” as applied to mineral waters (*d*).

And see under sect. 73, *post*.

The use before the Act of 1875 of words as part of a trade mark is not sufficient to entitle those words to registration (*e*).

It is doubtful whether the scientific name of a tree is a “distinctive word” capable of being registered as an old trade mark for a product of the tree (*f*).

The word “Royal” in connection with the name of a Company was held not sufficiently “special and distinctive,” and was refused registration (*g*). So also the word “Registered” will not be put on the register either alone or as part of a mark (*h*). See also p. 334, *post*.

The words “Family Salve” (*i*), “Kitchen Crystal Soap” (*j*), have been held entitled to registration as old marks.

“*Letter, figure, . . . combination of letters and figures,*” are additions to the Act of 1875, under which it was held that a single letter could not be registered as an old mark (*k*).

A word in foreign characters may be registered (*l*); but a translation must be supplied to the comptroller (*m*).

Although words or devices indicating merely quality cannot be registered, combinations of letters, indicating to purchasers (1) that the

(*s*) *Singer Co. v. Wilson*, 3 App. Cas. 376.

(*t*) *Singer Co. v. Wilson*, *ubi sup.*

(*u*) *Lazenby v. White*, 41 L. J. Ch. 354.

(*x*) *Hirst v. Deuham*, L.R. 14 Eq. 543.

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

(*z*) *McAndrew v. Bassett*, 4 D. J. S. 380.

(*a*) *Wotherspoon v. Currie*, L. R. 5 H. L. 508.

(*b*) *Wheeler v. Johnston*, L. R. 3 Ir. 284.

(*c*) *Braham v. Beachim*, 7 Ch. D. 848.

(*d*) *Apollinaris Co. v. Edwards*, “*Seton on Decrees*,” 4th ed., p. 237.

(*e*) *In re Palmer's Trade Mark*, 24 Ch. D. 504; *Rose v. Evans*, 48 L. J. Ch. 618.

(*f*) *Rose v. Evans*, *ubi sup.*

(*g*) *Re Royal Baking Powder Co.*, W. N. 1879, 108; *s.c.* on appeal, W. N. 1880, 49.

(*h*) *Re Meikle's Trade Mark*, W. N. 1876, 248.

(*i*) *Reinhardt v. Spalding*, 49 L. J. Ch. 57.

(*j*) *Eastman's Trade Mark*, W. N. 1880, 128.

(*k*) *Re Mitchell's Trade Mark*, 7 Ch. D. 36.

(*l*) *In re Rotherham's Trade Mark*, 11 Ch. D. 250; 14 Ch. D. 585. See also Judgment of Malins, V.C., *Re Barrow's Trade Marks*, 5 Ch. D. 364.

(*m*) Trade Marks Rules, 1883, *post*, r. 15.

goods are made by a particular firm, and (2) the quality and pattern of the goods, are valid trade marks, and may be registered (*n*).

Marks for cotton goods, consisting of a shield or frame in the shape of a shield, with (1) letters indicative of the firm itself, (2) representation of a swan, and also letters indicative of the firm, varying letters being used on each mark, indicating the date and packer of each parcel of calico, were considered sufficiently distinctive to be registered as old marks, on an undertaking not to use them except in the manner in which they had been previously used (*o*).

Price is no part of a trade mark, and therefore registration was refused for a mark containing words of price, but registration of two old marks was allowed, with a note that the marks might be varied in respect of price (*p*).

Representative
registration.

Where a firm had been in the habit of using as trade marks for iron the letter, "B B H," which were the initials of the firm, and also the same marks coupled with symbols or words common to the trade, denoting the quality of the iron, and the registrar objected to separate registration of each mark, it was suggested by the Court of Appeal, and accepted by the parties, on an appeal from a decision of Malins, V.C., ordering separate registration, that the proper mode of registering was to register "B B H" "either used alone or in common with a crown, or with a horse-shoe or with a crown and horse-shoe" (the symbols objected to as common to the trade), "or with any other mark, device, or words signifying the quality of the iron" (*q*). And in a subsequent case of *Re Brooks' Trade Mark* (*r*), it was held by Hall, V.C., that this method of registration (which was known as representative registration) ought to be adopted in like cases, and that such a series of marks was not entitled to separate registration. As to registering such marks now, see *post*, sect. 66.

"Used as a trade mark." In reference to the corresponding section (sect. 10) of the Act of 1875, it was said by Malins, V.C., that "wherever there is a trade mark which has been lawfully used, whether it consists of a single device, as the crown with the initials, or of a foreign word such as 'Anatolia,' or the Turkish word for 'warranted' simply, or of a name with a device, or also of a description of quality, if the whole combination is such as would, before the passing of the Act, have been the proper subject of a trade mark, and could have been protected as a trade mark, that should be registered, and could properly be registered" (*s*). But a trade mark in use before the Act cannot be registered unless it is within one of the definitions con-

(*n*) *Ransome v. Graham*, 47 L. T. (N. S.) 218; 51 L. J. (N. S.) Ch. 897. See also *Ainsworth v. Walmisley*, L. R. 1 Eq. 518.

(*o*) *Re Sykes & Co.'s Trade Mark*, 29 W. R. 235.

(*p*) *Re Steedman's Trade Mark*, L. J. No. Ca. 1883, 83.

(*q*) *Re Barrow's Trade Marks*, 5 Ch. D. 353.

(*r*) 26 W. R. 791.

(*s*) *Re Barrow's Trade Marks*, 5 Ch. D. 364.

prised in the above three sub-sections (*t*). And a mark used before the 13th August, 1875, is an old mark only in respect of the goods on which it has been used, and as regards other goods it is to be treated as a new mark (*u*).

As to registration of identical or nearly identical marks, see *post*, sect. 72.

65. A trade mark must be registered for particular goods or classes of goods (*a*). Connection of trade mark with goods.

(*a*) Trade Marks Rules, 1883, r. 6, and Third Schedule thereto, *post*.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (*a*) the statement of the goods for which they are respectively used or proposed to be used, or (*b*) statements of numbers, or (*c*) statements of price, or (*d*) statements of quality, or (*e*) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately. Registration of a series of marks.

See Trade Marks Rules, 1883, *post*, r. 14.

This section deals with what was known as representative registration (see *ante*, notes to sect. 64 (3) p. 160), and the last clause secures to the proprietors of the marks the same rights as if there had been separate registration of each, and meets the objections to representative registration stated in the arguments to the cases of *Re Barrow's Trade Marks* and *Re Brooks*, cited above.

67. A trade mark may be registered in any colour, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour (*a*). Trade marks may be registered in any colour.

(*a*) See *post*, p. 334, as to ornamental or coloured groundwork, part of a mark.

Under the Act of 1875 colours could not be registered, and therefore the Court would not take similarity of colour into consideration on a question of piracy, but the plaintiff was bound to prove his case from a comparison of uncoloured diagrams (*v*). The fact that under that Act the mark might be printed in any colour was considered a reason for

(*t*) *Re Mitchell's Trade Mark*, 7 Ch. D. 36.

(*u*) *Re Jelly, Son, & Jones*, 51 L. J. Ch. (N. S.) 639, n.

(*v*) *Nuthall v. Vining*, 28 W. R. 330. See also Judgment of Earl Cairns, C., *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 485.

refusing registration of a mark which, though if printed in a different colour from the opponent's mark was sufficiently distinctive, would yet have been liable to deceive if printed in the same colour (*w*).

But where a registered cotton mark was a silver rupee it was held that a gold mohur which had been deposited under r. 8 of the Rules under the Act of 1875 (now part of r. 13 of the Trade Marks Rules, 1883, *post*), and of which the representation could be seen, was not calculated to deceive, and could be registered for cotton goods (*x*).

Advertisement
of application.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller.

See Trade Marks Rules, 1883, *post*, rr. 25-28.

Opposition to
registration.

69. (1.) Any person may within two months of the first advertisement of the application, give notice in duplicate at the Patent Office of opposition (*a*) to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

(2.) Within two months after receipt of such notice or 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 for his application, and if he does not do so, shall be deemed to have abandoned his application.

(3.) If the applicant sends such counter statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court (*β*).

(*a*) Trade Marks Rules, 1883, *post*, Form J. (*β*) *Ibid.* r. 29.

Substantially an enactment of sect. 16 of the Rules of August 1876, as altered by Rule 15 of the Rules of March 1883, under the Act of 1875.

(*w*) *Re Worthington & Co.'s Trade Mark*, 14 Ch. D. 8.

(*x*) *Re Robinson's Trade Mark*, 29 W. R. 31.

(4.)

In an opposed application, where the case “stands for the determination of the Court,” the comptroller is to require the applicant to issue a summons in the chamber of a Judge of the High Court of Justice for an order that, notwithstanding the opposition, the registration be proceeded with, or to take such other proceedings as may be proper and necessary for the determination of the case by the Court (Trade Marks Rules, 1883, *post*, r. 29). This is substantially in accordance with the old practice as stated by Jessel, M.R., in *Re Simpson, Davies, and Sons' Trade Mark* (*y*). In the same case a motion by the opponent for an injunction to restrain the registration, a course which had been adopted in previous cases (*z*), was considered irregular. In a previous case of *Re Salamon* (*a*), where a question of title was involved, one of the parties was directed to bring an action to try the right; and in the same case Jessel, M.R., said that a simple question of law was best tried by special case (*b*).

The case does not, for the purpose of costs, “stand for the determination of the Court” till the security for costs has been given by the opponent under (3) (*c*). See *post*, p. 335.

70. A trade mark, when registered, shall be assigned and transmitted (*a*) only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Assignment and transmission of trade mark.

(*a*) See Trade Marks Rules, 1883, *post*, rr. 34–36.

It is settled by a series of cases that both trade marks and trade names are, in a certain sense, property, and that the right to use them passes with the goodwill of the business to the successors of the firm that originally established them, even though the names of that firm be changed so that they are no longer strictly correct (*d*).

“*Determinable with that goodwill.*” See *Ralph's Trade Mark* (*e*).

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court (*a*).

Conflicting claims to registration.

(*a*) This is to be by special case. Trade Marks Rules, 1883, rr. 41, 42, 43.

(*y*) 15 Ch. D. 525.

(*c*) *Re Brandreth's Trade Mark*, 9 Ch. D. 619.

(*z*) *Re Worthington & Co.'s Trade Mark*, 14 Ch. D. 8, and the other cases mentioned in the argument to *Re Simpson, &c.*, cited above.

(*d*) *Per* Lord Blackburn, *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 33, citing *Hall v. Barrows*, 4 De G. J. & S. 150; *Millington v. Fox*, 3 My. & Cr. 338. See also *Bury v. Bedford*, 4 De G. J. & S. 352.

(*a*) Seb. Dig., p. 340.

(*b*) See also *Re Grimshaw*, W. N. 1877, 24.

(*e*) 32 W. R. 168.

“*Proprietor of the same trade mark.*” Where two persons had used the same mark independently and *bonâ fide* for several years, the mark was registered in both names (*f*). And an outgoing partner who was entitled to use the original mark was allowed, under the Act of 1875, to register this mark, although it was identical with the mark on the register used by the successors of the old firm (*g*). See also *Dent v. Turpin* (*h*).

Restrictions on registration.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

(2.) The comptroller shall not register with respect to the same goods or description of goods a trade mark so nearly resembling a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

This section materially differs from the corresponding section of the Act of 1875, under which the registrar was forbidden to register in respect of the same goods or *classes* of goods marks identical with marks on the register, or so nearly resembling as to be calculated to deceive.

“*Already on the register.*” On the question of similarity, the Court has regard only to marks which have been registered, and not to pending applications (*i*).

Subdivision of classes: “three mark” rule.

“*Same goods or description of goods.*” Under the Rules of August 1876 subdivision of classes was allowed (*j*), but the registrar would not register the same mark in respect of more than three descriptions of goods of the same class whether the mark were new or old (*k*); and this was enforced even where the articles on which the mark was to be used, though in the same class, were different in character from the goods for which the mark was already registered (*l*). But subject to this rule a new mark might be registered for some of the goods in a class, though a similar old mark had already been registered for other goods in the same class, provided that the goods and trades were sufficiently distinct for no confusion to take place (*m*), and old marks might be registered up to the number of three by different persons in respect of the same goods, even if identical (*n*).

(*f*) *In re Powell, In re Pratt*, Seb. Dig., p. 357.

(*g*) *Benbow v. Low*, 29 W. R. 837.

(*h*) 2 J. & H. 139.

(*i*) *Re Dugdale's Application*, 49 L. J. (N. S.) Ch. 303.

(*j*) *Ex parte Barrow & Co.*, W. N. 1877, 119; *Re Jelley, Son, & Jones*, 51 L. J. (N. S.) Ch. 639, n.

(*k*) *Re Walkden Aerated Waters Co.*, Seb. Dig., p. 332; *Re Jelley, Son, & Jones*, 51 L. J. (N. S.) Ch. 639, n.

(*l*) *Re Hargreaves*, 11 Ch. D. 669.

(*m*) *Re F. Braby & Co.*, 21 Ch. D. 223; *s.c.* 51 L. J. (N. S.) 637; *Ex parte Barrow & Co.*, W. N. 1877, 119.

(*n*) *Re Jelley, Son, & Jones*, 51 L. J. (N. S.) Ch. 639, n.

Thus, a device of a pointer eating out of a porridge-pot was registered as a new mark for "fencing" in Class 5, and as an old mark for "screw wrenches," &c., in Class 13 (metal goods not included in other classes), though a device of a pointer standing at a pail, with the word "Stanch" under, was on the register as an old mark in Class 5, for "unwrought metals used in manufacture," and in Class 13 generally (*o*).

And the mark "T. H. H." under a crown was held entitled to registration as an old mark for tin plates and turn-plates, though another firm had a mark in the same class, "B. B. H." over a crown, for bar iron (*p*). So also a new mark, consisting of a device of a rising or half sun, was registered for galvanized iron, although there was an old mark on the register of a sun for bar iron in the same class (*q*).

But to entitle an old mark to registration under the "three mark rule," the user must have been in England (*r*).

For the future, identical marks will in no case be registered for the same goods or description of goods unless the Court has first decided that two or more persons are entitled to the mark. There appears, however, to be no reason why identical marks should not, subject to the provisions of sect. 74 (3), *post*, still be registered in respect of different descriptions of goods in the same class, as was provided for by Rule 20 of the Rules of March 1883, under the Act of 1875, and if the descriptions of goods in the same class be sufficiently dissimilar not to be within sect. 74 (3), it would seem that more than three identical marks might be registered in the same class.

(2.)

Where there was on the register as a mark for beer a plain triangle coloured red, registration was refused to a triangle with a double outline inscribing within the name of the brewery, the inner triangle having a conspicuous figure of a church, the ground of decision being that, as the latter might be printed in a red colour, it would, if so printed, be too similar to the other mark, (*s*). So also, where a male hand pointing upwards was on the register as a trade mark, the registration of a female hand pointing horizontally with letters on it was not allowed (*t*).

But the combination of a signature with the words "Filtre Rapide" was registered, although the words "Rapid Water Filter" were already on the register (*u*).

Where A. had registered a coat of arms and a medallion *as part* of his mark, and B. proposed to register the medallion and arms alone,

(*o*) *Re Jelley, Son, & Jones, ubi sup.*

(*p*) *Ex parte Barrow & Co., W. N. 1877, 119.*

(*q*) *Re F. Braby & Co., 21 Ch. D. 224; s.c. 51 L. J. (N. S.) 637.*

(*r*) *In re Münch's Application, W. N. 1883, 170.*

(*s*) *Re Worthington & Co.'s Trade Mark, 14 Ch. D. 8.*

(*t*) *Allsopp v. Walker, Seb. Dig., p. 325.*

(*u*) *Re Maignan, 28 W. R. 759.*

the latter was considered sufficiently distinctive, and was registered, as the simple medallion and arms could not be taken to be the same as A.'s compound mark (*x*).

The question whether the mark is calculated to deceive is purely one of fact. And if the English Court thinks the mark objectionable on this ground, registration will be refused, although a foreign Court of Appeal, differing from the Court of First Instance, has allowed the mark to be registered, the foreign decisions being regarded merely as opposite verdicts of juries (*y*). And this question does not depend merely on evidence, but the Court will look at the marks themselves and form its own opinion (*z*). Thus, where a Sheffield corporate mark for cutlery and metal goods consisted of a plain horn suspended by a looped cord, a mark being a sprig of two roses and a twisted horn was considered too similar, especially when stamped on the metal, to be admitted to registration in the same class (*a*).

Further
restriction on
registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice, or any scandalous design.

See also *post*, sect. 86.

“*By reason of their being calculated to deceive.*” These words have reference to deceptiveness inherent in the mark itself, and not to any question of comparison or similarity between two or more trade marks, and therefore an opposition by oil merchants, owners of a mark being a device containing the word *Valvoline*, to the registration of another different device with the word *Valvoleum*, on the ground that the similarity of the two words was calculated to deceive, was not allowed to prevail (*b*).

If there is false representation in the mark, or if the trade itself was fraudulent, a Court of Equity would not interfere. And it was said by Mellish, L.J., that the same would have been the rule at common law and that the case would come within the maxim, *Ex turpi causâ non oritur actio* (*c*). The first of these cases is that alone which is dealt with in this section. Cases in which the trade itself is fraudulent will be considered under sect. 77.

As to fraudulent representation in the mark itself—

In *Pidding v. How* (*d*) plaintiff was refused relief in respect of

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| (<i>x</i>) <i>Re Farina</i> , 26 W. R. 261. | (<i>a</i>) <i>In re Rosing</i> , Seb. Dig., p. 379. |
| (<i>y</i>) <i>Re Farina</i> , 27 W. R. 457. | (<i>b</i>) <i>Re Horsburgh</i> , Seb. Dig., p. 364. |
| (<i>z</i>) See Judgment of Jessel, M.R.,
<i>Re Jelley, Son, & Jones</i> , 51 L. J. Ch.
(N. S.) 640, n. | (<i>c</i>) <i>Ford v. Foster</i> , L. R. 7 Ch.
611, 630, 631. |
| | (<i>d</i>) 8 Sim. 477. |

certain tea which he sold in packets labelled "Howqua's Mixture," Howqua being a celebrated Chinese merchant, and it being proved that plaintiff's tea was neither made nor sold by Howqua.

And where plaintiff sold an article under the name of "Estcourt's Hop Supplement," which was a substitute for hops, and was intended to deceive the public, he was held not entitled to protection (*e*).

Where the plaintiffs had succeeded to the business of a firm of J. R. and C. P. Crockett, who were manufacturers of leather cloth, but plaintiffs did not themselves carry on business in that name, the insertion on the trade mark of the words "J. R. and C. P. Crockett, Manufacturers," was held to be a misrepresentation disentitling the plaintiffs to relief. So also the insertion in the mark of the words "Tanned, Patented," where the mark was used for goods neither tanned nor patented (*f*).

And where a company claimed to use the words "Anglo-Portugo Oysters" upon a trade mark for oysters, whether the oysters were or were not brought from Portugal and fattened in English waters, as had been the case with the oysters in connection with which the name was first used, registration was refused (*g*).

But the question has most commonly arisen on the use of the word "Patent" or "Patented," or the like, in the trade mark. As to new marks the point will not arise, since the office declines to register such words as part of a mark (*h*). But the words may occur in old marks, which are otherwise entitled to be protected (see pp. 172, 173, *post*). It is therefore desirable to consider how far the use of such words has been held disentitled to protection.

If the article has never been patented, the use of the word "Patent" or "Patented" on the mark was held to disentitle the plaintiff to relief (*i*), unless from the usage of many years the goods have acquired the designation in the trade generally of "Patent" (*k*), or there is some foundation for the use of the word, as that the plaintiff has registered the article as a design (*l*).

But in connection with this subject it must be remembered that henceforth the use of such words where no patent has been granted may render the party using them liable to a penalty (*post*, sect. 105).

But if the article had once been the subject of a patent, and the

(*e*) *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276.

(*f*) *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523.

(*g*) *Re Saunton & Co.*, Seb. Dig., p. 381. See also a case of guano made in England sold as "Peruvian guano," mentioned in the Judgment of Mellish, L.J., in *Ford v. Foster*, L. R. 7 Ch. 631.

(*h*) See pp. 181, 334, *post*.

(*i*) *Flavel v. Harrison*, 10 Ha. 467; *Morgan v. McAdam*, 36 L. J. Ch. 228; *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 352; *Lamplough v. Bulmer*, W. N. 1867, 293; *Nixon v. Roffey*, W. N. 1870, 227.

(*k*) *Marshall v. Ross*, 8 Eq. 651; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523, Judgment of Lord Kingsdown.

(*l*) *Cave v. Myers*, Seb. Dig., p. 181.

word "Patent" was used as descriptive only, relief was not refused (*m*), unless the word was used in the mark in such a manner as to imply that the patent was still subsisting (*n*), and *a fortiori* if the plaintiff's advertisements and circulars stated that he has no patent right, or the word has become merely descriptive of the article made (*o*).

Placing the words "Special Registered Trade Mark" on a label where the mark was not, in fact, registered, though an application had been sent in for registration, was not held to disentitle the plaintiff to an injunction, the object of which was the protection not of the label, but of the name acquired by its use (*p*).

"Or otherwise." Another ground on which words have been held disentitled to protection as trade marks is that they are merely descriptive or mere indications of quality.

Of such are :—

1. *Words originally descriptive only*, as "Paraffin Oil" (*q*), "Nourishing Stout" (*r*).

And the words "Anglo-Portugo Oysters" (*s*), "Porous," as applied to a particular kind of plaster (*t*), have been refused registration as being only descriptive. Descriptive words may, however, be registered as part of a mark (*u*). Thus the words "Valvoline" and "Valvoleum," both being considered descriptive only, were held non-essential parts of two trade marks of which the devices were different, and both marks were registered. In such a case, however, it is the device only, and not the descriptive word, which is protected (*x*). For the proper mode of registering such marks, see the order *Re Clippens Oil Co.'s Application*, Appendix, *post*. But the words "Family Salve" (*y*), "Kitchen Crystal Soap" (*z*), have been registered.

2. *Words originally not merely descriptive, but which have become so by usage*.

Of these there are two classes :—

- (a.) Fancy names originally applied to new articles which are patented, such as "Linoleum" (*a*), "Paraffin Oil" (*b*), "Home Washer" (*c*), "Braided Fixed Stars" (*d*), or of which the

(*m*) *Sykes v. Sykes*, 3 B. & C. 541; *Edelsten v. Vick*, 11 Ha. 78; *Leather Cloth Co. v. Hirschfield*, 1 N. R. 551.

(*n*) *Cheavin v. Walker*, 5 Ch. D. 850; *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523.

(*o*) *Ransome v. Graham*, 47 L. T. 318.

(*p*) *Read v. Richardson*, 45 L. T. 54. See Judgment of Cotton, L.J., p. 59.

(*q*) *Young v. Macrae*, 9 Jur. (N. S.) 322.

(*r*) *Raygett v. Findlater*, L. R. 17 Eq. 29.

(*s*) *Re Saunion & Co.*, Seb. Dig., p. 381.

(*t*) *Re Brandreth*, Seb. Dig. 382.

(*u*) See observations of Malins, V.C., *Re Barrow's Trade Marks*, 5 Ch. D. 358.

(*x*) *Re Horsburgh*, Seb. Dig., p. 364.

(*y*) *Reinhardt v. Spolding*, 49 L. J. Ch. 57.

(*z*) *Eastmann's Trade Mark*, W. N. 1880, 128.

(*a*) *Linoleum Co. v. Nairn*, 7 Ch. D. 834.

(*b*) *Young v. Macrae*, *ubi sup.*

(*c*) *Ralph's Trade Mark*, 32 W. R. 168; *s.c.* 49 L. T. (N. S.) 504.

(*d*) *In re J. B. Palmer's Trade Mark*, 24 Ch. D. 501.

first producer is for some time the sole maker, such as "Macassar" (e), "Golden Ointment" (f), "Chlorodyne" (g), "Angostura Bitters" (h), "Valvoline" (i).

(b.) Words connected with the name of the original maker or discoverer, such as "Velno's Vegetable Syrup" (j), "Dr. Johnson's Yellow Ointment" (k), "Tayler's Patent Solid-headed Pins" (l), "Burgess' Essence of Anchovies" (m), "Lieutenant James' Horse Blister" (n), "Liebig's Extract of Meat" (o), "Condy's Fluid" (p), "Wheeler and Wilson" (q), or "Singer System" (r), as applied to sewing-machines.

In all these cases, where the patent has expired (s), or the secret has become known (t), or the manufacture has from any cause become general (u), the right, originally exclusive, may be lost. The test whether the name has become *publici juris* is that the use of it by other persons has ceased to deceive the public as to the maker of the article (v).

There are also other words which, as being too general, are held incapable of appropriation, such as "Colonial" (x) or "London and Provincial" (y), or "London Assurance" (z), as applied to an insurance company, "India and China" as applied to a tea company (a), "Merchants'" as the name of a bank (b), "Chronicle" as the name of a newspaper (c), "Post Office" as applied to a directory (d).

It will be remembered that the present Act gives a rule for ascertaining, at least for the purpose of registration, whether a trade mark has become non-exclusive, *post*, sect. 74, sub-sect. (3). And by that

(e) *Rowland v. Breidenbach*, Seb. Dig., p. 230.

(f) *Green v. Rooke*, W. N. 1872, 49.

(g) *Browne v. Freeman*, W. N. 1873, 178.

(h) *Siegert v. Findlater*, 7 Ch. D. 801.

(i) *Leonard v. Wells*, W. N. 1884, 5.

(j) *Canham v. Jones*, 2 V. & B. 218.

(k) *Singleton v. Bolton*, 3 Doug. 293.

(l) *Edelsten v. Vick*, 11 Ha. 78.

(m) *Burgess v. Burgess*, 3 D. M. G. 896.

(n) *James v. James*, L. R. 13 Eq. 421.

(o) *Liebig's Extract of Meat Co. v. Hamburg*, 17 L. T. (N. S.) 298; *Same v. Anderson*, L. J., No. Ca. 1882, 119.

(p) *Condy v. Mitchell*, 37 L. T. (N. S.) 268, 766; 26 W. R. 269.

(q) *Wheeler and Wilson Manufacturing Co. v. Shakespear*, 89 L. J. (N. S.) Ch. 36. See also *Singer Manufacturing Co. v. Wilson*, 3 App. Cas. 376.

(r) *Singer Manufacturing Co. v. Loog*, 8 App. Cas. 15, 26.

(s) *Linoleum Co. v. Nairn*, 7 Ch. D. 835; *In re J. B. Palmer's Trade Mark*, 24 Ch. D. 504; *Ralph's Trade Mark*, 32 W. R. 168; s.c. 49 L. T. (N. S.) 504.

(t) *James v. James*, L. R. 13 Eq. 421.

(u) *Canham v. Jones*, 2 V. & B. 221.

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

(x) *Colonial Life Assurance Co. v. Home and Colonial Assurance Co.*, 33 Bea. 548.

(y) *London and Provincial Law Assurance Society v. London and Provincial Joint Stock, &c., Co.*, 17 L. J. Ch. 37.

(z) *London Assurance v. London and Westminster Assurance Corporation (Limited)*, 32 L. J. Ch. 664.

(a) *India and China Tea Co. v. Teede*, W. N. 1871, 241.

(b) *Merchants' Banking Co. of London v. Merchants' Joint Stock Bank*, 9 Ch. D. 560.

(c) *Cowen v. Hutton*, 46 L. T. (N. S.) 897.

(d) *Kelly v. Byles*, 13 Ch. D. 683.

section marks common to the trade may, in certain cases, be registered as additions to trade marks.

The Courts would also refuse protection to a so-called trade mark, which was, in fact, a mere advertisement of the character and quality of the goods (*e*), or a mere description of an article as made according to a particular patent (*f*).

Saving for power to provide for entry on register of common marks as additions to trade marks.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(*a.*) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(*b.*) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

(2.) The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

This section appears to relate only to marks not already registered. With regard to marks already registered, see *post*, p. 186, and sect. 92, p. 189.

(*e*) *Leather Cloth Co. v. American Leather Cloth Co.*, 11 H. L. 523.

(*f*) *Cheavin v. Walker*, L. R. 5 Ch. D. 850.

(3.)

This was the rule adopted under the Act of 1875 (*g*). See also *post*, sect. 90.

Effect of Registration.

75. Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark. Registration equivalent to public use.

A re-enactment of the last clause of sect. 2 of the Act of 1875. "This is for the benefit of those making new trade marks. As the law at present stands, if the mark be not already in use, and is sufficiently distinctive to distinguish the goods to which it is applied as being those of the person using it, the public use of that mark gives a property in it" (*h*).

As to what "public use" is sufficient for this purpose, see "Sebastian on Trade Marks," pp. 49, 50, 215.

76. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act. Right of first proprietor to exclusive use of trade mark.

Under the corresponding section of the Act of 1875 (*i*), it was held that a mark which is not a trade mark, and which therefore ought not to be registered, does not acquire the character of a trade mark by being on the register for five years, and may be removed from the register (*k*), and it would seem, though the point has not been decided, that a person sued for using a name which has been on the register for five years may defend himself on the ground that it is not a trade mark (*l*).

77. A person shall not be entitled to institute any proceeding 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 Restrictions on actions for infringement, and on defence to action in certain cases.

(*g*) *Re Jelley, Son, & Jones*, 51 L. J., Ch. (N. S.) 640, n.

(*h*) *Per Lord Blackburn, Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 496.

(*i*) Sect. 3.

(*k*) *Re Palmer's Application*, 21 Ch. D. 48.

(*l*) "Sebastian on Trade Marks," p. 33; "Bryce on the Trade Marks Registration Acts, 1875 and 1876," p. 3, commented on by Jessel, M.R., in *Re Palmer's Application*, *ubi sup*.

repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request (a), and on payment of the prescribed fee, grant a certificate that such registration has been refused.

(a) See Trade Marks Rules, 1883, *post*, Form L.

This section differs considerably from the corresponding sections of the Acts of 1875 and 1876 (m). By those sections registration was required as a preliminary to suing only in cases of trade marks *as defined by the Act*, and as to *any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act* (n), it was sufficient to obtain a certificate that registration had been refused. The result of these sections was that if the proprietor of a trade mark in use before the passing of the principal Act had been refused registration, he might, notwithstanding such refusal, institute proceedings either for prevention of, or damages for, the infringement of such trade mark, and need not wait till he had got the register rectified (o).

In the present section registration as a preliminary to suing is required in all cases of trade marks *capable of being registered under this Act*, while a certificate of refusal of registration is sufficient only in cases of "*any OTHER trade mark in use before the 13th August, 1875.*"

If the words, "trade mark capable of being registered," are to be read as meaning the same thing as "defined by the Act," that is to say, trade marks consisting of or containing the essential particulars mentioned in sect. 64 (1) (a), (b), (c), with or without the additions referred to in subsect. (2), then the law as to suing has not been altered, but if (which it is submitted is the proper construction) they are to be taken to mean trade marks which can be put on the register, then they will include not merely all marks, whether new or old, within sect. 64 (1) and (2), but also all old marks which, under the authority given by sect. 64 (3), are allowed to be registered, and a certificate of refusal of registration will be sufficient only in the case of actions brought for infringement of *other trade marks in use, &c.*, that is, old marks which, though in use as trade marks before the 13th August, 1875, are not permitted to be registered, such, for instance, as the single letter in the case of *Re Mitchell's Trade Mark* (p) under the Act of 1875.

As to marks in this position, the owner, on obtaining a certificate that

(m) 38 & 39 Vict. c. 91, s. 1; 39 & 40 Vict. c. 33, s. 1.

(n) 13 Aug., 1875.

(o) *Per* Lord Blackburn, *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 498.

(p) 7 Ch. D. 36.

the registration has been refused, is in the same situation for suing for the protection of his trade mark as if the Act had not passed (*q*).

But there are two other cases to which the section does not appear to apply, viz. :—

- (*a*.) New trade marks within the definition of sect. 64, sub-sect. (3), not capable of registration as new marks, but which, if old, could have been registered under that sub-section.
- (*β*.) Names, whether new or old, which are “so appropriated by user as to come to mean the goods of a particular person, though ‘the name’ is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark properly so called, or within” the Trade Marks Registration Acts (*r*).

The principles on which the Court acts in preventing a man from passing off his goods as those of another have not been altered by the Trade Marks Registration Act (*s*), and therefore relief may still be had in classes (*a*) and (*β*) mentioned above, in cases where relief would have been given before the Acts. The principles referred to are thus laid down by Lord Kingsdown (*t*): “The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot therefore (in the language of Lord Langdale in *Perry v. Truefitt* (*u*)), ‘be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.’” And again, in *The Singer Manufacturing Co. v. Loog* (*x*), Lord Blackburn said: “The original foundation of the whole law is this, that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader’s; but it is established alike at law, *Blofeld v. Payne* (*y*), and in equity, *Edelsten v. Edelsten* (*z*), that it is an actionable injury to pass off goods known not to be the plaintiff’s as and for the plaintiff’s, even though not inferior.”

Upon these principles it was held that a question of alleged infringement of a trade mark registered as a white selvage could not be decided without considering whether the alleged infringement (which, in fact, was dark grey) was not according to the custom of the trade a white selvage, and if it was, then whether the differences in quality and position of the threads in the defendant’s selvage were sufficient to dis-

(*q*) *Per* Malins, V.C., *Re Barrow’s Trade Marks*, 5 Ch. D. 359.

(*r*) See *Singer Manufacturing Co. v. Loog*, Judgment of Lord Blackburn, 8 App. Cas. 32.

(*s*) *Mitchell v. Henry*, 15 Ch. D. 181.

(*t*) *Leather Cloth Co. (Limited) v.*

American Leather Cloth Co., 11 H. L. C. 538, cited with approval by Lord Blackburn, *Johnston v. Orr Ewing*, 7 App. Cas. 228.

(*u*) 6 Bea. 66, 73.

(*x*) 8 App. Cas. 15, 29.

(*y*) 4 B. & Ad. 410.

(*z*) 1 D. J. S. 185.

tinguish the defendant's goods from those of the plaintiff so as to prevent purchasers from being misled (a).

Notwithstanding the registration of a trade mark, the Court may, it is presumed, still act on the principles laid down before the passing of the Registration Acts, and refuse to extend its protection "to persons whose case is not founded in truth" (b).

Cases of false representation in the trade mark itself have been already dealt with under sect. 73. But the trade itself may be fraudulent, and in such a case the Court of Equity has been accustomed not to interfere (c).

Thus, in *Pidding v. How*, cited above, the plaintiff, a tea-dealer, who sold under the name of "Howqua's Mixture" a mixed tea composed of different kinds of teas, sought to restrain the defendant from selling teas under the same name and in packages with labels resembling the plaintiff's. The plaintiff, however, had stated in his labels and advertisements that the mixture was made by one *Howqua*, a celebrated Canton merchant, and was purchased from him and imported into this country in the packages in which it was sold, and that the tea which gave it its peculiar flavour was rare in China, and could not be procured in England. All these statements were proved to be untrue, and on that ground Vice-Chancellor Shadwell, although satisfied that the defendant's proceedings were improper, refused to interfere by injunction until the plaintiff had established his right at law.

So also in the case of *Perry v. Truefitt* (d), the plaintiff, a maker of a preparation which he called "Medicated Mexican Balm," sought to restrain the sale by a rival trader of a different preparation under the same name. The plaintiff's advertisement, however, having stated his preparation to have been "made from an original recipe of the learned J. F. Blumenbach, and recently presented to the proprietor by a very near relative of that illustrious physiologist," whereas, in fact, he had purchased the preparation from one Leathart; an injunction was refused, but the motion was ordered to stand to the hearing, with liberty for the plaintiff to bring an action at law (e).

But a merely collateral misrepresentation by the owner of the trade mark, as, for instance, a statement in invoices and a few advertisements that he was a patentee when he was not (f), or a statement, contrary to the fact, that he was a professor (g), was insufficient to disentitle the plaintiff to relief, either at law or in equity.

(a) *Mitchell v. Henry*, 15 Ch. D. 181.

(b) *Pidding v. How*, 8 Sim. 480.

(c) Nor apparently could the plaintiff have succeeded at law. See Judgment of Mellish, L.J., *Ford v. Foster*, L. R. 7 Ch. 630.

(d) 6 Bea. 66.

(e) See also *Estcourt v. The Estcourt Hop Essence Co.*, L. R. 10 Ch. 276.

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

(g) *Holloway v. Holioway*, 13 Bea. 209.

The questions arising on the use of the word "patent" have been already considered under sect. 73.

The last part of the marginal heading to the section is an error.

If a trade mark consist of a device in combination with a word which, being merely descriptive, could not by itself be registered, the mark will only be infringed if the device itself is encroached upon (*h*).

Register of Trade Marks.

78. There shall be kept at the Patent Office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed (*a*). Register of trade marks.

(*a*) See Trade Marks Rules, 1883, rr. 30-48.

See sect. 81 as to the "Sheffield Register" for the registration of cutlery marks in applications by applicants in Hallamshire, or within 6 miles thereof. See also sect. 87.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect. Removal of trade mark after fourteen years unless fee paid.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade mark from the register accept the said fee

(*h*) *Re Horsburgh*, Seb. Dig., p. 364.

as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade mark which is already registered (a).

(a) Trade Marks Rules, 1883, r. 48.

Substantially a re-enactment of Rules 29 to 32 of the Trade Marks Rules of March 1883.

Fees.

Fees for registration, &c.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct (a).

(a) Trade Marks Rules, 1883, First Schedule, *post*.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that Company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

- (2.) The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875.
- (3.) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (a):
- (4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:
- (5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court.
- (6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if

the application had been made to the comptroller on that day :

- (7.) The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register (β) ; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :
- (8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :
- (9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :
- (10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :
- (11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks :
- (12.) Any person aggrieved by a decision of the Cutlers'

Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm reverse or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court (γ):

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.

(α) Trade Marks Rules, 1883, rr. 53-56.

(β) *Ibid.* r. 56.

(γ) *Ibid.* Form W.

These provisions differ considerably from the corresponding provisions in the Act of 1875.

A list and short abstract of the Cutlers' Companies Acts is given in "Sebastian on Trade Marks," Appendix D.

When the Cutlers' Company opposed the registration of a trade mark for cutlery for three classes of goods on the ground that it so nearly resembled a Sheffield corporate mark previously assigned to another manufacturer of cutlery, and still used by him, as to be calculated to deceive, and in the Court of Appeal succeeded as to two of the classes, but abandoned their opposition as to the third class, it was held that applicant must pay the costs of the appeal, but that no costs of the motion in the Court below could be given (*i*).

(7.)

As to the assignment of a corporate trade mark granted by the Cutlers' Company, see *Bury v. Bedford* (*k*).

PART V.

GENERAL.

Patent Office and Proceedings thereat.

82. (1.) The Treasury may provide for the purposes of this Patent Office. Act an office with all requisite buildings and conveniences,

(*i*) *Re Rising*, Seb. Dig., p. 379.

also *In re Rabone Brothers*, Seb. Dig.,

(*k*) 4 De G. J. & S. 352. See p. 395.

which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

See *ante*, sect. 12 (2).

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

The Patent Office has hitherto registered deeds of trust relating to patents (*l*). As regards trade marks, this section is an enactment of Rule 22 of the Rules of August 1876, re-enacted in Rule 23 of the Rules of March 1883.

(*l*) Johnson's "Patentees' Manual," 4th ed., p. 221.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Refusal to grant patent, &c., in certain cases.

The comptroller will also decline to register as part of any trade mark the Royal arms, or arms so nearly resembling them as to be calculated to deceive, or the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery," "Patent," "Patented," or, except as old marks or parts of old marks, representations of the Queen or Royal Family, or of the Crown or national arms or flags, or prize or exhibition medals (*m*).

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be (*a*). The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Entry of assignments and transmissions in registers.

(*a*) See Patents Rules, 1883, rr. 65-70; Designs Rules, rr. 22-28; Trade Marks Rules, 1883, rr. 34-39; *post*.

PATENTS.

"*Assignments.*" See sect. 36. The right of assignment depends on the words of the patent itself (*n*), and in the form in the First Schedule (*post*, p. 203) the grant is to the "patentee," which word, by a previous recital, is made to include his assigns.

A patentee may assign a distinct and separate part (*o*), or an undivided share (*p*) of a patent, and the assignee, whether of the entirety, or of a part or share, takes the legal interest, and is not to be considered merely as a licensee (*q*).

(*m*) See p. 334, *post*.

(*n*) "Hindmarch on Patents," p. 234.

(*o*) *Dumcliff v. Mallet*, 7 C. B. (N. S.) 209.

(*p*) *Walton v. Lavater*, 8 C. B.

(N. S.) 162.

(*q*) *Per Erle, C.J., Walton v Lavater*, *Ibid.* p. 184.

An agreement by a vendor of a patent to assign to a purchaser all future patent rights which the vendor may hereafter acquire of a like nature to the patent sold is not void as against public policy (*r*).

The law as to the rights of co-owners of a patent is thus laid down by Lindley, L.J. (*s*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement, and can also work the patent himself and give licences (*t*) to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences."

Where two persons entered into a partnership for working a patent belonging to one, it was held by Bacon, V.C., that the patent was an asset of the partnership, and that neither partner could assign it without the other, but that both had a licence to work the invention, and when they separated each could work it on his own account (*u*).

By the Act of 1852 (*x*) a "register of proprietors" was required to be kept at the Great Seal Patent Office, in which an entry of all assignment of letters patent, or of any interest or share, is to be made, and all licences, &c., and it was provided that until such entry should have been made, the grantee of the letters patent should be deemed the sole proprietor thereof.

Under this section it was held, in *Chollet v. Hoffman* (*y*) that an assignee could not sue until his assignment had been registered, otherwise, as the Statute provides that before such registry the original patentee shall be deemed the sole owner, a defendant would be liable to be sued at one and the same time by the grantee and assignee of the letters patent. The reasoning in this case appears equally to apply to the present section, and it would seem that under this present Act, as under the Act of 1852, registration of the assignment is necessary to enable an assignee to maintain an action for infringement.

The case of *Chollet v. Hoffman* was, however, a case of litigation between the assignee of a patent and third parties. As between the assignor and assignee the rule was held not to apply, and an assignee might maintain a suit against the assignor and licensees from the assignor subsequent to and with notice of the assignment, although the assignment has not been registered (*z*).

It was not decided whether and how far the registration of an assignment related back. In *Chollet v. Hoffman* the Court expressly

(*r*) *Printing and Numerical Registering Co. v. Sampson*, L. R. 19 Eq. 462. See also *Leather Cloth Co. v. Lonsont*, L. R. 9 Eq. 345.

(*s*) "Lindley on Partnership," 4th ed., pp. 68, 69, citing *Dunnicliff v. Mallet*, 7 C. B. (N. S.) 209; *Walton v. Lavater*, 8 C. B. (N. S.) 162; *Mathers v. Green*, L. R. 1 Ch. 29. See also *Hancock v. Bewley*, Johns. 601.

(*t*) See, however, *Powell v. Head*, 12 Ch. D. 686, 690; and see p. 184, *post*.

(*u*) *Kenny's Patent Button-Making Co. v. Somervill*, 26 W. R. 787.

(*x*) 15 & 16 Vict. c. 83, s. 35.

(*y*) 7 E. & B. 636.

(*z*) *Hassall v. Wright*, L. R. 10 Eq. 510.

refused to decide the point, but in *Hassall v. Wright* it seems to have been the opinion of Sir Richard Malins, V.C., though it was not necessary actually to decide the point, that registration under the Act of 1852 related back to the date of the assignment, and that an assignee whose assignment was registered might maintain a suit to restrain infringement instituted after the date of the assignment and before registration.

An assignment by executors of a patentee made after probate but before the probate was registered, the assignment itself being registered after the registration of the probate, gave under the Act of 1852 a valid title to the assignee to sue (a).

Upon the bankruptcy of a patentee letters patent which have been granted to him will vest in the trustee (b), and he may therefore maintain a suit to restrain infringement committed before the bankruptcy, but it is presumed that the title of the trustee must be registered.

Letters patent granted to any person vest on his death in his executor or administrator (c), who may sue in respect of an infringement committed during the life of the patentee (d), the probate of the will being previously registered in the Great Seal Patent Office. See also sect. 34.

The register will apparently be conclusive as between persons interested in the patent and third parties, who, it would seem, may safely, in the absence of notice of other claims, deal with the persons appearing on the register.

DESIGNS.

Under the Act of 1843 it was held that a partial assignment of or a licence to use a design must be in writing, and could only be made by a registered proprietor (e). See now notes under Designs Rules, 1883, *post*, r. 22.

A design devolves on the executor of the proprietor (f).

In *Powell v. Heud* (g) it was held by Jessel, M.R., that one part owner of the copyright of a dramatic entertainment could not grant a licence for its representation without the consent of all the other owners. This decision was grounded on the provision of the 3 & 4 Wm. 4, c. 15, forbidding representation except with the consent of the "author or other proprietor," which words, by the effect of sect. 4 of the same Statute, meant "authors or other proprietors." On similar grounds it would seem that since sect. 58 of the present Act requires the consent of the registered proprietor to the use of a registered design, and by 13 & 14 Vict. c. 21, s. 4, words in an Act of Parliament importing

(a) *Ellwood v. Christy*, 17 C. B. (N. S.) 754; 10 Jur. (N. S.) 1079.

(b) *Hesse v. Stevenson*, 3 Bos. & P. 565; *Bloxam v. Elsee*, 6 B. & C. 169; s.c. 9 Dowl. & R. 215.

(c) "Williams on Executors," 8th ed., vol. i, p. 824. See also Form D, *post*, p. 203.

(d) "Hindmarch on Patents," p. 252.

(e) *Jewitt v. Eckhardt*, 8 Ch. D. 404.

(f) *Jewitt v. Eckhardt*, *ubi sup.*, p. 409, and see s. 61.

(g) 12 Ch. D. 686.

the singular include the plural, the consent of all the registered proprietors is necessary, and that one of several registered co-owners cannot alone grant a licence for the use of a design.

Similar reasoning seems to show that whatever may have been the law hitherto, a valid licence for the use of an invention comprised in a joint patent can only be made with the concurrence of all the grantees whose names appear on the Register of Patents.

TRADE MARKS.

As to assignment of trade marks, see sect. 70.

Where two persons who carried on distinct trades at different places of business had derived from a common predecessor in the respective businesses the right to use one and the same particular name as a trade mark, each was held entitled separately to sue to restrain infringement (*h*).

Inspection of
and extracts
from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (*a*).

(*a*) Patents Rules, 1883, r. 75; Marks Rules, 1883, r. 49; *post*.
Designs Rules, 1883, r. 33; Trade

This section must be read (so far as it relates to the register of designs) as subject to the provisions of sects. 52 and 53.

Sealed copies
to be received
in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents specifications disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

A re-enactment, with alterations, of 16 & 17 Vict. c. 115, s. 4. By that Act the sealed copies were receivable in evidence in all proceedings relating to letters patent for inventions. The present section is general, and applies to all proceedings.

Rectification
of registers
by Court.

90. (1.) The Court may (*a*) on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such

(*h*) *Dent v. Turpin*, 2 J. & H. 139.

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.

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

(a) Trade Marks Rules, 1883, *post*, any order made under this section, rr. 44-48. The comptroller may r. 47. publish, at the expense of the applicant,

This section combines the provisions of the Act of 1852, sect. 38, and the Act of 1875, sect. 5, and makes these provisions applicable to all the subjects of this Act. "Making" an entry is an addition to the old powers as to patents.

In a trade mark case it was held under the Act of 1875 that the powers of rectification of the register are only exerciseable in cases of mistake or error in the registration, and not where there is a mere devolution of interest (*i*). In such a case the proceeding should be under sect. 87, *ante*.

(1.)

PATENTS.

(See Patents Rules, 1883, *post*, r. 71.)

Under the corresponding section of the Act of 1852 (*j*), by which the jurisdiction was given to the Master of the Rolls alone, it was held that any entry fraudulently made on the register could be expunged, and that any facts relating to the proprietorship could be entered, but not the legal inferences from those facts (*k*).

Thus, where a patentee, having assigned his patent to persons who omitted to register the assignment, afterwards assigned the patent to his father, which assignment was registered at once, the Master of the Rolls ordered the entry of the latter assignment to be expunged (*l*). In this case it appears from the subsequent case of *Re Morey's Patent* (*m*) that there was evidence that the second assignment was clearly fraudulent.

And so also an entry made by one of two joint patentees of a deed whereby he assigned his share of the patent, and purported to release

(*i*) *Re Ward, Sturt, and Sharp's Trade Marks*, 29 W. R. 395.

(*j*) Sect. 38.

(*k*) *Re Morey's Patent*, 25 Bea. 581.

(*l*) *Re Green's Patent*, 24 Bea. 145.

(*m*) 25 Bea. 584.

his assignee from all claims by himself and his co-patentee, was expunged at the instance of the latter (*n*).

But where a patentee assigned half his patent to A., and afterwards assigned the whole to B. by a deed reciting that he had already granted a licence to A., and B.'s assignment was first registered, Lord Romilly, M.R., although holding that B. had on the face of the deed notice of A.'s right, would not (there being no other evidence of notice) enter a statement to that effect on the register, but ordered an entry to be made that the licence referred to in the assignment to B. was the deed of assignment to A. (*o*).

And where a deed is perfectly good and *bonâ fide*, it would seem that no entry could be made on the register qualifying its effect or giving it a construction (*p*).

In *Re Horsley and Knighton's Patent*, cited above, it was contended that the entry ought not to be expunged, as so far as the entry stated the deed to be an assignment it was correct. But Lord Romilly, M.R., held that, as he could not alter the deed, the only course was to strike out the whole entry.

In *Re Berdan's Patent* (*q*) it was held that the Master of the Rolls, as Keeper of the Records, had power to order a disclaimer which had been filed without the consent of the patentee to be taken off the file. This jurisdiction would seem to be strictly within the present section, "amendments" being entered in the register of patents (see sect. 23).

Orders made by the Master of the Rolls under the Act of 1852, sect. 38, were not, prior to the Judicature Acts, subject to Appeal (*r*), but by those Acts the jurisdiction was transferred to the High Court of Justice, and could be appealed like any order of the Court (*s*).

TRADE MARKS.

If a mark which is common to the trade, or which contains words or devices common to the trade, has got on the register, it may, on the application of other persons in the same trade, be removed (*t*), or a note may be added that a particular word (*u*), or particular words and devices (*x*) in the mark is common to the trade, or that a particular device in the mark is not claimed *per se*, but only in combination (*y*). This, however, will not be done in the absence of the registered owner without his consent (*z*). And see now sect. 74 (*ante*, p. 170).

Although an application to register a mark has been duly advertised,

(*n*) *Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*o*) *Re Morey's Patent*, 25 Bea. 581.

(*p*) *Per* Lord Romilly, M.R., *Re Morey's Patent*, 25 Bea. 584.

(*q*) L. R. 20 Eq. 347.

(*r*) *Re Horsley and Knighton's Patent*, L. R. 4 Ch. 784.

(*s*) *Re Morgan's Patent*, 24 W. R. 245; *Re Myers' Patent*, W. N. 1882 53, 56.

(*t*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 724; *In re Palmer's Trade Mark*, 24 Ch. D. 504; *Leonard v. Wells*, W. N. 1884. 5.

(*u*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

(*x*) *Re Leonardt*, Seb. Dig. p. 373.

(*y*) *Re Kuhn & Co.*, Seb. Dig. p. 390.

(*z*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

a person who has not seen the advertisement, and who desires to rectify the register in respect of that mark, is not prejudiced by delay if he come to the Court with due diligence after the fact has come to his knowledge (a), but the delay must be accounted for (b).

Where a person has registered in his own name the trade mark of another person without the knowledge or consent of the true proprietor, the register of trade marks cannot be rectified by transferring the registration into the name of the true proprietor. The false entry will be expunged, and the true owner must apply in the usual way to register the mark (c).

Where a trade mark belonging to a firm has, on an application by one of the partners described as trading under the firm's name, been registered in the name of that partner, the register may be rectified by cancelling the name of that partner as registered proprietor, and inserting the names of all the partners trading under the firm's name (d). But this could not be done where the registration had been applied for and obtained through a mistake of the firm in the sole name of one of the partners, without any mention of the firm's right to the mark. In such a case the proper course was, under the old practice, for the registered partner to assign the trade mark to the firm (e).

Under the corresponding section of the Act of 1875 (f) it was held that the application should be by motion, of which two clear days' notice should be given, and that an affidavit of the applicant verifying his case would be all the evidence that was required (g).

Any dealer who has used a particular word in connection with or as "Person descriptive of the article in which he deals is a "person aggrieved" by aggrieved." the entry of such a word on the register (h). But a foreigner not using or intending to use the mark in this country is not such a person (i).

COSTS.

Patents.—In *Re Green's Patent* (ante, p. 185) the original assignor and the second assignee, and in *Re Horsley and Knighton's Patent* the persons who put the wrong entry on the registry, were ordered to pay the costs of rectifying the register, but in *Re Morey's Patent* the order was made without costs.

Trade Marks.—Where a trade mark which had, in fact, been common to the trade, and had been registered as an old mark by a firm of traders, and it was shown that they had known of the user by other firms for above six years before registration, they were ordered to

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| (a) <i>Re Hyde & Co.'s Trade Mark</i> ,
7 Ch. D. 726. | (e) <i>Re Farina's Trade Mark</i> , 29
W. R. 391. |
| (b) <i>Ransome v. Graham</i> , 51 L. J.
(N. S.) Ch. 903. | (f) 38 & 39 Vict. c. 91, s. 5. |
| (c) <i>Ex parte Lawrence Brothers</i> ,
29 W. R. 392. | (g) <i>Ex parte Stephens</i> , W. N.
1876, 202. |
| (d) <i>Re Rust & Co.'s Trade Mark</i> ,
29 W. R. 393. | (h) <i>Rose v. Evans</i> , 48 L. J. Ch. 618;
<i>In re Ralph's Trade Mark</i> , 32 W. R.
168, 49 L. T. (N. S.) 504. |
| (i) <i>Re Riviere's Trade Mark</i> , 49 L. T. (N. S.) 507. | |

pay the costs of a successful application for its removal from the register (*j*), and it was held that it was no objection to the allowance of the costs that the applicants, who had not seen the advertisements in the "Trade Marks Journal," had not opposed the registration (*k*), nor in a similar case that the applicants had not informed the person on the register of their intention to take action (*l*).

But if a mark has actually become common by being copied without the owner's permission, and is then registered by the original owner, it may be that the costs of an application to remove it will not be given (*m*).

Where on an opposition to registration of a trade mark in different classes the applicant succeeds as to some and fails as to others, no costs are given on either side (*n*). But an unsuccessful opponent must pay the costs, even though the opposition is by a public body in the public interest (*o*). And an application to rectify the register which fails will be dismissed with costs, including the costs of the registrar (*p*).

Under the Trade Marks Act, 1875, it was held that an applicant who, on the registrar objecting to register a particular mark, succeeded against the registrar on the matter being referred to the Court, must nevertheless pay the registrar's costs, there being no fund out of which the registrar could be paid (*q*).

And this was the case where the registrar appeared and did not oppose (*r*). But the costs thus to be paid were confined to the costs of proceedings in Court, and the applicant could not be ordered to pay the costs in the registrar's office (*s*). This distinction proceeded on the words of the Judicature Rules, 1875, Order LV, which provided that the costs of proceedings in the High Court should be in the discretion of the Court. The present section, it will be observed, is very wide, and gives the Court full jurisdiction over all the costs of the proceedings.

(2.)

See *Re Salamon* (*t*), where an action was directed.

The provision as to damages is new.

Power for
comptroller to
correct clerical
errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee,—

(*a.*) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark (*a*); or

(*b.*) Correct any clerical error in the name style or address

(*j*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 725. See also *Re Kuhn & Co.*, Seb. Dig. p. 390.

(*k*) *Re Hyde & Co.'s Trade Mark*, *ubi sup.*

(*l*) *Re Kuhn & Co.*, Seb. Dig., p. 390.

(*m*) *Re Kuhn & Co.*, *ubi sup.*

(*n*) *Re Jelley, Son, and Jones*, 31 L. J. (N. S.) Ch. 639; Seb. Dig., p. 377; *Re Rosing*, Seb. Dig., p. 379.

(*o*) *Re Rosing*, *ubi sup.*

(*p*) *Re Riviere's Trade Mark*, W. N. 1883, 212.

(*q*) *Re Maignan*, 28 W. R. 759; *Rotherham's Trade Mark*, 14 Ch. D. 585.

(*r*) *Re Orr Ewing*, W. N. 1880, 24.

(*s*) *Re Brandreth's Trade Mark*, 9 Ch. D. 619; *Re Hargreaves*, 11 Ch. D. 675.

(*t*) Seb. Dig., p. 340.

of the registered proprietor of a patent, design, or trade mark (β).

(c.) Cancel the entry or part of the entry of a trade mark on the register (γ): 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.

(α) (β) Patents Rules, 1883, *post*, Form P; Designs Rules, 1883, *post*, Form M; Trade Marks Rules, 1883, *post*, r. 46 and Forms M and Q, In the case of designs and trade marks the Rules include amendment of drawings. (γ) Trade Marks Rules, 1883, *post*, Forms O and P.

(a.) All documents for the amending which no special provision is made by the Act may be amended if and on such terms as the comptroller may think fit (Patents Rules, 1883, r. 18). This will include clerical errors in a specification, and apparently, whether provisional or complete (*Ibid.* Form P). See also Designs Rules, 1883, r. 30; Trade Marks Rules, 1883, r. 51.

(c.) If more than mere cancellation is required, the application must be made to the Court under sect. 92.

Under the old Act a mark might be struck out of the register on the application of the registered proprietor (*u*).

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. Alteration of registered mark.

(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 (*a*).

(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 of leave.

(*a*) Trade Marks Rules, r. 48, Form N.

Substantially a re-enactment of Rules 34 and 35 of the Rules of March 1883.

Certain additions to the mark may be made by the comptroller under sect. 74, *ante*. But as to cases not within that section, and also, it would seem, where the comptroller refuses to make the addition asked, the applicant may proceed under this present section.

(*u*) *Ex parte Sales, Pollard, & Co.*, Seb. Dig., p. 378.

Under the Act of 1875 leave was given on the application of the registered proprietor to alter the mark by substituting in it a new for an existing word, denoting the address of the proprietor (*v*), and to rectify the register by limiting the registration to particular goods (*x*).

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

A re-enactment in substance of sect. 37 of the Act of 1852.

That section, however, only related to patents, but the present section applies to every register kept under this Act.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (*a*).

(*a*) See Patents Rules, 1883, rr. 13-15; Trade Marks Rules, 1883, rr. 11-13; Designs Rules, 1883, rr. 17-19, *post*.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate (*a*) purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

(*a*) Patents Rules, 1883, *post*, Second Schedule, Form Q; Designs Rules, 1883, *post*, r. 34, Form J; Trade Marks Rules, 1883, *post*, r. 57, Form U.

A re-enactment of sect. 8 of the Act of 1875, making its provisions generally applicable to this Act.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorized or required to be left made or given at the

(*v*) *Ex parte Walker & Co.*, Seb. Dig., p. 381. (*x*) *Re Lysaght*, Seb. Dig., p. 381.

Patent Office or to the comptroller, or to any other person under this Act (a), may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

(a) Or under the Rules, see Patents Rules, 1883, *post*, r. 12; Trade Marks Rules, 1883, *post*, r. 19; Designs Rules, 1883, r. 16.

Where a witness produced a copy of a letter which he said was made by him, and swore that he should, in the ordinary course of business, have posted the original, it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence (y).

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively. Provision as to days for leaving documents at office.

99. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circum- Declaration by infant, lunatic, &c.

(y) *Trotter v. Maclean*, 13 Ch. D. 574.

stances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Taken from Rule 67 of the Trade Mark Rules of March 1883.

Transmission
of certified
printed copies
of specifica-
tions, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of, or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

A re-enactment, with modifications, of 16 & 17 Vict. c. 115, s. 5.

Power for
Board of
Trade to make
general rules
for classifying
goods and
regulating
business of
Patent Office.

101. (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

- (a.) For regulating the practice of registration under this Act (a):
- (b.) For classifying goods for the purposes of designs and trade marks:
- (c.) For making or requiring duplicates of specifications, amendments, drawings, and other documents:
- (d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents:
- (e.) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other documents in the Patent

Office; and providing for the inspection of indexes and abridgments and other documents :

- (*f.*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :
- (*g.*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid (β).

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

(α) Patents Rules, 1883, Designs Rules, 1883, and Trade Marks Rules, 1883, *post*.

(β) This has been done as to certain Forms in the Schedule to the Act. See the various Rules, *post*.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under

Annual
Reports of
comptroller.

or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

International
arrangements
for protection
of inventions,
designs, and
trade marks.

103. (1.) If Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such State, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign State.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign State with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under

this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

(4.) The provisions of this section shall apply only in the case of those foreign States with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Provision for colonies and India.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or 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 five pounds.

Penalty on falsely representing articles to be patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has

been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

This section is based on sect. 7 of the Act of 1835 (z) as to patents, and sect. 11 of the Act of 1843 as to designs. As to trade marks, see also the Merchandise Marks Act, 1862 (a).

As to false representation of a design as being registered, see *Barley v. Walford* (b).

The section does not apply to cases of false representation of an expired patent as being still subsisting, such as in *Cheavin v. Walker* (c), cited *ante*.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland ; Ireland ; &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the

(z) See *Myers v. Baker*, 3 H. & N. 802.

(a) 25 & 26 Vict. c. 88.

(b) 9 Q. B. 197.

(c) 5 Ch. D. 863.

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.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

See *ante*, sect. 26.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

Reservation of remedies in Ireland.

A re-enactment of the last clause of sect. 29 of the Act of 1852.

Before that Act it was the practice to grant separate patents for the three kingdoms, and under that practice it was held in *Brown v. Annandale* (*d*) that the public use of an invention in England prior to the date of letters patent for Scotland invalidated the letters patent.

Upon this case it is observed by Mr. Webster (*e*) that neither in *Roebuck's* nor in *Brown's Case* was the grantee of the letters patent the true and first inventor in England, and he suggests that the decision would not be held to apply to a case in which the true and first inventor in one part of the realm was the grantee of the letters patent in the other part; and this view was followed in *Magill v. Ewing* (*f*), where it was held by the Lord Chancellor of Ireland that where an inventor who had obtained letters patent in England subsequently obtained letters patent in Ireland for the same invention, the Irish patent was not invalid by reason of prior publication in England.

In *Bovill v. Finch* (*g*) it was held under the Act of 1852 and the amending Act of 1853 (*h*) that a prolongation patent, which, by those Acts, was under the Great Seal of the United Kingdom, was to be considered as granting three separate prolongations of three distinct patents, and that although the prolongation might be invalid as to one grant (the Scotch) by reason of the want of novelty in Scotland at the time of the original patent, it might be good as to the English and Irish grants. The Court did not, however, decide what would be the effect of want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal, which has been the case with all patents since 1852, and is continued by the present Act. See *ante*, sect. 36.

(*d*) 1 Webst. 433, following *Roebuck v. Stirling*, 1 Webst. 45. See also *Re Pow's Patent*, 2 Webst. 5; *s.c.* under name *Robinson's Patent*, 5 Moo. P. C. 65.

(*e*) 1 Webst. 454, *n.*
 (*f*) 11 Ir. Jur. (N. S.) 164.
 (*g*) L. R. 5 C. P. 523.
 (*h*) 15 & 16 Vict. c. 83; 16 & 17 Vict. c. 115.

A strict construction of this section might lead to the conclusion that the patent can only be revoked as regards Ireland by an Irish Court. But such a construction cannot, it is submitted, be correct, since it is inconsistent with the general power given in sect. 26 (2), which is unlimited, and moreover would make it possible that there should at the same time be a patent in force in one branch of the United Kingdom while revoked in another, which, having regard to sect. 16, can hardly have been intended. It would appear, therefore, that the present section must be construed to relate only to patents which have never been revoked by any of the Courts mentioned in sect. 111 as included in the word "Court" where used in the Act.

General saving
for jurisdiction
of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the controller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to these Courts;

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings.

113. The enactments described in the third schedule to this Act are hereby repealed. But this repeal of enactments shall not—

Repeal and saving for past operation of repealed enactments, &c.

- (a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or
- (b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or
- (c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

Former registers to be deemed continued.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this

Saving for existing rules.

Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed (a) altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

(a) Patents Rules, 1883, r. 78; Marks Rules, 1883, r. 60; *post.* Designs Rules, 1883, r. 37; Trade

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

A re-enactment of part of sect. 16 of the Act of 1852.

The grant of a patent is discretionary in the Crown, and may be stopped at any stage of the proceedings (i).

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

“Person” includes a body corporate:

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England:

“Law Officer” means Her Majesty’s Attorney-General or Solicitor-General for England:

“The Treasury” means the Commissioners of Her Majesty’s Treasury:

“Comptroller” means the Comptroller-General of Patents, Designs, and Trade Marks:

“Prescribed” means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act:

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or

(i) “Hindmarch on Patents,” p. 17.

of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

“Legislature” includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

FORM A. (k)

FORM OF APPLICATION FOR PATENT.

Section 5.

£1
Stamp.

(a) Here insert name, address and calling of inventor.

I, (a) *John Smith*, of *29, Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do solemnly and sincerely declare that I am in possession of an invention for (b) "*Improvements in Sewing Machines*"; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

(b) Here insert title of invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(c) Signature of inventor.

(c) *John Smith.*

Declared at *Birmingham*, in the county of *Warwick*, this _____ day of _____ 18____.

Before me,

(d) Signature and title of the officer before whom the declaration is made.

(d) *James Adams,*
Justice of the Peace.

NOTE.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted; and the declaration must be made before a British Consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

FORM B. (k)

FORM OF PROVISIONAL SPECIFICATION.

Improvements in Sewing Machines. (a)

(a) Here insert title as in declaration.

I, (b) *John Smith*, of *29, Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do hereby declare the nature

(b) Here insert name, address, and calling of inventor as in declaration.

(k) See note (l) p. 203.

of my invention for "*Improvements in Sewing Machines*," to be as follows (c) :—

* * * * *

(d) *John Smith.*

(c) Here insert short description of invention.
(d) Signature of inventor.

Dated this _____ day of _____ 18____.

NOTE.—No stamp is required on this document.

FORM C. (l)

FORM OF COMPLETE SPECIFICATION.

£3
Stamp.

Improvements in Sewing Machines. (a)

I, (b) *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do hereby declare the nature of my invention for "*Improvements in Sewing Machines*," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (c) :—

* * * * *

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is (d).

- 1.
- 2.
- 3, &c.

(e) *John Smith.*

(a) Here insert title, as in declaration.
(b) Here insert name, address, and calling of inventor, as in declaration.
(c) Here insert full description of invention.
(d) Here state distinctly the features of novelty claimed.
(e) Signature of inventor.

Dated this _____ day of _____ 18____.

FORM D.

FORM OF PATENT.

Section 33.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith :
To all to whom these presents shall come greeting :

Whereas *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, hath by his solemn decla-

(l) For this and Forms A and B, are now substituted Forms A, A1, B, and C in the Second Schedule to the Patents Rules, 1883, *post*, see r. 5.

ration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines,*" 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 we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor 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 and 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 this _____ one thousand eight hundred and _____ and to be sealed as of the _____ one thousand eight hundred and _____

(Seal of
Patent Office.)

Section 47.

FORM E. (m)

FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

_____ day of _____ 18 ____.

You are hereby requested to register the accompanying
(a) Here insert _____ Design, in Class _____ in the name of (a) _____
legibly the name and address of the individual or firm. of _____
who claims to be the Proprietor thereof, and to return the same to _____

Statement of nature of Design _____

Registration Fees enclosed £ „ s.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, W.C.

(Signed) _____

(m) See now the Form E in the Second Schedule to the Designs Rules, 1883, *post*.

FORM F. (n)

Section 62.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

[NOTE.—Each side of this square in the Schedule to the Act is 4 inches in length.]

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size.)

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.)

You are hereby requested to register the accompanying trade mark, [*In Class —Iron in bars, sheets, and plates; in Class —Steam engines and boilers; and in Class —Warming Apparatus*], in the name of (a) _____, who claims to be the proprietor thereof.

(a) Here insert legibly the name, address, and business of the individual or firm.

Registration Fees enclosed £ „ s.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, W.C.

(Signed) _____

NOTE.—If the trade mark has been in use before August 13, 1875, state length of user.

(n) For this Form is now substituted Form F in the Second Schedule to the Trade Marks Rules, 1883, *post*, see r. 4.

THE SECOND SCHEDULE.

*Fees on Instruments for obtaining Patents, and Renewal.**(a.) Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification	3	0	0			
	<hr/>			4	0	0
<i>or</i>						
On filing complete specification with first application				4	0	0

(b.) Further before end of four years from date of patent.

On certificate of renewal	50	0	0
-----------------------------------	----	---	---

(c.) Further before end of seven years, or in the case of patents granted after the commencement of this Act, before the end of eight years from date of patent.

On certificate of renewal	100	0	0
-----------------------------------	-----	---	---

Or in lieu of the fees of £50 and £100 the following annual fees:—

Before the expiration of the fourth year from the date of the patent	10	0	0
" " fifth " " "	10	0	0
" " sixth " " "	10	0	0
" " seventh " " "	10	0	0
" " eighth " " "	15	0	0
" " ninth " " "	15	0	0
" " tenth " " "	20	0	0
" " eleventh " " "	20	0	0
" " twelfth " " "	20	0	0
" " thirteenth " " "	20	0	0

THE THIRD SCHEDULE.

Enactments Repealed.

21 James 1, c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled “An Act to amend the law touching letters patent for inventions.”
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vict. c. 69. (a) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled “An Act for the better administration of justice in His Majesty’s Privy Council, and to extend its jurisdiction and powers.” In part; namely,— Sections two to five, both included.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70. [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.

(a) NOTE.—Sections 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the Schedule the words and figures. “Certificate of the registration of a design .. £5 0 0 And see section 65.”
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

PATENTS RULES, 1883.

By virtue of the provisions of the Patents Designs and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules :—

Short Title.

1. These Rules may be cited as the Patents Rules, 1883. Short title.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of December 1883. Commencement.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned Act, in addition to the fees mentioned in the Second Schedule thereto, so far as it relates to patents, shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

Forms.

5. The Forms A, B, and C in the First Schedule to the said Act shall be altered or amended by the substitution thereof respectively of the Forms A, A1, B, and C in the Second Schedule hereto. Forms.

6. (1.) An application for a patent shall be made either in the Form A or the Form A1 set forth in the Second Schedule hereto, as the case may be. Application.

Specification. (2.) The Form B in such Schedule of provisional specification and the Form C of complete specification shall respectively be used.

Other forms. (3.) The remaining forms set forth in such Schedule may, as far as they are applicable, be used in any proceedings under these Rules.

See a list of these Forms, *post*, p. 230.

General.

Hours of business. 7. The Patent Office shall be open to the public every week-day during the hours of ten and four, except on the days and times following:—

Christmas Day.

Good Friday.

The day observed as Her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency. 8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller and all attendances by the applicant upon the Comptroller may be made by or through an agent duly authorized to the satisfaction of the Comptroller, and if he so require resident in the United Kingdom.

Statement of address. 9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this Rule be in the United Kingdom.

Size, &c. of documents. 10. All documents and copies of documents sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand

part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

11. Before exercising any discretionary power given to the Comptroller by the said Act 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 discretionary power by Comptroller.
Notice of hearing.

12. 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 to the Comptroller whether or not he intends to be heard upon the matter.

Notice by applicant.

See Form E, *post*, p. 236.

13. 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.

Comptroller may require statement, &c.

14. 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 any other person affected thereby.

Decision to be notified to parties.

15. The term "applicant" in Rules 11, 12, and 13 shall include an applicant whose specification bears a title the same as or similar to that of the specification of a prior applicant, and has been reported on by the examiner.

Definition of "applicant."

16. Such prior and second applicant respectively may attend the hearing of the question whether the invention comprised in both applications is the same, but neither party shall be at liberty to inspect the specification of the other.

Prior and second applicant may attend hearing

17. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any

Industrial or International Exhibitions.

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, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice 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 applicant 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.

See Form O, *post*, p. 247.

Power of
amendment,
&c.

18. Any document for the amending of which no special provision is made by the said Act 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.

This rule includes apparently amendment of clerical errors in a specification (Second Schedule, Form P, *post*, p. 248). These errors, which hitherto could be corrected only on application to the Master of the Rolls (*ante*, p. 23), are not mentioned in sect. 91 (*ante*, p. 188); but the rule appears to be within the powers of sect. 101 (1, *c*), *ante*, p. 193, and by that section has the force of an Act of Parliament.

Documents
by post.

19. Any application, notice, or other document authorized 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 respectively 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.

Affidavits.

20. Affidavits may, except where otherwise prescribed by these Rules, be used as evidence in any proceedings

thereunder when sworn to in any of the following ways, viz. :—

- (1.) In the United Kingdom before any person authorized to administer oaths in the Supreme Court of Judicature or before a justice of the peace for the county or place where it is sworn or made.
- (2.) In any place in the British dominions out of the United Kingdom before any Court, Judge, or Justice of the Peace or any person authorized to administer oaths there in any Court.
- (3.) In any place out of the British dominions before a British Minister, or person exercising the functions of a British Minister, or a British Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a Judge or magistrate.

21. Where any statutory declaration prescribed by these Rules, or used in any proceedings thereunder, is made out of the United Kingdom, the words, “and by virtue of the Statutory Declarations Act, 1835,” must be omitted, and the declaration shall (unless the context otherwise requires) be made in the manner prescribed in Rule 20, sub-section (3). Statutory declarations.

Application with Provisional or Complete Specification.

22. Applications for a patent sent by prepaid letter 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.

23. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to Application for separate patents by way of amendment.

apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Act and by these Rules as if every such application had been originally made on that date for one invention only.

Application by representative of deceased inventor.

24. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative.

Notice and advertisement of acceptance.

25. On the acceptance of an application with a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Inspection on acceptance of complete specification.

26. Upon the publication of such advertisement of acceptance in the case of an application with 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.

Application on communication from Abroad.

Communication from abroad.

27. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the Second Schedule hereto.

Sizes and Methods of preparing Drawings accompanying Provisional or Complete Specifications.

Size of drawings.

28. The drawings accompanying provisional or complete specifications shall be made upon half-sheets or sheets of imperial drawing paper, to be within a border line of 19 inches by 12 inches, or 27 inches by 19 inches, with a margin of half an inch all round.

29. A copy of the drawings will be required upon *rolled* imperial drawing paper or upon thin Bristol board of the same dimensions as the original drawing or drawings. All the lines must be absolutely black, Indian ink of the best quality to be used, and the same strength or colour of the ink maintained throughout the drawing. Any shading must be in lines clearly and distinctly drawn and as open as is consistent with the required effect. Section lines should not be too closely drawn. No colour must be used for any purpose upon the copy of the drawings. All letters and figures of reference must be bold and distinct. The border line should be one fine line only. The drawings must not be folded, but must be delivered at the Patent Office either in a perfectly flat state or rolled upon a roller so as to be free from creases or breaks.*

Copies of drawings.

30. Where a complete specification is left at the Patent Office after a provisional specification has been accepted the complete specification and drawing or drawings accompanying the same, as well as the copy thereof, must be prepared in accordance with Rules 10, 28, and 29.

Illustrated Journal.

31. Every applicant for the grant of a patent shall, in addition to the drawings to be furnished with his complete specification, furnish the Comptroller with a drawing illustrative of the feature or features of novelty constituting his invention. Such drawing must be prepared in the manner prescribed for the copy of the original drawing or drawings accompanying the specification, but must not cover a space exceeding 16 square inches. The drawing must be accompanied by a concise explanatory statement on foolscap paper and legibly written or printed.

Additional drawing to be furnished.

This provision is new, and if enforced is likely to throw a considerable burden of trouble and expense on the patentee.

* As the drawings accompanying the provisional and complete specification respectively are copied at the Patent Office for publication by the process of photo-lithography, this rule must be strictly observed in order that correct copies may be made.

Opposition to Grants of Patents.

Notice of
opposition.

32. A notice of opposition to the grant of a patent shall state the ground or grounds on which the person giving such notice (herein-after called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

See Form D, *post*, p. 235.

Copy for
applicant.

33. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant.

If the applicant desires to be heard on the opposition, he must send the Comptroller the application Form E, *post*, p. 236.

Particulars of
prior patent.

34. 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 title, number, and date of the patent granted in such prior application shall be specified in the notice.

Opponent's
evidence.

35. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent shall leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof.

Applicant's
evidence.

36. Within 14 days from the delivery of such list the applicant shall leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent shall leave at the Patent Office his statutory declarations in reply, and deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Evidence in
reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

Closing of
evidence.

37. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application made to him for that purpose.

38. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

39. On the completion of the evidence the Comptroller shall appoint a time for the hearing of the case, and shall give to the parties seven days' notice at the least of such appointment.

Notice of hearing.

40. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition.

Disallowance of opposition in certain cases.

41. The decision of the Comptroller in the case shall be notified by him to the parties.

Decision to be notified to parties.

Certificates of Payment or Renewal.

42. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to make the prescribed payment for keeping the same in force, he shall seven days at least before such expiration give notice to the Comptroller of such intention, and shall, before the expiration of such fourth or eighth year, as the case may be, leave at the Patent Office a form of certificate of payment, duly stamped, subject as herein-after provided, with the prescribed fee of 50*l.* or 100*l.*, as the case may be.

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

See Form J, *post*, p. 242.

43. In the case of patents granted before the commencement of the said Act, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

As to patents granted before commencement of Act.

44. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l.* and 100*l.*, he shall seven

Payment of annual fees in lieu of 50*l.* and 100*l.*

days at least before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, give notice to the Comptroller of such intention, and shall, before the expiration of such respective periods as aforesaid, leave at the Patent Office a form of certificate of payment, duly stamped with the fee prescribed to be paid at such periods respectively.

See Form J, *post*, p. 242.

Certificate of payment.

45. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall give to the patentee a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

46. 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.

See Form K, *post*, p. 243.

In other cases.

47. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Amendment of Specification.

Request for leave to amend.

Advertisement.

48. A request for leave to amend a specification shall be signed by the applicant or patentee and accompanied by a 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.

See Form F, *post*, p. 237.

49. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (herein-after called the opponent) intends to oppose the amendment, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

Notice of
opposition.

See Form G, *post*, p. 238.

50. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant or patentee, as the case may be (herein-after called the applicant).

Copy for the
applicant.

If the applicant or patentee desires to be heard on his application or on the opposition, he must send the Comptroller an application Form E, *post*, p. 236.

51. Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent shall leave at the Patent Office statutory declarations in support of his opposition and deliver to the applicant a list thereof.

Opponent's
evidence.

52. Upon such declarations being left, and such list being delivered, the provisions of Rules 36, 37, 38, and 39 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 pro-
ceedings.

53. The decision of the Comptroller in the case shall be notified by him to the parties.

Decision to be
notified to
parties.

54. 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 10, 28, and 29.

Requirements
thereon.

55. Where a request for leave to amend is made by or in pursuance of an order of the Court or a Judge, an official or

Leave by Order
of Court.

verified copy of the order shall be left with the request at the Patent Office.

Advertisement of amendment.

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

Compulsory Licences.

Petition for compulsory grant of licences.

57. A petition to the Board of Trade for an order upon a patentee to grant a licence 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.

See Form H1, *post*, p. 240.

To be left with evidence at Patent Office.

58. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

See Form H, *post*, p. 239.

Directions as to further proceedings unless petition refused.

59. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the Comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

60. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Petitioner's evidence.

61. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner. ^{Patentee's evidence.}

62. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the petitioner; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply. ^{Evidence in reply.}

63. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition. ^{Further proceedings.}

The provisions as to compulsory licences are new. They do not apply to patents granted before the commencement of the Act, or on applications then pending. (Sect. 44 (9), *ante*, p. 137.)

Neither the Act nor the Rules contain any provision as to costs, which, if the application be unfounded, may be a serious burden to the patentee.

The Act gives no appeal from the decision of the Board of Trade. But by sect. 22 (*ante*, p. 29) the order of the Board of Trade for a compulsory licence may be enforced by mandamus. A writ of mandamus is, however, a prerogative writ, and not a writ of right, and it is in this sense in the discretion of the Court whether it shall be granted or not. The Court may refuse to grant the writ, not only upon the merits, but upon some delay or other matter personal to the party applying for it (*o*), or possibly on matters connected with the conduct of the parties (*p*). The writ may also be refused where it is inequitable to grant it (*q*), and it was refused where performance of an order of the Board of Trade, which the applicant sought to enforce, was shown to be impossible owing to want of funds (*r*). It would seem, therefore, that where a compulsory licence has been ordered, the patentee may, on the application for a mandamus, obtain a review of the decision of the

(*o*) *R. v. Churchwardens of All Saints', Wiyan*, 1 App. Cas. 611; Judgment of Lord Chelmsford, p. 621.

(*p*) *Ibid.* p. 622; Judgment of Lord Hatherley.

(*q*) *R. v. Garland*, L. R. 5 Q. B. 269.

(*r*) *Re The British and North Somerset Railway Co.*, 3 Q. B. D. 11.

Board of Trade. Where, however, the compulsory licence has been refused by the Board of Trade, the applicant has no remedy.

Register of Patents.

Entry of grant. 64. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

65. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, 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.

See Form L, *post*, p. 244.

Reading this Rule (which has the force of an Act of Parliament—see sect. 101 (3), *ante*, p. 193) in connection with sects. 23 and 87 (*ante*, pp. 30, 181), it would seem that the registration of assignments is now made compulsory, in order to their validity, not merely as against third parties, but also as between the parties themselves (*s*). A similar observation occurs as to licences. See Rule 74, *post*.

Signature of request.

66. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized in like manner.

Particulars to be stated in request.

67. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons

(*s*) For the law under the Act of 1852, see *ante*, pp. 181-183, 185, 186; and *Hassall v. Wright*, L. R. 10 Eq. 510.

to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

68. 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 be produced to the Comptroller, together with the request above prescribed, and such other proof of 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.

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

Copies for Patent Office

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an examined copy.

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

Body corporate.

71. Where an order has been made by Her 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 by the Court for the revocation of a patent or the rectification of the register under section 90 of the said Act 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 Orders of the Privy Council or of the Court.

“Where an order,” &c., “for extension of patent.” See Form S, *post*, p. 251.

72. Upon the issue of a certificate of payment under Rule 45, the Comptroller shall cause to be entered in the

Entry of payment of fees on issue of certificate.

Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of failure to pay fees.

73. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licences.

74. An examined copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

See Form M, *post*, p. 245.

"*Shall be left.*" From this it would appear that the registration of licences is compulsory. See *ante*, under Rule 65.

Hours of inspection of register.

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

- (a.) Christmas Day, Good Friday, the day observed as Her 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;
- (c.) Times when the register is required for any purpose of official use.

Certified copies of documents.

76. 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.

Power to dispense with Evidence, &c.

77. 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.

Repeal.

78. All general rules made by the Lord Chancellor, or by ^{Repeal.} any other authority, under the Patent Law Amendment Acts, and in force on the 31st day of December, 1883, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to any application then pending.

Dated the 21st day of December 1883.

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

FIRST SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNEXION WITH LETTERS PATENT

		<i>Up to Sealing.</i>					
		£	s.	d.	£	s.	d.
1.	On application for provisional protection	1	0	0			
2.	On filing complete specification	3	0	0 (t)			
		<hr/>			4	0	0
or							
3.	On filing complete specification with first application				4	0	0
4.	On appeal from Comptroller to Law Officer. By appellant				3	0	0
<hr/>							
5.	On notice of opposition to grant of patent. By opponent				0	10	0
6.	On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
<hr/>							
7.	On application to amend specification:—						
	Up to sealing. By applicant				1	10	0
8.	After sealing. By patentee				3	0	0
9.	On notice of opposition to amendment. By opponent				0	10	0
10.	On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
11.	On application to amend specification during action or proceeding. By patentee				3	0	0
<hr/>							
12.	On application to the Board of Trade for a compulsory licence. By person applying				5	0	0
13.	On opposition to grant of compulsory licence. By patentee				5	0	0
14.	On certificate of renewal :—						
	Before end of 4 years from date of patent				50	0	0
15.	Before end of 7 years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of 8 years from date of patent				100	0	0
	or in lieu of the fees of 50 <i>l.</i> and 100 <i>l.</i> , the following annual fees:—						

(t) These payments are in lieu of the fees under the Act of 1853, which, up to the specification, amounted to 25*l.*

						£	s.	d.
16.	Before the expiration of the 4th year from the date of				the patent	10	0	0
17.	"	"	5th	"	"	10	0	0
18.	"	"	6th	"	"	10	0	0
19.	"	"	7th	"	"	10	0	0
20.	"	"	8th	"	"	15	0	0
21.	"	"	9th	"	"	15	0	0
22.	"	"	10th	"	"	20	0	0
23.	"	"	11th	"	"	20	0	0
24.	"	"	12th	"	"	20	0	0
25.	"	"	13th	"	"	(u) 20	0	0
On enlargement of time for payment of renewal fees :--								
26.	Not exceeding 1 month	3	0	0
27.	"	2 months	.	.	.	7	0	0
28.	"	3 months	.	.	.	10	0	0
29.	For every entry of an assignment, transmission, agree-							
	ment, 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.	"	"	of drawings, cost according to agree-					
			ment.					
35.	For certifying office copies, MSS. or printed	.	.	.	each	0	1	0
36.	On request to Comptroller to correct a clerical error	0	5	0
37.	For certificate of Comptroller under section 96	0	5	0
38.	For altering address in register	0	5	0

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

21st December, 1883.

Approved:

(Signed) CHARLES C. COTES,
HERBERT J. GLADSTONE,
*Lords Commissioners of
Her Majesty's Treasury.*

4th December, 1883.

(u) These payments will be in time if made before midnight on the anniversary of the day of the date of the patent (*Williams v. Nash*, 28 Bea.

93). (See also sect. 98.) In the case of existing patents the annual fees are payable only where the 50*l* duty has not already been paid. See *ante*, p. 139.

THE SECOND SCHEDULE.

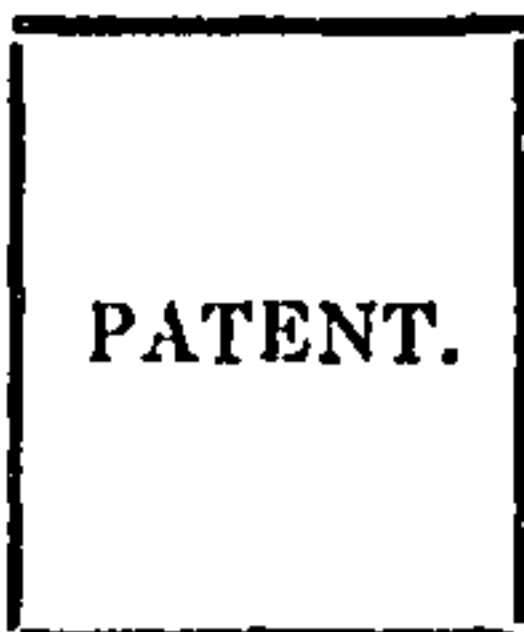
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PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form A.

APPLICATION FOR PATENT.



(a) _____

(a) Here insert name, full address, and calling of applicant or applicants.

_____, do solemnly and sincerely declare that _____ in possession of an invention for (b) _____

(b) Here insert title of invention.

that _____ the true and first inventor _____ thereof ; and that the same is not in use by any other person or persons to the best of _____ knowledge and belief ; and _____ humbly pray that a patent may be granted _____

for the said invention.

And _____ make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(c) _____

(c) Signature of applicant or applicants.

Declared at (d) _____ in the _____
_____ this _____ day of
_____ 18__.

(d) If declared by more than one applicant and at different times or places, insert after "Declared" the words "by the above-named."

Before me,
(e) _____

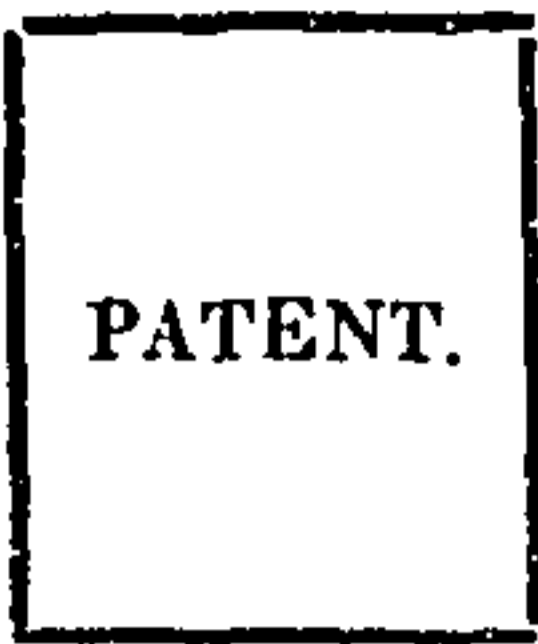
(e) Signature and title of the person before whom the declaration is made.

[Declared at (d) _____ in the _____
_____ this _____ day of
_____ 18__.

Before me,
(e) _____

(f) If not required as in note (d), strike out part within brackets.

NOTE.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted, and the declaration must be made before a British Consular Officer, or, where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.



PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form A1.

APPLICATION FOR PATENT FOR INVENTIONS
COMMUNICATED FROM ABROAD.

(a) Here insert name, full address, and calling of applicant.

I (a) _____ in the
of _____ county of _____ do solemnly and

(b) Here insert title of invention.

sincerely declare that I am in possession of an invention for (b) _____

(c) Here insert name, address, and calling of communicant.

which invention has been communicated to me from abroad by (c) _____

that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(d) Signature of applicant.

(d) _____

Declared at _____ in the county of _____
this _____ day of _____
18____.

(e) Signature and title of the officer before whom the declaration is made.

Before me;

(e) _____

NOTE.—Where the above declaration is made out of the United Kingdom, the words “and by virtue of the Statutory Declarations Act, 1835,” must be omitted, and the declaration must be made before a British Consular Officer, or, where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

[To be issued with Form A or A1.]

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(a) _____

(a) Here insert
title, as in decla-
ration.

(b) _____

(b) Here insert
name, full address,
and calling of ap-
plicant or appli-
cants, as in decla-
ration.

do hereby declare the nature of said invention for _____

to be as follows (c): _____

(c) Here insert
short description
of invention.

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification ; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant or his agent on the last sheet, the date being first inserted as follows :—

"Dated this day of , 18 ."



PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form C.

COMPLETE SPECIFICATION.
(To be furnished in Duplicate—one unstamped.)

(a) Here insert title, as in declaration.

(a) _____

(b) Here insert name, full address, and calling of applicant or applicants, as in declaration.

(b) _____

_____ do hereby declare
the nature of _____ invention for _____

and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (c):—

(c) Here insert full description of invention, which must end with a distinct statement of claim or claims, in the following form:

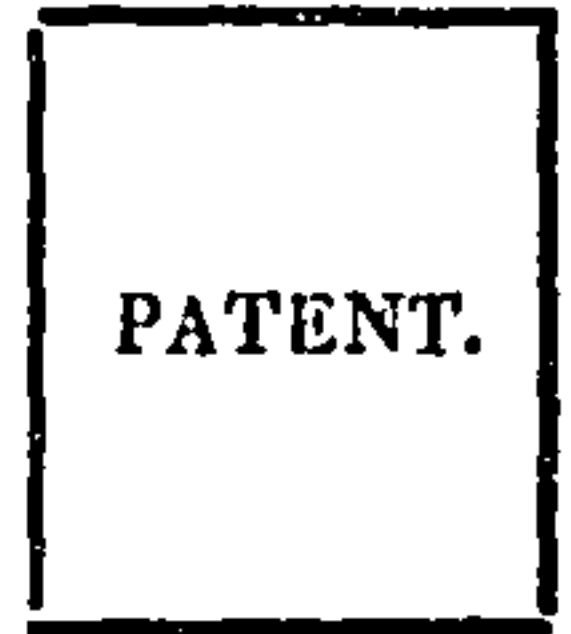
“Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is,

(1.)
(2.)
(3.)
Here state distinctly the features of novelty claimed.”

NOTE.—This document must form the commencement of the complete Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The complete Specification and the “Duplicate” thereof must be signed by the applicant or his agent on the last sheet, the date being first inserted as follows:—

“Dated this _____ day of _____, 18__.”

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

[To be accompanied by an unstamped copy.]

I (a) _____

(a) Here state name and full address.

hereby give notice of my intention to oppose the grant of Letters Patent upon application No. _____ of _____, applied for by

upon the ground (b) _____

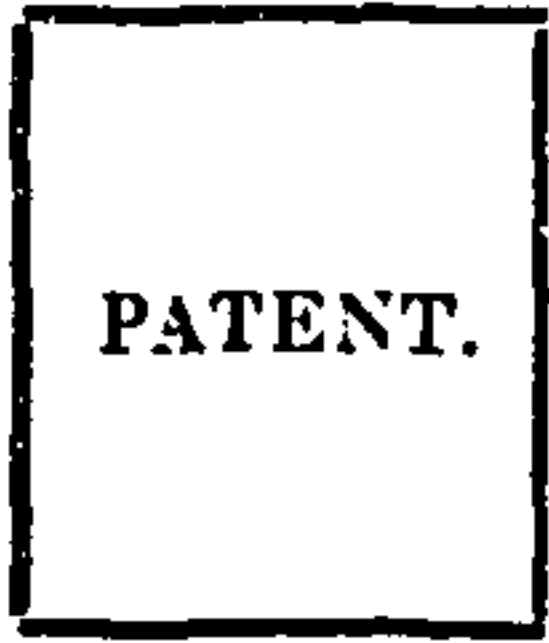
(b) Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed.

(Signed) (c) _____

(c) Here insert signature of opponent or agent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form E.

FORM OF APPLICATION FOR HEARING BY THE
COMPTROLLER.

IN CASES OF REFUSAL TO ACCEPT, OPPOSITION, OR APPLICATION FOR
AMENDMENTS, &c.

SIR,

(a) Here insert
full address.

of (a)

hereby apply to be heard in reference to

and request that I may receive due notice of the day fixed for the
hearing.

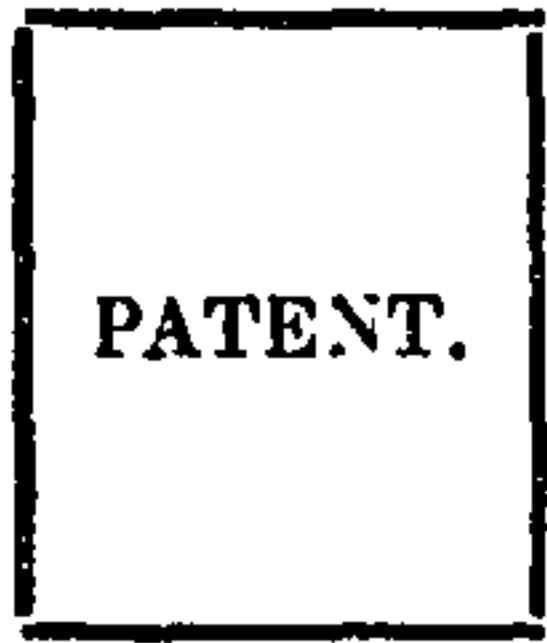
Sir,

Your obedient Servant,

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.



PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFI-
CATION OR DRAWINGS.

[To be accompanied by an unstamped copy.]

(a) Here state name and full address of opponent.

(a) _____

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. _____ of 188_____

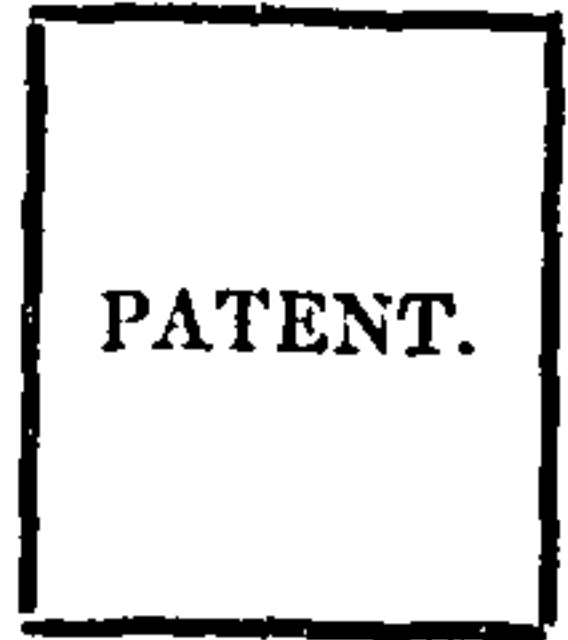
(b) Here state reason of opposition.

for the following reason : (b) _____

(Signed) _____

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form H.

FORM OF APPLICATION FOR COMPULSORY GRANT OF
LICENCE.

[To be accompanied by an unstamped copy.]

(a) _____

(a) Here state
name and full
address of appli-
cant.

hereby request you to bring to the notice of the Board of Trade the
accompanying petition for the grant of a licence to me by (b) _____

(b) Here state
name and address
of patentee, and
number and date
of his patent.

(Signed) _____

NOTE.—The petition must clearly set forth the facts of the case and
be accompanied by an examined copy thereof. See Form next page.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form H1.

FORM OF PETITION FOR COMPULSORY GRANT OF
LICENCES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

(a) Here insert name, full address, and description.

THE PETITION of (a) _____ of _____
in the county of _____, being a
person interested in the matter of this petition as hereinafter
described :—

(b) Here insert title of invention.

SHEWETH as follows :—

(c) Here state fully the nature of petitioner's interest.

1. A patent dated _____ No. _____
was duly granted to _____
for an invention of (b) _____

(d) Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licences on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

2. The nature of, my interest in the matter of this petition is as follows :—(c) _____

3. (d) _____

(e) Here state the ground or grounds on which relief is claimed in the language of section 22, subsections (a), (b), or (c), as the case may be.

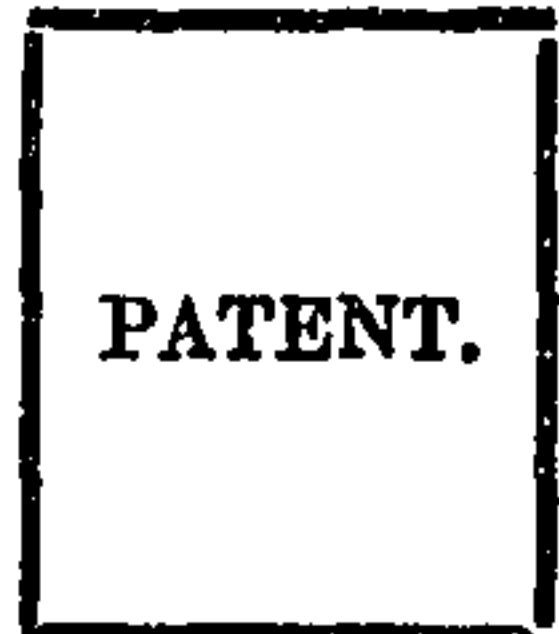
Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licences on reasonable terms (e) _____

(f) Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

Your petitioner therefore prays that
an order may be made by the Board of
Trade (f) _____

or that the petitioner may have such
other relief in the premises as the Board
of Trade may deem just.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form I.

FORM OF OPPOSITION TO COMPULSORY
GRANT OF LICENCE.

(a) _____

(a) Here state
name and full
address.

hereby give notice of objection to the application of _____

for the compulsory grant of a Licence under Patent No. _____

of 188 .

(Signed) _____

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT
OR RENEWAL.

_____ hereby transmit the fee prescribed for the continuation in
force of _____ Patent No. _____, of 18____, for a
further period of _____.

(a) Here insert
name and full ad-
dress of patentee
or his agent.

Name (a) _____

Address _____

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

CERTIFICATE OF PAYMENT OR RENEWAL.

PATENT.

Letters Patent No. _____ of 188____.

_____ 18____.

This is to certify that _____ did this _____
day of _____ 18____, make the prescribed payment of
£ _____ in respect of a period of _____ from _____,
and that by virtue of such payment the rights of _____
remain in force (b).

(b) See section
17 of the Patents,
Designs, and
Trade Marks Act,
1883.

(Seal.)

Patent Office, London.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form K,

FORM OF APPLICATION FOR ENLARGEMENT OF TIME
FOR PAYMENT OF RENEWAL FEE.

SIR,

I HEREBY apply for an enlargement of time for _____
month in which to make the _____ payment of
£ _____ upon my Patent, No. _____,
of 188 .

I am,

Sir,

Your obedient Servant,

(a) _____

(a) Here insert
full address to
which receipt is
to be sent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.



PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form L.

FORM OF REQUEST TO ENTER NAME UPON THE
REGISTER OF PATENTS, AND OF DECLARATIONS IN
SUPPORT THEREOF.

(a) Or We.
Here insert
name, full ad-
dress, and de-
scription.

I (a), _____

(b) My or our.
(c) Or names.

hereby request that you will enter (b) _____ name (c) in the
Register of Patents :—

(d) I or We.
(e) Here insert
the nature of the
claim.

(d) _____ claim to be entitled (e) _____

(f) Here give
name and ad-
dress, &c., of Pa-
tenteo or Paten-
tees.

of the Patent No. _____ of 188 , granted to (f) _____

(g) Here insert
title of the inven-
tion.

for (g) _____

(h) Here specify
the particulars of
such document,
giving its date,
and the parties to
the same, and
showing how the
claim here made
is substantiated.

by virtue of (h) _____

(i) Here insert
the nature of the
document.

And in proof whereof I transmit the accompanying (i) _____
_____ with an examined copy

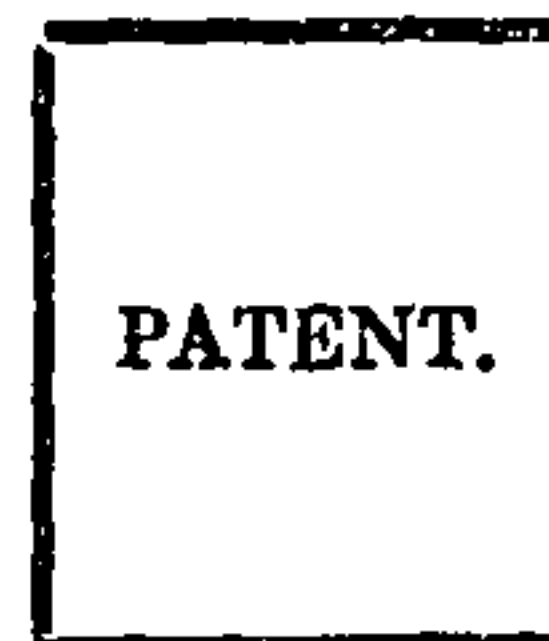
(j) Where any
document which
is a matter of re-
cord is required
to be left, a certi-
fied or official
copy in lieu of an
examined copy
must be left.

thereof (j).

I am,
Sir,
Your obedient Servant.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form M.

FORM OF REQUEST TO ENTER NOTIFICATION OF
LICENCE IN THE REGISTER OF PATENTS.

SIR,

I HEREBY transmit an examined copy of a licence granted to me

by _____

under Patent No. _____ of 188 , as well as the original licence for
verification, and I have to request that a notification thereof may be
entered in the Register.

I am,

Sir,

Your obedient Servant,

(a) _____

(a) Here insert
full address.

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.



PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form N.

APPLICATION FOR DUPLICATE OF PATENT.

Date _____

SIR,

I REGRET to have to inform you that the Letters Patent,

(a) Here insert
date, No., name,
and full address
of Patentee.

dated (a) _____ No. _____

granted to _____

(b) Here insert
title of invention.

for an invention of (b) _____

(c) Here insert
the word "des-
troyed" or "lost,"
as the case may
be.

have been (c) _____

I beg therefore to apply for the issue of a duplicate of such

(d) Here state
interest possessed
by applicant in
the Letters Pa-
tent.

Letters Patent. (d) _____

[Signature of Applicant.] _____

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED
INVENTION.

(a) _____

(a) Here state name and full address of applicant.

hereby give notice of my intention to exhibit a _____
of _____ at the _____

Exhibition, which (b) _____ of _____ 18_____,
under the provisions of the Patents, Designs, and Trade Marks Act
of 1883.

(b) State "opened" or "is to open."

_____ herewith inclose (c) _____

(c) Insert brief description of invention, with drawings if necessary.

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.



PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

Form P.

FORM OF REQUEST FOR CORRECTION OF
CLERICAL ERROR.

SIR,

(a) or errors. I HEREBY request that the following clerical error (a) may

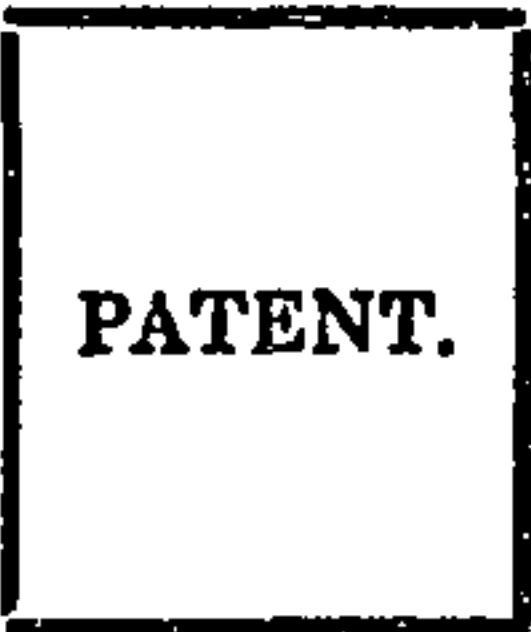
(b) Here state whether in application, specification, or register. be corrected in (b) _____

Signature _____

Full Address _____

*To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.*

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office,

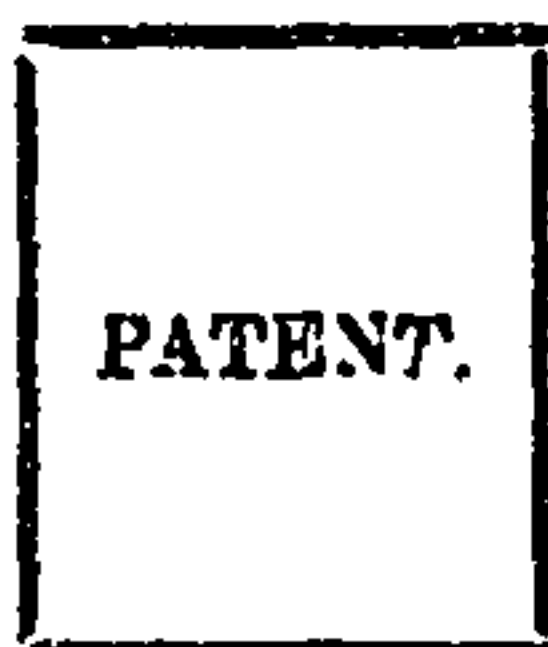
London,

188 .

I, _____, Comptroller-General of Patents,

Designs, and Trade Marks, hereby certify _____

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS
IN REGISTER.

SIR,

(a) Here state name or names and full address of applicant or applicants.

(a) _____

hereby request that _____ address now upon the Register may be altered as follows :—

(b) Here insert full address.

(b) _____

Sir,

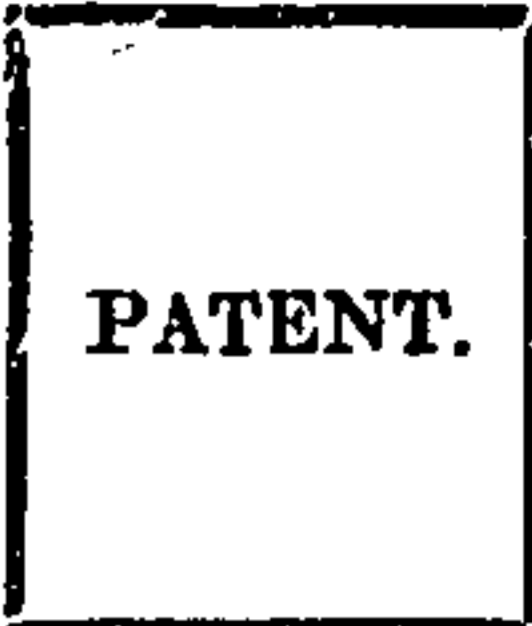
Your obedient Servant,

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.



Form S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF
PRIVY COUNCIL IN REGISTER.

(a) _____

(a) Here state name and full address of applicant.

hereby transmit an office copy of an Order in Council with reference
to (b) _____

(b) Here state the purport of the order.

Sir,

Your obedient Servant,

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT,
1883.

PATENT.

Form T.

FORM OF APPEAL TO LAW OFFICER.

(a) Here insert name and full address of appellant.

I, (a) _____ of (a) _____

(b) Here insert "the decision" or "that part of the decision," as the case may be.

hereby give notice of my intention to appeal to the Law Officer from

(c) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

(b) _____

of the Comptroller of the _____ day of _____

188 , whereby he (c) _____

(d) Insert number and year.

No. (d) _____ of the year 188 . (d)

Signature _____

Date _____

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

21st December, 1883.

(Signed)

J. CHAMBERLAIN,

President of the Board of Trade.

RULES REGULATING THE PRACTICE AND
PROCEDURE ON APPEALS TO THE LAW
OFFICERS.

I. WHEN any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within 14 days from the date of the decision appealed against file in the Patent Office, a notice of such his intention.

See Form T, *ante*, p. 252.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk at room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by

the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or opponents; and, when the Comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.

FARRER HERSCHELL, S.G.

JUDICIAL COMMITTEE RULES.

No Rules having been made under sect. 25 (6) *ante*, p. 31, the following, which were made under the repealed Acts, are still in force.

Rules to be observed in Proceedings before the Judicial Committee of the Privy Council under the Act of the 5th and 6th Wm. 4, intituled "An Act to amend the Law touching Letters Patent for Inventions," cap. 83.

RULE I.—A party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which

he intends to apply for a time to be fixed for hearing the matter of his petition (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*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application, shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This Rule relates to the provisions for confirmation of letters patent contained in the repealed Acts, and not re-enacted in the present Act.

RULE II.—A party intending to apply by petition, under section 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (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*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

“Section 4 of the said Act.” This section contained full directions as to the advertisements to be issued, and required the petitioner to

“advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town.”

The present Act (sect. 25 (1), *ante*, p. 31) refers for the regulations as to advertisements to Rules to be made, and does not itself prescribe any mode of advertising, but as the above directions of the repealed Act have hitherto regulated the “procedure and practice in patent matters of the Judicial Committee” as to advertisements, it would seem that until new Rules are made this method of advertising must still be followed. See sect. 25 (6), and Rule IV, *post*.

The advertisements are proved before the case is heard (*x*).

If the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in the places where the manufacture is actually carried on (*y*). The name of an equitable assignee of a co-petitioner must appear in the advertisements (*z*).

“*Time to be fixed for the hearing.*” Where on an application to fix hearing it appeared that the petition had been presented nearly eighteen months before the expiry of the patent, the application was ordered to stand over, as the profits accruing in the meantime might materially affect the question of extension (*a*). Whether on a renewal of such an application the notices served before the first application will be sufficient, *qu.* (*b*).

Under the repealed Acts it was required that the petition should be prosecuted with effect before the patent expired, otherwise, unless the petition was presented more than six months before the date of expiration (*c*), no extension could be granted, and “prosecuted with effect” meant obtaining the report of the Judicial Committee (*d*). There is no such requirement in the present Act, and it is submitted that if the petition is presented in time extension may be granted, although the hearing does not take place till the patent has expired (*e*).

RULE III.—Petitions under sections 2 and 4 of the said Act must be presented within one week from the

- | | |
|--|--|
| (<i>x</i>) <i>Perkins' Patent</i> , 2 Webst. 8. | (<i>c</i>) 5 & 6 Wm. 4, c. 53, s. 4; 2 & |
| (<i>y</i>) <i>Derosne's Patent</i> , 2 Webst. | 3 Vict. c. 67, s. 2. <i>Bodmer's Patent</i> , |
| 2. | 1 Webst. 740. |
| (<i>z</i>) <i>Noble's Patent</i> , 7 Moo. P. C. | (<i>d</i>) <i>Ledsam v. Russell</i> , 1 H. L. C. |
| 191. | 687. |
| (<i>a</i>) <i>Mackintosh's Patent</i> , 1 Webst. | (<i>e</i>) Compare <i>Somerset and Walker's</i> |
| 739, n. | <i>Patent</i> , 13 Ch. D. 397; <i>Johnson's</i> |
| (<i>b</i>) <i>Ibid.</i> | <i>Patent</i> , <i>Ibid.</i> 398, n. |

insertion of the last of the advertisements required to be published in the *London Gazette*.

In a case of delay arising from mistake this Rule has not been insisted on (*f*). And a supplementary statement to correct errors in the petition has been allowed to be delivered before the hearing (*g*).

Where a petitioner who was entitled to a moiety of the patent, and who, with the assignees of the other moiety, had presented a petition for prolongation, died before the petition was heard, his widow, being executive and residuary legatee, was allowed to appear at the hearing without a supplemental petition, but the Judicial Committee directed, in case a prolongation should be granted, that sufficient proof should be afforded to enable the recital of the death and bequest to be inserted in the new letters patent (*h*).

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the 1st and 2nd of these Rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

RULE V.—All persons entering caveats under section 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

“*Caveats.*” See *ante*, p. 34.

An alien resident abroad who was interested in an English patent by a foreign inventor, and who had had considerable dealings in this country in respect of sales of the patented machine and in granting

(*f*) *Hutchinson's Patent*, 14 Moo. 364. (*g*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*h*) *Herbert's Patent*, L. R. 1 P. C. 399, 401.

licences, was held to have sufficient *locus standi* to oppose the extension of an English patent which would interfere with the first-mentioned patent. But it was not decided whether without such an interest he would have been entitled to inform the Crown in any matter touching letters patent (i).

“Section 4 of the said Act.” See now sect. 25, *ante*, p. 31.

“All parties, &c. . . . , under section 2 of the said Act.” This relates to the repealed provisions as to confirmation.

“Entitled to be served.” The Rule extends to cases of applications to correct an irregularity in the service of the petition. In such a case a person who has entered a *caveat* must be served with notice of the application (k).

RULE VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Under this Rule it is sufficient to state the grounds of objection without stating the particulars of those objections (l).

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

RULE VIII.—The Registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

As to costs of this nature in actions for infringement, see *ante*, p. 86.

RULE IX.—A party applying for an extension of a patent, under section 4 of the said Act, must lodge at the Council Office six printed copies of the

(i) *In re Schlumberger*, 9 Moo. P. C. 1.

(k) *Hutchinson's Patent*, 14 Moo. P. C. 364.

(l) *Ball's Patent*, 4 App. Cas. 171.

specification, and also four 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. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

"Copies of the specification." See *In re Bell's Patent* (m).

"Not less than one week." This Rule is imperative, and is necessary, that the Attorney-General may have the power of inspecting the accounts and making inquiries, and where the accounts had only been filed on the morning of hearing the Judicial Committee refused to go into the accounts, but allowed the hearing to be postponed (n).

"The Attorney-General." See *ante*, pp. 34, 41. Where the invention is one which is not likely to be used except by the Government, the Judicial Committee rely very much on what is said in favour of the invention by those who represent the Crown (o).

It seems that the Attorney-General may adduce evidence impeaching the patent, irrespective of any notice of objections (p).

(m) 2 Webst. 159.

(n) *Johnson's and Atkinson's Patent*, L. R. 5 P. C. 88.

(o) *Hughes' Patent*, 4 App. Cas.

179, citing *Berrington's Case* and *Ruthven's Patent*.

(p) *Bull's Patent*, 4 App. Cas. 173, 174.