

show that in the past the Privy Council has refused to postpone the public's right to the enjoyment of an invention except under very special circumstances, and there is no reason for supposing that the judges of the High Court will depart from this precedent.

In considering the merit of an invention, the Court will not go into the question of validity. Utility, on the other hand, is all-important, and one of the difficulties which the petitioner has usually to overcome is to rebut the presumption of non-utility which arises from the non-success of the invention. The petitioner must be furnished with strong evidence on this part of the case and be prepared to show that the causes which militated against success are not inherent in the invention.

For example, its adoption may involve the discarding of existing plant and machinery, and the erection of new plant at an outlay which manufacturers are loth to incur; or it may be of such a character as to appeal to a very limited section of the public. Thus, where the railway companies were the patentee's only possible customers, and the non-success or belated success of the invention was ascribed to indifference and lack of enterprise on their part, this was accepted as a satisfactory explanation.

In the case of *Parson's patent*, for which an extension of five years was granted, the failure to win commercial success within the period of the patent was not so much due to want of enterprise on the part of the public, as to the need for prolonged and costly experimentation in order to surmount the mechanical difficulties involved in the application of the turbine principle to marine propulsion.

Again, the sheer novelty of the invention may be a bar to its success, at any rate for a while. This was shown to be the fact in the case of *Cross, Beaven and Beadle's Petition* for the extension of their patent for viscose. This substance, which is a soluble form of cellulose, was discovered by the

petitioners, and was a perfectly new material at the date of the patent. Analogy suggested its use at once for several obvious purposes; but there were, besides, many less obvious but important uses, such as the manufacture of artificial silk, to which it was also applicable; and a considerable amount of time had necessarily to be spent before these could be ascertained and the trades in them created.

In addition to the public utility of the invention, the Court will take into account the personal merit of the inventor. He must show that he has taken energetic steps to make his invention profitable and to introduce it into public notice. Ill-health, litigation or lack of funds will, however, be accepted as a reasonable excuse for default in this respect.

Although the merit of importation is admittedly inferior to that of actual invention, there is a precedent for the granting of an extension to a patentee who is only an importer.

The question of what is adequate remuneration is always one of the greatest difficulty. It is almost hopeless to attempt to appraise the value of an invention or to assess, even approximately, the amount of remuneration it deserves. Refusal to grant an extension has in the past usually been based on other grounds than that the remuneration has been inadequate. No universal rule can be laid down. Granting that the invention is meritorious enough to justify extension at all, remuneration to be adequate is bound to be on a fairly liberal scale. Hitherto, £20,000 has been the largest sum held to be insufficient for the inventor's deserts.

In laying his case before the Court, it is the duty of the petitioner to satisfy it as to the actual amount of profit he has realised from his invention. For this purpose he must submit the fullest accounts which it is in his power to

render. Faulty or inadequate accounts have in many cases proved to be the rock upon which the petition has foundered. The rule is that the petitioner seeking the grace and favour of the Crown is bound to strict truth and the utmost candour and frankness. He should therefore put the Court in possession of all the facts, and give a complete history of his dealings with the patent from its inception down to the latest period for which accounts are obtainable. If he manufactures and sells other goods besides the patented article, the accounts should show to what extent his ordinary manufacturing profit has been due to the patent. Profits from foreign patents, profits derived from working by licence and profits realised by the sale or working of subsidiary inventions are all relevant to the inquiry, and should all be fully disclosed in the accounts. The statement must show the profits or losses made year by year. Under the head of expenditure must be shown the actual money expended; estimates will not be accepted. Further, the accounts must be presented in such a shape that it is apparent on the face of them what remuneration the patentee has received in respect of the patent for which extension is sought.

In arriving at the net profit, the petitioner is allowed to include in deductions from gross profits a reasonable amount of remuneration for his own time and labour spent in working and pushing the invention.

The petitioner need not necessarily be the inventor; an assignee or any other person who is for the time being entitled to the benefit of the patent is equally competent to apply for extension. But the Court will only grant an extension to an assignee, where it is assured that the original inventor will directly or indirectly benefit thereby, and where the assignee has assisted the inventor with funds or otherwise in perfecting or exploiting his invention. An extension will not be granted when the original inventor

has died after having made an assignment of all his interest in the patent, so that neither he nor his estate can derive any advantage from the extension.

A company, or any other assignee, who has acquired a patent purely as a commercial adventure, is not entitled to prolongation on the ground of failure to make profits, when the inventor himself could have no legitimate interest in making such an application. But the case is different when, as was shown in *Parson's Petition*, the interests of the inventor are bound up with those of the company, and the company can claim the merit of having assisted in the development and introduction of the invention.

The period for which extension will be granted depends mainly upon the character of the invention. In rare cases an extension of 10 years has been allowed. Thus, in *Stoney's Petition*, where the invention related to sluices and flood gates for controlling the flow of water in canals, the chances of its use being extremely limited and depending in a great measure upon the construction of fresh canals, a long period seemed to be necessary to give the patentee a fair prospect of remuneration. Similarly in the case of *Currie and Timmis's Patent*, which related to the working of railway signals by electricity, an extension of 10 years was granted in view of the great difficulty that always exists in getting an invention of that character adopted, and the certainty that it could only be very gradually introduced and, perhaps, only in the case of new railways.

Seven years has been granted in a few instances, but latterly the longest period of extension, even for such meritorious inventions as the turbine or the discovery of viscose, has been a period of five years. The usual practice in granting an extension is to seal a fresh patent to run for the period allowed.

The costs are entirely in the discretion of the Court. In

the past, the practice has been to encourage fair opposition, in the interest of public policy, by awarding such costs to successful opponents as may be a reasonable contribution to the expenses to which they have been put. They are usually awarded in a lump sum, to be divided amongst the opponents where there are several.

CHAPTER XVIII.

MISCELLANEOUS.

THE PATENT OFFICE.

THE Patent Office is situated at 25, Southampton Buildings, Chancery Lane, W.C., and is presided over by the Comptroller-General of Patents, Designs and Trade Marks, assisted by the Chief Examiner and a numerous staff of examiners and clerks of various grades. It is under the immediate control of the Board of Trade, which from time to time issues Rules regulating the practice of the Office. These Rules, being authorised by Act of Parliament, have the same force and effect as if they formed part of the Act itself. A useful *résumé* of the practice is published by the Patent Office under the title "Instructions to Applicants for Patents."

The routine of the Patent Office, in so far as it directly affects the patentee, has already been discussed in the course of the preceding chapters; for a fuller insight into its inner working the reader is referred to the Comptroller-General's Annual Report, which furnishes a mass of detailed information bearing on the general administration of the Patent Office and the use made of it by the public. From this report it will be seen that, regarded as a lucrative department of the Board of Trade, the Patent Office is an eminently prosperous concern. In spite of its heavy working expenses, considerably augmented recently by extensions to premises and increase of staff, it nevertheless contrives to hand over to the Exchequer a yearly profit amounting

on an average to £100,000. This sum is principally derived from fees paid upon patents, which, in 1906, exceeded £250,000; designs and trade marks in the same year contributing an additional £20,000.

As some misapprehension exists in regard to the scope of the functions of the Patent Office, it may be mentioned here that it does not undertake to give legal advice or opinions in patent matters; to do this would be to encroach upon the province of professional men. Nor will it examine specifications or make searches before an application has been filed. Neither is it within the power of the Comptroller to give pecuniary assistance to enable indigent inventors to obtain patents, or to reduce or remit any of the prescribed fees.

The Office refuses also to recommend any particular patent agent for employment by an applicant.

PATENT OFFICE LIBRARY AND PUBLICATIONS.

Attached to the Patent Office is a free public library, open daily from 10 a.m. to 10 p.m., except on Sundays and Bank Holidays.

In addition to a complete collection of British specifications, supplemented by name and subject-matter indexes and abridgments of specifications, the library contains the full or abridged patent specifications of all the most important foreign countries, also the leading British and foreign scientific journals, transactions of learned societies, and text-books of Science and Art.

In searching for the invention of any particular person, the Name Indexes, published as part of the Illustrated Official Journal of Patents, should be consulted.

Where only the subject-matter of the invention is known, the Abridgment Class and Index Key should be first referred to, to ascertain where the subject-matter is classified in the

Patent Office publications. The whole range of patentable inventions is divided into 146 classes. Having ascertained to which class the invention belongs, the corresponding volumes of Abridgments of Specifications, each of which is furnished with name and subject-matter indexes, should then be examined. In the case of recent specifications for which abridgment volumes have not yet been published, the annual and monthly subject-matter indexes and the Illustrated Official Journal must be consulted.

British specifications can be purchased at the Sale Branch of the Patent Office for the uniform price of 8*d.* each. Foreign and colonial specifications can only be obtained by applying to the patent office of the country in which the patent was granted.

Illustrated volumes of Abridgments of Specifications may be bought for 1*s.* per volume. At present there are ten of these volumes, covering the period from 1617 to 1908, in each of the 146 classes. Anyone wishing to keep himself abreast of the march of invention in his own particular field of work cannot do better than procure and study these Abridgments from time to time as the sections are published

PATENT AGENTS.

Patent agents, properly so called, form a small and well-defined *coterie* of practitioners, qualified to advise inventors in all matters relating to patents. At the beginning of 1907, the total number on the register was 255.

Prior to 1888 anyone, no matter how little qualified he might be, was at liberty to designate himself a "patent agent." In that year, however, an Act was passed prohibiting any person from so describing himself unless he is registered as a patent agent in pursuance of the Act, and making any person who falsely assumes the title of "patent agent" liable, on summary conviction, to a fine, not

exceeding £20. Persons practising *bonâ fide* as patent agents prior to the passing of the Act were entitled to be registered without further evidence of their competence; but subsequently admission to the roll of patent agents has been confined to those who have qualified themselves by passing the examinations prescribed by the Chartered Institute of Patent Agents, an association founded in 1882 and incorporated in 1891. Fellows of the Institute are entitled to describe themselves as "Chartered Patent Agents."

The patent agent's business is to prepare specifications, to act as intermediary between the inventor and the Patent Office in the various stages of application, to make searches for novelty and to advise generally in all dealings with patents. In cases of opposition, he may appear in the Comptroller's Court and argue the matter on behalf of his client. He also usually undertakes, when the patent has been procured, to keep the inventor informed as to the date when the renewal fees fall due.

If the inventor contemplates taking out foreign patents, he should place himself in the hands of a firm that is in communication with reliable agents in the principal foreign countries, through whose instrumentality the applications for foreign patents can be made.

Few applicants for patents can afford to dispense with the services of a patent agent. Care should be taken, however, to select an agent or firm that has had wide experience and, preferably, experience in the particular field of science to which the invention relates.

The inventor should, as a rule, avoid persons who style themselves "patent experts," "inventors' agents" or, in fact, by any other name than "patent agent"; and all persons advertising their services in connection with patents for abnormally low rates should be distrusted.

The charges made by patent agents do not conform, like

solicitors' charges, to any fixed standard. For a scale of the fees that an inventor might expect a firm of good standing to charge for obtaining a complete British patent in a normal case, see p. 238.

The Comptroller may refuse to recognise as an agent any person whose name has been erased from the register of patent agents or who has been guilty of misconduct justifying erasure. This rule applies not only to the case of an agent acting in his individual capacity, but also where he is a member of a firm.

The Comptroller will also refuse to have dealings with any agent residing outside the United Kingdom.

OFFENCES UNDER THE PATENTS ACT.

Any person who falsely represents that an article sold by him is a patented article, as, for example, by stamping it with the word "patent" or "patented," is liable on summary conviction to a fine not exceeding £5 for each offence.

Any person who describes his place of business as "Patent Office," or uses other words suggesting that it is officially connected with the Patent Office, is liable to a fine not exceeding £20. The same penalty attaches to the unauthorised assumption of the Royal Arms by the patentee or others in connection with the sale of a patented article.

"PATENT MEDICINES."

The term "patent medicine," which has in the past been loosely used to signify not only medicine actually protected by letters patent, but also all manner of unpatented proprietary medicines, may not be legitimately used in this sense any longer. Any person representing a medicine as patented when it is not, renders himself liable to a penalty of £5 in respect of each article bearing such false description.

The best way to retain a monopoly in the sale of a nostrum or specific is to keep the prescription secret and to sell it under a registered trade mark.

It should be added that proprietary medicines are subject to a twofold tax. Any person dealing in them must take out a licence (5s. a year), and there is also an *ad valorem* duty levied upon each bottle, box or packet of the medicine sold, in the form of stamps to be procured from the Secretary of Stamps and Taxes, Inland Revenue, Somerset House.

CHAPTER XIX.

FOREIGN PATENTS.

If an invention is worth patenting in England, it is usually worth patenting in one or more foreign countries.

This generalization must, however, be accepted with caution, and the policy of applying for foreign patents very closely scrutinized before the inventor incurs the heavy outlay entailed in patenting abroad on an extensive scale.

But assuming that the policy is unquestioned, the problem that confronts the inventor, namely, how ultimately to *profit* by his foreign patents, is still a perplexing one. The first point to settle is the country or countries in which protection shall be obtained. This must, of course, depend primarily upon the nature of the invention; but there are also other considerations which have to be taken into account, *e.g.* the commercial status of the country, its established industries, its trade connections and so forth.

Indiscriminate patenting in all the principal countries is, as a rule, sheer waste of money. Of the forty odd countries (exclusive of British colonies) which grant patents at the present time, those which are of any value to the English inventor from a commercial point of view are comparatively few. The statistics disclosed in the Comptroller-General's Annual Report, showing the number of applications for patents emanating from various foreign countries, afford a very fair indication of the commercial activity of these countries respectively and their enterprise in regard to patents. Ranked according to this criterion, the following

are the first ten countries which should engage the inventor's attention.

The United States of America, Germany and France stand out as pre-eminently the most important; then follow Austria-Hungary, Switzerland, Belgium, Italy, Sweden, Russia and Denmark. Amongst British colonies, Australia, Canada and New Zealand, as a rule, present the most hopeful field for patent exploitation. The staple and established industries of a country are also very relevant matters for consideration. For, where the invention relates to an industry or manufacture already carried on in that country, or there is demand for the patented article already existing, negotiation of the patent is comparatively simple, provided its utility is easily demonstrated or its success has been proved elsewhere. But to establish new industries and create a new demand in a foreign country is an undertaking which few inventors, occupied as they presumably are with the same task at home, find themselves able to cope with successfully.

But even though a country offers no prospect of working the invention successfully on the spot, either through lack of materials or because of other adverse local conditions, it should not be at once dismissed from the mind as unprofitable from a patenting point of view.

It may still be expedient to take out a patent there, simply for the sake of securing a close market for the importation of the patented article from a neighbouring country, where the facilities for manufacture are greater.

An improved process for making cement may, for instance, be well worth protecting in a country entirely devoid of the materials for cement manufacture. It is true that a patent used merely as a pretext for importation and not worked in the country is generally liable to forfeiture after three years, but in some cases the advantage reaped during the three years of grace may still

be sufficient to give an abundant return for the expenditure on the patent. Moreover, even after the forfeiture of a patent in such a case, there is nothing to hinder the inventor from continuing to import. For if he has not a monopoly, he has, at least, the assurance of an open market for importation. On the other hand, the almost inevitable consequence of his neglect to patent the invention himself will be that someone else will patent it to his prejudice.

Again, the selection of the countries in which patents are to be applied for must be guided, in some measure, by the plan upon which the inventor intends to dispose of them when obtained. Patents are sometimes disposed of to best advantage by offering them in *groups*; this is particularly the case with inventions relating to articles of international commerce, or where the market is controlled by a trade combination comprising, maybe, manufacturers of different nationalities. Hence, in determining the countries in which protection will be sought, it is very desirable to take a preliminary survey of the ramifications of the trade under consideration, and the commercial relationships of the principal firms or companies engaged in it.

A French manufacturer, for example, who imports into Belgium and Spain will naturally be anxious to acquire the Belgian and Spanish rights as an adjunct to the French patent, in order, as far as possible, to cover the whole area of his market. On the same principle a Canadian patent, though perhaps valueless for the purpose of exploiting separately, is often of considerable value as a supplement to the American rights. Similarly, the closely interwoven commercial interests of the Germanic countries make it advisable, as a rule, when a German patent is applied for, to protect the invention also in Austria and Hungary, and to dispose of these patents *en bloc*.

The negotiation of foreign patents is too vast a subject to be adequately discussed in these pages; there is, however,

one observation directly arising out of the foregoing illustrations which may be added with advantage. The inventor must not fall into the mistake of selling his rights for any one country without carefully considering the effect it will have on his patents in other countries. This precaution is needed especially in dealing with inventions relating to articles in which there is a large international trade. For a manufacturer will not, as a rule, purchase a new machine or a new process unless he can use it throughout his manufacture, both for foreign markets as well as for his home trade. If, therefore, the overhasty disposal of one or more of the less important foreign patents has had the effect of closing the markets in those countries to the prospective purchaser of the patent in another, perhaps more important, country, so that the latter, should he acquire the patent, can only employ the invention for that portion of his output which finds its market at home, that will seriously damage the value of the patent, if it does not destroy its chance of sale altogether. In dealing with inventions of this character, the inventor's wisest policy is generally not to sell the patents outright, but to grant an exclusive right of manufacture to the principal manufacturer in each country together with a general licence to import, use and sell the product or manufactured article under the patents in the various countries to which his trade extends.

Since the adhesion of practically all the important countries to the International Convention, the application for foreign patents is not now a matter of such urgency as it was formerly. The inventor can act with more deliberation. He has a space of twelve months from the date of filing his application at home for considering the policy of protecting his invention abroad, and, in the meanwhile, he may publish and use it to any extent without prejudicing his claim to a patent in any of the countries belonging to the Union.

Another point which naturally weighs with the inventor, in considering the application for foreign patents, is the cost of obtaining the patent and of keeping it alive. Besides the bare fees payable to the patent office, there are, of course, the patent agent's charges for preparing the specification in a foreign language to be taken into account. A list of charges such as would be normally made by a firm of good standing for obtaining a complete patent in the more important countries is given in the Table at the end of Chapter XX.

In many countries the patent office refuses to hold communication with a foreign applicant except through the medium of a representative domiciled in the country; this is the rule, for instance, in Germany. But even in countries where there is no legal requirement to this effect, it is advisable to deal with the foreign patent authorities through such a local agent. English firms of patent agents are, as a rule, in touch with competent and responsible representatives in various foreign countries, through whom the application may be made, and all subsequent business with the patent office transacted.

But it is often desirable to employ these foreign agents as something more than a mere conduit pipe of communication with the foreign patent office. They naturally have a more intimate knowledge of the idiosyncrasies of their own patent laws than many English patent agents can be expected to possess, and much time and expense would often be saved if they were given a freer hand in the drafting of the specification and claims so as to meet the requirements of their own peculiar practice.

This suggestion is particularly pertinent with reference to applications in Germany and America, where the ideas of what constitutes good subject-matter for embodying in a single application, and the form in which it should be claimed, differ as widely from the English view as they do

from one another. For instance, in the case of a German application, instead of sending a copy of the English specification with claims cut and dried for translation and filing, the inventor would do well to transmit to the German agent through his English agent a full scientific description of the invention, indicating its novel features and emphasizing the salient points desired to be covered by the claims. With this material before him the German agent could, assuming him to be competent in his profession, draft a specification and claims in accordance with the requirements of German practice. The draft would of course be returned to the English agent for correction and approval. An application framed in this way would run far less risk of encountering the numerous objections from the German Office that so frequently form a stumbling block to the British applicant and occasion him unnecessary expense and annoyance.

Compulsory working clauses appear in nearly all the foreign patent codes, the United States being a notable exception. The prescribed period within which the invention has to be put into operation differs in various countries. In France and Italy it is two years from the granting of the patent; in Belgium it is one year from the commencement of working abroad. On the other hand, Clause III. of the Protocol to the International Convention, as amended by the Act of Brussels in 1900, stipulates that no patent shall be revoked for non-working until after the expiration of at least 3 years from the date of application. The British inventor, therefore, owning patents in France, Italy or Belgium can avail himself of the greater latitude allowed by the Convention in spite of the domestic laws of these countries. The danger of revocation, however, for non-working is not very serious, provided the patentee has honestly endeavoured to get his invention worked and has not used it simply as a means for retaining a close market for goods manufactured

and imported from abroad. A patentee, who has tried and failed to get his invention worked, should place the fact on record by advertising or otherwise publicly signifying his willingness to sell the patent or to grant licences on reasonable terms. Working by advertisement, as this proceeding is sometimes called, is extremely common and reduces compulsory working to a very simple matter. All the patentee has to do is to instruct the foreign representative to insert the necessary notices in suitable trade journals at a reasonable time before the expiry of the prescribed period. The cost is usually from £5 to £10 in each country.

The advertisements should of course be preserved and their insertion officially certified, in case they may be needed in future revocation proceedings.

THE INTERNATIONAL CONVENTION.

The importance of the International Convention, in its bearing upon the rights of inventors seeking protection in foreign countries, calls for a somewhat more detailed account of its scope and provisions than has hitherto been given.

The "International Convention for the Protection of Industrial Property" was ratified at Paris in 1884. It has since been amended and supplemented by the Act of Brussels (1900) which came into force in 1902. Amongst the countries appearing as original signatories to the Convention the most notable, besides Great Britain, are Belgium, France, Italy, Portugal, Spain and Switzerland. The following countries, with the omission of a few States of minor importance, have subsequently become members of the Union:—Norway and Sweden (1885), United States of America (1887), New Zealand (1891), Denmark (1894), Japan (1899), Germany (1903), the Commonwealth of Australia (1907). A complete list of the Convention States is given at p. 239.

The aim of the contracting States is to safeguard the rights of owners of patents, trade marks and designs in foreign countries, and as far as possible to co-ordinate and assimilate in certain respects the working of the various patent systems. The provisions affecting the rights of patentees are contained in the first five Articles; the remainder are mainly concerned with trade mark rights.

Articles II. and III. stipulate in general terms that in all matters relating to patents, trade marks and designs, equal and impartial treatment shall be accorded to citizens and foreigners, provided the latter are subjects of a contracting State or are domiciled or have *effective and serious* industrial establishments in the territory of one of the States of the Union. Article IV. gives the inventor a period of 12 months from the date of his first application, within which to apply for a patent in any other of the contracting States, without suffering prejudice by reason of publication in the interim. The English law is brought into conformity with this requirement by s. 91 of the Patents and Designs Act, 1907.

The form of application, required by English practice to entitle a foreign patentee to this privilege, has already been discussed in a foregoing chapter (p. 88).

Each country has its own regulations. In France and Belgium the privilege need not be specifically claimed and no special form of application is required; it is desirable, however, at any rate to refer to the previous application. In Germany and Italy, on the other hand, the claim to priority must be specifically made and the date of application officially certified.

According to English practice an application under s. 91 must be in the name of the foreign patentee; in other countries, however, at least in those that entertain an application by an assignee, the assignee of the foreign patentee has an equal right to claim priority under the

Convention. Article IV. provides that patents asked for in the different contracting States by persons admitted to the benefit of the Convention shall be independent of patents obtained for the same invention in other States, whether adherent to the Union or not. Hence a French patent or a Belgian patent of importation, granted to a British subject, will not expire upon the lapse of the corresponding British patent, but continue to the full extent of the original term.

Article V. states that the introduction by the patentee into the country where the patent has been granted of articles manufactured in one or other of the States of the Union shall not entail forfeiture. The patentee, however, remains subject to the obligation to work his patent in conformity with the laws of the country into which he introduces the patented articles. And where, as in Germany, the patentee is deemed not to have fulfilled this requirement, unless the bulk of the patented article consumed in Germany is manufactured by German labour, importation on a large scale would be considered inconsistent with the adequate discharge of this obligation, and thus, in an indirect way, might lead to the forfeiture of the patent.

The Convention is supplemented by a Protocol which, as amended by the Act of Brussels, provides in Clause 3^b, that a patentee shall not suffer revocation by reason of non-working until the expiration of the minimum term of 3 years from the date of application, and then only if he fails to justify the cause of his inaction.

As has already been pointed out, the provisions of the Convention conflict in several respects with the domestic legislation of the various countries belonging to the Union. Considerable misapprehension seems to exist as to the effect of this conflict, and the question whether an applicant can safely rely on the Convention in defiance of the internal

law of the country is treated as a moot point. The answer, however, appears to the writer to be tolerably plain. So long as a State remains a party to the Convention, it is bound by the terms of the Convention. To withhold the protection accorded by international agreement would constitute a grave breach of international obligation. It is true that there is no legal sanction to enforce the observance of these obligations, but the refusal by a contracting State to extend the full privileges secured by the Convention to any person entitled to claim them would at least involve the antecedent withdrawal of that State from the Union; and this can only take effect, according to Article XVIII., after the lapse of one year from the date of renunciation.

An International Office in connection with the Convention has been established at Berne in Switzerland, and publishes a monthly periodical entitled *La Propriété Industrielle*, which furnishes a comprehensive review of the changes that occur from time to time in the patent laws of various countries, and useful notes upon legal decisions of international interest.

CHAPTER XX.

FOREIGN PATENT LAWS.

UNITED STATES OF AMERICA.

Term of Patent.—The term of a patent for the United States of America is seventeen years reckoned from the date when the patent is issued. Patents granted prior to 1898 expire at the expiration of the term of a previously granted foreign patent for the same invention, or, if there is more than one foreign patent, with the expiration of the term of the one having the shortest term. Patents granted since 1898 are unaffected by the prior expiration of foreign patents.

Subject Matter.—Subject to certain conditions as to prior publication, a patent will be granted to any person, whether citizen or alien, who is the original inventor of “any new and useful art, machine, manufacture or composition of matter or any new and useful improvement thereof.” This enumeration of patentable inventions may be taken to include everything that would constitute good subject matter for an English patent.

Who May Apply.—The applicant must be the *original inventor* in the strictest sense of the word; hence the importer of an invention cannot make a good application. To establish his claim to originality, the invention must be one which was not already *known or used by others in the United States, or patented or published in print there, or elsewhere, prior to the date when the applicant first conceived his invention in a practical shape.* This rule, it will be

observed, differs in two important respects from the British law, according to which latter (a) the invention need only be novel within the realm, and (b) novelty is destroyed by publication even by the inventor himself at any time before the date of application.

Prior Publication of Invention.—In the United States, however, assuming the applicant to be the original and true inventor, a limited amount of publication preceding the application does not debar him from subsequently obtaining a patent. The extent to which an invention may be published by foreign patent or otherwise prior to application, without prejudicing the inventor's right to a patent, may be summarised in the following rules.

The original inventor can obtain an American patent provided his invention has not been—

(a) used or sold in the United States by himself or others for more than *two* years prior to his application,

(b) nor published in print in the United States or elsewhere by himself or others for more than *two* years prior to his application,

(c) nor patented elsewhere by himself more than *twelve* months before his application, unless in such case the United States patent issue before the foreign patent is granted,

(d) nor patented elsewhere by others more than *two* years before his application.

It will be observed that provision (c) brings the United States law into conformity with the terms of Article IV. of the International Convention, as amended by the Brussels Act of 14th December, 1900.

Since, according to the British law, a patent bears the date not of issue but of application, a British patentee, desiring an American patent, should lodge his petition within twelve months after his application in England. If this limit is overstepped by a month or so, it might still be

possible to obtain a United States patent, provided the British grant could be deferred until the United States patent is issued. But owing to the extreme dilatoriness of the United States Patent Office, and the impossibility, except when the grant is opposed, of getting the sealing of the British patent deferred beyond fifteen months from the date of application, this cannot be looked upon as a practicable plan. A collusive opposition instituted for the purpose of delaying the sealing of the British patent would probably result, if detected, in the refusal of the Patent Office to seal it at all.

Date of Patent.—Although in the United States a patent granted upon a convention application is not antedated as in England, yet for the purpose of protecting the applicant against the effect of prior publication, the United States application is deemed to be contemporaneous with the foreign application. If an inventor dies before applying, the right devolves upon his executors and administrators in trust for those entitled at law or under the deceased inventor's will.

Joinder of Inventions.—The practice of the United States Patent Office with regard to the joinder of similar inventions in one specification is very stringent. The rule of the Courts is that where the inventions are kindred and auxiliary, and capable of being used in connection with each other and to serve a common end, they may be embraced in a single specification. But in order to facilitate the task of examination and classification, the Patent Office has adopted a stricter practice, prohibiting the joinder, for example, of a process and a product in the same patent unless they are to such an extent inseparable, that the existence of one is dependent upon the other. A process may be joined with its inevitable product or with the apparatus by which it alone can be performed.

The following statement may be regarded as authoritative

on this point. "If the machine and manufacture are so related that the former cannot operate without producing the latter, and the latter can only be produced by the former, both may be united in one patent; but this is an exception to the general rule which forbids the joinder of the machine and its product in one application. The same rule applies in the case of a process and its product." Similarly, if an inventor has devised two pieces of mechanism, the Patent Office Rules require a separate application for each machine unless one cannot be regarded as an operative instrument without the other.

Claims.—The United States style of claiming clause is distinctive, and certain strict rules have to be observed to conform with the practice of the Patent Office in this respect. Thus "functional" claims, such as the German practice requires, are inadmissible. The invention must be described and claimed not in terms of its operation, but according to the construction of the article and the arrangement of its parts. This principle is responsible for the peculiar style of claiming clause in vogue in the United States, framed upon what is usually known as "the house that Jack built" pattern, according to which the claims proceed cumulatively, each claim introducing a single additional feature of construction until the whole invention has been covered.

Where, for example, the invention depends upon a combination of several elements, A, B, C and D, of which A is the principal novel feature, a series of claims will be employed, each covering a distinct combination of A with one or more of the other elements. The view prevails in the United States that an invention is not sufficiently protected unless every possible combination is specifically claimed and every contingency provided for. This naturally leads to a great multiplicity of claims, so that in cases of complex inventions, specifications have sometimes been

filed containing over a hundred claims and patents granted thereon.

Further, the Patent Office requires that each claim shall be precise and complete in itself. Hence, individual claims containing alternatives are not allowable, nor may elements be imported into a claim by reference to the specification or to another claim. It should be observed that in the United States the invalidity of one or more of the claims does not, as in English law, vitiate the entire patent.

Drawings.—The rule with regard to drawings is that when the nature of the case admits of drawings the applicant must furnish them. The specifications of inventions quite unsuited for illustration may, nevertheless, be required to be accompanied by drawings, for the question is not whether the invention can be understood without drawings, but whether it is capable of being illustrated. Specimens and models must be furnished if required by the Patent Office.

Application.—The fee payable on application is \$15.

The specification must be signed by the applicant and attested by two witnesses, and must be accompanied by an oath of inventorship sworn before a diplomatic or consular officer of the United States, or before a notary public, judge or magistrate who has an official seal and is authorised to administer an oath. When the oath is taken before a notary, judge or magistrate, his authority must be certified by a United States diplomatic or consular officer. This oath, besides affirming that the applicant is the original and true inventor, should state in what other countries he has applied for or obtained patents, giving the dates of the applications or patents.

Issue to Assignee.—Though an application can only be made in the name of the original inventor, the applicant can, by lodging a short assignment, cause the patent to issue in the name of himself and an assignee, or of an assignee alone.

A British inventor can deal directly with the United States Patent Office, but he will do best to appoint an agent in the United States to act for him.

Examination.—The application must be completed and prepared for examination within a year after filing; otherwise it is regarded as abandoned. The application being complete, the specification is in due course subjected to examination, and an exhaustive search is made, ranging through the patents and scientific publications of foreign countries as well as those of the United States.

When, on examination, a claim for a patent is rejected for want of novelty or on the ground of some formal defect, the Commissioner notifies the applicant, giving him briefly the reasons for rejection and such information as may enable him to amend and renew his application. If the applicant persists in his claim without alteration, the Commissioner orders a re-examination of the case. If the decision is still adverse, the applicant has a right of appeal to the examiners-in-chief and thence to the Commissioner, and finally to the Supreme Court of the District of Columbia.

Interference.—Whenever an application is made which, in the opinion of the Office, would interfere with any pending application or with any unexpired patent, the Commissioner gives notice to the parties and directs the primary examiner to proceed to determine the question of priority of invention. This proceeding is somewhat analogous to an English case of opposition, the issue being, however, as to priority in conceiving the invention, not in applying for a patent for it. Where the applicant is a foreigner, and he is put in interference with a citizen of the United States, he is at a disadvantage, since he must show that the date when he disclosed his invention in the United States antedates the conception of the rival United States applicant. In cases of interference the applicant's right of appeal formerly

terminated with the Commissioner, but now extends to the Supreme Court of the District of Columbia.

Allowance and Issue.—Having passed safely through the ordeal of examination, the patent is “allowed,” and will issue upon payment by the applicant of the final fee of \$20; this he must pay within six months after receiving notice of allowance. In the event of the applicant’s failure to pay this fee within the time limited, anyone interested in the patent may, within two years after the date of allowance, adopt and prosecute the application to its issue. In such a case the Patent Office requires the payment of a fresh application fee.

After payment of the final fee, no further taxes whatever are payable. When the patent is granted, the specification is printed and copies can be obtained for a small sum.

Caveat.—An inventor who has not completely worked out his idea in detail, but is anxious to record his claim for a patent at the earliest possible moment, may lodge a caveat at the Patent Office. A caveat is in the nature of a provisional specification, and is filed in the “confidential archives” of the Office and preserved in secrecy for one year. This does not afford the same protection as a provisional specification filed with an application in England; the caveator is, however, entitled to notice if an application is received by the Patent Office for a patent covering what appears to be substantially the same subject matter. The application is withheld from examination, and the caveator has three months in which to prepare and file his full specification. If the inventions prove to be identical, a patent is sealed to the inventor who can establish priority; otherwise the applications proceed in the ordinary way.

Assignment.—Patents are assignable by an instrument in writing; but an assignment is void against a subsequent purchaser or mortgagee unless recorded in the Patent Office within three months.

Marking of Patented Articles.—Patented articles must be marked with the word “patented,” together with the date of the patent, either on the article itself or on the package; otherwise no damages for infringement can be recovered, except on proof that the defendant was duly notified of infringement and persisted in infringing after such notice.

Importation of patented articles from abroad does not invalidate a patent, and there are no conditions compelling the patentee to work his invention in the United States.

Prolongation of a patent can only be obtained by Act of Congress.

GERMANY.

Germany grants patents to its subjects and to foreigners alike; but, where the applicant is not resident in the country, he must appoint a representative residing in Germany to act on his behalf in all dealings with the Patent Office.

Kinds of Patents.—German patents are of three denominations:

- (1) Patents for original inventions
- (2) Patents for improvements,
- (3) Patents for “useful models.”

These will be dealt with in order.

Patents for Original Invention.—All inventions susceptible of industrial use are patentable, with the exception of:

- (1) Inventions which are contrary to law and public morals,
- (2) Inventions relating to articles of food, whether for nourishment or luxury,
- (3) Medicines,
- (4) Substances produced by chemical processes, in so far as the invention does not relate to a distinct process of manufacture.

Term of Patent.—The term of the patent is 15 years.

reckoned from the day after the application is lodged, and is unaffected by the prior expiration of foreign patents. No prolongation is allowed.

Novelty.—The invention must be new. It will not be considered new if it has been described in a printed publication in any country during the 100 years last preceding the application, or has been so publicly used within the realm, that an expert could carry out the alleged invention without exerting any inventive faculty. Invention will not be found if the method employed to achieve an old result is the mere logical deduction from what was well known to those conversant with the art, unless the new method reveals some unexpected commercial or industrial superiority over the old. Although, to amount to an anticipation, the printed publication need not have been actually introduced into Germany, it must be of such a character, *e.g.*, a foreign patent specification or a well-known scientific or technical journal, that it may be regarded as being within the knowledge of the German public.

Secret use of a process or manufacture in Germany will not debar its being subsequently patented, but the patent so granted will be of no effect against a person who at the time of the application was already using the invention. Germany now being a party to the International Convention, publication consequent on a patent application in a foreign country, also belonging to the Convention, will not prejudice the German application, provided it is lodged within twelve months of the foreign application (or the earliest of several foreign applications).

Applicant.—The person who first applies for a patent is entitled to the grant. He need not necessarily be the inventor. Anyone who is legitimately possessed of an invention answering to the above conditions may apply for a patent. But if the applicant has appropriated the invention of another without his consent, the latter can oppose

and lodge a rival application, and if successful he can demand a patent dated as of the day preceding the publication of the prior application, provided he made his application within a month of the decision.

Specification.—The application, which must be in the German language, has to be accompanied in the usual way by a specification and drawings. The specification may embrace only one invention; and an invention is only regarded as being one and indivisible if it is governed by a single inventive idea; otherwise the novel features are considered as “aggregated,” not “combined,” inventions. This differs widely from the American view according to which a single application will suffice, if the *embodied* invention is one coherent thing with co-operative parts.

The specification should be framed so as to bring out as prominently as possible the technical effects and scientific features of the invention, as the Patent Office, consisting of men more conversant with the theoretical than the practical side of science, is apt to lay greater stress upon the originality and ingenuity of the invention than upon its commercial or industrial advantages.

Claims.—The specification must conclude with one or more claiming clauses. German practice is, however, opposed to multiplicity of claims; the theory of the Patent Office being that a single invention (for no application can comprise more than one invention) is capable of being claimed in a single clause. Hence the applicant should frame a broad functional claim, describing and claiming the means employed to compass the desired end. This may be followed by one or more constructional claims embodying, as generically as possible, the principal features of the invention in their organic combination. Supplementary claims are allowed only in so far as they are embraced within or constitute a modification of the fundamental invention, and they should refer to the main claim

specifically. Product claims are not allowed when the product is merely the characteristic result of the process already covered by a claim; nor are they necessary, for in Germany a process claim protects the product made directly by that process.

In the case of mechanical inventions, models are sometimes required, and in the case of chemical processes, specimens of the product.

Modifications can be introduced at any time prior to publication.

Application.---The fee payable upon application is 20 marks. When the applicant does not reside in Germany, he must employ a resident agent, duly authorised by power of attorney and registered in the Imperial Office.

As soon as the application is filed, it is subjected to examination on the score of novelty and patentability. If defective in point of form or open to objection on the ground of prior publication, the papers are returned to the applicant with a request for amendment or reply within a stated time. If no reply is made within the prescribed time, the application is considered withdrawn. If the applicant amends or meets the objections, the case is re-considered, and, should the application still be unsatisfactory, this procedure may be repeated until the Office has before it all the information and material for consideration that can be brought to bear upon the case. The department of the Patent Office concerned with applications then gives its final decision. If this is unfavourable to the applicant, he may appeal to the Appeal Department. Assuming the decision of the Patent Office to be favourable and that it considers that the grant can be allowed, it notifies the applicant that his application is ready for publication, whereupon the invention is provisionally protected against infringement.

Publication will, at the request of the applicant, be

deferred for three months and in special cases for 6 months from the date of such notification. For two months after publication the application is open to public opposition; and within this same time the applicant must pay the first yearly tax of 30 marks. In the event of the application being successfully opposed, this tax will be refunded. After the two months have expired, the patent is finally allowed and issued to the applicant. The specification is printed and copies can be purchased for a small sum. To sustain the patent, yearly renewal fees must be paid: 50 marks for the second year; 100 marks for the third year, and so on, the fees rising by annual increments of 50 marks. These taxes must be paid before the anniversary of the date of the patent, but six weeks' grace is allowed without penalty, and a further six weeks upon payment of a fine of 10 marks.

A patentee, who proves lack of means, can obtain postponement of the payment of the taxes for the first and second year until the third year, and if the patent is then dropped, these taxes will be entirely remitted.

Patent of Addition.—If the invention relates to the improvement or further development of an invention already protected by a patent in favour of the applicant, he can apply for a patent of addition upon which it is only necessary to pay the filing fee and the first annuity. The patent of addition has a term corresponding with the residual term of the parent patent and, if the latter is allowed to lapse, will expire with it. But in the event of the principal patent being annulled, the patent of addition survives and becomes an independent patent, upon which renewal fees are payable. In such a case its duration and the date on which the taxes fall due will correspond with the duration and date of the principal patent, but the amount of the taxes payable on a surviving patent of addition is determined by the date of its own commencement.

Patent for Useful Model.—This form of patent is applicable to inventions the novelty of which consists in some new form or shape or arrangement of well-known elements, but which does not possess the requisite degree of ingenuity to warrant the grant of a full patent. The term for a patent of this kind is three years, extensible to six years in all. There is no examination as to novelty before the grant of this form of patent.

Where the invention is of this description, and can boast of no “notable new technical effect,” but merely a more convenient arrangement of parts, the inventor will be well advised to apply for a patent for a useful model in the first instance instead of trying to obtain a full patent, which after a long and expensive fight may have to be given up.

Annulment.—A patentee is liable to have his patent declared null on the following grounds:—

- (1) That the subject matter was not patentable, either because it does not fall within the category of patentable inventions or because it lacked novelty at the date of application. (This objection can only be raised within the first five years of the life of the patent.)
- (2) That the invention forms the subject of a patent of prior date. (This objection may be raised against a patent at any time by any person.)
- (3) That the essential features of the invention have been fraudulently taken from the work of another inventor. (This ground of objection is only open to the person aggrieved.)

If the patent is found to be defective only in a partial degree on any of the above grounds, its scope will be limited to a corresponding extent.

Revocation.—A patent can be revoked at the end of three years from the date of the official publication of the grant if—

- (1) The patentee neglects to put the invention into

practice within the realm to an adequate extent, or at any rate fails to do all in his power to ensure the attainment of that object.

- (2) If it appears in the interest of the community that licences should be granted, and the patentee declines to grant them for reasonable compensation or adequate security.

If the patentee is unable to comply with the requirements of actual working in Germany, he should instruct his representative to advertise in suitable trade journals his willingness to sell the patent or to grant licences under it upon reasonable terms, and he should repeat this as often as possible until the invention is actually being worked. The necessary amount of advertising can usually be carried out at the cost of about £5 each time.

The German patent law is designed to promote industries on German soil and to give employment to German workmen, and in interpreting the rules for the compulsory working of patented inventions this object is kept clearly in view.

Importation does not directly entail forfeiture; there is no provision of the German law to this effect, and indeed such a provision would violate Article V. of the International Convention, if the imported articles come from a country which is a party to the Convention; but if the importation of patented articles from abroad is carried on to such an extent as to interfere appreciably with the domestic manufacture, that is considered by the Courts a good ground for revoking the German patent. It should, however, be added that importation, over which the patentee has no control and for which he is not directly or indirectly responsible, will not endanger the validity of his patent.

Infringement.—Infringers who knowingly infringe can be proceeded against for damages, or can be punished by a fine not exceeding 5,000 marks or by imprisonment not exceeding

one year. The Court may award damages, in addition to the penalty, up to 10,000 marks.

FRANCE.

Patentable Invention.—A patent of invention may be obtained in France by an applicant, whether he be a French citizen or a foreigner, who is the inventor or is entitled to assume the rights of inventor of (1) a new industrial product or (2) a new method of manufacture or a new application of known methods. Excluded from the category of patentable inventions are:—pharmaceutical compounds, medicines, financial schemes or systems of business, and inventions contrary to good morals.

Novelty.—The invention must be new in the sense that it has not been published in France or abroad, prior to the date of application, to such an extent as to enable a competent person to carry it out in the light of such information. France being a signatory to the International Convention, an inventor, who has already applied for protection in Great Britain or any other Convention country, can claim a priority of 12 months in accordance with the provisions of Article IV. If the applicant desires to avail himself of this privilege, the previous foreign application should be specifically referred to.

Term of Patent.—Patents of invention are granted for 5, 10 or 15 years, the term of the patent being reckoned from the filing of the application. According to the Statute law of France, the term of the French patent is dependent upon and expires with a previously obtained foreign patent or that one of several which has the shortest term; this rule, however, must be taken as superseded, in the case of patentees entitled to claim the benefit of the Convention, by the stipulation, assented to by the contracting States, for the *independent* duration of patents in different countries of

the Union. Prolongation can only be obtained by a special act of the legislature.

Taxes.—The patent is subject to a yearly tax of 100 francs payable in advance. A receipt showing that the first year's tax has been paid must accompany the application. Beyond this instalment of the yearly taxes, no other Government fees are payable, in the ordinary course, to obtain the grant of the patent. Subsequent taxes fall due on the anniversary of the date of application. 'Three months' grace is allowed within which to make payment, a fine of 5 francs being levied for each month that the tax is overdue.

Patents of Addition.—Besides patents of invention the Government grants *certificates of addition* for improvements upon or modifications of the original invention. This form of patent only requires the payment of a single tax of 20 francs. It expires with the parent patent, no matter whether the latter is annulled or lapses from any other cause.

The owner of the parent patent is entitled to a certificate of addition in priority to any rival applicant, provided he applies for it within a period of twelve months from the date when his original patent was granted; during that period he has a paramount right to patent improvements on his own invention. No other applicant can obtain a valid patent for an improvement until after the expiration of 12 months. A rival inventor can, however, lodge an application during that period with the specification in a sealed packet, accompanied by the request that it shall not be opened until the 12 months have expired. When that time arrives, the seal is broken and, if the application is in order, the patent will be granted, but subject always to any application which may have been lodged in the meanwhile by the original patentee.

Application.—The application is addressed to the Minister of Agriculture and Commerce and must be accompanied by a receipt for the first year's tax and by the specification (in French) and drawings in duplicate.

The regulations regarding the form in which these documents should be presented are exceedingly precise and must be closely followed. The specification must conclude with a *résumé*, containing a succinct statement of the fundamental principles of the invention, and of any secondary features that characterise it. Claims are not recognised as having any legal significance. The scope of the invention is determined from the specification itself. If the applicant is a foreigner, he should appoint a specially authorised agent in France. As soon as the application is deposited, it is examined to see that it complies with formal requirements, but there is no examination as to the novelty or merit of the invention or the accuracy of the specification. If any irregularity is found, the applicant is notified and given an opportunity of explaining or arguing his case before the technical committee. If a patent is refused on the ground of irregularity, half the tax will be returned. An application may be withdrawn within 2 months from the date of filing, in which case the whole tax will be refunded.

If the application is in order, it is allowed; and the applicant is thereupon notified of the number and date of his patent, and the specification is printed and copies can be purchased for a small sum.

Before publication, proofs of the specification are submitted to the applicant, who has 3 months within which to make corrections. When once a patent has been granted, it is incapable of amendment.

Issue of Patent.—The issue of a patent, which usually takes place six or nine months after application, can by request be delayed till one year from the date of application, but this benefit cannot be claimed by those applicants who avail themselves of Article IV. of the Convention.

The law expressly states that patents are issued without any guarantee as to the genuineness, novelty or merit of

the invention. In token of this, if the patent be mentioned, the words *sans garantie du Gouvernement* must be added, these words usually being represented by their initials "S.G.D.G."

Annulment.—A French patent is liable to be annulled if the invention lacks novelty or covers matter not patentable under the law, or is not sufficiently described in the specification, or if the title is misleading, or if the patentee is neither the actual inventor nor entitled to assume the inventor's rights (*ayant droit*).

Working.—A patent is liable under the Statute law to be revoked if the patentee does not work his invention in France within the period of two years from the date of the signature of the patent, or if he ceases to work it during two consecutive years, unless a good reason for such inactivity can be advanced. But a patentee who can claim the benefit of the Convention presumably runs no risk of forfeiture for non-working until the lapse of three years from the date of grant.

If the patentee is unable himself to work the invention in France, and fails to induce others to take it up and work it within the prescribed period, he should cause advertisements to be inserted in some suitable technical journals and in one or more of the principal daily papers, notifying the public that he is willing to dispose of his patent rights or grant licences upon reasonable terms. The insertion of these advertisements together with any results in the way of answers should be officially certified in case they may be required as evidence in future proceedings for revocation. These advertisements should be repeated as often as possible, at any rate each two years, until the invention is in actual work. The cost of working by advertisement in France is usually about £10.

Importation.—Importation into France of articles made abroad, similar to those covered by the French patent, is

also a ground of forfeiture, unless they are introduced from a country which is a party to the International Convention.

This exception in favour of Convention countries is now so wide as to reduce the rule to comparative unimportance. In cases, however, where the rule still applies, special authorisation may be obtained from the Minister of Commerce and Industry for the importation of (1) models of machinery or (2) models of objects for official exhibitions.

In reference to the attitude of France towards the International Convention, it has already been noticed that in two other important matters besides that of importation, viz., (1) the dependence of French patents upon the duration of foreign patents and (2) the period within which the invention is required to be worked, the French domestic law conflicts with the international law as embodied in the Convention. In the foregoing pages the opinion has been expressed that an applicant belonging to one of the States of the Union is entitled to rely on and take advantage of the provisions of the Convention, in spite of the internal law of France and notwithstanding the application was not initially ear-marked as a Convention application. This view appears to be justified not only upon principles of international law, but to be borne out by judicial pronouncement in a case recently decided in the French Courts. The case, it is true, decided a different point, but the view stated above follows as an *a fortiori* inference from that decision. In an action for infringement brought by the owners of a French patent for an invention relating to the manufacture of carbide of calcium, the defendants raised by way of defence the plea that the plaintiffs' patent was invalidated by reason of the patentees having imported into France carbide of calcium manufactured in Italy. The contention of the defendants was that the plaintiffs, being domiciled Frenchmen, could not avail themselves of the privileges of the

Convention, which, it was argued, contemplated importation only by a foreign patentee. The French Courts decided that the Article of the Convention relating to importation makes no distinction between *French* patentees and *foreign* patentees, and that to read any such distinction into it would be to misconstrue the character of the Convention, the terms of which are general and "give in the common interest the same rights to all persons belonging to the Convention."

This decision has since been endorsed by the enactment of June, 1906, declaring that French subjects may claim the application in their favour, in France, Algeria, and the French colonies, of provisions of the International Convention in all cases where these provisions are more favourable than the French law for protecting patent rights, and especially in connection with the claim to priority and compulsory working of patents.

Infringement.—Infringement is punished by a penalty varying from 100 to 2,000 francs; if the infringement is repeated, the delinquent may be imprisoned. This penalty is exacted without prejudice to the patentee's claim for damages actually sustained.

TABLE OF COST, ETC., OF FOREIGN PATENTS.

The following charges include the cost of specifications, translations, drawings; notarial, consular and government fees; first year's tax (where annual taxes are payable), and agency charges at home and abroad for ordinary cases, where the specification is not of unusual length or the drawings numerous.

Country.		Term of Patent.	First Cost.	Taxes payable subsequent to grant, including agency at home and abroad.	Conditions as to Working.
Argentine Republic		5, 10 or 15 years	10 years .£45	.£4 10s. annually	Within 2 years of issue of patent. Time may be extended for good reasons.
Australian Commonwealth	C	14 years	.£22 1s.	At 7th year .£8	None.
Austria		15 years	.£15 15s.	First year .£4, afterwards increasing yearly to .£31 8s. for the last year	Within 3 years from grant. (Similar to German law.)
Belgium	C	20 years	.£8 8s.	Second year .£2, afterwards increasing 10s. yearly	Within 1 year from date of commercial working elsewhere. Time may be extended to 2 years.
Brazil	C	15 years	.£31 10s.	Second year .£5 5s., increasing yearly to .£17 12s. for the last year	Within 3 years from grant.

Canada		18 years	£21	At the end of the 6th year £10 10s. At the end of the 12th year £10 10s.	Within 2 years. May be commuted, upon appli- cation within 6 months from issue of patent, to granting of compulsory licences.
Cape of Good Hope		14 years	£25	At 3rd year £13 13s. .. 7th .. £23 3s.	None.
Denmark	C	15 years	£15 15s.	First 3 years £2 10s. yearly Next 3 .. £4 3 .. £7 3 .. £13 .. Last 3 .. £19 ..	Within 3 years. Time may be extended or patentee relieved of obligation for good reasons.
France	C	15 years	£14 14s.	£5 yearly	Within 2 years from sign- ing of patent.
Germany	C	15 years	£18 18s.	Second year £4, after- wards increasing £2 10s. yearly	Within 3 years from grant.
Hungary		15 years	£14 14s.	First year £4 8s., increas- ing yearly to £23 10s. for last year	Within 3 years from grant.
India		14 years	£25	At 4th, 5th, 6th, 7th and 8th years £7 10s. Each following year £12 10s.	None.

C signifies that the country is a member of the International Convention for the Protection of Industrial Property.

TABLE OF COST, ETC., OF FOREIGN PATENTS -(continued).

Country.		Term of Patent.	First Cost.	Taxes payable subsequent to grant, including agency at home and abroad.	Conditions as to Working.
Italy	C	1 year to 15 years	£25	£3 second and third years £4 each of next 3 years £5 3 .. £6 3 .. £7 3 ..	If originally granted for 5 years or less, must be worked within 1 year, otherwise within 2 years.
Japan	C	15 years	£35	£3 at end of first and second years. Afterwards increasing 10s. each third year.	Within 3 years of grant.
Mexico	C	20 years	£36 15s.	5th year £13 13s. 10th .. £18 18s. 15th .. £24 3s.	None; but if not worked within 3 years of grant, compulsory licences obtainable.
Natal		14 years	£25	At 3rd year £8 3s. .. 7th .. £13 3s.	None.
New Zealand		14 years	£15 15s.	At 4th year £7 12s. .. 7th .. £12 12s.	None.
Norway	C	15 years	£16 16s.	£2 10s. second year, afterwards increasing 10s. yearly	Within 3 years of grant. Time may be extended for good reasons.

Portugal	C	1 to 15 years	1 year £15 5 years £20 10 years £25 15 years £30	None.	Within 3 years of grant.
Russia		15 years	£26 5s.	£4 second year, increasing gradually up to £46 10s. for 15th year	Within 5 years of grant.
Spain	C	5, 10 or 20 years	£21	£2 10s. second year, afterwards increasing 10s. yearly	Within 3 years of grant.
Sweden	C	15 years	£18 18s.	Yearly, 2nd to 5th years £3, 6th to 10th £4 10s., 11th to 15th, £6.	Within 3 years. Time may be extended.
Switzerland	C	15 years	£16 16s.	£2 10s. second year, increasing 10s. annually	Within 3 years from grant.
Transvaal		14 years	£26 5s.	At 3rd year £4 12s., increasing 10s. each year	None.
U. S. A.	C	17 years	£26 5s.	None.	None.

C signifies that the country is a member of the International Convention for the Protection of Industrial Property.

APPENDIX A.

TABLE 1.—PATENT FORMS AND FEES.

Form.	Proceeding.	Fee.
Patents Form	No. 1.—Application for Patent£1
"	No. 1A.—Application for Patent communicated from abroad£1
"	No. 1B.—Application for Patent under International and Colonial arrangements	£1
"	No. 1C.—Application for Patent of Addition	£1
"	No. 1D.—Application for Secret Patent	—
"	No. 2.—Provisional Specification	—
"	No. 3.—Complete	£3
"	No. 4.—Appeal to Law Officer	£3
"	No. 5.—Application for extension of time under Rule 16 for 1, 2 or 3 months, respectively	£2, £4, or £6
"	No. 6.—Application for extension of Time for leaving Complete Specification	£2
"	No. 7.—Application for extension of Time for acceptance of Complete Specification for 1, 2 or 3 months, respectively	£2, £4, or £6
"	No. 8.—Opposition to Grant of Patent	10s.
"	No. 9.—Notice that Hearing will be attended	—
	(a) on opposition to Grant, Restoration, Amendment or Surrender of Patent	£1
	(b) on Revocation proceedings under ss. 26 and 27	£2
"	No. 10.—Notice of Desire to have Patent sealed	£1
"	No. 11.—Application for extension of Time for sealing of Patent, where period allowed for sealing of Patent will expire after commencement of Act for 1, 2 or 3 months, respectively	£2, £4, or £6

Form.	Proceeding.	Fee.
Patents Form No. 12.	Application where period allowed for the Sealing of the Patent has expired before the commencement of the Act	£10
..	No. 13.—Application for Certificate of Payment or Renewal according to age of Patent	£5 to £14
..	No. 14.—Application for Enlargement of Time for Payment of Renewal Fee for 1, 2 or 3 months, respectively	£1, £3, or £5
..	No. 15.—Application for restoration of a lapsed Patent	£20
..	No. 16.—Notice of opposition to an application for restoration of a lapsed patent	£5
..	No. 17.—Application to amend Specification before or after sealing, respectively	£1 10s. or £3
..	No. 18.—Opposition to Amendment of Specification	10s.
..	No. 19.—Application for Grant of Compulsory Licence or Revocation of Patent	£1
..	No. 20.—Petition for Grant of Compulsory Licence or Revocation of Patent	—
..	No. 21.—Opposition to petition for Grant of Compulsory Licence or Revocation of Patent	£1
..	No. 22.—Application to the Comptroller for an Order for the Revocation of a Patent under s. 26 of the Act	£2
..	No. 23.—Offer to Surrender a Patent	£1
..	No. 24.—Application for Revocation of a Patent under s. 27 of the Act	£2
..	No. 25.—Notice for alteration of Name or Address or Address for Service in Register	5s.
..	No. 26.—Request to enter two Addresses for Service on Register	5s.
..	No. 27.—Request to enter Name upon the Register of Patents	10s.
..	No. 28.—Request to enter Notice of Interest in the Register	10s.
..	No. 29.—Request to enter Notification of Document in Register	10s.
..	No. 30.—Request for Correction of Clerical Error before or after sealing, respectively	5s. or £1

PATENT FORMS AND FEES (*continued*).

Form.	Proceeding.	Fee.
Patents Form No. 31 .	Request for Certificate of Comptroller	5s.
..	No. 32 .—Application for Duplicate of Patent	£2
..	No. 33 .—Notice of Intended Exhibition of Unpatented Invention	10s.
..	No. 34 .—Application for Entry of Order of Court	10s.
..	No. 35 .—On postal request for printed Specification	8d.
Search or inspection fee	each	1s.
For office copies	every 100 words	4d.
	(but never less than one shilling)	
For office copies of drawings	(cost according to agreement.)	
For certifying office copies, MSS. or printed	each	1s.

TABLE 2.—COST OF OBTAINING A BRITISH PATENT.

The following may be taken as a normal scale of charges for obtaining a complete British patent in an ordinary case, where the specification does not call for an unusual expenditure of time in its preparation. These charges are exclusive of the cost of making drawings and of any amendments necessitated by objections raised by the Patent Office on the ground of anticipation or otherwise; they also exclude the cost of meeting any opposition that may be brought against the application.

Preparing and settling the complete specification and making the necessary copies; stamp duty and agency	£12 12 0
Sealing the patent, if allowed	2 2 0
Total	£14 14 0

If provisional protection is applied for in the first instance, the cost will be as follows:—

<i>Provisional Application</i> .—Preparing and settling provisional specification and making the necessary copies; stamp duty and agency	£5 5 0
<i>Completing the Application</i> .—Preparing and settling the complete specification and making the necessary copies; stamp duty and agency	£10 10 0
Sealing the patent, if allowed	2 2 0
Total	£17 17 0

The cost of drawings, and of answering any objections the Comptroller may raise on account of prior specifications, and of meeting any opposition, will be in accordance with the amount of work involved.

TABLE B.—CONVENTION COUNTRIES.

The following is a complete list of the countries which have up to the present time subscribed to the Articles of the International Convention for the Protection of Industrial Property, ratified at Paris in 1884 and amended by the Brussels Act of 1900.

Belgium	Mexico
Brazil	Netherlands, with the
Cuba	Dutch East Indies
Denmark with the Farøe	Surinam
Islands	Curaçoa
France, with Algeria and	Norway
Colonies	Portugal, with the Azores and
Germany	Madeira
Great Britain, with the Com-	Santa Domingo
monwealth of Australia	Servia
(including Tasmania)	Spain
Ceylon	Sweden
New Zealand	Switzerland
Trinidad and Tobago	Tunis
Italy	United States of America
Japan	

Under this Convention, an applicant for a patent in any one of the contracting States may obtain priority in any of the other States.

Similar arrangements, for the mutual protection of inventions, designs and trade marks, have been made between Great Britain on the one side, and each of the following States and Colonies on the other :—

Ecuador (designs and trade marks only). Greece (designs and trade marks only). Honduras. Paraguay. Roumania (designs and trade marks only). Uruguay.

PART II.

'COPYRIGHT' IN DESIGN.



INTRODUCTION.

The protection of copyright in design has formed the subject of a surprisingly large number of enactments. Glancing back at these, and particularly the earlier of them, one cannot help being struck by the meticulous spirit in which Parliament appears to have handled this matter. Indeed, a sorer spectacle of piecemeal legislation it would be hard to find anywhere in the Statute-book.

The first of these Acts, evoked by the wholesale piracy of designs then prevalent in the cotton trade, was passed in 1787. It went no further than was absolutely necessary to meet the immediate needs of the case, by granting a monopoly for 2 months in new patterns for printing on linens, cottons, calicoes and muslins. In 1794 this period of protection was extended to 3 months.

By a further instalment of legislation in 1859 a similar degree of protection was accorded to designs for fabrics of wool, silk and hair; and Ireland, hitherto excluded, was brought within the scope of the Acts.

In the same year a more liberally conceived measure was passed, granting to the proprietor of any new and original design, applicable to the purposes specified in the Act, the sole right of user for 12 months, or, in certain cases, for 3 years. The purposes specified covered practically all the

uses to which designs are applicable. This Act also contained a provision making the infringer of a registered design liable to a penalty of £5 to £30 for each offence.

By an Act of 1842, registration was extended to all ornamental designs; at the same time, in order to prevent a person from unduly monopolising a design in respect of all manner of articles, a system of classification was adopted. Thirteen classes of articles were drawn up, and the applicant was required to specify the class or classes for which he claimed registration. This Act also provided that the plaintiff in an action for infringement should have the option of claiming damages instead of a penalty.

In the following year registration was further extended to embrace *useful* as well as *ornamental* designs.

The Designs Act of 1850 introduced a species of provisional protection for designs which enabled the proprietor to publish his design without harmful consequences; he could not, however, without jeopardising his title, sell or offer for sale any article bearing the design, until registration was completed. The advantages of this provision seem to have been somewhat questionable and it was subsequently dropped.

With a view to facilitating the means of legal redress, an Act of 1858 sanctioned the institution of infringement proceedings in the County Courts.

In 1865 a measure was passed, granting provisional protection to designs exhibited at industrial exhibitions.

An important administrative change was effected in 1875, when the business of the Board of Trade in regard to designs was transferred to the Patent Office and the duties of the registrar of designs were vested in the Commissioner of Patents.

The Patents, Designs and Trade Marks Act of 1883 swept away all previous legislation on the subject of designs and

formulated the law afresh. The period of copyright obtainable by registration was made, for all designs, an invariable period of 5 years, and this term was not capable of extension. Provisional protection was abolished and the distinction between useful and ornamental designs was discarded, the Legislature recognising that the purpose of the design is irrelevant to the question of its registrability.

This Act was repealed by the Patents and Designs Act of 1907, which now, in Parts II. and III., as supplemented by the Board of Trade Rules, embodies the whole of the statutory civil law of copyright in designs. The most radical innovation introduced by the new Act is the provision enabling the proprietor of a registered design to extend the period of his registration for 2 further terms of 5 years each, thus virtually enlarging the maximum period of copyright in designs to 15 years. It should also be noted that a branch office for the registration of printed or woven designs on textile piece goods, handkerchiefs and shawls has been established at Manchester, under the control, for the time being, of the Keeper of Cotton Marks. The other changes are mainly of a minor character, tending to assimilate the legal practice in regard to designs to that already prevailing in the case of patents.

CHAPTER I.

REGISTRABLE DESIGNS.

Every new and original design, not hitherto published in the United Kingdom, is capable of registration.

This statement sums up in a single sentence the greater part of the law regulating the registration of designs. But, like most general statements of law, it stands in need of explanation and commentary.

In the first place it is obviously desirable to get at the outset a clear notion of the precise meaning attached by the Legislature and the Courts to the word "design." To the layman the word appears simple and obvious enough. Actual cases, however, have shown that it is not altogether free from the danger of misapprehension. The definition of the word furnished by the Statute is as follows:—

“ ‘Design’ means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, 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.”

Although scarcely a definition in the true sense, the above statement affords a fairly comprehensive catalogue of the various forms which a design may assume. It is

plain also from the wording that the only kind of design contemplated by the framers of the Act is a design applicable to manufactured articles. Drawings, engravings, photographs and pictures generally are not within the statutory definition. Copyright in these is governed by a different set of Statutes.

Of the four words used to describe the various applications of a design, "pattern" is the term which may properly be used to denote a design as applied to fabrics, wall papers, china, etc.; "shape" and "configuration" mean much the same thing and suggest rather the outline and general form of an object; "ornament" is appropriate to a design when applied in a superficial, partial or accessory manner. But no hard and fast meaning need be attached to these terms, and an applicant who states in his application that his design is for one or the other does not thereby limit the scope of his copyright. It should be observed that the thing registered is not the article to which the design is applied, but the design as applied to the article. The distinction is obvious enough when the design is for a pattern or ornament, but when the design is for the shape of a thing the distinction is reduced, as Lord Justice Lindley put it, to "the difference between the shape of a thing and a thing of that shape."

The use of the word "ornament" in the above definition implies no antithesis to "usefulness." The aim and object of a design may be purely æsthetic, or purely utilitarian, or both, but as far as the copyright in a design is concerned, its purpose is wholly immaterial. All that the Courts are concerned with is its outward and visible appearance. Hence, if two designs are identical to the eye, it cannot be pleaded as a defence to an action for infringement that the objects they compass are different, or that the one is useful and the other is useless. Conversely, the fact that two designs compass the same end is quite irrelevant

to the consideration of the question whether the one is identical with or a fraudulent or obvious imitation of the other.

This was the principle laid down in the often quoted House of Lords case, *Hecla Foundry Co. v. Walker & Co.* The plaintiffs were the owners of a registered design for a kitchen range fire door, with a moulding on the top which served to exclude cold air. This moulding fitted into another moulding on the range when the door was closed. The infringement complained of was a range fire door with a moulding which had the same effect, but did not fit into the moulding on the range. The Courts below had allowed the purpose, for which the moulding was intended, to influence their decision. The House of Lords, disapproving this ground of decision, ruled that the object which the designer may have in view in adopting a particular shape ought not to be regarded in considering what is the design protected, and whether there has been an infringement of that design.

The utility of a design, on the other hand, is no disqualification; though, where the importance of a particular shape resides in its utility, it becomes a serious question whether it is not better to protect it by patent instead of by registration. Mistakes, resulting in the loss of copyright, have sometimes been made by attempting to protect by registration so-called designs, that are in reality processes or methods of manufacture. A good instance of such a case is furnished by *Moody v. Tree*. There the design registered was a picture of a basket, and underneath was the statement that the claim was for "the pattern of the basket, consisting in the osiers being worked in singly and all the butt ends being outside." The basket had no recognisable novelty in its shape, configuration or ornamentation; nor in its pattern, according to the proper significance of that word. Its virtue lay merely in the

process by which it was made, and that, if novel and useful, might form good subject matter for letters patent; but the Court held that it was not capable of being registered as a design. It is not the intention of the Statute that processes, which cannot, either for want of novelty or want of utility or for some other reason, be protected by patent, should by a specious transformation be protected as designs.

Similar questions arose in two subsequent cases, both relating to designs for ladies' corsets, viz., *Cooper v. Symington* and *In re Bayer's Design*.

In the former case the plaintiffs had registered a design for a new style of corset. The novelty consisted substantially in the method of lacing the corset so as to facilitate the removal of the busks. The lacings were diagonal, and so arranged that when the corset was fastened, it had the appearance of being laced together (though in reality it was fastened by clasps and studs), and looked precisely like the old laced corset. It was held that this was not a new or original design capable of registration under the Statute. In *Bayer's Design* the application stated that the novelty consisted in "a corset having the gores or gussets cut horizontally and from the front of the busk towards the back of the corset, as shown in the representations." The registered sketch showed a straight-fronted corset in which the seams were not exactly horizontal, but the gussets tapered towards the front. It was held that the representation attached to the application illustrated a method of manufacture, and that there was no design capable of registration.

Cases will readily occur to the reader in which the particular form of an article might be equally fitting subject matter for letters patent and for registration as a design, e.g., an aeroplane, a new form of screw propeller, or a photographic screen ruled in some new fashion for half-tone

engraving, or in fact any other invention in which the shape or pattern is the determining factor of its utility. Where, however, an invention appears equally suitable for protection by copyright or patent, the very marked difference in the scope of protection afforded in either case must not be overlooked. An aeroplane, for instance, regarded purely as a design, presents a meaningless assemblage of parts; meaningless, because the appeal is solely to the eye and not to the intelligence. The protection secured by registering it as a design will be confined to the superficial aspect of the object, as stereotyped in the representation accompanying the application. Consequently, anyone minded to steal the invention could do so, provided he could give his machine an appearance sufficiently unlike the registered design. In the case of a patented invention, however, no colorable alteration of shape will avail the infringer if the principle of the invention has been taken. Hence it is plain that when utility is an important function of the design, registration is a very inadequate means of protection.

An actual instance of the co-existence of design and patent rights in the same subject matter not long ago came under judicial consideration in the case of *Werner Motors, Ltd. v. Gamage*. On November 18, 1901, the plaintiffs registered a design applicable for the pattern of a motor-cycle frame. Previously, on November 8, they had applied for a patent for a frame for motor-cycles similar to that shown in the design. It was contended by the defendants that, a patent having been granted on the application, the registration of the design was invalidated by reason of the prior grant of exclusive rights to the article. The Court, however, affirming the principle that the rights in a patent and a design are distinct and may co-exist, held that in the above circumstances the registration of the design was valid, as it had been completed before the actual grant of

the patent. The question whether the registration of a design would debar the proprietor or a stranger from *subsequently* obtaining a valid patent for the mechanical advantages flowing from the use of a similar design was raised but not decided.

It is obvious that the co-existence of copyright and patent right in the same article might lead to somewhat curious results in the event of their becoming vested in different proprietors. The assignee of the patent might find himself exposed to an action, at the instance of the owner of the registered design, for manufacturing an article, which, though in accordance with the specification of his patent, infringed the other's copyright by reason of its appearance.

The Court was not blind to these difficulties, but declined to meet them prematurely. Lord Justice Romer, however, addressing himself to the case of the possible interference of patent right and copyright, expressed the opinion that the difficulty might be met by saying that the right, second in point of time, must be held subject to the first.

Novelty and Originality.—Having thus far ascertained the legal meaning of “design,” it still remains to consider what is meant by the requirement that the design shall be “new and original” and “not hitherto published within the United Kingdom.” If there is any distinction in meaning between the words “new” and “original,” and so far the Courts have failed to discover any, there is authority for saying that the design need not be *both* new and original.

In considering the novelty or originality of a design, it must always be borne in mind that it is not the abstract design but its *application* to the manufactured article that must be novel. To demand originality of design in the abstract sense of the word would be to seriously curtail the designer's freedom of choice and place too heavy a tax on his creative ingenuity. As it is, he is at liberty to select from the multitude of objects that surround him any that

strikes him as affording a good design for commercial application. Nature teems with such ready-made designs, and mankind has been busy applying them ever since the world began.

A discussion upon this aspect of the requirement of originality arose in the case of *Saunders v. Wiel*. There it was not a natural but a well-known artificial object, to wit, Westminster Abbey, which had been appropriated in miniature as the design for a spoon handle. The objection was raised that this miniature model of the Abbey was not a design within the meaning of the Act, or if it was, that it was not "new and original." The Court, however, overruled both these objections, holding that the novelty and originality of a design are not destroyed by its being taken from a source common to mankind or from some natural object. But it seems open to doubt whether the taking of a natural object itself, and the adaptation of it with little or no change to some ornamental purpose, would constitute subject matter for registration. For example, it is questionable whether the mounting of a Brazilian butterfly as a brooch, or an Egyptian scarab as a scarf pin, would be registrable as a valid design.

The design must be new and original with reference to the kind of article for which it is registered. A design for the shade of a gas lamp can hardly be new, if it was old for an oil lamp. The character and use of the articles being closely analogous, there must be substantial difference between the designs as applied to them respectively. A leading case in point is *Le May v. Welch*. There the Court had to consider the design of a collar, the cut of which differed in two or three trifling features from previous patterns of collars. The Court held that the difference was not substantial enough to constitute registrable novelty, and Lord Justice Bowen observed: "It is not every mere difference of cut, every change of outline, every change of

length or breadth or configuration in a simple and most familiar article of dress like this, which constitutes novelty of design. To hold that, would be to paralyse industry and make the Act a trap to catch honest traders. There must be not mere novelty of outline, but a substantial novelty in design, having regard to the nature of the article."

On the other hand, in *Rollason's Design* (which related to the ornamentation of a tombstone), Lord Herschell pointed out that if by a slight variation of an old design a much more attractive and pleasing effect is produced upon the eye, protection should not be denied to the more successful designer.

A combination of old shapes or patterns will afford good subject matter for registration, provided there is some degree of originality in the manner of combining them. But mere aggregation of old designs will not pass muster as a new design.

A variation of the material upon which the design is impressed does not constitute novelty. Thus, in *Bach's Design*, a rose-shaped lamp-shade, made in linen, having been registered for goods in Class 12, it was held that a lamp-shade of the same design but made in china, registered in Class 4, was deficient in novelty and the registration was expunged.

In *Clarke's Design* a particular form of lamp-shade, previously used for gas and oil lamps, was subsequently registered in respect of electric lamps. The only feature of novelty was the omission of the chimney which, in the case of electric lighting, was superfluous. The Court held that the novelty of the application did not satisfy the requirements of the Statute. As a corollary to the foregoing cases, it should be added that the fact of the articles or materials to which the design is applied falling in different classes does not constitute a difference in the eyes

of the Court, if in reality the nature and use of the articles are the same or closely analogous.

Where, on the other hand, the articles are not of similar character, a design which is old in respect of one may be new as applied to the other: in other words, what is old for a coal scuttle may be new for a bonnet. In *Walker, Hunter & Co. v. Falkirk Iron Co.*, the registration of a design for the shape of an iron door applicable to a kitchen range was upheld, although wooden doors of the same shape for sideboards and other articles of furniture were old.

Though the law is averse to a stranger or rival taking a design already registered in one class and registering it in another for a closely analogous purpose, the same objection does not exist where the proprietor of a design wishes to do the same thing. Prior to 1908, however, the proprietor of a registered design who wished thus to extend his registration to other classes, laid himself open to the charge of self-anticipation. To meet this hardship, a special provision is introduced in s. 50 of the Patents and Designs Act, 1907, to the effect that in such circumstances the subsequent registration shall not be invalidated.

(a) on the ground of the design not being a new and original design, by reason only that it has been previously registered by the applicant in another class:

(b) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

The requirement of novelty in the sense that the design intended for registration must not have been previously published in the United Kingdom is, in the main, identical with the rule as to prior publication in the case of patentable inventions. Stated compendiously, the rule is that the

printed publication of the design, or the sale or exhibition for commercial purposes of any article bearing the design, is fatal to subsequent registration of a valid copyright. To save unnecessary repetition, the reader is referred for further information on this head to Part I., Chap. II., where the subject of anticipation by prior publication and prior user is fully dealt with. As in the case of patented inventions, so also with designs, the stringency of the rule previously prevailing in regard to prior publication has been somewhat relaxed by the Act of 1907. Section 55 provides that neither confidential disclosure of a design by the proprietor to any other person, nor disclosure by the person confided in, in breach of good faith, shall prejudice the subsequent registration of the design. A special provision is also made to the effect that the acceptance of a first and confidential order for goods, bearing a new and original textile design, shall not be a bar to subsequent registration. The reason why this indulgence is confined to designers in the textile trade is not very apparent. True, the number of applications emanating from that source largely preponderates over those coming from other trades, yet this in itself scarcely seems to be a sufficient ground for making the distinction.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

Publicity given to a design, either by showing it at an Industrial or International Exhibition or by publicly describing it elsewhere during the period of the exhibition, will not prejudice its subsequent registration provided that:—

- (a) The exhibitor gives the Comptroller 7 days' previous notice of his intention to exhibit or publish the design ;
- (b) The application for registration is made within 6

months from the date of the opening of the exhibition.

The notice to the Comptroller must be accompanied by a description and drawing of the design sufficient for the purpose of identification.

This privilege may be claimed in the case of all exhibitions certified by the Board of Trade, or any other exhibition to which these provisions may be extended by Order in Council. In the latter case compliance with the above conditions may be dispensed with.

CHAPTER II.

REGISTRATION.

WHO MAY REGISTER.

THE rule regulating the right to register a design allows any person, claiming to be the *proprietor* of a new and original design, to apply for registration. The Act recognises four different grounds upon which the claim to proprietorship may be based. The proprietor may be :

1. *The author of the design.* That is, the person who first conceives the design and embodies it in concrete form. Though the point has never been clearly decided, the cases seem to indicate that the importer of a design is not, as in patent law, on the same footing as the true author of the design. In practice, however, where there is no evidence that the design, though published abroad, has been previously published in England, it would be extremely hard to upset a registration by an applicant who claimed to have independently invented the design in question.

2. *The person who orders the design and pays for it.*—Doubtful questions, such as arise in the case of invention as to the respective rights of master and workman, cannot arise in the case of designs. If the master is not the author of the design, he has at least commissioned the work and paid for it, and can therefore claim proprietorship on that score.

3. *The purchaser of a design or the right to use it either exclusively or to a limited extent.*—In other words, the assignee or licensee of the original proprietor. No assign-

ment or licence, however, can be registered until the original proprietorship has been duly entered on the Register. With reference to this class of proprietorship, it should be observed that the acquisition of the right to sell merely the article to which the design is applied, even though it be an exclusive right, is not the same thing as the acquisition of copyright in the design, and will not therefore support a claim to registration (*Jewitt v. Eckhardt*).

4. *The person on whom the property in a design devolves.*—The copyright in a design being personal property, it devolves, in the case of the proprietor's death, upon his personal representatives, and in the event of bankruptcy, upon his trustee.

APPLICATION.

As registered designs are not ordinarily open to public inspection until some time after the date of registration (5 years in the case of designs in Classes 13, 14 and 15, and 2 years in the case of other designs), the intending applicant has not the same opportunity, as an applicant for a patent, of satisfying himself that his idea has not been anticipated. He may, however, employ the Patent Office to make a search for him, by applying on Form Designs No. 21, accompanied by 2 copies of the design, and stating the class in which it is proposed to register it. The Comptroller will then inform him whether it is identical with, or an obvious imitation of, any design the copyright in which is still subsisting.

The procedure of applying for registration is simple enough. The applicant must first decide upon the class or classes of goods for which he desires to register. A list of the 16 classes is given at p. 277. He may register the same design in all or any of the classes; but a separate form and fee is required for each class. In case of doubt as to the class in which a design ought to be registered, the applicant may refer to the Patent Office to decide the

question. The design may be registered either for a single article or for a set of articles, *e.g.*, a dinner service. In the former case, the application must be made on Form Designs No. 2; in the latter, on Form Designs No. 3. The stamp duty on these forms is 5s. and 10s. respectively.

An application for the registration of a lace design in Class 9 must be made on Form Designs No. 4 (stamp 1s.), or, in the case of a set, on Form Designs No. 5 (stamp 2s.). For the registration of printed or woven designs on textile piece goods or on handkerchiefs and shawls (comprised in Classes 13, 14 and 15) special provisions have now been made: see p. 258.

The applicant must state the nature of the article to which the design is to be applied and, if the Comptroller so requires, the purpose for which it is to be used and the material of which it is to be made. He may also be required by the Comptroller to indorse on the application a brief statement of the novelty claimed for the design.

The application must be accompanied by *three* or, where the design is applied to a set, *four* identical drawings, photographs or specimens of the design, drawn or mounted on ordinary foolscap paper. Drawings may be executed in ink or pencil (fixed), but rough sketches will not be accepted. To insure compliance with the minute requirements of the Patent Office in regard to drawings, etc., a copy of the "Instructions" issued by the Office regarding the registration of designs should be procured and studied.

If it is desired to secure a date of registration at the earliest possible moment, only one sketch of the design (sufficient to identify it) need be sent upon application. In this case the design, if accepted, will eventually be registered as of the date when the sketch was received; but no certificate of registration will be issued until three exact drawings, photographs or specimens have been sent in substitution for the sketch. The application papers

being all in order, they should be sent by hand or by prepaid post addressed to the Comptroller of the Patent Office (Designs Branch) 25, Southampton Buildings, Chancery Lane, London.

There is no opportunity given to the public to oppose an application to register a design; the only objections that the applicant is liable to encounter are those emanating from the Patent Office. The Comptroller may refuse to register the design. But if so, he will notify the applicant of his objections, and the latter has then one month within which to apply for a hearing so that he may appear personally or by his agent to argue the case. When registration is refused on the ground of identity with some design already registered, the applicant is entitled to inspect the design cited as anticipating his own. If, after hearing what the applicant has to say, the Comptroller still refuses to register the design, the applicant may appeal to the Board of Trade. Notice of appeal must be given on Form Designs No. 25, within a month after the Comptroller's decision.

An application, not completed, owing to neglect on the part of the applicant, within twelve months from the date of filing, will be deemed to have been abandoned. The applicant is notified of the expiry of this period, and has 14 days' grace within which to complete his application. If no hitch occurs in the application, a certificate of registration is sealed in due course and forwarded to the applicant, dated as of the day of application.

THE MANCHESTER OFFICE.

A Manchester Branch Office for Designs has now been established and is located, for the time being, at the Trade Marks Registry of the Patent Office, 48, Royal Exchange, Manchester, under the superintendence of the Keeper of

Cotton Marks. It is concerned with the registration of designs in the following classes :—

Class 13.—Printed or woven designs on textile piece goods (other than checks or stripes).

„ 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).

„ 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls), being checks or stripes.

An application for registration in any of the above classes may be lodged either at the London or the Manchester Office. It must be furnished in duplicate and accompanied by *six* representations or specimens of the design.

For Classes 13 and 14 the appropriate form is Designs (Manchester) No. 1 (stamp 2s. 6d.); for Class 15 the form is Designs (Manchester) No. 2 (stamp 1s.).

The Manchester Register contains entries concerning all designs registered in these classes. These entries also appear in the London Register.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

An applicant who has already registered his design in one or other of the Convention States can obtain a British registration of the same date as his foreign application (or the first of them, where there are several), provided he applies in England within 4 months after such foreign application.

The names of the countries belonging to the International Convention, or with which some similar preferential arrangement exists, are given on page 239.

DURATION OF COPYRIGHT.

Registration confers the exclusive right to apply the registered design to any article in the class specified for a period of *five* years.

Prior to 1908 this was the limit of protection allowed. By virtue of the Patents and Designs Act of 1907, however, the time may be extended for two further periods of 5 years each.

To obtain extension of the period of copyright for a second term of 5 years, application may be made at any time after the registration of the design by lodging Form Designs No. 8 (stamp £1); but the extension will not be granted unless the application be made at least a week before the expiration of the original period of 5 years. Where the proprietor possesses several design copyrights expiring simultaneously, he may include them all on one form. This first extension can be demanded as a matter of right under s. 52 (2) of the Act. The second extension for a third period of 5 years is left within the discretion of the Comptroller; it will not, however, be refused unless there are special reasons against granting the extension. This final extension may be applied for at any time not less than 6 months and not more than 12 months before the expiration of the second period of 5 years. The form to be used is Design No. 9, and the fee is 10s. If the Comptroller grants the application, the registered proprietor will be duly notified of the fact, and he must then lodge Form Designs No. 10 (stamp £1 10s.) at least a week before the current copyright period expires.

Extensions of the period of copyright are advertised in the Illustrated Official Journal (Patents).

The term of protection cannot be extended beyond 15 years.

CANCELLATION FOR NON-USER.

No conditions, beyond the payment of fees, are attached to the continuance of copyright in design. But if a registered design is used in manufacture exclusively or mainly outside the United Kingdom, the proprietor runs the same risk of having his registration cancelled as the patentee whose patent is worked mainly abroad, with this

difference, however, that in the case of a design no period of grace is allowed; the application to annul may be made *at any time* after the registration. In other respects, the procedure is precisely the same as that prescribed for the revocation of patents on this ground.

THE REGISTER.

A Register of Designs is kept at the Patent Office, containing representations, or specimens, of registered designs, names and addresses of proprietors of registered designs, notifications of assignments and similar matters. In order to get his name entered on the Register, a person who has become entitled either by assignment or by licence to use a registered design, must make his request to the Comptroller either conjointly with the registered proprietor on Form Designs No. 11 (No. 12 for Lace) or, if he cannot get the registered proprietor to join with him, then upon Form Designs No. 13. In the latter case the application must be accompanied by a full statement of the circumstances in which he claims to be entitled to an interest in the design. The Comptroller may require the statement to be verified by statutory declaration. The fee on registration of assignment is the same as that required for the original registration.

(a) *Inspection of the Register.*—The Register of Designs is not accessible to the public as freely as is the Register of Patents. The general rule is that in the case of ordinary designs inspection is not permitted until 2 years after registration and, in the case of Manchester designs, not before 5 years. During these periods, however, the Register may be inspected by the proprietor of the design and by persons authorised by the proprietor, the Comptroller or the Court. A person entitled to inspect a design, before the close time has expired, must furnish the Comptroller

with sufficient information to enable it to be identified. Inspection takes place in the presence of an official of the Patent Office and no copy of the design is allowed to be taken.

After the expiration of the close time, the design becomes open to public inspection generally, and copies may be taken on payment of a small fee. Particulars as to the duration and scope of any copyright may be obtained from the Comptroller upon request on Form Designs No. 19, accompanied by information enabling the identification of the design in question.

(b) *Rectification*.—The Comptroller has ample power to make clerical amendments in the entry in the Register at the instance of the proprietor of the design; amendments, for instance, such as the correction of an error in the representation of the design or in the name of the proprietor (Form Designs No. 17), or the entry of a new address (Form Designs No. 16). He may also, at the proprietor's request, cancel the registration altogether, or restrict the scope of the design to particular goods. Corrections of this kind can be effected by forwarding to the Comptroller a request on Form Designs No. 18 (stamp 1s.).

The power to rectify the Register, where someone else's design is concerned, at the instance of a "person aggrieved" is reserved to the Court. The rules regulating this procedure are the same in the case of designs as in the case of patents. Any person hampered in his trade or prevented from doing what he deems he has a right to do, by the registration of a particular design, is a "person aggrieved" within the meaning of the Act. An obvious example would be a person threatened with an action for infringement. Anyone coming to the Court with a legitimate grievance of this kind is entitled to attack the obnoxious design on all the grounds upon which registration can at any time be attacked, *e.g.*, want of novelty, defective title, or invalidity through non-user.

The powers conferred under this section are exceedingly wide, enabling the Court not only to expunge the name of a person wrongfully registered, but at the same time to substitute on the Register the name of the lawful proprietor of the design (*Grocott's Design*).

An application to rectify the Register is made either by summons or motion in the High Court, and 4 clear days' notice must be given to the Comptroller, in case he may wish to appear and oppose the application.

CHAPTER III.

MARKING.

ALL goods to which a registered design is applied must, before delivery on sale, be marked with the prescribed marks of registration. Every article must be marked with the word "REGISTERED" or with the abbreviation "REGD" or "RD," and also (except in the case of designs registered in Classes 9, 13, 14 and 15) with the number appearing on the certificate of registration.

If the mark cannot be conveniently placed on the article itself it may be put on a label attached to or a wrapper containing the article. In the case of trimmings and lace, it will be sufficient to place the mark on the packet in which the material is put up for sale. But where a number of articles are manufactured in a single piece and subsequently cut up and retailed separately, each unit must have its own individual marking. Thus in *Hothersall v. Moore* it was held that the placing of a single mark upon the corner of a square of a dozen dusters woven together, but afterwards cut up and hemmed separately, was not sufficient. For the result was that only one duster ultimately bore the mark "Regd," and the other eleven dusters went out to the public without any indication that they were the subject of a registered design. An article sold before it is completely finished must nevertheless be marked, if it is completed as far as the design is concerned.

Care should be taken to affix the mark to that part of the article to which the design is applied or at least to place it where it will not be misleading. In *Lea v. Price*

the registered design was for a lamp head to be attached to arc gas lamps. The registration mark was placed not on the lamp head at all, but on a metal ring at the base of the glass globe some little distance from the lamp head. It was held that the marking did not comply with the requirements of the Act. This decision is, however, balanced by two other decisions on the other side of the line. A butter dish consisting of two parts, the dish and the lid, was held to be sufficiently marked by being stamped only on the dish, though the registered design was confined to the lid. For without the dish the lid was useless (*Piebling v. Hawley*).

A similar point arose in the more recent case of *Ingram v. Edwards*. There the registered design was for an electrolier bracket. The objection was taken that the article was marked only on the "cup," a detachable part adjacent to the burner and not novel in design. The judge left it to the jury to say whether the bracket would be a complete article without the cup, and the jury finding that it would not, the objection was overruled.

The consequences of failure to comply with the statutory requirement as to marking are not now so serious as they were formerly. Whereas, prior to the Act of 1907, defective marking entailed forfeiture of the copyright in the design, now the only result is that the careless proprietor loses his right to recover damages for infringement or the penalty as the case may be. This rule is, however, relaxed if he can show that he took all proper steps to ensure the marking of the article, or if he can prove that infringement took place after the infringer had become aware of the existence of the copyright in the design. It has been held that to issue orders for the marking of the articles, without seeing that the orders were properly executed, was not taking "all proper steps" within the meaning of the Act. But where a proprietor had had the dies for stamping

the articles with the registration mark duly prepared and sent to his manufacturer in Germany, who accidentally used some other dies belonging to the same proprietor, the Court held that reasonable care had been taken.

Articles of registered design must be marked in the regulation manner even though they are destined solely for export and use abroad.

The Board of Trade is empowered to modify or dispense with the statutory requirements as to marking as regards any description of article, where such modification is shown to be expedient in the interests of any particular trade or identity.

Any person falsely describing as "registered" any design applied to an article sold by him is liable, on summary conviction, to a fine not exceeding £5 for every offence.

CHAPTER IV.

INFRINGEMENT.

REGISTRATION confers the exclusive privilege, during the period of copyright, of applying the registered design to any article or substance in the class in which it is registered, and every act done in contravention of this right constitutes an infringement. It should be observed that, according to the statutory definition of copyright, the monopoly is limited to the right to *apply* the design. Hence, but for the express provision in another part of the Act, the proprietor's right of redress would be only against the manufacturer, *i.e.*, the person who *applied* the design. To meet the obvious necessity of providing a remedy also against the *sale* of articles bearing a pirated design, the Act expressly includes in the category of infringer the vendor who sells or offers for sale the pirated article, knowing it to be an infringement. With this prefatory observation, it will be well to proceed straight to s. 60 of the Patents and Designs Act, 1907, which deals with the subject of infringement. The first part of the section must be quoted *verbatim*, as the wording is important.

“ During the existence of copyright in any design it shall not be lawful for any person—

- (a) For the purposes of sale, to apply or cause to be applied to any article, in any class of goods in which the design is registered, the design or any fraudulent or obvious imitation thereof, except with the licence or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or,

(b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale such article."

The latter part of the section states that any act done in contravention of this prohibition renders the offender liable to pay either damages or a penalty and to be restrained from further infringement by injunction.

Some comment is needed both as to *who is an infringer* and as to *what constitutes infringement* within the meaning of the above section.

(a) *Infringer*.—First, as to the infringer, it is to be noticed that the section is only concerned with piracy which results in, or aims at, the *sale* of the pirated article. The application of a pirated design to an article for the manufacturer's own use or delectation, though doubtless an infringement, does not expose the infringer to the pains and penalties of this section. There is further a clear differentiation between two classes of infringer: (a) the *manufacturer* who applies the design and (b) the *seller* who disposes of the article to which the pirated design has been applied.

Provided the manufacture is for purposes of sale, it is immaterial whether the manufacturer acted innocently or not. Experience has shown that, in nine cases out of ten, infringement of this kind is deliberate. Hence the law declines to accept the plea of ignorance. A prudent manufacturer, who is in doubt whether a design, which he desires to adopt, does not too closely resemble a design already registered, will apply to the Patent Office, submitting a specimen of the design proposed to be used, and obtain the opinion of the Comptroller on the question (Form Designs No. 21). The words "or do anything with a view to enable the design to be so applied," at the end of sub-section (a),

are doubtless introduced into the Act to meet the facts of a case like *Potter v. Braco de Prata Printing Co.*, for which no remedy was provided under the previous Act. In that case the plaintiff had registered a new design for printing calicoes. The defendants, adopting a similar design, manufactured the calico and engraved suitable printing rollers in this country, but the actual printing was done in Portugal. It was held that there was no actionable infringement.

With ... seller, however, the case stands differently. It is not part of his business to enquire into the question whether the design applied to the goods supplied to him for sale is registered or not, or, if registered, whether it is applied with the sanction of the proprietor. The law, therefore, refuses to penalise a vendor unless it is shown that he was aware that he was infringing or unless, after being made aware of the fact, he continues to sell the pirated article. To bring the seller within the section, it must be proved that he had specific knowledge; and this may be difficult unless the proprietor takes steps to inform the seller of the fact that the design is applied without his consent. Accordingly, if the proprietor hears of the sale of articles pirating his design and there is reason to apprehend repetition of the infringement, he should at once notify the seller that he is infringing, mentioning the number of his registered design, and ask for an undertaking not to infringe in future. If the undertaking is refused, even though no further sales ensue immediately, an action for injunction may then be brought with a fair certainty, provided that the infringing character of the articles is proved, of getting an injunction and costs; whereas, if the writ is launched without previous warning, the plaintiff runs considerable risk, even though he gets his injunction, of being deprived of his costs.

But the Court discourages the bringing of actions where the infringement is of a trivial character, and where there is

no serious danger of the offence being repeated. Thus, in *Jan v. Grossman*, the defendant had purchased three infringing powder puffs, one of which he had sold to an unknown customer and another to the plaintiff, on which occasion he was informed for the first time that the puffs were an infringement. The defendant thereupon promised to sell no more and removed the third puff from his shop window. The plaintiff asked for a written undertaking not to infringe, which the defendant declined to give. The plaintiff accordingly commenced an action. No legal infringement could be proved, since at the time of sale the defendant was unaware that the design was registered. The judge, characterising the proceedings as trumpery, refused an injunction and dismissed the action with costs.

Apparently the purchaser or user of an article to which a pirated design has been applied, even though he has full knowledge of its illicit origin, is not liable under the section, or indeed guilty of any sort of infringement under the Act.

(b) *Infringement*.—The section quoted above mentions three kinds of imitation as constituting an infringement: an exact facsimile, a fraudulent imitation and an obvious imitation.

No comment is needed as to the first of these. The second, “fraudulent imitation,” is applicable to the case of a man who knows a design to be registered and deliberately goes and imitates it; perhaps disguising his imitation under the cloak of specious differences. It must be distinguished from conscious imitation animated by the desire to improve upon an old pattern and produce something better on the same general lines.

In the absence of circumstances suggesting fraud, the imitation, to be actionable, must be “obvious.” The question of similarity is for the eye alone, and must be determined by placing the designs side by side and asking whether they are substantially alike in all those essential

features wherein the novelty of the registered design resides. It is also relevant to consider whether they are so similar as to be mistaken one for the other when met with apart.

Contrasting the expressions "fraudulent imitation" and "obvious imitation," the inference to be drawn from the wording of the section seems to be this. Where the circumstances point to deliberate plagiarism on the part of the defendant, the burden of proving that the later design is not an imitation of the other is upon the defendant, and the Court will, in such a case, be more inclined to see identities than differences between the two designs. In other words, where a registered design has been chosen as a model upon which to form a new design, more pronounced originality and novelty may be required to be shown than where the similarity is purely accidental. In considering the question of infringement, attention must be focussed on those features of the registered design for which novelty is claimed, to the exclusion of such features as are old and commonplace.

In *Walker v. Scott*, the plaintiff had registered a design for a cyclist's tin oil can of oval shape, the feature of novelty being that the edges at the top and bottom were rounded off so that there were no sharp corners. The defendant manufactured an oil can of the same shape and general appearance, but with the edges left sharp. This was held to be no infringement.

A more recent case illustrating the same point is the *Helter Skelter Tower* case (*Staples v. Warwick*). The plaintiff's registered design consisted of a conical tower in the form of a lighthouse with a spiral slide wound round it, so that a person, seated or lying on a mat, could slide from top to bottom. The defendant constructed a tower with a precisely similar spiral slide, but instead of being in the form of a lighthouse it was in the form of a mediæval machicolated tower. Had the plaintiff been the first to

devise this particular variety of "giddy go-round," doubtless the defendant's tower would have been held to be an obvious imitation. It appeared, however, that the conical tower with a corkscrew slide round it was old. The Court, therefore, confining its attention to a comparison of the lighthouse and the mediæval fortress, held that there was no infringement.

These cases also illustrate the rule that, in determining the question of infringement, it is material to see what the state of knowledge was at the time when the design, alleged to be infringed, was registered.

It should be observed that the Act provides no remedy against piracy which consists in applying the registered design to articles *outside the registered class or classes*. Indeed, such a form of plagiarism is not an actionable infringement of copyright at all. Thus the somewhat paradoxical position arises, that a design which has been held devoid of novelty as applied to a particular substance, say china, in view of the prior registration of the same design applied to linen, may, nevertheless, be freely used without infringement because the two substances, china and linen, happen to fall in different classes.

THE REMEDIES FOR INFRINGEMENT.

When an offence under s. 60 has been committed, the proprietor of the design has the option of bringing an action either for damages or for the statutory penalty. The penalty recoverable is a sum not exceeding £50 for each offence, subject to the proviso that the total sum recoverable in respect of any one design shall not exceed £100. In determining whether he will ask for a penalty or for damages, the plaintiff must be guided by the circumstances of the case. If the infringement has caused him heavy loss and he can prove what his loss has been, he

should ask for damages. Damages, however, can only be recovered to the amount of such loss as can be proved. A penalty, on the other hand, is awarded quite irrespectively of the actual loss sustained, and will be heavy or light according to the conduct of the defendant. In cases of deliberate and persistent infringement, where the actual loss has not been large enough to warrant heavy damages, the plaintiff's best policy is to ask for the infliction of a penalty. In either case, a successful plaintiff is also entitled to an injunction against the repetition of the offence.

The person entitled to bring an action is the proprietor of the registered design; a licensee, therefore, as he falls within that category, can protect his own interests without the intervention of the licensor, provided his name is duly entered on the Register. But a mere agent for sale of the article bearing the registered design, even though his agency is exclusive, is not entitled to sue for infringement.

TRIBUNAL.

An action for infringement of copyright in design may be brought in the County Court or in the High Court. In a clear case of infringement where the plaintiff sues for a penalty, or where the damage does not exceed £100, the cheaper and more expeditious machinery of the County Court will, as a rule, be found most convenient.

If the action is brought in the High Court, it is usually set down on the Chancery side, unless the parties desire the facts to be tried by a jury, in which case it will be entered in the King's Bench Division.

The Chancery Court of the County Palatine of Lancaster has concurrent jurisdiction with the High Court, and causes of action arising in the County Palatine will usually be dealt with by this Court.

An appeal lies in the ordinary way to the Court of Appeal,

and finally to the House of Lords. From a decision of a County Court judge the appeal is in the first instance to the Divisional Court.

The provisions of the Patents and Designs Act of 1907 are declared to extend to Scotland and Ireland, and the term "Court," as used in the Act, is defined as including the High Court in Ireland and any Lord Ordinary of the Court of Session in Scotland. These Courts have, therefore, equal competence with the English Courts in trying actions for infringement of design. The Irish Courts have, however, doubted their competence to entertain an application to rectify the Register.

PROCEDURE.

The procedure in actions for infringement of design is modelled upon the procedure in patent actions. As soon as he has issued his writ, the plaintiff may apply for an interlocutory injunction to restrain infringement until the hearing of the action. Success in this application will depend upon the plaintiff making out a good *prima facie* case. The defendant may escape being put under an injunction by undertaking to keep an account of the manufacture or sale of the articles alleged to be infringements.

The plaintiff must decide at the outset whether he will claim the statutory penalty or damages; he cannot leave it uncertain, nor can he claim both. The choice of remedy makes no difference in the procedure, except that, if the plaintiff sues for a penalty, he cannot compel the defendant to answer interrogatories tending to show that he has infringed.

In his defence, the defendant may rely on all grounds of invalidity that can be urged against the plaintiff's copyright. The Act of 1907 expressly provides that the fact of the design being used exclusively or mainly outside the

United Kingdom may be used as a defence to an action for infringement.

There is not the same scope for expert witnesses in a design action as there is in a patent action, but the evidence of one or two experts in the trade is, as a rule, useful to guide the judge's eye in comparing two designs and in distinguishing between what is old and new. Where the case is tried by jury, the question of identity, or fraudulent or obvious imitation, will be a matter for the jury to decide.

A successful plaintiff is entitled to damages or a penalty, whichever he has elected to ask for, and also to an injunction and delivery up of the infringing articles. The Court will grant a "certificate of validity," as in a patent action, where the plea of invalidity has been raised without success.

To protect the public against the annoyance of receiving threats of legal proceedings from proprietors of designs of questionable validity, the Act of 1907 provides the person intimidated in this manner with the same remedy that exists in the case of patents (see Part I., Chapter XIII.).

APPENDIX B.

TABLE 1.—DESIGN FORMS AND FEES.

Form.	Proceeding.	Fee.		
		£	s.	d.
Form Designs	No. 1.—Authorisation	—		
"	No. 2.—Application for registration of design, not being lace and except articles in Classes 13 to 15	0	5	0
"	No. 3.—Application for registration of set of designs, not being lace	0	10	0
"	No. 4.—Application for registration of a design to be applied to lace	0	1	0
"	No. 5.—Application for registration of design to be applied to a set of lace articles	0	2	0
"	No. 6.—Application for entry of address for service in Register	0	1	0
"	No. 7.—Request for statement of grounds of decision under Rule 38	0	5	0
"	No. 8.—Extension of copyright for second period	1	0	0
"	No. 9.—Application for extension of copyright for third period	0	10	0
"	No. 10.—Extension of copyright for third period	1	10	0
"	No. 11.—Joint request by registered proprietor and assignee, &c., to enter the name of assignee, &c., in the Register	Same as registration fee.		
"	No. 12.—Joint request by registered proprietor and assignee of design in Class 9 to enter the name of assignee in the Register			
"	No. 13.—Request to enter name of subsequent proprietor, &c., in the Register under Rule 44	0	10	0
"	No. 14.—Form of declaration in support of statement of case accompanying Form Designs No. 13	—		
"	No. 15.—Form of application under Rule 49 to vacate entry of name of mortgagee or licensee in Register	0	1	0

DESIGN FORMS AND FEES (*continued*).

Form.	Proceeding.	Fee.
		£ s. d.
Form Designs No. 16.	Form of application for alteration of address or address for service in Register	0 1 0
„	No. 17.—Form of request for correction of clerical error in application to register, or for correction of clerical error under s. 70	0 1 0
„	No. 18.—Form of application by registered proprietor to cancel entry in Register	0 1 0
„	No. 19.—Request for search under s. 57 when registration number is supplied	0 1 0
„	No. 20.—Request for search under s. 57 when registration number is not supplied	0 2 6
„	No. 21.—Request for search under Rule 60	0 2 6
„	No. 22.—Request for certificate for use in legal proceedings or other special purpose	0 5 0
„	No. 23.—Request for cancellation of registration under s. 58	1 0 0
„	No. 24.—Notice of intended exhibition of an unregistered design	0 5 0
„	No. 25.—Appeal from Comptroller to the Board of Trade	0 5 0
„	No. 26.—Request for the Register to be altered in pursuance of an Order of the Court	0 5 0
„	No. 27.—Application for copy of Certificate of Registration	0 1 0
Form D. O. No. 1.	Certificate of Registration	—
Designs (Manchester) No. 1.	Application for registration of design in Class 13 or Class 14	0 2 6
„	„ No. 2.—Application for registration of a design in Class 15	0 1 0
„	„ No. 3.—Notice to Keeper under Rule 87	0 2 6
Inspection of Register or design where inspection is permitted, except inspection under the second paragraph of s. 56 (1) of the Act, for each quarter of an hour		0 1 0
Office copy of design (cost according to agreement)		—
For Office copy of documents, every 100 words (but never less than 1s.)		0 0 4
For certifying Office copies, MSS. or printed		0 1 0

The fees to be paid on any proceeding at the Manchester Office are the same as for the similar proceeding at the London Office.

TABLE 2.—CLASSIFICATION OF GOODS.

CLASS 1.—Articles composed wholly of metal or in which metal predominates, not included in Class 2.

CLASS 2.—Jewellery.

CLASS 3.—Articles composed wholly of wood, bone, ivory, papier maché, or other solid substances not included in other classes, or of materials in which such substances predominate.

CLASS 4.—Articles composed wholly of glass, earthenware, or porcelain, bricks, tiles, or cement, or in which such materials predominate.

CLASS 5.—Articles composed wholly of paper (except paper hangings), card-board, mill-board or straw-board, or in which such materials predominate.

CLASS 6.—Articles composed wholly of leather or in which leather predominates, and bookbinding of all materials.

CLASS 7.—Paper hangings.

CLASS 8.—Carpets and rugs in all materials, floorecloths, and oil-cloths.

CLASS 9.—Lace.

CLASS 10.—Hosiery.

CLASS 11.—Millinery and wearing apparel, including boots and shoes.

CLASS 12.—Ornamental needlework on muslin or other textile fabrics.

CLASS 13.—Printed or woven designs on textile piece goods (other than checks or stripes).

CLASS 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).

CLASS 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls) being checks or stripes.

CLASS 16.—Goods not included in other classes.

PART III.

TRADE MARKS.

INTRODUCTION.

THOUGH it has been the custom from earliest times for merchants to distinguish the goods of their own manufacture from those of their rivals by affixing to them some special symbol or device, by way of trade mark, it is only since a comparatively recent date that an exclusive right to a particular trade mark has come to be recognised by the Courts as *property* capable of being legally protected against infringement; and only within the last 50 years that this right has obtained statutory recognition, and the use of trade marks been made the subject of legislative enactment. This is all the more surprising in view of the early attention bestowed by the Legislature upon two other important species of "intellectual" property, viz. patents and literary copyright. More than a hundred years after the famous Statute of Monopolies (1624) and eight years after the passing of the first Copyright Act (1734) we find Lord Hardwicke, the then Lord Chancellor, refusing to grant an injunction at the suit of a maker of playing cards, to restrain the defendant from manufacturing and selling cards bearing the counterfeit of the plaintiff's mark, on the ground, amongst others, that he knew of no instance of the granting of an injunction to restrain one trader from

using the same mark as another, and that to impose such restraint would be fraught with mischievous consequence. This observation, however, he qualifies by the remark that if it were done with fraudulent design or to draw away customers from the rival trader, whose mark is thus appropriated, that might be sufficient to maintain an action.

In the earliest authentic instance of a successful attempt to restrain trade mark piracy, the case of *Sykes v. Sykes* in 1824, we find that fraud was made the basis of the action. Deceit and fraudulent misrepresentation were causes of action well known to the Common Law, and this was presumably the form of action most nearly suited to the circumstances of this case. For, at a time in the development of our legal system, when forms of action were stereotyped and their number strictly limited, the complaint had, perforce, to be framed to fit the action instead of, as now, the action framed to suit the complaint. If, therefore, the merchant, despoiled of his trade mark, could not bring his grievance under the head of fraud, there was no other form of action available at Common Law. The Courts of Chancery also exercised a concurrent jurisdiction in cases of this kind, and their ability to grant an injunction restraining the continuance of a fraud proved a very valuable supplement to the award of damages, the only form of redress obtainable at that time in the Common Law Courts. But even the Chancery judges for a while retained the doctrine that fraudulent intention was a necessary ingredient in an action for infringement of trade mark, and refused to grant an injunction unless the plaintiff first proved his case in the Common Law Courts. Gradually, however, the view gained ground that the owner of a trade mark has a genuine *proprietary* interest in his mark which he is entitled to have protected against invasion and infringement like any other right of property. The case of

Millington v. Fox, decided in 1884, definitely established the principle that a trader has a good right of action against any person who wrongfully assumes his trade mark, even in the absence of proof of fraudulent intent. The decision of this case signalises the full recognition, at least in the Chancery Courts, of trade marks as property capable of legal protection.

The fusion of the principles of Common Law and Equity, effected by the Judicature Act of 1873, brought the Common Law Courts into line with the Chancery; so that in the Common Law action, which still survives under the name of a "passing off" action, the plaintiff is no longer required to prove fraud, but merely that the "get up" of the defendant's goods actually did mislead, or was calculated to mislead, the public into believing them to be the goods of the plaintiff's manufacture.

The proprietary right of a trader to the exclusive use of his particular mark having been judicially recognised, the next step was to provide adequate means for its protection. Infringement was very rife, particularly through the importation of spuriously marked goods from abroad. But the extreme costliness of the procedure entailed by the Common Law action and the uncertainty of success except in the clearest cases discouraged the public from invoking the aid of the Courts. For, in order to prove his case, the plaintiff in an action for infringement of trade mark had, in the first place, to show that his mark had acquired a public reputation, and that goods bearing it were associated in the public mind with goods of the plaintiff's manufacture as distinct from those of all other manufacturers. To prove this, it was necessary to summon a cloud of witnesses and array a mass of evidence, the cost of which usually devolved upon the plaintiff, even though he were successful, since in most cases the infringers were mere men of straw. That this burden should be put upon traders seeking to

protect their legitimate rights was naturally felt to be a great hardship and evoked loud complaint from the mercantile community. A Parliamentary Commission was summoned in 1862, to consider the amendment of the law with a view to remedying these grievances. The outcome of their report was the passing of the Merchandise Marks Act of 1862 and later the Trade Marks Registration Act of 1875. The object of the first Act was to arm the Courts with summary jurisdiction to deal with the grosser forms of trade mark piracy, such as the deliberate forgery of a mark, and to make certain other fraudulent dealings with trade marks punishable as criminal offences. This Act was amended by the Merchandise Marks Act of 1887 which, as amended by the Acts of 1891 and 1894, still remains in force.

The Trade Marks Registration Act of 1875 introduced a new era in the history of trade mark law, and the principles which it formulated have, in the main, been adhered to up to the present day.

The object of this Act was two-fold. It was designed to afford protection to the trader on the one hand, and to the public on the other, against the abuse of trade mark rights. A register of trade marks was established and placed under the control of the Commissioner, afterwards the Comptroller, of Patents. Registration was not obligatory, but it was made a condition precedent to the bringing of an action for infringement of trade mark. The appearance of a trade mark on the register was accepted as presumptive evidence of the right of the registered owner to the exclusive use of that mark upon the goods in respect of which it was registered; and, after 5 years, registration was treated as conclusive evidence of the registered owner's title to his trade mark. This relieved the plaintiff in an action for infringement of trade mark from the necessity he had previously been under of first proving his exclusive title to the trade mark in

question. In the interest of the public, on the other hand, the Act required the publication of all registered trade marks and their definite appropriation to certain classes of goods, so that any member of the public might know, by inspecting the register, the precise features and scope of any particular trade mark for which an exclusive right of use was claimed.

All trade marks, however, were not admitted to the register. To be capable of registration the Act required that the mark should possess certain "essential particulars." Precisely what these "essential particulars" were is now unimportant, since they have undergone modification in subsequent Statutes; but it should be observed that there was one serious flaw in the catalogue of registrable trade marks, which greatly detracted from the value of the new Act to the commercial community. It excluded from registration all marks consisting of "fancy names" or, as they are more generically termed, "word-marks"—a species of trade mark which has always been exceedingly popular and extensively used. An exception was, however, made in favour of word-marks which had been used prior to the passing of the Act.

The aim of the Act was to limit, for the future, the kind of trade mark in respect of which exclusive rights could be acquired; but, in discountenancing the use of word-marks, the Legislature had gone too far. No sooner had the Act come into force than its framers perceived that it shut out from protection numerous traders who had already acquired valuable rights in marks, devoid of the prescribed "essential particulars" and therefore incapable of registration. To remove this injustice, a short Act was passed in the following year to the effect that owners of old marks, registration of which was refused, might upon satisfactory proof of title obtain a certificate of refusal which placed them practically in the same position as regards the

institution of proceedings for infringement as if their mark had been registered. The removal of the ban upon the registration of new word-marks was not effected till 1883.

The Act of 1875 has been dealt with at some length because its provisions, though long since repealed, embody the principles and plan which have, with comparatively minor modifications, formed the basis of all later legislation.

The subsequent amendments of the law may be treated in a more summary manner. The Patents, Designs and Trade Marks Act of 1888 repealed the Act of 1875, but re-enacted it again without substantial alteration beyond sanctioning the registration of trade marks consisting of "fancy words" or words not in common use, but geographical names and words describing or commending the quality of goods were expressly barred from registration.

Desirable as was the amendment of the Act of 1875 in regard to the qualified admission of word-marks, the phraseology chosen could not have been more unfortunate. The Courts were driven to despair in their endeavours to agree upon a definite meaning to be attached to the expression "fancy word." Ultimately it was decided that the word must be "obviously meaningless" to the average Englishman, and that it must be "notoriously inappropriate" to the character of the goods. Words containing the slightest glimmering of a meaning were rejected as either descriptive or deceptive. "Bovril" passed muster, but "Triticumina," as applied to wheat meal bread and biscuits, was rejected as descriptive.

An amending Act of 1888 abolished this troublesome phrase and substituted for it "an invented word or invented words." But this change did not much improve matters, at any rate for a while. For, following the previous decisions, the Courts still adhered to the view that the "invented word" must be a word having no reference to the character

or quality of the goods. Thus, such words as "Emolliorum" as applied to harness paste, "Satinino" as applied to starch and soap, and "Electrozone" as applied to electrically treated chemical substances, were held to be descriptive. The "Somatose" case (*Farbenfabriken Application*) may be quoted as an illustration of the absurd length to which this view was pushed. The word "Somatose" was sought to be registered as applied to a new extract of meat. Registration was refused and the decision of the Comptroller was upheld by Mr. Justice North, who considered the word descriptive "in that it had reference to the applicability of the goods to the human body"; "Somatose" being, so it was alleged, suggestive of "sōmatos," the genitive case of the Greek word for "body." Things had come to such a pass that it was hard indeed to find any "invented word" that would be proof against the discovery of some covert allusion or hidden meaning sufficient to destroy its registrability. Fortunately, at this juncture, the House of Lords was called upon, in the famous "Solio" case, to interpret the meaning of this much canvassed expression. The Eastman Photographic Company sought to register the word "Solio" in connection with photographic printing. The Comptroller refused to register the word, on the ground of its supposed derivation from "Sol" (Sun), and his decision was affirmed by the Court of First Instance and the Court of Appeal. Undeterred, however, the applicants appealed to the House of Lords. The appeal succeeded, and their Lordships ordered the registration of the word, holding that "Solio" was clearly an "invented word" within the meaning of the Act. Several of the earlier cases were reviewed and disapproved, and the principle was laid down that, provided the trade mark was a newly coined and genuinely invented word, the requirement of the Statute was fulfilled, and it was no objection to a word that it might be traced to a foreign

origin or contain a covert or skilful allusion to the character and quality of the goods.

This decision re-opened the register to a large number of word-marks which, had the trend of previous decisions remained unchecked, would undoubtedly have been excluded. But in spite of this, there were still a great many valuable trade marks disqualified from registration by the existing law. The statutory restriction placed upon the registration of word-marks was designed to counteract any attempt to monopolise the use of words which are essentially common property and which everybody has an equal right to use. "There is a perpetual struggle going on," said Lord Justice Fry, "to enclose and appropriate certain little strips of the great open common of the English language." In endeavouring to combat this tendency, the Legislature had prescribed a test which was by no means infallible in distinguishing between trade marks suitable and unsuitable for registration. Consequently, many widely used and recognised trade marks were excluded. To protect these from piracy the trader had to fall back upon the Common Law action against the infringer for "passing off his goods as and for the goods of the plaintiff": or else he could have recourse, if the circumstances justified it, to proceedings under the Merchandise Marks Act of 1887. In either case he was put to the expense of proving the reputation of his mark.

Moreover, in other respects also the working of the Trade Marks Acts proved unsatisfactory. The practice had grown up of requiring the applicant for registration of a trade mark to *disclaim* everything except the "essential particular" of the mark. This was injurious to the applicant in two ways. The effect of such a disclaimer was held to be that the applicant lost all exclusive right to use the matter disclaimed notwithstanding that it had come to be associated in the public mind with goods of his manufacture.

Even in a "passing off" action the plaintiff was debarred from urging an exclusive claim to matter he had been obliged to disclaim for purposes of registration.

The refusal by the English Office to register a trade mark without the insertion of a disclaimer had also an injurious effect upon applications to register the same mark in foreign countries, and was made the ground of refusal to register such marks although they might be, and not infrequently were, registered afterwards upon the application of a rival trader.

Another serious drawback in the existing state of the law was the liability to which traders were exposed of having their marks struck off the register even after the lapse of 5 years, on the ground that at the time of registration the mark failed to comply with the requirements of the Statute. Section 76 of the Act of 1883 declared, in what at the time appeared to be unequivocal language, that, after 5 years, registration should be conclusive evidence of the registered owner's right to the exclusive use of the trade mark. Nevertheless the Courts succeeded, with strange perversity, in interpreting this to mean that registration, after 5 years, was conclusive evidence of his right only so long as his mark remained on the register, but that it did not debar any "aggrieved" member of the public from applying, even after the expiry of 5 years, to expunge the mark from the register on the ground that it had been improperly registered in the first instance.

The Trade Marks Act of 1905 deals with all these points. With the object of allowing the public greater latitude in the choice of a registrable trade mark, it has slightly remodelled the list of "essential particulars," so that it now admits to the register every mark deserving registration; that is, every mark which is in fact used or can be used as an honest and effective trade mark. It modifies

the practice with regard to disclaimers and introduces a clause giving the proprietor of a trade mark that has been registered for 7 years absolute security against attack on the ground of initial defect in the registration of the mark. In addition to these changes there are various other salutary amendments of a minor character which will be alluded to in due course. The Act is a comprehensive one. It is an attempt to codify the entire civil law dealing with trade marks. The only section of the law which it does not embrace is that relating to the protection of trade marks under the International Convention. It was found impossible to transplant this from its old setting in s. 103 of the Patents, Designs and Trade Marks Act of 1883 (now s. 91 of the Patents and Designs Act, 1907, and it consequently remains there). With this one exception, however, the whole of trade mark law is now to be found in the Act of 1905, and all the provisions relating to trade marks in preceding Acts (except the Merchandise Marks Acts) are accordingly repealed.

Though the statutory connection between trade marks and patents has been severed, the registration of trade marks still forms an important branch of the work discharged by the Patent Office and remains under the direct supervision of the Comptroller-General. It should be added that where reference is made to this official in the following pages, he will usually be designated by his statutory title of "Registrar."

CHAPTER I.

MEANING OF TRADE MARK.

THE habitual association of trade marks with letters patent, as kindred topics, suggests perhaps a closer affinity between these subjects than in reality exists. Indeed, from a legal point of view, trade marks have but little in common with patents. Both, it is true, confer monopolies; but with that the likeness begins and ends. In other respects a comparison between these two species of monopoly is marked rather by contrasts than by analogies.

A patent monopoly is based upon the material and inherent character of the patented article by whomsoever manufactured or sold; a trade mark, on the other hand, has a purely personal significance and denotes only that the goods are manufactured or sold by some particular person or persons: whenever it comes, as by usage it sometimes does, to signify the goods themselves irrespective of their origin, it ceases at once to be an effective trade mark. Registration of a trade mark is not, like a patent, granted as a reward of merit. The public derive no benefit from it beyond the assurance which it conveys that the proprietor of the mark is responsible for the quality of the goods to which it is applied. But a trade mark is not in any sense a guarantee of quality; it warrants neither excellence nor uniformity. A man who buys goods bearing a certain mark which he has been accustomed to associate with first rate quality, has no actionable grievance against the vendor, if the goods turn out to be of inferior quality. No doubt, in practice, a trade mark comes to be regarded

by the public and is generally treated as a guarantee that the quality is up to a certain standard, but it should be remembered that that is a purely gratuitous assumption, and if the public act upon it, they do so at their own risk.

The monopoly granted by a patent has a strictly limited duration; but the monopoly secured by a trade mark continues so long as the trader is minded to keep up its registration, or so long as he has skill and industry to keep his mark before the public as the symbol of his manufacture.

Finally, in the case of a patent, it is registration, in the shape of the patent grant, that actually confers the monopoly; without it the inventor has no legal right to the exclusive use of his invention. But registration of a trade mark on the other hand is, in a large number of cases, nothing more than the official endorsement of a right already existing and created by dint of public user of the mark. It is in the nature of collateral security, furnishing the trader with a cheaper and more direct remedy against infringers. Cancel the registration, and he has still his right, enforceable at Common Law, to restrain the piracy of his trade mark, provided, of course, he can prove that such piracy amounts to an imposition upon the public.

The foregoing comparison serves to indicate broadly the general nature and function of trade marks. For an accurate definition we may turn to the third section of the Trade Marks Act of 1905.

After premising that a "mark" shall include a "device, brand, heading, label, ticket, name signature, word, letter, numeral, or any combination thereof," the Act proceeds to define a trade mark as—

"A mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection certification, dealing with or offering for sale."

This definition (the first attempt of the Legislature to define a trade mark, crystallises into comparatively simple and definite shape the effect of the numerous cases in which the legitimate scope and character of a registrable trade mark have been judicially determined. Simple and precise though the language be, it requires, nevertheless, a little expansion and analysis to explain its full significance.

In the first place it is to be observed that actual use of a trade mark or at least a *bonâ fide* intention to use it in connection with certain definite goods continues to be, as it always has been, the only legitimate basis and justification of admission to the Register. By way of introduction to this proposition it should perhaps have been explained that, for the purpose of registration, merchantable goods are arranged in various classes, some 50 in number; and an applicant for registration is required to specify the class, or, if the class is large and miscellaneous, the particular *descripton* of goods in respect of which he desires to register his mark. This classification is designed to correspond approximately to the conventional grouping of commodities in commerce, whilst at the same time the classes are made as comprehensive as possible, in order to avoid multiplicity of registration. But, like all methods of classification, it has its defects. A glance at the various classes shows at once that there is considerable overlapping, necessitating in many cases the registration of a trade mark for the same commodity in two or more classes. Thus, for instance, a trade mark for a new effervescing powder possessing medicinal as well as nutritious properties would have to be registered in Class 3, viz., "Chemical substances prepared for use in medicine and pharmacy," as well as in the Food Class.

The proprietor of a trade mark registered in a particular class is not entitled to the exclusive use of the mark in respect of all goods comprised in the class, simply because

he has registered the mark for the whole class without discrimination. To substantiate his claim, he must show actual user. If in fact the mark is used only in connection with a small group of the goods falling within a multifarious class, it becomes an encumbrance on the Register, and any person hampered by it may apply to have it removed or the registration confined to the goods actually traded in. Thus, in the case of *Hart's Trade Mark*, a trader had registered a Red Rose Device for the whole of Class 42, that is for "Substances used as food or ingredients in food," but had in practice only used the mark for part of the class and not for condensed milk, which he had dealt in under different marks. Another trader, who had for some time been using the same device in connection with condensed milk, subsequently applied to register it. On being refused, on the ground that the mark was already registered for the whole of Class 42, he applied to the Court to have this obstructive mark expunged, or limited so as to exclude condensed milk. The Court decided that the registered mark must be limited in the way desired, and that the applicant was entitled to have his mark entered on the Register in respect of condensed milk.

In the absence of actual user, a *bona fide* intention to use the mark in respect of the goods in question is essential to the validity of the registration. In the case of a new trade mark tendered for registration, an intention to use will ordinarily be presumed. If, however, it is proved that the applicant does not in fact intend to use the mark himself in the way of trade, but only for the purpose of obstructing others from using it, registration may be refused or, if allowed, may be subsequently impugned.

The registration of the words "Hunyadi Janos" by the Apollinaris Co. may be cited as a case in point. This mark was the property of Mr. Saxlehner, the owner of the spring from which "Hunyadi Janos" water came. In

order to prevent the importation into England of mineral water labelled with this mark, the Apollinaris Co., with the assent of Mr. Saxlehner, registered the words "Hunyadi Janos" in England as their own trade mark. They did not use, nor did they intend to use, the label themselves. It was held that the registration was improper and must be expunged (*Apollinaris Co.'s Trade Mark*).

By s. 37 of the Act of 1905, any person "aggrieved" may apply to have a registered mark removed from the Register on the ground that it was registered without any *bona fide* intention to use it, or on the ground that it has not in fact been used in connection with the goods for which it was registered during the five years immediately preceding the application. The registered owner may, however, save his mark if he can adduce reasons justifying such non-user.

The statutory definition of a trade mark postulates further that the trade mark must be used "upon or in connection with" the goods. Mere association of goods with a particular mark is not sufficient; to draw the definition as wide as that would involve the inclusion of advertisements, trade circulars and the like within the category of trade marks. The connection between a trade mark and the goods to which it is applied must be exceedingly intimate. Strictly speaking, the mark should be physically attached or affixed to the goods themselves, for example by being impressed or branded upon them or attached in the form of a label, tally or wrapper. The important point is that the mark should go to the market with the goods, that it should be upon them when they come under the purchaser's eye, so that he may identify them as coming from a particular trade source.

The question, how close the connection between goods and trade mark must be, has occasioned considerable controversy in the Courts. A good illustration is afforded

by the "Yorkshire Relish" case (*In re Powell's Trade Mark*). In that case the manufacturers of the well-known sauce had been in the habit of stencilling the words "Yorkshire Relish" on the four sides of the large wooden packing cases containing the bottles. The bottles themselves also bore distinctive labels with a different mark. The question raised was whether this use of the words "Yorkshire Relish" constituted a user of the words as a trade mark. The Courts held that it did not, the ground of their decision being that it was not the words on the packing case that sold the goods but the mark on the bottles. Whatever might be the result, were these facts to be retried with reference to the definition contained in the Act of 1905, it is clear that the same principle applied to the use of a branded packing case in connection with goods of another kind might well lead to an entirely different conclusion. For instance, the use of a distinctive mark upon a case containing fruit or tobacco would, beyond doubt, be a use of the mark "in connection with" the goods within the meaning of the statutory definition.

A trade mark may consist of several physically separated parts, the registration covering only the entire combination. The component parts of the trade mark must, however, all be used together, though they need not necessarily be connected or even visible at the same time. Thus, in *Crompton & Co.'s Trade Mark*, the registered mark consisted of three different sized labels, used by pasting the largest and smallest on different sides of the outside wrappers of bundles of yarn and the medium label on the inside wrappers. This was held to be a legitimate method of using the mark.

The inclusion of marks of certification in the category of trade marks also deserves note. Prior to 1906, the name "trade mark" was applicable only to marks affixed to goods *traded in by the person affixing the mark*: it might be

the manufacturer, the retailer, the selector or any other person dealing with the goods in the way of trade. The Act of 1905, however, authorises the registration, subject to the approval of the Board of Trade, of certain special marks, which are not trade marks in the above sense, but are marks used by persons or associations who undertake the analysis or standardization of goods submitted to them, without having any commercial interest in the articles themselves. As an instance of such a mark might be cited the monogram "N^o." signifying that the goods have been analysed or standardized by the National Physical Laboratory at Teddington, or the letters "L.R." used upon shipbuilding materials to denote that they have been passed by Lloyd's surveyors.

So much for the statutory definition. There is, however, one important attribute, omitted from the definition, which a mark must nevertheless possess in addition to those already mentioned, in order to be effective as a trade mark, and that is *distinctiveness*. A trade mark must distinguish or be capable of distinguishing the goods of the owner of the mark from the goods of all others. It must not be of such a character as to lend itself to confusion with somebody else's trade mark, or to encroachment upon the rights of the public generally. In other words, no person may lay claim to an exclusive right in a mark which will clash with a mark already appropriated by another, or which tends to monopolise words or symbols that may fairly be reckoned as public property and therefore unbecoming individual appropriation.

Recognising the necessity of safeguarding the rights of the public in this respect, the Legislature has, ever since the first Trade Marks Registration Act of 1875, laid it down as a condition of registration that a trade mark must possess certain distinctive characteristics, termed in the Act "essential particulars," of which at least one must be

present to qualify the mark for registration. The list of "essential particulars," prescribed by the earlier Acts, has undergone no radical alteration in the Act of 1905. Such changes as have been introduced have all been made either with the object of clearer definition or of enlarging the "area of registration," so as to admit to the Register as nearly as possible all marks which are in fact distinctive and effective trade marks.

Since, for the adequate protection of a new mark, registration is of the utmost importance, it is very necessary, in selecting a mark, to see at the outset that it possesses the requisite characteristics to qualify it for registration. This point is frequently overlooked, with the consequence that traders, who have gone to considerable expense in advertising and creating a market for their goods under some newly invented trade mark, discover upon subsequently applying to register it that it cannot be registered, either because it fails to comply with the provisions of s. 9 of the Act, that is to say, it is deficient in some "essential particular," or because it too nearly resembles some mark already upon the Register. To avert the risk of refusal on the latter score, an applicant can easily take the precaution of searching the Register himself or of having an official search made (see p. 320).

To obtain a thorough grasp of the conditions with which a trade mark must comply in order to be proof against objection under s. 9 is, however, not quite so simple a matter. This is a fundamental section and will require somewhat detailed discussion; it will, therefore, be best to defer its consideration for a separate chapter.

CHAPTER II.

QUALIFICATION FOR REGISTRATION.

SECTION 9 of the Trade Marks Act of 1905 provides that a registrable trade mark must contain or consist of at least *one* of the following essential particulars :—

- (1) The name of a company, individual or firm represented in a special or particular manner.
- (2) The signature of the applicant for registration or some predecessor in his business.
- (3) An invented word or invented words.
- (4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname.
- (5) Any other distinctive mark ; but a name, signature or word or words other than such as fall within the descriptions in the above paragraphs (1), (2), (3) and (4), shall not, except by order of the Board of Trade or the Court, be deemed a distinctive mark.

Provided always that any special or distinctive word or words, letter, numeral or combination of letters or numerals, used as a trade mark by the applicant or his predecessors in business before the thirteenth day of August, 1875, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application for registration, shall be registrable as a trade mark under this Act.

For the purpose of discussion it will be convenient to take this section in detail, dealing with the sub-sections in order.

(1) The Name of a Company, Individual, or Firm Represented in a Special or Particular Manner.

This sub-section requires little comment. It should be observed however, that it is not permissible to register under this head the name of a fictitious or mythological person as the name of an "individual." Thus "Trilby" has been held not to be a name within the meaning of the sub-section, and such names as "Hamlet," "Jupiter" and "Venus" would similarly be inadmissible in this category of trade mark; but there is no reason why they should not be registered as "words" under sub-s. (4) provided they are neither descriptive nor geographical. Further, the name should be registered in the nominative case. Under the old sub-section (from which the new sub-section does not materially differ) the Courts held that the registration of a name in the possessive case, *e.g.*, "Pirie's Parchment Bank," was bad.

The applicant is not limited to his own name; but if he seeks to register the name of some well-known person, living or recently deceased, the Registrar usually requires to be satisfied that the proper consent has been obtained before allowing the registration to proceed.

The name may be printed, woven or impressed; but the lettering must be distinctive; ordinary typographic printing or even common fonts of ornamental type will not be so considered.

(2) The Signature of the Applicant for Registration or some Predecessor in His Business.

This "essential particular" is merely a specialised form of the preceding one. The signature must be that actually

used, as the *bonâ fide* trading style, in the ordinary course of business. Descriptive trading styles such as the "Millenium Baking Coy." or the "Anti-Corpulency Soap Syndicate" will not be accepted. But these names, if represented in a "special and particular manner," could, of course, be registered under sub-s. (1).

A signature has always been a popular form of trade mark. But, unless its characters are unusually bold and fantastic, the margin or protection it gives is narrow. For the exclusive right conferred by registration is confined to the use of the name solely in the distinctive form in which it is registered, and other persons bearing the same name are equally entitled to come and register their signatures as trade marks. If, therefore, Mr. Brown or Mr. Jones relies upon his autograph for a trade mark, he is likely to find it very inadequate security.

Generally speaking, every man has a right to use his own name in connection with his business. But this proposition cannot be allowed to pass without qualification. For instance, where a man uses his own name or assumes somebody else's name for the purpose of trading upon another's reputation and dishonestly profiting by the goodwill of another's business, the law will interfere to stop this abuse. Thus, to take an old case, where a man named Martin associated himself with a person named Day for the purpose of carrying on business as manufacturers and vendors of boot blacking, manifestly with the object of trading upon the reputation of the old-established firm of Day & Martin, they were restrained by injunction from so doing.

The Courts grant this relief, quite apart from any right the plaintiff may have under the Trade Marks Act, acting upon the well-known principle that no man has a right to represent or "pass off" his goods as the goods of another; and whether the public are deceived by the name of the

vendor or by the "get up" of the goods is immaterial as affecting the principle.

More recent examples of the application of this principle are to be found in *Valentine Meat Extract Co. v. Valentine Extract Co., Ltd.*, and *J. & J. Cash, Ltd. v. Joseph Cash & Co.* In the former case, the defendant company (one of the directors of which bore the name Valentine) was absolutely restrained by injunction from using the name "Valentine" in connection with extract of meat. In the latter case, in view of the evidence that to the ordinary purchaser "Cash's Frillings" meant the plaintiffs' goods, the defendant was restrained from selling frillings under the name "Joseph Cash & Co.," without taking reasonable precautions to clearly distinguish his business and frillings from those of the plaintiffs.

(3) An Invented Word or Invented Words.

The history of the controversy that has raged round the interpretation of the expression "invented word" and its predecessor "fancy word" has been briefly sketched in the introductory chapter. Having reached a point of hyper-criticism at which it was impossible to predicate of any word that it was an "invented word" within the meaning of the Act, the trend of judicial decisions was opportunely turned by the decision of the House of Lords in the "Solio" case (*Eastman Photographic Materials Co.'s Application*). The principles laid down in that case govern the interpretation to be placed upon the expression "invented word" in this sub-section.

The word must be one hitherto unknown to the English vocabulary and not occurring at any rate in the more commonly understood foreign languages. The fact, however, that the root or one or more syllables of the word may be recognisable as English or foreign words will not

disqualify the word; but there must be some genuine invention about it. A mere variation in the orthography or termination of a word will not do. For example, "Panoram" as applied to photographic cameras and films, and "Absorbine" as applied to absorbent ointment, were held not to be genuinely "invented words."

The coalition of two or more well-known words into a single portmanteau word, such as "Cheapandgood," does not constitute an "invented word"; and misspelling does not improve the case, if to the ear the words are still merely common words run together. Thus the word "Uneeda" was held not to be an "invented word"; and similarly "Phiteesi" would not comply with the requirements of the sub-section. But a combination of words from a foreign language, so little known in this country as to be meaningless to all but a few scholars, would probably pass muster as an "invented word." Thus, "Mazawattee" (*In re Densham's Trade Mark*) was held to be properly registrable, though both "maza" and "wattee" are well-known words in Hindustani and Cingalese respectively.

The word should be newly coined at the date when it is adopted as a trade mark: it need not, however, necessarily be the invention of the applicant. The following are examples of words upheld by the Courts as "invented words":—*Kynite*, for explosives: *Tachytype*, for typographical machines: *Neostyle*, for stationery: *Kodak*, for cameras. Examples of words expunged as not falling within this sub-section or its prototypes are:—*Somatose*, for an extract of meat: *Perle*, for cloth: *Satinine*, for starch and soap: *Panoram*, for cameras: *Bioscope*, for cinematograph apparatus; but the last-named was disqualified on the ground that it was not new when first used by the applicant as a trade mark.

- (4) **A Word or Words having no Direct Reference to the Character or Quality of the Goods, and not being according to its Ordinary Signification a Geographical Name or a Surname.**

It is obvious that if words descriptive or commendatory of the quality of the goods were allowed to be registered as trade marks, the rights of the public might be very seriously abridged. For example, to take a gross case, it would be manifestly unfair to the rest of the commercial community if any one person were allowed to monopolise the word "best" as applied to butter, or "fresh" as applied to eggs. But it is not only in the case of such obviously descriptive or encomiastic phrases as these that registration has been refused in the past. Construing the wording of the old sub-section, "having no reference to," in the strictest possible sense, the Courts were astute to disqualify many words as being descriptive which to the ordinary lay mind can at most be regarded as remotely allusive, and then only by putting upon them a somewhat strained and far-fetched interpretation.

Thus "John Bull," as applied to beer, was held by the Court of First Instance to be a mark having reference to the character and quality of the goods, the allusion being extracted in the following somewhat circuitous manner. After referring to the Century Dictionary, which explains the name as denoting "the coarse burly form and bluff nature ascribed to the typical Englishman," the judge observed: "without going further, you at once have some description or designation of the article, either that it is made in England or that its character is that which suits Englishmen." In more recent times, the Court has refused to sanction the registration of "Nectar" as applied to tea; and "Century," as applied to printing machinery, has been held to be disqualified, as being a commendatory phrase

importing that the article was the best made in the century. The introduction into the Act of 1905 of the qualified expression "having no *direct* reference" is clearly designed to counteract the overstringent tendency of previous decisions and to inaugurate a somewhat milder censorship over this class of trade mark.

The principle of refusing to allow anyone to acquire by registration the exclusive right to use a geographical name as a trade mark is obviously reasonable. To permit a boot-maker, for instance, to register the name "Northampton" as his trade mark and so prevent any competitor in that locality from using the name "Northampton" in connection with his goods would be a manifest encroachment upon the just rights of the latter and a limitation upon the freedom of trade. But where the name is adopted and used without any geographical significance, it will not be disqualified merely because it happens to be the name of a coral reef in the Pacific Ocean or a peak of the Himalayas. There could be no possible objection, for example, to "Sahara" stoves, or to a tobacconist registering "Matterhorn" or "Monte Rosa" cigarettes. "St. Paul's" as applied to soap has been held not to be geographical, and "Magnolia" as applied to a new antifriction metal, though objectionable on other grounds, was held not to be disqualified by the fact that there were several obscure places in America bearing that name. But the mere obscurity of the place cannot be pleaded in defence of the trade mark if the name is really a local name, and chosen because of the connection of the article with the locality. An instance of this is to be found in the case of the word "Apollinaris" given to the water from a spring known as the Apollinaris spring.

It sometimes happens that a name, not originally descriptive, acquires in course of time a secondary meaning and becomes the ordinary appellation of the goods to which it is applied. A classic instance of this is furnished by the

“Linoleum” case (*Linoleum Co. v. Nairn*). The word “Linoleum” was coined by the inventor to designate a new kind of oilcloth. The invention was patented. Upon the expiry of the patent, the assignees of the inventor's rights strove to retain a monopoly of the word. It was held, however, that “Linoleum” was the only name by which that particular kind of floorcloth was known, and consequently, the word being descriptive, no claim to its exclusive use could be maintained.

Similarly in the “Magnolia” case, alluded to above, the Court of Appeal refused to allow the ex-patentees to monopolise the name “Magnolia” after the expiration of the patent, and laid down the general principle that “when an article is made under a patent or a secret process, the manufacturer cannot, after the patent has expired or the secret process been discovered, claim a monopoly in a name which does not distinguish the article as being of his manufacture.” Other instances of a similar kind of expropriation have occurred in the case of the names “Singer,” as applied to sewing machines, and “Dunlop,” as applied to pneumatic tyres. But where a person invents a new article and at the same time invents a new name to designate it, but does not patent it or keep the process secret, so that others are at liberty to manufacture the same article under any name they choose, it is doubtful whether the above rule would apply to preclude the inventor from establishing a monopoly in the word and registering it as his trade mark.

These were, in substance, the facts in the “Vaseline” case (*In re Chesebrough's Trade Mark*); with this difference, that before applying to register the name, the inventor had already established a reputation as sole manufacturer of “Vaseline,” and though the same material was sold under other names, such as “petroleum jelly,” “unguentum petrolei” and the like, his was the only manufacture desig-

nated by the word of his own invention. In view of these facts, the Court of Appeal held the word "Vaseline" to be properly registered as a trade mark. The decision was, however, the other way in the somewhat analogous case of *Leonard & Ellis's Trade Mark*. There the inventors of an improved lubricating oil to which they had applied the newly coined name "Valvoline" had used the word not as a trade mark, *i.e.*, to designate oil of their own manufacture, but rather as describing the character of the oil itself. It should be added, moreover, that "Valvoline" was the only name by which this particular kind of oil was known. Upon these facts the word was held to have been improperly registered.

- (5) **Any other Distinctive Mark ; but a Name, Signature, or Word or Words, other than such as fall within the Descriptions in the above Paragraphs (1), (2), (3) and (4), shall not, except by Order of the Board of Trade or the Court, be deemed a Distinctive Mark.**

This comprehensive sub-section has been not inaptly likened to Aaron's snake, in that it swallows up all the other sub-sections. In the first place, it includes every species of mark, not already mentioned in the foregoing sub-sections, such as pictorial and ornamental devices, letters, numerals and the like, distinctiveness being made the sole condition of registration. Secondly, it admits to the Register, subject to the approval of the Board of Trade, any name-marks or word-marks which, though inadmissible under the preceding sub-sections, can nevertheless lay claim to distinctiveness in the sense that they distinguish the goods of the proprietor of the trade mark from goods manufactured by others.

The first part of the section calls for little comment except in reference to the requirement of distinctiveness.

Whether a mark is distinctive or not is a question to be determined solely by comparison with other marks used or registered in connection with the same description of goods. In making such comparison the Courts have regard to the appearance of the marks as they are in actual use, for the likelihood of deception will largely depend upon the method of branding, impressing or embossing a mark or upon the colour in which a mark is printed.

In the case of device-marks, distinctiveness should reside in the broad outlines of a design rather than in a number of small details. For example, a bell has been held to be non-distinctive where a bee-hive was already registered for the same class of goods; and a mere difference in *species* between birds or animals appearing in similar postures as trade marks upon competitive goods has been held to be an insufficient element of distinctiveness.

A picture or device may lose its distinctive character through sheer popularity as an advertising medium, though never actually used as a trade mark. Thus Gainsborough's famous portrait of the Duchess of Devonshire was held not to be distinctive as a trade mark for millinery, as it had long been in common use in the hat and millinery trade for all purposes except by impression on the goods themselves (*Louise v. Gainsborough*).

Where an ornamental or pictorial device has been registered, no mark will be regarded as distinctive which consists in a description of such device. For instance, where the device of a star had been registered as a trade mark for glass, the words "Red Star Brand" subsequently registered by a rival glass merchant were held not to be distinctive, and the mark was accordingly expunged (*Société, etc., des Verrieres de l'Etoile's Trade Mark*).

Trade marks which consist in pictorial representations of the goods to which they are applied are not considered distinctive and will be refused registration. In judging of the

distinctiveness of word-marks, the test of both eye and ear must be applied. Words may be spelt very differently but sound much the same.

The following words have been held to resemble each other so closely as to be calculated to deceive:—

Cocotina	and	Cocaotina	as applied to beverage
Stephen's	..	Steel pens ink
Apollinaris	..	Apollinis mineral waters
Secotine	..	Securine gum
Tabloid	..	Tablone drugs
Iron-ox	..	Iron-oxide tonic

On the other hand, the Courts have held that in the case of the following words there was sufficient dissimilarity to negative the probability of confusion:—

Ivy	and	Ivory	as applied to soap
Colloline	..	Cocosoline butter
Lancashire	..	Lanco belting
Pianola	..	Neola mechanical piano players

Word-marks as applied to cotton piece goods are declared by Statute (s. 64, sub-s. (10) of the Act of 1905) to be non-distinctive and may not be registered for such goods except in combination with some other device. For to the Oriental, unacquainted with our language, one English word looks much like another of the same length. Line headings also, as applied to cotton piece goods, have lost their distinctive character owing to the infinite multiplicity of this kind of marking; a cotton mark, therefore, consisting of a line heading alone is similarly disqualified from registration.

Prior to 1906, colour was not taken into account as conferring distinctiveness upon a mark. Consequently many trade marks, which were in fact distinctive, were excluded from the Register. Take for example the familiar "Red,

White and Blue " label—a tricolour flag—distinguishing the coffee of a well-known firm. Deprived of its colour, this mark appears simply as three parallelograms placed side by side, a commonplace geometrical figure, devoid of distinctiveness. Apart from colour, therefore, it was incapable of registration. The Act of 1905 has altered this rule, and gives to colour its proper value as an element of distinctiveness. Section 10 provides that a trade mark may be limited in whole or in part to one or more specified colours, and in such case the limitation as to colour will be taken into consideration in deciding whether the mark possesses the requisite distinctiveness. If no particular colour is specified, the mark is deemed to be registered indifferently for all colours.

The second part of the section introduces an innovation of considerable importance. It marks the recognition of the fact, hitherto ignored by the Legislature, that there are trade marks (chiefly word and name marks) which when tested by the criteria of distinctiveness prescribed in the preceding sub-sections are found wanting, but which, none the less, have acquired as a commercial fact a distinctive character and have become effective and valuable trade marks. Experience has shown that words which are descriptive or geographical in their primary sense sometimes acquire, by long association with the manufacture of a particular person or firm, a secondary meaning that is as distinctive as any trade mark could be. Two instances will illustrate this. "Camel Hair," as applied to machine belting, is obviously descriptive and therefore *prima facie* incapable of registration. It was, however, claimed by Messrs. Reddaway, who had for many years sold belting under this description, that the words had become distinctive. As the result of a "passing-off" action brought by that firm to protect their alleged right to the exclusive use of these words, it was finally held in the House of Lords

that the words "Camel Hair," as used in the trade, had in fact become distinctive and designated the goods of Messrs. Reddaway as distinct from the goods of all others (*Reddaway v. Banham*).

Similarly, in the "Stone Ale" case (*Thompson v. Montgomery*), a name primarily geographical acquired a distinctive meaning. There it was held by the House of Lords that the local name "Stone," as applied to ale, designated ale brewed or sold by the plaintiffs, who had carried on business as brewers at Stone in Staffordshire for upwards of a century. The Court accordingly granted them a perpetual injunction against a rival brewer, who had established himself in the same town with the intention of selling his ale as "Stone Ale" and so trading on the plaintiffs' reputation.

But in neither case could the owners of these marks, successful though they were in vindicating their right to exclusive user, obtain registration under the old Acts; for "Camel Hair" was plainly descriptive, and "Stone" was undeniably a geographical name. The latter part of sub-s. (5) is designed to remedy this anomaly and to render such marks registrable, subject to the Court being satisfied as to their distinctive character. "Yorkshire Relish" may be quoted as another instance of a mark previously unregistrable, though held by the Courts to be distinctive.

The list of "essential particulars" concludes with a saving clause concerning what are known as "old marks," *i.e.*, marks used prior to the first Registration Act of 1875. Its application is confined to marks consisting of words, letters, numerals, or combinations of these. Device-marks are not within the proviso. The mark must be "special and distinctive" and must have been continuously used without substantial alteration down to the date of application for registration. A word can only be properly registered as an old mark, if it has been used

alone as a mark, before 1875, and not if it has been used merely in combination with other words. Thus, in *Richards v. Butcher*, the word "Monopole" was held to have been wrongly registered as an old mark, the evidence being that, prior to 1875, it had never been used as a trade mark except in conjunction with other words or devices.

Few trade marks consist simply of the "essential particular." There is usually combined with it a certain amount of non-distinctive matter of an ornamental or literary kind to give the mark completeness. According to the practice which prevailed prior to the Act of 1905, an applicant was in all cases required to "disclaim" any exclusive right to these supplementary features or, as it was termed, "added matter." These disclaimers were endorsed upon the certificate of registration.

This practice was open to objection on several grounds. It was misunderstood by the foreign trade mark officials, when it was sought to register the mark abroad, and rendered it impossible in many cases to register a mark abroad in the same form in which it was registered in England. Further it was held by the Courts that when a person had disclaimed the "added matter" for the purposes of registration, he was thereby precluded from afterwards asserting an exclusive claim to it in a "passing-off" action.

The practice in this respect has accordingly been altered by the Act of 1905, and disclaimers are now only required in exceptional cases. Section 15 provides that if a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar (or the Court) *may* require a disclaimer as the condition of registration.

Disclaimers are, therefore, no longer required as a matter of course. It is left to the discretion of the Registrar to

determine when they are needful, and he will only insist upon their insertion in cases where there appears, upon the face of the trade mark, matter which, in his opinion, is liable to mislead the public into the belief that they are precluded from using what is in reality common property. Such a case might occur when the "essential particular" was combined with a device or words bearing a *prima facie* stamp of distinctiveness, but which in fact were open to the trade. Where the trade mark gives prominence to such common-place and obvious devices as cup and saucer or syphon and glass for beverages, or heaped fruit and flowers for perfumery, a disclaimer will still most likely be required. Also, in cases where the trade mark combines with other features a single initial letter or several letters, the Registrar will usually require a disclaimer of the exclusive use of the letters or will append a statement to the effect that the mark shall not interfere with the *bona fide* use by any person of his own initials.

The Act further provides that in cases where a disclaimer is required, it shall not affect any rights of the proprietor of the mark other than those arising out of the registration. He cannot sue for infringement of trade mark where only the words disclaimed have been taken; but he is not precluded, as formerly, from relying on them in a "passing-off" action, and adducing evidence to show that they signify goods of his manufacture as distinct from all others.

The difficulty with regard to registration abroad is met by a rule enabling the Registrar to omit from the certificate of registration all reference to any disclaimers appearing on the Registrar in cases where the certificate is required for obtaining registration in a foreign country.

CHAPTER III.

RESTRICTIONS ON REGISTRATION.

“ Ever since Courts of Equity have interfered to protect traders in the exclusive use of marks and words which they have lawfully appropriated for the purpose of distinguishing their goods, it has been an established principle that this protection is not to be extended to persons whose case is not founded in truth.” Thus does Lord Macnaghten, in the leading case of *Eno v. Dunn*, sum up the law with regard to deceptive trade marks. Reduced to the more peremptory language of the Statute, the rule appears as follows:—“ It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would, by reason of its being calculated to deceive or otherwise, be disentitled to protection in a Court of Justice, or would be contrary to law or morality, or any scandalous design.”

The most obvious case in which deception is likely to arise is, of course, where the mark tendered for registration is identical with or closely resembles one already registered or used in connection with the same description of goods. The “ same description of goods ” is, however, a phrase capable of a narrow or wide construction according to the circumstances. The case alluded to above, *Eno v. Dunn*, may be quoted as an illustration of the utmost limit to which it can be stretched. The facts were shortly these. Mr. Eno had registered “ Fruit Salt ” as his trade mark for a powder used in producing an effervescing drink ; and, as such, “ Eno’s Fruit Salt ” had a wide reputation. Ten years later Mr. Dunn applied to register in the same class

of goods the words "Dunn's Fruit Salt Baking Powder." The application was opposed on the ground that the words "Fruit Salt" were clearly calculated to deceive, and the Comptroller refused to register the mark. The opponent's contention was that the public would suppose that Eno's Fruit Salt formed an ingredient in Dunn's Fruit Salt Baking Powder, and consequently a batch of badly made baking powder might seriously injure the credit of the effervescing powder. This supposition, though seemingly improbable, was nevertheless given colour by some evidence to the effect that certain persons had, in fact, attempted to use Eno's Fruit Salt as baking powder, and apparently with success. The case eventually went to the House of Lords, and though the decision was not unanimous, it was decided by the majority that Mr. Dunn's mark was "calculated to deceive" in the sense that it was not free from reasonable risk of causing deception. That being so, the Comptroller was held to be justified in the exercise of his discretion in refusing to register it.

Similarly in a recent case (*Compagnie Industrielle des Petroles' Application*), registration of the word "Motricine" was applied for in Classes 47 and 50 for spirit for motive power purposes. The proprietors of the trade mark "Motorine," which had previously been registered in Class 47 for lubricating oil, opposed the application on the ground that the similarity of the two words was likely to cause confusion, which would be not only damaging to the proprietors of "Motorine," but a source of danger to the public. The Court held that the danger was a real one and refused to allow the word to be registered.

In estimating the danger of deception, it is not only the careful customer that the law has in view, but also, to use the phrase that has been often employed, "the unwary purchaser." But that expression must not be taken to mean the "ignorant customer," who knows nothing or very

little about the usage of the trade with regard to the "get-up" of the kind of goods in question. Lord Justice Romer emphasised this point in *Payton & Co. v. Titus Ward & Co.*, and observed that the kind of customer that the Courts ought to think of in these cases is the customer who knows what is common to the trade and is familiar with the distinguishing characteristics of the plaintiff's goods.

A mark tendered for registration may be adjudged deceptive on account of its resemblance not only to marks already registered, but also to unregistered marks in common use, and even to marks which are not strictly trade marks, such as advertising circulars and pictorial posters which have become associated in the popular mind with the goods of a particular firm. Thus, in the case of the *Sphincter Grip Trade Mark*, registration of a design representing a length of armoured fire hose, tied into an elaborate knot, was refused on the ground of its resemblance to a design shown in an advertisement of similar goods issued by a rival firm.

The mere verbal description of a device or design already registered will not be accepted, nor is the application less objectionable because the description is in a foreign tongue. In the leading case of *Dewhurst's Trade Mark* the applicants applied to register in connection with cotton goods certain words in Burmese characters, meaning "The Golden Fan Brand." There was already on the Register a design representing a golden fan, entered in respect of similar goods. Notwithstanding that the applicants had obtained the consent of the owner of this trade mark, the Court refused to allow registration.

The fact that a conflicting mark is sought to be registered in a *different class* will be no answer to the objection that it is likely to deceive, if in fact both marks relate to goods usually associated in the ordinary course of trade or likely to compete with one another. Thus the

word "Kodak," which had been registered by the Eastman Photographic Co. for cameras, was held not to be registrable by another company in respect of cycles. On the other hand, similar marks are sometimes allowed to be registered in the same class where the character of the goods is so widely different as to make the danger of confusion or deception very remote. So, where an oil and colour manufacturer had registered the mark "Rainbow" for all goods in Class I., excepting mineral dyes, and subsequently a photographer sought to register the same word in respect of photographic plates, which also fall within Class I., the latter was held entitled to registration, it being proved that he had sold photographic plates under the trade mark "Rainbow" for several years, and that the word had not been used by anyone else in connection with the photographic trade (*Hare's Trade Mark*).

Similarly in the converse case registration has been refused. Thus, in *Pomril, Ltd.'s Application*, it was sought to register a mark for cider consisting of the representation of an apple sliced in half, with "Pomril" written across it. The Comptroller declined to register this mark owing to the danger of its conflicting with another cider mark, already on the Register, consisting of the words "The Apple Brand."

The question of what amounts to deceptive similarity between two marks has already been sufficiently discussed (p. 305) in dealing with the subject of distinctiveness. It is only necessary to add that, in judging whether a mark is likely to mislead the public, the Registrar and Court look primarily to the "essential particulars." A mark is not "calculated to deceive" which resembles another only in features that are common to the trade.

In view of the Act of 1905, the general rule forbidding the registration of identical or similar marks for the same description of goods requires qualification. The Legis-

lature, recognising the fact that in some classes of goods, where the market is almost exclusively local, no harm can come of allowing two traders in widely separated markets to use the same registered trade mark, has expressly provided for the relaxation of this rule in exceptional cases. These exceptions, which are dealt with by sections 19—21 of the Act of 1905, may be summarised as follows:—

An old mark, proved to the satisfaction of the Registrar to have been in use before August 13th, 1875, may be registered in spite of its similarity to one already on the Register.

An applicant who seeks to register a new mark (*i.e.*, a mark not used prior to 1875) in the same circumstances must obtain the leave of the Court, and leave will only be granted if he can show that there is no danger of his mark clashing with or being mistaken by the public for the mark already on the Register. But the consent of the owner of the conflicting registered trade mark will not, in itself, be sufficient to satisfy the Court.

In the case of several persons claiming to be the proprietors of and desiring to register the same mark or nearly identical marks in respect of the same description of goods, two courses are open. The rival claimants may agree between themselves as to the delimitation of their respective rights, and if such arrangement appears satisfactory to the Registrar, he may direct registration to proceed subject to these terms. If no amicable arrangement can be agreed upon, the Comptroller will refuse to proceed with the registration and refer the applicants to the Court, and the Court may order the registration of these similar marks subject to such conditions and limitations as it may think fit to impose.

Where, in pursuance of the above sections, two or more persons are registered proprietors of the same or

substantially the same trade mark, no right of exclusive user is acquired (except so far as their respective rights may have been determined by the Court) by any one as against the other or others. As regards the rest of the world, however, each has the same rights as if he were sole registered proprietor of the mark in question.

Hitherto, in the case of an application to register an "old mark" where it is proved that the mark has been used by more than three different persons or firms in respect of the same kind of goods, it has been treated as open to the trade and registration refused. This is known as the "Three Mark Rule" and doubtless still applies in the case of "old marks." Whether the same rule will be observed also in regard to new marks is not clear.

In a recent case (*Hudson's Application*) a manufacturer of whistles, who had used the words "The Thunderer" upon a certain type of whistle for a considerable number of years, applied to register the name as his trade mark. Another whistle-maker who had also sold whistles under the same title applied shortly afterwards to register the same mark. The Comptroller referred these conflicting claims to the Court for determination in accordance with s. 20 of the Act. The evidence at the trial showed that, besides the two claimants, four or five other firms had been selling "Thunderer" whistles for a considerable time past. The judge accordingly held that the mark was public property, and that neither claimant could register either an exclusive or concurrent right to its use.

The restriction imposed by ss. 19—21 upon the registration of identical or similar trade marks applies only to cases where the marks belong to different owners. When the marks are the property of the same person, registration will generally be allowed on condition that they are entered on the Register as "associated" marks. This form of registration is an innovation of the Act of 1905, and its

effect is simply to make the groups of similar marks, so registered, assignable and transmissible only as a whole; for all other purposes they are regarded as separately registered. For instance, if the owner of a trade mark desires to register the entire mark and also a portion of it separately, he can now do so, provided each possesses the requisite qualifications. The parent mark and its offspring will then each have all the incidents of an independent trade mark, except that one cannot be disposed of without the other.

In the case of several trade marks, substantially identical and for substantially the same description of goods, but differing in respect of:—

- (a) Statements of the goods for which they are to be used;
- (b) Statements of number, price, quality or names of places;
- (c) Colour,

or in any other way which does not affect the identity of the trade mark, the whole series can be registered in a single registration. All marks so registered in a series will also be treated as associated marks.

Returning from this digression to the subject of trade marks “calculated to deceive,” it should be noted that there are other causes of possible deception besides resemblance between rival marks. For example, a word-mark might be held to be deceptive if, without being directly descriptive, it was nevertheless so far suggestive as to convey to the public a misleading notion of its quality, composition or origin. Thus the mark “Eton” upon cigarettes made in London, and the mark “Forrest” upon watches not made by Forrest, have been held to be deceptive. Objection has also been taken to a mark on the ground that the words “trade mark,” printed across a portion of it, were so placed as to mislead anyone into

thinking that only that part of the mark was registered and that the remainder was open to the public.

The purity of the Register is to be preserved not only by excluding marks calculated to deceive, but also marks which would be "contrary to law or morality, or containing any scandalous design." But sentimental objections to a trade mark on the ground that it is scandalous will not be entertained. A firm of wine merchants having registered the word "Quaker" as a trade mark for fermented liquors and spirits, the Secretary of the Society of Friends applied to remove the word from the Register, on the ground that it was scandalous and liable to deceive. It was held that, there being no rule of total abstinence in the Society of Friends, the objection was not well founded (*Ellis & Co.'s Trade Mark*).

As an additional safeguard against the use of misleading trade marks, certain words and devices are expressly debarred from registration, or only allowed upon the Registrar being satisfied that their use is justified. By the Trade Mark Rules registration will not be allowed of any mark embodying the following words or devices, unless they can be claimed as old marks:—

- (a) The Royal Arms or Royal Crests, or Arms or Crests so nearly resembling them as to be misleading;
- (b) British Royal Crowns;
- (c) British National Flags;
- (d) The word "Royal" or any other words, letters or devices calculated to lead persons to think that the applicant has Royal patronage or authorization.

The Registrar is also authorized to refuse applications for the registration of trade marks embodying:—

- (a) The words "Patent," "Patented," "By Royal Letters Patent," "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To Counterfeit this is Forgery," or words to like effect;

(b) Representations of their Majesties or of any member of the Royal Family.

If the Armorial Bearings of any Foreign State or of any City or Borough or Society, etc., or the name or representation of any living or recently deceased person appear upon the trade mark, the Registrar may require to be satisfied that these representations are used with proper consent or justification.

Ornamental or coloured groundwork, such as tartans or checks, cannot be claimed as part of a mark unless such groundwork is included within the mark by some border or lines.

Where there appears on the face of a trade mark the name or description of the goods to which it is applied, the Registrar may refuse to register the mark in respect of any other goods than those so named or described. If, therefore, the applicant intends to use the same mark with suitable variation of description for other kinds of goods, that should be expressly stated in the application in order to obtain registration in other classes.

CHAPTER IV.

REGISTRATION.

A. ENTRY UPON THE REGISTER.

HAVING decided what is permissible as a trade mark, the next question to consider is the procedure for getting the mark registered. Any person, firm or company, whether British or foreign, claiming to be the proprietor of a trade mark, may apply to register it within the United Kingdom. If an application has already been made in any of the foreign countries or colonies belonging to the International Convention or with whom arrangements exist for the mutual protection of trade marks, the applicant is entitled to priority of date (similar to that accorded in the case of patents and designs) provided that the British application is made within *four* months from the date of the first effective application abroad, and that the mark is otherwise registrable under the Act of 1905.

Where the mark intended for registration is a new one, the applicant will do well to take the precaution of making a preliminary search before lodging his application, in order to ascertain whether there is already on the Register any mark which is likely to clash with that which he proposes to adopt. This he may do either by making a search himself or by applying to the Registrar to cause an official search to be made. In the latter case he must forward a request upon Form T. M. No. 28 (stamp 10s.), accompanied by two representations of the proposed mark, each mounted on half a sheet of foolscap. Anyone, however, is at liberty to make a search himself amongst the classified

representations of trade marks at the Trade Marks Branch of the Patent Office, a charge of 1s. being made for every quarter of an hour spent in searching. Besides the general index of collected trade marks, there is a divisional index of devices and an alphabetically arranged index of words. It must not be assumed that all the words contained in this index are protected by registration, for it includes not only registered word-marks, but also words forming *part* of a trade mark. Complete searches amongst the classified collections of cotton marks (*viz.* Classes 23, 24, and 25) can only be made at the Manchester Branch Office.

As it is desirable, before adopting an "invented word" as a trade mark, that its registrability should be beyond controversy, the Office invites the submission of newly coined words for the Registrar's consideration. The Registrar will, of course, only express an opinion as to how far the word submitted complies with the requirements of s. 9, and will make no search for the purpose of ascertaining whether any other person has a similar registered mark, unless a search fee is paid.

Applications for the registration of all marks, except Sheffield and cotton marks (as to which see pp. 330—331), must be addressed to the Registrar, The Patent Office, Trade Marks Branch, 25, Southampton Buildings, London, W.C. In making the initial application and at all succeeding stages the appropriate stamped forms must be used. These forms (a list of which is given on page 349) are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6) in London, or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

The ordinary application is made upon Form T.M. No. 2, bearing an impressed stamp of 10s. A special form (T.M. No. 5) is allotted for applications to register a

name or word only registrable as a trade mark with the sanction of the Board of Trade under s. 9, sub-s. 5; and a special form (T.M. No. 6) is required for applications to register standardisation marks expressly authorised by s. 62 of the Act. A separate application form must be used for each class in cases where the same trade mark is claimed in more than one class of goods.

The Patent Office publishes a "Guide to the Classification of Goods," which will be of assistance to any applicant who finds difficulty in determining to which of the stereotyped classes the goods, for which he uses his mark, belong.

To identify his mark, the applicant has to furnish *five* representations of it, one affixed to the form of application and four additional facsimile copies, each mounted on Form T.M. No. 3. The representations may be made in any suitable medium, such as ink or paint, but in no case may they be executed in pencil. Marks consisting of or including words printed in other than Roman characters should be accompanied by a translation and likewise a phonetic transliteration. Where an application is made for the registration of a series of marks, a representation of each of the marks of the series must be affixed to the principal form and also to each of the four additional forms.

To entitle an "old mark" to registration as such, there must have been continuous user since August 13th, 1875, in the United Kingdom and in connection with the goods specified in the application. An applicant seeking to register such a mark must vouch for these facts and should further state how it has been used, whether as a label or by branding, embossing, etc. The Registrar may require a sworn declaration verifying the applicant's assertions upon these points. Where the name or description of certain goods appears upon the face of the trade mark, but the applicant intends in practice to vary these particulars

in using the mark for other goods, a statement to this effect should be appended to the application, otherwise the Registrar may decline to register the mark in respect of any goods other than those specified on the mark itself.

In due course, after an application has been lodged, the Registrar notifies the applicant whether it is acceptable or not. Should the Registrar refuse the mark or only accept it conditionally or subject to amendment, the applicant may, by sending in a request upon Form T.M. No. 4, obtain from the Registrar a statement in writing of the grounds of his decision and the materials upon which it is based. If he is dissatisfied with the decision, he may appeal at his option to the Board of Trade or the Court.

As soon as an application has been accepted, it is advertised in the *Trade Marks Journal*. For this purpose the applicant must, on receiving a formal demand from the Registrar, furnish a wood or copper block engraving of his mark (except in the case of cotton marks, for which no blocks are required). Care must be taken to have the blocks made within the prescribed dimensions. The largest space available for the insertion of a single block is $5\frac{1}{2}$ ins. broad by $7\frac{1}{2}$ ins. deep. No charge is made for the insertion of a block not exceeding two inches in breadth or depth; but if the block exceeds these dimensions, a small charge is made for every inch of additional space taken. The block having been prepared, it should be sent to the Trade Marks Branch of the Patent Office accompanied by the paper marked "Form R. Adv. 3," and the representation of the mark sent for the guidance of the applicant in preparing the block.

Anyone desiring to oppose the registration of the trade mark has one month from the date of advertisement within which to lodge his notice of opposition. Notice is given by filing Form T.M. No. 7, together with an unstamped duplicate which the Registrar sends on to the applicant.

The ordinary grounds of opposition are :—(a) That the mark is not characterised by any “essential particular” as required by s. 9; (b) that the mark is identical with or closely resembles one already registered by the opponent; (c) that it will interfere with his using a mark he has hitherto been accustomed to use; (d) that it is otherwise calculated to mislead the public.

If the registration is opposed on the ground that the proposed mark resembles a mark already on the Register, the opponent must specify the number of the mark relied on and the date of the Journal in which it was advertised. The applicant has one month from the date of the receipt of notice of opposition within which to file a counter statement. Each party has then a further period within which to file evidence by sworn declaration. In lieu of or in addition to these statutory declarations the Registrar may permit the parties to give oral evidence at the hearing. The decision of the Registrar is subject to appeal to the Court or, with the consent of the parties, to the Board of Trade. The Registrar and, in the case of an appeal, the appellate tribunal have power at any stage of the proceedings, whether before or after acceptance, to correct any error in the application or permit the applicant to amend his application upon such terms as they think fit. They have also power to award such costs as they may consider reasonable.

An application for registration of a trade mark must be completed within 12 months. Whenever through default of the applicant this period is exceeded, the Registrar notifies the applicant of the fact and specifies a period, usually 14 days, within which the application must be completed. If not completed within this time, the application will be deemed to have been abandoned.

After the expiration of the time allowed for opposition, the Registrar will, in the absence of opposition, proceed to

register the trade mark ; but a trade mark cannot in any event be entered on the Register until after the lapse of one month from the date of its advertisement in the Journal. The entry on the Register specifies the date of registration (*i.e.*, the date of application), the goods in respect of which the mark is registered and gives the usual particulars identifying the proprietor. Notifications of assignment, disclaimers, conditions and limitations affecting the use of the mark are also entered. As soon as registration is completed, the Registrar forwards to the applicant a certificate on Form O, No. 2. Special certificates are issued for use in procuring registration abroad or for the purposes of litigation, and may be obtained by application upon the prescribed forms. In the case of an "old mark" not registrable under the Act, the applicant may obtain a certificate of refusal, which gives him a status in an action for infringement equivalent to that conferred by registration.

The cost of registration varies so widely according to the nature of the goods and the number of classes for which the mark is to be registered, that a general statement will be of little use. The table of forms, given at page 349, contains a complete list of fees, and will furnish any information that may be desired on this head.

B. RENEWAL OF REGISTRATION.

A trade mark that has been duly registered will remain upon the Register without further payment for a period of 14 years. At the expiration of this time the registration may be continued by the payment of a renewal fee (£1 for every class in respect of which the goods are registered) for another period of 14 years ; and so long as the renewal fees are duly paid at intervals of 14 years, registration may be indefinitely prolonged. The renewal fee must be paid not less than 2 months nor more than 3 months

before the period of registration expires. If the renewal fee is not paid at the proper time, the Registrar sends a notice to the proprietor of the mark, warning him of the approaching expiry of his registration. If after receiving two such notices the proprietor still allows the date of expiry to pass without paying the renewal fee, the Registrar advertises the fact in the Journal. After the appearance of this advertisement, the registered proprietor has still one month's grace within which, upon payment of a fine of £1 in addition to the renewal fee, he may save his registration from lapsing. Upon the renewal of a registration, the proprietor of the mark is notified and the fact is advertised in the Journal. Marks which have lapsed through non-payment of the renewal fee are removed from the Register, and an entry made of the removal and its cause.

To obviate the risk of improper use being made of a recently lapsed mark, as, for instance, by a rival immediately adopting and registering the same mark, s. 31 of the Act provides that a trade mark which has lapsed in this way shall nevertheless, for the purpose of any application for registration, for one year after its removal be deemed to be still upon the Register. If, however, the Registrar is satisfied that there has been no *bona fide* trade user of the mark during the 2 years immediately preceding the removal, he is at liberty to waive the application of this rule.

C. RECTIFICATION OF THE REGISTER.

(1) *By the proprietor of the mark.*

The Act invests the Registrar with ample powers to rectify or alter entries in the Register upon the application of the registered proprietor. Section 32 provides for the correction of errors in name or address, for the cancellation of an entry, or for its limitation by entering a disclaimer or by striking out some of the goods or classes of

goods for which the mark was originally registered. Where an application is made to enter a disclaimer or memorandum, the proposed entry must be first advertised in the Journal, so that anyone who desires may have the opportunity of opposing it.

Section 33 provides for the entry upon the Register of notifications of changes in proprietorship by assignment or devolution. A request to register an assignment may be made jointly by the assignor and assignee (Form T.M. No. 16), or alone by the person claiming to be entitled by assignment or otherwise. In the latter case, the claimant must make his request for registration in Form T.M. No. 18, and at the same time furnish a statement giving full particulars of the origin of his title. If in the opinion of the Registrar his claim is well-founded, he will be required to file a statutory declaration (Form T.M. No. 19) verifying the statements upon which his claim is based.

Applications to amend the registered mark (as distinct from the entry in the Register) are looked upon with less favour. Small changes, however, by way of addition to or alteration in the mark are permitted, provided that the change does not substantially affect the identity of the mark. For example, the addition of the word "Limited," or the substitution of a new name and address, are alterations that will usually be allowed. All such alterations must be advertised in the Journal, though no provision is made in the Act enabling anyone to oppose them.

(2) *Upon a hostile application.*

In virtue of s. 36 any person aggrieved by a wrongful entry, error or omission in the Register may apply to have the entry expunged or varied or the error rectified in any other way that may be necessary. An application to rectify the Register under the provisions of this section is made by motion to the Court. The definition of the expression an "aggrieved person" has occasioned some

little difficulty in the past; the meaning, however, seems to be this. Whenever a trader, by dint of a wrongly registered trade mark, narrows the area of business open to his rivals and thereby excludes, or, with reasonable probability, will in future exclude a rival from trading in such goods as he desires to trade in, that rival is an "aggrieved person." Anyone threatened with proceedings for alleged infringement or accused of passing off his goods as those of the complainant would be an obvious instance of a person aggrieved.

In the case of fraud in the registration or transmission of a registered mark, the Registrar may himself apply to the Court for rectification.

An opponent may apply to rectify on numerous grounds. For instance, he may contend that the mark contains none of the "essential particulars" prescribed by s. 9; that it is descriptive or has reference to the character and quality of the goods; that it was common to the trade at the date of registration; that it was improperly registered as an old mark; that it was calculated to deceive owing to its similarity to a mark already on the Register, that it is otherwise of a deceptive character; that the registration was obtained by fraud. In fact every legal ground of objection to the registration is open to him, provided the mark has not been on the Register for more than 7 years. After 7 years a mark is only open to attack on the limited ground that the original registration was deceptive or fraudulent. Prior to the Act of 1905, a mark was liable to be expunged on the ground that it had been improperly registered, no matter how many years it had been on the Register. The provision contained in the Patents, Designs and Trade Marks Act of 1883, that registration should be deemed conclusive evidence of title after the lapse of 5 years, was construed by the Courts to mean merely that the defendant in an action for infringement was debarred from

relying on the plea of invalidity in the case of a trade mark which had been on the Register for 5 years. He was not, however, precluded from applying to rectify the Register by expunging the mark. Hence it became the common practice to retort to an action for infringement by a motion to rectify the Register, in cases where the mark sued upon was more than 5 years old.

The Act of 1905 has made an important change in this respect, so that now a mark, which is immune from attack in an action for infringement, is equally immune from attack by a motion to rectify the Register. A further beneficial amendment is the provision that a mark cannot be expunged from the Register on the ground that it was improperly registered, if its registration can be justified under the Act of 1905.

In deciding whether a mark shall be removed from the Register, the Court observes a distinction between a registration which is inherently illegal and one which, though it might have been objected to at the date of registration, has ceased to be objectionable. Thus the Court is not bound to expunge a mark upon the motion of an unmeritorious applicant (a trader, for instance, who has flagrantly infringed it) merely because the original registration might have been opposed on the ground of prior user by someone who, at the time of the motion to rectify, had discontinued his user. Upon an application to rectify, the Court has also the right to require the entry of a disclaimer to the exclusive use of any part of the mark.

The removal of a trade mark on the ground of non-user has already been alluded to (p. 291). It is only necessary here to recapitulate briefly that a mark may be removed by the Court upon the application of any person aggrieved, if (1) it was registered without any *bona fide* intention to use it and there has been no actual user, or if (2) there has been no *bona fide* use made of it during the 5 years

immediately preceding the application for its removal. In the exercise of its discretion the Court will take into consideration any special circumstances which may justify the non-user of a trade mark.

SHEFFIELD MARKS.

The Sheffield Register of Corporate Marks, kept by the master, warden and commonalty of the Cutlers' Company in Hallamshire in the County of York, dates back to a time considerably before the introduction of a general system of registration by the Act of 1875. Being an efficient working system for the registration of cutlery and kindred marks, it was preserved in its integrity by the early Trade Marks Acts and engrafted upon the general system: and the Sheffield Register, though continued as a separate record, was closely co-ordinated with the principal Register. It is now, by virtue of the Act of 1905, declared for all purposes to form part of the London Register.

The only point requiring special note in regard to Sheffield marks is the manner of applying for registration. The procedure is briefly as follows. All applications for the registration of marks used on *metal goods* by persons carrying on business in or within 6 miles of Hallamshire must be directed to the Cutlers' Company. The expression "metal goods" includes all metals whether wrought, unwrought or partly wrought, and all goods composed wholly or partly of any metal. The application must be made in duplicate on Form T.M. No. 2, and forwarded to the Cutlers' Hall, Sheffield. Requests to enter Old Corporate Marks should be made on Form Sheffield No. 1, bearing a £5 stamp. Upon receipt of an application, the Cutlers' Company notifies the Registrar, and entry on the Sheffield Register is subject to his approval. As soon as the mark is entered by the Cutlers' Company, a corresponding entry is made on

the Register in London. The mark is registered as of the date of application to the Cutlers' Company.

Applications for registration of marks on metal goods by persons carrying on business *beyond* the 6 miles radius must be made to the Registrar in the usual way. A notification of such applications is sent to the Cutlers' Company.

An appeal lies from every decision of the Cutlers' Company direct to the Court.

COTTON MARKS.

The Manchester Branch Office for the registration of cotton marks has been in existence since the Trade Marks Registration Act of 1875. It was established by the Rules made in pursuance of that Act and it has now, for the first time, obtained direct statutory recognition. The principal officer of the Manchester Branch is designated "The Keeper of Cotton Marks." The section of the Register which deals with marks upon goods falling within classes 23, 24 and 25 is styled "The Manchester Register," and a duplicate copy of it is kept at the Manchester Branch.

According to the present classification, the cotton goods comprised in these three classes are as follows:—

Class 23. (a) Cotton yarn.

(b) Sewing cotton.

Class 24. Cotton piece goods of all kinds (such as cotton shirtings, long cloth).

Class 25. Cotton goods not included in Classes 23, 24 or 38 (such as cotton lace, cotton braids, cotton tapes).

Applications for marks upon goods of this character should be made upon Form Cotton No. 1 (stamp 10s.), and should be accompanied by an unstamped duplicate and also by four additional representations of the mark on Form

Cotton No. 2. The application must be addressed to the Keeper of Cotton Marks, 48, Royal Exchange, Manchester.

Every application to the Manchester Branch is notified to the Registrar in London. If no objection is raised by him, the mark is forthwith advertised in the Journal by the Manchester Branch. The registration fee must be paid to the Keeper of Cotton Marks, who thereupon notifies the Registrar, and the registration is duly completed.

An exceedingly comprehensive record is kept at the Manchester Branch of all applications for the registration of cotton marks, whether accepted, lapsed or rejected; and this record is open to public inspection.

In the case of cotton piece goods and cotton yarn, no mark will be accepted for registration which consists of a word or words alone (whether invented or not). Line headings, unless combined with some other distinctive device, are also disqualified from registration in connection with cotton piece goods. The Act of 1905 further stipulates that in no case shall the registration of a cotton mark give any exclusive right to the use of any word, letter, numeral, line heading or any combination thereof.

Questions of novelty or difficulty arising out of applications to register cotton marks may be settled by the Manchester Branch in consultation with the Trade and Merchandise Marks Committee, appointed by the Manchester Chamber of Commerce.

Appeals to the Court from the Registrar's decision will usually, in the case of cotton marks, be heard by the Chancery Court of the County Palatine of Lancaster.

CHAPTER V.

EFFECT OF REGISTRATION.

THE registration of a trade mark is no idle formality. The advantages it confers are of a very substantial and valuable kind. What these advantages are will be best shown by considering registration from three aspects; first, as a means of establishing an exclusive right to a trade mark; secondly, in facilitating its assignment; and thirdly, as a protection of the mark against infringement.

TITLE ACQUIRED BY REGISTRATION.

Before the introduction of a general system of registration by the Act of 1875, any person who laid claim to an exclusive right to use a particular mark was required to justify his claim. This he could only do by proving that he had used the mark to such an extent that it had come to be identified in the public mind exclusively with goods of his manufacture. Manifestly a reputation of this kind could only be established by lapse of time, and there was always the danger, meanwhile, that the prescriptive acquisition of an exclusive right might be frustrated by some rival adopting the same mark. The object of registration is to enable a trader to establish his right to exclusive use from the outset, that is, from the very day that he adopts the mark; to establish instantaneously a right which previously could only be acquired by the lapse of a considerable time. Registration is, in fact, the means of *creating* a trade mark right, and in the great majority of

cases trade mark rights are originated in this way; it is only comparatively seldom that registration is the record of a "fait accompli," of an exclusive right already acquired by use. But registration is, nevertheless, based upon use. There must be either actual use or a *bona fide* intention to use the mark in order to justify its registration; otherwise it is in the nature of an imposture upon the public and may be expunged upon the application of any person aggrieved.

Although by registration the title of a claimant to the use of a trade mark is at once established, the security which registration gives is, at any rate for a time, of a partial kind. In the words of the Act, registration is at first only *prima facie* evidence of title. It may be attacked, as has been shown in the previous chapter, on various grounds. The onus, however, of proving that the mark was improperly registered is upon the person attacking it, and in cases of doubt the presumption is always in favour of the validity of the registration. After the lapse of 7 years, the position of the registered proprietor is improved, and his title may only then be impugned on the special grounds that the original registration was fraudulent or that the mark is calculated to deceive or consists of a scandalous design. After seven years, therefore, a registered proprietor may be said to be fairly secure in the exclusive right to his registered mark.

It is expressly stipulated, however, by the Act that registration shall in no case entitle the registered proprietor to interfere with anyone entitled by registration to the concurrent use of the same mark, or to restrain any unregistered trader who has used the identical mark in connection with the same goods continuously from a date anterior to the registration. It is also expressly provided that no registration shall interfere with any *bona fide* use by a person of his own name or place of business or that of

any of his predecessors in business, or the use by any person of any *bonâ fide* description of the character or quality of his goods. The latter proviso will effectually prevent the maintenance by registration of an exclusive right, originally established under cover of a patent, to a name which, like "Linoleum," has by common usage become descriptive.

ASSIGNMENT.

A registered trade mark is capable of being transferred by assignment, like any other personal property : subject to this qualification, however, that it can only be transferred in conjunction with the goodwill of the business concerned in the goods for which it is registered. The reason for this rule is obvious. The essence of a trade mark is that it denotes the origin of the goods to which it is applied ; it cannot therefore be divorced from the goods with which it has previously been connected, and attached to goods proceeding from a different source, without becoming deceptive. So intimately are the two related, that, even without express mention of them, the trade marks of a business will automatically pass to the purchaser of the goodwill.

If the goodwill is transferred merely for a portion of the goods covered by the registration of the trade mark, the assignee will acquire an exclusive right in the mark only to the extent of the goodwill assigned. It is not possible, as with patents, to grant a licence to use a trade mark, except in the sense that an arrangement is possible whereby the goodwill of a business might be leased for a period. The fact that a trade mark can only be used by the proprietor of the goodwill precludes the possibility of a licence in the sense of a subordinate co-existing right of user. With the determination of the goodwill of a business the right to use the trade mark of the business also determines.

When trade marks are the property of a partnership and the partnership is dissolved, they may be dealt with in one of two ways. They may either be bought out and out by one of the partners, or they may be apportioned. To get them apportioned, the parties must apply to the Registrar who is specially empowered by s. 23 of the Act to permit an apportionment of the trade marks among the persons severally continuing the business, subject to such conditions and modifications as he may think necessary in the public interest. The operation of this section presupposes the possibility of so apportioning the marks, that *different* marks are allotted to each of the former partners. If, however, they desire to have the right of using identical marks in their several capacity, this privilege can only be secured by application to the Court (See p. 315).

As a condition of allowing the apportionment amongst several persons of marks previously used by a single firm, the Registrar would probably stipulate that the marks should be registered as "associated," so that, for the purposes of any subsequent assignment, they could only be dealt with *en bloc*.

Assignments should be duly notified to the Registrar with a request to enter them upon the Register. The entry of an assignment is not, however, a condition precedent to the right to sue for infringement of trade mark; but the Court would probably insist upon seeing that the assignment had been duly registered before giving judgment for an assignee.

In the event of death of a registered proprietor, his trade marks devolve upon his personal representative; in the case of bankruptcy, they pass to his trustee.

INFRINGEMENT.

Registration is, with one exception, a condition precedent to the institution of proceedings to restrain infringement of

a trade mark. The single exception is that in favour of the proprietor of an "old mark" who has applied for registration and been refused; a certificate of refusal granted in such case being deemed for the purpose of litigation equivalent to registration.

An action for infringement of trade mark, reserved as it is exclusively for those who have availed themselves of the Registration Acts, is therefore essentially the *statutory* remedy as distinct from the Common Law remedy, viz., the "passing off" action, available indifferently for the protection of registered and unregistered marks. Contrasted with the action for infringement, the Common Law action (a brief account of the origin and development of which will be found in the introductory chapter) has much wider scope and greater elasticity, inasmuch as it serves not only to check the direct piracy of a trade mark, but also to suppress other forms of commercial plagiarism by which the goods of one trader are palmed off upon the public as the goods of another. It involves, however, one serious drawback: it places the owner of the mark under the necessity of proving that his mark has acquired such a wide and distinctive reputation, that the use of it by another is calculated to impose upon the public.

The owner of a registered mark, on the other hand, is under no such obligation. All he has to do is to produce his certificate of registration. It then rests with the defendant, if he challenges the right which the certificate imports, to prove that the mark was improperly registered. The grounds upon which a registered mark can be impeached, before and after the lapse of 7 years, have already been stated. Such objections as can be taken to the validity of registration may be relied on by way of defence to the action.

Assuming that the registration is unimpeachable, the

only matter then to be tried is the question of infringement, that is, whether the mark complained of is the same or substantially the same as the registered mark. If the marks are not absolutely identical, their similarity must be such as to render the risk of their confusion extremely probable. The subject of deceptive resemblance has been fully discussed in the preceding pages, and it is only necessary to add that the same considerations which operate to disqualify a mark for registration on the ground of its deceptive similarity to a mark already registered are equally applicable in determining the question of infringement. This, however, should be noted, that, to constitute an infringement, the method of *applying* the marks need not necessarily be identical in both cases. Thus a registered trade mark used by application to the goods in the ordinary way may be infringed by the representation of the same mark upon a circular or invoice or poster used in connection with the same class of goods. The Court is expressly empowered, in trying the question of infringement, to admit evidence of the usage of the trade in respect to the "get up" of the goods for which the mark is registered, and of any trade marks or "get up" legitimately used in connection with the same class of goods by other persons.

Proof of actual deception is not required to support an action for infringement nor does it avail the defendant that the infringement was committed without fraudulent intent. A person who misapplies another's mark to his goods is none the less an infringer because the purchaser buying the goods from him is aware of their true origin; for the goods may pass on into other hands where their spurious character is not known and may consequently cause deception.

In practice it is usual to add a claim for "passing off" in an action for infringement, so that, should the plaintiff

fail to substantiate the valid registration of his mark, he may fall back upon his Common Law rights. Thus, in the famous "Yorkshire Relish" case (*Powell v. Birmingham Vinegar Brewery Co.*), the House of Lords held that the mark had been improperly registered and must be expunged, but they granted an injunction, all the same, restraining the defendants from using the words "Yorkshire Relish" and thereby passing off their goods as and for the goods of the plaintiffs. And there are other cases in which a man may succeed in a "passing off" action, though he fails in his action for infringement. For instance, the facts may show that though the mark complained of does not infringe the mark as registered, yet it bears a deceptive resemblance to the mark as actually used by the plaintiff in the course of his trade.

On the other hand, an action for infringement may succeed in circumstances where a "passing off" action would be hopeless. Take the case of a newly registered mark, the adoption of which is so recent that it has not yet acquired a reputation in connection with the goods to which it is applied; the registered proprietor can, nevertheless, obtain an injunction against an infringer in virtue of the statutory right conferred by registration.

But it must be remembered that the statutory action for infringement is strictly confined to those cases in which the thing pirated is the registered trade mark; for other forms of piratical trading upon the goodwill and reputation of the plaintiff the proper remedy is the "passing-off" action. A trader is consequently dependent upon his action at Common Law to restrain such forms of dishonest competition as the imitation by a rival of the general style and "get up" of his goods or the use or adoption of a personal or local name in a way calculated to mislead the public.

In a "passing-off" action, as in an action for infringement, fraudulent motive need not be proved, nor, if the

circumstances all point strongly to the likelihood of deception, is it essential to adduce any particular instance in which the public has been deceived; though a case is, of course, considerably strengthened when such evidence is forthcoming.

CHAPTER VI.

MISCELLANEOUS.

ACTION FOR INFRINGEMENT—THE TRIAL AND TRIBUNAL.

ACTIONS for infringement of trade mark are tried in the Chancery Division of the High Court or, in the case of "cotton marks," in the County Palatine Court of Lancaster. The decisions of these Courts are subject to appeal in the ordinary way to the Court of Appeal and finally to the House of Lords.

In the normal Chancery action the plaintiff fortifies the plea of infringement by adding a claim for "passing off," so that, whilst he enjoys the advantages of the statutory action, he is not cramped by its limitations. As soon as the writ has been issued, an interlocutory injunction may be applied for, to restrain the use of the infringing mark until the hearing of the action. This is usually granted upon terms; the plaintiff undertaking, in the event of his failing in the action, to indemnify the defendant for any loss sustained in consequence of the injunction.

The action is tried by a judge without a jury. The form of relief granted to a successful plaintiff is substantially the same as that awarded in a patent action, viz. an injunction and damages or, at the option of the plaintiff, an account of profits. The Court will also order the delivery up of all spuriously marked articles for erasure of the mark or, where that is impracticable, the destruction of the goods themselves.

If the validity of registration has been called in question at the trial, the Court will grant a certificate to that effect,

which will entitle the plaintiff to costs as between solicitor and client in any subsequent proceedings for the infringement of the same mark.

When a "passing off" action is brought, not as an adjunct to an action for infringement but to restrain some form of trade piracy outside the scope of the Trade Marks Act, the case is set down and tried in the King's Bench Division.

The County Courts have no jurisdiction to entertain an action for infringement of trade mark. In Scotland and Ireland the Courts competent to entertain proceedings for infringement of trade mark are the Court of Session and the High Court of Justice respectively.

THE MERCHANDISE MARKS ACT.

Besides being exposed to a civil action, a trade mark pirate is liable to the severer penalty of criminal proceedings, when his conduct is tainted with an intention to defraud.

The Merchandise Marks Act of 1887 (supplemented by the Acts of 1891 and 1894) renders liable to criminal prosecution any person, firm or company, guilty of the following offences:—

- (1) Forging a trade mark or making or having in possession any die or instrument for that purpose;
- (2) Falsely applying to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive;
- (3) Applying any false trade description to goods.

A person convicted of any of the foregoing acts is guilty of a criminal offence, unless he proves that he acted without intent to defraud.

Persons selling or exposing for sale or having in their possession goods to which a forged or fraudulent trade mark or description has been applied are also guilty of an

offence under the Act, unless they can prove that they have taken reasonable precautions or have otherwise acted innocently, and are willing to give all information in their power as to the persons from whom the goods were obtained.

A not uncommon instance of the application of a false trade mark is the refilling of empty wine or spirit bottles, bearing the label of a well-known firm, with wine or spirit of a different or inferior brand. A person who knowingly uses the mark of another cannot claim that he acted "innocently" merely because he had no positively fraudulent intent. Thus, where a manufacturer of mineral waters, for the sake of economy and convenience, used bottles embossed with the name of another maker, putting his own labels upon them, it was held that he had not acted "innocently" within the meaning of the Merchandise Marks Act, notwithstanding no fraud was intended and no one was misled (*Thwaites & Co. v. M'Erilly*).

A false trade description embraces any untrue or deceptive statement with reference to the quantity, quality or origin of the goods. It must, however, be a written or printed statement; an oral misrepresentation, though it might be actionable on other grounds, is not a false trade description within the meaning of the Merchandise Marks Act. A familiar instance of a false trade description relative to quantity is the sale of tea in packets labelled "a $\frac{1}{4}$ lb. of tea," which, however, only scale a quarter of a pound when weighed with the lead-paper wrapper.

Some instances of false trade descriptions as to quality which have resulted in the successful prosecution of the offender are:—the sale of margarine under the description "French Produce—Guaranteed Pure Butter"; the sale of New Zealand mutton as "Welsh"; of machine-cut tobacco as "hand-cut," and of Turkish cigarettes as "Egyptian."

A propos of the first of these misdescriptions it may be

mentioned here that the Butter and Margarine Act, 1907, has introduced a new provision with regard to the marking of wrappers, etc., used in connection with margarine. It is an offence under the Act to sell margarine under any other name than either "margarine." or a name combining the word "margarine" with a fancy or other descriptive name approved by the Board of Agriculture and Fisheries and printed in type not larger than and in the same colour as the word "margarine." A name will not be approved by the authorities for use in connection with margarine if it refers to or is suggestive of butter or anything connected with the dairy interest.

A trade description, however, is not false unless it is deceptive. No one dreams for a moment that "Bath buns" come from Bath or "Swiss rolls" from Switzerland, or that "Patent leather" is protected by letters patent. There are dozens of similar titles which have lost their original significance and have become purely descriptive. Whether such a change has taken place is a question of fact to be determined by evidence as to custom and trade usage. "Harris" as applied to tweeds, and "Shetland" as applied to shawls, are descriptive of a particular style of fabric, but they retain, nevertheless, some local significance. "Havannah" as applied to cigars, and "Dresden" as applied to china, have been held to be false trade descriptions when applied to goods manufactured in England. If, however, such trade description is qualified by the addition of the maker's name and address, its misleading character is, of course, counteracted. Convention and trade usage may, on the other hand, cause a description to be deceptive which is technically correct. Thus "soda crystals" was held to be a false trade description as applied to a parcel of alkali consisting mainly of sulphate of soda (otherwise known as Glauber's salt) which is undeniably a crystalline salt, it being proved

that "soda crystals" was the conventional trade description for common washing soda, that is, carbonate of soda.

The Merchandise Marks Act further prohibits the importation of spuriously marked foreign goods, or foreign goods marked so as to suggest a British or foreign origin from which they are not in fact derived, unless they are accompanied by a definite indication of the country where the goods were made or produced. Hence the familiar inscription "made in Germany." Imported goods which bear no marks whatever are not subject to the Act and, therefore, require no statement or indication of their origin.

The Act contains special provisions with regard to the marking of watches, with the object of clearly differentiating between foreign-made watches and those made in the United Kingdom.

A prosecution under the Merchandise Marks Acts may be brought by any member of the public, or it may be instituted at the instance of the Board of Trade or the Board of Agriculture. The defendant has the option of being dealt with summarily or upon indictment. The punishment on indictment is a fine and imprisonment not exceeding 2 years. On summary conviction imprisonment is limited to 4 months with or without hard labour and the fine to £20 for a first offence and to 6 months and £50 for any subsequent conviction. Prosecutions must be commenced within a year from the time when the prosecutor becomes aware of the offence, but in no case later than 3 years from the date of its commission.

OTHER PENAL OFFENCES.

Any person who falsely represents that he is a Royal warrant-holder or a contractor to the Government is liable, on summary conviction, to a penalty not exceeding £20.

Any person who represents a trade mark as registered

which is not so, is liable for every offence, on summary conviction, to a fine not exceeding £5.

Anyone making or causing to be made a false entry in the Register of Trade Marks is guilty of a misdemeanour.

DECEPTIVE USE OF NAMES AND TRADING STYLES.

No one can be restrained from using his own name in connection with his business, provided he does not make it a handle for deception. But where a man is found to be using his name dishonestly for the purpose of trading upon another's reputation, reaping, in fact, where he hath not sown, the Courts will grant an injunction restraining him at least from using his name in such a manner as to mislead the public. The case against a man who has taken an assumed or fancy name for the same dishonest purpose is still stronger. The Courts have gone so far in such a case as to restrain him absolutely from using the name in any shape or form in that particular line of business in which confusion is likely to occur. In all such cases, however, the plaintiff must remember that success in an action at law depends upon his satisfying the Court that deception is likely to arise, in other words, that his (the plaintiff's) name is pre-eminently associated in the public mind with the goods in question.

The same principle applies to the assumption of a trading style by a firm or company. The name must not resemble any existing trading style so closely as to lead to ambiguity and confusion. The case of *Massam v. Thorley's Cattle Food Co.* may be cited as a good illustration of this principle. Joseph Thorley for many years manufactured and sold extensively an article called "Thorley's Food for Cattle," made according to a secret recipe; and down to the time of his death he was the only person who made the food. His executors continued the business. Shortly after

his death a company was formed by other persons under the name of J. W. Thorley's Cattle Food Co., in which J. W. Thorley, a brother of the deceased, took a shilling share. J. W. Thorley knew the secret of the manufacture and was employed by the Company to superintend it. The Company sold the same article under the name of "Thorley's Food for Cattle." It was held that they were not at liberty to use this name unless they took such precautions as would prevent purchasers from supposing that the article sold by them was manufactured at the original establishment of Joseph Thorley.

But the same reluctance which the Courts have shown in admitting to the Register words having a descriptive or geographical significance also characterises their attitude towards the recognition of any claim to monopolise, under cover of a trading style, words that are simply descriptive of the goods traded in or the locality in which the business is carried on. Thus, upon an application of the Daimler Motor Co. to restrain another concern from trading as the Daimler Wagon Co., Ltd., the Court refused to grant an injunction on the ground that "Daimler" was a word descriptive of a particular construction of motor, which anyone trading in motors of that type was at liberty to use. This was in 1901. In 1907 the Daimler Motor Co. again applied to the Court to restrain another Company from trading under the style "London Daimler Co., Ltd." It was held on this second application that the term "Daimler" was no longer indicative of a particular type of motor, the original "Daimler" pattern having become obsolete and having been entirely abandoned in England since the last action was tried. An injunction was accordingly granted.

In the case of limited liability companies, there exists an additional safeguard against plagiarism of this kind by virtue of the Companies Act of 1862. Section 20 of that

Act empowers the Registrar to refuse to register the name of any company which is identical with that by which an existing company is already registered, or so nearly resembles it as to be calculated to deceive.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

Great Britain being a signatory to the International Convention (ratified at Paris in 1884 and supplemented by the Brussels Act of 1900), British subjects can avail themselves of the privilege of priority under the provisions of the Convention in practically all civilised countries. To obtain this privilege the application in the foreign country must be made within 4 months of the English application. Foreign subjects of Convention States, applying in England, have a corresponding privilege. But applications must conform to the English practice, and the trade mark tendered for registration must be one registrable under the Act of 1905. A list of the Convention States and other countries with whom similar arrangements have been made for the international protection of trade marks is given on page 239.

A foreigner, suing in the British Courts for infringement or "passing off," is in precisely the same position in the eye of the law as a British subject; a similar equality is accorded under Article X. *bis* of the Convention to British subjects suing in the courts of foreign States belonging to the Union.

APPENDIX C.

TRADE MARK FORMS AND FEES.

Form.	Proceeding.	Fee.		
		£	s.	d.
TM No. 1.	Form of authorisation of Agent	—		
.. No. 2.	Application for registration of Trade Mark	0	10	0
.. No. 3.	Additional Representation of Trade Mark	No stamp.		
.. No. 4.	Request for statement of grounds of decision under s. 12(3)	0	10	0
.. No. 5.	Application for registration of Special Trade Mark under s. 9(5)	0	10	0
.. No. 6.	Application for registration of Special Trade Mark under s. 62	0	10	0
.. No. 7.	Notice of Opposition to application for registration	1	0	0
.. No. 8.	Counter-statement to opposition to application for registration	0	10	0
.. No. 9.	Application for hearing in cases of opposition	1	0	0
.. No. 10.	Application to the Board of Trade for hearing under Rule 38	1	0	0
.. No. 11.	Fee for Registration of a Trade Mark	1	0	0
.. No. 12.	Renewal of Registration before notice has been given by Registrar	1	0	0
.. No. 13.	Renewal of Registration after notice has been given by Registrar	1	0	0
.. No. 14.	Additional fee to accompany renewal fee within one month after advertisement of non-payment of renewal fee	0	10	0
.. No. 15.	Restoration of Trade Mark where removed for non-payment of fee	1	0	0
.. No. 16.	Joint request by registered proprietor and assignee to register assignee as subsequent proprietor	1	0	0
.. No. 17.	Form of Declaration (only to be furnished when requested by Registrar) by assignee in support of Form TM No. 16	—		
.. No. 18.	Request to enter name of subsequent proprietor upon register	1	0	0

TRADE MARK FORMS AND FEES—*continued.*

Form.	Proceeding.	Fee. £ s. d.
TM No. 19.	Form of Declaration (only to be furnished when requested by Registrar) in support of Statement of Case accompanying Form TM No. 18	—
„ No. 20.	Application for alteration of address on Register	0 5 0
„ No. 21.	Application to permit an apportionment of Trade Marks	5 0 0
„ No. 22.	Request for correction of clerical error or amendment of application.	0 5 0
„ No. 23.	Request to enter change of name of registered proprietor	0 5 0
„ No. 24.	Application to cancel entry on register	0 5 0
„ No. 25.	Request to strike out goods from those for which a mark is registered	0 5 0
„ No. 26.	Request to enter disclaimer or memorandum	0 5 0
„ No. 27.	Application to add to or alter a Trade Mark	1 0 0
„ No. 28.	Request for search under Rule 95	0 10 0
„ No. 29.	Appeal from Registrar to Board of Trade	1 0 0
„ No. 30.	Notice of Order of Court for alteration of Register	0 10 0
„ No. 31.	Request for general certificate	1 0 0
„ No. 32.	Request for certificate of refusal to register.	1 0 0
„ No. 33.	Request for certificate of registration for use in obtaining registration abroad	0 5 0
„ No. 34.	Request for certificate of registration for use in legal proceedings	1 0 0
	For inspecting register in connection with any particular trade mark, for every quarter of an hour	0 1 0
	For making a search amongst the classified representations of trade marks, for every quarter of an hour	0 1 0
	For office copies, every 100 words (but never less than one shilling)	0 0 4
	For certifying office copies MS. or printed matter	0 10 0
	An additional stamp duty of one shilling is also charged under the Stamp Act upon certified copies of certain documents.	

These Stamped Forms are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), Strand, London, W.C., or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

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