THE

LAW, PRACTICE, AND PROCEDURE,

RELATING TO

PATENTS, DESIGNS, AND TRADE MARKS.

CONTAINING THE

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883:

WITH

THE RULES AND FORMS,

AND THE OFFICIAL INSTRUCTIONS, REGULATIONS, AND NOTICES ISSUED IN PURSUANCE OF THE ACT: AND ALSO THE LAW OFFICERS' RULES, AND PRIVY COUNCIL RULES:

With Full Notes and Comments,

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PREFACE.

THE object of the writer in preparing this work has been to endeavour to collect into a small and convenient compass the whole of the materials which may be useful to the legal practitioner in considering questions relating to Patents for Inventions, Designs, and Trade-marks.

The Practice in reference to these subjects—that is to say, the proceedings to be taken by persons desirous of securing exclusive rights in respect of Patents, Designs, or Trade-marks, or by persons opposing the acquisition of such rights by others—will in future depend mainly, and indeed it may be said entirely, upon the "Patents, Designs, and Trade Marks Act, 1873," and the Rules and Forms and Official Regulations issued and enforced under and by virtue of this statute. Consequently this work contains the Statute at length, with the Rules and Forms now in force, and also the "Instructions" and "Information," and other official notices that have been issued by the Board of Trade for the benefit of persons making applications, or interested in or affected by applications, in respect of Patents, Designs, or Trade-marks. And the writer has added notes and comments upon the most important points, together with cross-references wherever necessary.

The Procedure in reference to these subjects—that is

to say, the legal proceedings which may have to be taken by persons to enforce their rights, or in opposition to persons claiming rights, in respect of Patents, Designs, or Trade-marks—will be regulated to some extent by the Act and the Rules, and in part also by reference to existing decisions upon previous statutes. The present statute codifies the prior statute law on these subjects, but it does not codify, or make any pretence to codify, the very many existing judicial decisions. The general nature of the proceedings to be taken in actions for infringement, upon applications to rescind letters patent, for compulsory licenses, or to rectify the registers of proprietors of Patents, Designs, and Trade-marks, or upon petitions for extension of patents, is prescribed, and the outlines of such proceedings are indicated very briefly by the Act and Rules; but the questions which must arise from time to time as to the exact details of these proceedings and the rights of litigant parties will have to be determined in many cases by a recourse to reported decisions on analogous points which have already arisen under previous statutes. Consequently this book contains in the notes and comments the substance of the reported decisions upon these points, and the attempt has been made to incorporate or refer to every decision which can be of any real importance on any question of Procedure.

In connection with this the Law Officers' Rules and the Rules now in force in respect of Proceedings before the Privy Council have been inserted and annotated.

The law relating to these three subjects is now somewhat extensive, particularly on the subject of Patents, and is made up almost entirely of judicial decisions and dicta. A summary of the whole of these decisions would

have expanded the work into an unwieldy size. Consequently what has been done has been to enunciate the various leading principles relating to Patents, and to the rights of persons interested as proprietors or otherwise in Patents, and to illustrate these principles by statements of the substance of or by reference to the leading decisions upon the different points. The law, so far as it relates to Designs and to Trade-marks, is much less extensive, and the decisions are far less numerous than the law and the decisions in connection with Patents. Consequently it has been possible to incorporate in the notes substantially the whole of the decisions of material importance on these two subjects.

The cases, and the copies of official documents which have been included, have been brought down to date.

For the preparation of the list of cases and the full Index the writer is indebted to his friend Mr. H. H. Browell, M.A., of Lincoln's Inn, Barrister-at-Law.

S. B.

5 *New Court, Lincoln's Inn.*
December, 1884.

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CORRECTIONS.

Page 31, line 5 from bottom, for "declaimer" read "disclaimer."
„ 42, note (*zz*), for "Patent," read "Patents."
„ 92, line 3, for "or," read "of."
„ 97, line 11, for "to," read "from."
„ 108, note (*s*), for "97," read "79."
„ 111, line 3 from bottom, for "valid," read "liable."
„ 129, line 11, for "121," read "120."
„ 134, line 11, for "trade," read "trade-marks."
„ 168, line 16, for "c. 160," read "c. 100."
„ 190, line 11, for "licenses," read "assignments."

ADDITIONS.

CASES.

Page 30 . .	Add reference to *Hearson's Patent*, O. J. Rep. vol. i. p. 213, as note to sub-s. (4) of s. 10.
„ 34, note (*yy*)	Add reference to *Hearson's Patent* and to *Cropper* v. *Smith*, W. N. 1884, p. 225.
„ 37 . .	Add reference to *Re Brandon's Patent*, 9 App. Cas. 590, as note to s. 25.
„ 39, note (*aa*)	*Newton's Patents* is now reported, 9 App. Cas. 592.
„ 42, note (*zz*)	*Re Newton's Patents* is now reported 9 App. Cas. 592.
„ 46, s. 26 .	Add reference to *Fuldan's Patent*, W. N. 1884, 192, as to the right of petitioner to exhibit interrogatories.
„ 47, s. 26, sub-s. (4)	Add reference to *Re Martin's Patent*, 29 Sol. J. p. 148, where the Attorney-General, after consulting the Solicitor-General, *held* that on an application by a licensee for the consent of the Attorney-General to the presentation by him of a petition for the revocation of letters patent, which application was opposed by the patentee and was abandoned, *held* that he had no power to order costs to be paid.
Pages 60 and 61	Add references to *Cropper* v. *Smith*, 26 C. D. (C.A.) 700, 33 W. R. 60.
Page 68, note (*n*)	*United Telephone Co.* v. *London and Globe Telephone Co.* is also reported in 26 Ch. D. 766.
„ „ note (*p*)	*Nordenfeldt* v. *Gardner* is reported in O. J. Rep. vol. i. p. 10.
„ 78, note (*m*)	Add reference to *Jackson* v. *Needle*, O. J. Rep. vol. i. p. 174, where Bacon, V.C., granted an interim injunction, but the Court of Appeal dissolved it, putting the defendant upon an undertaking to keep an account of his sales.

Page 93, note (*zz*)	*Brandon's Patent* is now reported 9 App. Cas 590.
„ 101, note (*r*)	*Cropper* v. *Smith* is now reported 26 C. D. (C.A.) 700, 33 W. R. 60.
„ 103 . .	Add reference to *Le May* v. *Welch, Margetson & Co.* (App.) 33 W. R. 33; 28 Ch. D. (C.A.) 24, to entitle a "new or original" design to be registered there must be substantial novelty or originality.
„ 108 . .	Add reference to *Wittman* v. *Oppenheim*, 27 C. D. 260, as note to s. 51.
„ 124, note (*l*)	Add reference to *Re Heaton's Trade Mark*, 27 C. D. 570.
„ 127 . .	Add reference to *Re Price's Patent Candle Co.*, 27 C. D. 681.
„ 133, note (*z*)	Add reference to *Re Heaton's Trade Mark*, 27 C. D. 570.
„ 133, note (*z*) and page 134	Add reference to *Re Lloyd & Sons' Trade-mark*, 27 C. D. 646.
„ 134 . .	Add reference to *Re Price's Patent Candle Co.*, 27 C. D. 681.
„ 141, note (*s*)	Add reference to *Wittman* v. *Oppenheim*, 27 C. D. 260.
„ 153 . .	Add reference to *Re Lloyd & Sons' Trade-mark*, 27 C. D. 646.
„ 155 . .	Add reference to *Re Mitchell & Co's., and Houghton & Hallmark's Trade-mark*, 33 W. R. 148; W. N. 1884, p. 217, as to placing on the register a note as to an agreement.
„ 167 . .	Add reference to *Re Brandon's Patent*, 9 App. Cas. 590, as note to s. 113.

THE

PATENTS, DESIGNS,

AND

TRADE MARKS ACT, 1883.

SUPPLEMENT.

PART I.

Additions and Corrections.

PAGE

2. *Add* to s. 4 a reference to s. 5 of 48 & 49 Vict. c. 63, *post*, p. 9.
7. *Add* to sub-s. 2 of s. 5, a reference to s. 2 of 48 & 49 Vict. c. 63, *post*, p. 8.
11. *Add* to paragraph IV., *Gandy* v. *Reddaway*, O. J. Rep. vol. ii. p. 49—If there are several varieties of a substance (such as canvas bands) for the user of which a patent is taken out, and only some of such varieties are available for the patent, then, if the specification does not indicate which alone are so available, the patent will be bad, even though it is admitted to be—if it had been so limited—very useful.
18, 19, and 24. *Add* to ss. 8, 9, and 12, references to s. 3 of 48 & 49 Vict. c. 63, *post*, p. 8, whereby extensions of time are allowed with respect to the leaving, accepting, and filing a complete specification.
20. *Add* to s. 10 a reference to s. 4 of 48 & 49 Vict. c. 63, which provides that if an application be not accepted, the specifications and drawings (if any) shall not be open to public inspection or be published.
30. *Add* to sub-s. 7 of s. 18, *Hearson's Patent*, O. J. Rep. vol. i. p. 213. There the law officer said, "As a general rule, and apart from exceptional circumstances, it is proper that when desired a condition should be imposed that no action shall

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be brought or other proceeding taken in respect of any infringement prior to the 1st of January, 1884. . . . . The order in the present case will be:—That the application ought to be allowed, subject to the condition that the applicants shall not bring any action, or take any proceeding in respect of an infringement of the patent prior to the 1st of January, 1884, but this condition is to be without prejudice to the pending action or any question arising therein. I think there should be no costs of the appeal."

30 and 34. *Add* to sub-s. 10 of s. 18, and to s. 19, *Cropper* v. *Smith* (No. 2) 28 Ch. D. 148; 33 W. R. 338, where held that after judgment in any action there is no longer as regards such action any "pending proceeding" even though there should be an appeal from such judgment pending.

34. *Add* to s. 19, *Hiram Codd* v. *Bratby*, O. J. Rep. vol. i. 209. The plaintiff in this action applied under this section (19) for liberty to apply at the Patent Office for leave to amend the specification of his patent by way of disclaimer, and that in the meantime the trial of the action might be postponed. It appeared that the plaintiff had previously made application to the Comptroller for leave to disclaim, which was refused on the ground that the action was pending, and no leave to disclaim had been obtained from the Court. It was held, that the liberty applied for should be granted upon the terms that the specification when amended should not be given in evidence at the trial of the action, and that no evidence should be given of any infringement prior to the date of the filing of the amended specification; and that the costs of the motion and of the previous application to the Comptroller and thrown away by reason of the amendment be paid by the plaintiff.

38. *Add* to sub-s. 5 of s. 25—In *W. W. Smith's Patent*, O. J. Rep. vol. ii. p. 14, a new patent was granted for seven years without conditions, and without requiring a new specification to be filed.

40. *Add* to note (*i*) a reference to *Furness' Patent*, O. J. Rep. vol. ii. 175.

41. *Add* to note (*q*)—"It was laid down in Hill's Patent (1 Moore's P. C. 251), where the patentee was also a manufacturer, that two-thirds was too much to be attributed to the general manufacturing profit, and that one-third was too little to

PAGE

be attributed to the patent profits. But there is no specific rule which can be acted upon."—Judgment of Privy Council: *Duncan and Wilson's Patent*, O. J. Rep. vol. i. 257, where an application for extension was refused chiefly by reason of the state of the accounts, though the invention was "an exceeding ingenious and meritorious one, and useful."

47. *Add* to sub-s. 5 of s. 26—In *Haddon's Patent*, 54 L. J. C. 126, 33 W. R. 96, a petitioner was allowed to deliver interrogatories to the patentee.

53. *Add* to sub-s. 6 of s. 29—Where the judge decided against the defendant, but the Court of Appeal and the House of Lords held the patent invalid, a certificate (under the Act of 1852) was given as to the costs of the particulars upon which the defendant ultimately succeeded by the judge who heard the action in the first instance: *Cropper* v. *Smith*, W. N. 1885, p. 111.

„ Where the plaintiff's case broke down on his own evidence, and the judge dismissed the action with costs, and therefore the defendant put in no evidence, it was held both by the judge and by the Court of Appeal, with respect to the costs of the defendant's particulars (which had not been proved), that neither Lord Cairns' Act (21 & 22 Vict. c. 27) nor Sir J. Rolt's Act (25 & 26 Vict. c. 42) made it obligatory on a Court of Equity to follow the rule as to costs of particulars of objections laid down by the Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83), s. 43, and that the rule which applied to Courts having no discretion as to costs ought not to be followed by analogy by a Court which had discretion as to costs; that the Vice-Chancellor had therefore power in his discretion to give these costs, and that they must be allowed: *Parnell* v. *Mort, Liddell, & Co.*, 29 C. D. (C. A.) 325; 33 W. R. (C. A.) 481.

„ As to costs, where parties succeed on some and fail on others of several issues raised by them, see *Badische Anilin, &c., Fabrik* v. *Levinstein*, 29 Sol. J. (C. A.) 354; *Pooley* v. *Pointon*, O. J. Rep. vol. ii. 167; *Lawrence* v. *Perry*, O. J. Rep. vol. ii. 179.

56. *Add* to note (*r*)—Where articles were manufactured abroad which if manufactured here would have been an infringement of the plaintiff's patent, and were imported and used

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here solely (as the defendant alleged) by way of experiment and to afford instruction to pupils to see whether they could not be improved upon, as certain royalty-paid apparatus in the defendant's possession were too expensive to pull to pieces, &c., this was held a user for advantage, and consequently an infringement: *United Telephone Co.* v. *Sharples*, 29 C. D. 164; 33 W. R. 444.

59. Particulars of objections delivered by one of two defendants who were partners were available on behalf of the other defendant: *Cropper* v. *Smith*, 10 App. Cas. 249.

62. *Add* to note (*g*) a reference to *Otto* v. *Steel*, O. J. Rep. vol. ii. 139.

69. *Add* as note under heading "Referee"—Where any question in an action is sent to a referee, the costs of such reference will usually be made costs in the action: *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 C. D. 156; 31 W. R. 913.

71. *Add* as note to last paragraph a reference to *United Telephone Co.* v. *Sharples*, O. J. Rep. vol. ii. p. 12—Where two actions were brought the judge at the trial allowed to the plaintiffs succeeding only the costs of one.

74. *Add* to note (*r*) a reference to *Pannell* v. *Mort, Liddell, & Co.*, as cited, *ante*, p. 3.

79. *Add* to note (*r*)—Where the evidence of the plaintiffs applying for inspection only amounted to suspicion on their part that the defendants were infringing, and no grounds were stated for such suspicion, an application for inspection of the defendant's mills was refused: *Germ Milling Co.* v. *Robinson*, O. J. Rep. vol. i. p. 217.

83. *Add* to note (*k*)—If the defendant (who has put in a defence) does not appear on the hearing, the plaintiff must prove his specification and the fact of infringement, and is then entitled to judgment, though not to a certificate of validity or to costs on the higher scale: *Peroni* v. *Hudson*, O. J. Rep. vol. i. p. 261.

A certificate under 15 & 16 Vict. c. 83, s. 43, that the validity of a patent came in question cannot be obtained by a defendant in an action for infringement: *Badische Anilin und Soda Fabrik* v. *Levinstein*, 29 C. D. C. A. 366.

84. *Add* to note (*m*) references to *Barney* v. *United Telephone Co.*, 28 C. D. 394; and *Household* v. *Fairburn* (No. 1), 51 L. T. 498; (No. 2), O. J. Rep. vol. ii. p. 140.

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105. *Add* as note to "Invalid Designs"—A design is not a proper subject of registration under the Patents, &c., Act, 1883, unless there is a clearly marked and defined difference involving substantial novelty between it and any design previously in use. A design for a shirt collar was registered, the advantages claimed for which were—the height of the collar above the stud which fastened it in front, the cutting away of the corners in a segment of a circle, and the absence of a band. A collar was shown to have been previously in use which had no band, and in which the corners were cut away in arcs of circles; but the cutting away was not so wide, and the height above the stud was not so great, as in the registered design. It was held by the Court of Appeal that the registered design was not new or original within the meaning of the Act, and must be removed from the register: *Le May* v. *Welch*, 28 C. D. C. A. 24; 54 L. J. C. 279; 33 W. R. 33; 51 L. T. 867.

108. *Add* to note (*u*) a reference *Wittman* v. *Oppenheim*, 27 C. D. 260.

116. As to amount of similarity which will prevent a proposed trade-mark being registered: see *Sone & Fleming Manufacturing Co.'s Trade-mark*, 29 Sol. J. 540.

„ *Add* to note (*e*) a reference to *Heaton's Trade-mark*, 27 C. D. 570.

118. *Add* to note (*m*) a reference to *Houghton & Hallmark's Trade-mark*, 28 C. D. 666, reported as *Mitchell & Co.'s, &c., Trade-mark*, 33 W. R. 408.

119. *Add* to note (*n*)—So decided by Kay, J., in *Hayward & Sons' Trade-mark*, W. N. 1885, p. 158.

122. *Add* to note (*b*) a reference to *Leonard* v. *Wells*, 26 C. D. 288—"valvoline" as applied to a particular kind of oil.

125. *Add* as note to sub-s. 1 of s. 64—An application was made for an order upon the Comptroller of Trade-marks to register a mark having the words "Price's Patent Candle Company" in common letters round the upper border, and "National Sperm" in the centre, with the address of the company round the lower border. The Comptroller refused to register the mark, on the ground that there was a mark so nearly resembling this, already on the register, as to be calculated to deceive, and also because it was not a distinctive label within the terms of the Patents, &c., Act, 1883.

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The Court held (*a*) that the name of the firm printed in common letters not being distinctive, and the words "National Sperm" not being fancy words "not in common use," the label did not fulfil the requirements of s. 64 of the Act; and (*b*), that the Comptroller would be justified in refusing to register a label so nearly resembling another label already on the register as to be calculated to deceive, until the opinion of the Court should have been obtained authorising him to do so: *Re Price's Patent Candle Company*, 27 C. D. 681; 54 L. J. C. 210.

126. *Add* generally as notes to this page—As to "fancy" words. Single words, &c., may now be registered; but words or expressions to be registered must be of a "fancy" description, *e.g.* "Asiatic Walnut" is not: *Friedlander's Trade-mark*, 29 Sol. J. 397. "Alpine," as applied to woollen, &c., goods, is: *Trade-mark "Alpine,"* 29 C. D. 877; 54 L. J. C. 727; 33 W. R. 725; 53 L. T. 79; so is "The Lawford" as applied to tennis bats: *Slazenger* v. *Malings*, W. N. 1885, p. 124.

"Not in common use." This is essential, and therefore in *Re Price's Patent Candle Co.*, 27 C. D. 681, it was held that the words "National Sperm," even if fancy words, being in fact in common use could not be registered.

A single word, *e.g.* "Valvoline," cannot be registered as a "heading" unless it was so used before the Act: *Leonard* v. *Wells*, 26 C. D. C. A. 288.

The plaintiff registered a trade-mark with the words "Strathmore Blend," and the whisky became known to many of his customers and in the market as "Strathmore whisky." The defendant afterwards registered a trade-mark, and the name of "Strathmore," for a whisky blended and sold by him. The Court held that the word "blend" described the operation of manufacturing, and was not an essential part of the name of the plaintiff's whisky; that "Strathmore" was a fancy name; that the defendant must be restrained from using the word either as part of his trade-mark or otherwise; and that the defendant could not register the word "Strathmore" in combination with his trade-mark, and that the register must be rectified by striking out the word: *Blair* v. *Stock*, 52 L. T. 123.

128–9. The words in sub-s. 3 of s. 64, "any special and distinctive

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word or words, letters, figures, or combination of letters or figures, or of letters and figures used as a trade-mark before the 13th day of August, 1875, may be registered as a trade-mark under this part of this Act," refer to words when used alone, not in combination with any other device—*per* Selborne, L. C., in *Leonard* v. *Wells*, 26 C. D. C. A. 288, 295, referring to *J. B. Palmer's Trade-mark*, 24 C. D. 504, 518. See also *per* Fry, L. J., in the same case.

137. *Add* as note to s. 76—The Act does not confer by registration and the lapse of five years an indefeasible title when the thing registered ought not to have been registered: *Leonard* v. *Wells*, 26 C. D. C. A. 288; *Lloyd & Son's Trade-mark*, *Lloyd* v. *Bottomley*, 27 C. D. 646; *Wragg's Trade-Mark*, 29 C. D. 551.

141. *Add* to note (*s*)—*Upmann* v. *Forester* was followed in *Wittman* v. *Oppenheim*, 27 C. D. 260: but not by Smith, J., in *Upmann* v. *Currey*, 29 Sol. J. 735.

151. *Add* as note to s. 85—This section prevents the entry on the register of any memorandum to the effect that the right registered, *e.g.* a trade-mark, is restricted by agreement between the parties: *Mitchell & Co's., and Houghton & Hallmark's Trade-mark*, 28 C. D. 666. Undertakings as to the user of the rights registered may, however, be entered on the register. *Ibid.*

168. *Add* to s. 113 a reference to *Hayward & Sons' Trade-mark*, W. N. 1885, p. 158.

PART II.

48 & 49 VICT. c. 63.

ARRANGEMENT OF SECTIONS.

SECTION.

1. Construction and short title.
2. Amendment of s. 5 of 46 & 47 Vict. c. 57.
3. Amendment of ss. 8, 9, and 12 of 46 & 47 Vict. c. 57.
4. Specifications, &c., not to be published unless application accepted.
5. Power to grant patents to several persons jointly.
6. Amendment of s. 103 of 46 & 47 Vict. c. 57.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Construction and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of s. 5 of 46 & 47 Vict. c. 57.

2. Whereas subsection two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that subsection mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that:

The declaration mentioned in subsection two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed. 5 & 6 W. 4, c. 62.

See Patents Rules 6, 20, and 21, *ante*, pp. 179–183; and Form A 1, *ante*, p. 198.

Amendment of ss. 8, 9, and 12 of 46 & 47 Vict. c. 57.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the Comptroller to extend in certain cases the said times: Be it therefore enacted as follows:

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the Comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

For the provisions authorising the Comptroller to extend time, see Patents Rules 46 and 47, *ante*, p. 187; Designs Rules, 31, *ante*, p. 231; and Trade-marks Rules, 52, *ante*, p. 254. These rules, however, apply only to the several periods of time specified in the different sets of rules themselves. Section 17, sub-ss. 3 and 4 of the principal Act (*ante*, p. 28), also provide for the extension of time in the cases there mentioned.

Specifications, &c., not to be published unless application accepted.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion

with such application, shall not at any time be open to public inspection or be published by the Comptroller.

This provision supplements sect. 10 of the principal Act (*ante*, p. 20), which provided that on the acceptance of the complete specification the specification and drawings shall be published.

Power to grant patents to several persons jointly.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

See sect. 4 of the principal Act, and notes thereto, *ante*, p. 2.

Amendment of s. 103 of 46 & 47 Vict. c. 57.

6. In subsection one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

THE

PATENTS, DESIGNS,

AND

TRADE MARKS ACT, 1883.

46 & 47 VICT. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August, 1883.

BE it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

PRELIMINARY.

PART I. PRELIMINARY.

SS. 1, 2.

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

Short title.

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

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

Division of Act into parts.

PART I. PRELIMINARY. S. 3. Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three.

PART II.

PATENTS.

Application for and Grant of Patent.

PART II. PATENTS. S. 4. Persons entitled to apply for patent.

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

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

For definition of "patent," see sect. 46.

GRANT.

To whom letters patent may be granted.

Letters patent may be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad (*a*).

A person may apply for a patent as trustee for another, whether a British subject or an alien (*b*). The representatives of a person who had made a discovery, but had not himself applied for letters patent, could not themselves apply (*c*). But now, by sect. 34, they may do so.

"True and first inventor."

The applicant for letters patent must, by section 5, be the "True and First Inventor." These words are taken from the Statute of Monopolies, 21 Jac. 1, c. 3, s. 5, and they include various persons other than those who are in strictness the actual inventors.

Communication from abroad.

Thus it has long been settled that a person who first receives from abroad a communication of a new invention may take out a patent for the same, but the cases which have decided this were an extension of the law. "It is difficult to say *à priori*, on what prin

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(*a*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*b*) *Beard* v. *Egerton*, 3 C. B. 97; 15 L. J. C. P. 270; *Re Newton's Patent*, 14 Moo. P. C. 156.

(*c*) See page 4, note (*h*); and sect. 34, *post*.

ciple a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor. I have never been able to discover the principle, and although I have often made inquiry of others, and of some who are more familiar with the patent law than even I am, although I cannot pretend not to possess a considerable familiarity with it, I could never get a satisfactory answer. The only answer was, 'It has been decided, and you are bound by the decisions.' But it is an anomaly as far as I know, not depending on any principle whatever. It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is, that I must look upon it as a sort of anomalous decision which has acquired by time and recognition the force of law" (*d*).

Whether, however, such persons will be able in future to take out patents in respect of the communicated invention, is doubtful. Section 5 provides (sub-sect. 2), that the declaration to be made by an applicant must state that he is in possession of an invention whereof "he or in case of a joint application one or more of the applicants claim or claims to be the true and first inventor or inventors." If this section were construed strictly, an importer, merely as such, plainly cannot apply for, and therefore cannot receive a grant of letters patent.

It is suggested, however, that the difficulty may be got over in either of two ways—(a) By joining the foreign inventor with the English applicant, who would make the declaration, varying it somewhat from the statutory form so as to state that the foreigner joined with him in the application, is the first inventor, or (b), by the foreign inventor himself making the application (which under this section he may do) and himself subscribing the necessary declaration.

When inventions are communicated from abroad this should be clearly stated and appear in the application and in the letters patent (*e*).

The person taking out such a patent may be, as indeed he

(*d*) *Per* Jessel, M.R., in *Marsden* v. *Saville Street Co.*, 3 Ex. D. C. A. 203, 205. A person obtaining a patent for an invention communicated to him from abroad is an "inventor" within the meaning of the statute of James I. *Nickels* v. *Ross*, 8 C. B. 679.

(*e*) *Milligan* v. *Marsh*, 2 Jur. N. S. 1083. See Patent Rules, Form A 1.

PART II. PATENTS. S. 4.

usually is, an agent of the foreign inventor who has had no share in discovering the invention (*f*).

The person taking out the patent is deemed for all purposes connected with the grant of the patent or its validity the actual inventor (*g*).

Persons entitled to apply for patent.

A communication made in this country by one person to another does not make the latter the "first and true inventor" so as to entitle him to obtain a patent (*h*).

Person in public office.

A person filling a public office, such as a referee appointed by Act of Parliament to make inquiries of a public nature, who in the course of his duty and inquiries, makes a discovery, cannot take out a patent for such discovery (*k*).

Concurrent applications.

In the case of concurrent applications for letters patent for the same invention the most expeditious applicant, even though the later in date will, or at least may, get the great seal affixed to the grant to himself (*l*).

In such case it has been held prior to the present statute that letters patent cannot subsequently be granted to the earlier applicant (*m*), and that if a grant be subsequently made to the earlier applicant, on the ground that a part of the invention claimed by him is not within the letters patent already granted, this second grant ought to be dated subsequent to the date of the previous grant (*n*).

But Earl Cairns, L.C., in *Dering's Patent* (*o*) questioned the soundness of this principle, and declined to follow it in the case now cited. Here the applications for provisional protection were made on the same day, and the Lord Chancellor considered that a grant of separate letters patent ought to be made to each applicant

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(*f*) *Beard* v. *Egerton*, 3 C. B. 97; *Wirth's Patent*, 12 Ch. D. 303.

(*g*) See *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 582; *Wegmann* v. *Corcoran*, 13 Ch. D. C. A. 65.

(*h*) *Marsden* v. *Saville Street Foundry Co.*, 3 Ex. D. C. A. 203; which case also decided that the legal personal representatives of a person who had made an invention but had not taken out a patent for it, could not themselves take out letters patent for such invention.

(*k*) *Patterson* v. *Gaslight and Coke Co.*, 3 App. Cas. 239.

(*l*) *Ex p. Dyer*, Holroyd, 59; *Ex p. Bates and Redgate*, L. R. 4 Ch. 577; *Ex p. Bailey*, L. R. 8 Ch. 60. Compare *Lee* v. *Walker*, L. R. 7 C. P. 121, where an action was brought against a patent agent for negligence under such circumstances.

(*m*) *Ex p. Bates and Redgate, ubi supra.*

(*n*) *Ex p. Bailey, ubi supra.*

(*o*) 13 Ch. D. 393–396; compare *Ex p. Manceaux*, L. R. 6 Ch. 272.

and that thereby they would in effect be made co-proprietors, and neither could restrain or interfere with the other.

By consent of rival applicants letters patent may be granted to each of them, and dated on the same day (*p*).

Now by sect. 13 of the Act it is expressly provided that in the case of rival applications "the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application."

Persons entitled to apply for patent.

Sometimes in the case of contemporaneous discoveries, a patent has been granted to the discoverers jointly (*q*), and this would seem to be a proper course to adopt whenever the parties are willing.

Where a master and his foreman both made improvements, it was held that the letters patent ought only to be granted on the terms of their being vested in trustees for both (*r*).

Master and workman.

The cases of employers of labour and other persons applying for patents in respect of inventions which have in fact been discovered by persons in their employ, and of other persons from whom the applicants have obtained the secret are now expressly provided for in sect. 11.

CO-OWNERS (*s*).

When a grant is made to two or more persons jointly, it was

Co-owners.

(*p*) *Re Gething*, L. R. 9 Ch. 633.

(*q*) *Per* Campbell, C.J., and Cockburn, A.G., *Heath* v. *Smith*, 2 Web. P. C. 271.

(*r*) *Re Russell*, 2 D. & J. 130; Compare *Ex p. Scott and Young*, L. R. 6 Ch. 274.

(*s*) Lindley, L.J., in "Partnership," vol. i. p. 69, 3rd. ed., expresses himself thus:—"Cases may arise in which justice may be done by allowing each co-owner [of a chattel] to make what he can, and to keep what he may get. This may occur where the chattel is such that each co-owner can, in fact, enjoy his rights to the full extent, without the concurrence of the other owners (*e.g.*, where the chattel is a patent for an invention). In the case of a patent, belonging to several persons in common, each co-owner can by law assign his share and sue for an infringement (see *Dunnicliffe* v. *Mallett*, 7 C. B. 209, and *Walter* v. *Lavater*, 8 ib. 162; and as to tenants in common of trade-marks, see *Dent* v. *Turpin*, 2 J. & H. 139), and can also work the patent himself, and give licenses to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses (*Mathers* v. *Green*, L. R. 1 Ch. 29. The same point was discussed, but not decided, in *Hancock* v. *Bewley*, Joh. 601; see also *Russell's Patent*, 2 De G. & J. 130; and *Horsley* &

PART II.

PATENTS.

S. 4.

Persons entitled to apply for patent.

held in *Mathers* v. *Green* (*t*) that any one may use the invention for his own benefit without the consent of the others, or accounting to them for any profits made by his own personal user. But this case cannot be considered to have decided that a co-patentee is not liable to account to his joint owners for any profits made by him by granting licences. And it has been held that the part owner of a dramatic entertainment cannot grant a licence for the representation without the consent of the others, and if he does so he must account for any profits made (*u*).

Assignment.

Where an assignment had been made by a patentee of a share of a patent, and a share of profits arising from the working of the patent by licensees, it was held that the assignee—in the present case the mortgagee of the assignee—of the share was entitled to an account from the licensees, but that the account must be taken once for all in the presence of all the parties interested, and as the patentee had made other assignments of shares of the patent, and the profits arising therefrom to other persons who were not parties, the action was dismissed with costs (*x*).

Where a patentee assigned the patent, and the assignees covenanted to use their best endeavours to introduce the invention by granting licences or working it, and that the patentee should be entitled to 5 per cent. of the net profits however arising, and the assignees subsequently assigned the patent to a company formed for working it, it was held that the company was liable to account to the patentee in an action brought by him against the company directly (*y*).

The assignee of a distinct part of a patent can, however, sue for an infringement of that part without joining one who has an interest in another part, and the damages, if any, recovered will accrue to the former alone (*z*).

Knighton's Patent, L. R. 8 Eq. 475). The mutual rights of co-owners of a copyright not being partners, have not been decided, but they are probably similar to those of co-owners of patents. (See some observations on the indivisibility of copyright in 4 H. L. C. 992)."

(*t*) L. R. 1 Ch. 29; 35 L. J. Ch. 1. *Quære*, whether when a patent is vested in trustees upon trust for several persons as tenants in common or joint tenants, any one of them is at liberty to work the patent on his own account: *Hancock* v. *Bewley*, Joh. 601.

(*u*) *Powell* v. *Head*, 12 Ch. D. 686.

(*x*) *Bergmann* v. *Macmillan*, 17 Ch. D. 423.

(*y*) *Werderman* v. *Société Générale d'Électricité*, 19 Ch. D. C. A. 246.

(*z*) *Dunnicliffe* v. *Mallett*, 7 C. B. N. S. 209; 29 L. J. C. P. 70.

Where a partnership at will was formed between A. and B. for the purpose of working an invention for which a patent had previously been taken out by and registered in the name of A. alone, and the business of such partnership was carried on for some time, it was held that the patent became an asset of the partnership, and each partner acquired a right to practise the invention, and that this right was not taken away by A., the registered owner assigning the patent to third parties, who had notice of the existence of the partnership; but that B. had not thereby acquired a right in the patent itself (*a*).

Application and specification.

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner (*a*).

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

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

(4.) A complete specification, whether left on application or subsequently, must particularly describe and

(*a*) Patent Rules, 6, 8, 9, 10, 19.

(*β*) Ibid. rr. 28–30. Forms A, B, and C, in the First Schedule to the Act, replaced by forms A. A 1, B, and C in the Second Schedule to the Patent Rules. See rule 5.

(*a*) *Kenny's Patent Button-holeing Co.* v. *Somervell*, 38 L. T. 878; 26 W. R. 786.

PART II. PATENTS. — S. 5. — Specifications.

ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

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

PROVISIONAL SPECIFICATIONS.

Provisional specifications were introduced by the Patent Law Amendment Act, 1852. Their object is only to describe generally and fairly the nature of the invention and not to enter into minnte details as to the manner in which the invention is to be carried out (*b*).

Specifications.

The provisional specification cannot be prayed in aid for the purpose of supplying a defect in the complete specification (*c*).

Where a provisional specification was filed on the 17th of March, and afterwards abandoned by the inventor, who delivered another specification for the same invention on the 10th of April, in respect of which a patent was granted to him on the 12th of October, but dated as of the 10th of April; it was held that there had not been a dedication of the invention to the public by the abandonment of the first provisional specification, but that the patent was valid (*d*).

Language of provisional specification.

The provisional specification ought not to be vague or expressed in terms too wide or general, and the objections which formerly were often made to the validity of letters patent, on the ground that the title was not sufficiently explicit or connected with the subject-matter, apply equally to provisional specifications which are not precise and clear. "The relation which the provisional specification bears to the complete specification is much the same as that which, before the Patent Law Amendment Act, the title bore to the specification; and the observations of Tindal, C.J., in *Cook* v. *Pearce* (*e*) are as applicable to the provisional specification now as

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(*b*) *Newall* v. *Elliott*, 4 C. B. N. S. 269; 27 L. J. C. P. 337; 10 Jur. N. S. 954.

(*c*) *Mackellan* v. *Rennie*, 13 C. B. (N.S.) 52.

(*d*) *Oxley* v. *Holden*, 8 C. B. N. S. 666; 30 L. J. (C.P.) 68. Compare *Stoner* v. *Todd*, 4 Ch. D. 58.

(*e*) 8 Q. B. 1064.

they were to the title formerly. That learned judge says: 'The vagueness (he had previously spoken of the vagueness and generality) of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void.' These remarks, as applied to the title of a patent, have a stronger application to the case of a provisional specification under the Patent Law Amendment Act, because the law officer, if he thinks the specification too large, can order it to be amended. And if no objection is made by him, the generality of the specification, to repeat the words of Chief Justice Tindal, affords no grounds for avoiding the patent after it is granted "(*f*).

Nevertheless, as appears by the judgment just cited, it was for the law officer, and now it is presumed it will be for the comptroller, to object that a provisional specification is too general, and if he raises no objection on such ground no other person can impeach it.

Variance between provisional and complete specification.

The provisional specification so far controls the complete specification that the latter must not claim anything different from that which is included in the provisional specification (*g*), and ought not to vary materially in description of the manner of putting the invention into operation, or in the invention claimed from that set forth in the provisional specification (*h*). But there may be considerable variation between the two documents without avoiding the patent (*i*).

TITLE.

By sect. 6 the title "must sufficiently indicate the subject-matter of the invention," and if it does not do so the comptroller may (sect. 7) require it to be amended.

The title hitherto has been, and no doubt in future will be, read as indicating the exact object sought to be retained, and therefore *pro tanto* controlling the specification, consequently there ought to

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(*f*) Per Cranworth, L.C., in *Penn* v. *Bilby*, L. R. 2 Ch. 127, 133.

(*g*) *Penn* v. *Bilby*, *ubi supra*.

(*h*) *Bailey* v. *Roberton*, 3 App. Cas. 1055, 1061-2; *United Telephone Co.* v. *Harrison, Cox-Walker, & Co.*, 21 Ch. D. 720.

(*i*) *Foxwell* v. *Bostock*, 4 D. G. J. & S. 298; *Thomas* v. *Welch*, L. R. 1 C. P. 192; 35 L. J. C. P. 200.

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be no material variation between the title and the specification, or the patent may be void (*k*).

If, however, the specification is consistent with the title (*l*); or if the specification, though on one construction apparently wider than the title, can be read so as to limit it to the title (*m*); or if the specification being in wider language than the title applies only to things *ejusdem generis* with those described in the title (*n*), the patent will be good.

But if the title is, in fact, too wide and general, it cannot be limited or controlled by the specification, and the patent will be void (*o*).

COMPLETE SPECIFICATION.

The principles of law relating to the validity of specifications as depending upon the language used and the information given in and by them may be thus shortly enunciated:—

I. There must be no mis-description of the invention, or the manner whereby it is to be performed, or of the machines, implements, or substances to be employed in effectuating it (*p*).

Language of a specification.

The specification must so describe both the nature of the invention and the manner in which it is to be performed, as to enable the patented article or process to be made or carried into operation, and the public thereby to have the benefit of the invention at the end of the term. "To support a patent the specification should be so clear as to enable all the world to use the invention as soon as the term for which it has been granted is at an end" (*q*).

At the same time it must be borne in mind that a specification is often addressed to and intended for scientific persons, skilled artizans, and the like, and when this is so it will be sufficient and

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(*k*) *Hill* v. *Thompson*, 1 Web. P. C. 239; 8 Taunt, 375; *Rex* v. *Wheeler*, 2 B. & Ald. 345; *Croll* v. *Edge*, 9 C. B. 479; 19 L. J. C. P. 261; *Electric Telegraph Co.* v. *Brett*, 10 C. B. 838; 20 L. J. C. P. 123, 130.

(*l*) *Neilson* v. *Harford*, 8 M. & W. 806; 1 Web. P. C. 331; *Beard* v. *Egerton*, 3 C. B. 97; 15 L. J. C. P. 270.

(*m*) *Reg.* v. *Mill*, 10 C. B. 379; 20 L. J. C. P. 16; *Patent Bottle Envelope Co.* v. *Seymer*, 5 C. B. N. S. 164; 28 L. J. C. P. 22; *Oxley* v. *Holden*, 8 C. B. N. S. 707; 30 L. J. Q. B. 74.

(*n*) *Wright* v. *Hitchcock*, L. R. 5 Ex. 37.

(*o*) *Cook* v. *Pearce*, 8 Q. B. 1054; 13 L. J. Q. B. 192.

(*p*) *Neilson* v. *Harford*, 8 M. & W. 806; *Sturtz* v. *De la Rue*, 5 Russ. 322; 1 Web. P. C. 83.

(*q*) Eldon, L.C., in *Newbery* v. *James*, 2 Mer. 451.

valid if it describes the invention in such manner as to be understood by such persons, even though the description be not intelligible by the ordinary unskilled public (*r*).

Whether a specification contains a sufficient description can only be ascertained by experiment, and in making the experiment knowledge and means may be employed which have been acquired since the date of the patent (*s*).

II. A specification must not be in any manner misleading.

One of the objects, perhaps the main object, in granting letters patent being to secure that the public shall have the full benefit of the invention at the expiration of the term covered by the letters patent, it is an implied condition of the grant that "the nature of the invention, and the manner in which it is to be performed," shall be described, not only with particularity, but also so as to point out the best and simplest mode whereby the invention can be effectuated. The patentee must make himself acquainted with the knowledge on the subject to which his invention relates, existing at the time of his invention, and frame his specification by reference to such knowledge. Details that are necessary, but none that are unnecessary, should be given. A complicated, lengthy, or expensive process should not be described, whether as being the essential mode or only one mode of carrying the invention into effect if there is another mode which is substantially simpler, shorter, or cheaper. Least of all should stress be laid upon, or the attention be directed to, unimportant details or non-essential operations. The specification must further, of course, be free from ambiguity, and it must, when necessary, distinguish with reasonable clearness what is new from what is old (*ss*).

III. The specification must describe at least one method or process whereby the invention can be put into practical operation (*t*).

IV. If there are various "manners" whereby the invention may be performed, the specification must mention this and indicate that which, all things taken together, is the most useful (*u*).

(*r*) See *Bickford* v. *Skewes*, 1 Q. B. 938; 1 Web. P. C. 214; *Neilson* v. *Harford*, 1 Web. P. C. 295; *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 607.

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

(*ss*) See cases in following notes.

(*t*) *Derosne* v. *Fairie*, 2 C. M. & R. 476; 1 Web. P. C. 154; *Bailey* v. *Roberton*, 3 App. Cas. 1055.

(*u*) *Heath* v. *Unwin*, 2 Web. P. C. 228, 243.

PART II. PATENTS. S. 5. Specifications.

V. There must be no concealment—the full knowledge of the patentee must be given frankly and clearly (*x*).

VI. There must be no omission of steps or details in the process or operation patented, or any material part thereof, or of substances to be used in carrying the invention into effect (*y*).

VII. Steps or details in the process or operation which are unnecessary for the purposes of the invention, or which are needlessly complicated when other shorter proceedings are available, must not be described as being, and so as to constitute them a part of, or essential to, the invention. And similarly steps, details, or proceedings which are of minor importance, must not be so described or referred to as to imply that, or cause persons attempting to use the invention to think that such steps, details, or proceedings are of the essence of the invention (*z*).

VIII. There must be no ambiguity or uncertainty in the specification taken as a whole, and having regard to the title and to the drawings, if any (*a*).

IX. The specification must always discriminate that which is new from that which is old—it must, so to speak, indicate the *differentiæ separating the invention patented from already known* inventions or manufactures (*b*).

(*x*) *Rex* v. *Arkwright*, 1 Web. P. C. 66:—"The specification must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it."—*Per* Buller, J. *Turner* v. *Winter*, 1 T. R. 607; 1 Web. P. C. 77, 81—as to cheaper materials than those enumerated. *Lewis* v. *Marling*, 10 B. & C. 26; 1 Web. P. C. 496:—"To support a patent it is necessary that the specification should make a full disclosure to the public. If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad. So, if he says that there are many modes of doing a thing, when in fact one only will do, this will avoid the patent; but if he makes a full and fair communication, as far as his knowledge at the time extends, he has done all that is required."

(*y*) *Wood* v. *Zimmer*, Holt, 58; 1 Web. P. C. 82; *Mackellan* v. *Rennie*, 13 C. B. N. S. 59.

(*z*) *Savory* v. *Price*, 1 Ry. & Mo. 1; 1 Web. P. C. 83.

(*a*) *Beard* v. *Egerton*, 8 C. B. 165; 19 L. J. C. P. 36; *Stevens* v. *Keating*, 2 Ex. 772; 19 L. J. Ex. 57; *Patent Type Founding Co.* v. *Richard*, Joh. 381; 6 Jur. N. S. 39; *Ralston* v. *Smith*, 11 H. L. C. 223; *Simpson* v. *Holliday*, L. R. 1 H. L. 315; *Daw* v. *Eley*, L. R. 3 Eq. 500, n., 14 W. R. 126; *Wegmann* v. *Corcoran*, 13 Ch. D. C. A. 65.

(*b*) *Carpenter* v. *Smith*, 1 Web. P. C. 530; *Newall* v. *Elliott*, 10 Jur. N. S. 954. Compare *Daw* v. *Eley*, L. R. 3 Eq. 500, n.; and *Wright* v. *Hitchcock*, L. R. 5 Ex. 37.

The above rules apply only to matters of real and substantial importance. A specification is to be construed reasonably and so as to support the patent rather than the contrary. Mere slips, whether of misdescription or of omission, too great attention to details and the like, will not vitiate if the specification is reasonably full, clear, and explicit.

CONSTRUCTION OF SPECIFICATIONS.

The construction of a specification is a matter of law for the Court and not a question of fact for the jury (*c*).

The sufficiency of the specification for the purpose intended would seem to be for the jury, not the Court to determine (*d*).

The explanation and precise meaning of technical terms and other words of art employed in a specification, as in any other document, are matters for the jury (*e*).

Questions of novelty and the like raised by, or which have to be decided by, a comparison of two specifications, are questions of law for the Court (*f*).

But where two specifications of different dates, relating to the same external objects, contain terms of art, though the expressions used in both are identical, their construction cannot be declared by the Court to be the same without the meaning and use of the terms of art employed therein, being first ascertained by evidence, and being shewn to be the same at the date of both the specifications (*g*).

"Where novelty or infringement depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine, or a material part of one machine, imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact which must be left to the jury" (*h*).

(*c*) *Bovill* v. *Pimm*, 11 Ex. 718; N. S. 37; 6 Jur. N. S. 271; *Hills* v. *Hills* v. *London Gaslight Co.*, 27 L. J. Ex. 60.

(*d*) *Bickford* v. *Skewes*, 1 Q. B. 938. It appears to be so settled in the United States. *Wood* v. *Underhill*, 5 How. 1, 4.

(*e*) *Hills* v. *Evans*, 31 L. J. Ch. 457; 8 Jur. N. S. 525.

(*f*) *Thomas* v. *Foxwell*, 5 Jur. *Evans, ubi supra*; *Bush* v. *Fox*, 5 H. L. C. 707; *Booth* v. *Kennard*, 2 H. & N. 84; 26 L. J. Ex. 305.

(*g*) *Betts* v. *Menzies*, 1 E. & E. 990, 1020; affirmed in the House of Lords, 10 H. L. C. 117.

(*h*) *Per* Campbell, L.C., in *Seed* v. *Higgins*, 8 H. L. C. 550, 561.

PART II. PATENTS. S. 5. Specifications.

Persons for whom specifications intended.

In construing a specification regard must be had to the class of persons to whom it may be presumed to be specially addressed in the case of specifications relating to a scientific or other special subject-matter. "In the case of a specification which is addressed, not to the world at large but to a particular class, for instance, skilled mechanicians possessing a certain amount of knowledge, it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanicians, and to see what the words of the specification mean when applied to such a subject as skilled mechanicians would know, and, as the tribunal has now, by the admission of evidence or otherwise, put itself in a position to understand, and then to say, what the words of the specification mean when applied to such a subject-matter" (*i*).

A specification, like any other document, is to be construed according to the ordinary and proper meaning of the language used (*k*). "In construing the specification, we must construe it like all written documents, taking the words and seeing what is the meaning of those words when applied to the subject-matter" (*l*).

CLAIM.

Claiming clause.

A complete specification "must end with a distinct statement of the invention claimed." This provision is new. Previously a "claim has not been essential to a specification" (*m*), and "you may have a perfectly good specification without the word 'claim' or the thing claim in it at all" (*n*).

"Nevertheless a claiming clause is commonly inserted at the end of a patent, and that is of immense importance in enabling us to construe the specification, and to see, looking at the whole specification, whether a thing is included in it or not" (*o*). "The real object of what is called a claim, which is now more commonly put in than it used to be formerly, is not to claim anything which is not mentioned in the specification, but to disclaim something. A

(*i*) Last note. Compare *Neilson* v. *Harford*, 8 M. & W. 803; 8 Web. P. C. 331; *Heath* v. *Unwin*, 2 Web. P. C. 236, 245; *Foxwell* v. *Bostock*, 84 D. G. & S. 298, 10 L. T. 144.

(*k*) *Elliott* v. *Turner*, 2 C. B. 446; 15 L. J. C. P. 49; *Simpson* v. *Holliday*, 13 W. R. 578, *per* Westbury, L.C.

(*l*) *Per* Lord Blackburn in *Clark* v. *Adie*, No. 2, 2 App. Cas., 423, 436.

(*m*) *Lister* v. *Leather*, 8 E. & B. 1034; 27 L. J. Q. B. 295.

(*n*) *Per* Lord Blackburn in *Dudgeon* v. *Thomson*, 3 App. Cas. 54.

(*o*) *Ibid.*

man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use—he describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says: 'But take notice, I do not claim the whole of that machine, I do not claim the whole of that *modus operandi*, but that which is new, and that which I claim, is that which I am about to state.' That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification" (*p*).

Claiming clause.

What construction will be given to the express enactment that there must be in future a claiming clause—"a distinct statement of the invention claimed"—cannot be predicated in advance. It is suggested as a first rule that the claim will be read with reasonable strictness. The patentee is now directed to formulate in distinct terms what it is he has invented, and there can be no hardship in requiring that the language used by him shall be clear and explicit, and his rights and privileges in respect of his invention be limited by, if co-extensive with, what he himself states to be his discovery. There is full power to amend (*q*) in the event of a specification being, whether in the body or claim, too extensive or vague.

It is suggested, in the next place, that in cases of ambiguity and the like, the claim must be read with, and interpreted by reference to, the whole of the specification taken together. This has hitherto been the rule. "You must always construe a claim with reference to the whole context of a specification" (*r*).

DRAWINGS.

Hitherto drawings have not been required as an essential in any case, but now, "if required," they must accompany the specification, whether provisional or complete.

What is the precise function and importance of drawings is not fully settled. It would seem, however, that drawings will be

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(*p*) *Per* James, L.J., in *Plimpton* v. *Spiller*, 6 Ch. D. C. A. 426. *Per* Jessel, M.R., in *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 607, 612.

(*q*) Sect. 18.

(*r*) *Per* James, L.J., in *Plimpton* v. *Spiller*, 6 Ch. D. C. A. 412, 427. Compare *per* Fry, J., in *United Telephone Co.* v. *Harrison*, 21 Ch. D. 720, 737–8.

PART II. PATENTS. SS. 6, 7.

allowed to explain an ambiguity in the specification (*s*), or to correct and limit a specification which would otherwise be too vague and general (*t*), and further, that drawings, when employed, are so far an essential part of the specification, that in construing it they must be looked at and considered, so that, if they shew, and apparently claim, appliances which are old, the patent, by reason thereof, will, or at least may, be rendered void (*u*).

Reference of application to examiner.

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

See Patent Rules, 5, 10, 27–30.
For definition of "comptroller," see sect. 82.

This section and sections 7 and 9, containing the necessary incidental and supplemental provisions, are new, and introduce a new procedure of great practical importance.

The "Examiners" are to be appointed by the Board of Trade (section 83).

Power for comptroller to refuse application or require amendment.

7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.

(2.) Where the comptroller requires an amendment,

(*s*) *Hastings* v. *Brown*, 1 E. & B. 450, 454; see *Clark* v. *Adie*, No. 1, 2 App. Cas. 315.

(*t*) *Daw* v. *Eley*, L.R. 3 Eq. 500, n.

(*u*) *Hinks* v. *Safety Lighting Co.*, 4 Ch. D. 607.

the applicant may appeal from his decision to the law officer (*a*).

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

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

Application for patent.

(5.) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

(6.) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so, he may refuse to seal a patent on the application of the second applicant (*γ*).

(*a*) Law Officers Rules, *post*.
(*β*) Patent Rules, 25.
(*γ*) Ibid. 13, 15.

For definition of "law officer," see sect. 117.

Appeals from the comptroller.

An appeal from the comptroller to the law officer in case of decisions by him is provided by the following sections: viz., sect. 7 sub-sect. 6, sect. 9, sub-sect. 2, sect. 11, and sect. 18, sub-sects. 3, 6. But there are no general provisions as to appeals from the comptroller in other cases.

The law officer is, if required on appeal from the comptroller, to hear the applicant and the comptroller, and no doubt they will be allowed to appear personally, or by solicitor or counsel.

PART II. PATENTS. SS. 7, 8.

As to the practice and procedure on appeals to the law officers, see the rules issued by them, *post*.

The effect of the concluding sentence of sub-sect. 6 is not quite clear, but apparently it implies that in every case of rival applications for a patent for the same invention, the grant of letters patent is to be made to the applicant first in date, subject of course to the provisions contained in sect. 11 of this Act (*x*).

Application for patent.

It will be observed, however, that the provision is that the comptroller "may," not "shall," refuse to seal a patent on the application of the second applicant.

Amendments.

The Master of the Rolls, as keeper of the records, had jurisdiction to direct the amendment of a clerical error in a specification (*y*). It would appear that this jurisdiction remains unaltered (*yy*).

By sect. 91 the comptroller is empowered on request to correct clerical errors in connection with applications for a patent, or in the name, style, or address of any registered proprietor of a patent. It is submitted that as well by virtue of this section as from the general authority which the comptroller necessarily has with respect to applications for patents, he has authority (a) to allow clerical and other similar amendments of any kind (not being of substance) in a specification provisional or complete, at least so long as letters patent have not actually been granted, and (b) by virtue of sect. 9, sub-sect. 2, to direct or allow all such amendments as may be necessary to bring the complete specification into accordance with the provisional specification.

Whether the comptroller can (a), even prior to the grant of letters patent, allow material amendments in specifications (except to the extent provided for by sect. 9, sub-sect. 2), or (b) after the grant of letters patent can (except to the extent allowed by sect. 91) permit clerical or other similar amendments, *quære*.

Time for leaving complete specification.

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

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

(*x*) Compare the cases cited, *ante*, pp. 4 and 5.

(*y*) *Johnson's Patent*, 5 Ch D. 503.

(*yy*) *Gare's Patent*, 26 Ch. D. 105.

"Month" is, by 13 & 14 Vict. c. 21, s. 4, "calendar month."

This section does not provide that the application shall become void if a complete specification be not left within nine months after the application, but only that in such case the application "shall be deemed to be abandoned." This would seem to imply that the comptroller is at liberty to accept a complete specification if left after the nine months and before the expiration of twelve months, when the application will become void (*z*).

Time for leaving complete specification.

The publication of a provisional specification which is subsequently abandoned (*a*), or which is followed by a complete specification, omitting a part of the invention described in the provisional specification (*b*), is not necessarily such a publication as to invalidate a patent subsequently obtained relating to the same matter—whether this is so or not will depend upon the amount of information given by the provisional specification.

Comparison of provisional and complete specification.

9. (1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining

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(*z*). Sect. 9, sub-s. 4. Compare *Re Hersee & Smyth*, L. R. 1 Ch. 518, *Somerset and Walker's Patent*, 13 Ch. D. 397; *Johnson's Patent*, 13 Ch. D. 398, n.

(*a*) *Oxley* v. *Holden*, 8 C. B. N. S. 666.

(*b*) *Stoner* v. *Todd*, 4 Ch. D. 58.

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

Complete specification.

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5.) Reports of examiners shall not in any case be published or be open *to* public inspection, and shall not be liable to production or inspection in any legal proceeding, other than an appeal to the law officer under this Act, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

For the extent of which a complete specification may vary from the provisional specification, see *ante*, p. 9.

It is submitted that the decision whether of the comptroller or of the law officer is in no manner conclusive or binding as to the validity of a patent, but that notwithstanding such decision any defence is open to a defendant in an action for infringement.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings, if any, shall be open to public inspection.

Patent Rules, 25, 26.

Opposition to grant of patent.

11. (1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification, give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention

from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground.

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

Patent Rules, 32–41.
Law Officers Rules, *post*.
Compare sect. 18 (4), and sect. 38, *post*.

OBJECTIONS TO GRANT.

The objections which may be made to the grant of a patent are of two kinds: first, objections to the grant of the patent to the particular applicant; and, secondly, objections going to the validity of the patent itself, if and when granted, and therefore to the grant of any patent at all—these latter objections being based on the

PART II. PATENTS. S. 11. Opposition to grant of patent.

existence of a prior patent or prior specification relating to the same invention.

(1.) The first objection is "on the ground that the applicant obtained the invention from" the person objecting.

This provision read strictly would apply only when the invention, that is substantially the whole secret or discovery, has been obtained by the applicant from the person opposing. This would be both a reasonable and a politic construction. Any wider interpretation will almost certainly lead to numerous unfounded claims. As the law is at present it seems quite clear that a person obtaining hints or suggestions from another, for instance, an agent of an inventor receiving a confidential communication not in a practically useful state, may improve on such hints or suggestions, or such crude communication, and take out for his own benefit a patent in respect of the idea carried into practical effect (*c*).

Agents.

Persons employed by others who make discoveries while in such employ are entitled to the benefit thereof, and this objection will enable such persons easily to maintain and enforce their rights as against their employers or others attempting to take out patents in respect of the discoveries so made (*d*).

This provision will, no doubt, provide a satisfactory means for determining to whom a patent ought to be granted when an objector alleges that the applicant obtained the invention from him by fraud or other improper conduct (*e*); or that the application is under the circumstances a breach of faith or otherwise unfair (*f*).

Legal personal representatives.

(2.) The second ground of objection is that the applicant obtained the invention from a person of whom the objector is the legal personal representative.

This taken in connection with sect. 34 introduces new rights—previously the representatives of a deceased person could not take out a patent if their ancestor had not made an application (*g*).

The other two objections which may be set up against the grant of a patent are—

(3.) That the invention has been already patented on an application of prior date.

(*c*) *Milligan* v. *Marsh*, 2 Jur. N. S. 1083; compare *per* Tindal, C.J., in *Allen* v. *Rawson*, 1 C. B. 551, 574.

(*d*) See *Bloxam* v. *Elsee*, 1 Car. & P. 558; *Russell's Patent*, 2 D. & J. 130; *Ex p. Scott and Young*, L. R. 6 Ch. 274.

(*e*) See *Lowe's Patent*, 25 L.J. Ch. 454; *Ex p. Bailey*, L. R. 8 Ch. 60.

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

(*g*) See *ante*, p. 4, note (*h*).

(4.) That the examiner has reported the pendency of a specification accompanying a previous application bearing the same or a similar title, and appearing to relate to the same invention.

Opposition to grant of patent.

From the objections being so specified it seems necessarily to follow that no objection can now be raised to the grant of a patent on the ground of want of utility, that the manufacture is not new, prior public user, and the like.

PRACTICE ON OBJECTION TO GRANT.

Time.

The notice of opposition must be given within two months of the advertisements, but probably in a proper case this time would be, if necessary, extended on terms (*h*).

Hearing of objection.

The comptroller is himself to hear the matter in the first instance. From his decision either party may appeal to the law officer.

It is submitted that the whole case ought to be raised, and all the grounds of objection clearly stated, before the comptroller, and that the parties will not, except under very special circumstances, be allowed to raise a new case or go into new facts before the law officer (*i*).

Prior to the present Act it has been held that a party who did not oppose the sealing of a patent before the law officer could not oppose before the Lord Chancellor (*k*), and it would seem both on principle and from the precise language of the section now in consideration, that persons desirous to oppose before the law officer must previously have opposed before the comptroller.

Costs.

There appears to be no provision empowering the comptroller to award costs in respect of opposition heard by him (*l*), but the law officers may, by sect. 38, order costs in respect of applications heard by them.

The cases which have hitherto been decided on costs in connection with opposition to grant of letters patent, cannot be said to have laid down any clear principle as to awarding or refusing costs, though generally,—(a) where the petition for grant is dismissed

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(*h*) See *Brennand's Patent*, 7 Jur. N. S. 690; 4 L. T. N. S. 456.

(*i*) *Vincent's Patent*, L. R. 2 Ch. 341.

(*k*) *Mitchell's Patent*, L. R. 2 Ch. 343.

(*l*) Whether there is any original jurisdiction in such cases to give costs, *quære*—see *Cutler's Patent*, 4 My. & Cr. 510; *Kynoch* v. *National Arms Co.*, 26 W. R. 22.

PART II. PATENTS. SS. 11, 12. Evidence.

the dismissal is with costs (*m*); (b) where the opposition is unreasonable and fails, the parties have to pay the petitioner's costs (*n*); and (c) the tendency now is to make the costs depend on the event, and therefore to order the opposition which fails, even if it was reasonable, to pay costs (special circumstances apart) (*o*).

The evidence is to be in the first instance by statutory declarations (Patents Rules, 35, 36). But power is given to the law officers to examine witnesses on oath (sect. 38), and it is presumed that, when justice requires it, *viva voce* evidence will, notwithstanding the rules, be received (*p*).

Sealing of patent.

12. (1.) If there is no opposition, or, in the case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases herein-after mentioned, that is to say—

(*a.*) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(*b.*) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal repre-

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(*m*) *Adamson's Patent*, 6 D. G. M. & G. 420; *Ex p. Yates*, L. R. 5 Ch. 1; *Ex p. Henry*, L. R. 8 Ch. 167. Except where it was a case of first impression, *Ex p. Bates & Redgate*, L. R. 4 Ch. 577; or hardship, *Lowe's Patent*, 25 L. J. Ch. 454.

(*n*) *Cutler's Patent*, 4 My. & Cr. 510.

(*o*) See *Re Harrison*, L. R. 9 Ch. 631; *Re Gething*, *ib.* 633.

(*p*) See *Re Gething*, *ubi supra*.

sentative and sealed at any time within twelve months after the death of the applicant.

Where delay had occurred in sealing a patent by reason of opposition, it was held that at whatever stage the opposition occurred the Lord Chancellor had power to extend the time for sealing the patent (*q*).

13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

Date of patent.

Compare sects. 5, 10, 15.

It is presumed that "publication of the complete specification," means the advertisement of the acceptance thereof directed by sect. 10.

Concurrent applications.

Where two patents were applied for on the 20th and 23rd of July respectively, and each patent was sealed and dated as of the day of application, but the patent applied for on the 23rd of July was in fact sealed before that applied for on the 20th of July, it was held that acts done under the patent applied for on the 23rd of July were infringements of the other patent (*r*).

This section provides that the sealing of one patent shall not in future prevent the sealing of another patent for the same invention on an earlier application (*s*); but it does not confer on the earlier applicant an absolute right to have a patent granted to him if he shall have been guilty of delay, negligence, or other improper conduct.

(*q*) *Somerset and Walker's Patent*, 13 Ch. D. 397.

(*r*) *Saxby* v. *Hennett*, L. R. 8 Ex. 210. See *Dering's Patent*, 13 Ch. D. 393, as to two patents applied for on the same day.

(*s*) Compare *Manceaux's Patent*, 18 W. R. 1184; *Ex p. Bates and Redgate*, L. R. 4 Ch. 577; and the cases cited, *ante*, pp. 4 and 5.

PART II. PATENTS. S. 14.

Provisional Protection.

Provisional protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

See sects. 5, 7, sub-sects. (3), and (4), 10.
Compare 15 & 16 Vict. c. 83, s. 8.

What is meant by the "acceptance" of an "application for a patent," is not quite clear. Probably, however, this refers to sub-sects. 3 and 4 of sect. 7. If so provisional protection dates, it is presumed, from the date when the comptroller notifies to an applicant that his application is in proper form.

As either a provisional or a complete specification, or both, may be left with the application, this section may have a somewhat different effect according as the one or the other is left.

Application abandoned.

What will be the effect if an application be abandoned and a new application be made in respect of the same invention? In a case of this kind it was held that there had not been a dedication to the public by the abandonment of the first provisional specification, and that consequently a patent granted on the provisional specification subsequently filed was valid (*t*).

Effect of provisional protection.

This section is substantially the same as sect. 8 of the Patent Law Amendment Act, 1852, and Lord Hatherley thus stated the effect of provisional protection as conferred by that section—the person leaving the provisional specification "may use his invention for six months without prejudice to his patent by that user, but he obtains no rights against the public until his patent has been sealed, and even then the patent will not relate back to acts done in the interval. He is only protected against the consequences of his own publication, and thus may employ workmen and obtain machinery without the risk of being betrayed. But that is all, and he has no right or privilege against any other person. If he wishes to have more, he may, under sect. 9, file a complete specifi-

(*t*) *Oxley* v. *Holden*, 8 C. B. N. S. 666; 30 L. J. C. P. 68.

cation, and then he is absolutely protected for six months, and has a right to proceed as if he had a patent for that period" (*u*).

Protection by Complete Specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

Effect of acceptance of complete specification.

See sect. 9, sub-sects. (2) and (3), 10, 13, 18; and as to infringement, sects. 17, sub-sect. (4), 28, 29, 30, 31.

It has been held under the former statutes that the filing of a complete specification does not prevent another person who had previously applied for a patent for a similar invention from obtaining a patent (*x*), and it is presumed that the decision will be the same in the event of a similar question arising under this section.

Patent.

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

Extent of patent.

See sect. 36.

Hitherto the Channel Islands have been included, but will in future be excluded.

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

Term of patent.

(*u*) *Ex p. Bates and Redgate*, L. R. 4 Ch. 577, 578.

(*x*) *Ex p. Henry*, L. R. 8 Ch. 167. See now section 13, *ante*.

(*y*) See *Russell* v. *Ledsam*, 14 M. & W. 574.

PART II. PATENTS. S. 17. Term of patent.

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

(3.) If, nevertheless, in any case, by accident mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment (*a*).

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(*a*.) The time for making any payment shall not in any case be enlarged for more than three months.

(*b*.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

(*a*) Patent Rules, 18, 46, 47.
See sect. 25, as to extension, and sect. 24, as to fees.

Foreign patents.

The Act of 1852 provided (sect. 25) that if letters patent are granted in the United Kingdom for or in respect of any invention first invented, and a patent for which is first granted in or by a *foreign country, such letters patent should ipso facto* determine with the expiration of the foreign patent. This section was construed strictly and held not only to determine the English patent with the expiration of the foreign one, but also to prevent the

Privy Council from granting in such cases any extension or renewal of the English patent (*z*).

No provision analogous to this is contained in the present statute, and it is therefore submitted that the expiration of a foreign patent will not in any manner in future affect an English patent relating to the same invention, or the right of the patentee to obtain an extension thereof—except only if and so far as by the joint effect of sects. 45 and 113, existing English patents may still remain subject to the provisions of this section (*zz*).

Amendment of Specification.

Amendment of specification.

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

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment (*β*).

(3.) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer (*γ*).

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice and being in the opinion of the law officer entitled to be

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(*z*) *Betts' Patent*, 1 Moo. P. C. C. N. S. 49; 9 Jur. N. S. 137; *Hill's Patent*, 1 Moo. P. C. C. N. S. 258; 9 Jur. N. S. 1209; *Poole's Patent*, L. R. 1 P. C. 514; *Winan's Patent*, L. R. 4 P. C. 93; *Johnson's Patent*, L. R. 4 P. C. 75; *Blake's Patent*, L. R. 4 P. C. 535.

(*zz*) See *Nordenfelt* v. *Gardner*, O. J. Rep. vol. i. 10, and cases cited under sections 45 and 113, *post*.

PART II. PATENTS. S. 18. Amendment of specification.

heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

(10.) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.

(α) Patent Rules, 48–56.
(β) Ibid. 47.
(γ) Ibid. 51.

CLERICAL AMENDMENTS.

The Master of the Rolls had an original jurisdiction as Keeper of the Rolls, to allow clerical and other similar amendments arising from mistake or inadvertence, whether occurring in the specification or in the enrolment of the patent. (*a*) Thus, where "October" was engraved for "November," and "Charles" for "George" (*b*); where the word "wire" was substituted for "fire" in the original specification, and the mistake was not discovered for five years (*c*); where numbers by which in a specification reference was made to a plan were transposed (*d*), and where "recovering" had been written for "covering" (*e*), the necessary clerical alterations were permitted.

It would appear that this jurisdiction of the Master of the Rolls still remains (*ee*).

An application to amend even clerical errors may, however, be refused as being out of time (*f*).

Power of comptroller.

By section 91 the comptroller may correct clerical errors (a) in or in connection with, any application for a patent, or (b) in the name, style, or address of a registered proprietor.

In any case, amendments of this kind and *à fortiori* amendments as to matters of real importance, if and when allowed, may be allowed only upon terms.

Enrolment.

Where a patentee was a day too late in enrolling his patent, and the mistake occurred through the fault of his clerk, it was ordered that the enrolment should be amended (*g*).

Disclaimer.

The Master of the Rolls may also, in virtue of his general jurisdiction over the Records, order a disclaimer improperly filed to be taken off the file (*h*).

Letters patent.

But the Master of the Rolls can amend only the enrolment of a patent, he cannot amend the letters patent themselves—the Lord Chancellor alone can do so (*i*), and it need scarcely be said that

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(*a*) See as to the extent of the jurisdiction of the M. R. in such matters, *Sharp's Patent*, 3 Beav. 245.

(*b*) *Rubery's Patent*, 1 Web. P. C. 649, n.; *Dismore's Patent*, 18 Beav. 538.

(*c*) *Whitehouse's Patent*, 1 Web. P. C. 649, n.

(*d*) *Redmund's Patent*, 5 Russ. 44; 1 Web. P. C. 649.

(*e*) *Nickels' Patent*, 4 Beav. 563; 1 Phill. C. C. 36; 1 Web. P. C. 650.

(*ee*) *Gare's Patent*, 26 Ch. D. 105.

(*f*) *Blamoud's Patent*, 3 L. T. N. S. 800.

(*g*) *Adam's Patent*, 21 L. T. 38. See, however, *Ex p. Beck*, 1 Br. C. C. 578.

(*h*) *Berdan's Patent*, L. R. 20 Eq. 346.

(*i*) See 1 Phill. C. C. 44–48; 1 Web. P. C. 660–63.

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this will be done only under special circumstances and as to merely clerical errors and the like.

S. 18.

MATERIAL AMENDMENTS.

Amendment of specification.

If amendments are required in matters of substance, this can only be done in the manner and to the extent expressly enacted by this section (*k*).

Who can amend.

As a "patentee" may have leave to amend, it follows that an amendment may be allowed even after grant of letters patent.

Specification.

Amendments may evidently be permitted in either the provisional or the complete specification, and they may be made either

Drawings.

in the body of the specification or in the drawings forming part of it (*l*).

Conditions.

Conditions may be imposed in allowing amendments—(a) when there is no opposition, by the comptroller (sub-section 5), or by the law officer on appeal from him (sub-section 7); and (b) in case of opposition, by the law officer (*m*).

A material amendment now may be by way of

(1.) Disclaimer,
(2.) Correction, or
(3.) Explanation.

What amendments allowed.

There is no definition or description of these terms, or any indication as to the exact extent to which, or the limits within which, amendments will be allowed, other than the provision in sub-section 8 of this section.

There can be little doubt, however, that amendments will not be

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(*k*) See *Sharp's Patent*, 3 Beav. 245.

(*l*) The provisions contained in 5 & 6 Will. 4, c. 83, s. 1, as to the nature of material alterations which will be allowed, were, that the grantee or assignee might (with the leave of the law officer mentioned) enter "a disclaimer of any part either of the title of the invention or of the specification, stating the reason for such disclaimer, or . . . . enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent."

(*m*) Under the former Statutes conditions were frequently imposed in allowing disclaimers and other amendments, e.g., not to commence or prosecute infringements in respect of prior infringements: see *Nickel's Patent, ubi supra; Medlock's Patent*, Newton's London Journal, N. S., vol. 22, p. 69; *Tranter's Patent* and *Jones' Patent*, reported in Johnson's "Patentees Manual," 4th ed. p. 182: *Smith's Patent* and *Lucas' Patent*, Macr. Pat. Cas. 232, 234.

allowed for the purpose of "bolstering up" a patent, so as to render that which previously was not a patent good and valid, or which would enlarge the scope or extent of the inventor (*n*). The alterations hitherto allowed by way of disclaimer have been the removal of portions of the specification which rendered the invention an infringement of prior patents. "It is proper that patentees should be allowed to correct errors in their patents by removing from the specifications parts which are not material or substantial, or which they have since discovered not to be new inventions" (*o*).

Amendment of specification.

And sub-section 8 expressly enacts that amendments are not to be allowed which would make the invention "substantially larger than or different from the invention" prior to amendment (*p*).

Under the statute 5 & 6 Will. 4, c. 83, it was held that the proper person to enter a disclaimer was the original grantee of the letters patent (*q*), even though he had entirely parted with his interest. It might seem that as the present section speaks only of an "applicant" and a "patentee," in future only the applicant for, or grantee of, letters patent can be the person to formally seek and have leave to amend. Sect. 46, however, gives a wide meaning to the word "patentee."

1. Disclaimer.

As to the operation and construction of a disclaimer, it has been decided—

(1.) That it has not a retrospective effect: that "from the time of the entry of the disclaimer it shall be taken to be incorporated with the letters patent and specification so as to effect all acts done after that period, but that it shall not have the effect of making parties wrongdoers by relation" (*r*).

(2.) That if a suit be pending at the time of filing a disclaimer, the plaintiff cannot avail himself of it by amending, but must commence a new action (*s*); and so, also, after a disclaimer a plaintiff cannot (usually if at all) enforce against infringers an injunction already obtained by him in an action on the original unaltered specification (*t*).

(*n*) See *per* Westbury, L.C., in *Foxwell* v. *Bostock*, 4 D. G. J. & S. 306; *Ralston* v. *Smith*, 11 H. L. C. 223.

(*o*) *Reg.* v. *Mill*, 14 Beav. 312.

(*p*) See cases in last two notes.

(*q*) *Spilsbury* v. *Clough*, 2 Q. B. 466; 1 Web. P. C. 255. Compare *Wallington* v. *Dale*, 7 Ex. 888.

(*r*) *Stocker* v. *Waller*, 9 Jur. 136; *Perry* v. *Skinner*, 2 M. & W. 471. See, however, *Reg.* v. *Mill*, 10 C. B. 379; 20 L. J. C. P. 16.

(*s*) *Lister* v. *Leather*, 3 Jur. N. S. 433. See now section 19.

(*t*) *Dudgeon* v. *Thomson*, 3 App. Cas. 34.

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Amendment of specification.

(3.) That the disclaimer, when made, becomes part of the patent and specification, so that henceforth the patentee becomes patentee of the undisclaimed part only (*u*).

(4.) "The reason for a disclaimer is no part of the disclaimer itself. The operative part of the disclaimer begins in this way, 'I for this reason wish to disclaim, and do hereby disclaim'" (*x*). It is consequently the language of the operative part of the disclaimer which must be considered, and when this is clear it is not to be controlled by the introductory sentences, if any.

(5.) That a disclaimer may be entered after verdict or judgment adverse to the validity of a patent.

2. Correction.

3. Explanation.

As to amendment by way of "correction" or "explanation," it is presumed that the general principles hitherto applicable to amendments of specifications will apply in future, namely, that a patentee will be permitted to make such, and only such, amendments as be *reasonably necessary to "correct" errors or inconsistent* statements, or to "explain" ambiguities in his specification.

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

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

Patent Rules, 56.
See sects. 17, sub-s. (4), 29 and 30.

One case has already been reported (*y y*) under this section, and it was there held (a) that the section applies to actions commenced before the Act came into operation; and (b) that the leave ought to be granted to the plaintiff to apply to amend by disclaimer only

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(*u*) *Clark* v. *Kenrick*, 12 M. & W. 219.

(*x*) *Per* Lord Westbury in *Cannington* v. *Nuttall*, L. R. 5 H. L. 205.

(*y*) See *Lister* v. *Leather*, 3 Jur. N. S. 433; *Dudgeon* v. *Thomson*, 3 App. Cas. 34.

(*y y*) *Winter* v. *Baybut, Madeley, & Co.*, O. J. Rep. vol. i. 76, which case also decided that "judge" used in this section includes the Vice-Chancellor of the County Palatine of Lancaster.

upon the terms of the plaintiff paying to the defendants the taxed costs of the action up to and including the motion for leave to apply; and (c) that proceedings in the action should be stayed pending the application to the Patent Office.

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

The provision in the latter part of this section by implication authorises the giving of damages in the cases and subject to the conditions mentioned.

Advertisement of amendment.

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

Patent Rules, 56.

Compulsory Licenses.

Power for Board to order grant of licenses.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

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

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

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

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for

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payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Patent Rules, 57–63.

Mandamus.

An application for an ordinary mandamus may be made to any branch of the High Court (*z*).

Register of Patents.

Register of patents.

23. (1.) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed (*a*).

(2.) The register of patents shall be primâ facie evidence of any matters by this Act directed or authorized to be inserted therein.

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

(*a*) Patent Rules, 64–76.
Compare 15 & 16 Vict. c. 83, sects. 35–38.

The provisions in this section differ from the corresponding provisions in the Patent Law Amendment Act, 1852, in not containing the provisions expressly contained in that Act, that until registra-

(*z*) *Re Paris Skating Rink Co.*, 6 Ch. D. 731.

tion of any assignment, the original patentee was to be deemed exclusive proprietor of the patent (*a*).

Quære, whether any entries of matters which merely affect provisional specifications will be allowed.

Sect. 85 provides that no notice of any trust expressed, implied, or constructive, shall be entered on any register, or be receivable by the comptroller.

Fees.

Fees in schedule.

24. (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct (*a*).

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

(*a*) Patent Rules, 42–45.

Extension of Term of Patent.

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

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

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

(*a*) *Chollet* v. *Hoffman*, 7 E. & B. 386; 26 L. J. Q. B. 249.

PART II. PATENTS, — S. 25. — Extension of term of patent.

(3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

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

(6.) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

(7.) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

Rules of the Judicial Committee, *post*.
See sect. 28, sub-sect. 2, as to calling of an assessor.

The previous statutory provisions as to extension were contained in 5 & 6 Will. 4, c. 83, s. 4; 2 & 3 Vict. c. 67; and 7 & 8 Vict. c. 69.

The right to have an extension of letters patent depends mainly and primarily upon the question of remuneration—"if the Judicial Committee report that the patentee has been inadequately remunerated by his patent," the term may be extended. By sub-sect. 4, however, the Committee are to take into account not only the merits of the invention, but all the circumstances of the case.

The present statute has made no alteration as regards the amount of information to be furnished to the Privy Council by applicants for extensions, or the amount of profits to be taken into account (*a a*).

REASONS FOR GRANT OF EXTENSION.

I.—*Utility.*

Invention must be useful.

The invention must be meritorious, but the ingenuity displayed by the inventor in making the discovery is not the sole, or even the most important element in determining whether or not the term of letters patent shall be extended or renewed. The benefit to the public is the first and most important factor (*b*). Consequently the skill exhibited in putting an invention into practical operation, and enabling the practical working of it to be carried on, will be considered by the Privy Council (*c*). Simplicity, also, is an ingredient for consideration (*d*).

Evidence.

The utility or otherwise of an invention must be proved by evidence in the ordinary way. But it is a presumption against the usefulness of an invention that it has become generally known but has been little used (*e*). This is a presumption against utility more or less cogent according to the circumstances, but not conclusive and capable of being rebutted by proof positive of utility, and explaining why the invention has been little used (*f*).

(*a a*) *Newton's Patents*, "Times," 9th July, 1884.

(*b*) *Re Derosne's Patent*, 4 Moo. P. C. C. 416; 2 Web. P. C. 1.

(*c*) *Betts' Patent*, 1 Moo. P. C. C. 49.

(*d*) *Muntz's Patent*, 2 Web. P. C. 113.

(*e*) See *per* Lord Chelmsford, *Bakewell's Patent*, 15 Moo. P. C. C. 385; and compare *Simister's Patent*, 4 Moo. P. C. C. 164; 1 Web. P. C. 721; *Herbert's Patent*, L. R. 1 P. C. 399; *Allan's Patent*, L. R. 1 P. C. 507; *Hughes' Patent*, 4 App. Cas. 174.

(*f*) Cases in last note.

PART II. PATENTS.

S. 25.

Extension of term of Patent.

II.—*Remuneration of the Inventor.*

Remuneration.

The main object in granting extensions is to secure that the inventor shall be properly remunerated for his own skill, trouble, and expenses. If he has been so remunerated the application will be refused—if he has not been so, then in the case of a really useful invention the rule is to grant an extension (unless, indeed, the applicant's conduct has disentitled him) for a longer or shorter term, according to the circumstances, and subject it may be to conditions and restrictions.

Amount.

It is impossible to lay down any definite rules as to what will be sufficient remuneration. Lord Brougham thus expressed himself in a judgment (*g*): "We cannot weigh in golden scales the proportion between manufacturers' profit and patentees', but we must take it in the gross; and applying our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing nor in his favour straining—we must ascertain whether he has, in the eyes of men of ordinary but enlightened understanding, judging fairly between him and the public, had a sufficient remuneration."

Everything depends upon the nature of the invention as to which an extension of the term is sought, and the circumstances of the particular application. In one case—improvements in apparatus in connection with steam-engines for condensing steam described as "of the greatest value, the testimony is unanimous on that subject"—£7000 profits was held insufficient remuneration, and therefore an extension was granted (*h*); whereas in another case £2835 was held to have been sufficient remuneration (*i*).

Accounts.

The accounts presented to the Privy Council should be full and clear, and give all information necessary for enabling a correct judgment to be formed as to what have been gross profits, and what are the various charges which the applicant proposes to set off against these.

If the accounts are not so complete and satisfactory, this may

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(*g*) *Muntz's Patent*, 2 Web. P. C. 113, 120.

(*h*) *Poole's Patent*, L. R. 1 P. C. 514. Compare the following cases where the profits made by the patentee were deemed insufficient; *Downton's Patent*, 1 Web. P. C. 565; *Perkins' Patent*, 2 Web. P. C. 6; *Carr's Patent*, L. R. 4 P. C. 539.

(*i*) *McInnes' Patent*, L. R. 2 P. C. 54.

alone "be fatal to the application" (*k*)—it is for the petitioner to present "his accounts in such a manner as to enable [the Privy Council] to pronounce that the petitioner has not received sufficient remuneration" (*l*). The Privy Council may, however, in their discretion direct or allow further and better accounts to be produced, and the application to stand over meanwhile (*m*). And they have recommended an extension, subject to a proper account duly verified, being produced to the Attorney-General (*n*).

The patentee should, indeed, from the commencement of his business or dealings, in connection with the patent, keep separate accounts relating thereto. "There can be no difficulty in a patentee beginning from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. He knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original term of his patent. It is not, therefore, too much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent" (*o*).

Profits—Deductions which may be made.

In estimating profits a patentee may make deductions in respect of the following matters:—experiments (*p*); manufacturer's profits in cases where he himself manufactures the subject of the invention (*q*); expense of litigation properly incurred (*r*); commission on sales (*s*); a reasonable allowance for his own personal skill and supervision where this is necessary (*t*), and in special cases for loss of time in bringing the invention before the public (*u*).

(*k*) *Trotman's Patent*, L. R. 1 P. C. 118, 124. Compare *Adair's Patent*, 6 App. Cas. 176, 179.

(*l*) *Clark's Patent*, L. R. 3 P. C. 421, 426.

(*m*) *Wield's Patent*, L. R. 4 P. C. 89.

(*n*) *Markwick's Patent*, 13 Moo. P. C. C. 310.

(*o*) *Per* Lord Chelmsford, in *Bett's Patent*, 1 Moo. P. C. C. N. S. 61, cited and approved in 6 App. Cas. 179.

(*p*) *Kay's Patent*, 1 Web. P. C. 568.

(*q*) *Betts' Patent*, 1 Moo. P. C. C. N. S. 49; *Hill's Patent*, 1 Moo. P. C. C. N. S. 258. These profits will, however, be taken into consideration in estimating the amount of the remuneration: *Saxby's Patent*, L. R. 3 P. C. 292.

(*r*) Cases in last two notes.

(*s*) *Perkins' Patent*, 2 Web. P. C. 6. Compare *Poole's Patent*, L. R. 1 P. C. 514.

(*t*) *Carr's Patent*, L. R. 4 P. C. 539.

(*u*) *Newton's Patent*, 14 Moo. P. C. C. 156.

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On the other hand the following matters must be brought into account as parts of the profits:—profits arising from sales for exportation (*x*); royalties and other receipts in respect of licences (*y*); advantages derived by the patentee from commanding orders as a manufacturer (*z*); profits derived from foreign patents (*z z*).

Extension of term of Patent.

It may be mentioned here that though on applications for extension the Privy Council on the one hand will not investigate the validity, or otherwise, of an invention, yet, on the other hand, if it clearly appears that the patent sought to be extended is void for want of novelty, or otherwise, the Privy Council will dismiss the application (*a*).

Validity of Patent.

III.—*Reasons special to the Applicant.*

In a sense all the reasons which the Privy Council take into consideration mainly relate to the applicant himself. "The grounds upon which their Lordships grant extensions of patents have reference to the inventor himself. They are in the first place to reward the inventor for the peculiar ability and industry he has exercised in making the discovery; in the second place to reward him because some great benefit of an unusual description has by him been conferred upon the public through the invention itself; or, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed upon the supposition that the invention is a new and useful invention" (*b*).

Applicant not the original patentee.

But in addition as the chief object in granting extensions is to secure that there shall be a sufficient remuneration for the invention of which the public gets the benefit, there is always greater favour shown—or rather there is a tendency to show greater favour—to an applicant for an extension who is himself the inventor than to one whose interest is derived by assignment from the inventor. It is fully settled that an extension may be granted to an assignee whether a private individual, or a company, or

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(*x*) *Hardy's Patent*, 6 Moo. P. C. C. 441; *Galloway's Patent*, 1 Web. P. C. 729.

(*y*) *Trotman's Patent*, L. R. 1 P. C. 118.

(*z*) *Johnson's Patent*, L. R. 4 P. C. 75, 82; *Saxby's Patent*, L. R. 3 P. C. 292.

(*z z*) *Norton's Patent*, "Times," 9th July, 1884.

(*a*) *Bats' Patent*, 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; *Hill's Patent*, 1 Moo. P. C. C. N. S. 258; *Saxby's Patent*, *ubi supra*; *McDougal's Patent*, L. R. 2 P. C. 1.

(*b*) *Norton's Patent*, 1 Moo. P. C. N. S. 339, 343; 9 Jur. N. S. 419.

trustees for a third party (c). "But it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use" (*d*).

Conditions imposed.

Consequently, where the original inventor, or, if dead, his personal representative, is not the applicant, or joined as applicant, the Privy Council may refuse an extension in a case where, if the original inventor had been joined, it would have granted it (*e*), or their Lordships may, and frequently do, impose terms in recommending an extension to secure some of the benefits thereof by way of annuity or otherwise to the original inventor (*f*), or to his personal representative if he should be dead (*g*).

Terms have been so imposed on an applicant who had been partner with the inventor, but the partnership was dissolved and the invention vested in the applicant (*h*).

But such terms are not imposed as of course—if the original inventor has been sufficiently remunerated, whereas the applicant has by his exertions and expense in bringing the invention before the public entitled himself to an extension, and has not himself been properly remunerated, the extension may be made to him unconditionally (*i*).

PERSONS TO APPLY FOR GRANT OF EXTENSION.

Legal owner of patent.

The proper person to apply for an extension and to receive the new letters patent is the person in whom the subsisting patent is legally vested (*k*).

(*c*) *Pettit Smith's Patent*, 7 Moo. P. C. C. 133; *Napier's Patent*, 13 Moo. P. C. C. 543.

(*d*) *Per* Romilly, M.R., *Norton's Patent*, 1 Moo. P. C. C. N. S. 344. Compare *Morgan's Patent*, 1 Web. P. C. 737; *Pitman's Patent*, L. R. 4 P. C. 84; *Normand's Patent*, L. R. 3 P. C. 193.

(*e*) See *Norton's Patent*, *ubi supra*.

(*f*) *Whitehouse's Patent*, 1 Web. P. C. 473; *Russell* v. *Ledsam*, 1 H. L. C. 687, 698; *Markwick's Patent*, 13 Moo. P. C. 310; *Russell's Patent*, 2 Moo. 4 P. C. C. 496.

(*g*) *Herbert's Patent*, L. R. 1 P. C. 399.

(*h*) *Normandy's Patent*, 9 Moo. P. C. 452.

(*i*) *Normandy's Patent*, 9 Moo. P. C. 452.

(*k*) *Pettit Smith's Patent*, 7 Moo.

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An importer-patentee may apply for an extension, though the Privy Council will scan carefully the merits both of the invention and of the application (*l*).

To whom extensions granted.

Extensions have been granted to the following persons, in addition to the original patentee and persons taking directly from him, namely:—

The administratrix of the patentee (*m*).

The agent and trustee for a foreign inventor (*n*).

The trustees of a joint stock company to whom the invention had been assigned (*o*).

The executor of a surviving assignee (*p*).

The assignees of the personal representatives of an assignee of the patent (*q*).

CONDITIONS IN GRANT OF EXTENSION.

Conditions imposed in favour of—

The Privy Council in recommending the grant of an extended term of letters patent frequently imposes conditions on the applicant. The conditions which are so imposed are of four main classes:—

(*a*) the inventor,

(a) *Conditions in favour or for the benefit of the inventor*, which have been already considered.

(*b*) the public,

(b) *Conditions in the interest of the public.*—Thus an extension has been granted upon terms that the patented article shall be sold to the public at a certain fixed price (*r*), or that licenses should be granted to the public upon terms similar to a license already granted (*s*). And where the patentee had by deed granted to a company an exclusive license to use the invention, and covenanted to obtain a renewal of the patent for the same purpose, an application by him for an extension was refused (*t*).

(*c*) the Crown.

(c) *Conditions in the interest of the Crown.*—The Privy Council frequently imposes as the condition of an extension that the Crown

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P. C. C. 133; *Southcorth's Patent*, 1 Web. P. C. 486. See now sect. 46 of the Act.

(*l*) *Berry's Patent*, 7 Moo. P. C. 187; *Claridge's Patent*, 7 Moo. P. C. 394. Compare *Schlumberger's Patent*, 9 Moo. P. C. 1; *Johnson's Patent*, L. R. 4 P. C. 75.

(*m*) *Heath's Patent*, 8 Moo. P. C. C. 217; 2 Web. P. C. 247.

(*n*) *Newton's Patent*, 14 Moo. P. C. C. 156.

(*o*) *Pettit Smith's Patent*, *ubi supra*.

(*p*) *Bodmer's Patent*, 6 Moo. P. C. C. 468.

(*q*) *Poole's Patent*, L. R. 1 P. C. 514.

(*r*) *Hardy's Patent*, 6 Moo. P. C. 441.

(*s*) *Mallet's Patent*, L. R. 1 P. C. 308.

(*t*) *Cardwell's Patent*, 10 Moo. P. C. C. 488.

or State represented by the various public departments, more particularly the War Office or the Admiralty, and their servants and persons contracting with them, shall have the right to use the invention on favourable terms, and perhaps without making any payment (*u*), and it seems that such a condition "has become now a usual one in cases of inventions which are likely to be required for use by the Government" (*u u*).

It is presumed that this power still remains, though by sect. 27 patents now bind the Crown.

(d) *Other persons.*—It seems clear that in addition to the above the Privy Council had authority under the Act of 1852 in proper cases to impose conditions in granting an extended term for the benefit of persons other than those comprised in the above classes (*x*), and it is submitted that by virtue of the express provisions of sect. 25 sub-sect. 5 of the present statute, such conditions *may now be imposed.*

(d) Other persons.

GENERAL.

The Privy Council had no jurisdiction under the Act of 1852, and it is very doubtful whether they have any jurisdiction now to impose any terms on, or make any recommendation to the Crown with respect to any extended grant of letters patent, except the fact whether or not there shall be any extension, and if so, the length of it (*y*).

An extension may be granted as to, and in proper cases will be restricted to, a part only of the patent (*z*).

It seems that there is no jurisdiction to grant a second extension (*a*).

PRACTICE BEFORE THE PRIVY COUNCIL (*b*).

The application must be by petition. This should set out fully and explicitly the whole of the circumstances in any way material

Petition

(*u*) *Pettit Smith's Patent*, 7 Moo. P. C. C. 133; *Lancaster's Patent*, 2 Moo. P. C. C. N. S. 189; *Hughes' Patent*, 4 App. Cas. 174.

(*u u*) *Napier's Patent*, 6 App. Cas. 174. But in *Re Lancaster's Patent* (*ubi supra*) the Privy Council refused to insert a condition *in favour of the Crown.*

(*x*) E.g. apprentices of the patentee, see *Baxter's Patent*, 13 Jur. 593.

(*y*) *Russell* v. *Ledsam*, 1 H. L. C. 687, 699.

(*z*) *Napier's Patent*, 6 App. Cas. 174.

(*a*) *Goucher's Patent*, 2 Moo. P. C. N. S. 532.

(*b*) See generally as to this the Rules of the Judicial Committee, *post.*

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to the application. In case of any omission to do so the petition may on such ground alone be dismissed (*c*).

The title of the petitioner must be strictly proved, even though admitted by the opponents (*d*).

A petition may, under special circumstances, be allowed to be amended (*e*).

Extension of term of patent.

It is not required that persons opposing should have any interest in relation to the patent.

Title.

Amendment.

Caveat.

Every person opposing should enter a caveat even in case of a Government department desiring to object (*f*), which caveat should be entered in the name of the opposing party (*g*).

Costs.

The general rules as to costs are—(1) that the costs of a successful opposition will be allowed (*h*) unless there has been some impropriety in the manner in which the opposition has been conducted (*i*); (2) that opponents having no ground for their opposition will be ordered to pay the extra costs (and only those) occasioned by their opposition (*k*); (3) that when a petition is abandoned the petitioner will usually (*l*), though not invariably (*m*), be ordered to pay the costs of the opposition.

Sometimes when there are several opponents a lump sum for costs has been ordered to be paid for division amongst them all (*n*).

Revocation.

Revocation of patent.

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

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

(3.) Every ground on which a patent might, at the

(*c*) *Pitman's Patent*, L. R. 4 P. C. 84; *Adair's Patent*, 6 App. Cas. 178.

(*d*) *Galloway's Patent*, 1 Web. P. C. 725.

(*e*) See *Hutchison's Patent*, 14 Moo. P. C. 364.

(*f*) See *Pettit Smith's Patent*, 7 Moo. P. C. 133.

(*g*) *Lowe's Patent*, 8 Moo. P. C. 1.

(*h*) *Wield's Patent*, L. R. 4 P. C. 89.

(*i*) *Hoskiall's Patent*, 9 Moo. P. C. 378, 394.

(*k*) *Downton's Patent*, 1 Web. P. C. 567.

(*l*) *Bridson's Patent*, 7 Moo. P. C. 499; *Hornby's Patent*, ib. 503.

(*m*) *Milner's Patent*, 9 Moo. P. C. 39.

(*n*) *Johnson's Patent*, L. R. 4 P. C. 75; *Wield's Patent*, ib. 89.

commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

S. 26.

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

Revocation of patent.

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

(*b.*) Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(*c.*) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims:

(*d.*) Any person alleging that he or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

(*e.*) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7.) The defendant shall be entitled to begin, and give

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evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.

Revocation of patent.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Sects. 44, sub-sects. 3 and 9, 109, 111, 117.

SCIRE FACIAS.

Fiat of the Attorney-General.

Proceedings hitherto for the repeal of letters patent have been by *scire facias*, which was a proceeding in form (as regards letters patent) at the suit of the sovereign, but in reality at the instance of a private prosecutor, who obtained the fiat of the Attorney-General sanctioning the procedure.

It was established that the Courts had no jurisdiction over the Attorney-General (except perhaps when the proceeding might be purely vexatious) either to direct him to refuse his fiat or to control his discretion by entering, or directing him to enter a *nolle prosequi* (*o*). It would seem that the fiat of the Attorney-General is not granted as of course (*p*).

Persons entitled to apply for revocation.

It will be observed that the present statute enables certain persons *proprio motu* to apply for revocation of letters patent—a person defrauded by the grant of the patent, a person claiming to be the true inventor, a person alleging to have sold, &c., prior to the date of the patent anything claimed by it.

The circumstances under which proceedings may be instituted by *scire facias* to repeal letters patent (*q*) are thus stated in Bacon's Abridgment, vol. ix. p. 137:—

(*o*) *R.* v. *Prosser*, 11 Beav. 306. Compare *R.* v. *Neilson*, 1 Web. P. C. 671, 672.

(*p*) Compare *R.* v. *Neilson*, 1 Web. P. C. 671, 672.

(*q*) Which of course means any letters patent, e.g. charters, and not merely letters patent for inventions.

"The writ of *scire facias* to repeal letters patent lieth in three cases: 1st, When the King by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the first patentee shall have a *scire facias* to repeal the second; Secondly, When the King doth grant a thing upon a false suggestion, he *prærogativa regis* may by *scire facias* repeal his own grant: Thirdly, When the King doth grant anything which by law he cannot grant, he, *jure regis*, and for the advancement of justice and right, may have a *scire facias* to repeal his own letters patent; and the judgment in all these cases is, '*Quod prædictæ patentes dicti domini regis revocentur, &c.*'

Revocation of patent.

Grounds of scire facias.

"Where a patent is granted to the prejudice of the subject, the King, of right, is to permit him upon his petition to use his name for the repeal of it in *scire facias* at the King's suit; and to prevent multiplicity of actions: for such actions will lie, notwithstanding such void patent: as, where the King grants a patent for holding a fair or a market without a writ *ad quod damnum*, or where such writ hath been deceitfully executed, in such case a *scire facias* lies to repeal the patent."

Of the three grounds above mentioned for proceedings by *scire facias*, the second, "false suggestion," is the most obscure. If an untrue statement or "suggestion" is made in letters patent either (a) in the recitals setting forth the reason of the grant, or (b) in that which is expressed as the consideration for the grant, this is a "false suggestion" (*r*). Whether other matters than these are properly to be included under the expression "false suggestion" is doubtful, but apparently not.

"False suggestion."

It is clear, however, that letters patent may be invalid for other reasons than those just mentioned. It therefore follows that if "false suggestion" is limited to the two (a) and (b) classes of matters above stated, it is possible that a person may have a defence to an action for infringement of an alleged patent who nevertheless may be unable to institute proceedings for revocation.

Grounds of invalidity of letters patent.

As to this, however, it will be observed (a) that the section in consideration does not (sub-sect. 3) limit the grounds of revocation upon petition under this Act, to those grounds for which a writ of *scire facias* lay; and (b) that by clauses *c* and *d* of sub-sect. 4, the persons therein mentioned may, under the circum-

(*r*) See *Morgan* v. *Seaward*, 2 M. & W. 544, 561; 1 Web. P. C. 187, 196; *R.* v. *Wheeler*, 2 B. & Ald. 345.

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Revocation of patent.

stances therein stated, petition, and therefore, it would seem, may obtain judgment on establishing their case, for revocation.

As to what will and what will not come within the meaning of the expression "false suggestion," a learned author thus expresses himself (*s*): "The distinction pointed out by the learned judge between the case of a false recital in the letters patent, and a false statement not recited in the patent by way of suggestion, as an error in the specification, is of the greatest importance. It would appear that a distinction is to be drawn between such an error in the specification as will render a suggestion in the letters patent false, and such an error, in a matter of direction or otherwise, as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility. Other defects in a specification, as insufficiency of description, vitiate by reason of non-compliance with the proviso in the letters patent.

"The two classes of defects above specified may be distinguished, 1st, as false suggestion; 2nd, as insufficient description; the former may be considered as on the record and for the Court, the latter for the jury."

Particulars of objections.

The section expressly provides that particulars of objections must be delivered with the petition (*t*).

Staying proceedings.

It is submitted that the Court has jurisdiction in a proper case to stay proceedings in an action for infringement, pending a petition for revocation (*u*).

Costs.

As to costs, it is submitted that in every case these should, in the absence of special circumstances, "follow the event" (*x*).

Crown.

Patent to bind Crown.

27. (1.) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject.

(*s*) 1 Web. P. C. 42.

(*t*) Where the prosecutor on a writ of *scire facias* filed a notice of objections, stating that certain persons not named had used the invention in England before the grant of the patent, the Court refused to order particulars of the names and addresses of such persons, *R.* v. *Walton*, 2 Q. B. 969. As to "particulars," see the notes to sect. 29, *post*.

(*u*) The Court upon terms postponed the trial of a case for a definite period, to await the result of a pending motion in proceedings by *scire facias* to repeal the patent. *Smith* v. *Upton*, 6 Scott, N. R. 804.

(*x*) Pending a proceeding in *scire facias* to repeal a patent, the

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between these officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Patent to bind Crown.

Prior to this Act it was held that the Crown might use a patented invention without the assent or remuneration of the patentee (*y*). But this right did not extend to contractors supplying the patented article to the Crown, even though they were indemnified by the Crown (*z*).

Legal Proceedings.

28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

Hearing with assessor.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor

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patentee disclaimed a part. The prosecutor still proceeded, and ultimately failed. It was held that he ought to pay the costs subsequent to the disclaimer: *R.* v. *Mill*, 14 Beav. 312.

(*y*) *Feather* v. *The Queen*, 6 B. & S. 257; 35 L. J. Q. B. 200.

(*z*) So decided in the House of Lords, reversing the Court of Appeal: *Dixon* v. *London Small Arms Co.*, 1 App. Cas. 632.

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under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

MODE OF TRIAL.

Jury.

In *Sugg v. Silber* (*a*) it was held that a defendant in a patent, as in any other action in the Queen's Bench Division, could, by giving notice under the Judicature Rules, insist on a trial before a judge and jury, and that there was no power to direct a trial contrary to the wish of either party before a judge and assessors.

Patent actions could, before the Judicature Acts, have been brought and decided in the Court of Chancery, and, of course, in such case they were heard by a judge alone without a jury, and this power has been reserved to the Chancery Division by the Judicature Acts and the Orders made thereunder (*b*).

Not only has the Court now in every patent action a discretion as to allowing a trial with a jury, but "the action shall be tried without a jury unless the Court shall otherwise direct."

It is submitted that, as a general rule, patent actions are more fit to be tried without than with a jury (*c*); and though the same reasoning does not necessarily apply to trials of specific issues of fact, it is submitted that except under special circumstances of convenience and the like, the whole of the issues should be tried at one and the same trial (*d*).

Referees.

The Judicature Acts and the Rules contain provisions for referring matters arising in an action to referees, official or special, and either for trial of questions, and that such referees may inquire and report to the Court (*e*). Under these provisions a person has been appointed to make experiments for the purpose of informing the Court (*f*).

(*a*) 1 Q. B. D. 362.

(*b*) See Supreme Court Rules, 1883, Order 36, r. 4.

(*c*) See *per* Lord Cairns, L.C., in *Bovill* v. *Hitchcock*, L. R. 3 Ch. 417; *per* Selborne, L.C. (sitting for the M.R.), in *Patent Marine Inventions Co.* v. *Chadburn*, L. R. 16 Eq. 447; and *per* Cockburn, L.C.J., *Sugg* v. *Silber*, 1 Q. B. D. 362.

(*d*) See *Roskell* v. *Whitworth*, L. R. 5 Ch. 459; *Young* v. *Fernie*, 1 D. G. J. & S. 353.

(*e*) See J. A. 1873, ss. 56, 57; Order 34, r. 2.

(*f*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 157.

29. (1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence, or by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

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

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant (*ff*); and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to

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(*ff*) See *Young* v. *Rosenthal & Co.*, O. J. vol. i. p. 29, as to costs where the plaintiff proved his particulars of breaches, but failed to obtain judgment on the ground of want of novelty. See also *Needham* v. *Johnson & Co.*, O. J. Rep. vol. i. p. 50, and *Nordenfelt* v. *Gardner*, O. J. Rep. vol. i. p. 61, as to costs where in each case a defence of want of novelty was set up but not proved, but it was held that the respective defendants had not infringed, and were, therefore, entitled to the general costs of the action.

PART II. PATENTS. S. 29.

have been proven or to have been reasonable and proper, without regard to the general costs of the case.

ACTION FOR INFRINGEMENT.

I.—*Parties.*

Plaintiff.—The original patentee and any person claiming from or under him as assignee of the whole interest in the letters patent may be plaintiff.

Assignee. An assignee may sue to restrain infringement, although at the time of the institution of the action the assignment to him has not been registered, and in such case it would seem that the subsequent registration of the assignment relates back to the date thereof (*g*).

Where there are two assignees and one dies, an action for an infringement during his lifetime descends on the survivor (*h*).

The assignee of a separate and distinct portion of an invention may sue for an infringement of the rights relating to such portion alone, without joining the persons interested in the residue of the invention (*i*).

Co-owners. Probably any co-owner or person interested in an indvisible patent may by himself sue to restrain infringements without joining the other co-owners. But if such person desires to obtain an account from wrongdoers he must usually, if not invariably, make all the co-owners parties (*k*).

Agents. A person employed as general agent of patentees resident abroad and having the sole agency and control of the working of the patent in England, and entitled to a share of the royalties and profits cannot institute an action in the ordinary form in respect of and to restrain infringement (*l*).

Licensee. A mere (non-exclusive) licensee cannot sue for an infringement. But it has been held that an exclusive licensee is entitled to use the name of the patentee in an action for infringement (*m*), and also to sue in his own name in respect of infringements (*n*).

(*g*) *Hassall* v. *Wright*, L. R. 10 Eq. 509.

(*h*) *Smith* v. *London and North-Western Ry. Co.*, 2 E. & B. 69.

(*i*) *Dunnicliff* v. *Mallet*, 29 L. J. C. P. 70; 7 C. B. N. S. 209; *Walton* v. *Lavater*, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

(*k*) *Bergmann* v. *Macmillan*, 17 Ch. D. 423.

(*l*) *Adams* v. *North British Ry. Co.*, 29 L. T. 297.

(*m*) *Renard* v. *Levinstein*, 2 H. & M. 628.

(*n*) *Hassall* v. *Wright*, *ubi supra*.

Defendant.—Every person who in any manner is party to or conduces directly or indirectly to an infringement, or is responsible for the persons causing an infringement, is liable for and may be sued in respect of such infringement. Consequently persons concerned in infringements as the servants, workmen, or agents of others directing the acts which are infringements are themselves as much liable as their principals.

Action for infringement.

Agents, servants, &c.

The decision in *Adair* v. *Young* (*o*) aptly shews the extent of the liability of persons parties to infringements. The facts were as follows:—The action was brought against the master of a ship to restrain him from using pumps which were an infringement of the plaintiff's letters patent; he denied having used any pumps which were an infringement of the patent; it was shewn that the ship was fitted up exclusively with pumps which were an infringement of the letters patent, but had been so fitted up before the defendant (who was not a part owner) had taken command of her; he had nothing to do with putting them on board, and they had never been worked in British waters: it was held by a majority of the Court of Appeal (Brett and Cotton, L.JJ., dissentiente James, L.J.), affirming Bacon, V.C., that an injunction was rightly granted to restrain the master from using the invention on the ground that the defendant, being in command of a ship exclusively fitted up with pumps which were an infringement of the letters patent, was intending to use the patented invention.

Master of ship.

Person supplying materials.

In *Sykes* v. *Howarth* (*p*) the facts were these:—A patent consisted of the application of cards or strips of leather covered with wire to rollers at "wide distances." The defendant was a person who contracted to clothe rollers, and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer. He was held to have infringed the patent, though he alleged that his business was that of a card-maker only, and did not include the nailer's work; but it was suggested that the decision would have been the other way if he had merely supplied the cards without making the nailer his agent.

Any user is an infringement.

In short, whatever constitutes an "exercise," a "putting in operation," or a "user," however slight, of a patented invention, or a "vending" of articles made in accordance therewith, will, if unauthorized, be an infringement, and the persons responsible for such

(*o*) 12 Ch. D. C. A. 13.

(*p*) 12 Ch. D. 826; see *Briggs & Co.* v. *Lardeur*, O. J. vol. i. p. 126; and *United Telephone Co.* v. *Dale*, 25 Ch. D. 778.

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proceedings, whether acting on their account or not, will be liable to an action (*q*).

There must, however, be some actual participation by the defendant himself, or by persons for whose acts he is responsible, to constitute him an infringer, and liable as being such.

Action for infringement.

Custom House agents.

Thus in *Nobel's Explosives Company* v. *Jones, Scott & Co.* (*r*), the House of Lords held that the defendants, who had acted merely as Custom House agents in getting goods (admitted to be infringements of the plaintiff's patent) landed and stored in this country, had not committed, and were not liable as for, an infringement.

So in *Townsend* v. *Howarth* (*s*) it was held that a person who sold the component articles which entered into a patented invention with the knowledge that they were to be used for the purpose for which the patent was obtained, could not be sued as an infringer of the patent, although he sold the articles with an indemnity from all consequences in reference to the patent.

Employers.

Persons having the control of other parties, such as workmen or servants, will be liable for infringements committed by the latter in the course of their employment, even though contrary to express

Directors.

directions given to them. Thus directors of a company have been held so liable for infringements committed by their company's workmen in violation of orders issued to them (*t*).

Intention to Infringe.

Intention.

Absence of an intention to infringe is no defence to an action in case of infringement. But where the defendant was a retail dealer who unwittingly sold articles which were an infringement of the plaintiff's patent, James, V.C., held that he was not liable for the costs of an action to restrain the infringement if he at once gave full information as to the persons from whom he obtained the articles complained of, and promised not to retail any more (*u*).

(*q*) *Caldwell* v. *Van Vlissengen*, 21 L. J. Ch. 97; *Betts* v. *Neilson*, L. R. 3 Ch. 429; *Elmslie* v. *Boursier*, L. R. 9 Eq. 217; *Von Heyden* v. *Neustadt*, 14 Ch. D. 230; *United Telephone Co.* v. *London and Globe Telephone Co.*, O. J. Rep. vol. i. p. 117. Compare *Betts* v. *Willmott*, L. R. 6 Ch. 239; *Société Anonyme des Mfs de Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 Ch. D. C. A. 1.

(*r*) 8 App. Cas. 5. Compare *Upmann* v. *Elkan*, L. R. 7 Ch. 130; *Moet* v. *Pickering*, 8 Ch. D. C. A. 372.

(*s*) 12 Ch. D. C. A. 831, n. See *United Telephone Co.* v. *Dale*, 25 Ch. D. 778; *Same* v. *London and Globe Telephone Co.*, 32 W. R. 870.

(*t*) *Betts* v. *De Vitre*, L. R. 3 Ch. 441.

(*u*) *Betts* v. *Wilmott*, 18 W. R. 946; *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

And in *Upmann* v. *Elkan* (*x*), Hatherley, L.C., adopting the same principle, held that forwarding agents and warehousemen who had received boxes of cigars bearing forged brands, but were unaware of the forgery and gave all information in their power immediately on being informed thereof, were not liable to the costs of an action brought to restrain the sale of such cigars.

Action for infringement.

In *Cooper* v. *Whittingham* (*y*), which was a case of infringement of copyright, the late Master of the Rolls, however, laid down broadly "that where a plaintiff comes to enforce a legal right and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of his costs—the Court has no discretion, and cannot take away the plaintiff's right to costs," and he therefore ordered the defendants, who were agents and were willing to give an undertaking in any terms which the plaintiffs desired, to pay the costs of the action.

There is also a subsequent express decision to the same effect as the case last cited, *Upmann* v. *Forester* (*z*). Here the defendant, who was a china manufacturer, purchased abroad for his own private use a large number of cigars which were consigned to him at the docks here in cases bearing a spurious brand, purporting to be that of the plaintiffs, who were cigar manufacturers. He was not aware that the brand was spurious, nor, except from seeing it on the invoice, that any such brand was in use. Immediately upon the plaintiffs issuing their writ and serving the defendant with notice of motion for an injunction to restrain him from selling the cigars, he stated that he had no intention of selling the cigars, and offered all the relief asked for by the writ, and afterwards at the motion agreed to an undertaking in the terms of the writ, the question of costs being reserved. Chitty, J., nevertheless held that the defendant must pay all the costs of the action.

Assignments.

In the case of assignments of patents, the assignor and subsequent licensees from him will be restrained from afterwards working or using the invention (*a*); and as to prior licensees from him the rule seems (in the absence of any express reservation in the assignment of their rights) to be this—that if the assignee took the assignment with notice of, he takes it subject to, their licenses, and therefore cannot restrain them, but that if he had no such notice he is entitled to restrain them.

(*x*) L. R. 7 Ch. 130.
(*y*) 15 Ch. D. 501.
(*z*) 24 Ch. D. 231.

(*a*) *Hassall* v. *Wright*, L. R. 10 Eq. 509, which, however, was the case of an exclusive license.

PART II. PATENTS.

II.—*Pleadings.*

S. 29. Action for infringement. Rules as to pleading.

The general rules with respect to pleadings apply equally to actions for infringement and patents as to other actions. The parties, the plaintiff in his statement of claim, and the defendant in his defence, must respectively state their cases and set forth or at least indicate shortly the main allegations of fact intended to be relied upon at the trial. As regards the defence it is generally the wiser plan to plead the whole of the pleas as to which there is any probability at the hearing of giving evidence. If necessary for the avoidance of expense the issues can prior to trial by notice be restricted (*b*).

Particulars.

The most important matters in connection with pleadings in patent actions are the particulars which have to be furnished—*of breaches* by the plaintiff with his statement of claim, and *of objections* by the defendant with his defence. They may respectively be delivered by order at subsequent times, but if only on the score of costs it is advisable to deliver them with the claim or the defence as the case may be.

Requisites of particulars.

With regard to the matters to be specified by particulars, it will be observed that the statute does not enact what is to be particularized, except as regards invalidity from want of novelty or otherwise.

The plaintiff's particulars are to be "of the breaches complained of."

The defendant's particulars must be "of any objections on which he relies." And (a) if he disputes the validity of the patent he "must state on what grounds he disputes it," and (b) "if one of those grounds is want of novelty he must state the time and place of the previous publication or user alleged."

What is requisite to be set forth in particulars is consequently—with the exceptions above indicated—to be determined only by reference to judicial decisions (*c*).

Breaches.

Particulars of breaches.—These will be sufficient if, taken with

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(*b*) See *Borill* v. *Goodier* (No. 2), L. R. 2 Eq. 195; *Morgan* v. *Fuller* (1), L. R. 2 Eq. 296.

(*c*) It seems that, apart from statutes, the Court has in patent, as in other actions, a general power to order particulars whenever necessary. See *Perry* v. *Mitchell*, 1 Web. P. C. 269; *Electric Telegraph Co.* v. *Nott*, 4 C. B. 462; *Wren* v. *Weild*, L. R. 4 Q. B. 213.

the pleadings, they give the defendant full and fair notice of the case alleged against him (*d*).

A plaintiff, as a rule, will not be ordered to specify the particular passages and lines of the specification which are alleged to have been infringed (*e*).

Requisites of particulars.

But such particulars may be ordered if the invention is a complicated one, or the defendant on other sufficient grounds requires the information for the preparation of his defence (*f*).

Specifications.

Where the patent is in respect of numerous improvements the plaintiff must specify which of the improvements have been infringed (*g*).

Improvements.

Identifying specific objects.

In various cases (*h*) it has been held sufficient for the plaintiff to identify as an exhibit to an affidavit a specific object as being, by user or manufacture, the infringement upon which he relies; but it is submitted that he ought to give details in all cases of complicated inventions (*i*).

Dates, Names, and Addresses.

It would seem now settled that the dates of the various occasions when the infringements took place, and the names and addresses of the persons (if any) concerned therein as buyers, &c., should be stated (*k*).

Objections.

Particulars of objections.—The general principles as to particulars of breaches apply equally to particulars of objections, but it would seem that the latter are construed somewhat more stringently than the former, and that consequently the defendant is compellable to give more explicit information on various points than is the plaintiff, and is also limited rather more strictly than the plaintiff to the case set up by him in his pleadings and accompanying objections.

Novelty.

Objections on the ground of want of novelty must specify not only the "time and place" as required by the section, but also

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(*d*) *Needham* v. *Oxley*, 1 H. & M. 248.

(*e*) *Electric Telegraph Co.* v. *Nott*, 4 C. B. 462; *Talbot* v. *La Roche*, 15 C. B. 310; *Batley* v. *Kynock* (No. 2), L. R. 19 Eq. 229; and compare *Needham* v. *Oxley*, *ubi supra*.

(*f*) See *Lamb* v. *Nottingham Manufacturing Co.*, cited L. R. 19 Eq. 230, and *Wren* v. *Weild*, L. R. 4 Q. B. 213.

(*g*) *Perry* v. *Mitchell*, 1 Web. P. C. 269.

(*h*) *Needham* v. *Oxley*, *Batley* v. *Kynock*, and *Perry* v. *Mitchell*, *ubi supra*.

(*i*) See cases in note (*f*); and *Jones* v. *Lee*, 25 L. J. Ex. 241.

(*k*) See *Murray* v. *Clayton*, L. R. 15 Eq. 115; *Crossley* v. *Tomey*, 2 Ch. D. 533; *Sykes* v. *Howarth*, 12 Ch. D. 826. Compare *Flower* v. *Lloyd*, 45 L. J. Ch. 746; 25 W. R. 17.

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whether the defendant objects to the patent generally as not new, or to a part only, and if so what part (*l*).

Requisites of particulars.

With regard to this objection, *i.e.* want of novelty, the Court of Appeal has decided that inasmuch as the legislature has specially enacted what such particulars are to be set forth—viz., the time and place—no further or more minute particulars can be ordered (*m*).

Name of Inventor.

When the objection is that the plaintiff is not the first and true inventor the practice now is to require that the name of such inventor should be given (*n*).

Specifications.

The practice is now settled, at least in all cases other than those of the simplest and shortest specifications, to require the defendant to state the particular parts of the plaintiff's specification which he says have been previously anticipated, whether by prior specifications or by books, and in the case of books to state the pages (*o*) considered to be anticipatory.

As regards prior specifications an order has been made on various occasions (and it is submitted that such order is all that the plaintiff can be entitled to), that the defendant state in his particulars as to each of the previous specifications mentioned by him which of the plaintiff's claims is covered or referred to or anticipated by such specification.

Language of specifications.

Considerable latitude will be allowed as to the generality of particulars of objections when the objections are as to the language of the specification or the nature of the invention, *e.g.* that the specification does not sufficiently describe the nature of the invention (*p*) or distinguish between what is new and what is old (*q*), or that it is calculated to deceive (*r*).

Prior user.

Where the objection is prior user, it seems to be settled that the names and addresses of the persons alleged to have previously used the invention, and the circumstances of the occasions of such user sufficient to enable the plaintiff to make the necessary enquiries to verify or rebut the same, must be given (*s*).

(*l*) *Heath* v. *Unwin*, 10 M. & W. 859.

(*m*) *Flower* v. *Lloyd*, 45 L. J. Ch. 746; *Plimpton* v. *Spiller*, 20 Sol. J. 859.

(*n*) See however, *contra*, *Russell* v. *Ledsam*, 11 M. & W. 647.

(*o*) *Plimpton* v. *Spiller*, 20 Sol. J. 684; *Russell* v. *Ledsam*, 11 M. & W. 647.

(*p*) *Jones* v. *Berger*, 5 M. & G. 208; 1 Web. P. C. 544, 546; *Heath* v. *Unwin*, 1 Web. P. C. 551, n.

(*q*) *Ibid.*

(*r*) *Neilson* v. *Harford*, 1 Web. P. C. 295, 324, n.

(*s*) *Galloway* v. *Bleaden* and *Carpenter* v. *Walker*, 1 Web. P. C.

General Requirements.

Requisites of particulars.

Particulars whether of breaches or objections must be definite and precise, and therefore such expressions as "elsewhere" (*t*), "among others" (*u*), are objectionable, and have in various cases been struck out (*x*), though there are instances where they have been allowed to remain (*y*).

Particulars must be precise.

If the allegation is that of general prior user this may be so stated, *e.g.* "by candlemakers generally in London and the vicinity" (*z*).

But even allegations of general prior user must not be expressed in language too general or vague (*a*).

If particulars are delivered which are objectionable on the ground of vagueness or generality the opposite party may by section 29, sub-section 5, obtain an order directing them to be amended (*b*).

But if this be not done it will be too late to object at the trial to the objections (*c*)—though of course the Court would have power upon terms to adjourn the hearing to enable the plaintiff properly to meet the case proposed to be set up.

Amendments.

The above section contains a specific provision for the amendment of particulars (*d*).

Under the former statute amendments, and even re-amendments (*e*) were allowed when reasonable cause was shown.

268, n.; *Palmer* v. *Cooper*, 9 Ex. 231; *Flower* v. *Lloyd* (C.A.), 45 L. J. Ch. 746; 25 W. R. 17.

(*t*) *Holland* v. *Fox*, 1 W. R. 448; *Jones* v. *Berger*, 1 Web. P. C. 544, 549; *Patent Type Founding Co.* v. *Richards*, 2 L. T. N. S. 359.

(*u*) *Flower* v. *Lloyd*, 20 Sol. J. 860; *Birch* v. *Mather*, 22 Ch. D. 629.

(*x*) See *Galloway* v. *Bleaden*, 1 Web. P. C. 268, n.; *Fisher* v. *Dewick*, 1 Web. P. C. 551, n.; *Hull* v. *Bollard*, 1 H. & N. 134; 25 L. J. Ex. 304; *Flower* v. *Lloyd*, *ubi supra*.

(*y*) *Curtis* v. *Platt*, 8 L. T. N. S. 657; *Penn* v. *Bibby*, L. R. 1 Eq. 548. See also *Tilghman's Patent Sand Blast Co.* v. *Wright*, O. J. Rep. vol. i. p. 103.

(*z*) *Palmer* v. *Wagstaffe*, 8 Ex. 840; *Jones* v. *Berger*, 1 Web. P. C. 544, 549.

(*a*) *Morgan* v. *Fuller* (No. 2), L. R. 2 Eq. 297.

(*b*) See cases in previous notes; and *Hull* v. *Bollard*, 1 H. & N. 134; 25 L. J. Ex. 304.

(*c*) See last note and *Neilson* v. *Harford*, 8 M. & W. 806; *Sykes* v. *Howarth*, 12 Ch. D. 826.

(*d*) *Quære*, whether it is necessary that, to entitle a party to leave to amend, the new particulars or new issues should be such as he could not with due diligence have discovered earlier? See *Wilson* v. *Gann*, 23 W. R. 546; *Holste* v. *Robertson*, 4 Ch. D. 9.

(*e*) See *Penn* v. *Bibby*, *ubi supra*.

PART II. PATENTS. S. 29. Requisites of particulars. Amendments. Costs.

The costs of amendments are usually made those of the opposite party in any event, and the incidental costs arising therefrom are also often, and if after issue joined are almost invariably, given to the opposite party (*f*).

The rule is thus laid down as to amendments at a late stage of the action—"In granting the defendant in a patent action after issue joined and a day fixed for the hearing leave to amend his particulars of objection, the Court will place the plaintiff in the same position as to discontinuing the action, or disclaiming a portion of his invention, as he would have been if the original particulars of objection had contained the new instances of prior publication proposed to be introduced by amendment; and accordingly all costs incurred by the plaintiff subsequently to the delivery of the original particulars of objection will be ordered to be paid to him by the defendant in case he elects, within a time fixed by the order, to discontinue his action" (*g*).

III. RELIEF.

I.—*Injunction.*

Delay.

The chief branch of relief claimed in a patent action is usually an injunction.

Before the Judicature Acts, in case of great delay in bringing or prosecuting the action for infringement, the Court might refuse an injunction at the hearing and leave the plaintiff to his action for damages (*h*). The plaintiff ought also as soon as conveniently might be after commencing the action to move for an interlocutory injunction, and on this point Page Wood, V.C., laid down:—"With respect to obtaining a perpetual injunction, the rule is established by *Bacon* v. *Jones* (*i*) that in patent cases, unless the plaintiff takes steps to bring the matter before the Court by motion before the hearing, he will not, in general, be entitled to a perpetual injunction at the hearing. He is therefore not at liberty to wait for the hearing, but the Court requires him to place the matter in course of investigation at the earliest possible period" (*k*).

The decisions upon this point, namely, as to the right of a plaintiff, who has been guilty of delay in commencing or prosecuting an

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(*f*) *Edison Telephone Co.* v. *India Rubber Co.*, 17 Ch. D. 137.

(*g*) *Ibid.*

(*h*) *Bacon* v. *Jones*, 4 My. & Cr. 433, 438.

(*i*) *Ibid.*

(*k*) *Patent Type Founding Co.* v. *Walter*, John. 727, 730.

action for infringement, to obtain at the hearing an injunction to restrain further infringement are somewhat contradictory, but it is submitted that the law on the matter is shortly as follows, namely:—

Action for infringement. Relief. Delay.

(a) That in the case of an infringement of a patent as of the violation of any other legal right, the injured party is entitled as of course (special circumstances apart) to an injunction to restrain the wrongdoer from further infringing his rights (*l*).

(b) That mere delay in commencing or prosecuting legal proceedings is not of itself any ground of refusing an injunction at the hearing.

(c) That if the delay has taken place under or been accompanied by circumstances from which it might reasonably be presumed that the person seeking relief did not intend to enforce his rights or, if so, at least did not intend to insist on his right to an injunction, and the wrongdoer in reliance on such conduct has expended moneys in connection with the infringements complained of, then the plaintiff will, or at least may be, estopped from insisting on an injunction at the hearing, in respect of matters which have then already occurred. For instance, if the result of the plaintiff's conduct has been the erection of expensive machinery, portions of which, or the working of which, are infringements of the plaintiff's patent, or if the defendant has manufactured or bought, and has in hand quantities of articles made in accordance with the patent, the plaintiff may not be granted an injunction to restrain further working or user of such machinery or the sale of such articles.

(d) But even in the cases last mentioned the plaintiff will be entitled to an injunction to restrain further acts in infringement of patent subsequent to the judgment, except in those cases where the defendant's position is such that the injunction would prevent him from obtaining the benefit of moneys which he had already expended in reliance on the plaintiff's conduct, and on the assumption that he would not be restrained. For instance, the defendant would be restrained from buying and selling other articles additional to his existing stock which would be infringements, though he might not be restrained from getting rid of an existing stock of patented articles, or from using the expensive machinery which he

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(*l*) So expressly decided by Jessel, M.R., and the Court of Appeal in *Krehl* v. *Burrell*, 7 Ch. D. 551; 11 Ch. D. C. A. 146; and by Fry, J., in *Fullwood* v. *Fullwood*, 9 Ch. D. 176.

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had erected as above mentioned, unless he could at little expense and inconvenience alter it so as not to be an infringement of the plaintiff's rights.

Form of injunction.

The injunction, if granted, extends to restraining "the defendant, his agents, servants, and workmen during the subsistence of the plaintiff's letters patent, or any extension thereof, from manufacturing, selling, or disposing of any machine constructed according to the plaintiff's patented invention, or only colourably differing therefrom, or being an infringement of the plaintiff's said patent, and from in any way infringing the plaintiff's said patent."

II.—*Account.*

Account or damages.

The plaintiff succeeding at the trial will be entitled, whether an injunction is or is not granted, at his option, to either an account of profits made by the defendant or to damages for the injury sustained by him by reason of the infringements, but not to both profits and damages (*m*). However, as the plaintiff may sue different persons in respect of the same infringement, he may, in one action against one person, for example, a manufacturer, obtain an account of profits made by him and in another action in respect of the same matter against another person, for example, the seller or user, obtain damages (*n*).

Form of order for account.

The usual form of the account which is directed is as follows, with, of course, the necessary alterations according to the circumstances, namely: "Let an account be taken of all roller skates being the same as the skates sold by the defendant to G. as in the pleadings mentioned, or otherwise made in infringement of the said letters patent, which have been manufactured, or sold, or let for hire, by or by the order, or for the use or profit of the defendant, and also the gains and profits made by the defendant by reason of such manufacture, sale, or letting for hire (*o*)."

What profits must be accounted for.

The account of profits will include not only profits actually made by the wrongdoer, but also any benefits the value of which

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(*m*) *De Vitre* v. *Betts*, L. R. 6 H. L. 319.

(*n*) *Penn* v. *Bibby*, *Penn* v. *Jack*, *Penn* v. *Fernie*, L. R. 3 Eq. 308.

(*o*) See *Plimpton* v. *Malcolmson*, Jessel, M.R., 28th of January, 1876, "Seton," 4th ed. p. 354. In the common law action of *Saxby* v. *Easterbrook*, L. R. 7 Ex. 207, the order made was "that the master do assess or take an account of the profits made by the defendants by reason of the infringements by the defendants of the letters patent and patent rights mentioned in the declaration herein."

can be reasonably estimated, which may have been derived by him directly or even incidentally from the infringements, provided a sufficient case as to this is set up in the plaintiff's pleadings and established by his evidence (*p*).

The plaintiff, however, is not entitled to an account of anything other than what the defendant himself has received, either as profits or as collateral or incidental benefits in cases where an account of such benefits can be claimed. Thus, where the infringer was a manufacturer who had been paid a fixed royalty on articles manufactured by him, the plaintiff was held entitled only to the fixed royalty so paid or payable to the infringer, and not in addition to any allowance for manufacturers' profits, although he himself was a manufacturer, and, therefore, had lost, by reason of the infringements, some profits which as manufacturer he might have made (*q*); and in the same case it was held that the plaintiff, having succeeded in another action against other infringers who were users and not manufacturers of the articles in question, and been paid in certain cases the royalty which these users would otherwise have paid to the manufacturer-infringer, was not entitled in respect of such instances to be again paid the same royalty by the manufacturer. So also the plaintiff is not entitled, on taking the account, to any allowance for annoyances or trouble not being actual pecuniary loss which he may have suffered by reason of the infringement (*r*).

Infringer—manufacturer.

Annoyance, &c.

It has been held that where it clearly appears that no profits have been made, no account will be directed (*s*). It is submitted, however, that in such case the plaintiff is, in any event, entitled to nominal damages; and, further, that he may elect, even at the hearing, and though he has not specifically claimed damages, to take a judgment for damages (*t*).

No profits made.

It is submitted that the account, when directed, must be of all profits or benefits made, and should, therefore—at least in the case of patents, if not of designs and of trade-marks—extend "from the time of the infringement to the time of verdict" (*u*).

Period over which the account extends.

But it has been suggested that a plaintiff in a patent action,

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(*p*) *Crossley* v. *Derby Gaslight Co.*, 3 My. & Cr. 428; 1 Web. P. C. 119; *Household Co.* v. *Neilson*, 1 Web. P. C. 697, n.

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

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

(*s*) *Bacon* v. *Spottiswoode*, 1 Beav. 382; *Bergmann* v. *Macmillan*, 17 Ch. D. 423.

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

(*u*) *Saxby* v. *Easterbrook*, L. R. 7 Ex. 207, 209, per Kelly, C.B.

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may, by delay in commencing proceedings, lose his right to any account (*x*); and in a case where this question of delay was considered, the account was directed only for the period of six years prior to action brought (*y*). In one case of an infringement of a trade-mark the account was limited to the filing of the bill (*z*); and in another similar case an account was refused (*a*); although in both cases the plaintiff's right was admitted to be clearly established, and an injunction was, therefore, granted.

The writer ventures to submit that these decisions (unless they are based on the ground that the plaintiff, by his conduct, waived his right to any account), cannot be supported—that the right to an account is as much a legal right as the right to damages, and that, consequently, in any case where the plaintiff, whether in a patent or a trade-mark action, establishes his case, he is entitled, as of course, to an account, at least for the period of six years prior to his action (*b*).

III.—*Damages.*

Damages. As the plaintiff in a patent action can obtain, as the result of an account, only the payment by the defendant of the amount of such profits or benefits as he has actually derived by reason of the infringements—and this may often be very much less than the damages really sustained by the plaintiff—it will frequently be advisable, in the interests of the plaintiff, to take judgment for damages instead of an account. In such case the amount to be awarded will be the actual damages sustained by the plaintiff by reason of the infringements, and they will not be estimated or be limited by reference to the profits which the defendant himself has made. Nothing, however, will be allowed to the plaintiff as compensation for mere personal trouble and annoyance caused to him in connection with the defendant's proceedings (*c*).

Enquiry. Where the case is tried before a jury, the damages will usually, though not invariably, be assessed by the jury at the trial, but may, under special circumstances, be assessed subsequently upon an enquiry.

When the trial takes place before a judge without a jury, the

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(*x*) See *Crossley* v. *Derby Gaslight Co.*, 3 My. & Cr. 428; 1 Web. P. C. 119.

(*y*) *Ibid.*

(*z*) *Ford* v. *Foster*, L. R. 7 Ch. 611, 627.

(*a*) *Harrison* v. *Taylor*, 11 Jur. N. S. 408.

(*b*) See *Fullwood* v. *Fullwood*, 9 Ch. D. 176.

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

usual rule is to direct an enquiry as to the damages. The Court itself will assess them only in simple cases.

The damages in patent cases will apparently always extend to and be limited to the period of six years prior to action brought (*d*).

Period over which damages extend.

In case of infringement of trade-marks, it has been stated that the enquiry as to damages will be limited to the commencement of the action, or at least to the date when the wrongdoer had notice that he was infringing the plaintiff's trade-mark, the reason suggested for such limitation being that in an action for infringement of trade-mark, fraud on the part of the defendant, that is, knowledge on his part that he is infringing, is necessary (*e*).

Inspection.

For the purpose of ascertaining the profits or assessing the damages after judgment, the Court may order inspection of the defendant's premises, books, and other documents (*f*); and may direct the defendant to make affidavits as to documents, as to his dealings with the patented articles, and otherwise and generally to furnish all information reasonably necessary to enable the plaintiff to have the full benefit of his judgment (*g*), and, if need be, the Court will allow the plaintiff to administer and compel the defendant to answer interrogatories (*h*).

IV.—*Destruction of Articles.*

Action. Destruction. Delivering up of articles.

In addition to the relief already mentioned the Court may order any articles, whether the subject of a patent (*i*) or a trade-mark (*k*), or a design (*l*), or parts thereof, which are an infringement of the plaintiff's rights to be destroyed, either entirely or so far as may be necessary to render them no longer infringements, or to be delivered up to the plaintiff (*m*). If, however, the articles complained of as being infringements are of such a description, or are so associated with other articles that the destruction or removal of them would be an expense to the defendant and out of all propor-

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(*d*) See *Davenport* v. *Rylands*, L. R. 1 Eq. 302.

(*e*) See per Romilly, M.R., in *Moet* v. *Couston*, 10 L. T. 395; per Page Wood, V.C., in *Davenport* v. *Rylands*, L. R. 1 Eq. 308.

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

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

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

(*i*) *Betts* v. *De Vitre*, 34 L. J. Ch. 289.

(*k*) *Moet* v. *Pickering*, 6 Ch. D. 770, 773.

(*l*) See *MacRae* v. *Holdsworth*, 2 D. G. & Sm. 496; *Prince Albert* v. *Strange*, Ibid. 717.

(*m*) Which is perhaps the commoner form of order. See last cases, and Seton on Decrees, &c.

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tion to the benefit thereby derived by the plaintiff, the Court may, instead of directing the destruction or removal of them, allow the defendant to retain them upon an undertaking not to use them in such a way as to be an infringement, and upon other terms as to working them, payment of further damages and the like (*n*).

V.—*Receiver.*

Receiver.

The Court has full power to appoint a receiver in any case where "it shall appear to be just or convenient," and it is expressly enacted that this power may be exercised on interlocutory application:—Judicature Act, 1875, s. 25; see Order L., r. 6.

It is, however, only under very special circumstances that in actions for infringement such an appointment could properly be made prior to judgment. But when judgment has been given in favour of the plaintiff it may be expedient to appoint a receiver, either as an ordinary incident to such judgment for the purpose of enforcing the same against the equitable property of the defendant (*o*), or for the special purpose of collecting any royalties or other moneys payable to the defendant in respect of the infringements committed by him (*p*).

TRIAL.

Consolidation.

Consolidation.—Where there are numerous actions upon the same patent by the same plaintiff against different persons defendants it is needless expense to have the whole of their actions proceeding concurrently. In such case the Court can (a), upon the application of any one of the defendants, consolidate the actions so as to have the questions which are common to all tried once for all in one selected action (*q*); and (b) upon the application of the

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(*n*) See *Needham* v. *Oxley*, 8 L. T. 604; *United Telephone Co.* v. *London and Globe Telephone Co.*, 32 W. R. 870.

(*o*) See *Ex parte Evans Re Watkins*, 13 Ch. D. C. A. 252; *Smith* v. *Cowell*, 6 Q. B. D. C. A. 75; *Salt* v. *Cooper*, 16 Ch. D. C. A. 544.

(*p*) See *Nordenfeldt* v. *Gardner*, *Times*, 28th March, 1884.

(*q*) Order xlix., r. 8. See *Foxwell* v. *Webster*, 4 D. G. J. & S. 77. In the case of a consolidation order it would seem that in the event of judgment being given for the plaintiff in the test action: (*a*) the defendant therein is entitled to contribution for his costs from the other defendants, and (*b*) his solicitor (if the same solicitor is employed by all the defendants) is entitled to be paid his costs by each and every of the defendants: *Anderson* v. *Boynton*, 13 Q. B. 308. See, however, *Davies* v. *Chatwood*, 11 Ch. D. 244.

plaintiff enlarge the time for taking the next step in the whole series of actions but one selected as a test action (*r*).

Action.

Evidence.—The plaintiff in order to succeed on the trial must, of course, establish his case by sufficient evidence in the usual manner. Whenever necessary or convenient the evidence of experts may be produced. How far in cases of similarity, whether of patents, trade-marks, or designs, the Court can act or ought to act upon its own opinion obtained from the comparison of different articles when such opinion is in conflict with the opinions of experts produced as witnesses, is open to doubt (*s*).

Trial. Evidence. Experts.

The Court may and frequently does in the course of an action, sometimes on the application of the parties, and sometimes *proprio motu*, direct a reference as to particular matters or questions to some properly qualified expert. Such reference will generally be for the information and the guidance of the Court. The referee is not a witness and his report merely as such is not evidence.

Referee.

"*Trade Secrets.*"—Difficulties frequently arise in the course of patent actions in reference to alleged "trade secrets." For instance, the defendant besides denying infringement alleges that his process of manufacture is essentially different from that constituting the subject of the patent by reason of some alterations or improvements known only to himself and his employees, and constituting a "trade secret," and that the main, if not the total, effect produced by his process arises from the trade secret, and that to make known the same to the plaintiff or other persons in the trade would be an extreme hardship upon him. He therefore objects to answer questions as to this trade secret, or to give such inspection of his machinery or mode of manufacture as will disclose it. What is to be done under such circumstances? If, as not seldom happens, the Court is satisfied upon the evidence produced to it that such an allegation of the defendant if not untrue, is at least without sufficient foundation, and that the alleged trade secret either does not exist, or, if it has any existence, it is a matter of no real value, in such case the order for inspection, to answer interrogatories and the like will be made.

Trade secrets.

In other cases where the Court is not so satisfied, the difficulty is got over by directing a reference as to such alleged trade secret, the referee to report thereon to the Court. This was done by the

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(*r*) *Amos* v. *Chadwick*, 4 Ch. D. 869; 9 Ch. D. C. A. 459; *Bennett* v. *Lord Bury*, 5 C. P. D. 339.

(*s*) See *Thorn* v. *Worthing Skating Rink Co.*, 6 Ch. D. 415, n.; *Mitchell* v. *Henry*, 15 Ch. D. C. A. 181.

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late Master of the Rolls in the case of the *Plating Co.* v. *Farquharson*, 1879, P. No. 264, 12th of March, 1880. The material parts of the order were as follows:—"This Court doth order that D. be appointed analyst for the purposes hereinafter mentioned and be allowed access to the works of the defendants situate at, &c., at all reasonable times upon giving the defendant two days' previous notice to see the defendant's method of making his solutions and the materials used and also to see the defendants' method of using their solutions in the process of Nickel Plating as ordinarily used by them, and also to be allowed to take samples of the solutions and thereupon to report to the Court upon the facts and his opinions founded upon them. But the said D. is not to disclose his report on the facts or opinion obtained or arrived at by him without the leave of this Court or the Judge."

Hearing in Camera.—It might be convenient if the Court could in cases where such an objection is set up hear the matter in camerâ for the purpose of deciding upon the bona fides and reality of the allegations, and subsequently so far as might be necessary in order to prevent the disclosure of a real and *bonâ fide* trade secret. But there is no general power in this respect in the Court. Mr. Justice Pearson, however, in a late case allowed the defendant who set up that he used a secret process entirely different from that of the plaintiff's to decline answering any questions in cross-examination which would disclose his secret process, and having come to the conclusion that the patent was valid he gave the defendant leave to state his secret process in camerâ, and he further ordered the short-hand writer's notes which would disclose the secret process to be impounded in Court (*t*).

COSTS.

General costs of action.

The section in consideration (sect. 29, sub-sect. 6) does not contain, nor does the Act elsewhere contain, any enactments as to the general costs of an action. Consequently these costs and the circumstances under which they will be allowed, and the persons by whom they must be paid are matters depending upon the general provisions applicable to costs. These provisions are now summed up in Order LXV. of the Rules of the Supreme Court, 1883. By this order it is provided—

(Rule 1) "Subject to the provisions of the Acts and these Rules,

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

the costs of and incident to all proceedings in the Supreme Court, including the administration of estates and trusts, shall be in the discretion of the Court or Judge; . . . . Provided also that, where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the Judge by whom such action, cause, matter, or issue is tried, or the Court shall, for good cause, otherwise order."

And by (Rule 2), "When issues in fact and law are raised upon a claim or counter-claim, the costs of the several issues respectively both in law and fact, shall, unless otherwise ordered, follow the event."

The word "discretion" in the above rule means, not an arbitrary but, a judicial discretion to be exercised in accordance with principles acted upon by Judges in the numerous decisions which have come before the Courts. It is fully recognised that where a plaintiff has a legal right (and it is submitted that the same principle holds in the case of an equitable right) and he has been compelled to come to the Courts to protect such right and has been guilty of no misconduct in the course of the litigation he is entitled as of right to his costs of such litigation (*u*).

It is only when the plaintiff's conduct has been, having regard to all the circumstances of the case, altogether vexatious, that he can be deprived whether wholly or in part of his costs.

Costs in jury actions.

Very similar observations apply to the qualification in the second rule as to costs in cases where there is a trial by jury, namely, that the successful party may be deprived of his costs, upon "good cause" shewn. As to this the judge may himself deprive the

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(*u*) "As I understand the law as to costs it is this, that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of his costs—the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts; for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or an oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it. It is, for instance, no answer where a plaintiff asserts a legal right for a defendant to allege his ignorance of such right, and to say, "If I had known of your right I should not have infringed it." Per Jessel, M.R., in *Cooper* v. *Whittingham*, 15 Ch. D. 504; and compare the judgments of Court of Appeal in *Smith* v. *Watts*, 22 Ch. D. C. A. 5.

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successful party of his costs without any application being made to him for such purpose (*x*); and in exercising his discretion the judge may take into account the conduct of the parties prior to litigation (*y*). It seems clear, however, that the successful party cannot be ordered to pay the costs of his opponent (*z*).

Subject to the limitations imposed by reason of the discretion vested in the judge, the broad rule in all actions is that the costs are "to follow the event," and this rule holds somewhat strictly in case of actions relating to infringements of patents and similar rights, because such actions relate to rights as such where the plaintiff is entitled, on establishing his case, to proper relief and not merely to matters as to which it is in the discretion of the Courts to say whether or not relief shall be granted.

Costs when infringer submits.

The above being the general rules as to costs, the question frequently arises, and—notwithstanding various decisions and numerous dicta—cannot be said to be clearly settled in all respects, (a) What are the respective rights and liabilities of the parties as to costs, if an infringer, on being informed of the claim of the injured party, consents to that claim? And (b) What is it which the infringer must express his willingness to do?

It is submitted that the result of the authorities on these points is as follows:—that the wrongdoer, in order to put himself as far as possible in the right, must, immediately on receipt of a communication from the injured party, offer to do all that he will be compellable to do in the event of a judgment in respect of the matters complained of, and that such offer must include the matters (*a*), namely:—

(1.) Payment of such costs (if any) as have then been properly incurred by the other party (*b*).

(2.) Destruction of the articles complained of, or (in cases where removal of marks, &c., is a sufficient and proper relief) the removal from them of everything constituting infringement.

(3.) In cases where the wrongdoer is not himself the manu-

(*x*) *Turner* v. *Heyland*, 48 L. J. C. P. 535.

(*y*) *Harnett* v. *Vise*, 5 Ex. D. C. A. 307.

(*z*) *Foster* v. *G. W. Ry. Co.*, 8 Q. B. D. C. A. 515.

(*a*) See the cases in the notes following. With regard to the matters numbered 3, 4, and 5, it is submitted that if the infringer cannot give the names and addresses referred, or if there have been no profits an affidavit by him as to these points will be sufficient.

(*b*) Where the party submits at once the costs will be taxed on the lower scale: see *Hudson* v. *Osgerby*, 32 W. R. 566; W. N. 1884, p. 83.

facturer of the articles, or the actual or sole author of that which causes them to be infringements, a statement of the names and addresses of such manufacturers or other authors (*c*).

(4.) A statement of the names and addresses of the persons, if any, who have received from the wrongdoer, whether as purchasers or otherwise, any of the articles complained of.

(5.) To give an account of profits, and for such purpose to give reasonable inspection of his books and other documents, if and so far as necessary (*d*).

(6.) If an action is pending, to allow an order to be taken and drawn up in the above terms.

And (7.) To pay the costs of, and incidental to, such order.

Notice.

A person complaining of an infringement is not bound to give notice before commencing an action. If he should do so, and the wrongdoer should thereupon offer to desist and give all necessary information, &c., it is, perhaps, doubtful whether he is entitled to proceed to action. But the better view seems to be that he is so entitled because (a) he was not bound to give notice, and (b) an order made or undertaking given in an action is in every way more satisfactory than an undertaking outside an action (*e*).

If an injured party persists in carrying on an action after a proper offer has been made to him by the wrongdoer, he will get no further costs, and he may be ordered to pay costs (*f*); and this applies however late in the proceedings the offer is made, and even if made after judgment against the wrongdoer, and pending an appeal by him (*g*).

Taxation.

Taxation.—Costs will, of course, be taxed as between party and

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(*c*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140.

(*d*) *Quære*, whether this is so in case of trade-marks: *Edelsten* v. *Edelsten*, 1 D. G. J. & S. 185. It is submitted, moreover, that if an account of profits is insisted on and taken, the wrongdoer submitting to account and to give all proper information is entitled (a) to have such account taken at the risk of the other party in all cases, except where profits have admittedly been made, and (b) to have any further account beyond the admitted profits taken at the risk of the other party: see *Nunn* v. *D'Albuquerque*, 34 Beav. 595.

(*e*) See *Geary* v. *Norton*, 1 D. G. & Sm. 9; *Upmann* v. *Elkan*, *ubi supra*; *Upmann* v. *Forester*, 24 Ch. D. 231, 235–6.

(*f*) See *Colburn* v. *Simms*, 2 Hare, 543; *Caruncho* v. *Highmore*, L. J. No. Cases, 1883, p. 15; cases in last note.

(*g*) *De Vitre* v. *Betts*, L. R. 6 H. L. 319, 326.

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party (*h*), and the Court has no discretion to give to any party by way of damages, or as a penalty or otherwise, costs as between solicitor and client (*i*).

In taxing the costs the ordinary rules will be followed, and only such costs will be allowed as are necessary for the conduct of the litigation (*k*). Each party is entitled to all such costs as are reasonably necessary to enable him to put his case properly before the Court; therefore models, when requisite, will be allowed (*l*), but not costs of drawings and sections explanatory of the exhibits to the defendant's affidavits, and required only for the purposes of the briefs of his own counsel (*m*).

Models, drawings, &c.

Scientific witnesses.

In connection with scientific witnesses, there will be allowed, not only the expense of their actual attendance at the hearing, but also a moderate fee, such as £7 7*s.* a day to read up the case for the purpose of giving evidence (*n*).

Reference.

The costs of any reference directed by the Court for its own information will also usually be made costs in the action (*o*).

Trial.

As regards preparing for trial, the rule is not to allow any costs relating to the trial incurred prior to notice of trial being given (*p*); but under special circumstances some, if not all, the costs reasonably incurred in anticipation of a trial may be allowed, although the action is dismissed before notice of trial (*q*).

Where an action for infringement was dismissed with costs without calling on the defendant's witnesses, and no certificate was given under section 43 of the Patent Law Amendment Act, 1852, it was held that the defendant was entitled to his costs of preparing objections and of his witnesses in support (*r*).

Directors of a Co.

There are various other points in connection with costs which may be noticed. Directors of a company and other agents who in

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(*h*) Except in patent actions when a certificate has been obtained in a previous action under s. 31.

(*i*) *Cockburn* v. *Edwards*, 18 Ch. D. C.A. 449.

(*k*) *Smith* v. *Buller*, L. R. 19 Eq. 473.

(*l*) *Batley* v. *Kynock*, L. R. 20 Eq. 632.

(*m*) *Smith* v. *Buller*, *ubi supra*.

(*n*) *Smith* v. *Buller*, *ubi supra*; *Macklay* v. *Chillingworth*, 2 C. P. D. 273.

(*o*) See *Plating Co.* v. *Farquharson*, *ante*, p. 70; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 176.

(*p*) *Freeman* v. *Springham*, 14 C. B. N. S. 197.

(*q*) See *Batley* v. *Kynock*, L. R. 20 Eq. 632.

(*r*) *Parnell* v. *Mort*, O. J. Rep. vol. i. p. 4.

any way participate in infringements, may be made parties to an action and rendered liable in damages (*s*).

Similarly, trustees of a defendant who becomes bankrupt, if, being joined as parties they take active proceedings, may be ordered to pay costs (*t*).

Where a motion is ordered to stand till the hearing, the costs of such motion will be costs in the action, whether it is dismissed (*u*) or judgment is given for the plaintiff (*x*).

If an order for an interlocutory injunction is made, and the costs are made costs in the action, or nothing is said as to the costs, in case the action is ultimately dismissed, the defendant will be entitled to the costs of such application (*y*).

In case judgment is given against the defendant, and an appeal is presented, the costs of any application to stay proceedings pending an appeal (*z*), (which application ought to be made in the first instance to the Court below, and not to the Appeal Court), must as a general rule be borne by the applicant, whether an order is or is not made on his application (*a*).

Action. Costs. Trustees.

Motion Standing over.

Stay of proceeding.

30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

Order for inspection, &c., in action.

This section provides for the more important of the interlocutory proceedings in the course of a patent action. But it is expressed in language sufficiently wide to apply to, and must be considered as applying to, proceedings at and subsequent to the trial of an action. Its provisions are supplemental and ancillary to, and not in substitution for, the analogous provisions contained in the Judicature Acts and Orders.

(*s*) *Betts* v. *De Vitre*, L. R. 3 Ch. 429, 442; Ibid. L. R. 6 H. L. 319.

(*t*) *Watson* v. *Holliday*, 31 W. R. C. A. 536.

(*u*) *Betts* v. *Clifford*, 1 J. & H. 74.

(*x*) *Mounsey* v. *Earl Lonsdale*, L. R. 6 Ch. 141.

(*y*) *Stevens* v. *Keating*, 1 Mac. & G. 659.

(*z*) *A.-G.* v. *Swansea Improvements, &c., Co.*, 9 Ch. D. C. A. 46.

(*a*) *Merry* v. *Nickalls*, L. R. 8 Ch. 205; *Cooper* v. *Cooper*, 2 Ch. D. C. A. 492; *Adair* v. *Young*, 11 Ch. D. C. A. 136.

PART II.

PATENTS.

S. 30.

Interim injunctions.

INTERIM INJUNCTION.

The principles upon which the Court proceeds in patent cases in granting or refusing interim injunctions may be thus summed up:—

Principles upon which granted.

(1.) If the patent has been established in an action *bonâ fide* contested, the injunction is as of course (*b*).

(2.) If the patent is an "old" one, and has been in use and unquestioned for a reasonable time an injunction will be granted (*c*).

(3.) In cases coming within these two classes an injunction will be granted, although the defendant may raise such *bonâ fide* doubts as to the validity of the patent that the Court would, in the case of a new patent or one not established in prior proceedings, refuse an interim injunction (*d*).

(4.) If the *primâ facie* right to an interim injunction be shewn, then an order will be made, even though it may be extremely hard upon the defendant, and extend to the shutting up of a new business (*e*). But there can be no doubt that, if the granting of an interim order would under the circumstances inflict damage upon the defendant out of all proportion to any advantage to be derived by the plaintiff, the Court, in its discretion might; and probably would, refuse the order, putting the defendant upon terms to keep an account, especially if the plaintiff was a person of small means, and his undertaking therefore not substantial (*f*).

(5.) In the case of a "new" patent not established in any legal proceedings, the Court will grant an injunction, if the validity of the patent be shewn by sufficient *primâ facie* evidence (*g*), and provided that there are no circumstances of hardship on the defendant sufficient to justify a refusal of an interim order.

(6.) If the patent be a "new" one, and there is not such evidence of its validity, or if, although it is of some long standing, it has not been put into use to such an extent or under such circum-

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(*b*) *Neilson* v. *Harford*, 1 Web. P. C. 373; *Bovill* v. *Goodier* (No. 2), L. R. 2 Eq. 195; *Plimpton* v. *Spiller*, 4 Ch. D. 286.

(*c*) *Muntz* v. *Foster*, 2 Web. P. C. 93; *Electric Telegraph Co.* v. *Nott*, 2 Coop. 41; *Stevens* v. *Keating*, 2 Ph. 333; *Dudgeon* v. *Thompson*, 30 L. T. 244; 22 W. R. 464; *Briggs & Co.* v. *Lardeur*, O. J. Rep. vol. i. p. 126.

(*d*) *Betts* v. *Menzies*, 3 Jur. N. S. 357.

(*e*) *Plimpton* v. *Spiller*, 4 Ch. D. 286; *Flower* v. *Lloyd*, 36 L. T. 444.

(*f*) See *Rigby* v. *G. W. Ry. Co.*, 2 Ph. 44; *Morgan* v. *Seaward*, 1 Web. P. C. 167.

(*g*) *Gardner* v. *Broadbent*, 2 Jur. N. S. 1041.

stances as to raise a fair presumption of its validity, the Court will usually refuse an injunction and put the defendant upon terms of keeping an account (*h*).

(7.) The right which *primâ facie* the owner of a patent might have to restrain infringements by interim injunctions may be lost by delay in coming to the Court, and *à fortiori* by conduct amounting to acquiescence in what is complained of. The party applying for an interim order must be "prompt and speedy" (*i*), but the rule cannot be stated more definitely—everything will depend upon the attendant circumstances. A delay from November in one year till July in the following was held too long in one case (*k*), whereas three months, part of which was spent in making enquiries, was not too long in another case (*l*).

(8.) When the matter is really doubtful, and when the inconvenience of granting or refusing an interim order—to the defendant if granted, to the plaintiff if refused—are about equally balanced, it is not possible to lay down any positive rule as to what course should be adopted. In such case everything should be considered, and, among other things, the solvency of the parties and the probability or otherwise of the party who may succeed finally being able to recover from his opponent the damages that may be

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(*h*) See cases in previous notes; and *Liston* v. *Norton Bros.*, O. J. Rep. vol. i. p. 114.

(*i*) See *Att-Gen.* v. *Sheffield Gas Co.*, 3 D. G. M. & G. 304; *Ware* v. *Regent's Canal Co.*, 3 D. G. & J. 212, 230.

(*k*) *Bovill* v. *Crate*, L. R. 1 Eq. 388.

(*l*) *Losh* v. *Hague*, 1 Web. P. C. 200. Shadwell, V.C., thus expressed himself: "On the 23rd of March the plaintiff received some information that there was an invasion of his patent, and some portion of time, it appears, was spent in making inquiries; there was notice given distinctly on the 8th of May. Then some further correspondence takes place and letters between the parties; and then a bill is filed on the 7th of July, and the application is virtually made. I cannot but think, therefore, that the plaintiff has come in sufficient time."

In *Bridson* v. *Benecke* (12 Beav. 1, 3), Lord Langdale, M.R., thus stated the law: "I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established, against the party who is alleged to have infringed it, ought to come at an early period. I do not say at the earliest possible period, because that would be putting an application for an injunction or notice, where all parties have an opportunity of being heard, in the same condition as an injunction *ex parte*, which it would not be expedient to do. The rule of this Court is very strict that you must apply in proper time."

PART II. PATENTS. S. 30. Interim injunctions.

payable by him, whether as the result of the action or by reason of any undertaking in damages given by him. "There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo*—for that is really what the Court has to do—to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, 'We will not stop a going trade; we will not adopt a course which will result in a very great difficulty in giving compensation on the one side or the other.' We have to deal with it as a practical question in the best way we can. I think, on the whole, that the Master of the Rolls has made the right order, viz. by granting the injunction, and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make, if he should ultimately turn out to be in the wrong; and that it would not be right in this case merely to put the defendant upon the terms of keeping an account, which I conceive might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right" (*m*).

Ex parte injunctions.

Injunctions may be granted *ex parte* in actions for infringements of patents, designs, or trade-marks as of other actions. The Courts are, however, disinclined to make such orders, and will only do so in really urgent and pressing cases. This urgency seldom exists as regards actions relating to patents or designs. But in the case of trade-marks, *e.g.* when the infringement consists in the user of forged brands on spirits, wines, cigars, and the like, it is often necessary to apply *ex parte* and before the wrongdoer has notice of legal proceedings—otherwise the whole mischief may be done before a restraining order can be obtained.

Undertaking in damages.

The rule is now in every case of the interlocutory injunction, and not merely of those which are obtained *ex parte*, to put the person obtaining the order upon an undertaking in damages (*n*).

Evidence.

Infringement.—Of course on every application for an interlocutory injunction, as for a final and perpetual one (*o*), there must be sufficient evidence of infringement to justify an order being made. If there is on the evidence before the Court any substantial doubt as to this, the rule is to refuse the injunction and put the defendant upon terms of keeping an account (*p*).

(*m*) *Per* James, L.J., in *Plimpton* v. *Spiller*, 4 Ch. D. C. A. 289.

(*n*) *Chappell* v. *Davidson*, 8 D. G. M. & G. 1; *Graham* v. *Campbell*, 7 Ch. D. C. A. 491.

(*o*) See pp. 69 and 70.

(*p*) *Electric Telegraph Co.* v. *Nott*, 2 Coop. 41; *Muntz* v. *Vivian*, 2 Web. P. C. 87; *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37.

The evidence of infringement need not be so positive or complete on interlocutory applications as on the final hearing, and may be merely information and belief—unless, indeed, the defendant displaces this by strict proof. Speaking generally, it is not politic on either side on an interlocutory motion to attempt to go fully into, and to completely establish or refute, the fact of infringement. The Court is indisposed to try the question on interlocutory applications, and, as already stated, will usually, in the event of the infringement being seriously contested on what appears to be *primâ facie* satisfactory evidence, merely put the defendant upon terms of keeping an account.

Interim injunctions.

INSPECTION.

One of the most beneficial powers possessed by the Courts is the power to order, in the course of the action or at or subsequent to the trial, inspection of the machinery, process, or articles complained of as being infringements of, or employed for the purpose of infringing, the plaintiff's patent. The inspection extends to whatever is material to the conduct of the action. It may be of machinery or processes while quiescent or when in operation, and the Court may, and will when necessary, direct the machinery or process to be put into operation (*q*).

Of what inspection ordered.

An order for inspection is not as of course. The party applying must produce evidence shewing, in the case of the plaintiff, a *primâ facie* right to his alleged patent, and a *primâ facie* case of infringement by the defendant (*r*); and further, in the case of either party, shewing by sufficient evidence (*s*) that an inspection of the works, machinery, process of manufacture, or articles which is sought, will be of material importance to himself, whether in carrying on the action or in preparing for the trial, whether he be plaintiff or defendant (*t*).

Evidence required for order.

If and when necessary an order may be made that specimens of the patented articles, or of the chemical solution or other substances used in the preparation thereof, be supplied to the other

Specimens.

(*q*) Whether experiments will be directed, see *Flower* v. *Lloyd*, W. N. 1876, p. 169, 230; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156.

(*r*) *Shaw* v. *Bank of England*, 22 L. J. Ex. 26; *Meadows* v. *Kirkman*, 29 L. J. Ex. 295.

(*s*) *Shaw* v. *Bank of England*, *ubi supra*; *Batley* v. *Kynock*, L. R. 19 Eq. 90.

(*t*) See Cases in last two notes.

PART II. PATENTS. S. 30. Interim injunctions. "Trade secrets."

side for purposes of analysis (*u*), or to an independent person for him to report on for the information of the Court (*x*).

The difficulty which has already been referred to in respect of alleged "trade secrets" (*y*) may, and often does, arise in respect of inspections. Indeed, whenever the subject-matter in dispute is a chemical process, or the like, or the employment of a combination of machinery or apparatus, it is more than probable that every manufacturer will make alterations and arrangements which he considers improvements, and which he would be unwilling to disclose to a competitor in trade or his agents. In all such cases it seems fair as between the parties that the inspection should be confined to scientific persons, with a direction not to make disclosures to either side (*z*).

INTERROGATORIES.

Interrogatories—what must be answered.

If in any action the party interrogated, whether the defendant or the plaintiff when made defendant in a counter-claim, sets up any *bonâ fide* defence to the claim of the opposite party, he may decline to answer interrogatories relating to matters which are subsidiary to such claim, and can become of importance only if it shall be, and after it has been, established (*a*). Thus if the defendant in a patent action denies the fact of infringement he will not be compellable to answer interrogatories as to articles alleged to be infringements now in his possession or sold by him, or as to accounts of profits made by him by means of the alleged infringements (*b*).

But this limitation applies only to interrogatories relating to matters entirely dependent upon the part (or, it maybe, the whole) of the case which is denied, and which will become immaterial if such case be not established. It does not extend further and protect a defendant who denies the plaintiff's title *in toto* or alleges that his patent is invalid from answering fully all interrogatories which are material (*c*).

Subject to the above limitation the broad rule as to answers to

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(*u*) *Patent Type Founding Co.* v. *Walter*, John. 727: see same case at law, 5 H. & N. 192.

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

(*y*) *Ante*, p. 69.

(*z*) *Flower* v. *Lloyd*, W. N. 1876, pp. 169, 230.

(*a*) *Parker* v. *Wells*, 18 Ch. D. C. A. 477.

(*b*) *De la Rue* v. *Dickinson*, 3 K. & J. 380; *Rolls* v. *Isaacs*, W. N. 1878, p. 37.

(*c*) *Swinborne* v. *Nelson*, 16 Beav. 416; *Foxwell* v. *Webster*, 9 Jur. N. S. 1189; 3 N. R. 103.

interrogatories is that "he who answers at all must answer fully." This maxim is perhaps scarcely applicable, taken literally, to the present system of procedure, but the principle still holds. Consequently the answering party must give a full and complete answer to all interrogatories, which will materially assist the opposite party in making out his case.

Interrogatories.

Persons to whom articles sold—patent, trade-mark.

It has been held in a patent action that the defendant who has sold or licensed articles manufactured in infringement of the patent must give the names and addresses of the parties to whom articles have been sold or by whom royalties or other moneys have been paid or are payable in respect thereof (*d*), although in a trade-mark case the Court of Appeal held that the defendant was not compellable to answer interrogatories relating to similar matters (*e*).

Composition of chemical, &c., substances.

The defendants in patent actions have usually, if not invariably, been held not bound to answer interrogatories as to the component parts of chemical and other substances employed by them in their processes (*f*), or to give details of substances, e.g. the size of wire employed by them for the purposes of their manufacture (*g*).

Prior user.

When a defendant sets up prior user of the invention claimed by the plaintiff, interrogatories as to particulars of such prior user will be allowed (*h*), but such interrogatories will not be allowed to extend to descriptions of articles in existence prior to the plaintiff's patent, or to the names of the persons to whom such articles were sold (*i*).

(*d*) *Crossley* v. *Stewart*, 1 N. R. 426; *Orr* v. *Diaper*, 4 Ch. D. 92.

(*e*) *Carver* v. *Pinto Leite*, L. R. 7 Ch. 90.

(*f*) See *Simpson* v. *Charlesworth*, W. N. 1866, p. 255; *Rolls* v. *Isaacs*, W. N. 1878, p. 37; *Renard* v. *Levinstein*, 10 L. T. 94.

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

(*h*) *Finnegan* v. *James*, L. R. 19 Eq. 72; *Crossley* v. *Tomey*, 2 Ch. D. 533; *Birch* v. *Mather*, 22 Ch. D. 629.

(*i*) *Daw* v. *Eley*, *ubi supra*.

The report of one of the numerous applications in the case of *Renard* v. *Levinstein*, 11 L. T. 79, is very useful as shewing the kind of interrogatories which parties to patent actions may be compelled to answer. What the patentee there claimed was "the treating red aniline dye, or its homologue, so as to transform it into other dyes;" and he stated that the invention was the result partly of a communication from abroad made to him by one De Loire, and partly of invention and discovery made by himself. The defendant filed a concise statement stating briefly the matters in respect of which he required discovery from the plaintiff, accompanied with interrogatories for his examination. The more material of the interrogatories were as follows—the plaintiff, on exceptions to his answers, being ordered to answer substantially the whole of them (the excepted portions of the inter-

PART II. PATENTS. S. 31.

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

Certificate of validity questioned and costs thereon.

rogatories as to which an answer was not compelled being as to proportions in which he used the materials and what it was he added, and in what proportions)—namely:

(1.) Whether it was not the fact that no true and pure blue could be produced according to the specification, even by day, and that at night, and by artificial light, the so-called blue of Girard's process was not blue, but purple, or a blue not free from red.

(2.) Whether the plaintiffs had not, since the 4th of July, 1862, *made and sold in England* some blue dye, manufactured by Girard's process, some materials being added not mentioned in the specification, or not mentioned there for the purpose of making the blue dye. Whether the plaintiffs had not wholly, or to some extent, abandoned making blue dyes strictly in accordance with Girard's process, because blue dyes so manufactured were not saleable, but worthless as blue dyes; and if the plaintiffs had sold in England, since the 4th of July, 1862, any blue dye made strictly according to Girard's specification, the defendant required them to set forth the proportion of the quantity of blue dye so made and sold by them, as compared with the quantity not so made and sold by them since the same date.

(3.) What do the words "red aniline dye of commerce" and "red aniline dye" used in the specification, mean? Whether it was not the fact that there was no one substance known as "red aniline dye" or "red aniline dye of commerce?" Whether "red aniline dye" meant, as it ought to do, a real dye, and not merely a substance which could be used for preparing dye, whether it was not then a liquid dye? The defendant required the plaintiffs to set forth the nature and chemical composition of every substance they knew of which was, at the date of the specification, sold and known as "red aniline dye." Whether the expressions "red aniline dye" and "red aniline dye of commerce" did not mean any one of the following substances, namely, sulphate of aniline, arseniate of aniline, iodide of aniline, hydrochlorate of aniline, or any salt of aniline of a red colour.

(4.) What did the words "the acid being mixed with a large quantity of water," occurring in the specification mean? What was the proportion of water to hydrochloric acid used in the mixture for violet dye? Would any proportion of water to acid be sufficient, and what was the strength of the acid? The plaintiffs were required to state the lowest and greatest proportions *respectively of water to be used in* making the mixture. What was the meaning of "hydrochloric acid of commercial strength?" and what was that strength? And did not hydrochloric acid sold in commerce vary very much in strength? and what were the limits of such variation?

(5.) Whether the plaintiffs had

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

Certificate. Consent verdict.

In order to entitle a patentee to a certificate, the validity of the patent must not merely have come in question in the action, but it must have been really contested at the hearing; consequently the certificate cannot be given if the defendant consents to a verdict for the plaintiff (*k*).

Where in an action for infringement there was a plea denying the novelty of the invention, it was held at the trial that the validity of

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not for some time manufactured and sold in England blue dye prepared without pure aniline, and whether they did not use, in making the blue dye, acetate of aniline, or oxalate of aniline, or some other and what salt of aniline, formed with an organic acid instead of aniline? Whether the process used by the plaintiffs for making blue dye did not in its essential footing resemble the processes described in the patents of Schlumberger and Gilbee respectively, and differ in essential particulars from Girard's process?

(6.) Whether it was not the fact that Girard's specification was altogether, or to some extent, inefficient as regarded the blue dye, and that no true blue dye could be produced from it.

(7.) The plaintiffs were required to set forth how they made out that Girard's specification was sufficient to produce the blue dye, particularly the manner and process of performing the invention, by stating the chemical composition of the red aniline dye used, the strength of the hydrochloric acid used, the quantity of water used, and all other necessary particulars.

(8.) Whether any, and which, of the homologues of aniline, being used with red aniline dye, and without the use of aniline itself, would produce the violet dye mentioned in Girard's specification. Whether it was not the fact that no homologues of aniline, used without aniline, would produce such violet dye. Whether any, and which, of the homologues of aniline, mixed with red aniline dye, and without the addition of any other ingredient, except hydrochloric acid and water, would produce blue dye, or violet dye. Whether the plaintiffs had ever made or sold any blue dye made without any other ingredient added to the said four ingredients, namely, red aniline dye, a homologue of aniline, hydrochloric acid, and water.

(*k*) *Stocker* v. *Rodgers*, 1 C. & K. 99; *Bovill* v. *Hadley*, 17 C. B. N. S. 435.

PART II. PATENTS. SS. 31, 32.

the patent might be considered to have come in question so as to entitle the plaintiff to a certificate (*l*).

The certificate should be applied for at the trial; the judge has no power to grant it after taxation (*m*).

The certificate, if proved in a subsequent action, should not be given in evidence during the progress of the trial, which might prejudice the defendant's case, but should be proved only in the event of, and subsequent to, a verdict being given for the plaintiff to entitle him to his extra costs (*n*).

Remedy in case of groundless threats of legal proceedings.

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

Circulars.

This section in effect gives legislative sanction to the principles laid down by the late Vice-Chancellor Malins, in *Rollins* v. *Hinks*, and *Axmann* v. *Lund* (*o*), where it was held that the Court will restrain a patentee from issuing circulars threatening legal proceedings

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(*l*) *Gillett* v. *Wilby*, 9 C. & P. 334.

(*m*) *Gillett* v. *Green*, 7 M. & W. 347.

(*n*) *Newhall* v. *Wilkins*, 17 L. T. O. S. 20.

(*nn*) See *Barnett & Foster* v. *Barrett's Screw Stopper Bottling Co.*, O. J. Rep. vol. i. p. 9; *Household* v. *Fairburn*, O. J. Rep. vol. i. p. 109.

(*o*) L. R. 13 Eq. 355; L. R. 18 Eq. 330.

against infringers, unless he will undertake to commence proceedings to assert the validity of his patent.

These decisions were very much questioned, if not by implication overruled, by the late Master of the Rolls and the Court of Appeal in *Halsey* v. *Brotherhood* (*p*). Here it was laid down that a patent so long as it subsists is *primâ facie* good, and therefore a patentee who issues notices against purchasing from a vendor alleging infringements of his patent is not bound to follow up his notices by taking legal proceedings; and, provided he issues the notices *bonâ fide* in assertion of what he believes, though erroneously, to be his legal rights under his patent, he does not render himself liable to an action by the vendor for damages for injury caused by issuing them. But it was admitted that he may be liable, notwithstanding his *bona fides*, to be restrained by injunction from continuing to issue the notices, if it is proved in the action for an injunction that his allegation of infringement is untrue.

There is a somewhat earlier case of *Wren* v. *Weild* (*q*), upon the subject of circulars containing allegations to the effect that articles sold by another person are infringements of patent rights alleged to be vested in the person issuing the circulars. The facts in this case were as follows:—The plaintiffs brought an action, alleging in their declaration that the defendant falsely and maliciously wrote to and told persons who had bought certain machines of the plaintiffs, that the machines were infringements of the defendant's patent, and that the defendant claimed royalties for the use of the machines, and that if they used the machines without paying royalties he should take legal proceedings: the defendant pleaded not guilty: the plaintiffs, at the trial, offered to prove various specifications and machines, existing before the date of the defendant's patent, to shew that the defendant's specification claimed matters that were not new, and also that the defendant had used them: the judge ruled that, as the defendant's patent was still subsisting the evidence was immaterial, and directed a nonsuit. Upon a motion for a new trial it was held, that the ruling of the judge was right; that where a person claims a right in himself which he intends to enforce against a purchaser he is entitled to give the intended purchaser warning of his intention; and that no action lies for giving such preliminary warning, unless it can be shewn, either that the threat was made *malâ fide*, only with the

(*p*) 15 Ch. D. 514; 19 Ch. D. C. A. 386.

(*q*) L. R. 4 Q. B. 730. Compare *Dicks* v. *Brooks*, 15 Ch. D. C. A. 22.

PART II. PATENTS. S. 32.

intent to injure the vendor, and without any purpose to follow it up by an action against the purchaser, or that the circumstances were such as to make the bringing of the threatened action altogether wrongful.

Threats of legal proceedings.

The declaration in the last case did not allege that the publication by the defendant was "without reasonable and probable cause," but the judgment was not based entirely (if at all) upon the absence of such an allegation.

Circulars defamatory of the business of another.

With regard to similar circulars containing allegations that what a person is doing by manufacturing or selling certain articles is an infringement of rights (whether patent or not) vested in the persons issuing the circulars (*r*) or allegations disparaging the quality of the articles manufactured or sold by such other person (*s*) or otherwise defamatory to the trade carried on by him (*t*), it is now fully settled that not only can damages be obtained by the injured party, but also an injunction to restrain the further publication of the defamatory circulars at the hearing and also in a proper case and upon sufficient evidence on an interlocutory application (*u*).

It will be noticed that the language of the above section includes only a "person claiming to be patentee." Whether the section will be construed so as to apply to persons not themselves "patentees" (under which term are included by sect. 46 "persons for the time being entitled to the benefit of a patent") but having or claiming to have some other rights, such as licensees and the like, is perhaps doubtful (*x*). If not, it would seem that such persons, on the principles laid down in *Wren* v. *Weild* and *Halsey* v. *Brotherhood*, will be under no liability for issuing circulars containing statements of the kind in consideration notwithstanding that it is conclusively shewn that the patent by them alleged to be infringed is in fact and law altogether invalid.

(*r*) *Saxby* v. *Easterbrook*, 3 C. P. D. 339. Compare *Anderson* v. *Liebig's Extract of Meat Co.*, 45 L. T. 757; *Société Anonyme des Mfs de Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 Ch. D. C. A. 1.

(*s*) *Western Counties Manure Co.* v. *Lawes Chemical Manure Co.*, L. R. 9 Ex. 218; *Thorley's Cattle Food Co.* v. *Massam*, 14 Ch. D. C. A. 763.

(*t*) *Thomas* v. *Williams*, 14 Ch. D. 864. Compare *Clark* v. *Adie*, 21 W. R. 456, 764.

(*u*) *Burnett* v. *Talt*, 45 L. T. 743; *Hill* v. *Hart-Davies*, 21 Ch. D. 798.

(*x*) See cases in notes, p. 54, *ante*.

Miscellaneous.

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

Patent for one invention only.

Section 116.
Patent Rules, 23.

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

Patent on application of representative of deceased inventor.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent Rules, 24.

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

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

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as

Assignment for particular places.

(*y*) See *Vincent's Patent*, L. R. 2 Ch. 341.

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effectually as if the patent were originally granted to extend to that place or part only (*yy*).

Section 110.

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

Patent Rules, Second Schedule, Form N.

Proceedings and costs before law officer.

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

See the "Rules Regulating the Practice and Procedure on Appeals to the Law Officers," *post*.

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

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply

(*yy*) *Borill* v. *Finch*, L. R. 5 C. P. 523.

for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

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

(*b.*) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Publication of illustrated journal, indexes, &c.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important (*a*).

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

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

(*a*) Patent Rules, 31.

Patent Museum.

41. The control and management of the existing Patent Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject

PART II. PATENTS.

SS. 41-3.

to such directions as Her Majesty in Council may see fit to give.

Power to require models on payment.

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

Foreign vessels in British waters.

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

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

The provisions in sub-sect. 1 are in effect the same as sect. 26 of the Patent Law Amendment Act, 1852, which to a great extent abolished the principle enforced in *Caldwell* v. *Van Vlissengen* (*z*), where an injunction was granted to restrain the owners of a foreign

(*z*) 21 L. J. Ch. 97; 16 Jur. 115.

vessel from using while in English waters a propeller which was an infringement of an English patent.

It will be observed that the section applies only (a) to the "use" of an invention (b) for the "purposes of the navigation" (c) of a "foreign" vessel, and (d) that the enactment does not exempt from liability the vessels mentioned in the latter sub-section.

Assignment to Secretary for War of certain inventions.

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

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

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the applica-

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

Assignment to Secretary of State for War of certain Inventions.

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

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

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

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

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in

relation to which the Secretary of State has certified as aforesaid.

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

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

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

Existing Patents (zz).

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

Provisions respecting existing patents.

(2.) Every patent granted before the commencement

(zz) As to how far the Act applies to existing patents see *Nordenfelt* v. *Gardner*, O. J. Rep. vol. i., p. 10; *Winter* v. *Baybut*, *Madeley & Co.*, ibid p. 76; *Singer* v. *Stassen*, ibid p. 121; *Brandon's Patent*, ibid p. 154.

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of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses (*a*).

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

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

(*a*) See section 113.

Existing patents.

It will be observed that by this section the provisions of the Act are applied to all patents without distinction, whether granted before or after the passing of the Act, with the sole exceptions that patents (a) already granted, or (b) to be granted upon pending application, shall remain unaffected by the provisions relating (1) to patents binding the Crown, and (2) to compulsory licences.

This enactment is unqualified, and if so held (and it is submitted that it ought to be so held) it will relieve patents existing at the passing of the Act both (a) from the qualifications expressly introduced by sect. 25 of the Patent Amendment Act, 1852 (*a*), and (b) from the restrictions imposed by the Privy Council in respect of extensions of patents coming within such section (*b*).

(*a*) Which section in substance avoids patents granted in the United Kingdom in respect of inventions first invented in a foreign country, and there patented before the grant of the home patent, at the expiration of such foreign patent—see *Borill* v. *Goodier* (No. 2), L. R. 2 Eq. 195; *Poole's Patent*, L. R. 1 P. C. 514; *Daw* v. *Eley*, L. R. 3 Eq. 496, 511; *Winan's Patent*, L. R. 4 P. C. 93; *Blake's Patent*, L. R. 4 P. C. 535; *Holste* v. *Robertson*, 4 Ch. D. C. A. 9. Compare *ante*, pp. 28–9.

(*b*) See *Hill's Patent*, 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; and *Winan's Patent* and *Blake's Patent*, *ubi supra*.

Definitions.

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention:

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

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

Definitions of patent, patentee, and invention.

Sect. 6 of the Statute of Monopolies is as follows:—"Provided also that any declaration before mentioned shall not extend to any letters patent and grant of privilege for the term of fourteen years or under, hereafter to be made, if the sole working or making of *any manner of new manufactures within this realm to the true and* first inventor and inventors of such manufactures, which others at the time of making such letters patents, and grants shall not use so as also they be not contrary to the law nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patents, or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other."

REQUISITES OF A VALID PATENT.

The description of what constitutes a valid patent contained in the above section is very vague. Consequently the section has been largely supplemented by very numerous decisions. It is not possible here, and indeed it would be beyond the scope, to attempt to set forth a summary of these decisions. But the leading and guiding principles to be extracted from them may be shortly stated in the following propositions.

Requisites of valid patents.

I. A mere principle cannot be patented.

I. Principle.

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This maxim or statement has been enunciated in numerous judgments and is established beyond dispute. But it holds only when and so far as it is applied to a "mere" principle. "A man cannot take out a patent for an idea, but he may take out a patent, if I may say so, for an idea coupled with a practical process of effecting that idea" (*c*). It will suffice if accompanying the principle stated by the patentee, and the discovery of which probably constitutes the real if not the sole merit of his invention, there is stated some process or mode however crude, if really "usable" as a commercial proceeding, whereby the principle can be made available. Consequently patents have frequently been supported, the essence of which has consisted in the principle enunciated by the patentee rather than in the mode stated by him of rendering his principle practically useful—as in the well-known instance of Watt's steam engine (*d*), the hot air blast (*e*), the use of anthracite instead of ordinary coal (*f*), and many cases of patents for chemical or electrical discoveries.

II. Manufacture.

II. A patent must be for some description of manufacture.

The term "manufacture" is used in the Statute of Monopolies. It is to some extent ambiguous, for it may denote either (a) the mode or process of manufacturing, or (b) the result thereof—the thing or product manufactured. It has long been fully established that the word includes both meanings—that is, that a patent will be valid which relates to either a fresh process or mode of production, or to a new thing produced by old or improved machinery or processes.

The difference between these two meanings of the word "manufacture" will often give rise to important consequences in considering the validity of patents and the rights of patentees.

If a patent is for a new product, one not known previously as a commercial commodity, and the patentee describes a practical mode of producing the product, then he acquires a monopoly of such commodity (*g*).

If on the other hand the patent is for a process or for machinery or other means of carrying such process into operation, then the

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(*c*) *Per* Pearson, J., in *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 162.

(*d*) *Boulton* v. *Bull*, 2 H. Bl. 463.

(*e*) *Neilson* v. *Harford*, 1 Web. P. C. 295.

(*f*) *Crane* v. *Price*, 1 Web. P. C. 377. Compare *Muntz* v. *Foster*, 2 Web. P. C. 93; *Stevens* v. *Keating*, 2 Web. P. C. 175.

(*g*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 171–3, and cases there cited.

patentee has no monopoly as to articles which can be produced by such processes, machinery, or means—they may be produced by any one who can do so by using other means than those described in the patent—but he is entitled to prevent any one using his peculiar process, machinery, or means or trafficking, or using articles produced by means thereof (*h*).

Requisites of patents. III. New.

III. The requisites of an invention, in order that it may be patentable, are, that it must be "new within the realm," and also useful.

When a process or a product is "new" in the sense of being admittedly different to what has been in use or been known before there can be little difficulty in determining whether or not it is "new," so as to be the subject of a valid patent. But difficulties arise when the process or product in question resembles in certain salient aspects processes or products already in use or known. It is impossible to lay down any definite rules as to what amount of prior information will render a patent void for want of novelty. It is clear however that prior actual knowledge is not necessary to do so—mere suggestions may be sufficient, provided such suggestions have taken such a form that they could be put into practical operation (*i*).

Information contained in prior publications.

A good illustration of the difficulties attendant upon this question of novelty is shewn by the history of the litigation of *Betts* v. *Menzies* (*k*). It was an action for an infringement and the main defence was that Betts' patent was invalid on the ground that his invention had been discovered by Dobbs and been by him set forth in two specifications published long prior to Betts' patent. There were two trials, both which resulted in verdicts for the plaintiff—the Court of Queen's Bench directed a verdict to be entered for the defendants—the Exchequer Chamber by a majority affirmed this decision—and finally the House of Lords reversed the decisions below, and directed the verdict obtained for the plaintiff to stand. Lord Westbury said (*l*), "I pass on to the next conclusion, which is involved in the answer of the learned Judges to your Lordship's question, and that conclusion, I think, is also of great importance to the law of patents, because it results from that opinion that an antecedent specification ought not to be held to be

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(*h*) *Von Heyden* v. *Neustadt*, 14 Ch. D. C. A. 230, and cases cited.

(*i*) See *United Telephone Co.* v. *Harrison, Cox-Walker, & Co.*, 21 Ch. D. 720, affirmed in the C. A. W. N. 1883, p. 21.

(*k*) 10 H. L. C. 117.

(*l*) 10 H. L. C. 154.

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an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery. Here we attain at length to a certain undoubted and useful rule. For the law laid down, with regard to the interpretation of a subsequent specification, is equally applicable to the construction to be put upon publications or treatises previously given to the world, and which are frequently brought forward for the purpose of showing that the invention has been anticipated. The effect of this opinion I take to be this, if your Lordships shall affirm it, that a barren, general description, probably containing some suggested information, or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding, for want of novelty, a subsequent specification or invention which involves a practical truth, productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical and useful information."

IV. Simplicity.

IV. If it is established that the discovery claimed by a patentee is in reality new and practically useful, the patent will be good, however small or simple may be the actual discovery itself.

Very frequently the chief merit of an invention consists in its simplicity, and in every case undoubtedly the more simple the process is the more useful it will be. All that is required is that there should be a discovery of *something materially different from* what was already in existence. In reference to this point, Jessel, M.R., thus expressed himself in the case of *Hinks & Son* v. *Safety Lighting Co.* (*m*). "The only material difference between the two patents which was pointed out was this, that one used a round wick and the other a flat wick. On the one hand it was said you can never support a patent by substituting a round wick for a flat wick, as there is no invention in that. On the other hand it was said, Why not? If it is a combination patent, the very essence of a combination patent is that it is a new combination of known parts, and in fact very few machines are now invented which contain any new part. As a general rule, every machine invented is made up of parts which are previously known. A new part of a machine is very uncommon indeed; consequently that is an objection which, *per se*, is not of great weight. But, like every combination which is new, it must have merit, and now how is a Judge to apportion the merit? I do not know. As far as I can

(*m*) 4 Ch. D. 607, 615-6.

ascertain from the authorities, the merit very much depends on the result produced. Where a slight alteration in a combination turns that which was practically useless before into that which is very useful and important, Judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and, as far as a rough test goes, I know of no better."

V. Improvements.

V. While it is necessary in order that an invention may be patentable, that the new manufacture to which it relates should consist in the creation of a new and distinct trade, machinery, process or product, it will be sufficient if the invention consists in a substantial improvement in an existing machine, process or mode of using any commodity.

A good case illustrative of the principle here stated, is *Cannington* v. *Nuttall* (*n*). The patent in this case was for improvements in the manufacture of glass, and consisted substantially in making various alterations in the processes of manufacture then practised, but as to which the patentee made no claim, and combining these things with an improved furnace, and he described his invention as consisting in "forming the sides of the tank or chamber containing the glass making materials hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or inclose the fused material." It was held that this patent was perfectly good, and Lord Hatherley, L.C., thus expressed himself: "It was suggested in one case, I think, that a tank should be used and placed upon the earth, and fire applied to the sides. But although all these things had been done, yet the glassmakers had not yet got what they wanted; they had not got an effectual mode of getting rid of the pots, and getting rid of the sieges, and making glass without them. Now, said the patentee, I think I have got it; but in the first place I said that my invention consisted in doing that. But that was a wrong expression, because others know that that can be done, and they have tried it; so I had better not speak of my invention as being the removal of the sieges, or the removal of the pots, but my mode of effecting the object is by so placing the tanks as to obviate the bursting of the pots through the extreme heat. I will make that very objection, if it takes place, work its own cure. I will so carry the air around the sides of the tank that when the melted material does burst forth from it, and permeate a portion of the sides of the

(*n*) L. R. 5 H. L. 205.

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tank in consequence of the extreme amount of heat to which the tank is subjected, I will take care that an external cooling apparatus shall be at hand which shall arrest and congeal the fluid, and enable the congealed fluid to operate to the end that we have in view. It is quite apparent, my Lords, that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every new invention—the skill and ingenuity of the inventor are shown in the application of well-known principles. Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a practical result not yet achieved. And I take it that the test of novelty is this. Is the product which is the result of the apparatus for which an inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view."

VI. Improved application of existing machines.

VI. An invention is patentable if it consists in the improved application of existing machines to materials whether old or new.

This is the principle upon which patents for combinations are based. If there be a new and beneficial combination and application of old and well-known machinery, a patent properly limited to and claiming this combination will be valid (*o*). And "if a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered consisting, for example, of the introduction of some new parts or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented" (*p*).

Combination patents.

"Combination" patents may claim and consist of either (a) merely and solely the combination, or (b) both the combination and something new, whether in the process used or in the respective products in connection therewith.

In the case of the former class of patents it is the combination

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(*o*) *Wright* v. *Hitchcock*, L. R. 5 Ex. 37; *Harrison* v. *Anderston Foundry Co.*, 1 App. C. 574; *Saxby* v. *Gloucester Waggon Co.*, 7 Q. B. D. 305.

(*p*) *Per* Lord Westbury, C., in *Foxwell* v. *Bostock*, 4 D. G. J. & S. 311; *Westinghouse* v. *Lancashire and Yorkshire Ry. Co.*, O. J. Rep. vol. i. p. 98.

itself and alone which is the subject of the patent, and upon the novelty of which the validity of the patent depends, and in such case where "the claim is for a combination and nothing but a combination, *there is no infringement unless the whole combination is* used" (*q*).

Requisites of patents.

In the latter case as the patent claims both the combination and also the additional matter alleged to be new, on the one hand the validity of the patent will depend upon the novelty both of the combination claimed and of the additional matter, and on the other hand the patent may be infringed by the user either of the combination or of the other matter claimed as new (*r*).

VII. Employment of mere materials.

VII. But an invention or that which is claimed to be an invention is not patentable, if it consists merely in the user about other, it may be new (already known) materials of existing machinery already employed in connection with other analogous materials or substances.

A leading case on this is *Brook* v. *Aston* (*s*), where the plaintiff's patent was held bad. Martin, B., said: "The question therefore is, whether another person can take the same machinery as was patented in 1853 for linen and cotton yarn, and obtain a patent for the application of it to woollen and thread. I quite concur in the judgment of the Court of Common Pleas in *The Patent Bottle Envelope Co.* v. *Seymer* (*t*), that the application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes in fact a tool. I am therefore of opinion, that the application of this machinery to woollen yarn is not the subject of a patent."

As illustrations of the limitations in respect of patentable matters enunciated in the above proposition may be mentioned and compared the cases of *Parkes* v. *Stevens* (*u*), where it was held that the adaptation of a sliding door to a spherical lamp, sliding doors having previously been applied to cylindrical lamps and to other glazed surfaces, cannot of itself be the subject of a patent, and

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(*q*) *Per* Cairns, L.C., 1 App. C. 578. Compare *Boxill* v. *Keywood*, 7 E. & B. 725; *Thomas* v. *Foxwell*, 5 Jur. N. S. 37, 39; *Moore* v. *Bennett*, in the House of Lords, O. J. vol. i. p. 129.

(*r*) See *Leather* v. *Lister*, 8 E. & B. 1004, 1031; *Foxwell* v. *Bostock*, 4 D. G. J. & S. 298; *Clark* v. *Adie* (1), 2 App. C. 315; *Cropper* v. *Smith* (C.A.), W. N. 1884, p. 80; O. J. Rep. vol. i. p. 81.

(*s*) 8 E. & B. 478; 28 L. J. Q. B. 175, 176.

(*t*) 28 L. J. C. P. 22.

(*u*) L. R. 5 Ch. 36.

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Murray v. *Clayton* (*v*), where it was proved that a machine for which a patent had been granted was shewn to produce work more expeditiously, more economically, and of a better quality than any previous machine; and it was held that the patent could not be invalidated on the ground that the machine was formed by the mere arrangement of common elementary mechanical materials, producing results of the same nature as those previously accomplished by other mechanical arrangements and construction.

PART III.

DESIGNS.

Registration of Designs.

PART III. DESIGNS. S. 47.

Application for registration of designs.

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

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

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

(*v*) L. R. 7 Ch. 570. Compare *Harrison* v. *Anderston Foundry Co.*, 1 App. Cas. 574; *Clark* v. *Adie*, (No. 1) 2 App. Cas. 315.

(*vv*) This section differs materially from the previous statute, 5 & 6 Vict. c. 100, s. 3, in omitting the very important words "or elsewhere." Consequently it would seem that now prior publication to vitiate a design must be publication within the United Kingdom.

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

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

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

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

(α) Designs Rules, 4, 6, 12.
(β) Ibid. 9 and Form E, First Schedule to Designs Rules.
(γ) Designs Rules 5 and Third Schedule.
(δ) Compare *Barran* v. *Lomas*, 28 W. R. 973.
(ε) Designs Rules, 6–9.
(ζ) Ibid. 16–20.
(η) See sect. 62, sub-s. 4, as to Trade-Marks.
See Sections 54, 60, 61.

DESIGNS.

The only indication of the meaning of "Design," as used in the Act is in the so-called definition in section 60, which however does not state what are the requisites of a "design," but merely limits the expression for the purposes of this Act to designs applicable to the articles, substances, and things therein referred to.

A design may be stated to be some peculiar shape, configuration, or form, given to any article or pattern, or arrangement of lines or the like used on or with an article, and not the article itself. It is this which separates a design from a patent having for its subject a new product. If what is claimed in any particular litigation is an article or thing itself, then the claim to be valid must be based upon a patent—if it is the peculiar shape, pattern, or appearance of the article which is claimed, then this is a claim for a design.

Definition of design.

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Application for registration.

Erle, J., thus expressed himself in reference to this point (*w*): "It is a combination of means for the purpose of easily admitting air and avoiding a downward draught, and there is a skilful combination of means to produce this result. But the particular shape or configuration is accidental and wholly unimportant, and unconnected with the purpose to be attained. An oblique pane is of no particular use; a square or circular pane, and a straight or curved screw, would produce the same result. If the prosecutor relies on the shape or configuration as producing a useful result, he fails in making out that the defendant has infringed the protected right, because there is no doubt that the shape of the defendant's invention varies materially from that registered by the prosecutor; in the one the pane being nearly square and in the other oblong, and the screw being straight in the one, and crooked in the other. The prosecutor intended to protect a combination of means producing a useful result, and that is within the law relating to patents, and not within statute 6 & 7 Vict. c. 65."

Scandalous.

Immoral.

By section 73 no "scandalous" design may be registered, and by section 86 the same prohibition extends to one which is contrary to law or morality.

The design must be "new or original," and not previously published within the United Kingdom (*x*).

Person entitled to register.

The person entitled to register is the "proprietor," who by section 61 is the "author," except when the author has executed the design for another person for good consideration, in which case the latter person is the proprietor; and so a person who acquires a design for good consideration is the proprietor.

Employers.

Purchasers.

The employer of a workman who invents a design is "the proprietor" of it (*y*); but persons who purchased a design from abroad (*z*), and who acquired from foreign manufacturers the sole

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(*w*) *Reg.* v. *Bessell*, 15 Jur. 773, 16 Q. B. 810. Compare per Byles, J., and Wightman, J., in *Harrison* v. *Taylor*, 4 H. & N. 815; 29 L. J. Ex. 3; 5 Jur. N. S. 1219.

(*x*) As to what will amount to publication, see *Hunt* v. *Stevens*, W. N. 1878, p. 79. Whether "publication" includes making known in any manner, *e.g.* by the issue of the design in a book or the like, or is limited to publication by actual user of the design in connection with some article, *quære*—see *Dalglish* v. *Jarnie*, 2 Mac. & G. 231, 2 H. & T. 437; and compare sect. 50, sub-sect. 2. The expression in which "before delivery on sale" may perhaps be held to give to "publication," the more restricted meaning.

(*y*) *Lazarus* v. *Charles*, L. R. 16 Eq. 117.

(*z*) *Ibid.* p. 121.

right to sell articles improved with the design (*a*) were respectively held not to be proprietors.

Valid Designs.

It has been decided that the following matters claimed as designs under former statutes were good and valid designs, namely:

Application for registration.

A brick having on two of its opposite sides a semicircular cavity corresponding with a similar cavity in a brick placed next to it (*b*).

A peculiar arrangement of six stars in an ornamental chain forming together the ornamentation of a woven fabric (*c*).

A pattern for woollen cloths in which large and small honeycomb cells were so arranged that the border of the larger cells surrounded an enclosed portion of the smaller cells, though neither the large nor the small honeycomb was new (*d*).

An arrangement consisting of a dish and cover forming one compound article (*e*).

Combinations.

A combination of two old and well-known designs, if forming a new pattern or arrangement (*f*).

But in order that a combination design may be good, the combination must constitute one new design and not be in reality a collection of separate designs (*g*).

Invalid Designs.

On the other hand, the following claimed as designs have been held to be invalid, and not entitled to protection, namely:—

A mechanical contrivance in connection with a dog-cart phaeton, allowing the hind wheels to be turned more easily (*h*).

A photograph of a public character (*i*).

And it was doubted whether a mechanical contrivance within the stem of a parasol for raising or lowering it with one hand (*k*);

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

(*b*) *Rogers* v. *Driver*, 16 Q. B. 102.

(*c*) *Holdsworth* v. *M'Crea*, L. R. 2 H. L. 380.

(*d*) *Harrison* v. *Taylor*, 4 H. & N. 815.

(*e*) *Fielding* v. *Hawley*, 48 L. T. 639.

(*f*) *R.* v. *Firmin*, 15 "Justice of the Peace," 740, cited in *Harrison* v. *Taylor*, *ubi supra*; *Norton* v. *Nicholls*, 1 E. & E. 765.

(*g*) *Norton* v. *Nicholls*, *ubi supra*; *Mulloney* v. *Stevens*, 10 L. T. 190; *Lazarus* v. *Charles*, *ubi supra*. In the use of a combination design, as with a combination patent, it is the combination which is protected, not the separate parts.

(*h*) *Windover* v. *Smith*, 32 Beav. 200.

(*i*) *Adams* v. *Clementson*, 12 Ch. D. 714.

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

PART III. DESIGNS.

and whether a label having in it an eyelet hole lined with a metallic ring through which a string was passed for attaching it to packages (*l*) were valid designs.

SS. 47, 48.

The question of novelty is for the jury to be decided by visual inspection aided by the evidence of experts where necessary (*m*).

SUB-SECTION 7.

This sub-section contains no provisions, either allowing an appeal from the Board of Trade to, or authorizing the Board of Trade to refer any matter to the Court (*n*).

Jurisdiction of Board of Trade.

It seems therefore to follow that the jurisdiction of the Board of Trade is necessarily final, but it is submitted that in any case this jurisdiction is subject to the general powers of rectification of any register vested in the Court by sect. 90.

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

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

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

(*a*) Designs Rules, 8, 9, 30.
(*β*) Ibid. 13.

Apparently in addition to "representations or specimens" there must, pursuant to sect. 47 sub-sect. 3, be a sufficient written description of a proposed design.

In *Norton* v. *Nichols* (*o*) Page Wood, V.C., differing from the Queen's Bench in the same case (*p*), held that the registration of a

(*l*) *Margetson* v. *Wright*, 2 De G. & S. 420.

(*m*) *Harrison* v. *Taylor*, *ubi supra*. Compare *Mitchell* v. *Henry*, 15 Ch. D. 181; and *ante*, p. 69.

(*n*) See sect. 62 as to Trade Marks.

(*o*) 4 K. & J. 475.

(*p*) 5 Jur. N. S. 1203.

specimen of the article comprised in the design satisfied the requirement as to registering a "copy" of the design.

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SS. 48-51.

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

Certificate of registration.

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

(a) Designs Rules, 11, 12.
Compare sect. 96, *post*.

Copyright of registered Designs.

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

Copyright on registration.

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

(a) Compare note (*x*), *ante*, p. 104.
See sect. 60 for definition of "copyright."

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark (*a*), or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall

Marking registered designs.

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cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

(a) Designs Rules, 32.

Marking registered designs.

"Prescribed mark." Under the old Acts it has been held that sale abroad without the proper sign or mark (*r*), or sale of even one or two articles (*s*), forfeits the copyright.

Samples.

Patterns or samples containing the design on a small scale must be properly marked (*t*).

The concluding sentence of the section is new, and may perhaps be construed as entitling a proprietor to relief under circumstances analogous to those in *Pierce* v. *Worth* (*u*).

A book of designs need not be registered (*x*).

Inspection of registered designs.

52. (1.) During the existence of copyright in a design, the design shall not be open to inspection (*a*) except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

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

(*a*) Designs Rules, 35.
(*β*) Ibid. 33.

Information as to

53. On the request of any person producing a par-

(*r*) *Sarazin* v. *Hamel* (No. 2), 32 Beav. 151; 32 L. J. Ch. 380.

(*s*) *Pierce* v. *Worth*, 18 L. T. 710; *Hunt* v. *Stevens*, W. N. 1878, p. 97.

(*t*) *Fielding* v. *Hawley*, 48 L. T. 639.

(*u*) *Ubi supra.*

(*x*) *Branchardiere* v. *Elvery*, 4 Ex. 380.

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

Designs Rules, 35.

Existence of copyright.

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

Cesser of copyright in certain events.

Register of Designs.

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

Register of designs.

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

(*a*) Designs Rules, 21–28.

Compare sect. 87 as to the Register of Trade-Marks; sects. 88 and 89 as to inspection of any register, and sects. 90, 91, 93, and 94 as to rectification of any register.

Under the former statutes it was held that an assignment must be in writing (*y*), but whether this is so now, *quære*—there is no reference in the Act or the Rules to writing.

Assignments.

An assignment should be registered as soon as possible, as otherwise, in case of the bankruptcy of the assignor before registration,

(*y*) *Jewitt* v. *Eckhardt*. 8 Ch. D. 404.

PART III. DESIGNS.

SS. 55–57.

the copyright would probably be held to be in his order and disposition, and therefore to go to his trustee in bankruptcy (z).

Fees.

Fees on registration, &c.

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

Designs Rules, First Schedule.

Industrial and International Exhibitions.

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

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

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

(*b.*) The application for registration must be made before or within six months from the date of the opening of the exhibition.

Designs Rules 36, Second Schedule, Form L.

(z) See *Longman* v. *Tripp*, 2 Bos. & P. N. R. 67; *Re Dilworth*, 1 Deac. & C. 411.

Legal Proceedings.

58. During the existence of copyright in any design—

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

Penalty on piracy of registered design.

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

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

LEGAL PROCEEDINGS.

Manufacturers.

The first sub-clause, it will be seen, applies only to manufacturers and does not require, to render a person liable, knowledge that the design used by him has been registered (*a*).

Retailers.

The second sub-clause applies to all persons offering for sale articles having on them a registered design, and it requires, in order to render them valid, that they should know the design or imitation thereof has been applied without the consent of the registered proprietor.

(*z a*) As to what operations will amount to an "application" of a design so as to render the person liable under this section, see *Mallet* v. *Howitt*, W. N. 1879, p. 107.

(*z b*) Compare the last sentence of sect. 59.

(*a*) See *MacRae* v. *Holdsworth*, 2 D. G. & Sm. 496; *Mallet* v. *Howitt*, *ubi supra*.

Legal proceedings.

The question as to what will amount to a "fraudulent or obvious imitation" of another design was very fully discussed in the recent case of *Grafton & Co.* v. *Watson & Co.*, 28 Sol. Jo., p. 376-7. The exact question here was whether a registered design, consisting of a dominant part and subordinate parts, so arranged as to produce a general effect, was infringed by a design producing a similar effect, notwithstanding that such design imitated neither the dominant part nor the subordinate parts of the registered design.

Fraudulent imitation.

The plaintiffs and defendants were calico printers, at Manchester, and it is the custom of the trade to produce designs in the autumn for the fashions in the following spring, orders for execution being received in the meantime. In October, 1883, the plaintiffs registered four designs as a range or series, but found, in January, 1884, that goods bearing a design of alleged similarity to their design were being sold by the defendants. It was stated by the defendants that their design had been especially produced for them in Paris by a designer to whom the plaintiff's design had been admittedly shewn in order that he might, whilst producing a general effect, which it was said was the fashion in vogue, avoid imitating in any particular the plaintiffs' design. The defendants' design did not imitate the parts of the registered design, but was a combination of equivalents, so arranged as to produce a similar effect. It was contended that general effect could not be the subject of registration. Chitty, J., held that the defendants' design was a "fraudulent and obvious imitation" within the words of the above section—the general effect produced was the same as that of the plaintiffs' design, and was in palpable imitation of it, and he was satisfied that, but for the production of the plaintiffs' design, that of the defendants would not have appeared.

Knowledge.

Both sects. 58 and 59 require that a mere seller or retailer must know that he is infringing in order to be liable.

5 & 6 Vict. c. 100.

These provisions are considerably different from those of the previous statute (5 & 6 Vict. c. 100, s. 7) on the same points, which were that "no person shall publish, sell, or expose for sale any article of manufacture, or any substance to which such design, or any fraudulent imitation thereof, shall have been so applied, after having received either verbally or in writing, or otherwise, from any source other than the proprietor of such design, knowledge that his consent has not been given to such application, or after having been served with or had left at his premises a written notice signed by such proprietor or his agent to the same effect."

Upon this section it was held by the full Court of Queen's Bench

in *Norton* v. *Nicholls* (*b*), that a notice which was addressed to the defendants, both as manufacturers who had applied the design to articles of manufacture, and as retail dealers who had sold articles of manufacture to which the design had been applied by others, and stated, that if the defendants either applied the design to an article of manufacture, or sold an article of manufacture with the design applied to it, the plaintiff would sue them was not sufficient, as not being tantamount to a notice that the plaintiff had not given his consent to the application of his design to the manufactured article.

Legal proceedings.

In *Halsey* v. *Brotherhood* (*c*), Jessel, M.R., said: "In many cases it is [the plaintiff's] duty to [give notice] before bringing an action, and in some cases the legislature has compelled him to do so before bringing an action. Take for instance those cases of infringement of copyright and designs and so on where the seller is only liable if he knows that the right has been infringed; there you must let him know before bringing an action or your action would fail."

Action for damages.

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

(*a*) Of course in addition or substitution for an injunction.

(*β*) Compare the last sentence of sect. 58, and the cases cited upon it.

(*b*) 1 E. & E. 761; 5 Jur. N. S. 1203.

(*c*) 15 Ch. D. 514, 517.

PART III. DESIGNS.

SS. 60, 61.

Definitions.

60. In and for the purposes of this Act—

Definition of "design," "copyright."

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

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

This definition makes "design" include all matters of the kind mentioned, and is not limited to such as are "ornamental" or "useful."

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application

thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

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See cases cited *ante*, p. 104.

PART IV.

TRADE MARKS.

PART IV. TRADE MARKS. S. 62.

Registration of Trade Marks.

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

Application for registration.

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

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

(4.) The comptroller may, if he thinks fit, refuse to register a trade-mark, but any such refusal shall be subject to appeal (*δ*) to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may

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(*d*) See *Riviere's Trade-Mark*, 49 L. T. 504, for the case of a foreigner proposing to register.

PART IV. TRADE MARKS.

S. 62.

Application for registration.

make an order determining whether, and subject to what conditions (*dd*), if any, registration is to be permitted (ε).

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

(α) Trade-Marks Rules, 7–16, as to mode of making and other requisites of an application for registration.

(β) Trade-Marks Rules, Second Schedule, Form F.

(γ) Ibid. Form G.

(δ) Ibid. Form H.

(ε) Trade Marks Rules, 20–24, 44, as to appeals to the Board of Trade. See sect. 68 as to advertising applications.

" 69 as to opposition.

" 71 and 72 as to registering more than one person.

" 72 and 74 as to mode of registration, &c.

" 81 as to applications subject to the Cutlers' Company.

" 91, 92, and 94 as to rectifying the register.

" 97 as to mode of giving notices.

The application may be sent by post or left or given at the Patent Office or to the comptroller—see sect. 97 and Trade-Marks Rules, 16.

There is no limitation as to the power of the comptroller "if he thinks fit to refuse to register a trade-mark." The refusal may take place *mero suo motu* and without the need for opposition from other parties. It is presumed, however, that the refusal will take place by the action of the comptroller himself only (a) when a mark proposed to be registered is the same as, or closely resembles another already on the register, or (b) under sect. 71. When opposition arises to a proposed registration the resemblance to existing marks no doubt will be the chief, but it will not necessarily be the sole, ground of opposition. To justify a refusal to register on this ground it has been held that the similarity between the proposed mark and already existing marks must be such as probably to deceive (*e*).

Opposition.

In case of opposition by other parties to the registration of any particular application, the applicant may, by sect. 69, furnish a state-

(*dd*) Compare sect. 47, sub-sect. 7 as to designs.

(*e*) *Re Farina*, 26 W. R. 261; *Re Farina*, 27 W. R. 456.

ment of the grounds of his application. Then security is to be given, and, this done, the case "shall be deemed to stand for the determination of the Court." On an appeal to the Board of Trade, the proceedings as laid down by the Trade-Marks Rules are as follows—

(1.) Notice of appeal must within one month of the decision appealed against be left at the Patent Office (r. 20).

Application for registration.

(2.) The notice is to be accompanied with a "statement of the grounds of appeal and the appellant's case in support thereof" (r. 21).

(3.) A copy of the notice is to be sent forthwith to the Board of Trade (r. 22).

(4.) The Board of Trade will thereupon give directions for the purpose either of the having before the Board of Trade or of referring the appeal to the Court (r. 23).

Appeals to.

There are no specific provisions or directions as to the hearing of the appeal by the Court; when or how it is to be brought before the Court and what is to be the course of procedure.

Costs.

It will also be noticed that the section does not, nor does the Act elsewhere, contain any provisions as to the costs of proceedings before the comptroller or the Board of Trade.

It is to be submitted that a person who is entitled to the exclusive use of a trade-mark is absolutely entitled to have it registered (*f*).

Issues of fact.

It was the practice—originally invariable but recently growing less common—of the Court of Chancery to direct in patent, as in other similar, actions the issues of fact to be separately tried before a judge usually with, though sometimes without a jury. By Cairns' Act and Rolt's Act (*g*) provisions were made for the trial of questions of fact by the Court of Chancery. These Acts have now been repealed, but the High Court of Justice has both by virtue of its general jurisdiction and also by the special provisions of the Judicature Acts and the Rules (*h*) power to direct issues where necessary (*i*).

Conditions.

When necessary for the protection of interested parties conditions will be imposed, in allowing registration, as to the user and otherwise of a trade-mark or a design. Thus, where an application made

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(*f*) See *Orr-Ewing* v. *Registrar of Trade-Marks*, 4 App. Cas. 479.

(*g*) 21 & 22 Vict. c. 27; 25 & 26 Vict. c. 42.

(*h*) J. A. 1873, s. 57; Order 33, r. 1; Order 34, r. 2; Order 36, rr. 5, 7, 8. See also section 90.

(*i*) See *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28.

PART IV. TRADE MARKS.

SS. 62, 63.

to register for certain goods an old mark consisting of two globes with letterpress, which had been used on labels and wrappers, but not stamped on the goods, was opposed by the registered proprietor of certain old marks, registered for goods in the same classes, one consisting of a single globe, and another of the word "Globe," which marks were stamped on the goods, it was held that registration ought to be granted only on the applicant's undertaking (to be noted on the register) not to stamp his mark upon the metal of his goods, nor to use it otherwise than he had previously used it (*k*).

Application for registration.

In another case the facts were these:—A firm of calico bleachers applied for registration of old marks for cotton goods, consisting of a shield, or frame in the shape of a shield, with (1) letters indicative of the firm itself, (2) the representation of a swan and also letters indicative of the firm. Varying letters were also used upon each mark, indicative of the date and packer of *each* parcel of calico. In the bleaching trade the trade-mark is stamped inside the fold of the parcel of calico, which is then stitched up, and the manufacturer's and merchant's mark is stamped outside the parcel. It was held that registration ought to be proceeded with, a note being placed upon the register of an undertaking entered into by the applicants not to use the marks otherwise than they had been previously used; namely, inside the fold of calico (*l*).

Alterations of the registers.

Sects. 91 and 92 provide for the making of additions to or alterations in entries on the registers. Where a proposed alteration merely limits the extent of, or the right of a proprietor with respect to a trade-mark, the comptroller may on the *ex parte* application of the proprietor make the alteration (*m*).

Sheffield registry.

By sect. 81 provision is made for the establishment of a Sheffield Register, in which register are to be entered the trade-marks in respect of cutlery, edge tools, and other goods belonging to persons carrying on business in Hallamshire or within six miles thereof, together with certain other trade-marks mentioned (sub-sect. 2).

Limit of time for proceeding with application.

63. Where registration of a trade-mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part

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(*k*) *Re Whiteley*, 29 W. R. 235, n.; 43 L. T. 626.

(*l*) *Re Sykes*, 29 W. R. 235; 43 L. T. 626.

(*m*) *Keep's Trade-Mark*, 26 Ch. D. 187; 32 W. R. 427.

of the applicant, the application shall be deemed to be abandoned.

This provision would appear to be imperative (n).

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

Conditions of registration of trade-mark.

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

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

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

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

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

See sects. 65-7, 73, 86.

Trade-marks.

There are two distinct classes of devices, signs, symbols, designations, or descriptions—*indicia* is, perhaps, the widest expression applicable—which are used in connection with articles the subjects of commerce, namely (a) trade-marks proper, and (b) those other *indicia* of the nature, quality, class, or description of goods which

Trade names.

(*n*) See Trade-Marks Rules 52, as to enlarging time.

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S. 64.

are not trade-marks proper, and to which, for want of some other better general designation, the term "trade-name" may be applied.

TRADE-MARKS PROPER.

Trade-marks proper.

Whatever may have been the intention of the Legislature in passing the Trade Marks Acts as to registration, it has not been actually enacted, and therefore it is not absolutely necessary that, in order that any particular symbol, mark, name, or device, or the like, may be a true trade-mark entitled to the protection of law, it should be registered, or even be capable of registration.

Sect. 77 of this statute discriminates between trade-marks "capable of being registered under this Act" and "other trade-marks in use before the 13th August, 1875," that is to say, trade-marks incapable of registration (*o*); and it provides that, with respect to actions for infringement in the case of the former class of marks, registration shall be an essential preliminary; in the case of the latter, a refusal to register shall be essential.

Trade-marks which are capable of registration are conveniently arranged in two great classes, namely (a) "old marks" which are any trade-marks in use before the 13th August, 1875, but which for the purposes of the Act are limited to "any special and descriptive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade-mark before the 13th August, 1875;" and (b) "new marks," namely, those which were not in use at such date, and which must consequently come within the description set forth in sub-sects. 1 and 2 of sect. 64.

"Old marks."

The essential requisites of "old marks" are that the word, letter, figure, or combination claimed (1) should be "special and distinctive" (*p*); and (2) should been actually used as a trade-mark prior to the 13th August, 1875.

User.

Such user involves two essentials: (1) that the trade-mark should have been actually applied to a commercial commodity (*q*); and

(*o*) *Semble*, there is a third class of trade-marks, viz., trade-marks which were not in use before the 13th August, 1875, and yet are not capable of registration. In other words, trade-marks are divisible into (a) capable, (b) incapable of registration, and the latter are again divisible into (1) old, and (2) new marks.

(*p*) In *Anderson's Trade-Mark*, 26 Ch. D. 409; 32 W. R. 667, Chitty, J., held that a portrait of Baron Liebig was not a sufficiently "distinctive device" within sect. 10 of the Trade Marks Act, 1875, to be entitled to registration *per se*.

(*q*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561.

(2) that it should have been so used in connection with such commodities as to have become known in the trade as solely applied to and indicative of such commodities (*r*).

With regard to the public user or knowledge of the trade-mark, or the length of time that it must have been used, Lord Cranworth, L.C., thus expressed himself in *Seixo* v. *Provezende* (*s*): "The principle on which relief is given in these cases is that one man cannot offer his goods for sale, representing them to be the manufacture of a rival trader. Supposing the rival to have obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods or from the higher price which the public are willing to give for them, rather than for the goods of other manufacturers whose reputation is not so high. Where, therefore, a manufacturer has been in the habit of stamping the goods which he has manufactured with a particular mark or brand, so that thereby persons purchasing goods of that description know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp."

There are, however, expressions in other judgments, more particularly in recent cases, which apparently imply that the mere fact that a person adopts a particular trade-mark is sufficient without more to entitle him to the benefit thereof as a trade-mark (*t*).

But this question, so far as it relates to true trade-marks, can now be of comparatively small importance, since it can affect only old trade-marks, and to these only in so far as it concerns the question whether or not any particular mark should be registered. As regards registered trade-marks, the fact of registration is by sect. 75 "equivalent to public use."

Requisites of Trade-Marks.—With regard to the general requisites of trade-marks, it is clearly settled that there cannot be claimed as valid trade-marks any words of the following classes, namely:

(a) Words which are merely descriptive of the quality of articles, such as "nourishing," applied to stout (*u*).

(b) Words which simply describe or identify a particular article

General requisites.

(*r*) *Millington* v. *Fox*, 3 My. & Cr. 338; *McAndrew* v. *Bassett*, *ubi supra*.

(*s*) L. R. 1 Ch. 192, 195.

(*t*) See per Hall, V.C., in *Cope* v. *Evans*, L. R. 18 Eq. 138, 143-4.

(*u*) *Raggett* v. *Findlater*, L. R. 17 Eq. 29. Compare *Siegert* v. *Findlater*, 7 Ch. D. 801, as to "Angostura Bitters"; *Young* v. *Macrae*, 9 Jur. N. S. 322, as to "Paraffine" Oil.

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as being that article and nothing more, and do not state or suggest that the particular article marked is an article manufactured or sold by a particular manufacturer or dealer, such as "Cheavin's Patent Filter," applied to water filters (*x*); "linoleum," applied to floor-cloth (*y*); "Singer," applied to sewing machines (*z*); "braided fixed stars," applied to matches (*a*); "Liebig's Extract of Meat," as applied to meat extract (*b*).

Trade-marks proper.

Under this head will come those cases where a patentee has

General requisites.

during the existence of his patent, applied a particular name or description to the articles the subject of the patent, and by reason thereof, the articles have come to be known by such name or description. At the expiration of the patent the patentee will not be entitled to claim this name or description as a trade-mark (*c*). "I do not mean to say that a manufacturer of a patented article cannot have a trade-mark not descriptive of the patented article, so as to be entitled to the exclusive use of that mark after the patent has expired; for instance, if he impressed on the patented articles a griffin or some other device; but if his only trade-mark is a word or set of words, descriptive of the patented article of which he is the only maker, it appears to me to be impossible for him ever to make out as a matter of fact that this mark denotes him as the maker as distinguished from other makers" (*d*).

A case illustrative of this principle is *J. B. Palmer's Trade-Mark* (*e*). The facts were these:—Palmer, in 1876, registered "braided fixed stars" as a trade-mark for matches, alleging that he had used it as a trade-mark before the passing of the Act of 1875, and at the same time he registered a label enveloping the boxes in which his matches were sold, which contained the words "braided fixed stars" in two places, so as to be conspicuous on each side of the boxes, but also contained a number of other words. It was shewn that at the time when Palmer introduced the term "braided fixed stars," the term "fixed stars" was known in the trade as denoting a particular class of fusees, and that he had just

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(*x*) *Cheavin* v. *Walker*, 5 Ch. D. C. A. 850. Compare *Maxim* v. *Thorley's Cattle Food Co.*, 14 Ch. D. C. A. 748; *Rose* v. *Evans*, 48 L. J. Ch. 618.

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

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

(*a*) *J. B. Palmer's Trade-Mark*, 24 Ch. D. C. A. 504.

(*b*) *Anderson's Trade-Mark*, 26 Ch. D. 409; 32 W. R. 677.

(*c*) See cases in last notes.

(*d*) Per Lindley, L.J., 24 Ch. D. C. A. 521.

(*e*) 24 Ch. D. C. A. 504.

bought a patent for enveloping the stems of fuses with wire by means of a braiding machine. This patent expired in August, 1881. It appeared from the evidence that Palmer had not before the Act used "braided fixed stars" separately as a trade-mark, or otherwise than as a part of the above-mentioned label. In October, 1881, an application was made by a rival trader to expunge the registration. It was held by the Court of Appeal that the registration must be expunged (a) because, to entitle Palmer to register these words as a trade-mark, he must, before the Act, have used them as such alone, and not merely in conjunction with other words; and (b) because, even if they had been so used alone, they ought not to have been registered, for that they were only words properly descriptive of the patented article, and Palmer had no exclusive right to their use after the patent had expired.

(c) Words which were originally descriptive, whether as being the name of the maker or otherwise, of particular articles as being manufactured or made by a particular person or house (*f*), but which have passed into common use and indicate only the articles themselves and have ceased to refer to the original or any particular makers thereof. "There is no doubt, I think, that a word which was originally a trade-mark, to the exclusive use of which a particular trader, or his successors in trade, may have been entitled, may subsequently become publici juris, as in the case which has been cited of Harvey's Sauce. It was admitted that, although that originally had been the name of a sauce made by a particular individual, it had become publici juris, and that all the world were entitled to call the sauce they made Harvey's Sauce if they pleased. Then what is the test by which a decision is to be arrived at whether a word which was originally a trade-mark has become publici juris? I think the test must be, whether the use of it by other persons is still calculated to deceive the public, whether it may still have the effect of inducing the public to buy goods not made by the original owner of the trade-mark as if they were his goods. If the mark has come to be so public and in such universal use that nobody can be deceived by the use of it, and can be induced from the use of it to believe that he is buying the goods of the original trader, it appears to me, however hard to some extent it may appear on the trader, yet practically, as the right to a trade-mark is simply a right to prevent the trader from

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(*f*) And being therefore, of course, originally good trade-marks, *Ransome* v. *Graham*, 51 L. J. Ch. 894; 47 L. T. 218.

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being cheated by other persons' goods being sold as his goods through the fraudulent use of the trade-mark, the right to the trade-mark must be gone" (*g*).

(d) Words which, however descriptive of the articles themselves, do not in any manner identify the manufacturer or maker thereof. Such as "prize medal" (*h*).

Trade-marks proper.

(e) Words which themselves contain false statements of a kind to deceive the public, such as the word "patented" used, when there never was a patent or a patent has expired, in such a way as to imply the existence of an existing patent (*i*); and on analogous grounds registration has been refused of the word "royal" (*k*), and of the word "registered" (*l*).

General requisites.

Subject however to the qualifications above mentioned it is settled that trade-marks used as such prior to the 13th August, 1875, might have consisted, and if now registered may consist, of any words, names, marks, or other descriptions which serve to indicate the particular articles as being the production of particular houses of business. Names of persons, whether of the makers themselves or of other persons living or dead, or fictitious; names of localities and districts; fancy words or descriptions of every kind; devices, whether taken from existing or non-existing animals or objects, symbols, or marks of any kind; and initials, single letters, or numerals have all been adopted and recognised as perfectly good trade-marks.

Names of persons.

With regard to names of persons there is this observation to be made:—Every person is entitled to use his own name as a trade-mark or otherwise in connection with articles manufactured or sold by him. Consequently another person having the same

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(*g*) Per Mellish, L.J., in *Ford* v. *Foster*, L. R. 7 Ch. 611, 628. Compare *Lazenby* v. *White*, 41 L. J. Ch. 354.

(*h*) *Batty* v. *Hill*, 1 H. & M. 264. Registration was refused as to so much of a proposed mark as contained statements of price: *Steedman's Trade-Mark*, L. J. No. Cases, 1883, p. 83. See sect. 66.

(*i*) *Flavel* v. *Harrison*, 10 Hare, 467; *Leather Cloth Co.* v. *American Leather Cloth Co.*, 33 L. J. Ch. 199; 11 H. L. 523; *Cheavin* v. *Walker*, 5 Ch. D. C. A. 850, 863–5. But it is not every statement or suggestion of this kind which, even if not literally true, will disentitle the person using it to protection: *Marshall* v. *Ross*, L. R. 8 Eq. 651; 39 L. J. Ch. 225; *Read* v. *Richardson*, 45 L. T. 54.

(*k*) *Re Royal Baking Powder Co.* C. A. W. N. 1880, p. 49. See "Instructions to persons proposing to Register," *post*.

(*l*) *Meikle's Trade-Mark*, W. N. 1876, p. 248.

name and manufacturing or selling articles of the same description cannot restrain the other person from so using his own name (*m*).

Nevertheless the one person cannot so use and employ his own name upon or in connection with goods manufactured or sold by *himself* as to cause the public to believe that such goods are the production of the other person with the same name, and this applies equally whether the other person does or does not use his own name as a trade-mark or part of a trade-mark for his own goods (*n*).

New Marks.

These are all such as are claimed to be trade-marks entitled to registration, but which were not used prior to the 13th of August, 1875. That they may be registered they must contain one at least of the particulars mentioned in sub-section 1 of sect. 64, which particulars will be dealt with seriatim.

Names of persons.

(1.) A name of an individual or firm may be registered (*o*); but it must be "printed, impressed, or woven in some particular and distinctive manner."

This provision is to some extent a restriction, but the adoption of it gets rid of the difficulty which, as already pointed out (*p*), sometimes arose when persons bearing the same names dealt in the same commodities. A person cannot print, impress, or weave his name in the same manner as another has been accustomed to do except for the purposes of fraud (*q*).

Numerous cases have come before the Courts for decision where names have been used as trade-marks, sometimes the names of the litigants themselves (*r*), sometimes the names of persons who

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(*m*) *Burgess* v. *Burgess*, 3 D. G. M. & G. 896; *James* v. *James*, L. R. 13 Eq. 421.

(*n*) *Holloway* v. *Holloway*, 13 Beav. 209; *Fullwood* v. *Fullwood*, 9 Ch. D. 176.

(*o*) Whether this name may be that of some individual or firm other than the applicant, is perhaps doubtful, but it is submitted that such name, if it cannot be registered by virtue of the first clause of this sub-section, may be registered under the third clause of this section as being a "fancy word."

(*p*) Cases in notes *m* and *n*.

(*q*) See *Holloway* v. *Holloway*, 13 Beav. 209; *Stephens* v. *Peel*, 16 L. T. 145.

(*r*) *Taylor* v. *Taylor*, 23 L. J. Ch. 255; *Dent* v. *Turpin*, 2 J. & H. 139; *Collins Co.* v. *Brown*, 3 K. & J. 423; *Liebig's Extract of Meat Co.* v. *Hanbury*, 17 L. T. 298; *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; *Wheeler and Wilson Manufacturing Co.* v. *Shakspear*, 39 L. J. Ch. 36.

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originally were, but have ceased to be connected with the manufacture or sale of the articles in question (*s*), sometimes the names of persons, it may be altogether fictitious, who, if existent, never had the slightest connection with the manufacture or sale of the articles such as "Brougham," "Bismarck," &c., and such names may of course have added to them other additional words (*t*), or symbols (*u*).

Trade-marks proper.

(2.) "A written signature or copy of a written signature of the individual or firm applying for registration" (*x*).

New marks.

(3.) "A distinctive device (*y*), mark (*z*), brand (*a*), heading (*b*), label (*c*), ticket (*d*), or fancy word or words not in common use."

It was decided under the old Acts that a single word or combination of letters could not be registered as a new mark (*e*); but as the present Act provides that a fancy "word" not in common use may be registered, it follows that a single word, provided that it is a "fancy word," may be registered.

It will be noticed that the word "wrapper" is not specifically

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(*s*) *Dixon* v. *Fawcus*, 3 E. & E. 537; *Bury* v. *Bedford*, 33 L. J. Ch. 465.

(*t*) *Stephens* v. *Peel*, 16 L. T. 145; *Cheavin* v. *Walker*, 5 Ch. D. C. A. 850.

(*u*) *Ransome* v. *Bentall*, 3 L. J. Ch. 161; *Rodgers* v. *Nowill*, 5 C. B. 109; 3 D. G. M. & G. 614; *Farina* v. *Silverlock*, 6 D. G. M. & G. 214; 4 K. & J. 650.

(*x*) See *Farina* v. *Silverlock*, 6 D. G. M. & G. 214; 4 K. & J. 650; *Maignen's Application*, 28 W. R. 759.

(*y*) *Edelsten* v. *Edelsten*, 1 D. G. J. & S. 185; *Cartier* v. *Carlile*, 31 Beav. 292; *Bass* v. *Dorolser*, 19 L. T. N. S. 626; *Barrows' Trade-Marks*, 5 Ch. D. C. A. 353; *Re Dugdale*, 49 L. J. Ch. 503; *Mitchell* v. *Henry*, 15 Ch. D. C. A. 181; *Read* v. *Richardson*, 45 L. T. 54.

(*z*) *Beard* v. *Tanner*, 18 L. T. 746; *Standish* v. *Whitwell*, 14 W. R. 512; *Re Rotherham*, 14 Ch. D. C. A. 585; *Re Worthington*, 14 Ch. D. C. A. 8; *Re Robinson*, 29 W. R. 31; *Re Sykes*, 29 W. R. 235; *Re Whiteley*, 29 W. R. 235.

(*a*) *Welch* v. *Knott*, 4 K. & J. 747; *McAndrew* v. *Bassett*, 33 L. J. Ch. 561; *Seixo* v. *Provezende*, L. R. 1 Ch. 192; *Richards* v. *Williamson*, 22 W. R. 765; *Rose* v. *Loftus*, 47 L. J. Ch. 576; *Upmann* v. *Elkan*, L. R. 7 Ch. 130; *Moet* v. *Pickering*, 8 Ch. D. C. A. 372.

(*b*) *Harter* v. *Souvazoglu*, W. N. 1875, pp. 11, 101; *Mitchell* v. *Henry*, 15 Ch. D. C. A. 181; *Leonard* v. *Wells*, 26 Ch. D. C. A. 288.

(*c*) *Bass* v. *Dawber*, 19 L. T. 626; *Cocks* v. *Chandler*, L. R. 11 Eq. 446; *Cotton* v. *Gillard*, 44 L. J. Ch. 90; *Wotherspoon* v. *Currie*, L. R. 5 H. L. 508; *Hirsch* v. *Jonas*, 3 Ch. D. 584; *Re Farina*, 27 W. R. 450; *Singer Manufacturing Co.* v. *Wilson*, 3 App. Cas. 376.

(*d*) *Orr-Ewing* v. *Johnston*, 13 Ch. D. C. A. 434.

(*e*) *Ex p. Stephens*, 3 Ch. D. 659.

included in the above, but no doubt the Courts will, if necessary, hold it to be sui generis with "label" or "ticket" (*f*).

The above list is wider than the corresponding section of the Trade-marks Regulation Act, 1875, in including "brand," and also the sentence any "fancy word or words not in common use." Trade-marks of the latter description are very numerous, and questions relating to them have often come before the Courts for decision.

Trade-marks proper.

"Fancy words."

Thus the names of personages famous in history or having a transcient notoriety, or known only in romance, have often been adopted for trade-marks as being catch words likely to attract attention to the articles to which they are appended.

Other fancy words are those which have been coined as expressions to indicate more or less clearly the nature or characteristics of the articles to which they are applied, such as "Lacto Peptine" (*g*), "Chlorodyne" (*h*), "Paraffine Oil" (*i*), "Pyretic Saline" (*k*).

Another class of fancy words used for trade-marks closely allied to the latter are those of which: "Reading Sauce" (*l*), "Licensed Victualler's Relish" (*m*), "Kitchen Crystal Soap" (*n*), "Family Salve" (*o*), and similar words and expressions are examples.

In other cases fancy words and expressions in no way descriptive of or otherwise connected with the articles to which they are applied have been used. The whole law on this point and on fancy names used as trade-marks was fully discussed in *Ford* v. *Foster* (*p*), and in *Hirst* v. *Denham* (*q*), where a cloth manufacturer had used the words "Turin," "Sefton," "Leopold," "Liverpool," in connection with his cloth.

It is now quite settled that the place of origin of an article may be used as a trade mark. This holds equally whether the name be

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(*f*) See *Cocks* v. *Chandler*, *ubi supra*; and *Siegert* v. *Findlater*, 7 Ch. D. 801.

(*g*) *Carnrick* v. *Morson*, L. J. Notes of Cases, 1877, p. 71.

(*h*) *Browne* v. *Freeman*, 12 W. R. 305.

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

(*k*) *Lamplough* v. *Balmer*, W. N. 1867, p. 293. Compare "Valvoline," *Leonard* v. *Wells*, 26 Ch. D. C. A. 288.

(*l*) *Cocks* v. *Chandler*, L. R. 11 Eq. 446.

(*m*) *Cotton* v. *Gillard*, 44 L. J. Ch. 90.

(*n*) *Eastman's Trade-Mark*, W. N. 1880, p. 128.

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

(*p*) L. R. 7 Ch. 611, the "Eureka" Shirt Case, *ante*, pp. 123–4.

(*q*) L. R. 14 Eq. 542.

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S. 64.

Trade-marks proper.

that of the place where an article is manufactured, which article apart from such fact of manufacture has no necessary or other connection with such place as "Glenfield" Starch (*r*), or that of the place or district where the article grows naturally or is produced in its raw or natural state, as in the well-known cases of "Anatolia" liquorice (*s*), "Seixo" port (*t*), "Angostura" bitters (*u*), "Apollinaris" water (*x*).

Foreign words.

Words in foreign languages or characters have often been recognised as valid trade-marks, as in *Gout* v. *Aleploglu* (*y*), where the Turkish word "Pessendedc," "warranted," in connection with watches was used, and *Rotherham's Trade Marks* (*z*), where the word "Tod" in Arabic letters was used (*a*).

It was well settled, prior to the Act, that letters, whether initials of a person's name or not, might be trade-marks. They have usually been accompanied by other marks or symbols (*b*), but it does not seem that this is necessary (*c*).

The section (64) in consideration provides that there may be added to the particulars enumerated "any letters, words, or figures, or combination of letters, words, or of figures, or any of them." What may be the effect or import of this provision is not clear. There was a similar provision in the previous statute, which was discussed on various occasions but did not become the subject of judicial decision (*d*).

Old Marks.

Sub-sect. 3 of sect. 64 provides that "any special and distinctive word or word, letter, figure, or combination of letters or figures, or

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

(*s*) *McAndrew* v. *Bassett*, 33 L. J. Ch. 561.

(*t*) *Seixo* v. *Provezende*, L. R. 1 Ch. 192.

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

(*x*) *Apollinaris Co.* v. *Norrish*, 33 L. T. 242; *Radde* v. *Norman*, L. R. 14 Eq. 348. Compare *Braham* v. *Beachim*, 7 Ch. D. 848, the "*Radstock Collieries*" *Case*; *Wheeler* v. *Johnston*, L. R. 3 Ir. 284, as to the words "Cromne Springs."

(*y*) 6 Beav. 69, n.

(*z*) 14 Ch. D. C. A. 585.

(*a*) See Trade-Marks Rules, 15.

(*b*) *Crawshay* v. *Thompson*, 4 M. & G. 357; *Ransome* v. *Brettel*, 3 L. J. Ch. 161; *Kinahan* v. *Bolton*, 15 Ir. Ch. 75; *Cartier* v. *Carlile*, 31 Beav. 292; *Barrows' Trade-Marks*, 5 Ch. D. C. A. 353.

(*c*) See cases in last note, and *Motley* v. *Downman*, 3 My. & Cr. 1; *Millington* v. *Fox*, 3 My. & Cr. 338.

(*d*) See *Barrows' Trade-Marks*, 5 Ch. D. C. A. 353; *J. B. Palmer's Trade-Mark*, 24 Ch. D. C. A. 504.

of letters and figures used as a trade-mark before the 13th of August, 1875, may be registered" (*e*).

This section is expressed in wider language than the corresponding section under the Act of 1875, under which it was decided that a single letter could not be registered as an old mark (*f*).

The description of old marks which may be registered is extensive enough to comprise almost every variety of symbol which is composed of words, letters, or numerals (*g*); but it must be taken as subject to the restrictions and limitations mentioned on pages 121–124, *ante*.

As to what will amount to a sufficient user, see *ante*, page 121 and the cases there cited. The user must be in connection with some particular commodities. If not so used the mark claimed will not be valid, and if and so far as valid the mark will nevertheless be a new mark as to all other commodities (*h*).

TRADE NAMES.

Trade names include all the various designations which one trader uses in connection with his business to indicate the particular business, and that it belongs to himself, or that particular commodities are manufactured, sold or supplied by himself. He has no right of property in these designations (*i*). His only right is that rival traders shall not defraud him by adopting and using the same or similar designations in such a manner as to mislead persons dealing with them and to cause them to believe that they are dealing with or buying the commodities of the other trader (*k*).

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

Trade-Marks Rules 6, and Third Schedule.

(*e*) See *ante*, p. 120.

(*f*) *Re Mitchell*, 7 Ch. D. 36.

(*g*) "Figures," as here used means numerals, per Jessel, M.R., in *Ex parte Stephens*, 3 Ch. D. 659.

(*h*) *Re Jelley*, 46 L. T. 381; 51 L. J. Ch. 639.

(*i*) Not even in a person's own name merely as such and apart from user of it in connection with a trade or business: *Clark* v. *Freeman*, 11 Beav. 112; *Maxwell* v. *Hogg*, L. R. 2 Ch. 307; *Du Boulay* v. *Du Boulay*, L. R. 2 P. C. 430, 441.

(*k*) See *Isaacson* v. *Thompson*, 20 W. R. 196 ("Madame Elise"); *Lee* v. *Haley*, L. R. 5 Ch. 155 ("The Guinea Coal Co."); *Boulnois* v. *Peake*, 13 Ch. D. 513, n. ("Carriage Bazaar"); *Hookham* v. *Pottage*, L. R. 8 Ch. 91 ("Pottage from Hookham and Pottage"); *Merchant Banking Co. of London* v. *Merchants' Joint Stock Bank*, 9 C. D. 560; *Hendriks* v. *Montagu*, 17 Ch. D. C. A. 638.

A new mark may be registered in respect of some of the goods in a class though a similar old mark has been already registered for other goods in the same class if the goods are distinct (*l*).

Registration of a series of marks.

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

Trade-Marks Rules, 14 (*m*).

Trade-marks may be registered in any colour.

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

The former Acts did not provide for the registration of colours as such, and did not protect colour as such as part of a trade-mark (*n*).

This section allows the registration of the colour of a trade-mark and provides that such registration shall (subject to the provisions of the Act) (*o*), confer the exclusive right to use the mark in the registered "or any other colour" (*p*).

(*l*) *Re F. Braby & Co.*, 2 Ch. D. 224, 51 L. J. Ch. 637; *Re Jelley*, *ubi supra*.

(*m*) See *Brook's Trade-Marks*, 26 W. R. 791; *Barrows' Trade-Marks*, 5 Ch. D. C. A. 353.

(*n*) *Nuttall* v. *Vining*, 28 W. R. 330; *Worthington & Co.'s Trade-Mark*, 14 Ch. D. C. A. 8.

(*o*) Which probably means, among other things, subject to any conditions which may be imposed with respect to the colour of a particular trade-mark.

(*p*) Compare *Robinson's Trade-Mark*, 29 W. R. 31.

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

Trade-Marks Rules, 25-28.

Advertisement of application.

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

Opposition to registration.

(2.) Within two months after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

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

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

(*a*) Trade-Marks Rules, Second Schedule, Form F.
(*β*) See notes (*q*) and (*r*), page 132.
(*γ*) Trade-Marks Rules, 29.

PART IV. TRADE MARKS.

SS. 69, 70.

This section gives legislative effect to the practice as judicially laid down by the late Master of the Rolls in *Simpson, Davies, & Sons' Trade-Mark* (*q*).

A case does not "stand for the determination of the Court" until the security for costs has been given, and consequently the Court has jurisdiction to give only such costs as have been incurred since such date (*r*).

Assignment and transmission of trade-mark.

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

Trade-Mark Rules. 34–36.

This provision prevents the right to a trade-mark existing "in gross," that is apart from the goods themselves to which it applied, or the business in connection therewith (*s*).

This principle was well established prior to the present Act (*t*).

Upon the formation of a partnership with a person entitled to the benefit of a trade-mark the mark in the absence of express provisions in relation to it becomes an asset of the partnership (*u*). To the same effect was the decision in *Condy* v. *Mitchell* (*x*). The plaintiff, H. Bollman Condy, and the defendant Mitchell carried on business together under the style of "Bollman Condy & Co.," manufacturing and selling a disinfectant known as "Condy's Fluid."

(*q*) 15 Ch. D. 525, and cases there cited.

(*r*) *Brandreth's Trade-Mark*, 9 Ch. D. 618.

(*s*) In *Ralph's Trade-Mark, Ralph* v. *Taylor*, 25 Ch. D. 194, 32 W. R. 168, it was held that discontinuance of a business for one year and nine months determined the right to a trade-mark used in connection therewith. Compare *Mouson* v. *Boehm*, *post*, p. 133.

(*t*) *Shipwright* v. *Clements*, 19 W. R. 599; *Churton* v. *Douglas*, John. 174; *Hudson* v. *Osborne*, 39 L. J. Ch. 79; *Cotton* v. *Gillard*, 44 L. J. Ch. 90. Compare per Westbury, L.C., in *Leather Cloth Co.* v. *American Leather Cloth Co.*, 33 L. J. Ch. 199, and in *Hall* v. *Barrows*, 33 L. J. Ch. 204; per Page Wood, V.C., in *Ainsworth* v. *Walmsley*, L. R. 1 Eq. 518; and per Lord Blackburn in *Singer Manufacturing Co.* v. *Loog*, 8 App. Cas. 33.

(*u*) *Bury* v. *Bedford*, 4 D. G. J. & S. 352; 33 L. J. Ch. 465.

(*x*) 26 W. R. (C. A.) 269.

After dissolution of the partnership the plaintiff set up a business for the same purpose, under the name "H. Bollman Condy," and the defendant afterwards set up a similar business under the name of "The Condy's Fluid Company." The plaintiff sought to restrain the defendant from using the name of Condy in connection with the article which he sold as "Condy's Fluid." It was held that both the partners had an equal right to the use of the name "Condy's Fluid;" and that the plaintiff, to succeed, must shew fraud on the part of the defendant, such as to mislead the public into the belief that the article which he sold was in reality manufactured by the plaintiff.

Conflicting claims to registration.

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

Trade-Marks Rules, 41-3.

In *Benbow* v. *Low* (*y*), an outgoing partner entitled to use a mark belonging to the firm was allowed to register this mark though the continuing firm were already registered in respect of it.

In the case of *Mouson* v. *Boehm* (*z*) the facts were—A. had adopted a trade-mark in 1874; subsequently his business fell off, and in May, 1882, the existence of the mark was forgotten by him; in the year 1880, B., in perfect ignorance of his mark, adopted the same mark for the same goods, sold in the same market; in August, 1880, B. registered his mark; in July, 1882, A. applied for registration of his mark; thereupon B. applied to restrain the user by A. of the mark, and A. applied to remove B.'s name from the register. It was held by Chitty, J., that A. was entitled to have his mark registered, and to have the register rectified by the removal of B.'s name.

Restrictions on registration.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors

(*y*) 29 W. R. 837; *Dent* v. *Turpin*, 2 J. & H. 139.
(*z*) 26 Ch. D. 398.

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of the same trade-mark, the comptroller shall not register in respect of the same goods or description of goods a trade-mark identical with one already on the register with respect to such goods or description of goods.

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

Co-proprietors.

Two or more persons may be entitled to, and may therefore be entitled to be registered as proprietors of (*a*) the same trade, but in the case of old marks, sub-sect. 3 of sect. 74 imposes a limit of three.

In questions arising under this section the Court will have regard only to marks which are actually on the register (*b*).

There have been various cases where the Court has refused registration, or has ordered the removal of a registered mark, on the ground that the mark proposed to be, or already registered, was so similar to another previously registered mark as to be calculated to deceive (*c*).

Evidence as to similarity.

In determining whether or not two marks are so similar as to be calculated to deceive, expert evidence will, when necessary, be used and allowed to have weight (*d*), but, *semble*, the Court will not be guided simply by the evidence of witnesses, but will itself look at and compare the marks and draw its own conclusion from such comparison (*e*). "In each case the device or label, registration of which is applied for, must be looked at as a whole; and if it appears to be such as in the ordinary course of business would

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(*a*) See cases in last three notes.

(*b*) *Re Dugdale's Application*, 49 L. J. Ch. 303.

(*c*) Compare *Re Farina*, 26 W R. 261; *Re Maignan's Application*, 28 W. R. 759; *Robinson's Trade-Mark*, 29 W. R. 31; and *Re F. Braby & Co.*, 21 Ch. D. 223, in each of which registration was allowed with *Re Farina* (No. 2), 27 W. R. 456, and *Worthington & Co.'s Trade-Mark*, 14 Ch. D. C. A. 8, where registration was refused.

(*d*) *Mitchell* v. *Henry*, 15 Ch. D. C. A. 181; 43 L. T. 186.

(*e*) Per Jessel, M.R., in the last case, and in *Re Jelley*, 46 L. T. 381; 51 L. J. Ch. 639.

be distinguished from other devices or labels, it should be registered" (*f*).

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

Further restriction on registration.

Compare sect. 86.

The last section applies to a trade-mark as a whole. This section applies only to words part of, or used in combination with, and provides that such words are not to be registered, if,

(a) Calculated to deceive;

(b) "Otherwise" on any other ground disentitled to protection in a court of justice.

Trade-marks may be "calculated to deceive" in either of two ways,—

(a) By their resemblance to other trade-marks already in use and, if subject to this Act, registered (*g*).

(b) By containing statements or representations which are wilfully untrue or are of a kind "calculated to deceive" the public generally (*h*).

The chief grounds upon which (in addition to similarity to existing trade-marks) registration will be refused are set forth, *ante*, pages 120–124.

The concluding sentence of the above section applies in terms only to designs; but, of course, a trade-mark in whole or part scandalous or offensive would be "disentitled to protection in a court of justice;" and moreover, sect. 86 expressly provides that no trade-mark is to be registered the use of which would be contrary to law or morality.

(*f*) Per Hall, V.C., in *Orr-Ewing's Trade-Marks*, 8 Ch. D. 794, 798. See per Earl Cairns, L.C., in 4 App. Cas. 484. Compare *Mouson* v. *Boehm*, *ante*, p. 133.

(*g*) See *ante*, pp. 120–121.

(*h*) See *ante*, p. 124, and compare *Estcourt* v. *Estcourt Hop Essence Co.*, L. R. 10 Ch. 276.

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

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

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

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

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

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

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

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

this section, be deemed common to the trade in such goods.

See sects. 91 and 92 as to the power of the comptroller to make clerical alterations in entries and to cancel entries on the register.

This section will probably give rise to considerable doubt and litigation. It must be read in connection with sects. 62, 64, and 72. Whatever may be the exact effect of some of its provisions, this seems clear:—

(a) That it applies, not to trade-marks as such, but only to "additions" to trade-marks.

(b) That the "additions" are of two classes or descriptions: (1) *such as may be added to old trade-marks, and* (2) such as may be added to new trade-marks, these latter being limited to a "distinctive word or combination of words."

(c) That the additions must in each case be "common to the trade," which expression is not defined in the case of new marks, but is defined with respect to old marks as "public user by more than three persons on the same or a similar description of goods."

It is submitted that this section in no way affects the ownership of "common" trade-marks, but merely declares the conditions and limitations subject to and within which such marks may be registered.

Effect of Registration.

Registration equivalent to public use.

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

As to what amounts to "public use," see *ante*, pp. 120-121.

Right of first proprietor to exclusive use of trade-mark.

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

Effect of registration.

In *Re J. B. Palmer's Application* (*i*) it was held by the Court of

(*i*) 21 Ch. D. C. A. 47.

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Appeal, on an application to rectify the register by striking out a mark which had been registered more than five years, that the registered proprietor had not thereby acquired an absolute right, and that, consequently, evidence was to be received (*k*) to show whether or not the mark was valid.

In this case the question was raised but not decided (*l*), whether or not, in the case of a mark registered for more than five years, a person sued for infringement can defend himself by shewing that the alleged trade-mark is invalid.

Restrictions on actions for infringement, and on defence to action in certain cases.

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

Trade-Marks Rules, Second Schedule, Form L.

PRINCIPLES AS TO INFRINGEMENT.

Infringement.

The principles of law applicable to the various cases coming within the two classes of "trade-marks" and "trade-names" were originally, and are even now, primarily based upon the same general principle of fraud and deceit—that a person shall not, directly or indirectly represent, so as to cause the public to believe that particular commodities sold by himself are manufactured or produced by, or are the same as commodities manufactured or produced by some other person.

There is, however, a radical distinction between trade-marks and trade-names as to the nature of the rights belonging to proprietors

(*k*) Which was afterwards done, and the register rectified, 24 Ch. D. C. A. 504.

(*l*) See per Jessel, M.R., 21 Ch. D. 59, 60.

of the one and the other. The rights possessed by proprietors of trade-marks are rights of property—the rights possessed by those who have used trade-names are merely that they shall not be defrauded by persons improperly using the same or similar trade-names.

This distinction draws with it important consequences in considering the practical application of the principles of law relating to the two classes of rights in cases of infringement, and it must be admitted that the distinction has not always been clearly kept in view and expressed in the various judgments in connection with infringement.

"There are two distinct things known to us in dealing with these cases; that is to say, in the first place, there is the imitation of a trade-mark proper, which is different from other modes of false representation; and, secondly, there is the false representation, by which a man induces the public to believe that the goods which he is selling are the goods of another person—that is to say, he is passing off his goods as the goods of another person. But fraud is the essence in both cases." These were the expressions of James, L.J., in one of the well-known "Singer" sewing machine cases (*m*).

To the same effect is the language of Lord Chelmsford in *Wotherspoon* v. *Currie* (*n*): "When the principle is ascertained upon which the question of piracy of trade-marks is to be determined, each case must be considered upon the facts, whether they do or do not bring it within that principle. Where the trade-mark is not actually copied, fraud is a necessary element in the consideration of every question of this description—that is, the party accused of piracy must be proved to have done the act complained of with the fraudulent design of passing off his own goods as those of the party entitled to the exclusive use of the trade-mark. For the purpose of establishing a case of infringement it is not necessary to shew that there has been the use of a mark in all respects corresponding with that which another person has acquired an exclusive right to use, if the resemblance is such as, not only to shew an intention to deceive, but also such as to be likely to make unwary purchasers suppose that they are purchasing the article sold by the party to whom the right to use the trade-mark belongs."

It is submitted however that in the judgments above cited the

(*m*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. C. A. 434, 451.
(*n*) L. R. 5 H. L. 508, 519.

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learned Judges expressed themselves too strongly in laying down explicitly that fraud or deceit as such, that is actual or intentional fraud or deceit on the part of the defendant, is essential in order to entitle a plaintiff to succeed in an action for infringement of trade-mark. The law is thus stated by Cairns, L.C., in the same case of "*Singer*" *Machine Manufacturers* v. *Wilson* (*o*): "That there have been many cases in which a trade-mark has been used, not merely improperly but fraudulently, and that this fraudulent use has often been adverted to and made the ground of decision I do not doubt; but I wish to state in the most distinct manner that, in my opinion, fraud is not necessary to be averred or proved in order to obtain protection for a trade-mark. The argument that fraud must be proved assumes that the trade-mark of the plaintiffs has been adopted and used by the defendant, but contends that this use of it is to continue without restraint, even after the improper use has been pointed out, merely because, in the first instance, it took place ignorantly or inadvertently. This argument appears to me to be founded on a misapprehension. A man may take the trade-mark of another ignorantly, not knowing it was the trade-mark of the other; or he may take it in the belief, mistaken but sincerely entertained, that in the manner in which he is taking it he is within the law, and doing nothing which the law forbids; or he may take it knowing it is the trade-mark of his neighbour, and intending and desiring to injure his neighbour by so doing. But in all these cases it is the same act that is done, and in all these cases the injury to the plaintiff is just the same. The action of the Court must depend upon the right of the plaintiff, and the injury done to that right. What the motive of the defendant may be, the Court has very imperfect means of knowing. If he was ignorant of the plaintiff's rights in the first instance, he is, as soon as he becomes acquainted with them and perseveres in infringing upon them, as culpable as if he had originally known them. I have never known any serious doubt entertained on this subject since the case of *Millington* v. *Fox* (*p*), and I may refer to the observations of Lord Hatherley, when Vice-Chancellor, in the case of *Welch* v. *Knott* (*q*): 'That the defendant would not be entitled to use the plaintiff's bottles in such a manner as in fact to mislead the public, although there might be no intention on his part to mislead, is clear.' In *Millington* v. *Fox*, Lord Cottenham felt

(*o*) 3 App. Cas. 391-2. (*p*) 3 My. & Cr. 338.
(*q*) 4 K. & J. 747.

satisfied that in using the plaintiff's trade-marks the defendants had no intention to mislead the public; yet inasmuch as the public were in fact misled, he held that the plaintiffs were entitled to a perpetual injunction. It was not sufficient for the defendants to say that they used the marks in ignorance of their being the plaintiffs' trade-marks. How far that doctrine is capable of being reconciled with cases at law in which the scienter has been held to be essential in order to enable the plaintiff to recover (that is, to recover damages) it is not material to consider. In this Court the rule is clear, as laid down in *Millington* v. *Fox*."

It is therefore submitted as the true deduction from all the decisions that in a trade-mark proper there is a species of property so that the person entitled to the trade-mark can say to all the world, that no one shall put such trade-mark upon goods of the same description as those in connection with which it is used by the owner thereof, and that there is no necessity to prove actual fraud or intention to deceive, and consequently that the person who, however innocently, infringes a trade-mark is as much responsible as the person who does so wilfully.

The question whether or not actual fraud or deceit is necessary to support an action for infringement of trade-mark is of course highly important for two, amongst many other good reasons (*r*), viz., (a) that actual fraud being unnecessary, proof of the fact of infringement will suffice, and (b) that in many cases it would be difficult, if not impossible, to establish actual fraud or deceit if the defendant himself stoutly averred want of knowledge of the plaintiff's rights, or that he acted in *bona fides*. "The plaintiffs judged it necessary to proceed without waiting till actual deceit was proved, and I think they judged rightly" (*s*).

What constitutes infringement.

As to what will amount to an infringement of a trade-mark entitling the proprietor to sue—if the mark is actually copied, the

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(*r*) In addition to the question by whom the costs of an action are to be borne.

(*s*) Per Lord Blackburn, 7 App. Cas. 229. Some of the decisions on the subject of costs also go to establish the proposition that in actions for infringement of trade-mark, it is not necessary to prove actual fraud. Thus in *Upmann* v. *Forester*, 24 Ch. D. 231, it was held by Chitty, J., that the defendant who had, in fact, infringed a trade-mark, but had been altogether faultless of any intention to infringe, and had at once submitted to the plaintiff's demand, must, nevertheless, pay the costs of the action. *Quære*, whether this decision is correct: see *Betts* v. *Wilmott*, 18 W. R. 946.

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matter is clear, the proprietor is entitled to relief as of course. If, however, the mark itself is not copied, but portions of it are copied, or another mark resembling it is used, then the question is one of fact—whether what is complained of is likely to cause persons, dealing in the market to which the commodities are sent, to mistake the goods stamped with the objectionable trade-mark for the goods of the owner of the mark which has been copied.

The leading case upon this question is *Orr-Ewing & Co.* v. *Johnston & Co.* (*t*), where it was decided by all the Courts up to the House of Lords—

(1.) That if one trader appropriates a material and substantial part of a trade-mark which belongs to another trader, he is bound to use such precautions as to avoid the reasonable probability of error and deception, and the onus is on him to shew that purchasers of the goods will not be deceived.

(2.) That if the goods of a trader have acquired in the market a name derived from a part of the trade-mark which he affixes to them, a rival trader is not entitled to use a ticket which is likely to lead to the application of the same name to his goods, even though that name is not the only name by which the goods of the first trader have been known, or though it has been always used in conjunction with some other words.

(3.) That where a trader has a right to a trade-mark on goods sold in a foreign market, an injunction will be granted to restrain the export of goods under another trade-mark which may deceive the ultimate purchasers, although it would not deceive Englishmen or the dealers in the foreign market.

And an injunction against the use of trade-mark by the defendant was made general, although the plaintiff had never used his trade-mark, except in the Indian market.

Similarity.

No precise rule can be enunciated as to what amount of similarity will or will not constitute infringement. It is a question of degree, having regard to all the circumstances, and especially to the persons likely to deal in the goods, and to be deceived by the objectionable mark. It has however been laid down in numerous cases that a mark may be an infringement of an existing mark, although it differs so much from it that when the two are placed side by side no one would be deceived (*u*).

(*t*) 13 Ch. D. C. A. 434, 7 App. Cas. 219.

(*u*) See last case; and *Seixo* v. *Provezende*, L. R. 1 Ch. 192.

TRADE NAMES.

What are the principles to be adopted in considering infringements of trade names? Is it necessary to prove actual intentional fraud or deceit? Or will it suffice merely to shew that the defendant has in fact used a "trade name"—whether name, device, symbol, or other representation—of such a kind and under such circumstances as that the user is likely to lead to mistakes and consequent deception? And if so, is it sufficient to shew that the user will probably cause persons to mistake goods associated with it for the goods of another person, or must it be shewn that the user has actually caused such mistakes? The decisions seem to establish that actual intentional fraud or deceit is necessary to entitle the plaintiff to succeed. "But when it is not a case pure and simple of trade-mark, it must, as I have always understood the law, depend upon actual fraud; that is, the defendant must be shewn to have said or done something which, as between himself and the person with whom he was dealing, amounted to a fraudulent representation that his goods were the goods of the person who is complaining of his act or word. Actual fraud must be proved." This is so laid down by James, L.J. (*x*), and holds without qualification in respect of trade names and all other similar rights not being true trade-marks.

If, however, it is necessary to prove actual fraud to support an action, it seems clear that this would be sufficiently proved by shewing that the defendant continued to use the objectionable mark after his attention had been called to the similarity between it and the one used by the plaintiff (*y*).

As with true trade-marks so with trade names and the like, it is not possible to formulate rules as to what will constitute an improper user. There must not be such a user as will deceive reasonable persons. But, subject to this, a person may, in order to get a market for his own commodities, utilise the credit already obtained by a rival in the same line of business. Thus a trader has a right to make and sell machines similar in form and construction to those made and sold by a rival trader, and in describing and advertising his own machines to refer to his rival's machines and his rival's name, provided he does this in such a way as to obviate any reasonable possibility of misunderstanding or deception (*z*).

(*x*) *Singer Manufacturing Co.* v. *Wilson*, 2 Ch. D. C. A. 452.

(*y*) See per Fry, J., in *Barnett* v. *Tak*, 45 L. T. 743, and per Kay, J., in *Hill* v. *Hart-Davies*, 21 Ch. D. 798; 51 L. J. Ch. 845.

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

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QUASI TRADE-MARKS.

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This section in consideration divides trade-marks into two classes: (a) those which are "capable of being registered under this Act;" (b) "any other trade-marks in use before the 13th of August, 1875," *i.e.* old marks not capable of being registered.

Trade-marks—that is to say marks, symbols, &c., in the nature of trade-marks, "quasi" trade-marks—which are not within these two classes (*a*) are not within such protection as is afforded by the Act. Consequently if the above section be read strictly and if these quasi trade-marks are held to be true trade-marks within the meaning of this section, it seems necessarily to follow that no action whatever can be brought in respect of infringements of them. But as the Courts will interfere by injunction to restrain persons from using in connection with commercial commodities, names, devices, labels, and the like of such appearance or descriptions as to cause others dealing with them to think that such commodities are in reality the production of manufactures and others who in fact have not produced them (*b*), it is submitted that *à fortiori* in the case of marks which have all the characteristics of true trade-marks but cannot be registered, the fraudulent user of them will upon the same grounds be restrained. If not the persons who have hitherto used such marks will, for the protection of themselves and their customers, have to drop the user of them and communicate such disuse, not only to their own customers but also to the general public.

Register of Trade-Marks.

Register of trade-marks.

78. There shall be kept at the Patent Office a book called the Register of Trade-Marks, wherein shall be entered the names and addresses of proprietors of registered trade-marks, notifications of assignments and of transmissions of trade-marks, and such other matters as may be from time to time prescribed.

Trade-Marks Rules, 30–48.
See sects. 81 and 87.

(*a*) See *ante*, p. 120.

(*b*) See *ante*, pp. 139–142.

S. 79.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade-mark, the comptroller shall send notice to the registered proprietor that the trade-mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

Removal of trade-mark after fourteen years unless fee paid.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee, together with the additional prescribed fee, the comptroller may without removing such trade-mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade-mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade-mark to the register on payment of the prescribed additional fee.

(5.) Where a trade-mark has been removed from the register for non-payment of the fee or otherwise, such trade-mark shall nevertheless for the purpose of any application for registration during the five years next after

the date of such removal, be deemed to be a trade-mark which is already registered.

Trade-Marks Rules, 7, 45, 48.

Fees.

Fees for registration, &c.

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

Trade-Marks Rules, First Schedule.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade-marks (in this Act called the Sheffield register):

(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade-marks entered before the commencement of this Act in respect of cutlery, edge-tools, or raw steel and such goods in the register established under

the Trade-Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade-marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade-Marks Registration Act, 1875.

(3.) An application for registration of a trade-mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (*a*):

(4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court.

(6.) Upon the registration of a trade-mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade-marks;

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and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day:

(7.) The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade-marks, the effect of such registration, and the assignment and transmission of rights in a registered trade-mark shall apply in the case of applications and registration in the Sheffield register (β); and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register:

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade-mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade-marks, and thereupon all marks entered therein shall, unless

entered in the Sheffield register, be deemed to have been abandoned.

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade-marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade-mark or trade-marks (γ).

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court (δ):

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.

(α) Trade-Marks Rules, 53–55.
(β) Ibid. 56.
(γ) See *Bury* v. *Bedford*, 4 D. G. J. & S. 352.
(δ) Trade-Marks Rules, Third Schedule, Form W.

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Patent Office and Proceedings thereat.

SS. 82, 83.

Patent Office.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade-marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the Comptroller General of Patents, Designs, and Trade-marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade-marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

Refusal to grant patent, &c. in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade-mark, of which the use would, in his opinion, be contrary to law or morality.

See section 73.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade-mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade-mark, in the register of patents, designs, or trade-marks, as the case may be (*a*). The person for the time being entered in the register of patents, designs, or trade-marks, as proprietor of a patent, copyright in a design or trade-mark as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the

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same and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade-mark may be enforced in like manner as in respect of any other personal property.

(a) Patent Rules, 65-70; Designs Rules, 22-28; Trade-Marks Rules, 34-39.

See secs. 36 and 70.

As to the rights of co-owners and licensees of, and the power to assign shares and interests in patents, designs and trade-marks: see *ante*, pp. 5-7.

Whether registration is necessary in order to entitle an assignee of a patent, design or trade-mark capable of registration to sue for infringement is doubtful. In *Chollet* v. *Hoffman* (c), it was held that an assignee of a patent could not sue a third party for infringement until he had registered his assignment. But in *Hassall* v. *Wright* (d), it was held that an assignee could prior to registering his assignment, sue his assignor and licensees from the assignor who had become so after and with notice of the assignments to restrain infringements by them (e).

Where a patentee assigned his patent and the assignees did not at once register, and subsequently the patentee purported again to assign it and the latter assignment was forthwith registered, the Court on the application of the first assignees ordered the register to be rectified by expunging from it the second assignment with costs to be paid by the second assignee (f).

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any

(c) 7 E. & B. 636.

(d) Law Rep. 10 Eq. 510.

(e) As to the position of executors of patentees or of owners of designs, see *Ellwood* v. *Christy*, 17 C. B. N. S. 754; 10 Jur. N. S. 1079; *Jewitt* v. *Eckhardt*, 17 Ch. D. 404. As to trustees in bankruptcy, see *Bloxam* v. *Elsee*, 6 B. & C. 169.

(f) *Green's Patent*, 24 Beav. 145.

person requiring the same on payment of the prescribed fee.

Patents Rules, 75; Designs Rules, 33; Trade-Marks Rules, 49.
See sects. 52 and 53.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

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

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

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

(a) Trade-Marks Rules, 44–48.
See also Patents Rules, 71.

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Rectification of registers.

The power of the Court to rectify the register is unqualified, and its operation is limited only by the need of the circumstances giving it jurisdiction. These are that there must be either (a) the omission without sufficient cause of the "name of any person," or (b) some "entry" made without sufficient cause in the registry, and that the Court is put in motion by "some person aggrieved" thereby.

It will be noticed that a person may be aggrieved by "any entry," *i.e.* not limited to the entry of the name of some person, whereas the grievance in the case of an omission must be by the omission of the name of a person.

Who may apply.

To determine what persons will be "aggrieved" within the meaning of this section so as to entitle them to apply to the Court, reference must be made to the various cases of applications to rectify, or opposition to enter upon the register. Speaking generally, a person will be held entitled to put the section in motion, if being in fact affected by omissions from or entries on the register he belongs to either of these classes, viz. (a) persons who as co-owners, transferees and the like have an actual interest in the matter registered or omitted (*g*), and (b) persons carrying on a trade in commodities affected by the matter registered (*h*).

In *Ralph's Trade-Mark*, *Ralph* v. *Taylor* (*i*), a licensee of a patent, the owner of which had registered a trade-mark in connection with the articles manufactured under the patent, was held to be a person "aggrieved," so as to be entitled to apply to rectify the register. In *Riviere's Trade-Mark* (*k*), the Court of Appeal held that it could not be laid down as a proposition of law, that a foreigner not carrying on business in England and not intending to do so, could by no possibility be aggrieved by the registration of a trade-mark in England.

The Patent Law Amendment Act, 1852, contained a sect. 38, having similar provisions and numerous applications took place under it, some of the more important of which have been reported (*l*).

The Trade Marks Regulation Act, 1875, also contained a sect. 5,

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(*g*) See cases cited on p. 155, *post*.

(*h*) See *Rose* v. *Evans*, 48 L. J. Ch. 618.

(*i*) 25 Ch. D. 194; 32 W. R. 168.

(*k*) 26 Ch. D. C. A. 48.

(*l*) See *Green's Patent*, 24 Beav. 145; *Morey's Patent*, 25 Beav. 581; *Horsley & Knighton's Patent*, L. R. 8 Eq. 475; *Berdan's Patent*, L. R. 20 Eq. 346.

with very similar provisions and several decisions arising on applications under it have been reported, which no doubt will be useful in future as shewing the construction to be placed on this section. Thus it was decided—

That the powers given to the Court by this section to rectify the register of trade-marks, are only exerciseable in cases where there has been some mistake or error in the registration, and not in cases where a change is desirable in consequence of a devolution of interest (*m*).

That where a trade-mark belonging to a firm has been registered in the name of one of the partners, described as trading under the firm name, the register of trade-marks will be ordered to be rectified by cancelling the name of the registered proprietor, and inserting the names of all the co-partners trading under the firm name (*n*).

That where a trade-mark belonging to a firm has, by a mistake common to the firm, been applied for and registered in the name of one of the partners in the firm to the exclusion of the other partners, and without any mention of the firm's right to the mark, the proper course to take for obtaining the registration of the firm as proprietor of the trade-mark, is for the registered proprietor of the trade-mark or his legal personal representative to assign the trade-mark to the firm which is already entitled to the goodwill of the business with which the trade-mark has been used (*o*).

That where a person registers in his own name the trade-mark of another person, without the knowledge or consent of the true proprietor, the register of trade-marks cannot be rectified by transferring the registration into the name of the true proprietor (*p*).

That the register may be rectified not only by removing the whole of an entry objected to (*q*), but by striking out part of the entry or adding a note or qualification to it (*r*).

(*m*) *Re Ward*, 29 W. R. 395; 50 L. J. Ch. 347; 44 L. T. 97. In such case, *e.g.* devolution of interest by death, application should be made to the comptroller under sect. 87, but it is submitted that if he refused to act, the Court would in a proper case have jurisdiction under this, the 90th section.

(*n*) *Rust's Trade-Mark*, 29 W. R. 393, n.; 44 L. T. 98.

(*o*) *Farina's Trade-Mark*, 29 W. R. 391; 44 L. T. 99.

(*p*) *Marler's Trade-Mark*, 29 W. R. 392, n.; 44 L. T. 98.

(*q*) See cases in last notes.

(*r*) *Mitchell's Trade-Mark*, W. N. 1878, p. 101. Compare *Re Whiteley*, 29 W. R. 235; *Re Sykes*, *ibid.*

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A person may come to rectify the register not only after the advertisements have duly taken place (*s*), but even after the entry has been on the register for five years (*t*), provided that the delay is reasonably explained (*u*).

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee,—

(*a.*) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade-mark (*a*); or

(*b.*) Correct any clerical error in the name style or address of the registered proprietor of a patent, design, or trade-mark (*a*).

(*c.*) Cancel the entry or part of the entry of a trade-mark on the register (*β*). Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade-mark.

(*a*) Patents Rules, Form P; Designs Rules, Form M; Trade-Marks Rules, 45, and Forms M, Q.

(*β*) Trade-Marks Rules, O, P.

By rule 18 of the Patent Rules, 30 of the Designs Rules, and 51 of the Trade-Marks Rules, "any document for the amending of which no special provision is made by the Act may be amended," if and on such terms as the comptroller shall think fit.

Alteration of registered mark.

92. (1.) The registered proprietor of any registered trade-mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential

(*s*) *Hyde & Co.'s Trade-Mark*, 7 Ch. D. 724.

(*t*) *J. B. Palmer's Trade-Mark*, 24 Ch. D. C. A. 504.

(*u*) Last two cases, and *Ransome* v. *Graham*, 51 L. J. Ch. 894; and *Mouson* v. *Boehm*, 26 Ch. D. 398.

particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

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

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

(*a*) Trade-Marks Rules, 48, Second Schedule, Form N.

As to imposing "conditions" on registration, see sect. 47, sub-sect. 7, as to Designs, and sect. 62, sub-sect. 4, as to Trade-mark.

See sect. 74 as to entering on the register of "additions to any trade-mark."

Where an applicant for registration or a registered proprietor desires to limit the generality of a trade-mark (or design?) or otherwise to qualify his rights in respect thereof, the comptroller may on his request *ex parte*, insert on the register a note to this effect (*x*).

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor. **Falsification of entries in registers.**

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power **Exercise of discretionary power by comptroller.**

(*x*) *Keep's Trade-Mark*, 26 Ch. D. 187.

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adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade-mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Patent Rules, 11–13; Designs Rules, 13–15; Trade-Marks Rules, 17–19.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Patents Rules, Form Q; Designs Rules, 34, Form J: Trade-Marks Rules, 57, Form U.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act (*a*), may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post (*xa*).

(2.) In proving such service or sending, it shall be

(*xa*) See *Harris's Case*, L. R. 15 Eq. 18; and *Household Fire, &c., Insurance Co.* v. *Grant*, 4 Ex. D. 7 Ch. 587; *Wall's Case*, L. R.

sufficient to prove that the letter was properly addressed and put into the post (*xb*).

(a) Patents Rules, 19; Designs Rules, 12; Trade-Marks Rules, 16.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Provision as to days for leaving documents at office.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such in-

Declaration by infant, lunatic, &c.

216, deciding that the posting of a letter accepting a contract, such letter being duly addressed to the other party, is a sufficient acceptance of the offer, and binds the other side, although concurrently therewith or even previously thereto the offer had been withdrawn, and notwithstanding that such letter should be lost in the post.

(*xb*) See *Trotter* v. *Maclean*, 13 Ch. D. 574.

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capable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

101. (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a.*) For regulating the practice of registration under this Act:

(*b.*) For classifying goods for the purposes of designs and trade-marks:

(*c.*) For making or requiring duplicates of specifications, amendment, drawings, and other documents:

(*d.*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendment and other documents:

(*e.*) For securing and regulating the making, printing,

publishing and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f.*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies and institutions at home and abroad:

(*g.*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled,

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the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

See the several sets of rules, *post*.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade-marks.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade-marks, or any of them, then any person who has applied for protection for any invention, design, or trade-mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade-mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade-mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall

entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade-mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade-mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade-mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions,

Provision for colonies and India.

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designs, and trade-marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Compare the cases cited *ante*, p. 124. See also the Merchandise Marks Act, 1862, 25 & 26 Vict. c. 88.

Penalty on unauthorised assumption of Royal arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any

trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland; Ireland; &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "court of appeal" shall mean any court to which such action is appealed.

See sect. 28.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

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

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

See sect. 26.

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110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

Reservation of remedies in Ireland.

Compare sects. 16, 26, 36, and 111 (*y*).

General saving for jurisdiction of Courts,

111. (1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade-marks; and with reference to any such proceeding in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade-mark competent to those courts;

(*y*) See *Brown* v. *Annandale*, 1 Web. P. C. 433; and *Bovill* v. *Finch*, L. R. 5 C. P. 523, and cases there cited.

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings (*yy*).

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a.*) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade-mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b.*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect

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(*yy*) As to the effect of this section on existing patents, see *Re Brandon's Patent*, O. J. Rep. vol. i. p. 154.

PART V. GENERAL.

SS. 114, 115.

thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former registers to be deemed continued.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade-marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade-marks kept under this Act.

As to registers established by previous statutes: see the Patent Law Amendment Act, 1852, sect. 34 as to Register of Patents, and sect. 35 as to Register of Proprietors; 5 & 6 Vict. c. 160, sects. 14, 15 and 16 as to the Registry of ornamented Designs, and 6 & 7 Vict. c. 65, sects. 7, 8 and 9 as to the Registry of useful Designs; and the Trades Marks Regulation Act, 1875, sect. 1, as to the Register of Trade Marks.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

116. Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

Saving for prerogative.

General Definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

General definitions.

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller General of Patents, Designs, and Trade-Marks:

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

PART V. GENERAL. S. 117.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

FORM A.

FORM OF APPLICATION FOR PATENT.

FORM B.

FORM OF PROVISIONAL SPECIFICATION.

FORM C.

FORM OF COMPLETE SPECIFICATION.

For these Forms A, B, and C are now substituted the Forms A, A1, B, and C in the Second Schedule to the Patents Rules, *post*.

FORM D.

FORM OF PATENT.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

Whereas *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, hath by his solemn declaration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them,

referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

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

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantages from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor

thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our services all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this one thousand eight hundred and and to be sealed as of the one thousand eight hundred and

Seal of Patent Office.

FORM E.

FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

_____day of_____18 .

(*a*) Here insert legibly the name and address of the individual or firm.

You are hereby requested to register the accompanying_____ Design, in Class_____in the name of (*a*)
of
who claims to be the proprietor thereof, and to return the same to

Statement of nature of Design_____

Registration Fees enclosed £ „ *s.*

To the Comptroller,
Patent Office, 25, *Southampton Buildings, Chancery Lane, W.C.*

(Signed)_____

FORM F.

Section 62. FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size.)

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.)

(*a*) Here insert legibly the name, address, and business of the individual or firm.

You are hereby requested to register the accompanying trade mark [*In Class — Iron in bars, sheets, and plates; in Class — Steam engines and boilers; and in Class — Warming Apparatus*], in the name of (*a*) , who claims to be the proprietor thereof.

Registration Fees enclosed £ „ *s.*

To the Comptroller,
Patent Office, 25, *Southampton Buildings, Chancery Lane, W.C.*

(Signed)_____

Note.—If the trade-mark has been in use before the 13th of August, 1875, state length of use.

THE SECOND SCHEDULE.

Fees on instruments for obtaining Patents, and Renewal. Section 24.

(a.) Up to sealing.

	£	*s.*	*d.*	£	*s.*	*d.*
On application for provisional protection ..	1	0	0			
On filing complete specification	3	0	0			
				4	0	0
or						
On filing complete specification with first application ..				4	0	0

(b.) Further before end of four years from date of patent.

On certificate of renewal	50	0	0

(c.) Further before end of seven years, or in the case of patents granted after the commencement of this Act, before the end of eight years from date of patent.

On certificate of renewal	100	0	0

Or in lieu of the fees of £50 *and* £100 *the following annual fees:—*

Before the expiration of the fourth year from the date of the patent				10	0	0
„ „	fifth	„	„	10	0	0
„ „	sixth	„	„	10	0	0
„ „	seventh	„	„	10	0	0
„ „	eighth	„	„	15	0	0
„ „	ninth	„	„	15	0	0
„ „	tenth	„	„	20	0	0
„ „	eleventh	„	„	20	0	0
„ „	twelfth	„	„	20	0	0
„ „	thirteenth	„	„	20	0	0

With regard to the fees of £50 and £100 the following notice has been issued—The Board of Trade, with the consent of the Treasury, have made the following reduction relating to certain fees prescribed by the Second Schedule of the Patents, Designs, and Trade Marks Act, 1883. In the case of patents granted before the commencement of the said Act, the patentee who has paid the prescribed fee of £50, before the end of four years from the date of his patent, may, in lieu of the prescribed fee of £100 payable before the end of seven years from such date, pay the following annual fees:—Before the end of the seventh year from the date of the patent, £10; eighth year, £10; ninth year. £10; tenth year, £15; eleventh year, £15; twelfth year, £20; thirteenth year, 20. This reduction shall come into operation on the 1st day of August, 1884.

THE THIRD SCHEDULE.

Enactments repealed.

Section 113.	21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
	5 & 6 Will. 4, c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
	5 & 6 Will. 4, c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
	2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
	5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
	6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.
	7 & 8 Vict. 69. (*a*) [1844.] In part.	An Act for Amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included.
	13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.

(*a*.) *Note.*—Sects. 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70. [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the Schedule the words and figures. "Certificate of the registration of a design £5 . 0 . 0. And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.

38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

PATENTS RULES.

Issued 21st of December, 1883. *See Act, sect.* 101 *for the general power to make rules.*

By virtue of the provisions of the Patents, Designs and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules:—

Short Title.

1. These Rules may be cited as the Patents Rules, 1883. Short title.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of December, 1883. Commencement.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned Act, in addition to the fees mentioned in the Second Schedule thereto, so far as it relates to patents, shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

Forms.

5. The Forms A, B, and C in the First Schedule to the said Act shall be altered or amended by the substitution therefor respectively of the Forms A. A1, B, and C in the Second Schedule hereto. Forms. Alterations.

6. (1.) An application for a patent shall be made either in the Form A or the Form A1 set forth in the Second Schedule hereto, as the case may be. Application.

Specification. (2.) The Form B. in such Schedule of provisional specification and the Form C. of complete specification shall respectively be used.

Other forms. (3.) The remaining forms set forth in such Schedule may, as far as they are applicable, be used in any proceedings under these Rules.

GENERAL.

Hours of business. 7. The Patent Office shall be open to the public every week-day during the hours of ten and four, except on the days and times following:—

Christmas Day.

Good Friday.

The day observed as Her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency. 8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller and all attendances by the applicant upon the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and if he so require resident in the United Kingdom.

Statement of address. 9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

Size, &c. of documents. 10. All documents and copies of documents sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Exercise of discretionary power by 11. Before exercising any discretionary power given to the Comptroller by the said Act adversely to the applicant for a

patent or for amendment of a specification, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller.

Comptroller. Notice of hearing.

Act, sect. 94.

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

Notice by applicant.

Second Schedule, Form E.

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

Comptroller may require statement, &c.

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

Decision to be notified to parties.

15. The term "applicant" in Rules 11, 12, and 13 shall include an applicant whose specification bears a title the same as or similar to that of the specification of a prior applicant, and has been reported on by the examiner.

Definition of "applicant."

Act, sect. 13.

16. Such prior and second applicant respectively may attend the hearing of the question whether the invention comprised in both applications is the same, but neither party shall be at liberty to inspect the specification of the other.

Prior and second applicant may attend hearing.

17. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice of his intention to exhibit, publish, or use the invention, as the case may be.

Industrial or international exhibitions.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

Act, sect. 39.

Power of amendment, &c.

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

Act, sects. 91 and 101. This rule provides generally for amendments. Compare the corresponding rules, Designs, 30, and Trade-marks, 51. See the Special Rules 48–56, *post*, p. 187.

Documents by post.

19. Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

Act, sect. 97.

Affidavits.

20. Affidavits may, except where otherwise prescribed by these Rules, be used as evidence in any proceedings thereunder when sworn to in any of the following ways, viz.:—

(1.) In the United Kingdom before any person authorised to administer oaths in the Supreme Court of Judicature or before a justice of the peace for the county or place where it is sworn or made.

(2.) In any place in the British dominions out of the United Kingdom before any court, judge, or justice of the peace, or any person authorised to administer oaths there in any court.

(3.) In any place out of the British dominions before a British minister, or person exercising the functions of a British minister, or a British consul, vice-consul, or other person

exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

Act, sect. 98.

21. Where any statutory declaration prescribed by these Rules, or used in any proceedings thereunder, is made out of the United Kingdom, the words, "and by virtue of the Statutory Declarations Act, 1835," must be omitted, and the declaration shall (unless the context otherwise requires) be made in the manner prescribed in Rule 20, sub-section (3). Statutory declarations.

Application with Provisional or Complete Specification.

22. Applications for a patent sent by prepaid letter through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post. Order of recording applications.

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

23. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly. Application for separate patents by way of amendment.

Every such application shall bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Act and by these Rules as if every such application had been originally made on that date for one invention only.

24. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from will or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative. Application by representative of deceased inventor.

25. On the acceptance of an application with a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office. Notice and advertisement of acceptance.

Inspection on acceptance of complete specification.

26. Upon the publication of such advertisment of acceptance in the case of an application with a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon the payment of the prescribed fee.

Application on Communication from Abroad.

Communication from abroad.

27. An application for a patent for an invention communicated from abroad shall be made in the form A 1 set forth in the Second Schedule hereto.

Sizes and Methods of Preparing Drawings accompanying Provisional or Complete Specifications.

Size of drawings.

28. The drawings accompanying provisional or complete specifications shall be made upon half-sheets or sheets of imperial drawing paper, to be within a border line of 19 inches by 12 inches, or 27 inches by 19 inches, with a margin of ½ an inch all round.

Copies of drawings.

29. A copy of the drawings will be required upon *rolled* imperial drawing paper or upon thin Bristol board of the same dimensions as the original drawing or drawings. All the lines must be absolutely black, Indian ink of the best quality to be used, and the same strength or colour of the ink maintained throughout the drawing. Any shading must be in lines clearly and distinctly drawn and as open as is consistent with the required effect. Section lines should not be too closely drawn. No colour must be used for any purpose upon the copy of the drawings. All letters and figures of reference must be bold and distinct. The border line should be one fine line only. The drawings must not be folded, but must be delivered at the Patent Office either in a perfectly flat state or rolled upon a roller so as to be free from creases or breaks (*a*).

30. Where a complete specification is left at the Patent Office after a provisional specification has been accepted, the complete specification and drawing or drawings accompanying the same, as

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(*a*) As the drawings accompanying the provisional and complete specification respectively are copied at the Patent Office for publication by the process of photo lithography, this rule must be strictly observed in order that correct copies may be made.

well as the copy thereof, must be prepared in accordance with Rules 10, 28, and 29.

Illustrated Journal.

Additional drawing to be furnished.

31. Every applicant for the grant of a patent shall, in addition to the drawings to be furnished with his complete specification, furnish the Comptroller with a drawing illustrative of the feature or features of novelty constituting his invention. Such drawing must be prepared in the manner prescribed for the copy of the original drawing or drawings accompanying the specification, but must not cover a space exceeding 16 square inches. The drawing must be accompanied by a concise explanatory statement on foolscap paper and legibly written or printed.

Opposition to Grants of Patents.

Notice of opposition.

32. A notice of opposition to the grant of a patent shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

Act, sect. 11. Patents Rules, Second Schedule, Form D.

Copy for applicant.

33. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant.

Second Schedule, Form E.

Particulars of prior patent.

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

Opponent's evidence.

35. Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent shall leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof.

Applicant's evidence.

36. Within fourteen days from the delivery of such list the applicant shall leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent shall leave at the Patent Office his statutory declarations in reply, and deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Evidence in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

Closing of evidence.

37. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application made to him for that purpose.

38. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Notice of hearing.

39. On the completion of the evidence the Comptroller shall appoint a time for the hearing of the case, and shall give to the parties seven days' notice at the least of such appointment.

Disallowance of opposition in certain cases.

40. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition.

Decision to be notified to parties.

41. The decision of the Comptroller in the case shall be notified by him to the parties.

CERTIFICATES OF PAYMENT OR RENEWAL.

Payment of fees of 50*l*. and 100*l*. for continuance of patent.

42. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to make the prescribed payment for keeping the same in force, he shall seven days at least before such expiration give notice to the Comptroller of such intention, and shall, before the expiration of such fourth or eighth year, as the case may be, leave at the Patent Office a form of certificate of payment, duly stamped, subject as hereinafter provided, with the prescribed fee of 50*l*. and 100*l*., as the case may be.

Second Schedule, Form J.

As to patents granted before commencement of Act.

43. In the case of patents granted before the commencement of the said Act, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

Payment of annual fees in lieu of 50*l*. and 100*l*.

44. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l*. and 100*l*., he shall seven days at least before the expiration of the fourth and each succeeding year

during the term of the patent, until and inclusive of the 13th y. thereof, give notice to the Comptroller of such intention, and shall, before the expiration of such respective periods as aforesaid, leave at the Patent Office a form of certificate of payment, duly stamped with the fee prescribed to be paid at such periods respectively.

Certificate of payment.

45. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall give to the patentee a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

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

Act, sect. 17 (3). Patents Rules, Second Schedule, Form K.

In other cases.

47. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Act, sects. 7 and 18.

Amendment of Specification.

Request for leave to amend.

Advertisement.

48. A request for leave to amend a specification shall be signed by the applicant or patentee and accompanied by a copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

Second Schedule, Form F.

Notice of opposition.

49. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

Second Schedule, Form G.

Copy for the applicant.

50. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant or patentee, as the case may be (hereinafter called the applicant).

See Form E.

Opponent's evidence.

51. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent shall leave at the Patent Office statutory declarations in support of his opposition and deliver to the applicant a list thereof.

Further proceedings.

52. Upon such declarations being left, and such list being delivered, the provisions of Rules 36, 37, 38, and 39 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Decision to be notified to parties.

53. The decision of the Comptroller in the case shall be notified by him to the parties.

Requirements thereon.

54. Where leave to amend is given the applicant shall, if the Comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 28, and 29.

Leave by order of Court.

55. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

Advertisement of amendment.

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

COMPULSORY LICENSES (*b*).

Petition for compulsory grant of licenses.

57. A petition to the Board of Trade for an order upon a patentee to grant a license shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

Second Schedule, Form H1.

(*b*) Act, sects. 22 and 45 (2). There is no provision in the Act or the Rules as to costs of applications for compulsory licenses.

58. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee. To be left with evidence at Patent Office.

Second Schedule, Form H.

59. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the Comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition. Directions as to further proceedings unless petition refused.

60. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof. Procedure. Petitioner's evidence.

61. Within fourteen days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner. Patentee's evidence.

62. The petitioner within fourteen days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the petitioner; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply. Evidence in reply.

63. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition. Further proceedings.

Register of Patents.

64. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention. Entry of grant.

Request for entry of subsequent proprietorship.

65. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

Second Schedule, Form L.

It would seem that by the operation of this rule, and of sects. 23 and 87 of the Act, registration of licenses is now compulsory. See rule 74 as to licenses.

Signature of request.

66. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate, by their agent, authorised in like manner.

Particulars to be stated in request.

67. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

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

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

Copies for Patent Office.

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

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an examined copy.

Body corporate.

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

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

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

Second Schedule, Form S.

Entry of payment of fees on issue of certificate.

72. Upon the issue of a certificate of payment under Rule 45, the Comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of failure to pay fee.

73. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licenses.

74. An examined copy of every license granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original license shall at the same time be produced and left at the Patent Office if required for further verification.

It would seem that by the operation of this rule, and of sects. 23 and 87 of the Act, registration of licenses is now compulsory. See rule 65 as to assignments.

Hours of inspection of register.

75. The register of patents shall be open to the inspection of the public on every week-day between the hours of ten and four, except on the days and at the times following:—

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

(*b*.) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(c.) Times when the register is required for any purpose of official use;

Certified copies of documents.

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

Power to Dispense with Evidence, &c.

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

Designs Rules, 29; Trade-Marks Rules, 50.

Repeal.

Repeal.

78. All general rules made by the Lord Chancellor, or by any other authority, under the Patent Law Amendment Acts, and in force on the 31st day of December, 1883, shall be, and they are hereby repealed as from that date, without prejudice, nevertheless, to any application then pending.

FIRST SCHEDULE.

Approved 4th of December, 1883.

List of Fees payable on and in connection with Letters Patent (*a*).

Up to Sealing.

		£	s.	d.	£	s.	d.
1.	On application for provisional protection	1	0	0			
2.	On filing complete specification	3	0	0			
					4	0	0
	or						
3.	On filing complete specification with first application				4	0	0
4.	On appeal from Comptroller to Law Officer. By appellant				3	0	0
5.	On notice of opposition to grant of patent. By opponent				0	10	0
6.	On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
7.	On application to amend specification :— Up to sealing. By applicant				1	10	0
8.	After sealing. By patentee				3	0	0
9.	On notice of opposition to amendment. By opponent				0	10	0
10.	On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
11.	On application to amend specification during action or proceeding. By patentee				3	0	0
12.	On application to the Board of Trade for a compulsory license. By person applying				5	0	0
13.	On opposition to grant of compulsory license. By patentee				5	0	0
14.	On certificate of renewal :— Before end of four years from date of patent ..				50	0	0

(*a*) See the notice, *ante*, p. 175.

						£	s.	d.
15.	Before end of seven years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of eight years from date of patent					100	0	0
	Or in lieu of the fees of 50*l.* and 100*l.*, the following annual fees:—							
16.	Before the expiration of the 4th year from the date of the patent					10	0	0
17.	,,	,,	5th	,,	,, ..	10	0	0
18.	,,	,,	6th	,,	,, ..	10	0	0
19.	,,	,,	7th	,,	,, ..	10	0	0
20.	,,	,,	8th	,,	,, ..	15	0	0
21.	,,	,,	9th	,,	,, ..	15	0	0
22.	,,	,,	10th	,,	,, ..	20	0	0
23.	,,	,,	11th	,,	,, ..	20	0	0
24.	,,	,,	12th	,,	,, ..	20	0	0
25.	,,	,,	13th	,,	,, ..	20	0	0
	On enlargement of time for payment of renewal fees:—							
26.	Not exceeding 1 month					3	0	0
27.	,, 2 months					7	0	0
28.	,, 3 months					10	0	0
29.	For every entry of an assignment, transmission, agreement, license or extension of patent ..					0	10	0
30.	For duplicate of letters patent .. .. each					2	0	0
31.	On notice to Comptroller of intended exhibition of a patent under sect. 39					0	10	0
32.	Search or inspection fee .. .. .. each					0	1	0
33.	For office copies .. .. every 100 words (but never less than one shilling)					0	0	4
34.	,, of drawings, cost according to agreement.							
35.	For certifying office copies, MSS. or printed, each					0	1	0
36.	On request to Comptroller to correct a clerical error .. .. :					0	5	0
37.	For certificate of Comptroller under sect. 96 ..					0	5	0
38.	For altering address in register					0	5	0

THE SECOND SCHEDULE.

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PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

FORM A.

APPLICATION FOR PATENT.

(a) Here insert name, full address, and calling of applicant or applicants.

(a) _____

_____

_____

_____, do solemnly and sincerely declare that _____ in possession of an invention

(b) Here insert title of invention.

for (b) _____

_____

that _____ the true and first inventor _____ thereof; and that the same is not in use by any other person or persons to the best of _____ knowledge and belief; and _____ humbly pray that a patent may be granted _____

_____

_____

_____

for the said invention.

And _____ make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(c) Signature of applicant or applicants.

(c) _____

_____

_____

Declared at (*d*)_____ in the _____

_____ this _____ day of

_____ 18____.

Before me,

(*e*)_____

_____

_____

[Declared at (*d*)_____ in the _____

_____ this _____ day of

_____ 18____.

Before me,

(*e*)_____

_____

_____(*f*)]

_____

(*d*) If declared by more than one applicant and at different times or places, insert after "Declared" the words "by the above-named."

(*e*) Signature and title of the person before whom the declaration is made.

(*f*) If not required as in note (*d*), strike out part within brackets.

NOTE.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted, and the declaration must be made before a British Consular Officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.

PATENT.

FORM A1.

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

(*a*) Here insert name, full address, and calling of applicant.

(*b*) Here insert title of invention.

(*c*) Here insert name, address, and calling of communicant.

1 (*a*)_____ of _____ in the county of _____ do solemnly and sincerely declare that I am in possession of an invention for (*b*) _____ which invention has been communicated to me from abroad by (*c*) _____ that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*d*) Signature of applicant.

(*d*)_____

Declared at _____ in the county of _____ this _____ day of _____ 18____.

Before me,

(*e*) Signature and title of the officer before whom the declaration is made.

(*e*)_____

NOTE.—Where the above declaration is made out of the United Kingdom the words, "and by virtue of the Statutory Declarations Act, 1835," must be omitted, and the declaration must be made before a British Consular Officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.

To be issued with Form A or A1.

FORM B.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(*a*)_____

(*a*) Here insert title, as in declaration.

(*b*)_____

(*b*) Here insert name, full address, and calling of applicant or applicants, as in declaration.

do hereby declare the nature of the said invention for_____

to be as follows (*c*):_____

(*c*) Here insert short description of invention.

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on the left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant or his agent on the last sheet, the date being first inserted as follows:—

"Dated this day of 18 ."

PATENT.

FORM C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

(*a*) Here insert title, as in declaration.

(*a*) _____

(*b*) Here insert name, full address, and calling of applicant or applicants, as in declaration.

(*b*) _____

do hereby declare the nature of _____ invention for _____

and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (*c*):—

(*c*) Here insert full description of invention *which must end with a distinct statement of claim or claims, in the following form:*

"Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is

(1.)
(2.)
(3.) "

Here state distinctly the features of novelty claimed.

NOTE.—This document must form the commencement of the complete specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The complete Specification and the "Duplicate" thereof must be signed by the applicant or his agent on the last sheet, the date being first inserted as follows:—

"Dated this day of 18 ."

FORM D.

FORM OF OPPOSITION TO GRANT OF PATENT.

PATENT.

[*To be accompanied by an unstamped copy.*]

*I_____ * Here state name and full address.

hereby give notice of my intention to oppose the grant of Letters Patent upon application No._____ of_____, applied for by_____

upon the ground†_____ † Here state upon which of the grounds of opposition permitted by sect. 11 of the Act the grant is opposed.

(Signed)‡_____ ‡ Here insert signature of opponent or agent.

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENT.

FORM E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Refusal to Accept Opposition, or Applications for Amendments, &c.

Sir,

_____ of (*a*) _____

(*a*) Here insert full address.

_____

hereby apply to be heard in reference to

_____

and request that I may receive due notice of the day fixed for the hearing.

_____

Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM F.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

PATENT.

*_____

* Here state name and full address of applicant or patentee.

seek leave to amend the specification of Letters Patent No._____ of 188 , as shown in red ink in the copy of the original specification hereunto annexed_____

My reasons for making this amendment are as follows†_____

† Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the Letters Patent.

(Signed)_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

FORM G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

[To be accompanied by an unstampted copy.]

* Here state name and full address of opponent.

* _____

_____

_____

_____

_____

_____

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. _____

† Here state reason of opposition.

of 188 , for the following reason: † _____

_____

_____

_____

_____

_____

_____

_____

_____

_____

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM H.

PATENT.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENSE.

[*To be accompanied by an unstamped copy.*]

* _____ * Here state name and full address of applicant.

_____

_____

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a license to me by † _____ † Here state name and address of patentee, and number and date of his patent.

_____

_____

_____

(Signed) _____

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* form next page.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM H1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENSES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

(*a*) Here insert name, full address, and description.

THE PETITION of (*a*) of , in the county of , being a person interested in the matter of this petition as herein-after described:—

SHEWETH as follows:—

1. A patent dated No. was duly granted to for an invention of (*b*)

(*b*) Here insert title of invention.

2. The nature of my interest in the matter of this petition is as follows:—(*c*)

(*c*) Here state fully the nature of petitioner's interest.

(*d*) Here state in detail the circumstances of the case under sect. 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licenses on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

3. (*d*)

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licenses on reasonable terms (*e*)

Your petitioner therefore prays that an order may be made by the Board of Trade (*f*)

or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

(*e*) State grou grou which is cla the l of s sub-s (*b*), o the c be.

(*f*) state port effe the p order terms the of r secur paym othe upon the tione to be to t in qu

FORM I.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENSE.

PATENT.

* _____

_____

_____

_____

* Here state name and full address.

hereby give notice of objection to the application of _____

_____

_____

_____

for the compulsory grant of a License under Patent No. _____ of 188 .

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

_____

_____ hereby transmit the fee prescribed for the continuation in force of _____ Patent No. _____, of 18 , for a further period of _____.

Name* _____

Address _____

* Here insert name and full address of patentee or his agent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No. _____ of 188____.

_____ 18____.

This is to certify that _____ did this _____ day of _____ 18_____, make the prescribed payment of £_____ in respect of a period of _____ from _____, and that by virtue of such payment the rights of _____ remain in force.*

* See sect. 17 of the Patents, Designs, and Trade Marks Act, 1883.

Seal.

Patent Office, London.

FORM K.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

PATENT.

SIR,

I HEREBY apply for an enlargement of time for month in which to make the_____ payment of £_____ upon my Patent, No._____, of 188 .

I am,

Sir,

Your obedient Servant,

(*a*)_____

(*a*) Here insert full address to which receipt is to be sent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

FORM L.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS, AND OF DECLARATIONS IN SUPPORT THEREOF.

I (*a*), _____

_____

_____

hereby request that you will enter (*b*) _____ name (*c*) in the Register of Patents:—

(*d*) _____ claim to be entitled (*e*) _____

_____

of the Patent No. _____ of 188 , granted to (*f*) _____

_____

_____

for (*g*) _____

_____

_____

by virtue of (*h*) _____

_____

_____

_____

_____

_____

_____

And in proof whereof I transmit the accompanying (*i*) _____ with an examined copy thereof. (*j*)

I am,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) *Or We.* Here insert name, full address, and description.

(*b*) *My or our.*

(*c*) *Or names.*

(*d*) *I or We.*

(*e*) Here insert the nature of the claim.

(*f*) Here give name and address, &c., of patentee or patentees.

(*g*) Here insert title of the invention.

(*h*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.

(*i*) Here insert the nature of the document.

(*j*) Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an examined copy must be left.

FORM M.

PATENT.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENSE IN THE REGISTER OF PATENTS.

SIR,

I HEREBY transmit an examined copy of a license granted to me by _____

_____

under Patent No. _____ of 188 , as well as the original license for verification, and I have to request that a notification thereof may be entered in the Register.

I am,

Sir,

Your obedient Servant,

(*a*) _____ (*a*) Here insert full address.

_____

_____

_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

FORM N.

APPLICATION FOR DUPLICATE OF PATENT.

Date

SIR,

I REGRET to have to inform you that the Letters Patent,

[* Here insert date, No., name, and full address of patentee.]

dated* No.

granted to

[† Here insert title of invention.]

for an invention of †

[‡ Here insert the word "destroyed" or "lost," as the case may be.]

have been ‡

I beg therefore to apply for the issue of a duplicate of such

§ Here state interest possessed by applicant in the Letters Patent

Letters Patent. §

[Signature of Applicant.]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London. W.C.

FORM O.

PATENT.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

* _____ * Here state name and full address of applicant.

_____

_____

hereby give notice of my intention to exhibit a _____

of _____ at the _____

_____

_____

Exhibition, which † _____ of _____ 18____, † State "opened" or "is to open."

under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

‡ _____ herewith enclose _____ ‡ Insert brief description of invention, with drawings, if necessary.

_____

_____

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery, Lane, London, W.C.

PATENT.

FORM P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,

I HEREBY request that the following clerical error (*a*) may be corrected in (*b*)

(*a*) or errors.

(*b*) Here state whether in application, specification, or register.

Signature _____

Full Address _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

PATENT.

Patent Office,

London,

188

I, , Comptroller-General of Patents Designs, and Trades Marks, hereby certify

PATENT.

FORM R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,

(*a*) Here state name or names and full address of applicant or applicants.

(*a*) _____

_____

_____

_____

_____

hereby request that _____ address now upon the Register may be altered as follows:—

(*b*) Here insert full address.

(*b*) _____

_____

_____

_____

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM S.

PATENT.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

(*a*) _____

_____

_____

_____

(*a*) Here state name and full address of applicant.

hereby transmit an office copy of an Order in Council with reference to (*b*)

(*b*) Here state the purport of the order.

_____

Sir,

Your obodient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

FORM T.

FORM OF APPEAL TO LAW OFFICER.

(*a*) Here insert name and full address of appellant.

I, (*a*)_____ of (*a*)_____

_____

hereby give notice of my intention to appeal to the Law Officer

(*b*) Here insert "the decision" or "that part of the decision," as the case may be.

from (*b*)_____

_____

of the Comptroller of the _____ day of _____

(*c*) Here insert "refused [or allowed] application for Patent," or "refused [or allowed] application for leave to amend Patent," or otherwise, as the case may be.

188 , whereby he (*c*)_____

_____

(*d*) Insert number and year.

No. (*d*)_____ of the year 188 (*d*) .

Signature_____

Date_____

N.B.—This notice has to be sent to the Comptroller General at the Patent Office, London, W.C., and a copy of same to the Law Officer's Clerk at Room 549, Royal Courts of Justice, London.

21st December, 1883.

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within fourteen days from the date of the decision appealed against file in the Patent Office, a notice of such his intention.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officer's clerk at room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officer's clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officer's clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or opponents; and, when the Comptroller has refused to seal a patent on the ground that an

application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of sect. 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officer's clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.
FARRER HERSCHELL, S.G.

RULES TO BE OBSERVED IN PROCEEDINGS before the JUDICIAL COMMITTEE OF THE PRIVY COUNCIL under the Act of the 5th and 6th Wm. IV., intituled "An Act to amend the Law touching LETTERS PATENT FOR INVENTIONS" (cap. 83) (*a*).

RULE I.

A party intending to apply by petition, under sect. 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisments state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application, shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This rule relates to confirmation of letters patent, as to which no provisions are contained in the present Act.

(*a*) No new rules have been issued, and the following rules made under the statutes repealed by the present Act are still in force. The requirements of the rules should be strictly observed: *Bodmer's Patent*, 1 Web. P. C. 740; 2 Moo. P. C. C. 471; *Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87.

RULE II.

A party intending to apply by petition, under sect. 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Advertisements.

Section 4 of the Act of Wm. 4, related to petitions for prolongation of letters patent, and it provided with respect to advertisements of the petition, that if a patentee "shall advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture or where he lives, in case there shall not be any paper published in such town, that he intends to apply," &c., the petition shall be heard.

By sect. 25 of the present Act, the rules to be made thereunder are to provide any other things for advertisements, and until such rules are made, proceedings on petitions for extension "shall be regulated according to the existing procedure and practice of the Judicial Committee." As no rules have yet been made, it is presumed that the advertisements on petitions for extension must be issued in accordance with the above section of the Act of Wm. 4.

Place of business.

It would seem that the advertisements must be issued in the place or district where the business is actually carried on in cases where the patentee does not himself carry on the business and resides elsewhere (*b*).

It would, however, in any case be safer to advertise in both localities, *i.e.*, in that where the business is carried on, and also in that where the patentee resides.

Persons interested.

If an equitable assignee of a patent wishes to appear upon and in support of a petition for extension, his name should be inserted in the advertisements (*c*), and it is advisable in any case where a person having

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(*b*) *Derosne's Patent*, 2 Web. P. C. 2; 4 Moo. P. C. C. 416. Compare *Perkins' Patent*, 2 Web. P. C. 6, 8.

(*c*) *Noble's Patent*, 7 Moo. P. C. C. 191.

an interest in a patent desires to support an application for extension, that his name should be set forth in the advertisements.

Where the petitioner died before the hearing, his widow, as executrix, was allowed to appear without further advertisements on a supplemental petition (*d*).

Where on an application to fix the hearing, it appeared that the patent had nearly eighteen months to run, the application was ordered to stand over, as the accruing profits meanwhile might affect the question of extension (*e*). Time for hearing.

The provisions as to "prosecuting with effect" a petition for extension contained in the repealed statutes (*f*) are not reproduced in the present statute. It is, therefore, submitted that it will be sufficient if a petition is presented while the letters patent are in force, even though further proceedings cannot take place till they have expired.

An application for extension may be heard while proceedings are pending as to the validity of a patent (*g*).

Any person of the English public has a right to enter a caveat to be heard (*h*), and so has an alien who is resident abroad who is interested in an English patent competing with the patent sought to be prolonged (*i*); and a person who has entered a caveat is entitled to notice of any application in respect of the petition (*k*). Caveat.

Rule III.

Petitions under sects. 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

In case of accidental delay arising from mistake, the Privy Council may extend this time (*l*).

Rule IV.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of sect. 4 of

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(*d*) *Herbert's Patent*, L. R. 1 P. C. 399, 401.

(*e*) *Macintosh's Patent*, 1 Web. P. C. 739.

(*f*) 5 & 6 Wm. 4, c. 83, s. 4; 2 & 3 Vict. c. 67. See *Bodmer's Patent*, 1 Web. P. C. 740; 2 Moo. P. C. C. 471; *Kay's Patent*, 3 Moo. P. C. C. 24; *Ledsam* v. *Russell*, 1 H. L. C. 687.

(*g*) *Kay's Patent*, *ubi supra*.

(*h*) *Lowe's Patent*, 8 Moo. P. C. C. 1. *Query*, if a caveat can be entered by a person as agent for another so as to entitle the latter to be heard. *Ibid*.

(*i*) *Re Schlumberger*, 9 Moo. P. C. C. 1.

(*k*) *Hutchinson's Patent*, 14 Moo. P. C. C. 364.

(*l*) *Hutchinson's Patent*, *ubi supra*.

the said Act, and the 1st and 2nd of these Rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

RULE V.

All persons entering caveats under sect. 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

This rule extends to all applications (*m*).

RULE VI.

All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

The grounds of objection may be stated generally without going into particulars (*n*).

RULE VII.

Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

RULE VIII.

The registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

RULE IX.

A party applying for an extension of a patent, under sect. 4 of the said Act, must lodge at the Council Office six printed copies of

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(*m*) *Hutchinson's Patent, ubi supra.*

(*n*) *Ball's Patent*, 4 App. Cas. 171.

the specification (*o*), and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. *In the event of the applicant's specification not having been printed,* and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

One week. This rule is strictly adhered to in order to allow the Attorney-General to inspect the accounts and make inquiries (*p*).

(*o*) *Bell's Patent*, 2 Web. P. C. 159.

(*p*) *Johnson's and Atkinson's Patents*, L. R. 5 P. C. 88; *Chatwood's Patent, Ibid.*

PATENT OFFICE.

DESIGNS RULES.

Issued December 21, 1883. *See Act, sect.* 101, *for the General Power to make Rules.*

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules:—

Commencement.

1. These Rules may be cited as the Designs Rules, 1883, and shall come into operation from and immediately after the 31st day of December, 1883.

Interpretation.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively.

Fees.

Fees.

3. The fees to be paid under the said Act, so far as it relates to applications for and registration of designs, shall be the fees specified in the First Schedule hereto.

Forms.

Forms.

4. An application for the registration of a design shall be made in the Form E. in the Second Schedule hereto. The remaining forms in such Schedule may be used in all cases to which they are applicable.

Classification of Goods.

Classification of goods.

5. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto.

Application for Registration.

Agents.

6. All communications between an applicant for the registration of a design and the Comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the Comptroller.

Address of Comptroller.

7. An application for the registration of a design shall, with the prescribed fee, be left at the Patent Office, Designs Branch, or be sent prepaid by post, addressed to the Comptroller at the Patent Office (Designs Branch), 25, Southampton Buildings, Chancery Lane, London.

Second Schedule, Form E.

Size of papers.

8. An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office, Designs Branch, or otherwise furnished to the Comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than 1 inch and a half in the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand.

The Comptroller may in any particular case vary the requirements of this Rule as he may think fit.

Sketches and drawings.

Nature of design.

9. An application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

When sketches, drawings, or tracings are furnished they must be fixed.

When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished.

. Act, sect. 60, *ante*, p. 114, for definition of design.

Acknowledgment to applicant.

10. On receipt of an application for registration the Comptroller shall send to the applicant an acknowledgment thereof.

Notice of registration.

11. If the Comptroller determines to register a design, he shall as soon as may be send to the applicant a certificate of such regis-

tration in the prescribed form, sealed with the seal of the Patent Office:

Applications may be sent by post.

12. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

Act, sect. 97, *ante*, p. 158.

Hearing by Comptroller.

13. Before exercising any discretionary power given to the Comptroller by the said Act adversely to an applicant for registration of a design the Comptroller shall give him ten days' notice of the time when he may be heard personally or by his agent before the Comptroller.

Act, sect. 94, *ante*, p. 157.

Hearing by Comptroller.

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

Notification of Comptroller's decision.

15. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

Notice of appeal to Board of Trade.

16. Where the Comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Designs Branch, a notice of such his intention.

Statement on appeal.

17. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

Notice to Secretary of Board of Trade.

18. The applicant shall forthwith on leaving such notice send a copy thereof to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London.

19. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade. Directions by Board of Trade.

This rule purports to provide for hearings "for" (*i.e.*, not merely "by" the Board of Trade. But the Act contains no provision for hearings other than by the Board of Trade: see sect. 47, sub-s. (7)

20. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the Comptroller and the applicant. Notice of time of hearing.

Compare the corresponding Trade-Marks Rules, 20-24.

Register of Designs.

21. Upon the sealing of a certificate of registration the Comptroller shall cause to be entered in the register of designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller, which day shall be deemed to be the date of the registration. Registering design.

22. Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design, either exclusively or otherwise, a request for the entry of his name in the register as such proprietor of the design, or as having acquired such right, as the case may be (hereinafter called the claimant), shall be addressed to the Comptroller, and left at the Patent Office, Designs Branch. Subsequent proprietors.

23. Every such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively duly authorised to the satisfaction of the Comptroller; and in the case of a body corporate, by their agent authorised in like manner. Signature of request.

24. Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to show the manner in which and the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be. Particulars in request.

Statutory declaration with request.

25. Every such request shall be accompanied by a statutory declaration to be thereunder written verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

Proof of title if required.

26. The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction.

Corporate name.

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

Notice of order of Court.

28. Where an order has been made by the Court, under sect. 90 of the said Act, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Power to Dispense with Evidence.

Comptroller's discretion as to evidence.

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

Patents Rules, 77; Trade-Marks Rules, 50.

Amendments.

Amendments.

30. Any document, drawings, sketches, or tracings for the amending of which no special provision is made by the said Act may be amended, and any irregularity in procedure which, in the opinion of the Comptroller, may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and upon such terms as he may direct.

Act, sects. 91 and 101. Patents Rules, 18; Trade-Marks Rules, 51.

Enlargement of Time.

Enlargement of time.

31. The time prescribed by these Rules for doing any act or taking any proceeding thereunder may be enlarged by the Comptroller, if he think fit, and upon such terms as he may direct.

Marking Goods.

Registration mark.

32. Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes one to twelve in the third schedule hereto, cause each such article to be marked with the abbreviation "R^{D}" and the number appearing on the certificate of registration, and shall, if such article is included in the classes thirteen or fourteen in the third schedule hereto, cause each such article to be marked with the abbreviation "REG^{D}."

See Act, sect. 51, *ante*, p. 107.

Inspection.

Office hours.

33. On such days and during such hours as the Comptroller shall from time to time determine and notify by a placard posted at the Patent Office any person paying the prescribed fee may, on production of the number of any design of which the copyright has ceased, inspect such design, and any person paying the prescribed fee may take a copy or copies of such design.

Certificate by Comptroller.

Certificate in legal proceeding.

34. Where a certificate is required for the purpose of any legal proceeding or other special purpose as to any entry, matter, or thing which the Comptroller is authorised by the said Act or these Rules to make or do, the Comptroller may, on a request in writing and on payment of the prescribed fee, give such certificate, which shall also specify on the face of it the purpose for which it has been requested as aforesaid.

Searches on production of Sketch of Design.

Search.

35. The Comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office after the commencement of the Act, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any design applied to such goods and registered since the commencement of the Act.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

Notice of exhibition.

36. Any person desirous of exhibiting a design, or any article to which a design has been applied, at an industrial or international exhibition, or of publishing a description of a design during the period of the holding of the exhibition, shall, after having obtained from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice in writing of his intention to exhibit the design or article, or to publish a description of the design, as the case may be.

For the purpose of identifying the design in the event of an application to register the same being subsequently made, the applicant shall furnish to the Comptroller a brief description of the nature of the design, accompanied by a sketch or drawing thereof, and such other information as the Comptroller may in each case require.

Act, sect. 57, *ante*, p. 110. Second Schedule, Form L.

REPEAL.

Repeal of previous Rules.

37. All general rules and regulations made by any authority under the Acts relating to the Copyright of Designs, and in force on the 31st December, 1883, shall be, and they are hereby repealed as from that date without prejudice nevertheless to any application then pending.

SCHEDULES.

FIRST SCHEDULE.

FEES.

	£	s.	d.
1. On application to register one design to be applied to single articles in each class except classes 13 and 14	0	10	0
2. On application to register one design to be applied to single articles in classes 13 and 14	0	1	0
3. On application to register one design to be applied to a set of articles for each class of registration ..	1	0	0
4. On notice of appeal to Board of Trade against refusal of Comptroller to register	1	0	0
5. Copy of certificate of registration, each copy	0	1	0
6. On request for Certificate of Comptroller for legal proceedings or other special purpose	0	5	0
7. On request to enter name of subsequent proprietor	same as registration fee.		
8. On notice to Comptroller of intended exhibition of an unregistered design	0	5	0
9. Inspection of design of which the copyright has expired, for each quarter of an hour	0	1	0
10. Copy of one such design	cost according to agreement.		
11. On request to correct clerical error	0	5	0
12. On request for search under sect. 53	0	5	0
13. On request to enter new address	0	5	0
14. For office copy, every 100 words .. .. .. (but never less than 1*s*:)	0	0	4
15. For certifying office copies, MSS. or printed	0	1	0

NOTE.—The term "set" to include any number of articles ordinarily on sale together irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

Approved, 4th December, 1883.

SECOND SCHEDULE.

Forms.

Form of Application to Register.

„ Appeal to Board of Trade.

„ Certificate of Registration.

„ Application for Copy of Certificate of Registration.

„ Request for Certificate for use in Legal Proceedings.

„ Certificate for use in Legal Proceedings.

„ Request to enter Name of Subsequent Proprietor.

„ Notice of intending Exhibition of Unregistered Design.

„ Request for Correction of Clerical Error or for entry of New Address.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Designs.

FORM E.

APPLICATION FOR REGISTRATION OF DESIGN IN CLASSES_____.

You are hereby requested to register the accompanying design in Class_____, in the name of (*a*)_____

_____

of _____

_____

who claims to be the proprietor thereof, and to return the same to

_____

(a) Here insert legibly the name, address, and description of the individual or firm.

Statement of nature of design (*b*)_____

_____

_____

_____

(b) Such as whether it is applicable for the pattern or for the shape.

(*c*)

(c) To be signed by the applicant.

(Signed)_____

Dated the _____day of_____188____.

To the Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

Designs.

FORM F.

APPEAL TO BOARD OF TRADE ON REFUSAL OF COMPTROLLER TO REGISTER A DESIGN.

[*To be accompanied by an unstamped copy.*]

Sir,

I hereby appeal against your decision upon my application to register _____

and beg to submit my case (a) for the decision of the Board of Trade.

(a) The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

I am, Sir,

Your obedient servant,

The Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM G.

Seal of Patent Office.

CERTIFICATE OF REGISTRATION OF DESIGN.

(Rd. No._____.)

Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

This is to certify that the Design of which this is a copy was registered this_____day of_____188 , in pursuance of the Patents, Designs, and Trade Marks Act, 1883, in respect of the application of such Design to articles in Class ____, for which a copyright of five years is granted.

Designs.

FORM H.

APPLICATION FOR COPY OF CERTIFICATE OF REGISTRATION OF DESIGN.

Sir,

I hereby request you to furnish me with a Copy Certificate of Registration of Design No. _____ in Class _____.

(Signed)_____

Dated the _____ day of _____ 188____.

To the Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM I.

REQUEST FOR CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

Designs.

Sir,

I hereby request you to send me for the purposes of use in the suit of (*a*)_____

_____

_____

(a) Here state the title of the legal proceeding or the other purpose for which the Certificate is required.

a certificate that the design of which a copy is herein enclosed was (*b*)_____

_____

(b) Here state the entry, matter, or thing which the writer wishes certified.

(Signed) _____

_____ day of _____ 188____.

To the Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM J.

CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

In the matter of _____

_____

_____

No. _____

_____ Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that _____

_____

_____

_____

_____.

Witness my hand and seal this _____ day of _____ 188 ___ .

_____

Comptroller.

Seal

Patent Office, Designs Branch,
25, Southampton Buildings,
London.

FORM K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF DESIGN, WITH DECLARATION IN SUPPORT THEREOF.

Designs.

I, [a]_____

_____

_____

hereby request that you will enter [b]_____name [c]_____in the Register of Designs as proprietor_____of the Design No._____in Class_____.

[d]_____entitled as to the said Design_____

[e]_____

_____

_____

_____

_____

[f] And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Design as above claimed.

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

[g]_____

Declared at _____

_____

this _____day of_____188 .

Before me,

[h]

To the Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

[a] or We. Here insert name, full address, and description.

[b] My or our.

[c] of Names.

[d] I am, or We are.

[e] Here state whether design transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as, *e.g.*, "by deed dated the —— day of —— 188— made between So-and-so of the one part."

[f] This paragraph is not required when the declaration is made out of the United Kingdom.

[g] To be signed here by the person making the declaration.

[h] Signature and title of the authority before whom the declaration is made.

Design.

FORM L.

NOTICE OF INTENDED EXHIBITION OF AN UNREGISTERED DESIGN.

(a) Here state name and address of applicant.

(*a*)_____ hereby give notice of my intention to exhibit a _____

_____

of _____ at the _____

(*b*) State "opened" or "is to open."

Exhibition, which (*b*) _____

of _____ 188____, under the provisions of the

(*c*) Insert brief description of design, with drawing.

Patents, Designs, and Trade Marks Act of 1883 (*c*)_____

_____

_____

herewith enclose a _____

(Signed) _____

Dated the _____ day of _____ 188 .

To the Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

FORM M.

REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR ENTRY OF NEW ADDRESS.

Design.

Sir,

I hereby request that _____

_____

_____

_____

_____

(Signed) _____

Dated the _____ day of _____ 188 .

To the Comptroller,
Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

THIRD SCHEDULE.

CLASSIFICATION OF ARTICLES OF MANUFACTURE AND SUBSTANCES.

Classes.

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

Approved, 4th December, 1883.

TRADE MARKS RULES.

Issued 21 *December* 1883. *See Act, sect.* 101, *for the general power to make rules.*

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules:—

Preliminary.

1. These Rules may be cited as the Trade Marks Rules, 1883, and shall come into operation from and immediately after the 31st day of December, 1883.

Interpretation.

2. In the construction of these Rules any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

3. The fees to be paid in pursuance of the said Act, so far as it relates to trade-marks, shall be the fees specified in the First Schedule hereto. Fees.

Forms.

4. The Form F. in the First Schedule to the said Act shall be altered or amended by the substitution therefor of the Form F. in the Second Schedule to these Rules. Forms.

5. (1) An application for registration of a trade-mark shall be made in the Form F. in the Second Schedule to these Rules; (2) The remaining forms in such Schedule may be used in all cases to which they are applicable.

Classification of Goods.

6. For the purposes of trade-marks registration and of these Rules goods are classified in the manner appearing in the Third Schedule hereto. Classification of goods.

If any doubt arises as to what class any particular description of goods belongs, the doubt shall be determined by the Comptroller.

Act, sect. 63.

Application for Registration.

Application by firm.

7. An application for registration of a trade-mark, if made by any firm or partnership, may be signed by some one or more members of such firm or partnership, as the case may be.

If the application be made by a body corporate it may be signed by the Secretary or other principal officer of such body corporate.

Agency.

8. An application for registration and all other communications between the applicant and the Comptroller may be made by or through an agent duly authorised to the satisfaction of the Comptroller.

Acknowledgment of application.

9. On receipt of the application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Contents of form of application.

10. Where application is made to register a trade-mark which was used by the applicant or his predecessors in business before the 13th of August, 1875, the application shall contain a statement of the time during which and of the person by whom it has been so used in receipt of the goods mentioned in the application.

Act, sect. 64.

Size, &c., of documents.

11. Subject to any other directions that may be given by the Comptroller, all applications, notices, counter-statements, representations of marks, papers having representations affixed or other documents required by the said Act or by these Rules to be left with or sent to the Comptroller or to the Cutlers' Company, shall be upon foolscap paper of a size of 13 inches by 8 inches, and shall have on the left-hand part thereof a margin of not less than one inch and a half.

Qualification of metal goods.

12. In the case of an application for the registration of a trade-mark used on any metal goods, other than cutlery, edge tools, and raw steel, the applicant shall state in the specification of goods in the form of application of what metal or metals the goods in respect to which he applies are made.

Representation of trade-mark.

13. Subject to any other directions that may be given by the Comptroller, three representations of each trade-mark, except in the case of marks applied for in classes 23 to 35 inclusive, must be supplied upon paper of the size aforesaid, and must be of a durable

nature. One of such representations must be made upon or affixed to the form of application, the others upon separate half-sheets. In the case of trade-marks exceeding the limits of the foolscap paper of the size aforesaid, such may be pasted and folded upon the sheets of foolscap.

In the case of marks applied for in classes 23 to 35 inclusive, the applicant shall supply for representations of each mark for each class.

Where a drawing or other representation or specimen cannot be given in manner aforesaid, a specimen or copy of the trade-mark may be sent either of full size or on a reduced scale, and in such form as the Comptroller may think most convenient.

The Comptroller may, if dissatisfied with the representation of a trade-mark, require a fresh representation either before he proceeds with the application or before he registers the trade-mark.

The Comptroller may also, in exceptional cases, deposit in the Patent Office a specimen or copy of any trade-mark which cannot conveniently be shewn by a representation, and may refer thereto in the register in such a manner as he may think fit.

Second Schedule, Form G.

Representation of a series of trade marks.

14. When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section 66 of the said Act, a representation of each trade-mark of the series shall be made or affixed upon the form of application and also upon each of the separate half-sheets of paper aforesaid.

Compare rule 23, and see Act, sects. 64 and 66.

Translation of foreign characters.

15. Wherever a mark consists of or includes words printed in other than Roman character, there shall be given at the foot or on the back of each representation a translation of such words, signed by the applicant or his agent.

Mode of sending notices, &c.

16. Any application, statement, notice, or other document authorised or required to be left, made or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Act, sect. 97.

Exercise of Discretionary Powers.

Hearing by Comptroller.

17. Before exercising any discretionary power given to the Comptroller by the said Act adversely to the applicant for registration of a trade-mark, the Comptroller shall give him ten days' notice of the time when he may be heard personally or by his agent before the Comptroller.

Act, sect. 91.

Notice of wish to be heard before Comptroller.

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

Notification of decision.

19. The decision of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

Appeal to the Board of Trade.

Appeal to Board of Trade.

20. Where the Comptroller refuses to register a trade-mark and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Trade Marks Branch, a notice of such his intention.

Statement of grounds of appeal.

21. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

Copy of notice to Board of Trade.

22. The applicant shall forthwith on leaving such notice send a copy thereof to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London.

Directions by Board.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade, or for the purpose of their referring the appeal to the Court to hear and determine the same.

Notice of time of hearing.

24. Where the Board of Trade intend to hear the appeal, seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing, shall be given to the Comptroller and the applicant.

See Act, sect. 62. Compare the corresponding Designs Rules, 16-20.

Advertisement of Application.

Advertisement of application.

25. Every application shall be advertised by the Comptroller in the official paper, during such times, and in such manner as the Comptroller may direct.

If no representation of the trade-mark be inserted in the official paper in connection with the advertisement of an application, the Comptroller shall refer in such advertisement to the place or places where a specimen or representation of the trade-mark is deposited for exhibition.

Definition of official paper.

26. The official paper for the purposes of these Rules shall be some paper published under the direction of the Board of Trade, or such other paper as such Board may from time to time direct.

Means of advertising trade-mark to be supplied to official paper.

27. For the purposes of such advertisement the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of the trade-mark, of such dimensions as may from time to time be directed by the Comptroller, or with such other information or means of advertising the trade-mark as may be required by the Comptroller; and the Comptroller, if dissatisfied with the block or electrotype furnished by the applicant or his agent, may require a fresh block or electrotype before the proceeding with the advertisement.

Advertisement of series.

28. When an application relates to a series of trade-marks differing from one another in respect of the particulars mentioned in section 66 of the said Act, the applicant may be required to furnish a wood block or electrotype (or more than one, if necessary) of any or of each of the trade-marks constituting the series; and the Comptroller may, if he thinks fit, insert with the advertisement of the application a statement of the manner in respect of which the several trade-marks differ from one another.

Compare rule 14.

Opposition to Registration.

Manner of bringing case before Court.

29. (1.) Where a case stands for the determination of the Court, under the provisions of sect. 69 of the said Act, the Comptroller shall require the applicant within one month, or such further time as the Comptroller may allow, to issue a summons in the chambers of a judge of Her Majesty's High Court of Justice for an order that notwithstanding the opposition of which notice has been given the registration of the trade-mark be proceeded with by the Comptroller, or to take such other proceedings as may be proper and necessary for the determination of the case by the Court.

(2.) The applicant shall thereupon issue such summons, or take such other proceedings as aforesaid, within the period of one month above-named, or such further time as the Comptroller may allow, and shall also within the like period give notice thereof to the Comptroller.

(3.) If the applicant shall fail to issue such summons, or to take such other proceedings, of which failure the non-receipt by the Comptroller of the said notice shall be sufficient proof, the applicant shall be deemed to have abandoned his application.

Mode of giving notice that the matter has been brought before the Court.

(4.) Such notice to the Comptroller shall be given by delivering at or sending to the Patent Office a copy of the summons or other initiatory proceeding bearing an endorsement of service signed by the applicant or his solicitor, or an endorsement of acceptance of service signed by the opponent or his solicitor.

Compare, sect. 69, and rule 12, *post*.

REGISTER OF TRADE MARKS.

Time of registration of trade-marks.

30. As soon as may be after the expiration of two months from the date of the first advertisement of the application, the Comptroller shall, subject to any such summons, or other proceeding as aforesaid and the determination of the Court thereon, if he is satisfied that the applicant is entitled to registration, and on payment of the prescribed fee, enter the name, address, and description of the applicant in the Register of Trade Marks as the registered proprietor of the trade-mark in respect of the particular goods or classes of goods described in his application.

Where applicant dies before registration, the trade-mark may be registered for successor to good will of business.

31. In case of the death of any applicant for a trade-mark after the date of his application, and before the trade-mark applied for has been entered on the register, the Comptroller, after the expiration of the prescribed period of advertisement, may, on being satisfied of the applicant's death, enter on the register, in place of the name of such deceased applicant, the name, address, and description of the person owning the goodwill of the business, if such ownership be proved to the satisfaction of the Comptroller.

Entries to be made in register.

32. Upon registering any trade-mark the Comptroller shall enter in the register the date on which the application for registration was received by the Comptroller (which day shall be deemed to be the date of the registration) and such other particulars as he may think necessary.

Notice of registration.

33. The Comptroller shall send notice to the applicant of the registration of his trade-mark, together with a reference to the advertisement of such trade-mark in the official paper.

Request by subsequent proprietor.

34. Where a person becomes entitled to a registered trade-mark by assignment, transmission, or other operation of law, a request for the entry of his name in the register as proprietor of the trade-

mark shall be addressed to the Comptroller, and left at the Patent Office.

Act, sect. 78. Trade Marks Rules, Second Schedule, Form K.

Signature of request.

35. Such request shall in the case of an individual be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership by some one or more members of such firm or partnership, or in either case by his or their agent respectively duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised in like manner.

Contents of request.

36. Every such request shall state the name, address, and description of the person claiming to be entitled to the trade-mark (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom the trade-mark has been assigned or transmitted, and so as to show further that it has been so assigned or transmitted in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which the trade-mark has been registered.

Declaration to accompany request.

37. Every such request shall be accompanied by a statutory declaration to be thereunder written, verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the trade-mark as claimed by such request.

Further proof of title if required.

38. The claimant shall furnish to the Comptroller such other proof of title and of the existence and ownership of such goodwill as aforesaid as he may require for his satisfaction.

Body corporate.

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

Definition of applicant.

40. The term "applicant" in Rules 17, 18, and 19 shall include each of several persons claiming to be registered as proprietor of the same trade-mark.

Comptroller may require statement from rival claimants.

41. Whether all of such persons so claiming require to be heard before the Comptroller or not, he may, before exercising the discretion vested in him by sect. 71 of the said Act, require such persons, or any or either of them, to submit a statement in writing

within a time to be notified by him, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require.

Submission to Court of conflicting claims.

42. Where each of several persons claims to be registered as proprietor of the same trade-mark, and the Comptroller refuses to register any of them until their rights have been determined according to law, the manner in which the rights of such claimants may be submitted to the Court by the Comptroller, or if the Comptroller so require, by the claimants, shall, unless the Court otherwise order, be by a special case; and such special case shall be filed and proceeded with in like manner as any other special case submitted to the Court, or in such other manner as the Court may direct.

Compare rule 29, *ante*.

Settlement of special case.

43. Where the special case is to be submitted to the parties it may be agreed to by them, or if they differ, may be settled by the Comptroller on payment of the prescribed fees.

Second Schedule, Form T.

44. Where an order has been made by the Court in either of the following cases, viz.:—

(*a*) allowing an appeal under sect. 62 of the said Act;

(*b*) disallowing an opposition to registration under sect. 69; or,

(*c*) under the provisions of sects. 72, 90, or 92 of the said Act,

the person in whose favour such order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or altered, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Removal of mark from register.

45. Where a trade-mark has been removed from the register for nonpayment of the prescribed fee or otherwise, under the provisions of sect. 79 of the said Act, the Comptroller shall cause to be entered in the register a record of such removal and the cause thereof.

Alteration of address in register.

46. If the registered proprietor of a trade-mark send to the Comptroller, together with the prescribed fee, notice of an alteration in his address, the Comptroller shall alter the register accordingly.

Publication of rectification or variation of register.

47. Whenever an order is made by the Court for making, expunging, or varying an entry from or in the register, the Comptroller shall, if he thinks that such rectification or variation should be made public, and at the expense of the person applying for the same, publish, by advertisement or otherwise, and in such manner as he thinks just, the circumstances attending the rectification or variation in the register.

Notice to Comptroller of Order of Court for alteration of trade-mark under sect. 92 of Act.

48. Whenever the registered proprietor of any trade-mark intends to apply for the leave of the Court to add to or to alter such trade-mark, under sect. 92 of the said Act, the notice to be given to the Comptroller shall be given fourteen days at least before such application. If leave be granted on such application the applicant shall forthwith supply to the Comptroller such a number of representations of the trade-mark as altered as he may deem sufficient.

Inspection of Register.

Hours of inspection.

49. The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every week-day between the hours of ten and four, except on the days and at the times following:—

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

(*b.*) Days which may from to time be notified by a placard posted in a conspicuous place at the Patent Office;

(*c.*) Times when the register is required for any purpose of official use.

Power to Dispense with Evidence.

Dispensing with evidence.

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

dispense with any such act or thing, document, declaration or evidence.

Patent Rules, 77; Designs Rules, 92.

Amendments.

Amendment of documents.

51. Any document or drawing or other representation of a trade-mark for the amending of which no special provision is made by the said Act may be amended, and any irregularity in procedure which in the opinion of the Comptroller may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and on such terms as he may direct.

Act, sects. 91 and 101. Patents Rules, 18; Designs Rules, 30.

Enlargement of Time.

Comptroller may enlarge time.

52. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller, if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Cutlers' Company.

Sheffield applications in duplicate.

53. All applications to the Cutlers' Company for registration of a trade-mark, under section 81 of the said Act, shall be in duplicate, accompanied by the prescribed fees and representations.

Notice to Comptroller.

54. The Cutlers' Company shall, within seven days of the receipt by them of an application to register a trade-mark, send the Comptroller one copy of such application, by way of notice thereof, together with two representations of the mark for each class for which the applicant seeks registration.

Time within which Comptroller may object to application made at Sheffield.

55. (1.) The time within which the Comptroller shall give notice to the Cutlers' Company of any objection he may have to the acceptance of an application for registration made to the said Company shall be one month from the date of the receipt by the Comptroller of the notice from the said Company of the making of the application.

Advertisement of application made at Sheffield.

(2.) If no such objection is made by the Comptroller, the Cutlers' Company shall require the applicant to send the Comptroller a wood block or electrotype as the Comptroller may direct, and the Comptroller shall if satisfied with such wood block or electrotype, advertise the application in the same manner as an application made to him at the Patent Office.

(3.) The manner in which the Comptroller shall notify to the Cutlers' Company an application and proceedings thereon made as mentioned in subsection 8 of section 81 of the said Act shall be by sending to the Cutlers' Company a copy of the official paper containing the application of which notice is required to be given, with a note distinguishing such application.

Manner of notifying to Cutlers' Company application received by Comptroller.

56. The provisions of these Rules as to forms, representations, the proceedings on opposition to registration, registration, and all subsequent proceedings shall, as far as the circumstances allow, apply to all applications to register made to the Cutlers' Company, and to all proceedings consequent thereon.

Similarity of proceedings at London and at Sheffield.

CERTIFICATES.

57. The Comptroller, when required for the purpose of any legal proceeding or other special purpose to give a certificate as to any entry, matter, or thing which he is authorised by the said Act, or any of these Rules to make or do, may, on receipt of a request in writing, and on payment of the prescribed fee, give such certificate, and shall specify on the face of it the legal proceeding or other purpose for which such certificate is granted.

Certificate by Comptroller.

DECLARATIONS.

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

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

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

(*b.*) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(*c.*) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul or Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

59. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such

Notice of seal of officer taking declaration to prove itself.

declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

REPEAL.

Previous rules repealed.

60. All general rules as to the registration of trade-marks heretofore made by the Lord Chancellor under the Trade Marks Registration Act, 1875, and in force on the 31st day of December, 1883, shall be, and they are hereby repealed, as from that date, without prejudice, nevertheless, to any proceeding which may have been taken under such Rules.

SCHEDULES.

Approved 4th December, 1883.

FIRST SCHEDULE.

FEES.

	£	s.	d.
1. On application to register a trade-mark for one or more articles included in one class	0	5	0
2. On appeal to Board of Trade on refusal of Comptroller to register	1	0	0
3. For registration of a trade-mark for one or more articles included in one class	1	0	0
4. For registering a series of trade-marks, for every additional representation after the first in each class	0	5	0
5. For entering notice of opposition, for each trade-mark, whether in one or more classes	1	0	0
6. On application to register a subsequent proprietor in cases of assignment or transmission, the first mark	1	0	0
7. For every additional mark assigned or transmitted at the same time	0	2	0
8. For certificate of refusal to register a trade-mark under section 77	1	0	0
9. For certificate of refusal at the same time for more than one trade-mark, for each additional trade-mark after the first	0	10	0
10. For continuance of mark at expiration of 14 years	1	0	0
11. Additional fee where fee is paid within three months after expiration of 14 years	0	10	0
12. Additional fee for restoration of trade-mark where removed for nonpayment of fee	1	0	0
13. For altering address on the register, for every mark	0	5	0
14. For every entry in the register of a rectification thereof or an alteration therein, not otherwise charged	0	10	0

	£	s.	d.
15. For cancelling the entry or part of the entry of a trade-mark upon the register, on the application of the owner of such trade-mark	0	5	0
16. On request to Comptroller to correct a clerical error	0	5	0
17. For certificate of registration to be used in legal proceedings	0	10	0
18. For certificate of registration to be used for the purpose of obtaining registration in foreign countries	0	5	0
19. For copy of notification of registration	0	2	0
20. Settling a special case by Comptroller	2	0	0
21. For inspecting register, for every quarter of an hour	0	1	0
22. For making a search amongst the classified representations of trade-marks, for every quarter of an hour	0	1	0
23. For office copy of documents for every 100 words (but never less than one shilling).	0	0	4
24. For certifying office copies, MS. or printed	0	1	0
25. For certificate of Comptroller under section 96 ..	0	5	0
26. In cases where a trade-mark requires a greater space than two inches of the depth of the page of the *Trade Marks Journal*, for each additional inch or part of an inch	0	2	0
27. Manchester Trade Marks Office	Same as above		
28. Sheffield Marks	Same as above		
29. On appeal from Cutlers' Company, Sheffield, to Comptroller	1	0	0

SECOND SCHEDULE.

FORMS.

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„ Additional Representation of Trade Mark	.. ..	261
„ Appeal to Board of Trade	.. ..	262
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„ Request for Certificate of Refusal	.. .. ..	266
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TRADE MARKS.

FORM F. (a)

APPLICATION FOR REGISTRATION OF TRADE MARK.

One representation is to be fixed within this square, and two others to be sent on separate sheets of foolscap.

Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.

You are hereby requested to register the accompanying Trade Mark in Class_____, in respect of (a)_____

_____

_____

_____

in the name of (b)_____

who claims to be the proprietor thereof (c).

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

(Signed)_____

Dated this day of 1883.

(a) Only goods contained in *one and the same class* should be set out here.

A separate application form is required *for each separate class.*

(b) Here insert legibly the full name, address, and business of the individual, firm, or company. In the case of an individual, and trading style (if any).

(c) Alter to "claim to be the proprietors thereof" in the case of a firm or company.

(d) To be signed by the applicant; or, in the case of a firm, by a partner, adding "A member of the firm," or in the case of a company, by the Secretary or other Principal Officer, adding, "For the Company."

Or, in any case, an agent may sign, adding "Agent."

NOTE.—If the Trade Mark has been in use in respect of the goods since before 13th August, 1875, state length of such user.

(a) The official forms begin with D, or E. F—there are none lettered A, B, C.

FORM G.

ADDITIONAL REPRESENTATION OF TRADE MARK, TO ACCOMPANY APPLICATION FOR REGISTRATION.

One representation of the Trade Mark to be affixed within this square.

It must correspond *exactly*, in all respects, with the representation affixed to the Application Form.

Any representation of a larger size than foolscap may be folded, but must then be mounted upon linen and affixed hereto."

TWO of these ADDITIONAL REPRESENTATIONS of the Trade Mark must accompany *each* Form of Application.

In the case of a Trade Mark claimed in one of the CLASSES 23 to 35, THREE of these ADDITIONAL REPRESENTATIONS of the Mark must accompany the Form of Application.

TRADE MARKS.

FORM H.

FORM OF APPEAL TO BOARD OF TRADE ON REFUSAL OF COMPTROLLER TO REGISTER A TRADE MARK.

Sir,

I HEREBY give notice of my intention to appeal against your decision upon my application to register a Trade Mark No. _____ in Class _____ for _____

_____

and I beg to submit my case* for the decision of the Board of Trade.

I am, Sir,

Your obedient Servant,

*The statement of the case to be written upon foolscap paper (one side only), with a margin of two inches on the left-hand side thereof.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

FORM I.

FEE FOR REGISTRATION OF A TRADE MARK.

TRADE MARKS.

Sir,

In reply to your request I hereby transmit the prescribed fee for the registration of the Trade Mark No. _____, in Class _____.

I am, Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE MARKS.

FORM J.

NOTICE OF OPPOSITION TO APPLICATION FOR REGISTRATION.

[To be accompanied by an unstamped duplicate.]

In the matter of an Application,
No. by of .

Sir,

Notice is hereby given that I

of

oppose the Registration of the Trade Mark advertised under the above number for Class in the Trade Marks Journal of the day of 188 , No. , page .

The grounds of opposition are as follows:—

To be dated and signed at the end by the opponent or his solicitor.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

FORM K.

TRADE MARKS.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF.

I, (*a*)_____

(*a*) *Or* We. Here insert name, full address, and description.

hereby request that you will enter (*b*)_____ name (*c*) in the Register of Trade Marks as proprietor_____ of the Trade Mark No._____ in Class _____.

(*b*) My or our.

(*c*) *Or* names.

(*d*)_____ entitled to the said Trade Mark and to the goodwill of the business concerned in the goods with respect to which the said Trade Mark is registered.

(*d*) I am, or We are.

(*e*)_____

(*e*) Here state whether Trade Mark transmitted by death, marriage, bankruptcy, or other operation of law, and if entitled by assignment state the particulars thereof as, *e.g.*, "by deed dated the day of , 188 , made between So-and-So of the one part.

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every material fact and document affecting the proprietorship of the said Trade Mark as above claimed.

(*f*) And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.

(*g*)_____

(*g*) To be signed here by the person making the declaration.

Declared at _____

this _____ day of _____ 188 _____.

Before me,

(*h*)

(*h*) Signature and title of the authority before whom the declaration is made.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE MARKS.

FORM L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE 13TH AUGUST, 1875.

In the matter of an Application for Registration of an old Trade Mark, No. in Class .

SIR,

I, ,

of, ,

the Applicant in the above matter, hereby request you to furnish me with your Certificate of Refusal to register the said Trade Mark.

* Signature of Applicant. .

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

FORM M.

TRADE MARKS.

NOTICE OF APPLICATION FOR ALTERATION OF ADDRESS ON REGISTER OF TRADE MARKS.

In the matter of the Trade Mark,

No. registered in Class .

Sir,

Notice is hereby given that I

of

the registered proprietor of the Trade Mark numbered as above desire that my address on the Register of Trade Marks be altered to

Dated this day of 188 .

*** Signature of proprietor.**

To the Comptroller,
Patent Office, Trade Marks Branch
25, Southampton Buildings,
London.

TRADE MARKS.

FORM N.

NOTICE OF APPLICATION FOR ALTERATION OR RECTIFICATION OF REGISTER OF TRADE MARKS.

In the matter of the Trade Mark,
No. , registered in Class
in the name of

Sir,

Notice is hereby given that by an Order of the Court made on the day of 188 , it was directed that the entry on the Register of Trade Marks in respect of the Trade Mark numbered as above should be rectified in the manner therein specified.

An Office Copy of the Order of the Court is inclosed herewith.

Dated this day of 188 .

* To be signed by the person interested or his agent.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings
London.

FORM O.

TRADE MARKS.

FORM OF APPLICATION BY PROPRIETOR OF REGISTERED TRADE MARK TO CANCEL ENTRY ON REGISTER.

Trade Mark No._____ Class_____ advertised in "Trade Marks Journal," No._____, page_____.

Name of Registered Proprietor or Firm_____

_____

Place of Business_____

I, the undersigned,_____

of_____

_____ [*or* I, the undersigned,_____

_____ a member of the Firm of_____

_____ of_____

_____ on behalf of my said Firm]_____

apply that the entry upon the Register of the Trade Marks in Class_____ of the Trade Mark No._____ may be cancelled.

The_____ day of_____ 188 .

(Signed)_____

This is the statement marked "O" referred to in the Declaration of_____ _____ made before me the_____ of_____ 188 .

FORM P.

FORM OF DECLARATION IN SUPPORT OF APPLICATION FOR CANCELLATION OF TRADE MARK BY OWNER.

I, _____

_____; [*or*

I _____ a member of the Firm of

_____ of _____

_____]

do hereby solemnly and sincerely declare, to the best of my knowledge and belief, as follows:—

(1) The application signed by me, and dated the _____ day of _____ 18 , and marked with the letter "O," and shown to me at the time of making this Declaration, is true.

(2) I am the person whose name appears on the Register of Trade Marks as the Proprietor of the Trade Mark referred to in the said Application marked with the letter "O."

[*or* My said Firm is the Firm whose name appears on the Register of Trade Marks as the Proprietor of the Trade Mark referred to in the said Application marked with the letter "O."

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(Signed) _____

Declared at _____
this _____ day of _____ 18 ____.
Before me, _____

If the declaration be made before a Commissioner to administer oaths it will require to be stamped with a 2*s.* 6*d.* impressed Inland Revenue stamp.

FORM Q.

TRADE MARKS.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR IN REGARD TO A TRADE MARK.

SIR,

I HEREBY request that _____

_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE MARKS.

FORM R.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN OBTAINING REGISTRATION ABROAD.

In the matter of the Trade Mark, No. , registered in Class , in the name of

Sir,

I,

of

the registered proprietor of the above Trade Mark hereby request you to furnish me with your Certificate of Registration for use in obtaining registration of the same in *

* Here state name of country in which registration is to be sought.

Signature. †

Dated this day of , 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

FORM 8.

TRADE MARKS.

REQUEST FOR CERTIFICATE OF REGISTRATION OF TRADE MARK FOR USE IN LEGAL PROCEEDINGS.

In the matter of the Trade Mark,
No. , registered in Class
, in the name of

Sir,

I,

of

the registered proprietor of the above Trade Mark hereby request you to furnish me with your Certificate of Registration for use in the following Legal Proceedings*

* Here state exact title of legal proceedings.

†

† Signature.

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

TRADE MARKS.

FORM T.

APPLICATION FOR SETTLEMENT OF A SPECIAL CASE ON APPLICATION TO REGISTER A TRADE MARK.

In the matter of the Application
of and
of the Application of

Sir,

Notice is hereby given that I,
of
and I,

are unable to agree upon the facts on which the opinion of the Court is to be taken, and that we request you to fix a day on which we may attend before you and obtain your finding on the matters of fact to be submitted to the Court as settled.

Dated this day of , 188 .

* To be signed by both parties.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

FORM U.

TRADE MARKS.

GENERAL CERTIFICATE OF COMPTROLLER-GENERAL AS TO APPLICATION FOR OR REGISTRATION OF A TRADE MARK.

Patent Office, Trade Marks Branch,

London,

____ _____ 188 .

I,

Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

TRADE MARKS.

FORM V.

REQUEST FOR COPY OF OFFICIAL NOTIFICATION OF REGISTRATION OF TRADE MARK.

In the matter of the Trade Mark,
No. , registered
in Class .

Sir,

I, ,

of ,

the registered proprietor of the Trade Mark above named hereby request that you will furnish me with a copy of the official notification of the registration of the same.

* Signature

Dated this day of 188 .

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

FORM W.

TRADE MARKS.

FORM OF APPEAL FROM CUTLERS' COMPANY AT SHEFFIELD TO COMPTROLLER.

[To be accompanied by an unstamped duplicate.]

Sir,

I HEREBY give notice of appeal against the decision of the Cutlers' Company of Sheffield in regard to my application for registration of a Trade Mark No. , in Class for

and I beg to submit my case * for your decision accordingly.

Dated this day of , 188 .

† .

* The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

† Signature

To the Comptroller,
Patent Office, Trade Marks Branch,
25, Southampton Buildings,
London.

THIRD SCHEDULE.

General Note.

Any wares made of mixed materials (for example, of both cotton and silk) shall be included in such one of the classes appropriated to those materials as the registrar may desire.

CLASSIFICATION OF GOODS

	Illustrations.
	Note.—Goods are mentioned in this column by way of illustration, and not as an exhaustive list of the contents of a class.
Class 1.	
Chemical substances used in manufactures, photography, or philosophical research, and anti-corrosives.	Such as— Acids, including vegetable acids. Alkalies. Artists' colours. Pigments. Mineral dyes.
Class 2.	
Chemical substances used for agricultural, horticultural, veterinary, and sanitary purposes.	Such as— Artificial manure. Cattle medicines. Deodorisers. Vermin destroyers.
Class 3.	
Chemical substances prepared for use in medicine and pharmacy.	Such as— Cod liver oil. Medicated articles. Patent medicines. Plasters. Rhubarb.

CLASSIFICATION OF GOODS—*continued.*

CLASS 4.

Raw or partly prepared vegetable, animal, and mineral substances used in manufactures, not included in other classes.	Such as— Resins. Oils used in manufactures and not included in other classes. Dyes, other than mineral. Tanning substances. Fibrous substances (*e.g.*, cotton, hemp, flax, jute). Wool. Silk. Bristles. Hair. Feathers. Cork. Seeds. Coal. Coke. Bone. Sponge.

CLASS 5.

Unwrought and partly wrought metals used in manufacture.	Such as— Iron and steel, pig or cast. Iron, rough. „ bar and rail, including rails for railways. „ bolt and rod. „ sheet, and boiler and armour plates. „ hoop. Lead, pig. „ rolled „ sheet. Wire. Copper. Zinc. Gold, in ingots.

CLASSIFICATION OF GOODS—*continued.*

CLASS 6.

Machinery of all kinds, and parts of machinery, except agricultural and horticultural machines included in Class 7.	Such as— Steam engines. Boilers. Pneumatic machines. Hydraulic machines. Locomotives. Sewing machines. Weighing machines. Machine tools. Mining machinery. Fire Engines.

CLASS 7.

Agricultural and horticultural machinery, and parts of such machinery.	Such as— Ploughs. Drilling machines. Reaping machines. Thrashing machines. Churns. Cyder presses. Chaff cutters.

CLASS 8.

Philosophical instruments, scientific instruments, and apparatus for useful purposes. Instruments and apparatus for teaching.	Such as— Mathematical instruments. Gauges. Logs. Spectacles. Educational appliances.

CLASS 9.

Musical instruments.

CLASS 10.

Horological instruments.

CLASSIFICATION OF GOODS—*continued.*

CLASS 11.	
Instruments, apparatus, and contrivances, not medicated, for surgical or curative purposes, or in relation to the health of men or animals.	**Such as—** **Bandages.** **Friction gloves.** **Lancets.** **Fleams.** **Enemas.**
CLASS 12.	
Cutlery and edge tools.	**Such as—** **Knives.** **Forks.** **Scissors.** **Shears.** **Files.** **Saws.**
CLASS 13.	
Metal goods not included in other classes.	**Such as—** **Anvils.** **Keys.** **Basins (metal).** **Needles.** **Hoes.** **Shovels.** **Corkscrews.**
CLASS 14.	
Goods of precious metals (including aluminium, nickel, Britannia metal, &c.) and jewellery, and imitations of such goods and jewellery.	**Such as—** **Plate.** **Clock cases and pencil cases of such metals.** **Sheffield and other plated goods.** **Gilt and ormolu work.**
CLASS 15.	
Glass.	**Such as—** **Window and plate glass.** **Painted glass.** **Glass mosaic.** **Glass beads.**

CLASSIFICATION OF GOODS—*continued.*

CLASS 16.

Porcelain and earthenware.	Such as— China. Stoneware. Term Cotta. Statuary porcelain. Tiles. Bricks.

CLASS 17.

Manufactures from mineral and other substances for building or decoration.	Such as— Cement. Plaster. Imitation marble. Asphalt.

CLASS 18.

Engineering, architectural, and building contrivances.	Such as— Diving apparatus. Warming apparatus. Ventilating apparatus. Filtering apparatus. Lighting contrivances. Drainage contrivances. Electric and pneumatic bells.

CLASS 19.

Arms, ammunition, and stores not included in Class 20.	Such as— Cannon. Small arms. Fowling pieces. Swords. Shot and other projectiles. Camp equipage. Equipments.

CLASSIFICATION OF GOODS—*continued.*

CLASS 20.	
Explosive substances.	Such as— Gunpowder. Gun-cotton. Dynamite. Fog-signals. Percussion caps. Fireworks. Cartridges.
CLASS 21.	
Naval architectural contrivances and naval equipments not included in Classes 19 and 20.	Such as— Boats. Anchors. Chain cables. Rigging.
CLASS 22.	
Carriages.	Such as— Railway carriages. Waggons. Railway trucks. Bicycles. Bath chairs.
CLASS 23.	
Cotton yarn and thread.	Such as— Sewing cotton on spools or reels. Sewing cotton not on spools or reels. Dyed cotton yarns.
CLASS 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings. Long cloth.

CLASSIFICATION OF GOODS—*continued.*

CLASS 25.

Cotton goods not included in Classes 23, 24, or 38.	Such as— Cotton lace. Cotton braids. Cotton tapes.

CLASS 26.

Linen and hemp yarn and thread.

CLASS 27.

Linen and hemp piece goods.

CLASS 28.

Linen and hemp goods not included in Classes 26, 27, and 50

CLASS 29.

Jute yarns and tissues, and other articles made of jute not included in Class 50.

CLASS 30.

Silk, spun, thrown, or sewing.

CLASS 31.

Silk piece goods.

CLASS 32.

Other silk goods not included in Classes 30 and 31.

CLASS 38.

Yarns of wool, worsted, or hair.

CLASSIFICATION OF GOODS—*continued.*

CLASS 34.	
Cloths and stuffs of wool, worsted, or hair.	
CLASS 35.	
Woollen and worsted and hair goods not included in Classes 33 and 34.	
CLASS 36.	
Carpets, floor-cloth, and oil-cloth.	Such as— Drugget. Mats and matting. Rugs.
CLASS 37.	
Leather, skins unwrought and wrought, and articles made of leather not included in other classes.	Such as— Saddlery. Harness. Whips. Portmanteaus. Furs.
CLASS 38.	
Articles of clothing.	Such as— Hats of all kinds. Caps and bonnets. Hosiery. Gloves. Boots and shoes. Other ready-made clothing.
CLASS 39.	
Paper (except paper hangings), stationery, and book-binding.	Such as— Envelopes. Sealing wax. Pens (except gold pens). Ink. Playing cards. Blotting cases. Copying presses.

CLASSIFICATION OF GOODS—*continued.*

CLASS 40.	
Goods manufactured from india-rubber and gutta-percha not included in other classes.	
CLASS 41.	
Furniture and upholstery.	**Such as—** **Paper hangings.** **Papier-mâché.** **Mirrors.** **Mattresses.**
CLASS 42.	
Substances used as food, or as ingredients in food.	**Such as—** **Cereals.** **Pulses.** **Olive oil.** **Hops.** **Malt.** **Dried fruits.** **Tea.** **Sago.** **Salt.** **Sugar.** **Preserved meats.** **Confectionery.** **Oil cakes.** **Pickles.** **Vinegar.** **Beer clarifiers.**
CLASS 43.	
Fermented liquors and spirits.	**Such as—** **Beer.** **Cyder.** **Wine.** **Whisky.** **Liqueurs.**

CLASSIFICATION OF GOODS—*continued*.

CLASS 44.

Mineral and aërated waters, natural and artificial, including ginger-beer.

CLASS 45.

Tobacco, whether manufactured or unmanufactured.

CLASS 46.

Seeds for agricultural and horticultural purposes.

CLASS 47.

Candles, common soap, detergents; illuminating, heating, or lubricating oils; matches; and starch, blue, and other preparations for laundry purposes.

Such as—
Washing powders.
Benzine collas.

CLASS 48.

Perfumery (including toilet articles, preparations for the teeth and hair, and perfumed soap).

CLASS 49.

Games of all kinds and sporting articles not included in other classes.

Such as—
Billiard tables.
Roller skates.
Fishing nets and lines.
Toys.

Classification of Goods—*continued.*

Class 50.

Miscellaneous, including—	Such as—
(1.) Goods manufactured from ivory, bone, or wood, not included in other classes.	Cooper's wares.
(2.) Goods manufactured from straw or grass, not included in other classes.	
(3.) Goods manufactured from animal and vegetable substances, not included in other classes.	
(4.) Tobacco pipes.	
(5.) Umbrellas, walking sticks, brushes and combs.	
(6.) Furniture cream, plate powder	
(7.) Tarpaulins, tents, rick-cloths, rope, twine.	
(8.) Buttons of all kinds, other than of precious metal or imitations thereof.	
(9.) Packing and hose of all kinds.	
(10.) Goods not included in the foregoing classes.	

APPENDIX.

[NOTE.—*The information and instructions contained in this Appendix have been issued by the official authorities for the benefit of persons proposing to apply for Patents, or to register Designs or Trade-Marks.*]

I.

INFORMATION FOR INTENDING APPLICANTS FOR PATENTS FOR INVENTIONS.

1. All applications and communications must be made in English. No models are required.

2. Any person, whether a British subject or not, may make an application for a patent.

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

4. Applications may be left at the Patent Office or be sent, prepaid, by post. Applications sent by post must be addressed to the Comptroller, Patent Office, 25, Southampton Buildings, Chancery Lane, London.

5. Forms of application may be obtained at the undermentioned places in the United Kingdom:—

(*a.*) At the Inland Revenue Office, Royal Courts of Justice.

(*b.*) At the following Post Offices:—

London General Post Office, E.C.
District Post Office, 226, Commercial Road, E.
" 9, Blackman Street, Borough, S.E.
" Charing Cross, W.C.
" 28, Eversholt Street, Camden Town, N.W.
Post Office, 12, Parliament Street, S.W.

(*c.*) The Chief Post Offices at the more important towns in the United Kingdom.

6. The "declaration" in the form of application does not require to bear a 2*s.* 6*d.* stamp when made before a Commissioner.

7. An application for provisional protection consists of—
(*a.*) The form of application (*a*), either Patent Form A or A1, fee £1 each form.
(*b.*) The form of provisional specification (Patent Form B) (gratis).

8. An application for complete protection consists of—
(*a.*) The form of application, either Patent Form A or A1, as for provisional protection, fee £1 each form; and
(*b.*) The form of complete specification (Patent Form C) £3.

9. The object of a provisional (*b*) specification is to afford to intending patentees a period of nine months provisional protection in which to develop their inventions, but it is not necessary to leave a provisional specification when an intending patentee is prepared to leave a complete specification in the first instance. Where a provisional specification has been left, the applicant is required by Act to leave a complete specification in connexion with such provisional specification within nine months (*c*) from the date of the provisional specification, should he desire to obtain a patent. Where a complete specification is left after a provisional specification a second application form is not required.

In order to avoid unnecessary trouble, applicants should carefully read the directions upon the forms of application before filling them up.

10. The "declaration" (*d*) in the form of application must be signed by the applicant or applicants; but all other communications may be made by or through agents duly authorised to the satisfaction of the Comptroller.

11. The specifications and all other documents must be written or printed in large and legible characters upon strong wide-ruled foolscap paper of a size of 13 inches by 8 inches (on one side only), leaving a margin of two inches on the left-hand part thereof; and the signatures of the applicants or agents thereto must be written in a large and legible hand.

(*a*) *Note.*—There are two forms of application, namely, one Patent Form A, when the application is made by the applicant or applicants; and Patent Form A 1 when the invention is a "communication" from abroad.

(*b*) Act, sect. 5.

(*c*) Act, sect. 8.

(*d*) Act, sect. 5, sub-sect. 2.

12. The drawings (*e*) accompanying provisional or complete specifications must be made upon half sheets or sheets of imperial drawing paper, to be within a border line of 19 inches by 12 inches, or 27 inches by 19 inches with a margin of half an inch all round.

A copy of the drawings will be required upon *rolled* imperial drawing paper or upon thin Bristol board of the same dimensions as the original drawing or drawings. All the lines must be absolutely black, Indian ink of the best quality to be used, and the same strength or colour of the ink maintained throughout the drawing. Any shading must be in lines clearly and distinctly drawn and as open as is consistent with the required effect. Section lines should not be too closely drawn. No colour must be used for any purpose upon the copy of the drawings. All letters and figures of reference must be bold and distinct. The border line should be one fine line only. The drawings must not be folded, but must be delivered at the Patent Office either in a perfectly flat state or rolled upon a roller so as to be free from creases or breaks (*f*).

13. With a view of preparing an illustrated journal of patented inventions as directed by the Act, every applicant must, after his application has been accepted, also furnish the Patent Office with the drawing and concise explanatory statement required by Rule 31.

14. Copies of the Patent Rules (price, prepaid, [7*d.*], including postage within the United Kingdom) can be obtained from the Patent Office, Sale Branch, 88, Cursitor Street, Chancery Lane, E.C.

Applications for copies of the Rules should be addressed to the Comptroller, at the above address.

15. Every patent will be granted for the term of 14 years from its date, subject to the payment of £50 before the end of the fourth year of the term, and £100 before the end of the eighth year, or in lieu thereof to the payment of annual or renewal fees of £10, £15, and £20, commencing before the expiration of the fourth year of the term, and extending to and inclusive of the thirteenth year; for amount of fees, *see* Schedule of Fees annexed to the Rules. These

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(*e*) Act, sect. 5, sub-sect. 1. Sect. 6, 10.

(*f*) As the drawings accompanying the provisional and complete specification respectively are copied at the Patent Office for publication by the process of photolithography, this rule must be strictly observed, in order that correct copies may be made.—*Official Note.*

payments must be made by way of stamped forms which may be obtained at the places set forth in the list in paragraph 5.

16. The subsequent fees to be paid upon applications made prior to the 1st of January, 1884, are:—

(a.) The stamp duties required under the Patent Law Amendment Acts of 1852-3, must be paid upon subsequent proceedings in connexion with applications made prior to 1st January, 1884, up to and including the £5 stamp duty upon filing the "final" specification as required by Act. All applications under the Acts of 1852-3 must be completed in accordance with their provisions up to the stage of filing the final specification. Patents granted upon applications made prior to the first of January, 1884, are exempt from the provisions of the Act of 1883, as to the compulsory grant of licenses.

(b.) The payments which, under the conditions of the Letters Patent are payable before the end of the third year (1884), are by the Act of 1883, made payable before the end of the fourth year (1885); the fee may be paid either in one sum or by annual payments. (See Schedule of Fees).

(c.) The seventh year's payment, which under the conditions of Letters Patent is payable before the end of the seventh year, must in those instances where the £50 payment has already been paid, be paid as heretofore in one sum of £100.

In cases where the patentee has elected before the end of the fourth year to pay annual fees, he must, should he desire to keep his patent in force, continue the annual payments to the end of the term.

NOTE.—*As to the fees payable in respect of patents, see the Official Notice, ante, p. 275.*

II.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER DESIGNS UNDER THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Preliminary.

1. The Patents, Designs, and Trade Marks Act, 1883, and the Rules published in pursuance of that Act for the Registration of Designs, should be carefully studied.

Copies of the Rules, together with the Act, may be obtained on payment of 2*s.* for each copy at the Patent Office, Sale Branch, 88, Cursitor Street, London, E.C.

Copies will also be sent by post, on a prepaid application to that address, accompanied by a Post Office Order for the amount payable to H. Reader Lack, at the Chancery Lane Post Office, London, W.C.

2. In order to obtain registration application must be made to the Comptroller in pursuance of Rules Nos. 6–12.

Applications.

3. Stamped Forms of Application to register have been issued, and can be obtained at the principal agencies in the United Kingdom, hereinafter mentioned (*g*).

Applications sent by post should be addressed—

The Comptroller,
Patent Office,
Designs Branch,
25, Southampton Buildings,
London, W.C.

4. An application (*h*) consists of the following:—

(1.) The form of application, Form E, properly filled up, and

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(*g*) See *ante*, p. 289, for list of places.

(*h*) Designs Rules, 6-13, *ante*, pp. 227-8.

such evidence as will enable the Comptroller to identify the design.

(*e.*) If it is desired to secure a date of registration at once, one sketch of the design may be sent with the application form. In this case the design, if accepted, will be registered as of the date on which it was received; but no certificate will be issued until three exact drawings or specimens have been sent in substitution for the sketch. Or,

(*f.*) The application may be complete in the first instance if applicant sends three exactly similar drawings, photographs, or specimens.

The Drawings or Photographs.

5. The drawings (*i*), &c., accompanying an application must be sent in triplicate, each representation of each design upon strong foolscap paper (on one side only) of the size of 13 in. by 8 in.

6. When sketches, drawings, or tracings are furnished, they must be fixed. Drawings on tracing paper cannot be received. If tracings are supplied they must be done on tracing cloth or mounted on thick paper.

7. Rough sketches cannot be accepted.

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

9. When specimens (*k*) of the design are furnished in lieu of drawings, &c., they must be of such a nature as can be pasted into books, and the dimensions of each such specimen must not exceed 12 in. by 21 in.

10. The representations of a design should not be accompanied by any lengthened explanatory statement.

11. Only two views of the same design can be accepted, unless in the case of a design for a set.

12. All goods to which registered designs are applied—Classes (*l*) 1 to 12—should during the period of copyright bear the abbreviation "R." and the number given on registration.

(*i*) Designs Rules, 8, 9. (*k*) Ibid. 9. (*l*) Ibid. 5.

All goods to which registered designs are applied—Classes 13 and 14—should during the period of copyright bear the abbreviation "Regd."

13. The following is a list of the stamped forms to be had at the places mentioned in paragraph 3:—

DESIGNS.

Letter.	Title of Form.	Fee. £ s. d.
E	Application for Registration of Design in Classes 1 to 12	0 10 0
E	Application for Registration of Design in Classes 13 and 14 (woven and printed textiles)	0 1 0
F	Appeal to Board of Trade on refusal of Comptroller to Register a Design	1 0 0
H	Application for Copy of Certificate of Registration of Design	0 1 0
I	Request for Certificate for use in Legal Proceedings	0 5 0
K	Request to enter Name of subsequent Proprietor of Design, with Declaration in support thereof:— In Classes 1 to 12	0 10 0
K	" " 13 and 14 (woven and printed textiles)	0 1 0
L	Notice of intended Exhibition of an Unregistered Design	0 5 0
M	Request for Correction of Clerical Error or Address	0 5 0
N	Request for Search under Sect. 53	0 5 0
O	Application to Register Design for "Set" of Articles	1 0 0

N.B.—Forms E classes 1 to 12, E classes 13 and 14, and O are kept on sale at the places named in paragraph 3. The other forms must be bespoken of the post-masters at those places.

The Patent Office, Designs Branch, is open from 10 A.M. to 4 P.M.

III.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER TRADE-MARKS.

Preliminary.

1. All communications relating to Trade-Marks, not being Sheffield marks, should be addressed to the Comptroller, Patent Office, Trade-Marks Branch. All applications should be in the English language.

They may be made by post, or left at the Patent Office, Trade-Marks Branch, 25, Southampton Buildings, Chancery Lane, London, W.C.

2. The fees in relation to Trade-Marks Registration cannot be received at the Patent Office. They should be paid in exchange for the stamped forms required, which may be obtained at the following places (*m*.)

3. The following is a list of the stamped forms under the Patents, Designs, and Trade-Marks Act, 1883, which relate to Trade-Marks, and which may be obtained at the places mentioned above:—

Trade-Marks.

Letter.	Title of Form.	Fee.
		£ s. d.
F	Application for Registration of Trade-Mark .	0 5 0
G	Additional Representation Form . . .	No stamp.
H	Appeal to Board of Trade on Refusal of Comptroller to Register a Trade-Mark . . .	1 0 0
I	Registration Fee	1 0 0
J	Notice of Opposition to Application for Registration	1 0 0
K	Request to enter Name of subsequent Proprietor, with Declaration in support thereof . .	1 0 0
L	Request for Certificate of refusal to Register a Trade-Mark	1 0 0

(*m*) See *ante*, p. 263, for list of places.

TRADE-MARKS—*continued.*

Letter.	Title of Form.	Fee. £ s. d.
M	Notice of Application for Alteration of Address .	0 5 0
N	Notice of Application for Alteration or Rectification of Register	0 10 0
O	Application to Cancel Entry of Mark on Register	0 5 0
Q	Request for Correction of Clerical Error . .	0 5 0
R	Request for Certificate of Registration for use Abroad	0 5 0
S	Request for Certificate of Registration for use in Legal Proceedings	0 10 0
T	Application for Settlement of a Special Case .	2 0 0
T 1	Request for General Certificate of Comptroller .	0 5 0
V	Request for Copy of Official Notification . .	0 2 0
W	Appeal from Cutlers' Company at Sheffield to Comptroller	1 0 0

Of the above forms those bearing the letters "F," "G," and "I" are kept in stock at the various offices named in paragraph 2. Any of the others when required must be bespoken.

SALE OF OFFICIAL PUBLICATIONS (*a*).

DEFINITION OF A TRADE-MARK.

7. The definition of a Trade-Mark (not used prior to the 13th August, 1875), is given in the 64th section (*c*) of the Patents, Designs, and Trade-Marks Act, 1883, as follows:—

"For the purposes of this Act, a Trade-Mark must consist of or contain at least one of the following essential particulars:

"A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"A written signature or copy of a written signature of the individual or firm applying for registration thereof as Trade-Mark; or

"A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use."

All new Marks, therefore, which it is desired to register *must include one or more of the above essential particulars.*

(*a*) Clauses 4, 5, 6, relate to the sale of the Act, the Rules, and the *Trade-Marks Journal*, and give a list of the publishers from whom they can be obtained.

(*c*) Pages 119-120, *ante*.

The 64th section goes on—"There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or any of them."

In addition to the above—

"Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a Trade-Mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a Trade-Mark under this part of this Act."

A person wishing to adopt a Trade-Mark should, before engraving a block and circulating impressions of the Mark among his customers, make a search (*p*) or a formal application at the Trade-Marks Branch of the Patent Office with the view of ascertaining whether his proposed Mark is already registered, or whether, from its being calculated to deceive by a resemblance to other Marks already on record, it would be refused registration under the 72nd section of the Patents, Designs, and Trade-Marks Act, 1883.

The fee for making a search amongst the classified representations of Trade-Marks is 1s. for each quarter of an hour. The fee for a formal Application is 5s.

The Comptroller does not undertake to make searches amongst the Trade-Marks recorded at his Office, except in connection with formal applications for registration.

Applications for Registration.

8. Applications sent by post should be addressed to—

The Comptroller,
Patent Office,
Trade-Marks Branch,
25, Southampton Buildings,
London, W.C.

Agents and other persons who may be interested in more than one Application are particularly requested to make communications relating to different Applications in *separate* letters.

9. An Application for the registration of a Trade-Mark consists of:—

(*a.*) An Application Form (Form "*F.*" in the Second Schedule to the Trade-Marks Rules, 1883), giving certain particu-

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(*p*) Trade-Marks Rules, 19, *ante*, p. 253.

lars (specified in the form), and bearing an impressed stamp of 5s.

(The Applicant should before filling up the form carefully read the marginal notes).

(*b.*) Certain additional representations of the Trade-Mark, mounted on forms (Form "*G.*").

10. A *separate* Application Form is required for *each* class.

11. If the mark be the property of a firm (*q*), it should be signed by a member of the firm, who should add after his signature "A Member of the Firm;" if of a company, by the secretary or other principal officer, who shall add after his signature, and designation, "for the Company."

12. Applications may be made by agents (*r*) in the names of and on behalf of the owners of trade-marks. The agent must be duly authorised by the owner or owners; the necessary authority should be signed by the owner or owners.

Applications made by agents should have after the name of the agent the description "Agent."

13. A representation of the trade-mark should be placed in the centre of the Application Form.

14. Where an application is made for a trade-mark used on any metal goods other than cutlery, edge tools, and raw steel, it should be stated in the Application Form of what metal or metals the goods are made. See section 81 of the Act as to Sheffield marks.

15. When the mark consists of or includes words printed in other than Roman characters, (*s*) there should be given at the back of or at the foot of the Application Form and of each of the additional representations a translation of such words, signed by the applicant or his agent.

In the case of marks claimed in Classes 23, 24, or 25, the applicant should state by what name the particular mark claimed would be referred to in the invoices of his house.

Additional Representations of Mark.

16. Each of the additional (*t*) representations should be placed in the centre of a separate form (Form "*G.*").

In the case of a trade-mark which is not claimed in Classes 23

(*q*) Trade-Marks Rules, 7, *ante*, p. 216.
(*r*) Ibid. 8.
(*s*) Ibid. 15.
(*t*) Ibid. 13.

to 35, *two* additional representations are required for *each* class claimed.

In the case of a trade-mark claimed in any one or more of the Classes 23 to 35 *three* additional representations should be sent for *each* of such classes.

The representations of the mark on the Form "*G*." must agree *in every respect* with each other, and with that of the Form "*F*."

17. Representations of a mark of a large size may be folded. In that case they must, however, be backed with linen and firmly affixed to the forms. Representations must in no case be executed *in pencil*. They should be not only of a durable nature, but of such a kind as will admit of their being preserved and bound together in volumes as records of the property of the owners.

Series of Trade-Marks.

18. By section 66 (*a*) of the Patents, Designs, and Trade-Marks Act, 1883, the Comptroller is empowered to register under one registration a series of trade-marks which, whilst they resemble each other in the material particulars, differ from each other in respect of the statements of the goods for which they are used, of the statements of numbers, of the statements of price, of the statements of quality, or of the statements of names of places. When an application is made for such a series, a representation of each of the marks included in the series must be affixed to the Form "*F*." and also to *each* of the Forms "*G*."

Common or Open Marks.

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

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

See section 71 of the Act, sub-section 3, for definition of common marks.

(*a*) *Ante*, p. 130, and Trade-Marks Rules, 14, *ante*, p. 247.
(*x*) See *ante*, pp. 130, 123–4.

Classification (*y*) of Goods.

20. A Guide to the classification of Goods under the Trade-Marks Rules, 1883, can be obtained on application at the Patent Office, Trade-Marks Branch, and should be asked for if the applicant feels any difficulty in determining to which of the classes set out in the third schedule to the rules the goods for which he uses his mark belong.

Advertisement (*z*) in the Trade-Marks Journal.

21. A trade-mark cannot in any case be entered upon the Register until two months after its advertisement in the Official Paper.

22. A wood-block or electrotype (*a*) must be furnished for each mark in each class claimed (except in the case of Classes 23, 24, and 25, for which no blocks or electrotypes are required) but no block or electrotype should be forwarded until a formal demand for it is sent by the Comptroller.

23. In the case of a series of trade-marks differing only in respect of the particulars mentioned in Section 66 of the Patents, Designs, and Trade-Marks Act, 1883, a wood-block or electrotype must be furnished for each mark in the series for each class claimed.

24. The wood-blocks or electrotypes furnished must correspond *exactly* with the representations, must afford *perfectly distinct* impressions of the marks, and must be upon a scale sufficiently large to reproduce the marks faithfully. Worn or mutilated blocks or electrotypes cannot be accepted.

25. The largest space available for the insertion of any single block or electrotype is eight and a half inches broad by ten inches deep.

When a block or electrotype *exceeds two inches in depth*, a charge for additional space is made, at the rate of two shillings for every inch or part of an inch beyond the two inches.

26. The number given by the Comptroller should *not* be cut on the face of the block or electrotype, but should be *marked upon the side* in such a manner as to secure its identification.

27. All blocks or electrotypes should be sent to the Patent

(*y*) Trade-Marks Rules, 6, *ante*, p. 245.

(*z*) Ibid. 25-28.

(*a*) Ibid. 27.

Office, Trade-Marks Branch, together with the papers marked "Form 2," and with the representation of the mark sent for the guidance of the applicant in preparing the blocks or electrotypes.

28. The blocks or electrotypes supplied for the advertisement of trade-marks cannot in any case be returned to applicants.

Restrictions (*b*) on Registration.

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

30. The Royal Arms, or arms so nearly resembling them as to be calculated to deceive, and the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery," "Patent," "Patented," will not be registered under the Patents, Designs, and Trade-Marks Act, 1883, and should not, therefore, appear upon the Representations of Trade-Marks forming part of an application.

31. The following will not be registered as trade-marks, or as prominent parts of trade-marks, unless the marks have been used before 13th August, 1875:—

Representations of Her Majesty the Queen, or of any member of the Royal Family.

Representations of the Royal Crown.

National arms or flags.

Prize or exhibition medals.

32. When there appears on the face of a trade-mark an indication of the goods to which the mark is applied, the claim for its registration must be in respect of those goods only.

Forms of Counter-statement (*c*) and Bond.

33. The following is a form of Counter-statement:—

Patents, Designs, and Trade-Marks Act, 1883.

Trade-Marks.

In the Matter of an Application No.
and of the Opposition thereto No.

In reply to the Notice of Opposition in this matter by

(*b*) See sects. 73 and 76, and also, *ante*, pp. 121-4.
(*c*) See *ante*, pp. 131-2.

of , I give notice by way of Counter-statement that I rely for my application on the following grounds:—

(To be dated and signed by the applicant or his solicitor.)

To the Comptroller,
Patent Office,
Trade-Marks Branch,
25, Southampton Buildings,
London.

The following is a Form of Bond which the Comptroller is able to accept from persons opposing applications, and who have been required to give security for costs:—

Patents, Designs, and Trade-Marks Act, 1883.
Trade-Marks.

In the Matter of an Application No.
and of the Opposition thereto No.

Know all men by these presents that we of and of are jointly and severally held and firmly bound to Henry Reader Lack the Comptroller-General of Patents Designs and Trade-Marks in the penal sum of pounds of good and lawful money of Great Britain to be paid to the said Henry Reader Lack or to other the Comptroller-General of Patents Designs and Trade-Marks for the time being for which payment to be well and faithfully made we bind ourselves and each of us our and each of our heirs executors and administrators firmly by these presents sealed with our seals.

Dated this day of 18 .

Whereas pursuant to the provisions of the Patents Designs and Trade-Marks Act 1883 and of the Trade-Marks Rules, 1883, an application (No.) has been made by of to the Comptroller-General of Patents Designs and Trade-Marks for the registration of a certain trade-mark And whereas the above-bounden have delivered a notice of opposition to such registration and the said have sent to the said Comptroller-General a counter-statement of the grounds on which they rely for their application And whereas the said

Comptroller-General pursuant to the terms of the said Act hath required the said to enter into the above-written obligation (subject to the condition hereinafter contained) as security for such costs as may be awarded in respect of such opposition.

Now the condition of the above-written obligation is such that if the said or either of them their or either of their heirs executors or administrators do and shall well and truly pay or cause to be paid to all such costs as the High Court of Justice shall think fit to award to the said in respect of the said opposition, then the above-written obligation is to be void or else to remain in full force and virtue.

Signed, sealed and delivered by the above-bounden and in the presence of .

31. Before he is required to bring an opposition matter before the Court under Rule 29, the applicant is afforded an opportunity of objecting, if he think fit, to the solvency of the security for the costs which may be awarded in respect of the opposition.

Fees.

35. See the First Schedule to the Trade-Marks Rules, 1883, and the List of Forms, par. 3, of these instructions.

36. *An application for the Registration of a Trade-Mark will not be entered by the Comptroller, unless it be accompanied by the proper fees in impressed Stamps.*

Cutlers' Company.

37. By sect. 81 (*d*), sub-sect. 3, of the Patents, Designs, and Trade-Marks Act, 1883, application for the registration of Trade-Marks used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company.

See Rules 53 to 56 and par. 14 of these Instructions.

Applications made to the Cutlers' Company in pursuance of

(*d*) *Ante*, p. 116.

sect. 81 of the Patents, Designs, and Trade-Marks Act, 1883, should be made on Form "*F*," the address in the left-hand corner to be, "To the Cutlers' Company, Sheffield," instead of "To the Comptroller," and should be left at, or sent by post to, the Cutlers' Hall, Sheffield.

Each application should be accompanied by an unstamped copy on foolscap paper. *See* Rule 53.

Applications sent by post should be addressed—

CHAS. MACRO WILCOX, Esq.,
The Law Clerk,
The Cutlers' Hall,
Sheffield.

MANCHESTER OFFICE.

38. For the convenience of merchants and manufacturers engaged in the Cotton Trade, and for the purpose of facilitating the recording of trade-marks used in respect of Cotton Goods, an office will be opened at 48, Royal Exchange, Manchester, where searches can be made on payment of 1*s.* for each quarter of an hour for all marks in classes of Textiles from Class 23 to Class 25.

CERTIFICATES.

39. The Comptroller's certificate in relation to a trade-mark is of four kinds, viz.—

(i.) For use in legal proceedings (*e*).
(ii.) For use in applying for registration in Foreign countries.
(iii.) Of any application made and of proceedings thereon.
(iv.) A certificate of refusal (*e*) of a mark in use before 13th August, 1875, and not registerable.

40. A person desirous of obtaining any of the above certificates should forward Form "*R*," Form "*S*," Form "*T 1*" or Form "*L*" (see par. 8), as the case may be, to the Comptroller, giving the Comptroller's official number of the mark, and stating whether the certificate is required for use in legal proceedings, or for use in applying for the registration of the mark in a Foreign country, or for what other purpose.

The form should be accompanied by two unmounted copies of each mark for which a certificate is required.

(*e*) Sect. 77, *ante*, p. 138.

41. In every case where a certificate is required in respect of a cotton mark, or in respect of any trade-mark of which the representations or specimens forming part of the application for registration are *coloured*, two unmounted copies of the mark must be supplied, agreeing *in every respect* with the representations forming part of the application for registration. Special attention should be paid to this requirement, as the certificate cannot in any such case be prepared until these unmounted copies are received by the Comptroller.

Registration of subsequent Proprietors of Registered Trade Marks.

42. The request and declaration to be made by a subsequent proprietor on application for the registration in his name of a registered trade-mark must be made on Form "A" (see par. 3).

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