INFORMATION AND NOTES ON SOME OF THE PROVISIONS OF "THE PATENTS AND DESIGNS ACT, 1919," AND "THE TRADE MARKS ACT, 1919."

FOR THE CLIENTS AND CORRESPONDENTS OF

HASELTINE, LAKE & CO.,

Chartered Patent Agents,

28, SOUTHAMPTON BUILDINGS, CHANCERY LANE,

LONDON, W.C. 2.

AND AT

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Introduction and Prefatory Warning.

These pages are not intended to constitute a primer or text book on the new Acts, nor are they intended, any more than such a work, to supersede personal professional guidance and advice in specific cases and circumstances, which is so necessary where any material interest is concerned. In such cases proper professional advice should always be sought on the case, but we hope that the matter of the following pages will help the reader to appreciate the circumstances arising out of the new enactments in which such advice is desirable or necessary.

The Patents and Designs Act, 1919, and the Trade Marks Act, 1919, have made a number of important changes in the laws concerning Patents, Designs and Trade Marks. Many of these changes, although important, are in technical matters that do not directly interest the layman, and only affect his interests on specific occasions of such character that he has to seek particular professional assistance. It is not important, therefore, that he should instruct his mind in regard to these changes for the purpose of general future guidance and consequently it is not proposed to deal with them in these pages, but on the other hand, some of the changes of the laws effected by the Acts referred to are such that the layman should be informed on them in order that his course of action should be properly guided in a general manner to the end that his interests may not be prejudiced in absolute ignorance and some others of the changes are of such a character that it is useful for him to know of them in a general way. It is accordingly here proposed to explain to our clients those provisions of the recent Acts, which, from those points of view, are the more important.

PATENTS.

Time for completing an Application with Provisional Specification.

Where a Patent Application is accompanied by a Provisional Specification, which as is generally known, is the more customary procedure, the Final Specification which must be filed, if the Application is to be completed and the Letters Patent obtained, has now to be filed within nine months from the date of the Application instead of six months as formerly. As before, one month's extension of this period may be obtained by taking the proper steps and paying the prescribed Stamp Duty. A Provisional Specification need only contain a description of the nature of the invention, but the Final Specification must disclose the manner in which the invention may be properly practised, without calling for any further inventive skill or labour. Six months is in many cases all too short a period in which to design, and perhaps also construct and test, a suitable practical embodiment of the invention, and to have the Final Specification carefully prepared and filed at the Patent Office. From this point of view the increase of the period to nine months is advantageous. There is, however, another very important aspect of this change which should be borne in mind. In respect of the majority of important countries abroad International and Colonial arrangements exist under which an applicant for British Patent resident or having an establishment here, may, if he decides to file corresponding applications in these countries, obtain for these applications the priority of the date of the British Application, provided the applications abroad are filed

within twelve months from the date of the British Application. It is true that in some foreign countries this priority is not effective for all purposes, but it should at least protect the applicant against the effect of publication of the invention by himself or others in the meantime in periodicals and the like, and Patent applicants usually desire to avail themselves of these provisions when feasible. In fact, in the United States it is most important for a British Applicant to file his Patent Application there within such period of twelve months whether or not publication has taken place or is likely to take place in the meantime, because otherwise a valid Patent cannot be obtained there unless it be actually issued before grant of a Patent elsewhere on any application filed more than twelve months before the United States Application, and this it is not always feasible to do. Heretofore as the British Final Specification had to be filed within six—or with extension seven—months after the application for Patent it was usually possible to await the first report of the British Patent Office in regard to the result of its official search respecting the novelty of the invention before the applicant need decide whether he should file corresponding Patent Applications in countries to which the twelve months provision referred to applies. As the report referred to often shows that the invention claimed has not the extent or ambit of novelty it was thought to possess, we have usually, in ordinary circumstances, advised our clients to the effect that taking all points into consideration, it would be well to defer action abroad until receipt of the said report. In future, where the priority explained above is to be claimed it will be necessary to decide in regard to Foreign and Colonial applications about the time the British Final Specification is to be filed, except of

course in cases where the nine months' period is not taken advantage of to the full extent, in a substantial degree. Where Patent Applications abroad are contemplated it is therefore advisable to have the Final Specification prepared and filed at the earliest possible time consistently with its comprising all the details of the invention and the manner in which it may be practised sufficient to ensure that the Patent will be valid on that score. Thus time may be afforded in which to receive the first Patent Office report in regard to novelty, which although by no means conclusive, may give important information that should be before a client when he is deciding in regard to Patent Applications abroad, and should be in our knowledge also in order that the Specifications for the countries abroad may be put in the most acceptable terms in the circumstances.

Disclosure of Official Citations.

Heretofore it has not been possible to obtain, except through the patentee himself, particulars of prior Patent Specifications cited by the British Patent Office in connection with any particular Patent Application, and as a result of the official search made. By making application in the prescribed manner to the Patent Office it is now however possible for anyone to obtain these particulars. This new provision, while naturally somewhat disadvantageous to the owners, as such, of British Patents, will be of benefit to applicants or proposing applicants for Patents and others desirous for any purpose of having professional opinion on the validity of a Patent in cases where heretofore they could not obtain the same information otherwise than by having an expensive and tedious search made in British Patent Office records at their own expense. An inventor, if he happens to

know of one prior recent British Patent having relation in some degree to his invention, will be able to be supplied with particulars of prior specifications officially cited against it, and such prior specifications or some of them may have an important bearing on the question whether his invention is novel or to what extent it is novel. In some cases a short search may enable us to find a prior specification which would be useful for the purpose explained. These steps are of course by no means necessarily conclusive, but in many cases would enable us to prepare the final specification in better terms than we could without the information.

It has always been possible for a third party to obtain similar information from the United States official records in regard to any particular United States Patent.

Extension of the Grounds of Opposition.

For many years it has been possible for a properly interested party or a person aggrieved to oppose the grant of a British Patent to another, provided the prescribed proceedings be initiated and prosecuted at the proper time and in the proper manner. There is hardly need to explain here the grounds on which such an opposition could be based as they are somewhat technical, but by the new Act they have been extended in several respects, one of which may be of special interest, and that is, an opposition may now be based on the ground that the alleged invention has been made available to the public by publication in any document (other than a British Specification which case is otherwise provided for) published in the United Kingdom prior to the date of the Patent Application. It is presumed that any periodical or even a drawing will be considered to be a "document" for this purpose.

Disagreements between Parties Interested in a Patent Application.

Heretofore in the case of joint applicants, if the parties disagreed in regard to prosecuting the application for Patent, the interests of the party desiring to proceed for the grant, were often jeopardised by the party refusing to go further, for instance, in the case of joint applicants of which one was the inventor and one a non-inventor who had a financial interest in the invention, if the inventor served a notice on the Comptroller of Patents refusing to receive the grant of a Patent, the Comptroller had no option but to act on the notice for the reason that a Patent cannot be forced on anyone, and the law did not provide for the Patent being granted to the non-inventor alone. The position of a party financially interested, who was not a joint applicant, but who perhaps had put money down for purchase of the rights, was perhaps even worse. Even if the aid of the Courts could be invoked by the suffering party, probably it could not be invoked successfully in time to prevent loss of the Patent for the sealing of which there is a limit of time. In these cases the sufferer's only remedy might be an action for damages for breach of contract between the parties, a very unsatisfactory remedy in most cases, and absolutely useless in some.

The new Patent Act comprises valuable new provisions to remedy such troubles. It is provided that where an applicant has agreed in writing to assign a Patent when granted to another party or a joint applicant, and refuses to proceed with the application; or disputes arise between joint applicants as to proceeding with an application, the Comptroller, on satisfactory proof of the agreement, or if satisfied that one or more of such joint applicants ought to be allowed to proceed

alone, may allow such other party or joint applicant to proceed with the application, and may grant a Patent to him. All parties interested will be entitled to be heard before the Comptroller, and an appeal will lie from his decision to the Law Officer of the Crown.

It is to be noted that the agreement referred to must be in writing, must probably extend to the entirety of the Patent, and the provision dealing with such an agreement does not extend to an agreement for an exclusive license because such a license at present is not judicially considered to be in effect an assignment of the rights, or to confer any proprietary rights.

Term of Patents.

For nearly three hundred years the term limited by law for British Patents has been fourteen years, subject within the last century to provisions for extension of the term in certain circumstances. By the new Act the term is fixed at sixteen years instead of fourteen years, subject to the provisions for special extensions and subject also to renewal fees payable in respect of the two additional years. This provision applies to all British Patents in force 23rd December, 1919, as well as to Patents granted subsequently, but it is to be noted that in the cases of Patents which but for the new Act would have expired on or before 1st January, 1920, the Patent will, during the period of extension, be subject to the new "license of right" provisions which are explained later. In the case of a license existing 23rd December, 1919, under a Patent, it will, if the licensee so desires, be treated as having been granted for the term of the Patent as so extended. A somewhat peculiar sub-provision gives the Court power of relief to parties to contracts entered into before 19th November, 1917, who are subject to loss or liability by reason of the extension of term to sixteen years.

Extension of Patent Terms in Certain Circumstances.

For many years it has been feasible to petition for and obtain a special extension of the term of a British Patent where the patentee has been inadequately remunerated from his invention, having regard to the value of the invention to the public. In former times such petitions were adjudicated on by the Judicial Committee of the Privy Council, and in later times by the High Court. The 1919 Act provides that where a patentee as such has suffered loss or damage by reason of war, an application for extension may be made by originating summons instead of petition, and the Court in coming to a decision on the case, may have regard solely to such loss or damage. In such cases therefore the procedure will be simplified, and the proceedings much less complex, because the evidence needed in ordinary cases to establish that the patentee has not been adequately remunerated, having regard to the special merit of the invention will evidently not be needed where a person takes advantage of the new provision, which will therefore be of value to patentees. It is provided, however, that this special facility will not be available for subjects of the States formerly at war with us.

Conversion of Patents of Addition.

A new beneficial provision is one under which, in cases where there is a main Patent and a Patent of Addition to it and the main Patent is revoked, the Court or the Comptroller may order that the Patent of Addition shall be an independent Patent for the remainder of the term of the main Patent. Heretofore the Patent of Addition only remained in force so long as the main Patent was in force, whether that Patent expired by effluxion of time or was revoked.

Licenses of Right.

For many years our Patent Law has comprised provision for the grant of compulsory licenses under British Patents in certain circumstances. Section 24 of the Act of 1907 consisted of provisions to this effect, and thereunder if a person interested could prove that the reasonable requirements of the public with respect to a patented invention were not satisfied, the Court might order the patentee to grant licenses on such terms as the Court might think just, or if this would not meet the case, the Court might revoke the Patent. These provisions were, however, hardly ever taken advantage of, although no doubt as they were somewhat of a penalizing character, they helped to induce patentees to exploit their inventions in the proper manner from the public point of view. The new Act repeals this part of the old law, and substitutes for Section 24 entirely new provisions introducing "Licenses of Right." A patentee may now at his option have his Patent endorsed "Licenses of Right," and hereafter any person would be entitled as of right to a license upon such terms as, in default of agreement, may be settled by the Comptroller of Patents on the application of either party. When the Comptroller settles the terms he must be guided by certain considerations, namely, to secure the widest possible user of the invention in the United Kingdom consistent with the patentee deriving a reasonable advantage from his patent rights, while at the same time securing to the patentee the maximum advantage consistent with the invention being worked here by the licensee at a reasonable profit. The Comptroller must also endeavour to secure equality of advantage among the several licensees, and therefore may on proper cause reduce the payments accruing to the patentee under any license previously granted,

provided that in considering equality of advantage the Comptroller shall take into account any work done or outlay incurred by any previous licensee with a view to testing the commercial value of the invention, or to securing the working thereof on a commercial scale in this country. It therefore appears that in certain circumstances the terms of a license of right settled by the Comptroller may be more onerous in regard to royalty payable than those of a previous license. A license of right settled by the Comptroller may be so framed as to preclude the licensee from importing any goods, the importation of which if made by unauthorised persons would infringe the Patent, and in such a case the patentee and all licensees shall be deemed to have mutually covenanted against such importation. Every licensee of a license settled by the Comptroller will be entitled to call upon a patentee to take proceedings to prevent infringement, and if the patentee neglects to do so within two months the licensee may institute such proceedings in his own name but at his own expense, unless the patentee enters the case. If the license be settled by agreement between the parties they may by expressed agreement contract out of the provisions in regard to importation, and the licensee taking action for infringement, but unless there be such express agreement the license will be deemed to include those terms and conditions. A beneficial provision attached to Patents endorsed "Licenses of Right" is that as from the date of such endorsement the renewal fees for maintenance of the Patent will be reduced by half. As will be appreciated a Patent will not be endorsed "Licenses of Right" if the patentee has previously precluded himself by contract from applying to have his Patent so dealt with, as for instance, by having already granted an exclusive license, but he will

not be considered to have so precluded himself by having granted a license which does not limit his right to grant other licenses. An application under these provisions will be advertised in the Official Patents Journal, and will be open to opposition by any person alleging that the request is contrary to a contract in which he is interested. When the Patent has been endorsed the fact will be advertised in such manner as the Comptroller may deem desirable for the purpose of bringing the invention to the notice of manufacturers. In cases where there is no existing license at the time, the patentee may have the endorsement cancelled on paying the unpaid moiety of renewal fees since the Patent was endorsed, whereupon the patentee's rights and liabilities will be the same as if the endorsement had not been made. This latter facility is not of course open in the case of Patents which are subject to the license of right provisions as being Patents which if their term had not been increased from fourteen years to sixteen years would have expired on or before 1st January, 1920.—See " Term of Patents " *ante.*

The new Section 24 above explained applies to all Patents in force as well as those to be granted in the future.

The " Licenses of Right " provisions are in the main evidently intended for the benefit of the public and not for the patentee, but a monetary benefit in regard to the renewal fees is offered to a patentee if he will place his Patent under the provisions and in some cases a patentee will secure other advantages by doing so. It is therefore convenient to set out below the possible advantages and disadvantages of endorsing a Patent " Licenses of Right " as we can foresee them at present.

Advantages.

1. The reduction by half of the renewal fees. If a Patent be endorsed before the first renewal fee becomes due, that is, before the end of the fourth year from its date, and is maintained for its whole term so endorsed a total saving of £63 would be effected under the scale of official fees now in force. If this scale is made higher by new Rules the saving will of course be greater. On the other hand it is possible that in some years' time the scale will be reduced; and also against the saving must be put the cost of endorsing the Patent, contesting possible opposition to the step and dealing with applications for licenses before the Comptroller where the parties cannot agree.

2. The benefit of the arbitration, in effect, of the Comptroller is obtained in regard to the terms of the license whereby a proposing licensee may be more readily satisfied to the benefit of the patentee than by private negotiations.

3. The willingness of the patentee to grant licenses will be exemplified whereby in some circumstances the patentee will be in a better position to contest proceedings under the working conditions against his rights on the ground that there has been an abuse of them. As the terms in failure of agreement are settled by the Comptroller it can never be fairly alleged that the patentee's offer to grant licenses is not *bonâ fide*.

4. From the nature of the step taken by the patentee and the fact that it is advertised, we anticipate that in some cases exploitation of the invention would be thereby facilitated to the benefit of the patentee.

5. Where the Patent is applied for after 23rd December, 1919, and is for an invention closely and mainly dealing with the preparation or production of

food and medicine, the Patent would be in any event liable to compulsory licenses for that purpose, and therefore it might be advisable to obtain the "Licenses of Right" endorsement benefits.

In cases therefore where expense is an important consideration to a patentee, and he desires to grant non-exclusive licenses at a royalty which seems comparatively small compared to the cost of production, it would probably be advantageous for a patentee to have his Patent endorsed "Licenses of Right."

Disadvantages.

1. Where the license of right is not the first license to be granted, and the parties disagree, the Comptroller in settling the royalty may make the rate lower than that payable under the earlier license, and may reduce the latter to the same lower rate.

2. We do not think that the Act will be construed to enable a party to claim an exclusive license, therefore the interests of the patentee may suffer in the case of an invention that is best exploited by one party under an exclusive license.

3. Where the exclusive exploitation of the invention in the business of the patentee affords indirect benefit to him, or where he is in a better position to exploit the invention than any other party.

4. Where the proposing licensee is not, for some reason according to the views of the patentee, a fit and proper party to help exploit the invention, as for instance, from the technical point of view, it may not be feasible to induce the Comptroller to take the same view. We apprehend that in settling the "terms" the Comptroller will have the right to provide against possible loss to

the patentee by reason of weak financial position of the licensee, but we doubt if the Comptroller's power can be exercised in such a way as to remedy lack of technical knowledge or care on the part of the licensee until great harm might have resulted to the patentee's interests. In this connection it should be borne in mind that there is no power to refuse an application for a license of right and the patentee's only protection is the power of the Comptroller to settle the terms.

5. Where the license is settled by the Comptroller the licensee of right may bring an action for infringement without the consent of the patentee, if it be refused, which might result in the validity of the Patent or its scope being adjudicated on when it would have been to the patentee's benefit not to have such questions determined.

6. The rate of royalty fixed by the Comptroller may be very much less than that to which the patentee thinks he is entitled. A patentee in determining a suitable royalty naturally takes into consideration the probable extent of the public demand, the price the public will be willing to pay for the commodity, and the costs of manufacture, advertisement, distribution, etc. In other words, the patentee does not usually consider that he exists as such for the public benefit, and he endeavours to secure the greatest profit possible from the public. Years ago this was considered quite a correct attitude on the ground that under any conditions the public could hardly be worse off with an invention than without any knowledge of it. In settling the terms of a license of right, however, the Comptroller has to endeavour to secure the widest possible use of the invention consistent with a " reasonable " advantage to the patentee and a " reasonable "

profit to the licensee, so that this question will not be one of demand and supply. The Comptroller will no doubt not settle a higher rate of royalty than one which he thinks will leave fair profit to the licensee and fair return to the patentee having regard to his efforts, and possibly also to some extent to the value of the invention to the public.

7. Where the terms of the license are settled by the Comptroller he may frame them so as to preclude the licensee from importing the protected goods, and in such a case it is to be deemed that the patentee and all licensees have mutually covenanted against such importation which may be interpreted as meaning that the patentee himself must not import.

8. The patentee would be less able to keep an invention off the market. "Patentee" in the Act covers not only a grantee but an assignee. A patentee of one invention has whether right or wrong morally, often found it advisable to patent, or to buy the patents for, other inventions, just to put them on the shelf, as it were, to prevent them being exploited to the detriment of other inventions. This may be remedied, it is true, under the law, but the proceedings for the purpose are much more onerous than the application for a license of right.

9. In a license granted at the option of the patentee it is still lawful to insert a condition that the licensee shall not sell any goods other than those of a particular person or a condition requiring the licensee to obtain new parts for repair, whereas in a license of right it is quite likely in some cases that the Comptroller will not favour such conditions.

10. Generally, while the Comptroller in settling a license of right, will probably allow all usual conditions

of a license for protection of a patentee, yet there may be cases where if it had been an optional license the patentee might have insisted on certain lawful conditions that will not be allowed by the Comptroller.

The notes above given will, we think, enlighten our clients generally in regard to "Licenses of Right,"—which doubtless will be heard of a good deal in the future,—and enable the reader to form a general judgment as to the advisability and possibility of taking advantage of the new provisions, but in important cases or cases of doubt, our advice should be sought on the particular pertinent circumstances and incidents.

A further form of license of right is provided in the case of Patents dealing with foods and medicines, but an explanation of this is given later on in dealing with the new provisions connected with chemical substances and foods and medicines.

Working Conditions Attached to Patent Rights.

Under the Act of 1907 (Section 27) a Patent could be revoked by the Comptroller of Patents on the application of any person, if the patented invention were mainly or exclusively worked abroad, and (in the particular circumstances) not to an adequate extent in the United Kingdom, but such an application could not be entertained until the first four years of the Patent term had expired. This provision was therefore not effective if the invention were not being worked anywhere, or while not being worked elsewhere was only worked here to a very small extent, even if due directly to the patentee's deliberate election. Of later years little advantage was taken of this provision, but no doubt

it was effective to some extent to attain the general object aimed at. The new Act has, however, substituted for Section 27 new and more drastic provisions, the substance of which is shortly stated and explained below :—

(*a*) If after the expiration of four years from the date of the Patent the invention is not worked on a commercial scale in the United Kingdom, and no satisfactory reason can be given for such non-working,

or

(*b*) If such working is at any time being prevented or hindered by importation of the patented article,

or

(*c*) If the demand for the article in the United Kingdom is not being met to an adequate extent and on reasonable terms,

or

(*d*) If by the proprietor's refusal to grant a license on reasonable terms the national trade or trade of any person or class trading in the United Kingdom or the establishment of any new trade or industry in the United Kingdom is prejudiced, and it is in the public interest that a license should be granted,

or

(*e*) If any trade or industry in the United Kingdom, or any person or class engaged therein is unfairly prejudiced by conditions attached by the proprietor, whether in the past or future to the purchase, hire, license, working or use of the patented article or process,

the following remedies may be applied by the Comptroller of Patents on application made to him by any person interested, alleging and establishing to the satisfaction of the Comptroller any of the foregoing conditions :—

The Patent may be endorsed "Licenses of Right" and thereupon the same rules will apply as are provided in the Act in respect of Patents so endorsed (see "Licenses of Right" *ante*). This endorsement, however, may be made notwithstanding that an agreement may exist that would have precluded the Patent being so endorsed at the instance of the patentee and every existing licensee may apply to the Comptroller for exchange of his license for one to be settled by the Comptroller as if the Patent had been endorsed at the instance of the patentee,

or

Grant of a license to the Applicant may be ordered on such terms as the Comptroller may think expedient, but generally on such terms as a license of right would be settled by the Comptroller,

or

If the invention is not being worked on a commercial scale in this country and cannot be without capital for the raising of which it will be necessary, to rely on the Patent rights, the Comptroller may, unless the patentee or those claiming under him undertake to find such capital, grant to the applicant, or another, if able and willing to provide such capital, an exclusive license on such terms as the Comptroller thinks just. In settling such terms due regard will be paid to the risks undertaken

by the licensee in providing the capital and working the invention, but the license will be framed to secure to the patentee the maximum royalty compatible with the licensee working the invention on a commercial scale and at a reasonable profit, and to guarantee to the patentee a minimum yearly royalty so far as it is reasonable to do so having regard to all the circumstances of the case. In deciding to whom the exclusive license is to be granted preference will, if reasonable, be given to an existing licensee. The exclusive license will exclude the patentee himself and may revoke all existing licenses, subject to compensation to be paid by the exclusive licensee for money or labour expended by those parties in developing or exploiting the invention,

or

If the objects of the law cannot be attained by any of the foregoing steps the Patent may be revoked either forthwith or after an interval within which to comply with such conditions as may be ordered, and the said interval may be extended by subsequent order on due cause.

The object of the provisions in discussion is to prevent or remedy an abuse of the monopoly rights under the Patent, and the circumstances or conditions above set out in which relief may be claimed will each be considered to be such an abuse. It is, however, not quite clear that relief may not be given against some other unspecified circumstances that may be considered to be an abuse of the rights. It is to be particularly noted that the new Act prescribes that for the purpose of determining whether there has been any abuse of the

monopoly rights it is to be taken that Patents for new inventions are granted not only to encourage invention, but to secure that new inventions shall so far as possible be worked on a commercial scale in this country without undue delay. This is a reminder of the basic principle and reason under Common Law for the grant of Patents for inventions in this country. During the last century this principle was ignored to a great extent or accepted in a different form, as for many years it was considered that an invention was either immediately or ultimately in some way or other to the public benefit whether or not the invented manufacture was carried on in this realm.

It is also prescribed that the expression " patented article " in these provisions includes articles made by a patented process thus impliedly excluding articles made by a patented machine in which no new process is involved or claimed. This will often be an important consideration in connection with importation.

It is hardly within the scope of this explanation to deal with all the points that may in the future arise on the interpretation and application of the new provisions, but a few of the more prominent incidents may be perhaps advantageously brought to our clients' notice. While relief under the condition of things indicated at (*a*) can only be had after four years from the date of the Patent, relief from the other conditions indicated at (*b*) (*c*) (*d*) (*e*) can be granted at any time. Under (*b*) importation will probably be considered objectionable, even if the imported articles be inferior in quality and dearer in price, if the whole British demand could be supplied by home manufacture. In this connection it will probably not be sufficient that a manufacturer in the United Kingdom cannot be found,

and to manufacture here the patentee will, if necessary, be expected to establish works for the purpose. On the other hand, until the articles can be manufactured here the patentee must in view of (*c*) supply the demand by importation, and we think he will be expected to create and encourage a demand if one does not exist, or is but a very small and weak one. It is hardly likely that any person will claim relief on the sole ground that the articles are not supplied on reasonable terms, because this is almost always a question of opinion. Nevertheless, in cases where a patentee has granted an exclusive license, or assigned his rights for a royalty, it will probably be well in the future to secure that the licensee or assignee does not offend the principle. It involves, of course, not only the question of royalty, but the cost of production. Probably action will very rarely need to be taken under (*d*) except in cases where a subsequent patentee cannot work his own invention without a license from the owner of the prior Patent. Apart from this the provision is presumably directed against licenses being granted only to a class of persons (such as a ring or association) to the exclusion of persons outside. The condition (*e*) is intended to lead patentees to take their patentee's remuneration out of the sale of the patented machine, and not to provide for it by onerous conditions attached by them to its use. However it is not likely that a royalty reserved on the product of the machine will be considered objectionable where it is really more convenient to the user than to have to pay a heavy price for the machine in the first place.

In future, therefore, as the four year period does not as before control all action against the patentee's rights in regard to the working conditions of Section 27, and as it will not be necessary as before under that Section

to prove in the first instance that the invention is worked mainly or exclusively abroad, no patentee can afford to be inactive in the case of any Patent, or for any length of time. Patentees must now, immediately their Patents are sealed, try to make a demand if one does not exist, and meet the demand by home manufacture, or, until this is feasible, by importation, and must continue their efforts throughout the life of the Patent or until entirely successful within the spirit and terms of the new Section 27.

The new Section 27 was directed to come into force at a date not later than 23rd December, 1920, to be fixed by the Board of Trade, and applies to all Patents in force as well as those to be granted in the future. The Board of Trade directed the section to come into force 1st April, 1920.

The subject dealt with by Section 27 both as in the Act of 1907 and as amended, is somewhat complicated by emergency legislation and international arrangements arising out of the war. The effect of such legislation and arrangements will only exist for a time, but as this period in all probability will be somewhat lengthy, it is well to deal with them here.

By the Patents and Designs Act (Partial Suspension) Act 1915, the operation of Section 27 of the Act of 1907 was suspended for the continuance of the War and six months thereafter, and it was provided that in reckoning the period of four years mentioned in that section, the period during which that section is suspended, was not to be taken into account. In the first place, it must be noted that this did not mean that a patentee need do nothing whatever towards exploiting his invention for the period of suspension any more than the four year period was given to the patentee, in order that for

that time he need do nothing. Under Section 27 of the Act of 1907 a Patent could not be revoked for four years from its date, but thereafter it was open to attack if the invention was mainly or exclusively worked abroad, and not to an adequate extent in this country, so that it was necessary for a patentee during the period of four years to take steps to avoid possibility of such an attack after it had expired. The Act of 1915 merely extended the period of four years for a certain suspension period in respect of any Patent of which any portion of the four year period is current during any portion of the suspension period, and in case of any Patent more than four years old on the 23rd November, 1915, the Act created a second period during which the Patent could not be revoked. The question arises whether the Act of 1915 will apply to the new Section 27. We think that it may be considered so to apply by reason of a certain provision in the Act of 1919, and a provision in the Interpretation Act, but the matter is doubtful. A further point arising is that the termination of the War generally has not yet been fixed. Under the Termination of the Present War (Definition) Act 1918, His Majesty has by Order in Council, declared the termination of the War so far as regards Germany as the 10th January, 1920, which clearly is not the termination of the War contemplated by the Act of 1915, except perhaps as regards Germans. Therefore it seems likely that the date of termination of the War for purposes like that of the Act of 1915 will not be ordered to be earlier than the date of exchange of ratifications of the Peace Treaty between this country and the last of those with which we were lately at War to make peace with us. Consequently the Act of 1915 may be in operation until 1921. It is important to appreciate however, that patentees should in the meantime make every effort to place

themselves outside the scope of the new Section 27, otherwise they may be taken by surprise shortly after it becomes active, the more so as the four year period will not now apply to all circumstances. The Peace Treaty with Germany contains a provision that the period from 1st August, 1914, until the coming into force of the Treaty (10th January, 1920), shall be excluded in considering the time within which a Patent must be worked. It seems to us that this is little, if any, more than the equivalent of our Act of 1915, and as the period referred to has passed by we need not further deal here with that provision, except perhaps to remark that in our opinion the period of suspension under the Act of 1915 commenced only on 23rd November, 1915, so that any four year period current 1st August, 1914, or commencing between then and 23rd November, 1915, has been suspended, not only from 23rd November, 1915, but from 1st August, 1914, or the commencement of the period, as the case may be. The Peace Treaty also contains a provision that no Patent shall be liable to revocation by reason only of the failure to work it for two years from the coming into force of the Treaty. This, it will be observed, only in terms refers to revocation, and so far as British Patents are concerned, the new Section 27, as will have been appreciated, prescribes more remedies than revocation against a patentee's abuse of his monopoly, and we have no reason to suppose that the Treaty provision will be read to cover all remedies against a patentee in this respect. Further, the provision refers to the failure "to work" and in cases where it is of benefit for a patentee to explain the reasons for his inaction, the provision will not, we think be pleaded successfully as warranting him in making no efforts to work in the period.

Under the Treaty of Peace Act 1919, and the Treaty of Peace Order 1919, the provisions in question of the Peace Treaty with Germany have, with others, been made law in this country.

If the Peace Treaties still to come into force contain provisions similar to that in the German Treaty, the periods provided will naturally be carried on in effect.

The complications briefly outlined and explained above will be difficult for the layman to follow, and moreover, in some respects, in the absence of judicial interpretations, it is not feasible to form a firm opinion as to how the various enactments will operate. The only advice we can give generally to holders of British Patents now in force is to make every effort forthwith to manufacture the patented article in this country to supply the demand here, whatever be the date of the Patent, and in the case of Patents to be granted in the future to commence those efforts directly the Patent is granted.

We wish to make it clear that we are not here pretending to advise our clients in regard to their individual cases, but only to enlighten them generally as to the present position under the new Patents Act and the War enactments. In any case, where a British Patent is of material value, and there be any doubt, in view of our brief explanations, as to its position in regard to working conditions, our advice should be sought in the particular circumstances.

Rights of the Crown.

Heretofore any Government department by itself, its agents, contractors, or others might use a patented invention for the services of the Crown on such terms

as might either before or after the use be agreed on, with the approval of the Treasury between the department and the patentee, or in default of agreement, as might be settled by the Treasury after hearing all the parties. Two important points of doubt have arisen on the interpretation of this provision, viz.: whether the terms were to comprise a proper remuneration to the patentee or such a mere honorarium as the Treasury was disposed to award as an act of grace, and whether the Crown, having had patented articles made for its use, were free to dispose of them to members of the public when they were no longer required. The new Act provides that in case of dispute the terms in question shall be decided by the Court, thus strongly implying that the remuneration is to be commensurate, and not merely an arbitrary honorarium, and the Act also provides that the Crown shall have power to sell patented articles made under its powers, but no longer required for its service.

A new provision in regard to the Crown is one the need of which has arisen out of the late War, and is to the effect that where the subject of any Patent has been, before its date, duly recorded or tried on behalf of a Government department, the invention not having been communicated directly or indirectly by the applicant or the patentee, any Government department or its authorised agents, contractors, etc., may exercise the invention for Crown service free of any payment to the patentee. From one point of view this provision is of value to patentees, as it implies that such a Patent is not invalidated by reason of the prior disclosure of the invention by an independent party to a Government department, whereas heretofore there has been we think, at least grave doubts in this respect, even when the communication was confidential.

Invalid Claims in a Patent Specification.

Quite a new departure in regard to the claims in the specification of a British Patent is introduced by Section 9 of the new Act. Heretofore, unlike the case in many other countries, if there were a number of claims in a Patent Specification, and one were invalid, although the others were valid, the Patent was invalid and unenforceable in all respects until the defect was removed by amendment, if feasible. This rule has obtained for centuries, and is based on the fact that there has been a technical deceit of the Crown by reason of the inventor having, although probably in all innocence, claimed to have invented more than he had in fact invented thereby possibly misleading the Crown into making a grant when otherwise it might have refused, as it has always had power to do. Now it is provided that in an action for infringement relief shall be granted in respect of any valid claim infringed, although other claims may be invalid, subject to the Court's discretion in regard to costs, the date from which damages should be reckoned, and such terms as to amendment as the Court may deem desirable, and in exercising this discretion the Court may take into consideration the conduct of the parties in inserting such invalid claims or allowing them to remain there. It will be observed that the Court must grant the relief, but it may penalize the plaintiff in costs and loss of damages if it thinks fit, if for instance it can be shown that the plaintiff knew that the invalid claims were bad and recklessly inserted them or allowed them to remain or deliberately acted in that way to mislead the public. It is still important therefore for this reason alone for claims to be formulated with great care, and moreover unless care be taken the possibility of the only claims infringed being invalid ones may be greatly increased.

Chemical Substances, Food and Medicine.

The new Act provides that in the case of substances prepared or produced by chemical processes or intended for food or medicine, the specification of a Patent applied for after 23rd December, 1919, must not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed, or by their obvious chemical equivalents. It will therefore not be feasible now to claim validly a substance chemically produced or a food or medicine, characterised by some functional attribute. It must be claimed (if claimed apart from the method or process of its manufacture) as the product of such method or process, although the method or process may be perhaps defined broadly. So far as concerns a chemically produced substance, we do not think that British inventors will in practice suffer any substantial hardship from the new provision in question. In regard to foods and medicines, however, the new enactment is not limited to those produced by chemical means, and in the case of those consisting in novel mixtures of ingredients in which there is no novelty in the method of mixing or compounding in itself, the new law will be a serious limitation on the acquisition of Patent rights, unless "method" or "process" is interpreted to cover the act or steps in selecting and bringing together the ingredients. We think, however, that the term "method" may possibly be held to cover an invention of such a mixture.

A further important novel provision of the new Act in this connection is that in the case of a Patent applied for after 23rd December, 1919, for an invention intended for or capable of being used for the preparation or production of food or medicine, the Comptroller of Patents

will have power to grant to any person applying for the same, and unless the Comptroller sees good reason to the contrary, a license limited to the use of the invention for the purposes of the preparation or production of food or medicine, but not otherwise. In settling the terms of and royalty payable under such a license the Comptroller must have regard to the desirability of making the food or medicine available to the public at the lowest possible price consistent with giving to the inventor due reward for the research leading to the invention. This appears to be a provision seriously disadvantageous to inventors interested as such in foods and medicines, but will make it all the more important for foods and medicines produced by patented processes to be put on the market by the owner of the Patent under an appropriate registered Trade Mark. The most objectionable feature of this provision is however a general one, inasmuch as for the first time in our law it contemplates a reward to an inventor commensurate with his labour in making the invention. An inventor who quickly evolves a new method of producing a food or medicine without material expenditure of money or mental labour may therefore perhaps reap only a nominal profit. For the first time the legislature directs that in connection with the profits of an inventor, the merit of his invention is not to be judged by its value to the public but by the effort needed to produce it. At present this is only applied to a small class of invention, but the principle may hereafter be applied to all classes of invention.

In cases where an invention patented on an application made after 23rd December, 1919, is wholly or mainly for the preparation or production of food or medicine, it would appear advisable sometimes to have the Patent endorsed "Licenses of Right," so as to obtain the

benefits of that step because even without such endorsement the Patent will be liable to compulsory licenses, although a license of right may contain objectionable conditions that cannot be inserted in a license under the provisions now in discussion.

Reading a Paper on an Invention before a Learned Society.

For many years statute Patent Law has contained provisions whereby the exhibition of an invention at an industrial exhibition will not invalidate a Patent applied for it later within a certain time and provided a certain special step be taken in advance. This provision is in practice really a dead letter, and no inventor ought in our opinion to take advantage of it, but he should file an application for provisional protection in the first place. By the new Act the provision is extended to the reading of a paper by an inventor before a learned society, and to the publication of the paper in the society's transactions. In our opinion an inventor should on no account take advantage of this part of the law, and we only refer to it here in order to warn our clients most emphatically in this respect in case that from some layman source they may think the provision of benefit and try to take advantage of it without professional advice.

Registration of any Interest in a Patent.

For many years there has been proper provision for the registration in the official Register of Patents as proprietor of a Patent, an assignee thereof, and also for the registration of a mortgagee or licensee, or of any document affecting the proprietorship in a Patent.

There has been no limit of time for doing this, nor has it been usually considered necessary even in the case of an assignment in order legally to vest the interest in the party taking it. Naturally, in the case of an assignment it was in practice necessary to register an assignee, because it is only the registered proprietor who can take certain steps and do certain acts. Further, it was very advisable to register as soon as possible all transactions dealing with Patent rights, so that any person inspecting the Register would be made acquainted with them. The new Act does not prescribe a definite limit of time in which to effect registration but it provides that except in applications to the Court to rectify the Register, no document not entered in the Register of Patents shall be admitted as evidence in any Court in proof of any interest in a Patent unless the Court otherwise directs. For this purpose alone therefore it will in future be advisable to register all such documents as soon as possible so that no delay may occur if and when it may be necessary to produce the Document in a Court. Moreover, the Stamp Duty payable on registration is very much increased unless the application to register be made within six months of the date of the instrument.

DESIGNS.

Registrations of Designs are not in general so valuable as Patent rights, but they are nevertheless often of substantial commercial value and favoured by manufacturers as conferring comparatively inexpensive rights in respect of the shape or pattern of articles of manufacture which would not constitute valid subject matter for Letters Patent.

The Patents and Designs Act 1919 makes a few somewhat important changes in the law of registration

of Designs, to which it may be well here to direct our clients' attention.

Appeals.

Formerly appeals from decisions of the Comptroller were taken to and heard by the Board of Trade. In future these appeals only lie to the Court. In important cases this may be an advantage, but it must only be in very few cases that applicants for registration will care to incur the comparatively heavy expense thereby entailed. It must be borne in mind that appellants will be liable to pay the costs of the Registrar as well as their own, whether the appeal be successful or not. In initial stages a design can only in remote cases, be of sufficient certain value to warrant such heavy expenses and generally in practice the new provision will mean that the right of appeal has been practically abolished.

Registration of the same Design in Several Classes.

Registrations are effected in different official "classes" according, in some cases, to the material of which the article is made, and in others to the function of the article. Under the Act of 1907 a registration in one class and manufacture thereunder does not in itself invalidate a subsequent registration in another class by the same proprietor. The new Act provides that such subsequent registration shall not extend the period of copyright in the Design beyond that arising from the previous registration. We find it difficult to construe this provision. As the design is the same although the classes are different, it may be construed to mean that the subsequent registration shall expire with the first, because otherwise the later registration

would certainly extend the period of copyright in the design although in a different class, but if this be the interpretation of the provision it could have been much more clearly expressed. On the other hand, if it merely means that the second registration shall not extend the period of the first the provision is redundant, for it is quite clear that such a second registration never has, or could under the old law have, that effect. We shall continue to advise our clients in the cases of designs that should be registered in more than one class to file all the applications on the same day, or before publication in any one class takes place.

Cancellation of Design Registrations.

Heretofore it has only been possible to obtain cancellation of a registration on the ground that it was not novel in this country at the date of registration, by High Court proceedings, but now the new Act provides that any person interested may apply to the Comptroller for cancellation of a registration on the ground that the design had been published in the United Kingdom prior to the date of registration. The Comptroller may, however, refer any such application to the Court for trial if he thinks fit, and the new provision does not abolish the right of a person aggrieved to make his application to the Court if he prefers. The new provision will, we think, on the whole be found of benefit as supplying an economical procedure to remedy certain cases.

Under the Act of 1907 a Design registration could be cancelled by the Comptroller at any time after the registration if the design were used for manufacture mainly or exclusively abroad, and not to an adequate extent in this realm. This provision remains practically the same except that it will not now be necessary

for an applicant to establish that the design is mainly or exclusively used abroad and not to an adequate extent here, but merely that the design is used in manufacture abroad and not to a reasonable extent here. The Comptroller also has power to grant a compulsory license to remedy the evil on such terms as he thinks just.

Crown Rights.

The Crown now has the same rights to use a registered Design for its service as it has in regard to Patents.

Registration of an Interest in a Registered Design.

The new law in regard to registration of documents affecting the proprietorship of a Patent apply also to Design registrations.

Constitutional Character of a Registrable Design.

It has been laid down by the Courts for many years that in judging of the registrability of a new shape or pattern for an article it is a matter of an appeal to the eye. The Courts have, however, at times held that where the new shape has a specific useful purpose that may be borne in mind to some extent in order that the eye may appreciate the shape. Where there be a novel shape it was also not objectionable that it was designed to carry out some principle or mechanical operation, although a pattern was not registrable when it was merely the outcome of a particular method of construction. The new Act provides however that registrability of a shape or pattern is to be judged

solely by the eye, and that "design" shall not include any mode or principle of construction or anything which is in substance a mere mechanical device. This goes farther than the law as heretofore laid down in judgments, if it means that if the design includes a mode or principle of construction, or is a mechanical device, it shall be unregistrable notwithstanding that it is in fact a new shape. Probably the enactment will be officially interpreted in this way as the official tendency for some years has been to discourage registrations of new shapes designed with a mechanical object or for a mechanical function, or the underlying principle of which is a matter for Patent protection rather than Design registration.

TRADE MARKS.

Registration.

Heretofore a large proportion of Trade Marks used in trade and found in practice unobjectionable to the public, and meeting the purpose of a Trade Mark which is to distinguish in trade the goods of the proprietor, were yet unregistrable because they did not constitutionally meet the requirements of a registrable new Trade Mark as laid down by our legislature, which in this respect has probably taken a narrower view than that which obtains in almost every other country in the world. The Act of 1905 provided means whereby a Mark could be registered which had proved to be distinctive in use in this realm in respect of the goods in connection with which registration was desired, after long and exclusive user here, although as a new Mark it would be unregistrable, but this provision almost became a

dead letter for the reason that our Courts held that notwithstanding a mark might be so distinctive in fact yet if it were not "adapted to distinguish" the goods it ought not to be registered. The result soon was that very few marks distinctive in use could be registered if they were not registrable as new Marks. This did not necessarily mean that the proprietor had no protection for this Mark, because even if it were unregistered he could obtain at common law a remedy for any deceitful use by another of the same or very similar Mark. Such actions, however, are much more troublesome and expensive than actions under registrations, and therefore since registration was first possible some forty-five years ago it has always been highly desirable to register a Trade Mark if feasible. No doubt the policy of the legislature has been to induce or force traders to select for use Trade Marks which shall be of such a constitutional character as to be registrable, and so clearly be unobjectionable from the public point of view. This in effect means that a trader ought to register his Trade Mark before he commenced to use it because he could never be certain if it would be considered registrable until it was registered, and having once commenced to use a Trade Mark it is clearly extremely disadvantageous to have to substitute another for it. Registration proceedings take some months, however, and far too long in many cases for which to defer commencing to use a Trade Mark, having decided on it, in these days of rapid business. Moreover this principle of registration before use is one that never has been adopted by a large proportion of traders, and even when the danger to their own interests is known to them they persist in adopting and expending capital on Trade Marks which are unregistrable, to nobody's real harm true, and the legal risks are often

freely accepted as ordinary trade risks. This brings the law into contempt to some extent, and after all, as the nation does not live by law but by trade, manufacture and the like, law must to some degree be brought into line with the customs of our occupations when they are found by long experience to be such that they cannot well be departed from and suit the case. Moreover, as so much trade is now international it cannot be denied that, putting the ethics of law on one side, it is nationally unsound for one of the great nations of the world to refuse registration to Trade Marks considered registrable in every other well known country. It is true that our legislature recognised this to some degree in the Act of 1905, and made the provision referred to, but our Courts, as explained, practically nullified it for reasons which are probably inscrutable to the practical and business-like layman. By the Trade Marks Act 1919 the legislature has made another attempt to put matters right in this respect. The Register of Trade Marks is now to be divided into two parts, "Part A," comprising all Marks heretofore registered and to be registered in the future as complying with the old conditions, and "Part B," in which may be registered Marks which may not be registrable in "Part A," provided they answer to a certain requirement which is that they must have been *bona fide* used by the proprietor in the United Kingdom for at least two years upon or in connection with the goods in respect of which registration is desired, for the purpose of indicating that the goods are those of the proprietor of the Mark by virtue of manufacture, selection, certification, dealing with or offering for sale. The Mark must also of course not conflict with any prior registered Mark, and like all Marks its use must not be calculated to deceive, contrary to law or morality, etc. Most

unfortunately however it is also provided that the Registrar may refuse an application for registration in "Part B" if, in his opinion, it is not "capable of distinguishing" the goods of the Applicant, although it may have been used as a Trade Mark for that purpose. The phrase in point is certainly an improvement on "adapted to distinguish," as we apprehend that if it be proved on question that a Mark is in use distinctive in fact, it must be held to be capable of distinguishing even if it be not adapted or fitted to distinguish. This proof is always, however, troublesome and expensive, and we hope that, as we believe was the intention of the legislature, it will be only in extreme cases of apparent lack of power of distinguishing that the Registrar will require to be satisfied in this way. It is easy, however, even for a layman, to realise, after reading the foregoing, that a good deal of the evident intended benefit of the "Part B" provisions may in the course of a few years be whittled away. It would therefore, we think be advisable for all our clients who desire to register old Marks in "Part B" of the Register to do so as soon as possible.

We think it will be held that the two year period must be immediately prior to the application, and that there must have been no real abandonment of the Mark. We also think that it will not be an objection that for a part of the time the use was by a predecessor in the business.

In consideration of the greater facility for registration afforded by the institution of "Part B," it is provided that while the registration in that Part shall be *prima facie* evidence of the exclusive right to the Trade Mark, no relief will be given to the proprietor in an infringement action if the defendant establishes that his user is not

calculated to deceive or lead to the belief that his goods are those of the plaintiff. As the onus of this proof is on the defendant, we do not think this condition will work much hardship on the plaintiff, and he will lose nothing of any real consequence in most cases where the defendant does establish the harmlessness of his user.

In our opinion user on or in connection with goods includes not only a user on the goods themselves, but on the packages, boxes, etc., containing them, advertisements, invoices, etc., so that it may not be necessary that the Mark has been used actually on the goods.

Trade Marks Being or Becoming Names.

For many years it has been held that where a word Trade Mark becomes the name of the goods, that is, indicating their character rather than distinguishing them as the goods of a certain trader, the word is not registrable as a Trade Mark. Where, however, the Trade Mark was registrable at the time of registration, and only changed into a name slowly and many years after registration, some doubt has arisen as to the power to expunge it from the Register in consequence. As the Trade Marks Act 1905 provides that no registration shall interfere with the *bona fide* use by any person of a *bona fide* description of his goods, we believe that it should never have been possible for the owner of a registered word Trade Mark successfully to restrain by law the use by others of the same word when it could be clearly established to have become the name of the goods. In passing, we remark that a word Trade Mark usually becomes a name in the following circumstances. It was originated as a Trade Mark for one

special proprietary commodity, say patented or of secret composition or manufacture, and in course of time the public quite lose knowledge of the trader putting it on the market, and there being no other suitable descriptive name to hand for the commodity, being a special one, the public treat the former Trade Mark as a name. This process is often helped by the unfortunate manner in which the proprietor himself uses the Trade Mark in practice, often referring to it as a name, sometimes using it in the plural as a name or description and not in any direct way making the public continue to understand that it is a Trade Mark and not the name or description of the goods. This sort of thing frequently leads writers and compilers innocently to aid the process by referring to the commodity in their works by the Trade Mark used, just as an ordinary descriptive name for it.

The legislature has considered it an abuse that the owner of a registered word Trade Mark shall continue to claim exclusive right to its use after it is in the mouth of the public as a name, and by the new Act the following provisions have been made :—

Where in the case of any commodity manufactured under any Patent in force 23rd December, 1919, or granted later a registered word Trade Mark is the name or only practicable name for the commodity, all exclusive rights to the Trade Mark both under the registration and common law, will cease on the determination of the patent, and may be removed, on application, from the Register.

A word which is the only practicable name or description of any single chemical element or single chemical compound as distinguished from a mixture, shall not be registrable as a Trade Mark, and if on the

Register may be removed therefrom on application. This provision is not to apply, however, where the mark is used to denote only the proprietor's brand or make of such substance as distinguished from the substance as made by others, and in association with a suitable and practicable name open to the public use, and in the case of Marks registered before 23rd December, 1919, no application for removal of the Mark from the Register will be entertained until after 23rd December, 1923.

The power to remove a Trade Mark from the Register under these provisions is in addition to any other powers of the Court to remove Trade Marks from the Register so that the enactment cannot by any implication be considered a limitation in any respect of powers of removal, except as regard the four year period referred to where it applies.

The reader will appreciate that the best way for the owner of a word Trade Mark to escape the prejudicial effect of the new provisions and the law concerned apart from them, is to use the word Trade Mark always in close association with a name for the commodity in such manner as to indicate the Trade Mark and put into the mouth of the public the name of the article. This might, we think, be done in the manner indicated below by examples :—

In the case of an article of construction :—

SECTIONAL TABLE
"ABCD" MAKE
(TRADE MARK).

or in the case of a chemical substance, etc. :—

BLEACHING POWDER
"ABCD" BRAND
(TRADE MARK).

Where the commodity was or is a novel one in constitution at the time the Mark was or is first used in connection with it, and the generic names or descriptions broadly applicable to it, are too wide to be of any use to the public to identify the commodity by known name, then the proprietor should evolve some suitably appropriate or descriptive name or phrase for it to use as a name in conjunction with the Trade Mark.

There is some doubt whether the four year period will be available for the proprietor of a Trade Mark, who would at the present time be in danger of losing his rights under the provisions in question, within which to correct the error of his ways, so that at the end of the period the Mark cannot successfully be alleged to be a name, or whether the period is only given in order that the owner should have the benefit of exclusiveness for that period, but no longer in any circumstances if his Mark has now become the name of the goods. We are of opinion that the first is the correct interpretation. For this and other reasons owners of word Trade Marks that have been in use for some time should at once commence and continue to use them in the manner indicated above, or in some other unobjectionable manner.

In cases where there appears to be special danger of the Mark becoming a name, and in the case of old Marks which it is feared may by this time have become the name, it will be very advisable always to associate the proprietor's name with the Mark. For instance, in the examples before given the proprietor's name could appear beneath the Trade Mark, more or less prominently according to the ideas of the particular trade and the proprietor's taste. This would be done with the object of associating the goods bearing the Trade

Mark with the proprietor, which in itself helps to maintain the function of the Trade Mark.

Removal of Trade Marks from the Register.

Heretofore this could only be done by Court proceedings, but under the new Act the application for rectification or removal may, at the option of the Applicant, be made to the Registrar, if no action concerning the Trade Mark is then pending before the Court, but the Registrar may, if he chooses, at any stage refer the matter to the Court instead of dealing with it himself. We expect that this new provision will frequently be taken advantage of, particularly in cases where an application has been filed and it is barred by a prior registration which is open to be expunged by reason of non-user of the Mark, and it is desired to expunge it to clear the way for the pending application.

Registrations Under Limitations.

In future the Registrar will have power to register a Trade Mark subject to limitations as to mode or place of user or otherwise as he may think right to impose. This may help to obtain registration of a Mark quite sufficient for the owner's purpose, where heretofore it was not feasible for the Registrar to entertain such limitations.

Marks for Cotton Piece Goods and Cotton Yarn.

Under the Act of 1905 it was not feasible to register a word Trade Mark for cotton piece goods and cotton yarn, but this will now be possible under the new Act.

General.

Heretofore it was an offence for a person to describe himself in any way as a patent agent unless he was duly registered as a patent agent under the provisions of the law, but this, unfortunately, did not prevent a person practising to all intents and purposes as a patent agent, provided he did not describe himself as such. The new Patents and Designs Act for the first time makes it an offence for a person to practise as a patent agent, unless :—

In the case of an individual he is registered as a patent agent in the Register of Patent Agents.

In the case of a firm every partner is so registered.

In the case of a Company which commenced to practise as a patent agent after 17th November, 1917, every Director and Manager (if any) is so registered.

In the case of a Company which commenced to practise as a patent agent before that date a manager or a director is so registered.

Solicitors are permitted to take such part as they have heretofore taken in proceedings under the Patents Acts.

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