THE PRACTICE

AS TO

LETTERS PATENT FOR INVENTIONS, COPYRIGHT IN DESIGNS, AND REGISTRATION OF TRADE MARKS, &c.

R. O. Hughes.
1885

THE PRACTICE

AS TO

LETTERS PATENT FOR INVENTIONS,

COPYRIGHT IN DESIGNS, AND REGISTRATION OF TRADE MARKS,

UNDER

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883,

With the Practice in Actions for Infringement of Patent.

ARRANGED AS A COMMENTARY ON THE ACT, WITH THE RULES AND FORMS,

AND AN APPENDIX OF ORDERS MADE IN PATENT ACTIONS.

BY

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PREFACE.

THIS work is not a treatise on the Law of Patents generally, nor on the Law of Trade Marks generally. It deals only with so much of the former as may be said to depend on the legislation of the present and preceding reign, and with so much of the latter as arises out of the Registration Acts.

With regard to the Law of Designs the case is somewhat different. This rests entirely on the Statutes of the early years of the present reign; and the new Act, with the decided cases (few in number) on the repealed and re-enacted provisions of the old Acts, comprises all the law on the subject. There seemed, therefore, to the writer no sufficient reason, in the case of Designs, for confining his work merely to the practice of registration, and the following pages contain also a statement of the General Law.

The present Act is virtually, so far as regards Patents, a consolidation, with considerable amendments, of the provisions of all the Acts on the subject since 1835. It includes, therefore, oppositions to the grant, disclaimers, amendments, and extensions, with the provisions as to provisional specifications and registration introduced by the Act of 1852, and the various enactments as to particulars of breaches and objections and costs which are contained in the latter Act. These subjects are all dealt with in the present volume, and the Author has endeavoured to collect the decided cases on the various matters above mentioned and arrange them under the corresponding heads in the Act; but, in accordance with his plan, he has not touched such questions as the subject-matter of patents, true and first inventor, novelty, utility, and the like, nor has he dealt in any way with the various points arising on the complete specification, or, except in

relation to the practice, with the question of infringement. For these the reader is referred to the well-known works on the General Law of Patents.

In addition to the special matters above mentioned as comprised in this volume, the following pages contain also a detailed statement of the practice in actions for infringement of patent. The general questions on this subject, such as the commencement of the action, the parties, consolidation of actions, and the nature of the relief to be obtained, are treated of under the heading in the Act "Legal Proceedings"; while, following the order indicated in the Act, the practice as to the mode of trial is dealt with under sect. 28; the questions of statement of claim, particulars of breaches, defence, particulars of objections, evidence, and costs, under sects. 29 and 31; and the practice as to injunctions, inspection, discovery, account, and damages, under sect. 30.

The subject of Trade Marks has been dealt with in the same manner as the Law of Patents. The General Law of Trade Marks has been left untouched, except so far as seemed to be necessary in order to elucidate the practice under the new Act, and the writer has confined himself, apart from the cases on the repealed Acts, to such cases as relate to the definition of trade marks, leaving the question of infringement, and other like questions, to books on the General Law.

The present Act is, as far as it relates to trade marks, a consolidation of the Acts of 1875 and 1876, adopting (with alterations) as part of the Act many provisions of the old Trade Marks Rules; and the cases on those Acts and Rules will, it is conceived, form useful guides to the interpretation of the new Act.

On a perusal of the Act, two important innovations in established practice become immediately apparent: one, the abolition, or, to speak perhaps more correctly, the disuse, of the jurisdiction of the Lord Chancellor in the granting of patents; and the other, the conferring quasi-judicial functions on the Board of Trade in certain matters relating to patents, designs, and trade marks.

In the first of these no matter of principle is involved. The Crown has always been advised by the Law Officer on

the question of the grant of Letters Patent, and it was only in exceptional cases and on special grounds that the jurisdiction of the Lord Chancellor was ever invoked.

The present Act substitutes an investigation by the Comptroller for the investigation by the Law Officer under the old practice, and gives to the latter a power of reviewing the Comptroller's decision, and throws on the Law Officer very much the same duties as the Lord Chancellor formerly performed. The change is thus, in effect, merely the substitution of one officer of the Crown for another as its final adviser in applications for patents.

But the other point to which attention has been called is a much greater departure from established usage.

In patent matters the jurisdiction as to compulsory licences is by the Act given to the Board of Trade, while in the case of designs and trade marks the Board of Trade is thereby constituted a Court of Appeal from the refusal of the Comptroller to register a design or a trade mark, and there is no expressed right of appeal from the decision of the Board. The case of compulsory licences is a new matter altogether; and the enactment as to designs is a return to the practice under the Act of 1843 before the transfer (made in 1875) of the control over designs to the Commissioners of Patents; but in the case of trade marks, if the decision of the Board of Trade is found to be in fact without appeal, an important change in the law has been effected, and the final decision on the right to register—in itself an important right, and on which other important matters, such, for instance, as the power of bringing actions for infringement (sect. 77), depends—has been taken from the ordinary jurisdiction of the Courts, and handed over to a Government Department.

Although, however, the Act contains no provisions as to an appeal from the Board of Trade, it may be that indirectly a review of the decision can in some cases be obtained. The orders of the Board as to compulsory licences are to be enforced by mandamus (sect. 22). It is not probable that the Court will consider its duties as merely ministerial, and that it is bound to issue the writ without inquiry, and on the application for a mandamus to enforce an

order for a licence, the patentee may perhaps be able to reopen the question.

Again, the 90th section gives large powers to the Court to rectify the Register in cases which seem to include refusal of an application to register a design or trade mark, and it would seem probable that if a person can show himself "aggrieved" within that section, the Court will exercise the powers thereby conferred, whether the decision of the Comptroller has or has not been affirmed by the Board of Trade.

But it is to be observed that if the decision of the Board of Trade can be reviewed as above suggested, then, at all events in the cases of designs and trade marks, a needless burden will have been thrown on an applicant by the interposition of a step between the office of the Comptroller and the Court.

Upon this question it may be further noticed that while in the cases of designs and trade marks the Act provides (sects. 47 (7) and 62 (4)) that the Board of Trade shall hear the applicant and Comptroller, there is no such provision in the case of compulsory licences for the use of patented inventions. The omission has, however, been supplied in the Patents Rules 57-63, by which directions (which have the force of an Act of Parliament) (sect. 101 (3)), have been given for the hearing of the parties in certain cases.

No machinery for the hearing of the appeal to the Board of Trade is, in designs and trade mark cases, given by the Act, but directions on this point are contained in the Rules. The Act (sect. 62 (5)) empowers the Board of Trade in trade mark cases to refer the appeal to the Court if it shall appear expedient.

A more important point is the omission from the Act of all power to the Comptroller or the Board of Trade over the costs of proceedings. In cases relating to the grant of patents and amendments, costs can only be obtained before the Law Officer, a provision which may have the effect of encouraging unfounded oppositions, since it may be worth while to oppose before the Comptroller on the chance of success when it is certain that the Comptroller cannot order payment of costs in the event of failure.

In the case of compulsory licences the absence of a power

as to costs is still more serious, since the jurisdiction is never likely to be invoked except in cases where large interests are involved, and where, in consequence, there is likely to be great conflict of evidence and a large number of witnesses, and the absence of the control over the proceedings which a power over costs affords would seem likely to lead to merely speculative applications, the burden of which must in any event fall on the patentee.

Considering now the general effect of the Act as to patents, it will be found that comparatively little change in the law itself is effected, the only changes in the law being the power to grant patents to applicants of whom only one need be the inventor, the more extensive power of amendment conferred by the Act, the rights of patentees against the Crown, the question of compulsory licences, and the abolition of the power of confirmation of invalid patents, and of the provisions of the 25th section of the Act of 1852 as to foreign patents.

The main alterations will be found to be alterations in the procedure for obtaining, amending, and revoking patents, and in the amount and mode of payment of fees, and some provisions as to trial of patent actions; but these taken together involve a very considerable amount of change. Upon other points the Act is, as has been already mentioned, a consolidation Act, consolidating and amending the various previous enactments.

Taking first the changes in the law.

The new provision that an applicant not an inventor may with the actual inventor obtain Letters Patent, was probably intended to meet the case of an inventor without capital desiring to purchase the assistance of a capitalist by giving him a share of the patent. Reasons will be found in the text for believing that although one of two joint grantees may alone work the invention without accounting to the other, the concurrence of both is requisite to a valid licence. It will therefore be very desirable, before the patent is obtained, that the parties should stipulate in writing how the patent is to be worked for their common benefit.

The powers of amendment given by the Act are consider-

ably wider than the old power of disclaimer. This was amendment by excision only, but now amendments may be made by way of correction or explanation also, and facilities are also given (sect. 19) for amending by way of disclaimer during the trial of an action. There is no express provision in the Act like that under the Act of 1852, under which the Law Officer's fiat was necessary in order to enable actions to be brought for infringements prior to amendment, but the Act gives power to the Law Officer to impose conditions on the grant of leave to amend, and it may be expected that this power will be exercised so as to protect in proper cases, as hitherto, persons who have embarked capital on the faith of the invalidity of the patent. Moreover, where an amendment has been allowed under the Act, the patentee cannot in any case recover damages for infringements before the amendment, unless he shows that his original claim was framed in good faith and with reasonable skill and knowledge (sect. 20).

The provisions as to compulsory licences are new. The Board of Trade is empowered to compel the grant of licences (sect. 22) in cases where the patent is not being worked in the United Kingdom, or the reasonable requirements of the public cannot be supplied, or any person is prevented from working to the best advantage an invention of which he is possessed, cases which seem to include all possible cases of hardship.

The provisions of the 25th section of the old Act of 1852, whereby, in the case of English patents granted after a foreign patent for the same invention, the English patent expired with the foreign patent, are not re-enacted; but there may be, in the cases of existing patents, some instances (referred to in the text) in which rights have been acquired under this section which may still, for a few years, make it necessary to consider its provisions. For these provisions are substituted those in sects. 103, 104, enabling the Crown to make arrangements with foreign countries and British Colonies for the mutual protection of patents, designs, and trade marks, and in such cases to grant certain preferences to foreign and Colonial inventors in respect of their inventions

over applicants for patents for the same inventions in this country.

The old system of granting patents for communications from abroad is, except so far as it may be affected by the provisions of the last-mentioned sections, left untouched.

Another alteration in the law effected by the Act is on the question of the right of a patentee to issue circulars warning the public against selling articles made according to his patent, where the circulars point to particular articles or affect a particular manufacturer. In such cases it had been held that the sole question as to these circulars was whether or not they were issued *bonâ fide*, and with reasonable and probable cause. This rule is now altered (sect. 32), and the *bona fides* of the circulars will not for the future be available as a defence to an action by the party complaining of their issue. The sole question will be whether the statements as to infringements are true. If they are not, the circulars must not be issued. But a patentee who brings an action for infringement is exempted from the operation of the section.

Thus much for alterations in the law effected by the Act. In the matter of procedure the changes are much more numerous, and are very important.

The most noticeable is the requirement of a complete specification before the patent is granted at all. This was the exception under the old law, which, though it required the patent, when a complete specification had not been filed before the patent was granted, to be made subject to the condition of filing such specification, allowed the complete specification to be deposited, if the applicant chose, with his petition for patent.

The rules as to the provisional specification, except as to matters of time, are much the same as under the old law, but provisions are contained in the Act for the examination of the provisional and complete specifications by examiners. This examination embraces not formalities only, but also an inquiry as to the sufficiency of the provisional specification and the title, and a comparison of the provisional and complete specifications as between themselves, and also with other specifications relating to applications then pending in the

Office. Every specification is to conclude with a distinct claim, a practice which, though usual, has not hitherto been necessary. The examination of the specification is, it would seem, merely an office matter. There is nothing in the Act making the examination conclusive as against third parties. It has been questioned whether the old objections to the specification can still be raised by way of defence to actions for infringement, and in the text will be found reasons for thinking that the law has not been changed in this respect.

In cases of opposition to grant of patents the changes of procedure are very marked. The Comptroller and Law Officer take the place of the Law Officer and Lord Chancellor respectively, and the jurisdiction of the latter, which was reserved specially by the Act of 1852, is not mentioned in this Act, and is probably gone.

Opposition to the grant of a patent is only allowed on certain specified grounds (sect. 11), which do not include such grounds as prior public user by third parties, want of subject-matter, and the like, which were grounds of opposition under the old law. One of the new grounds of opposition is that the specification comprises the same invention as is comprised in a previous application.

The old practice, under which the parties in opposition cases fought in the dark, neither being able to see his opponent's specification, will, as a general rule, no longer exist, since oppositions can only be entered after the complete specification has been accepted, and the acceptance advertised, when the specification becomes open to inspection (sect. 10); but where the opposition is grounded on the examiner's report that the application conflicts with another application then pending, or where the question is between rival applicants for the same invention (sect. 7 (6)), the parties will still be in the dark before the Comptroller, since it is only on an appeal to the Law Officer (sect. 9 (5)) that the report can be seen.

The Law Officer may examine witnesses *viva voce*, but as a rule the evidence before him, and before the Comptroller, is to be by declaration. No evidence which was not before the Comptroller is to be brought before the Law Officer without

special leave—a marked improvement on the old practice, under which the evidence, being by declaration before the Law Officer and by affidavit before the Lord Chancellor, was practically taken twice over. The witnesses can, by the Law Officers' Rules, be cross-examined before the Law Officer, but there is no power in the Comptroller to allow the examination or cross-examination of witnesses. The Comptroller, as has already been mentioned, has no power over costs.

The rule laid down in *Ex parte Bates and Redgate*, under which it had become in many cases a practice to refuse to a first applicant a patent for an invention if a second applicant for the same invention had first obtained the Great Seal, is now declared not to be obligatory; and express provision is made (sect. 13) that, in case of more than one application for a patent for the same invention, the sealing of a patent on one of these applications shall not prevent the sealing of a patent on an earlier application. Patents may now be granted to the representatives of deceased inventors, thus obviating a hardship which was felt under the old Acts. Proceedings for amendment are before the Comptroller, and only by way of appeal come before the Law Officer, but he has now power over the costs, which he has not had hitherto.

Proceedings for extension remain practically the same under the new Act as under the old law.

The old action of *scire facias* is abolished, but instead a simple process for obtaining revocation of the patent is substituted (sect. 26).

The law as laid down in *Feather* v. *The Queen* is changed, and patents for the future will bind the Crown; but provisions are introduced into the Act for securing the use of the invention by contractors for the Crown on proper terms (sect. 27).

The old Register of Proprietors is discontinued, but the Register of Patents will practically include all entries which have hitherto been made in the Register of Proprietors.

There is considerable alteration in the matter of fees payable in respect of patents. The fees for obtaining the patent will be 4*l.* instead of 25*l.* The duties of 50*l.* and 100*l.* are continued, but are made payable before the end of

the fourth and eighth year, instead of the third and seventh, as heretofore.

The patentee may, in lieu of the 50*l.* and 100*l.*, pay the duties by annual instalments, so that he will be able from year to year to judge whether his patent succeeds so as to make it worth while to keep it up. This provision applies to existing patents, but owing to an omission in the Act it is of no avail to a patentee who has already paid a 50*l.* duty. In such a case, since the annual fees are only in place of both the 50*l.* and 100*l.*, there is no power in the Office to accept annual instalments in place of the 100*l.* only.

The office of Commissioner of Patents is abolished, and the whole business formerly transacted by the Commissioners is placed under a Comptroller appointed by and acting under the superintendence of the Board of Trade.

An illustrated Journal of Patents is to be issued, with reports of patent cases; but by the Patents Rules the burden is imposed on the patentee of sending to the Office a drawing of his invention, with a description of the feature of novelty, for insertion in the journal, a burden which it is feared will press very hardly on poor inventors.

Applications for patents may be made through the post. Each application is to comprise one invention only. This, though nominally the rule hitherto, is a rule which has not been very strictly enforced, and its strict enforcement may give rise to considerable trouble and expense.

The practice in actions for infringement of patent is little, if at all, altered, except that for the future they are not to be tried by a jury unless the Judge shall otherwise direct, and except also that either party may require the Judge to call in the aid of an assessor (sect. 28 (1)). The Court of Appeal and the Privy Council may also call in such aid (sect. 28 (2)), and the Law Officer may avail himself of similar assistance (sect. 11 (4)).

There is very little alteration as to the Law of Designs, except that the whole matter is put under the Comptroller. Provisional registration is abolished, and there is no registration of useful designs as such. Such of those designs as are patentable will probably form the subject of patents, while

other designs which were formerly registered as useful can be registered under the general powers of the Act. The power to register works of sculpture conferred by the repealed Act of 1850 is not re-enacted; and for the different terms of copyright given by the old Acts there is now substituted for all designs an uniform term of five years. The fees on registration are very materially reduced.

In trade marks there are one or two notable alterations in the practice. The definition of trade mark under which new marks are registered (sect. 64) is enlarged by the addition of some particulars, the most important of which is "fancy words not in common use"; and "letters or figures" may now be registered as old marks, which could not be done under the Act of 1875.

The "three mark rule" is considerably modified, and apparently any number of marks may now be registered in the same class, subject, however, to the restriction that old marks used by more than three persons on the same or a similar description of goods are to be deemed common to the trade in such goods (sect. 74 (3)), and that except where the Court has decided that two or more persons are entitled as proprietors of the same mark, identical marks, or marks too nearly resembling those already on the Register, are not in any case to be registered for the same goods or description of goods (sect. 72).

Power is now given to register as "additions" to trade marks devices, &c., common to the trade if accompanied by a disclaimer on the part of the applicant of any exclusive right to such devices (sect. 74 (3)).

Registration of a series of marks in one registration is expressly permitted, and each mark is then to be considered as separately registered, except for the purposes of transmission, thus obtaining all the benefits, and obviating the inconveniences, of the old practice of what was called "representative registration" (sect. 66).

Trade marks may now be registered in any colour, and the registration is to confer the exclusive right to use the mark in that or any other colour (sect. 67).

The practice as to cutlery marks is materially changed

(sect. 81), and a Sheffield Registry is established, under the control of the Cutlers' Company, for marks in the Sheffield district; but the registration, when made, is to be notified to the Comptroller, who is to enter the same in the Register of Trade Marks; and, on the other hand, the Comptroller is to notify to the Sheffield Registry applications which he receives from that district. The Comptrolier has power to stop registration of any mark by the Cutlers' Company, subject, however, to an appeal to the Court.

The Act contains stringent provisions for preventing the sale of articles as patented when there has been no patent granted; or the false representation of a design or trade mark as registered when it is not so (sect. 105); or the unauthorized use of the Royal arms in such a manner as to lead to the inference that the trade or calling in connection with which they are used is carried on under the authority of Her Majesty, or any of the Royal family, or any Government Department (sect. 106).

Under the old Act and Rules the question of registration of trade marks was assigned to the Chancery Division. This is no longer the case.

It remains to say a word as to the arrangement of this work.

The notes are placed at the end of each section of the Act, the various sub-sections being separately treated under numbers corresponding to the sub-section, and placed in the middle of the page. Immediately under each section are references (with Greek letters) to the various Rules, a mode of reference which appears to be very convenient when an Act is followed by Rules or Orders, and which the writer has taken the liberty of borrowing from Mr. Buckley's well-known book on the Joint Stock Companies Acts.

The Rules are printed at the end of the Act, and there is added an Appendix containing certain orders made in patent cases as to consolidation, inspection, and other matters, which have not, it is believed, been published. In the Appendix will be also found extracts from the "Instructions" relative to the registration of trade marks issued by the Patent Office.

The writer has to thank his friends, Mr. Hull, of the Chancery Bar, and Mr. C. E. E. Jenkins, of Lincoln's Inn, for

assistance in correcting the proof sheets; and Mr. Johnson, President of the Patent Agents' Institute, for like help, and for many valuable suggestions during the progress of the work.

In conclusion, the writer begs leave to lay his work before the profession, in the hope that it may be found useful.

LINCOLN'S INN,
JANUARY 1884.

ABBREVIATIONS USED IN THIS WORK.

The Act of	1835	.. 5 & 6 Wm. IV, c. 83 (Patents).
,,	1842	.. 5 & 6 Vict. c. 100 (Designs).
,,	1843	.. 6 & 7 Vict. c. 65 ,,
,,	1850	.. 13 & 14 Vict. c. 104 ,,
,,	1852	.. 15 & 16 Vict. c. 83 (Patents).
,,	1853	.. 16 Vict. c. 5 (Patents).
,,	1858	.. 21 & 22 Vict. c. 70 (Designs).
,,	1861	.. 24 & 25 Vict. c. 73 ,,
,,	1875	.. 38 & 39 Vict. c. 91 (Trade Marks Registration).
,,	1876	.. 39 & 40 Vict. c. 33 ,, ,,
Seb. Dig.	..	.. Sebastian's Digest of Cases of Trade Mark, &c.
S. J. ..	..	.. Solicitors' Journal.
Eng. Rep.	..	.. Notes of Cases reported in the "Engineer," reprinted from the "Engineer," 1881.

Mr. Webster's Reports of Patent Cases are referred to sometimes under the abbreviation Webst., and sometimes as Webst. P. C.

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[46 & 47 VICT. CH. 57.]

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ADDENDA.

Page 157, line 12, *add*—and such an undertaking may be added to the register on the *ex parte* application of the applicant, the consent in writing of the comptroller being produced (*Re Keep's Trade Mark*, W. N. 1884, p. 30).

Pages 163, 168, 187—*Re Ralph's Trade Mark* is now reported 25 Ch. D. 194.

Page 187, note (*i*)—In *Re Riviere's Trade Mark* it was held by the Court of Appeal that it could not be laid down 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; and that it was a matter to be tried on the evidence whether he was aggrieved, and that if he was he could apply to have the register rectified (W. N. 1884, p. 27).

THE

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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. A.D. 1883

[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.

Part I. Preliminary.

PRELIMINARY.

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:— Division of Act into parts.

Part I.—Preliminary.
Part II.—Patents.
Part III.—Designs.
Part IV.—Trade Marks.
Part V.—General.

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. Commencement of Act.

A.D. 1883.
Part II.
Patents.

PART II.

PATENTS.

Application for and Grant of Patent.

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.

(1.)

A patent might always be granted to an *alien amy* (*a*) even though resident abroad (*b*).

(2.)

Joint grantees.

This, so far as it relates to joint *inventors*, is only a statement of the existing law. It has been the common practice in such a case to grant patents to two or more persons jointly (*c*), and the fact that one of the joint grantees is an infant will not affect the validity of the patent (*d*).

In *Mathers* v. *Green* (*e*) it was held by Lord Cranworth, C., on the words of the grant in the patent, reversing the decision of Lord Romilly, M.R., that each one of three joint grantees might use the invention without the consent of the others, and without liability to account to them for the profits made by such use. In the same case Lord Romilly had held (*f*) that one of such grantees was bound to account to the others for royalties received under licences, but this point was left undecided on the appeal.

There is no decision as to the power of one grantee to grant a valid licence without the consent of his co-grantees. It appears, however, to be doubtful whether, except for the authority conferred by the granting and prohibitory clauses of the patent, any licence could be granted at all (*g*), and it will probably be found, therefore, that the question will in all cases turn on the words of the patent itself. If the grant is, as in the patent in *Mathers* v. *Green*, to the grantees, their executors, administrators, and assigns, that they and every of them, by themselves, their servants and agents, *and such others as they may agree with*, and no others, may use the invention, then, unless the effect of these words is modified by the prohibitory clause, it would

(*a*) *Beard* v. *Egerton*, 3 C. B. 130; citing *Chappell* v. *Purday*, 14 M. & W. 318.

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

(*c*) See *Mathers* v. *Green*, L. R. 1 Ch. 29.

(*d*) *Per* Bacon, V.C., *Cheavin* v. *Walker*, 5 Ch. D. 858.

(*e*) L. R. 1 Ch. 29.

(*f*) 34 Bea. 170

(*g*) "Hindmarch on Patents," p. 238. See First Schedule, Form D, *post*.

seem that no licence could be granted without the concurrence of all the grantees (*h*). See further as to co-owners of a patent, sect. 87, *post*.

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 (*a*); and must be left at, or sent by post to, the Patent Office in the prescribed manner (*β*).

(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 (*γ*).

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

(*a*) Patents Rules, 1883, rr. 6, 8, 9, 10, *post*. Applications must be signed by the applicant: all other documents may be signed by an agent (r. 8).

(*β*) Patents Rules, 1883, r. 19.

(*γ*) *Ibid.* rr. 28–30.

(*δ*) *Ibid.* Forms B, C, Second Schedule.

(2.)

These provisions are new. Hitherto patents could only be granted to the true and first inventor, that is, either the actual inventor or inventors, or the first importer of the invention into this kingdom (*i*).

Communications from abroad.

"*True and first inventor.*" These words, which are taken from the Statute of Monopolies (*k*), are, by what has been described as "an anomalous decision which has acquired by time the recognition and force of law" (*l*), held to include not merely the actual inventor but also the first importer of the invention into the country from abroad, even though not the actual inventor, and such an importer is entitled

(*h*) See also Judgment of Jessel, M.R., in *Powell* v. *Head*, 12 Ch. D. 690, a copyright case.

(*i*) "Hindmarch on Patents," 22, c. iii, ss. 2, 3.

(*k*) 21 Jac. 1, c. 3, s. 5.

(*l*) *Per* Jessel, M.R. *Marsden* v. *Saville Street, &c., Co.*, 3 Ex. D. 203, 205.

to take out a patent, and if not in a confidential relation to the actual inventor, may hold it for his own benefit (*m*). The invention comprised in such a patent is therein described as "communicated from abroad," and it is required that the name, address, and calling of the person by whom the same was communicated should appear in the application (Patents Rules, 1883, Form A1). If a person takes out a patent as for an original invention, when, in fact, it was communicated to him from abroad by the inventor in order that he might obtain a patent for the inventor, the patent is void (*n*). It is not necessary that the person taking out the patent should be the *meritorious* importer, he may be the mere clerk or agent of the foreign inventor (*o*), and may himself be an alien resident abroad (*p*).

Patentee may be agent of inventor.

The patent may be (*q*), and generally is, obtained by the agent as trustee for and on behalf of the actual inventor, and the latter is, in the eye of the law, a mere stranger. And so strictly has this distinction been observed that when it was objected that the inventor, a foreigner, for whom the patent was held by his English patent agent, to whom it had been granted as a communication from him, was possessed of knowledge which it was alleged ought to have been but was not embodied in the specification, and that therefore the patent was bad, it was held that, inasmuch as it was not suggested that this knowledge was possessed by the actual patentee, the objection failed altogether (*r*).

On question of specification, knowledge of the patentee, not of the inventor, is looked to.

So also it was held that the fact that in the specification of a patent for a communication from abroad the patentee had stated all that had been communicated to him was no answer to an objection that the specification did not sufficiently describe the invention (*s*).

Rule as to communication from abroad not extended to communication in this country.

It was, however, held that the privilege thus granted to the importer of a foreign invention could not be extended so as to include a communication made in England from one British subject to another, and that the legal personal representative of an inventor deriving his knowledge only from the inventor's papers could not take out a patent (*t*). (See now, however, sect. 34, *post*.) But if a man from abroad communicates to A., who communicates to B., it seems that B. may take out the patent (*u*), and letters patent can be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad (*x*).

(3.)

Provisional specification.

It will be observed that the language of the Act (which in this particular is the same as the Act of 1852) (*y*), differs as regards the

(*m*) *Steadman* v. *Marsh*, 2 Jur. (N. S.) 391.

(*n*) *Milliyan* v. *Marsh*, 2 Jur. (N.S.) 1083. The head-note appears incorrect.

(*o*) *Beard* v. *Egerton*, 3 C. B. 129.

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

(*q*) *Beard* v. *Egerton*, 3 C. B. 97.

(*r*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 582.

(*s*) *Wegmann* v. *Corcoran*, 13 Ch. D. 66; 41 L. T. (N. S.) 357.

(*t*) *Marsden* v. *Saville Street, &c., Co.*, 3 Ex. D. 203. See also *Tennant* v. ———, 1 Webst. 125, n.

(*u*) *Per* Jessel, M.R., *Plimpton* v. *Malcolmson*, 3 Ch. D. 552.

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

(*y*) 15 & 16 Vict. c. 83, s. 6.

provisional and complete specification. While the former is required only to *describe the nature* of the invention, the latter must *particularly describe and ascertain* the nature of the invention, *and in what manner it is to be performed* (*z*). The provisional specification need not enter into all the minute details as to the manner in which the invention is to be carried out (*a*). It is only to disclose the invention in the rough state (*b*). It need not describe the manner in which the invention is to be carried into effect, nor need it describe the nature of the invention otherwise than roughly, but it ought to do so fairly and honestly (*c*).

Difference of requirements in provisional and complete specification.

See also under sect. 9 (1), *post*.

(4.)

It is beyond the scope of this work to describe in detail the law as to complete specifications. On this subject the reader is referred to the well-known works on the General Law of Patents. An useful and complete summary of the rules as to specifications (with reference to the cases) will also be found in the Table of Contents to Mr. Goodeve's "Abstract of Reported Cases relating to Letters Patent."

(5.)

Hitherto a "claim," though usual, has not been a necessary part of a specification (*d*); its object was not to claim anything which is not mentioned in the specification, but to disclaim something which is in it, and which the patentee does not profess to have invented (*e*). Henceforth a claim will be an essential part of every specification. See First Schedule, Form C, and Patents Rules, 1883, Second Schedule, Form C.

Claims.

As to correction of clerical errors in or in connection with an application for a patent, see sect. 91 (*a*), and Patents Rules, 1883, r. 18, *post*.

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 (*a*), and the title sufficiently indicates the subject-matter of the invention.

Reference of *application to* examiner.

(*a*) Patents Rules, 1883, *post*, rr. 5–10, 27–30. The acceptance of an application is to be advertised, and notice of acceptance is to be given to the applicant. *Ibid.* r. 25.

"*Fairly described.*" See under sect. 5 (3), *ante*.

"*Title.*" See the cases collected in "Hindmarch on Patents," pp. 43-47;

(*z*) Sub-sect. 4.

(*a*) *Re Newall & Elliot*, 4 C. B. (N. S.) 269; *Penn* v. *Bibby*, L. R. 2 Ch. 127, 132.

(*b*) *Per* Jessel, M.R., *Stoner* v. *Todd*, 4 Ch. D. 58, 60.

(*c*) *Per* Fry J., *United Telephone Co.* v. *Harrison*, 21 Ch. D. 747.

(*d*) *Per* Williams, J., *Lister* v. *Leather*, 8 E. & B. 1004.

(*e*) See Judgment of James, L.J., *Plimpton* v. *Spiller*, 6 Ch. D. 426.

Johnson's "Patentees' Manual," 4th ed., pp. 93-97; "Agnew on Patents," pp. 143–149; Higgins' "Digest of Patent Cases," pp. 148–161.

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, 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 (*β*), give notice thereof to the applicant.

(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 (*a*), 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*) Whether with a provisional or complete specification (Patents Rules, 1883, *post*, r. 25), and the acceptance is to be advertised. *Ibid.*

(*γ*) The comptroller may require a statement in writing from or the attendance of the applicant's agent. *Ibid.* rr. 8, 13.

(6.)

Both applicants may attend the hearing, but each will be in ignorance of the nature of the rival specification so long as the matter remains before the comptroller (Patents Rules, 1883, r. 16). On appeal, however, to the law officer each will, under sect. 9 (5), be able to see the examiner's report. Neither can, however, in any case, see the rival

specification itself until its acceptance has been advertised (sect. 10). See Patents Rules, 1883, rr. 25, 26.

"*He may refuse*," &c. See *post*, pp. 14, 16.

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.

(1.)

The nine months is to be reckoned exclusively of the day of the date of the application. The usual course in recent times has been to "construe the day (of the date) exclusively, wherever anything was to be done in a certain event after a given event or date" (*f*); and see note to First Schedule, Patents Rules, 1883, *post*, and sect. 98.

Month means calendar month (*g*).

Abandoned provisional specification not made public by abandonment so as to vitiate subsequent patent for same invention.

A provisional specification which has been abandoned does not become public by abandonment, and therefore, when an applicant on the 10th April obtained, under the Act of 1852, provisional protection for four heads of invention, one of which formed the subject of a provisional specification lodged on the previous 17th March, which latter he thereupon abandoned and completed his patent on the provisional specification of the 10th April before that of the 17th March was made public by the Office, it was held that there was no publication of the invention sufficient to invalidate the patent (*h*).

Incomplete description in a provisional specification of part omitted in final.

And if a provisional specification contain an incomplete description which is omitted in the complete specification, the publication of the provisional specification is not necessarily such a publication as will invalidate a subsequent patent for the omitted part (*i*).

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 (*a*), 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

(*f*) *Per* Parke, B., *Russell* v. *Ledsam*, 14 M. & W. 582. *Williams* v. *Nash*, 28 Bea. 93.

(*g*) 13 & 14 Vict. c. 21, s. 4.

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

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

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

(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 (β).

(α) Patents Rules, 1883, r. 31, *post*.

(β) *Ante*, p. 6.

(1.)

The object of the provisional specification, which was first introduced by the Act of 1852, was to ascertain the identity of the invention, and to make it certain that the patentee should ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance (*k*). This being so, it was held that the provisional and complete specification of a patent ought not so to differ as that the nature of the invention as described in the one shall be materially different from the nature of the invention as described in the other (*l*); and an objection that there is a material variation between the provisional and complete specification has been a common objection to the validity of a patent. The provisions of this section will probably render such objections less frequent in future, but there appears to be nothing in the Act which makes the examination which the section directs conclusive, except as between the Patent Office and the applicant on the question whether or not the patent shall be granted. It will be useful, therefore, to consider the cases on this point.

Where a provisional specification of an invention of "improvements in preserving animal substances" described the use for this purpose of

(*k*) *Per* Pollock, C.B., *Newall* v. *Elliott*, 10 Jur. (N. S.) 935.

(*l*) *Foxwell* v. *Bostock*, 4 D. J. S. 298.

gelatine mixed with bisulphite of lime, and in the complete specification described and claimed several solutions, one being a solution of bisulphite of lime alone, as to which no directions for using were given, it was held that the claim was larger than, and different from, that disclosed in the provisional specification, and that if the complete specification were construed so as to include the use of bisulphite of lime alone, the patent would be invalid (*m*).

And where the complete specification for an invention of an electrical telephone included an invention of a phonograph which was not sufficiently described in the provisional, the patent was held void (*n*).

But where a patentee of improvements in apparatus for laying down telegraph wires described in his provisional specification a cable passed round a cone so that the cable in being drawn off the coil was prevented from kinking by means of the cone, and also described a cylinder outside which prevented the coil shifting, and the complete specification mentioned and claimed in addition certain rings placed round the cone with the object of preventing the bight of the rope from flying out when going at a rapid speed and so preventing kinking, it was held that the omission of the rings from the provisional specification did not invalidate the patent (*o*).

And again, where a provisional specification of an invention of "an improvement in the bearings and bushes of the shafts of screw and submerged propellers," described the invention as consisting in employing wood for such bearings and bushes, and the complete specification gave a detailed description showing how the wood was to be arranged in the bearings, and included the application of wood to the shaft so as to revolve therewith, there was held to be no material variance between the provisional and complete specification (*p*).

And generally when something is found out during the period of provisional protection "to make the invention work better, or with respect to the mode in which the operation is performed, a thing which is very likely to happen, when in carrying out his invention the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it, still the nature of his invention remains the same, and it is no objection that in the complete specification which comes afterwards the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that," the patent is good (*q*).

(*m*) *Bailey* v. *Roberton*, 3 App. Cas. 1055.

(*n*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 746. See also *Crossley* v. *Potter*, Macr. P. C. 240, 255.

(*o*) *Re Newall & Elliott*, 4 C. B. (N. S.) 269.

(*p*) *Penn* v. *Bibby*, L. R. 2 Ch. 127, 135.

(*q*) *Per* Lord Blackburn, *Bailey* v. *Roberton*, 3 App. Cas. 1055, 1075.

And a complete specification may omit something which is described in its provisional specification if there is no fraud, and the effect of the remainder is not altered (*r*). But if there is such an omission, the provisional specification cannot afterwards be read for the purpose of supplying a defect in the complete specification (*s*).

(2.)

There is nothing in the Act which makes the acceptance of the complete specification conclusive as to its sufficiency in point of law. Objections to the validity of a patent on the ground of insufficiency of specifications may, it is submitted, be taken as heretofore by way of defence to an action for infringement. See notes to sect. 29 (2), *post*.

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 (*a*).

(*a*) Patents Rules, 1883, rr. 25, 26, *post*.

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 (*a*).

(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,

(*r*) *Thomas* v. *Welch*, L. R. 1 C. P. 192; *Penn* v. *Bibby*, L. R. 2 Ch. 127, 134.

(*s*) *Mackelcan* v. *Rennie*, 13 C. B. (N. S.) 52.

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.

(a) As to proceedings on opposition, see Patents Rules, 1883, *post*, rr. 32-41, and Law Officers' Rules, *post*.

(1.)

Opposer must have an interest.

"*Any person.*" The 12th section of the Act of 1852 limited opposition to persons "having an interest in opposing the grant of letters patent." In the present section the first ground of opposition implies of necessity an interest in the opposer; but the second and third grounds are, on the face of them, available to any one of the outside public. The 3rd sub-section, however, limits this right to persons "being in the opinion of the law officer entitled to be heard in opposition to the grant." The old rule requiring an interest in the opposer therefore *in substance appears still to prevail.*

There is a similar limitation in the case of opposition to amendment of the specification, sect. 18 (4), but there is no such limitation on opposition to extension of the term of a patent, sect. 25.

Prior user—non-utility—no subject-matter not now grounds of opposition.

Prior public user (*t*)—want of utility (*u*)—or an objection that the invention is not subject-matter of a patent (*x*), were formerly, but are not now, grounds of opposition to the grant, which can now be opposed only on the three grounds mentioned in this section.

Under the new practice the comptroller will, it would seem, fill very much the position in regard to the grant of patents formerly occupied by the law officer, while the law officer will perform the duties formerly belonging to the Lord Chancellor, whose jurisdiction as to patents, specially reserved by sect. 15 of the Act of 1852, is not mentioned in the present Act, and appears no longer to exist, unless, perhaps, under sect. 116, *post*.

It may be therefore useful to examine the principles which appear to have guided the decisions on oppositions under the old practice, but it must be remembered in considering these cases that some of them are cases in which the patent had not been opposed before the law officer, and was opposed for the first time at the Great Seal, and in such cases opposition was in the discretion of the Lord Chancellor (*y*) and a matter of indulgence (*z*), whereas by the present Act there is a distinct right of appeal from the comptroller to the law officer.

(*t*) *Re Adamson's Patent*, 6 D. M. G. 420; *Re Samuda and Griffiths* cited "Hindmarch on Patents," p. 534; *Re Tolhausen's Patent*, 14 W. R. 551.

(*u*) *Re Cutler's Patent*, 1 Webst. 426.

(*x*) *Re Spence's Patent*, 3 De G. & J. 523.

(*y*) *Ex parte Henson*, 1 Webst. 432.

(*z*) *Ex parte Manceaux*, L. R. 5 Ch. 518; *Re Mitchell's Patent*, L. R. 2 Ch. 343.

A collection of cases before the law officers not elsewhere reported will be found in Johnson's "Patentees' Manual," 4th ed., pp. 159 to 163.

Lord Chancellor would not interfere with law officer's decision unless in special cases.

When the law officer had, after hearing the parties, allowed his warrant to issue, the Lord Chancellor would not interfere with his decision unless a case were made of surprise or fraud, or unless some material fact which, if brought before the law officer, would probably have led him to decide differently, had subsequently come to the knowledge of the party appealing (*a*); nor would the Lord Chancellor interfere on the ground that some fact which was in the knowledge of the opponent at the time was not brought before the law officer (*b*); nor was the opponent allowed to adduce before the Lord Chancellor evidence which he might have brought before the law officer, or to raise before the Lord Chancellor an argument on those facts which he did not raise before the law officer (*c*).

In doubtful cases rule was to seal patent.

In *Re Russell's Patent* (*d*), Lord Cranworth, C., said that as a general rule when the matter was in much doubt it was better to run the risk of putting the party opposing to the costs of making out his case in some ulterior proceedings than to withhold the Great Seal from the patent in the first instance, for the obvious reason that the one course would create a remediable and the other an irremediable injury. And this rule was approved and acted on by Lord Chelmsford, C., in *Re Spence's Patent* (*e*), where it was objected that there was no novelty in the alleged invention, and that it consisted merely in the application of a well-known process to an equally well-known manufacture; and in *Ex parte Sheffield* (*f*) Lord Selborne, C., said that the burden lies on the opponent of showing that the proposed grant is wrong. The question is not whether the proposed patent will be good, but merely whether the applicant can be allowed to proceed.

On this principle letters patent have been sealed even when on the evidence there appeared to be considerable similarity between the alleged invention and one already patented (*g*), and where the evidence of prior user was contained in only one affidavit proving a sale which was not corroborated by the person alleged to have sold the goods (*h*).

Law officer was bound to decide between rival applicants.

It was the duty of the law officer to hear and determine which of two rival applicants was entitled to a patent, and the question was not to be remitted to the Lord Chancellor by directing warrants upon both patents (*i*).

(*a*) *Re Vincent's Patent*, L. R. 2 Ch. 341; see also *Re Daines' Patent*, 26 L. J. Ch. 298; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*b*) *Re Vincent's Patent*, cited above.

(*c*) *Ex parte Sheffield*, L. R. 8 Ch. 237; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*d*) 2 De G. & J. 130, 132. See also *Re Simpson and Isaacs' Patent*, 21 L. T. 81; *Re Spence's Patent*, 3 De G. & J. 523.

(*e*) 3 De G. & J. 523. Not now a ground of opposition.

(*f*) L. R. 8 Ch. 237.

(*g*) *Re Tolson's Patent*, 6 D. M. G. 422.

(*h*) *Re Tolhausen's Patent*, 14 W. R. 551. This is not now a ground of opposition.

(*i*) *Ex parte Henry*, L. R. 8 Ch. 167.

The Lord Chancellor would sometimes hear *viva voce* evidence on an application for the Great Seal (*k*), but in general the evidence was taken by affidavit, though declarations were used before the law officer. The evidence is now to be by declaration (Patents Rules, 1883, rr. 35, 36). Power is given to the law officer to examine witnesses on oath (sect. 38), and they may be cross-examined (Law Officers' Rules, *post*, r. IX).

Viva voce evidence.

Upon the hearing of a petition for the Great Seal, the Lord Chancellor would not give effect to an objection founded on a mere matter of form, such as an objection to the jurat to a declaration (*l*). The Lord Chancellor could impose terms on the parties applying for a patent (*m*).

Mere formal objections not admitted.

As to costs in opposition cases, see notes to sect. 38, *post*.

GROUNDS OF OPPOSITION.

i. *That applicant obtained the invention from the person giving notice of opposition, or from a person of whom he is the legal representative.*

Grounds of opposition under this Act.

Where the grant of a patent was opposed on the ground that the invention was only an improvement on a previously patented invention, not the invention of the applicant, but in which he was interested, and which he and the patentee had assigned to the opponent, who had thereupon granted a licence to the applicant to use the patented invention; the new patent was ordered to be sealed, but (the Lord Chancellor being of opinion that the applicant had obtained his knowledge while working the original patent) only on the terms that it should be assigned to the owner of the first patent, to be subject, however, to the same arrangement as to licence and otherwise in favour of the applicant; the cost of obtaining the second patent to be considered as part of the costs of working the first patent (*n*).

And when a master and his foreman had both invented improvements for which the master sought letters patent, they were granted only on the terms of the master and foreman being treated as joint grantees, the letters patent being vested in two trustees for their joint benefit, and each party to have a free licence for himself and his partners (*o*).

But the fact that another person has been making experiments and working towards the same invention as the applicant is no ground for refusing the Seal (*p*).

ii. *That the invention has been patented in this country on an application of prior date.*

If the opponent could show that the proposed patent was for an invention, part of which was clearly identical with the subject of an

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

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

(*m*) *Re Daines' Patent*, 26 L. J. (N. S.) 298; *Re Russell's Patent*, 2 De G. & J. 130.

(*n*) *Re Daines' Patent*, 26 L. J. (N. S.) 298.

(*o*) *Re Russell's Patent*, 2 De G. & J. 130.

(*p*) *Ex parte Henry*, L. R. 8 Ch. 167.

existing patent, the Great Seal would not (*q*), at all events where both parties were *bonâ fide* inventors and there was no fraud (*r*), be affixed to a patent for that part, even though the validity of the original patent was disputed (*s*). And in *Ex parte Bates and Redgate* (*t*) this principle was applied when the owner of the existing patent was, in fact, the second applicant for the patent, but had first obtained the Great Seal (*u*). See notes under sect. 13, *post*.

But in *Re Vincent's Patent* (*x*), where the opposer brought forward a prior patent of his own, and the applicant alleged that he was the real inventor, and had confidentially communicated the invention to the opposer, who had applied for and obtained a patent in fraud of the applicant's rights, it was held that the case being thus within sect. 10 of the Act of 1852 (sect. 35 of the present Act), the applicant's patent ought to be sealed in order that he might have the opportunity of trying the question before a jury.

And the patent was sealed when the only ground of opposition was that the invention was borrowed from an existing patented invention, it being an improvement thereon (*y*).

But where, in a case of rival applicants, each opposed the other, and it appeared that the alleged invention was the subject of a previous patent, both applications were refused (*z*).

Where the law officer certified against an application on the ground that the invention was similar to an invention comprised in an existing patent, the application was refused, with costs (*a*).

Concurrent applications.

iii. *That the examiner has reported 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.*

Where two parties applied for a patent, and each opposed the other on the ground that he alone was the inventor, and the evidence on this point was conflicting, the patent of the first applicant was sealed (*b*).

Where there were concurrent applications for the same invention, and the last application having been delayed, the second applicant was in a position to seal his patent first, Lord Eldon, C., held that the applicant who first obtained the Great Seal was to be preferred, and said, "I can see no other mode of deciding than by awarding the patent to

(*q*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577; comp. *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(*r*) *Ex parte Manceaux*, L. R. 6 Ch. 272.

(*s*) *Ex parte Manceaux*, L. R. 6 Ch. 272.

(*t*) L. R. 4 Ch. 577.

(*u*) See also *Ex parte Bailey*. L. R. 8 Ch. 61; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*x*) L. R. 2 Ch. 341.

(*y*) *Ex parte Fox*, 1 Webst. 431; 1 V. & B. 67.

(*z*) *Re Samuda and Griffiths*. "Hindmarch on Patents," p. 534.

(*a*) *Ex parte Yates*, L. R. 5 Ch. 1. See also *Re Stoll's Patent*, 21 L. T. 233.

(*b*) *Re Lowe's Patent*, 25 L. J. Ch. (N. S.) 454.

him who runs the quickest through the process" (*c*). And this rule was subsequently recognized by Lord Cranworth (*d*).

As to applications on the same day in respect of the same invention, see *In re Dering's Patent* (*e*), *post*, sect. 13.

12. (1.) If there is no opposition, or, in 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. Sealing of patent.

(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 hereinafter 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 representative and sealed at any time within twelve months after the death of the applicant.

(2.)

"*As if it were sealed with the Great Seal of the United Kingdom.*" That is, it will prove itself and cannot be denied (*f*).

(3.)

(*a.*) Under the 20th section of the Act of 1852 it was held that when the delay was caused by opposition, the patent might be sealed even though the hearing took place after the expiration of the provisional protection, and the additional month allowed by the 6th section of the Act of 1853 (*g*).

On the analogy of this case it would seem that under similar circumstances the patent may be sealed though the hearing does not take place till after the fifteen months.

(*b.*) A re-enactment with modifications of sect. 21 of the Act of 1852.

(*c*) *Ex parte Dyer.* "Hindmarch on Patents," p. 535.

(*d*) *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*e*) 13 Ch. D. 393.

(*f*) "Hindmarch on Patents," pp. 37, 264, 438.

(*g*) *Re Johnson's Patent*, 13 Ch. D. 398, n; *Re Somerset and Walker's Patent*, *Ibid.* 397.

Date of patent.

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.

"*Dated and sealed as of the day of the application.*" This provision is new. Under the Act of 1852, sect. 23, the Lord Chancellor or the law officer had a limited discretion as to the date of the patent. And under this section it was sometimes made a condition of sealing the patent that it should bear a particular date (*h*). Such a condition cannot now be imposed.

The patent will, subject to the next proviso, take effect as from the day of application, whatever be the day when the seal is actually affixed (*i*).

"*Provided that no proceedings,*" *&c.* The result of this, and the proviso at the end of sect. 15, appears to be that until the patent is actually granted, no proceedings for infringement can be instituted at all, nor even then in respect of infringements committed before the publication of the complete specification (see sect. 10), but that in an action brought after the grant of the patent, relief may be had in respect of infringements committed between the date of the publication of the complete specification and the time of the grant, as well as in respect of infringements after the grant.

Rival applications at different dates for same invention.

"*Provided also that in case,*" *&c.* Certain expressions in the Judgment of Lord Hatherley, C., in *Ex parte Bates and Redgate* (*k*), and of Lord Selborne, C., in commenting on that case in *Ex parte Bailey* (*l*) and *Ex parte Henry* (*m*), appear to throw doubt on the power of the Crown, in the case of rival applications on different dates for patents for the same invention, to seal both patents. On the other hand, in *Saxby* v. *Hennett* (*n*) Kelly, C.B., said that in such case of the competency of the Crown to seal both patents there could be no doubt, and this appears also to have been the view of Earl Cairns, C., in *Re Dering's Patent* (*o*). The doubt is now removed as to the case mentioned in this proviso. But the proviso is only permissive and not obligatory, and it is therefore necessary to consider what was the old practice on this point.

(*h*) *In re Johnson's Patent*, 13 Ch. D. 398 n; *Ex parte Bailey*, L. R. Ch. 60; *In re Harrison*, L. R. 9 Ch. 631.

(*i*) See *Saxby* v. *Hennett*, L. R. 8 Ex. 210; *Holste* v. *Robinson*, 4 Ch. D. 9.

(*k*) L. R. 4 Ch. 580.

(*l*) L. R. 8 Ch. 63.

(*m*) L. R. 8 Ch. 169.

(*n*) L. R. 8 Ex. 213.

(*o*) 13 Ch. D. 395.

Rule in *Ex parte Bates and Redgate.*

It was at one time considered that under the Act of 1852 the provisional specification secured the invention for six months, and that the letters patent would be dated as of the date of the provisional specification; and the ordinary practice was to wait until the expiration of four months (*p*) before giving notice of intention to proceed with the patent, and then to wait two months more before obtaining the Great Seal (*q*).

But in *Ex parte Bates and Redgate* (*r*) it was held by Lord Hatherley, C., that leaving a provisional specification and obtaining provisional protection did not prevent a second applicant from leaving a provisional specification of a similar invention, and obtaining valid letters patent for his invention before the expiration of the first provisional protection, and that in such a case letters patent would not be granted to the first applicant for any part of his invention which was covered by the letters patent already obtained by the second applicant.

The ground of this decision was that a person could not, by filing a provisional specification only, not choosing to file a complete specification, obtain anything more than a right to be protected against the consequence of his own publication, and does not obtain *a right* to priority over any other person who had independently and originally hit upon the same idea, and, in anticipation of the other, first gave the world the benefit of it (*s*).

In *Ex parte Manceaux* (*t*) Lord Hatherley, C., again acted on this principle, and refused to seal the patent of a first applicant when the law officer had reported that part of the invention for which the patent was sought was comprised in a patent which had before the expiration of the first applicant's provisional protection been granted to a second applicant. His Lordship pointed out the inconvenience of granting two patents for the same invention arising from the fact that the question is not between the patentees only, but affects the public, who will be at a loss to know with whom to deal. In this last case the circumstances that the invention had been previously published abroad, so that neither of the parties was in the position of an original inventor, and that there was no case of fraud, nor was the first patentee a servant of the applicant, were considered as bearing on the question of affixing the Seal.

In *Ex parte Scott and Young* (*u*), however, in a case where servants had filed a provisional specification, after which the master filed a provisional specification of a similar invention, and before the servants had obtained their patent filed a complete specification, and had his patent sealed, and the evidence disclosed grounds for serious suspicion

(*p*) The period allowed by the rules of Dec. 12, 1853.

(*q*) *Lee v. Walker*, L. R. 7 C. P. 124, 125. Judgment of Brett, J.

(*r*) L. R. 4 Ch. 577.

(*s*) *Per* Lord Hatherley, C., *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(*t*) L. R. 6 Ch. 274. See also *Ex parte Yates*, L. R 5 Ch. 1; *Re Stoll's Patent*, 21 L. T. 233.

(*u*) L. R. 6 Ch. 274.

that the master had derived his knowledge from the servants, the same learned Judge held that *Ex parte Bates and Redgate* did not apply, and ordered the servants' patent to be sealed and dated as of the date of their provisional specification.

But in *Ex parte Bailey* (*x*) Lord Selborne, C., treated the case of *Ex parte Bates and Redgate* as laying down the rule that if an application to seal a patent is made after the sealing of another, care shall be taken that the new patent does not cover the ground which is covered by the earlier patent, and when a second applicant had first obtained the Great Seal, refused to antedate the patent of the first applicant, and ordered it to be dated as of the day of his application for the Seal, and this notwithstanding the conduct of the first applicant was alleged to be fraudulent.

Rival applications on same day.

Where, however, rival applicants had applied on the same day for patents for inventions alleged to be identical, and had afterwards mutually agreed to withdraw opposition, and one of the applicants, having obtained his patent, opposed the other at the Great Seal, and stated that the agreement only extended to proceedings before the law officer, Lord Cairns, C., being of opinion that the parties had agreed to withdraw opposition at all stages, treated both patents as having been unopposed, and sealed the second patent, dating it also the day of application (*y*).

And in similar circumstances, where, however, there had been no mutual agreement, the same learned Judge sealed both patents as of the day of the date of their respective applications; and after holding that the case was distinguishable from *Ex parte Bates and Redgate*, thus stated his objections to that case: "It has always seemed to me that if Parliament held out to inventors the advantage they should get from provisional protection, the inventor should have the enjoyment of that advantage for the six months given to him. Parliament intended the six months to be for the completion of the invention, and for the perfecting the specification, and never said that the applicant should be deprived of that advantage by want of any due diligence on his part." And again: "*Primâ facie* the Crown ought to seal both patents. The contract with each of them on provisional protection was that he should have six months' protection. Now, if it is true that both have acted in good faith, what right have I to confiscate the invention of one, because it happens to be identical with the invention of the other? . . . . . Why should they not have become joint proprietors of this invention by agreement between themselves? I cannot see any reason why they should not, and, if so, why cannot they in effect be made co-proprietors by the grant of separate letters patent?" (*z*).

Effect of the rule in *Ex parte Bates and Redgate*.

Since the decision in *Ex parte Bates and Redgate* it has been necessary to get a patent sealed as soon as possible in order to prevent a

(*x*) L. R. 8 Ch. 60.
(*y*) *Re Gething*, L. R. 9 Ch. 633.
(*z*) *In re Dering's Patent*, 13 Ch. D. 393.

rival inventor from stepping in and obtaining a patent, and in a case where a patent agent retained to obtain a patent for an applicant had, in ignorance of this decision, followed the old practice, and the result had been that a rival inventor had first obtained the Great Seal, and the applicant was refused a patent, the agent was held liable in an action for negligence (*a*).

If two patents have been sealed for the same invention, acts done by virtue of the patent dated last are infringements of the first-dated patent (*b*). Infringement when two patents for same invention

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. Provisional protection.

This provision is substantially the same as the corresponding provision in the Act of 1852, sect. 8, except as to the time of duration of the provisional protection.

The effect of provisional protection was thus stated by Lord Hatherley, C. (*c*), (referring to the Act of 1852) :— Provisional protection.

"Under sect. 8" the patentee "may use his invention for six months (*d*) 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 specification, and then he is absolutely protected for six months, and has a right to proceed as if he had a patent for that period."

These latter words must now be read subject to the proviso at the end of the 15th section of this Act.

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 Effect of acceptance of complete specification.

(*a*) *Lee* v. *Walker*, L. R. 7 C. P. 121.

(*b*) *Saxby* v. *Hennett*, L. R. 8 Ex. 210.

(*c*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 578.

(*d*) Now for the period between date of application and date of sealing.

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.

The first clause of this section is a re-enactment with modifications of part of sect. 9 of the Act of 1852, which authorized the filing of a complete specification with the petition for letters patent.

Under that section it was held that the principle of *Ex parte Bates and Redgate* could not be applied to enable an applicant who lodged a complete specification to acquire the rights of a patentee so as during the term of protection to prevent any other person who had previously applied for a patent for a similar invention from obtaining a patent (*e*).

"*Provided that an applicant*," *&c.* A re-enactment with modifications of the last clause of the 24th section of the Act of 1852. See note under sect. 13, *ante*.

Patent.

Extent of patent.

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

The Channel Islands, which under the Act of 1852, sect. 18, were included in letters patent, will be omitted from the patents to be granted under the present Act. See First Schedule, Form D.

Term of patent.

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

(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:

(*e*) *Ex parte Henry*, L. R. 8 Ch. 167.

(*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*) Patents Rules, 1883, *post*, rr. 46, 47. By r. 47 the time for doing any act or taking any proceeding under the Rules may be enlarged, and by r. 18 irregularities in procedure may be corrected.

(1.)

The term includes the day of the date, therefore the patent will expire at midnight of the 14th anniversary of the day before the date of the patent (*f*).

(2.)

See notes to sect. 8 (1), and First Schedule, Patents Rules, 1883, *post*.

(3) and (4.)

These provisions are new.

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 heard in opposition

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

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) Patents Rules, 1883, *post*, rr. 48–56.

(β) The notice is to state the grounds of opposition. *Ibid.* 49.

(γ) The evidence is to be by declaration (*Ibid.* 51), and before the law officer witnesses may be cross-examined. Law Officers' Rules, *post*, r. IX.

(1.)

Disclaimers under old law.

"*Disclaimer, correction, or explanation.*" The power to amend a specification or drawings by way of correction or explanation is new. The only amendment hitherto allowed, except in the case of clerical errors has been under the Act of 1835 (*g*), sect. 1, which gave power to file, with the leave of the law officer, "a disclaimer of any part of the title of the invention or of the specification," or to enter with the like leave "a memorandum of any alteration in the said title or specification not being such disclaimer, or such alteration as should extend the exclusive right granted" by the letters patent.

Under this Act the only authority conferred on the patentee was "the power of rejecting" (*h*). The invention might be "reduced or

(*g*) 5 & 6 Wm. 4, c. 83.

(*h*) *Per* Lord Westbury, C., in *Ralston v. Smith*, 11 H. L. C. 245.

diminished, but it must not be extended or enlarged" (*i*). But slight additions required to render intelligible what remains after something had been cut out of the specification were always admissible in a disclaimer (*k*), such, for instance, as the addition or transfer from a disclaimed part of the specification of the words "herein described" (*l*).

Clerical errors, old law.

Mere clerical errors in a specification could be corrected on application to the Master of the Rolls, as Keeper of the Records, on obtaining the consent of the law officer (*m*); and it would seem that this course will still be necessary if the amendment of a clerical error would bring the specification within the mischief of sub-sect. 8. Except in such a case a clerical error in a specification can be corrected under this section, or under sect. 91 (*a*), and the Patents Rules, 1883, r. 18 (see Second Schedule, Form P, *post*).

In *Dixon's Patent* (*n*), the order for correction was only made on the undertaking of the petitioner not to sue any person in respect of infringements committed previously to the date of the order. But this undertaking was not required in the subsequent case of *Re Johnson's Patent* (*o*).

As to amendment of errors in patents or specifications, see the cases collected in 1 Webst., p. 647, in a note to *Re Sharp's Patent*, and "Hindmarch on Patents," c. viii, s. 3. In all cases notice of the correction was required to be given to the Commissioner of Patents (*p*).

From a case of *Re Pullan's Patent* (*q*), it seems that drawings omitted by inadvertence could not be added to a specification, and it may be a question whether the words of the present section are wide enough to include such an amendment.

In *Re Blamond's Patent* (*r*) an application to amend a clerical error was refused on the ground of delay.

(2.)

This and the following two sub-sections relate to opposed applications; unopposed cases are dealt with in sub-sects. 5, 6, and 7.

"*Any person.*" It does not appear that the applicant for leave to amend can object before the comptroller that the opposer is not a person entitled to be heard in opposition. This objection can apparently be only taken on appeal before the law officer under sub-sect. 4.

(3.)

Under the Act of 1835 there was no appeal on the question of leave to file a disclaimer (*s*). Under this sub-section either party may appeal

(*i*) *Foxwell* v. *Bostock*, 4 D. F. J. 298, 306

(*k*) *Per* Lord Westbury, C., *Ralston* v. *Smith*, 11 H. L. C. 245.

(*l*) *Thomas* v. *Welch*, L. R. 1 C. P. 192, 195.

(*m*) *Johnson's Patent*, L. R. 5 Ch. D. 503; *Sharp's Patent*, 1 Webst. 641, and cases cited in the notes to that case.

(*n*) Eng. Rep. Jan. to Mar 1881, xvi.

(*o*) Eng. Rep. Ap. to June, 1881, xiii.

(*p*) *Re Dixon's Patent*; *Re Johnson's Patent*, *ubi sup.*; see also *Sharp's Patent*, 1 Webst. 649.

(*q*) Reported Johnson's "Patentees' Manual," 4th ed. p. 103.

(*r*) 3 L. T. (N. S.) 800.

(*s*) *Medlock's Patent*; Johnson's "Patentees' Manual," p. 187, 4th ed.

from the comptroller to the law officer. An appeal from the comptroller in unopposed cases is given by sub-sect. 6. There is no provision, however, for any appeal from the law officer, and his decision, it would seem, is final.

(4.)

The limitation of opposition in this sub-section is new. See the Act of 1835, sect. 1.

The law officers may now examine witnesses on oath, sect. 38, *post*.

Law officer may now give costs.

There was, under the Act of 1835, no power to give costs in disclaimer cases (*t*), but now, by sect. 38, *post*, the law officer is empowered to order payment of costs.

It does not appear that the comptroller has any power as to costs.

Conditions limiting retrospective effect of amendment.

"*Subject to what conditions, if any.*" Under the Act of 1835 it was provided (sect. 39) that no action should be brought on any letters patent on which a disclaimer had been filed in respect of any infringement prior to the disclaimer, without the leave of the law officer certified on his fiat. Under this section the law officers have been accustomed to impose conditions as to the user by opponents of apparatus in use before the disclaimer. The above provision is not contained in the present Act, but is replaced by sect. 20 (*post*). It appears, however (see note to (9)), that, subject to sects. 19 and 20, amendments will have a retrospective effect. The power of the law officer or of the comptroller to impose conditions on the allowance of amendments is, however, not limited by the Act, and it may therefore be useful to consider the cases under the old practice as to conditions limiting the right to sue on the amended specifications.

It was said by Sir A. E. Cockburn, A.G., that the cases where the disclaimer should be made retrospective and give the patentee power to proceed against those who have infringed before the disclaimer was filed are the exception and not the rule, and that it lies on the party applying for a certificate giving a disclaimer that retrospective power to make out a case entitling him to that certificate (*u*).

The law officer has also imposed terms preventing a patentee from suing in respect of continued infringements by the use of certain specified machines actually in use before the disclaimer (*x*), and in one case this principle was extended so as to prohibit suits in respect of new infringements committed by particular persons by the continued use of a process employed by them at the date of the disclaimer (*y*).

And in *Smith's Patent* (*z*) Sir A. J. E. Cockburn, A.G., said that the

(*t*) *Kynock* v. *National Small Arms Co., Limited*, 37 L. T. (N. S.) 31

(*u*) *Per* Sir A. J. E. Cockburn, A.G., *Lucas' Patent*, Macr. Pat. Cas. 234, 239.

(*x*) *Harrison's Patent*, Macr. Pat. Cas. 31.

(*y*) *Re Medlock's Patent*, Newton's "London Journal," vol. 22 (N. S.) p. 69. See, however, the earlier case of *Lucas' Patent*, cited above, when Sir A. J. E. Cockburn, A.G., said he ought not to impose a condition that the opponent should have a licence to continue his manufacture

(*z*) Macr. Pat. Cas. 232, 234.

undertaking not to sue in respect of past infringements must be general enough to include not only those who appeared and opposed the allowance of the disclaimer, but every one. However, in the same case he refused to prohibit the patentee from suing in respect of infringement after the disclaimer committed by persons who had previously entered into contracts for the supply of the patented article, and who asked that their immunity from suit should extend up to the termination of those contracts.

When the patent has been allowed to remain in its imperfect state for a long time, and manufacturers have embarked large capital in the trade, the law officer has imposed conditions for their protection (*a*).

There are some cases in which it is proper that a disclaimer should be retrospective.

Disclaimers sometimes retrospective.

"It is not right that a person should gain his information from a patentee, and, acting on that information, copy and use his invention. He must not presume upon some defect in the specification and infringe upon the valuable part of the patent" (*b*). And when this appeared to have been done, and the opponent had worked in secret, and had otherwise acted unfairly, the Attorney-General considered it right that the opponent should pay for his past infringement, and imposed on him the payment of a definite sum as a condition of the patentee not being alowed to bring an action for infringements prior to the disclaimer (*c*).

(8.)

Amended specification not to claim invention larger than or different from that in original specification.

"*Substantially larger than*," &c. These words, it will be observed, are considerably wider than the corresponding words of the Act of 1835, but under that Act it was held that a patentee could not by disclaimer convert a bad specification, in the sense of its containing no description of any useful invention at all, into a good specification by adding words that would convert "a barren and unprofitable generality" into a specific and definite and practical description. Nor, when the original description was wholly bad, and contained no new invention, could it be converted into a description containing a good invention, nor could the patentee by disclaimer make material additions to the original specification, so as by the aid of the corrected form of words, and the additions so made, to introduce into the specification an accurate and perfect description of an invention which was sought for in vain in the original specification (*d*).

Thus, where a patentee of improvements in embossing fabrics claimed the use of grooved, fluted, or indented rollers of metal, wood, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing action on the fabric, and

(*a*) *Tranter's Patent; Jones' Patent*, reported Johnson's "Patentees' Manual," 4th ed. p. 182.

(*b*) *Per* Sir A. J. E. Cockburn, A.G., *Lucas' Patent*, Macr. Pat. Cas. 238.

(*c*) *Lucas' Patent*, *ubi sup.*

(*d*) *Per* Lord Westbury, C., *Ralston v. Smith*, 11 H. L. C. 243, 244.

thereby produce an indefinite variety of pattern, and afterwards disclaimed the use of any pattern rollers except metal rollers with circular grooves, and it appeared that only circular grooves would produce the effect required, and further that the making the roller and bowl revolve at different speeds was not new, it was held that the disclaimer extended the exclusive right granted by the patent, and that the patent was therefore bad. These rollers not being specifically described in the original specification, but merely involved in the general terms used, the patentee had not sufficiently described his invention, and therefore when by disclaimer he confined his claim to circular grooved rollers as his sole invention, though in one sense he might be said to narrow a right, yet he really extended it, because he thereby described his invention sufficiently to enable him to assert a right which he never could have successfully maintained upon the original specification alone (*e*).

But when a specification of a patent for an improvement in machinery for roving cotton described a particular method of the application of centrifugal force, and claimed the "application of the law or principle of centrifugal force to the particular or special purpose above set forth," and by a disclaimer he declared that he intended to claim only the application of centrifugal force in the manner described in the specification, the specification thus amended was held good (*f*).

So under a patent for "improvements in instruments used for writing and marking, and in the construction of inkstands," a patentee disclaimed four out of eleven parts of his invention, the parts disclaimed relating to pens and to instruments used for marking with a stamp, the parts which remained untouched by the disclaimer being for improvements relating to penholders, pencil-cases, and in the construction of inkstands, it was held that the specification as amended satisfied the title of the letters patent and that the patent was good (*g*).

Claiming clauses might formerly be struck out on disclaimer.

And all the claiming clauses might be struck out of the specification if there remained in the body of the specification words sufficiently distinguishing what invention the patentee claimed (*h*).

(But it would seem that, having regard to sect. 5, sub-sect. 5, of the present Act, this could not be done now.)

Jurisdiction of Master of the Rolls as Keeper of Records.

In *Re Sharp's Patent* (*i*) it was held that the Master of the Rolls had no authority as Keeper of the Records to remove from the records of the Court of Chancery a memorandum of alteration which had been enrolled, the application being grounded on an allegation that the memorandum of alteration extended the exclusive right granted by the patent.

But when a disclaimer was filed without the consent of the patentee, it was held that the Master of the Rolls, as Keeper of the Records, had jurisdiction on the motion of the patentee, without bill filed, to take it off the file (*k*).

(*e*) *Ralston* v. *Smith*, 11 H. L. C. 223, 254; and see *Lucas' Patent*, Macr. P. C. 235, 236.

(*f*) *Seed* v. *Higgins*, 8 H. L. C. 550.

(*g*) *R.* v. *Mill*, 10 C. B. 379.

(*h*) *Thomas* v. *Welch*, L. R. 1 C. P. 192.

(*i*) 1 Webst. 641.

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

The effect of a disclaimer is merely to strike out from the specification those parts of the machinery which are disclaimed. It cannot operate by way of a claim of the residue, nor can what remains of the specification be construed by the disclaimer (*l*). Effect of disclaimer.

The reasons for the disclaimer form no part of the specification as amended by it, and ought not to be referred to in construing such amended specification (*m*).

The mere fact of entering a disclaimer as to part of a specification does not necessarily import that the patent is bad (*n*).

(9.)

A re-enactment of part of sect. 39 of the Act of 1852.

Under the Act of 1835 it was doubted whether, when the disclaimer violated the statutory condition, it was not itself void (*o*). There was no express enactment that the disclaimer, if it transgresses the statutory limit by extending the exclusive right, shall be void to all intents and purposes, but it was said that it might be proper to hold that the disclaimer is as inoperative for the excess only (*p*). This would appear to apply also to amendments under the present Act.

"*Except in case of fraud.*" Such, for instance, as where leave was given to file a disclaimer on certain conditions which the patentee refused to accept, and the disclaimer was afterwards filed without his consent (*q*).

"*Shall in all Courts and for all purposes,*" *&c.* A re-enactment of the corresponding part of sect. 1 of the Act of 1835. Amendments retrospective.

Under that Act it was held in *Perry* v. *Skinner* that a disclaimer was not retrospective, so as to enable an action to be brought in respect of an infringement committed prior to the disclaimer (*r*). But in *R.* v. *Mill* (*s*) the correctness of the decision in *Perry* v. *Skinner* was doubted, and it was held that the disclaimer was to be considered as part of the original specification as from the date of the letters patent, except in pending actions, an exception expressly made by a proviso in sect. 1. And one ground of the decision was that otherwise the proviso as to pending actions would be inoperative. This present Act does not contain the proviso of sect. 39 of the Act of 1852, mentioned above, nor any restriction on the retrospective effect of amendments, except (10) *post*, and sect. 19 (which deal only with pending actions), and sect. 20. The ground of decision in *R.* v. *Mill*, above mentioned, appears to apply equally to the last-mentioned sections, and it is therefore submitted that the words at the head of this note will receive the construction

(*l*) *Per* Cresswell, J. *Tetley* v. *Easton*, 2 C. B. (N. S.) 730.

(*m*) *Cannington* v. *Nuttall*, L. R. 5 H. L. C. 205, 228.

(*n*) *Per* Tindal, C. J., *Stocker* v. *Warner*, 9 Jur. 136, 138, 1 C. B. 198.

(*o*) *Foxwell* v. *Bostock*, 4 D. F. J. 298.

(*p*) *Foxwell* v. *Bostock*, *ubi sup.*

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

(*r*) 1 Webst. 250; *Stocker* v. *Warner*, 1 C. B. 148.

(*s*) 10 C. B. 379.

given in *R.* v. *Mill* to the corresponding words of the Act of 1835, and that subject to the provisions of sub-sect. 10 and sect. 19, and in the absence of conditions to the contrary imposed by the law officer or comptroller, actions may be brought in respect of infringements committed prior to the amendment.

(10.)

This must be read in connection with sect. 19, *post*, and it is presumed will be construed to mean that the provisions of sect. 18 are not to apply to patents in respect of which legal proceedings are pending, except in cases provided for by the 19th section. Otherwise the 19th section will not work at all, since on a strict construction of sect. 18, subsect. 10, there will be no jurisdiction in the case of such patents to entertain applications for amendment, notwithstanding the party may, under sect. 19, obtain leave to make the application. The difficulty arises from the circumstance that when the Bill was introduced into the House of Commons the 19th section gave power in pending actions for the Court or a Judge to allow the plaintiff to disclaim, and to give the disclaimer in evidence, and the section was altered to its present form in its passage through Parliament. It will be noticed that the marginal note to sect. 19 is incorrect, as also the figure (1) in brackets.

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 (*a*).

(*a*) Patents Rules, 1883, r. 56.

A disclaimer could, under the express terms of the Act of 1835, be received in evidence in an action of *scire facias* commenced before it was filed (*t*), and when after the disclaimer the action failed the prosecutor had to pay all the costs subsequent to the disclaimer (*u*).

But where a disclaimer had been filed after the commencement of a suit for injunction, it was held that the suit could not be continued by amendment of the bill, but a fresh bill must be filed (*v*).

And a patentee having obtained an injunction and then altered his specification by disclaimer, was held not entitled to enforce the injunction (*x*).

Now, however, all pending proceedings, whether for infringement

(*t*) *R.* v. *Mill*, 10 C. B. 379.
(*u*) *R.* v. *Mill*, 11 Bea. 312.
(*v*) *Lister* v. *Leather*, 3 Jur. (N. S.) 435.
(*x*) *Dudgeon* v. *Thomson*, 3 App. Cas. 34.

or for revocation of the patent (*post*, sect. 26) will be governed by this and the preceding section (see note to sect. 10), and in a proper case it is presumed the Court may order the amendment, when made, to be given in evidence.

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.

This provision is new. It will probably render it unnecessary on allowance of an amendment of a clerical error in a specification, to require the condition imposed in *Diron's Patent* (*y*). It does not appear to limit in any way the power of the law officer or the comptroller to impose conditions as to actions in respect of infringements committed before amendment.

Advertisement of amendment.

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

(*a*) Patents Rules, 1883, *post*, r. 56.

Compulsory Licences (*a*).

Power for Board to order grant of licences.

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 licences 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 licences on such terms as to the amount of royalties, security for 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.

(*a*) See notes under Patents Rules, 1883, *post*, rr. 58–64.

(*y*) Eng. Rep. Jan. to Mar. 1881, xvi.

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 licences 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, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

(*a*) Patents Rules, 1883, *post*, rr. 64–76.

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

The Act of 1852 provided (sect. 34) for a Register of Patents, and (sect. 35) for a Register of Proprietors. Under the present Act there will be no separate Register of Proprietors, but all the matters included in that Register will be entered on the Register of Patents.

Under the Act of 1852 it was held that the Register of Proprietors was to contain not merely a register of documents, but any other fact which the Court or the Commissioners might think it desirable should be entered on the Register (*z*).

It was not the practice of the Patent Office to enter on the Register of Proprietors documents affecting provisional protections only (*a*), and it is presumed this rule will still prevail, since this and the other sections of the present Act refer in terms to "patents," that is, by sect. 46, "letters patent."

The office would register deeds of trust (*b*), but now this will not be done (sect. 85).

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

(*z*) *Re Morey's Patent*, 25 Bea. 583.

(*a*) Johnson's "Patentees' Manual," 4th ed. p. 221.

(*b*) Ibid.

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*) Patents Rules, 1883, rr. 42–45. See *post*, under sect. 45.

Extension of Term of Patent.

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

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

(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 (*a*).

(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.

(*a*) No Rules have been made under the present Act. The old Rules are therefore in force (see Judicial Committee Rules, *post*).

The powers of the Judicial Committee to grant extensions were conferred by the repealed Acts 5 & 6 Wm. 4, c. 83, s. 4, and 2 & 3 Vict. c. 67.

By the first of these Acts (sect. 3) power was also given to the Judicial Committee to confirm letters patent in certain cases where the patentee, though a real inventor, was not the first inventor. The jurisdiction has been very little exercised, and is not re-enacted in the present Act.

The Judicial Committee may now call in an assessor in extension cases (see sect. 28 (2) *post*).

(1.)

Application by assignees.

"*Patentee.*" This word (sect. 46) includes the person for the time being entitled to the benefit of a patent. An assignee can, therefore, as he could under the old Acts (*c*), obtain an extension. But an assignee has not been viewed with the same favour as the original patentee (*d*), and applications by assignees when no benefit could come to the patentee have been refused (*e*). Moreover, conditions for the benefit of the patentee have, where extension has been granted to assignees, been inserted in the new letters patent (*f*), and when a petition was presented by a patentee and his mortgagees extension has been granted to the patentee alone (*g*).

But extension may be granted to an assignee without any such conditions as above, if the patentee has ceased to have any connection with the working of the patent (*h*), or has received a large sum from the assignee (*i*).

(*c*) 5 & 6 Wm. 4, c. 83; 7 & 8 Vict. c 69; *Russell* v. *Ledsam*, 14 M. & W. 588, affirmed 1 H. L. C. 687.

(*d*) *Norton's Patent*, 1 Moo. P C. (N. S.) 3 9; *Claridg's Patent*, 7 Moo R. C. 394; *Normand's Patent*, L. R 3 P. C. 193.

(*e*) *Norton's Patent*, *ubi sup.*; *Pitman's Patent*, L. R. 4 P. C. 87.

(*f*) See *post*, p. 41.

(*g*) *Borill's Patent*, 1 Moo. P. C. (N. S.) 348.

(*h*) *Napier's Patent*, 13 Moo. P. C. 543.

(*i*) *Bodmer's Patent*, 6 Moo. P.C. 469.

An agreement by a patentee to grant an exclusive licence to a company, and to obtain an extension of the patent, was held to be against public policy, and an application for extension by the patentee was refused (*j*).

The assignee's title must be strictly proved, whether admitted or not (*k*). An equitable assignee cannot appear as co-petitioner unless his name has been inserted in the advertisements (*l*).

Requisites of petition.

"*Petition.*" Prolongation is a matter of favour and not of right (*m*), and a petitioner seeking the grace and favour of the Crown is bound to strict truth, to *uberrima fides*, in his statements (*n*), and in *Pitman's Patent* (*o*) the Judicial Committee stated that for the future they would invariably act on the principle that a petition which failed to state everything belonging to the patent fairly and fully should therefore be dismissed.

What should be stated.

Among the matters which should be thus stated in the petition were the names and dates of, and material facts affecting, any foreign patents obtained by the English patentee. This was mainly in regard to the 25th section of the Patent Act, 1852 (now repealed and not re-enacted in the present Act, see *post*, under sect. 45), which made the duration of an English patent depend in certain cases on the date of the foreign patent (*p*). But the petitioner is also bound to state in his petition and accounts the remuneration which the patentee has derived from his foreign patents, as well as from his English patent (*q*).

So also where the petition was nominally by one company, but really was for the benefit of another company, to whom the shares in the first company had been transferred, and no statement of this fact appeared in the petition, and the real facts were only brought forward by the Attorney-General, the omission to state the real circumstances was held sufficient ground for refusing the petition (*r*).

Amendment of petition.

In *Hutchinson's Patent* (*s*) a petitioner was allowed to amend his petition, but the rules above stated had not then been expressly laid down. A petitioner, however, who had, in ignorance of their Lordships' rule, omitted in his petition to give the proper information as to his foreign patents, was allowed, on application made before the hearing, to add a supplementary paper giving the necessary information (*t*).

"*Such petition must be presented,*" *&c.* Under the repealed Acts (*u*) the presentation of the petition six months before the expiration of the patent was only required in cases where the petition was not prose-

(*j*) *Cardwell's Patent*, 10 Moo. P. C. C. 488.

(*k*) *Galloway's Patent*, 1 Webst. 725; *Wright's Patent*, 1 Webst. 561.

(*l*) *Noble's Patent*, 7 Moo. P. C. 191.

(*m*) *Adair's Patent*, 6 App. Cas. 178.

(*n*) *Clark's Patent*, L. R. 3 P. C. 421, 426; *Johnson's Patent*, L. R. 4 P. C. 75, 83.

(*o*) L. R. 4 P. C. 86; see also *Adair's Patent*, 6 App. Cas. 178.

(*p*) *Johnson's Patent*, L. R. 4 P. C. 82; *Pitman's Patent*, L. R. 4 P. C. 84; *Adair's Patent*, 6 App. Cas. 178.

(*q*) *Johnson's Patent*; *Adair's Patent*, *ubi sup.*

(*r*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*s*) 14 Moo. P. C. 364.

(*t*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*u*) 5 & 6 Wm. 4, c. 83, s. 4; 2 & 3 Vict. c. 67, s. 2.

cuted with effect during the existence of the patent. The requirement is now general.

Opposition.

"*Any person.*" There is no requirement of interest in the opponent as in the case of opposition to the grant of patents or the amendment of specifications (sect. 11 (3) and sect. 18 (4)) (*x*). See *post*, under (7) "*Costs.*"

"*Caveat.*" The caveat must be entered in the name of the actual opposer, not in that of his agent (*y*).

The statutory provisions as to particulars of objections were held not to apply to proceedings for extension under the old Acts, and opponents who had objected on the ground of want of novelty were allowed to give evidence of instances not mentioned in their objections (*z*). The present Act, like the repealed Acts, contains no provision requiring particulars of objection in extension cases.

(3.)

The Judicial Committee had, under sect. 4 of the Act of 1835, jurisdiction to entertain a petition referred to them by the Crown, seeking to revoke an Order in Council made on their recommendation, on an application by patentees for a prolongation of letters patent, and to recal the warrant for sealing (*a*).

"*By counsel.*" The Judicial Committee will not hear in opposition more than two counsel in the same interest (*b*). The Attorney-General always appears, whether the extension be opposed or not, to watch the case on behalf of the Crown (*c*), and he so far represents the Government and the public generally that a Government Department who had not entered a caveat in time were not allowed, the Attorney-General being present, to enter a caveat and be heard in opposition (*d*). See also Judicial Committee Rules, *post*, under r. IX.

(4.)

The rules laid down by this and the next sub-section do little more than state in express terms the practice which has hitherto been followed by the Judicial Committee in applications for extension under the repealed Acts. "The general object of the statutable jurisdiction of the Committee, in respect to advising an extension of the terms of the letters patent, is the reward of the inventor in cases where there has been extraordinary merit in the invention, but where, from circumstances, he has failed to reap any adequate remuneration for his invention during the currency of the term of the letters patent"(*e*).

Merit of invention.

"*Nature and merits,*" *&c.* It is of course not easy to define the degree of merit which will justify extension of a patent.

(*x*) *Lowe's Patent*, 8 Moo. 1.
(*y*) *Lowe's Patent*, *ubi sup.*
(*z*) *Ball's Patent*, L. R. 4 App. Cas. 171.
(*a*) *In re Schlumberger*, 9 Moo. P. C. 1.
(*b*) *Woodcroft's Patent*, 3 Moo. P. C. 172, n.
(*c*) 1 Webst. 557, n.
(*d*) *Pettit Smith's Patent*, 7 Moo. 133.
(*e*) *Per* Sir J. Colvile, *Pitman's Patent*, L. R. 4 P. C. 87; see also *Honiball's Patent*, 9 Moo. P.C. 393; *Markwick's Patent*, 13 Moo. P. C. 313; *Derosne's Patent*, 2 Webst. 4; *Norton's Patent*, 1 Moo. P. C. (N. S.) 339.

An invention "may have been the successful result of long and patient labour, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident or a fortunate guess; or it may have been very closely led up to by an earlier and, in a true sense, more meritorious but still incomplete experiment. Different degrees of merit must surely be attributed to an inventor under these different circumstances" (*f*).

The smallness of the step made is not to lead to any inference against the merit of the invention (*g*), nor is it any objection that great improvements have been made on the original invention (*h*), nor that the invention is an improvement on a former patent taken out by the patentee in consequence of a communication from abroad (*i*), nor that some alteration has since the patent been made in the actual working of the invention (*k*).

But if the original invention was a failure, there is no ground for extension, although the defect has since been remedied (*l*).

So also where the invention as described in the specification succeeded to a limited extent, but was only rendered a success by improvements introduced from abroad by persons other than the patentee (*m*).

The fact that the patent may tend to fetter the public in the use of known sanitary agents has been considered a reason for refusing extension (*n*).

Utility in relation to merit.

The public utility of the invention is an essential element to be taken into account on the question of extension (*o*).

The utility to be considered is not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit (*p*).

Where the invention has not been brought into use notwithstanding the efforts of the patentee, there is a very strong presumption against its utility (*q*). But this presumption may be rebutted (*r*), as where the subject of the invention has a limited market (*s*) or is an article which would not

(*f*) *Per* Coleridge, J., *Hills' Patent*, 1 Moo. P. C. (N. S.) 265.

(*g*) *Soames' Patent*, 1 Webst. 735; *Derosne's Patent*, 4 Moo. P. C. 418.

(*h*) *Galloway's Patent*, 1 Webst. 727.

(*i*) *Borill's Patent*, 1 Moo. P. C. (N. S.) 348.

(*k*) *Heath's Patent*, 2 Webst. 257.

(*l*) *Bell's Patent*, 2 Webst. 160.

(*m*) *Woodcroft's Patent*, 1 Webst. 740.

(*n*) *McDougal's Patent*, L. R. 2 P. C. 1; *McInnes' Patent*, L. R. 2 P. C. 54.

(*o*) *Woodcroft's Patent*, 2 Webst. 29; *Betts' Patent*, 1 Moo. P. C. (N. S.) 49; *McDougal's Patent*, L. R. 2 P. C. 1.

(*p*) *Saxby's Patent*, L. R. 3 P. C. 294. See also *Betts' Patent*, *ubi sup.*

(*q*) *Allan's Patent*, L. R. 1 P. C. 507; *Simister's Patent*, 1 Webst. 723; *Bakewell's Patent*, 15 Moo. P. C. 385.

(*r*) *Allan's Patent*, L. R. 1 P. C. 507; *Bakewell's Patent*, 15 Moo. P. C. 385; *Hughes' Patent*, 4 App. Cas. 174.

(*s*) *Herbert's Patent*, L. R. 1 P. C. 39; *Ruthven's Patent*, Johnson's "Patentees' Manual," 4th ed., p. 210.

be used by the public generally, as a soldier's knapsack (*t*), or was of such a nature as not to be likely to come into immediate use (*u*), or where the article would not be likely to be remunerative within the ordinary term of a patent (*x*), or was an article which the public viewed with distrust (*y*), or where, from circumstances beyond the control of the patentee, its merits had not been sufficiently appreciated (*z*).

Circumstances in favour of extension.

So also effect will be given in favour of extension to the circumstance that the invention had been violently resisted in the trade (*a*), that litigation had prevented the patentee and his assignees from receiving remuneration (*b*), or that the patentee had been in embarrassed circumstances (*c*).

And in every case where the invention has not been actually used the question is whether the evidence is sufficient to rebut the presumption arising from its non-use that the invention is one of no practical utility, and where there was strong and unanswered evidence of utility an extension was granted, although the invention had not been used in England during the whole term (*d*).

But it is not enough to rebut the presumption of inutility to allege that the invention can only be carried on by a company, and that existing companies would not adopt it (*e*).

Profits of patent to be shown.

"*Profits made by the patentee as such.*" An applicant for prolongation has always been required to produce to the Judicial Committee accounts showing in the clearest manner the *profit and loss* of working the patent (*f*), and the *onus* is upon him of satisfying the Committee, in a manner which admits of no controversy, what has been the amount of remuneration which, in every point of view, the invention has brought to him, and it is his duty to frame his accounts in such a shape as to leave no doubt on this point (*g*).

Necessity of accurate accounts.

For this purpose the patentee should be prepared to give the clearest evidence of everything which has been paid and received on account of the patent, and should keep distinct and separate patent accounts (*h*).

The balance-sheet is to be handed over to the Solicitor for the Treasury before the hearing (*i*).

Profits of licensees to be included.

It must be remembered that the question is not what the patentee

(*t*) *Berrington's Case*, cited in *Hughes' Patent*, 4 App. Cas. 179, and Higgins' "Digest," p. 274.

(*u*) *Southworth's Patent*, 1 Webst. 487.

(*x*) *Jones' Patent*, 1 Webst. 579.

(*y*) *Payne's Patent*, cited Higgins' "Digest," p. 266.

(*z*) *Kollmann's Patent*, 1 Webst. 565.

(*a*) *Roberts' Patent*, 1 Webst. 573; *Stafford's Patent*, 1 Webst. 563.

(*b*) *Pettit Smith's Patent*, 7 Moo. P. C. 133; *Heath's Patent*, 2 Webst. 257.

(*c*) *Wright's Patent*, 1 Webst. 575; *Southworth's Patent*, *ubi sup.*

(*d*) *Hughes' Patent*, 4 App. Cas. 174.

(*e*) *Bakewell's Patent*, 15 Moo. P. C. 385.

(*f*) *Trotman's Patent*, L. R. 1 P. C. 118; *Betts' Patent*, 1 Moo. P C. (N. S.) 49; *Hills' Patent*, 1 Moo. P. C. (N. S.) 258.

(*g*) *Saxby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, L. R. 3 P. C. 421.

(*h*) *Betts' Patent*, 1 Moo. P. C. (N. S.) 61; *Adair's Patent*, 6 App. Cas. 178.

(*i*) *Perkins' Patent*, 2 Webst. 14.

has received, but what has been made, or by proper judgment and application might have been made, by the patent, and therefore the profits made by licensees must appear in the accounts (*k*), and the applicant must also show what are the profits derived from any foreign patents he may have for the invention, as well as the profits from the English patent (*l*), and also the profits from the sale of the patented article for exportation (*m*).

And of foreign patents.

The remuneration from the patent as a whole is to be looked to (*n*).

An allowance may be made in the accounts to a patentee who is a manufacturer for his personal superintendence of the business of the patent (*o*), and a patentee may deduct his personal expenses for the exclusive devotion of his time in bringing the invention into practical operation and public notice (*p*).

Allowances in accounts.

But where the patentee did not manufacture but only granted licences, a charge for expenses in visiting and superintending the licensees' establishments was disallowed (*q*).

An allowance may also be made for the expenses of taking out and defending the patent (*r*) and for experiments (*s*).

But though deductions for law expenses in defending the patent are in general a fair head of deduction, still, if the patentee has compromised actions and given up claims to costs to which he had an apparent title, it is not proper to deduct these expenses in an unexplained lump (*t*).

A foreign patentee residing abroad may also be allowed to deduct moneys paid by him to an agent for the purpose of getting the patented article into use in England (*u*).

Where a patentee had sold his patent for a small sum when it was thought to be of little value, and afterwards bought it back at an increased value, the item was not allowed in the accounts as one of loss (*x*).

Manufacturers' profits to be taken into account.

The Judicial Committee have also required that the profits made by the patentee as manufacturer, although not in a strict point of view profits of the patent, should be taken into consideration on the question of remuneration. It may be that possession of the patent virtually

(*k*) *Trotman's Patent*, L. R. 1 P. C. 156; *Roberts' Patent*, 1 Webst. 123; *Saxby's Patent*, L. R. 3 P. C. 575.

(*l*) *Johnson's Patent*, L. R. 4 P. C. 82 (disapproving of *Poole's Patent*, L. R. 1 P. C. 517); *Adair's Patent*, 6 App. Cas. 178.

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

(*n*) *Perkins' Patent*, 2 Webst. 9.

(*o*) *Perkins' Patent*, 2 Webst. 8, 17; *Roberts' Patent*, 1 Webst. 575.

(*p*) *Carr's Patent*, L. R. 4 P. C. 539; *Newton's Patent*, 14 Moo. P. C. 298; *Hills' Patent*, 1 Moo. P. C. (N. S.) 258, 268.

(*q*) *Trotman's Patent*, L. R. 1 P. C. 125.

(*r*) *Roberts' Patent*, 1 Webst. 575; *Kay's Patent*, 1 Webst. 572; *Galloway's Patent*, 1 Webst. 729; *Betts' Patent*, 1 Moo. P. C. (N. S.) 49.

(*s*) *Kay's Patent*, 1 Webst. 572.

(*t*) *Hills' Patent*, 1 Moo. P. C. (N. S.) 258, 268.

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

(*x*) *Weild's Patent*, L. R. 4 P. C. 89.

secures to the patentee his power of commanding orders as a manufacturer (*y*). In such a case it was held that the two heads of profit could not be severed, and a very considerable sum having been in fact received, an extension was refused (*z*). And this principle was applied to manufacturing profits arising from the manufacture of the materials of which the patented article was made (*a*).

But deductions for these sometimes allowed.

The principle, however, was not to be pushed to an unreasonable extreme (*b*), and in some cases the profits as manufacturer have been deducted in ascertaining the profits of the patent (*c*). But the Committee refused to accept as reasonable, without explanation, an estimate by the patentee that the manufacturing profits were two-thirds of the total profits (*d*).

Practice when accounts imperfect.

The hearing of a petition has been adjourned for the purpose of enabling the petitioner to produce further evidence as to his profits, but this was only as an indulgence (*e*), and would probably not be now allowed (*f*). And where accounts were unsatisfactory, extension was refused even though the Committee considered the invention meritorious, and were not satisfied that the petitioner had been sufficiently remunerated (*g*).

If the accounts are on the face of them unsatisfactory, the Committee will adjudicate on the accounts without reference to the merits of the invention (*h*); but if the accounts are *primâ facie* satisfactory, the petitioner will be allowed to prove the merits without going first into the accounts (*i*).

Opposers have not been allowed production and inspection of the petitioner's accounts prior to the hearing (*k*), but under the Judicial Committee's rules they can obtain copies of the accounts lodged by the petitioner. See Judicial Committee Rules, rr. VII, IX, *post*.

"*All the circumstances of the case.*" It has been considered that it is no objection to an extension that during the existence of the patent an Act of Parliament has been passed which might in effect compel the use of the patented article (*l*).

The applicant must show that he has used his best endeavours to

(*y*) *Saxby's Patent*, L. R. 3 P. C. 295; *Betts' Patent*, 1 Moo. P. C. (N. S.) 49; *Hills' Patent*, 1 Moo. P. C. (N. S.) 258; *Johnson's Patent*, L. R. 4 P. C. 75.

(*z*) *Muntz's Patent*, 2 Webst. 121; see also *Saxby's Patent*, L. R. 3 P. C. 292.

(*a*) *Newton's Patent*, Eng. Rep. Jan. to Mar. 1881, xvi.

(*b*) *Hills' Patent*, 1 Moo. P. C. (N. S.) 258, 270.

(*c*) *Betts' Patent*, 1 Moo. P. C. (N. S.) 49; *Galloway's Patent*, 1 Webst. 729.

(*d*) *Hills' Patent*, *ubi sup.*

(*e*) *Perkins' Patent*, 2 Webst. 17; *Heath's Patent*, *Ibid.* 256.

(*f*) See *Clarke's Patent*, L. R. 3 P. C. 421.

(*g*) *Adair's Patent*, 6 App. Cas. 178.

(*h*) *Saxby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, L. R. 3 P. C. 421; *Weild's Patent*, L. R. 4 P. C. 89.

(*i*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*k*) *Bridson's Patent*, L. R. 7 Moo. P. C. 499.

(*l*) *Foarde's Patent*, 9 Moo. P.C. 376.

introduce his invention (*m*). If he has slumbered on his rights and permitted parties to infringe with impunity (*n*), or if there has been intentional delay on his part in bringing out the invention (*o*), or the proper working the invention has been postponed by reason of disputes between the co-owners of the patent (*p*), extension may be refused. And in any case he must prove that the circumstances have ceased which prevented the invention being lucrative, and that it is really coming into use (*q*).

Imported inventions.

The merit of an importer is less than that of an inventor (*r*), but in a proper case an importer may obtain an extension (*s*).

The circumstances, however, that the invention was imported, and that the owners of the English patent were foreigners, who made the article abroad and sent it over to England for sale, were considered as being against a prolongation (*t*).

The fact that the patentee at a late period of the patent disclaimed part of the invention has been urged, and apparently successfully, against an extension, as, if granted, it would interfere with what others had been doing in reliance on the invalidity of the patent (*u*).

Assignees.

In applications by assignees the Judicial Committee have considered in some respects the expenses incurred by the assignee in bringing the patent into notice, and the merit of the assignee patronizing the patentee, but the general rule is, as was stated by Lord Brougham in *Morgan's Patent* (*v*), that "they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest dammified" (*x*).

An English patent may be renewed though a foreign one taken out by the same inventor for the same invention has been allowed to expire (*y*).

Validity how far considered.

It has never been the practice of the Judicial Committee to decide on the validity of a patent, though they would abstain in any case from prolonging a patent which was manifestly bad (*z*). A *prima facie* case of validity was all that was required, the question being left to the

(*m*) *Honiball's Patent*, 9 Moo. P. C. 393; *Norton's Patent*, 1 Moo. P. C. (N. S.) 339.

(*n*) *Simister's Patent*, 1 Webst. 723.

(*o*) *Norton's Patent*, 1 Moo. P. C. (N. S.) 339.

(*p*) *Patterson's Patent*, 6 Moo. P. C. 469.

(*q*) *Wooderoft's Patent*, 2 Webst. 29.

(*r*) *Soames' Patent*, 1 Webst. 733; *Johnson's Patent* (Wilcox & Gibbs), L. R. 4 P. C. 75; *Bell's Patent*, 2 Webst. 160; *Claridge's Patent*, 7 Moo. P. C. 394.

(*s*) *Berry's Patent*, 7 Moo. P. C. 187; *Claridge's Patent*, *ubi sup.*

(*t*) *Johnson's Patent*, L. R. 4 P. C. 80; *Pitman's Patent*, *Ibid.* 88.

(*u*) *Simister's Patent*, 1 Webst. 723.

(*v*) 1 Webst. 738.

(*x*) *Per* Sir J. Colvile, *Pitman's Patent*, L. R. 4 P. C. 87.

(*y*) *Adair's Patent*, 6 App. Cas. 176.

(*z*) *Hill's Patent*, 1 Moo. P. C. (N. S.) 262; *Saxby's Patent*, L. R. 3 P. C. 294.

determination of the Courts of Law (*a*), and consistently with this view, applications for extension have been entertained while proceedings impeaching the patent were actually pending (*b*).

The Committee have, however, where on the face of the specification it appeared doubtful whether the alleged invention was proper subject-matter of a patent, refused, in the exercise of their discretion, to grant a prolongation (*c*).

(5.)

Remuneration.

"*Inadequately remunerated*," *&c.* On the question whether a patentee has been adequately remunerated, the Judicial Committee will take into consideration, in favour of the patentee, the benefit which has resulted to the public as compared with that which the patentee has received (*d*).

If the invention be meritorious, the facts that no profit has been made (*e*), or that from want of capital and means the inventor has not obtained an adequate return (*f*), or that a loss has resulted to the petitioner (*g*), or that the remuneration is insufficient having regard to the expense incurred (*h*), are grounds for extension, subject, of course, to the limitations above mentioned, that the want of profit has not arisen from the non-utility of the invention or the default of the owner of the patent (*i*). But extension was refused to an assignee who had purchased the petitioner's stock-in-trade at a fair value and had not lost by the transaction (*k*).

If the remuneration is adequate, it is no ground for extension that it was made only during the last few years of the patent (*l*).

Term of extension.

"*Extend the term of the patent*," *&c.* Where a loss had been incurred by the patentee, and there appeared to be no reasonable chance of that loss being counteracted by profit unless seven years' extension were granted, the patent was extended for that term (*m*). So also where pending litigation would be likely to prevent the parties availing themselves of the extension (*n*).

A detailed statement of several cases of application for prolongation, showing in each instance the remuneration made and the term of extension granted, will be found in Johnson's "Patentees' Manual," 4th edition, pp. 205 to 211, from which it will appear that the usual prac-

(*a*) *Kay's Patent*, 1 Webst. 568.

(*b*) *Kay's Patent*, *ubi sup.*; *Heath's Patent*, 2 Webst. 257.

(*c*) *McDougal's Patent*, L. R. 2 P. C. 1; *McInnes' Patent*, L. R. 2 P. C. 54.

(*d*) *Derosne's Patent*, 2 Webst. 4; *Newton's Patent*, 14 Moo. P. C. 156.

(*e*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*f*) *Daunton's Patent*, 1 Webst. 567.

(*g*) *Swaine's Patent*, 1 Webst. 560; *Stafford's Patent*, 1 Webst. 564; *Jones' Patent*, 1 Webst. 579; *Napier's Patent*, 6 App. Cas. 174; *Morton's Patent*, Eng. Rep. Apr. to June 1881, vii.

(*h*) *Martin's Patent*, Eng. Rep. Jan. to Mar. 1881, xiii; *Bate's Patent*, 1 Webst. 739.

(*i*) *Ante*, p. 35.

(*k*) *Quarrill's Patent*, 1 Webst. 740.

(*l*) *Ryder's Patent*, cited Johnson's "Patentees' Manual," 4th ed., p. 210.

(*m*) *Jones' Patent*, 1 Webst. 579.

(*n*) *Heath's Patent*, 2 Webst. 257.

tice of the Judicial Committee has been to grant extensions only for periods of less than seven years, and that in one case only has this limit been exceeded, viz., in *Ruthven's* patent for water-propellers, when an extension for ten years was granted.

It is not a matter of course that a patent should be extended, even though the Attorney-General offers no objection, and the application is otherwise unopposed (*o*). See *post*, under Judicial Committee Rules, r. IX.

New patent.

"*Grant of a new patent.*" Under the Act of 1835 it was held that renewed letters patent were not void if granted after the expiration of the term if the preliminary steps required by the 4th section of that Act were taken before the term ended (*p*), and this seems to be still the law if the provisions of sub-sect. (1) are complied with.

The new letters patent must be granted to parties having a legal interest in the existing letters patent (*q*), as the administrator of a deceased patentee (*r*) or the executors of a surviving assignee (*s*), or to trustees of a Company (*t*), or to the patentee being the agent for the foreign inventor (*u*).

Where an annuity to the patentee is part of the terms of the extension, the new letters patent may recite the conditions and contain a proviso avoiding the same if the annuity be not paid (*x*), or the letters patent may be withheld until the petitioner has executed a proper annuity deed (*y*).

Conditions in favour of inventor.

"*Restrictions, conditions, and provisions.*" It has been the practice of the Judicial Committee, in cases of applications by assignees for prolongation, to impose conditions in favour of the original inventor (*z*) or his representatives (*a*). Thus the assignee has been required to secure to the inventor an annuity (*b*) or a share of the profits (*c*).

Or persons dealing with him.

On the other hand, conditions have been imposed on a patentee in favour of persons who have acquired interests in the patent from him (*d*), or who might be prejudiced by the delay of the patentee in getting the new patent sealed (*e*).

But such conditions were only imposed when the patentee had made

(*o*) *Cardwell's Patent*, 10 Moo. P. C. 490.

(*p*) *Russell* v. *Ledsam*, 14 M. & W. 575.

(*q*) *Southworth's Patent*, 1 Webst. 488.

(*r*) *Heath's Patent*, 2 Webst. 247; *Downton's Patent*, 1 Webst. 565.

(*s*) *Bodmer's Patent*, 6 Moo. P. C. 469.

(*t*) *Pettit Smith's Patent*, 7 Moo. P. C. 133.

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

(*x*) *Whitehouse's Patent*, 1 Webst. 476, note (*h*); see also *Ibid.* 723.

(*y*) *Morton's Patent*, Eng. Rep., Apr. to June 1881, vii.

(*z*) *Pitman's Patent*, L. R. 4 P. C. 87.

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

(*b*) *Whitehouse's Patent*, 1 Webst. 473 (reported as *Russell's Patent*, 2 Moo. P. C. 496); *Markwick's Patent*, 13 Moo. P. C. 310; *Russell* v. *Ledsam*, 14 M. & W. 574.

(*c*) *Hardy's Patent*, 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep. Apr. to June 1881, vii.

(*d*) *Normandy's Patent*, 9 Moo. P. C. 452. See also *Baxter's Patent*, 3 Jur. 593.

(*e*) *Schlumberger's Patent*, 8 Moo. P. C. 282.

nothing by his patent, and therefore, where an assignee had given valuable consideration for the assignment and had sustained loss, the extension was granted without conditions (*f*).

Conditions in favour of the public or the Crown.

Conditions on behalf of the public have also been imposed, as that the patentee shall grant licences upon terms similar to one already granted by him (*g*), or shall sell the patented article at a fixed price (*h*), or shall disclaim so much of the specification as relates to parts of the invention not worked out (*i*).

In *Pettit Smith's Patent* (*k*) a condition was inserted requiring the patentee to allow the Crown to use the invention without licence. This condition was refused in *Lancaster's Patent* and *Carpenter's Patent* (*l*), but since the decision in *Dixon* v. *London Small Arms Co.* (*m*) a condition permitting the use of the invention by the Crown and all contractors employed by the Crown has become usual in all cases of inventions likely to be required by Government (*n*).

Two cognate patents with different terms were extended so that both should expire on the same day (*o*).

Prolongation may be granted for part only of the invention (*p*).

The Judicial Committee have no jurisdiction to grant a second extension after one prolongation has been granted (*q*).

(7.)

Costs in extension cases.

"*Costs.*" The Judicial Committee have always considered that it is not desirable to refuse the costs of a fair opposition to applications for prolongation, and that *bonâ fide* opposition should rather be encouraged in order that the Court may be put into possession of all that can be alleged against the continuance of the patent (*r*). The costs of a successful opposition are therefore in general allowed. But when the Committee have not been satisfied with the manner in which the opposition has been conducted, the costs of opposition have been refused (*s*). And where there was no ground for the opposition, the opponents were made to pay the extra costs occasioned thereby (*t*). And when the petition is abandoned, the petitioner will in general have to pay the costs of opposers (*u*). But this rule is not invariable (*x*).

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

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

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

(*i*) *Bodmer's Patent*, 8 Moo. P. C. 282.

(*k*) 7 Moo. 133.

(*l*) 2 Moo. P. C. (N. S.) 189, 191.

(*m*) 1 App. Cas. 632.

(*n*) *Hughes' Patent*, 4 App. Cas. 174; *Napier's Patent*, 6 App. Cas. 174.

(*o*) *Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87.

(*p*) *Napier's Patent*, 6 App. Cas. 174; *Lee's Patent*, 10 Moo. P. C. 226; *Bodmer's Patent*, *ubi sup.*

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

(*r*) *Wield's Patent*, L. R. 4 P. C. 89; *Westrupp and Gibbins' Patent*, 1 Webst. 556; *Honiball's Patent*, 9 Moo. P. C. 394.

(*s*) *Honiball's Patent*, 9 Moo. P. C. 394; see also *Muntz's Patent*, 2 Webst. 122.

(*t*) *Dournton's Patent*, 1 Webst. 567.

(*u*) *Macintosh's Patent*, 1 Webst. 739; *Bridson's Patent*, 7 Moo. P. C. 499; *Hornby's Patent*, 7 Moo. P. C. 503.

(*x*) *Re Mither's Patent*, 9 Moo. P. C. 39.

When there are several opponents the petitioner has been allowed the option of paying a named sum to be divided among the opponents, or of having the costs of all the opponents taxed in the usual way (*y*).

In the case of an abandoned petition there is no need to serve the petitioners with notice of an intended application by the opponents for costs (*z*).

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 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.

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

(*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.

(*y*) *Hill's Patent*, 1 Moo. P. C. (N. S.) 258; *Johnson's Patent*, L. R. 4 P. C. 75; *Wield's Patent*, L. R. 4 P. C. 89; *Milner's Patent*, 9 Moo. P. C. 39; *Jones' Patent*, 9 Moo. P. C. 41.

(*z*) *Bridson's Patent*, 7 Moo. P. C. 499.

(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 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.

(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.

This section must be read in connection with sect. 109, *post*.

Patents for inventions as to which the Secretary of State certifies under sect. 44 (3), *post*, are not revocable. See sect. 44 (9).

"*The Court.*" Having regard to sub-sect. (4) (*a*), (*b*), and to sect. 109, "the Court" would seem to be in England the High Court of Justice in England (sect. 117), in Scotland the Court of Session, and in Ireland the High Court of Justice in Ireland (sect. 111); and since the word "patent" means (sects. 46 and 16) letters patent having effect throughout the United Kingdom and the Isle of Man, it appears that revocation for the whole of the United Kingdom may be obtained in the Courts (defined as above) of any of the three kingdoms.

(3.)

Scire facias to repeal letters patent lay in three cases:—

General rule as to *scire facias*.

1. When the King doth grant by several letters patent one and the self-same thing to several persons, the first patentee shall have a *sci. fa.* to repeal the second (*a*).

2. When the King doth grant a thing upon a false suggestion, he, *prerogativâ regis*, may by *sci. fa.* repeal his own grant.

3. When the King doth grant anything which by law he cannot grant (*b*).

As to the second of these rules the law is thus stated by Parke, B.:—

(*a*) See *R.* v. *Neilson*, 1 Webst. 671, 672.

(*b*) *R.* v. *Mussary*, 1 Webst. P. C. 41; citing 4 Inst. 88.

"That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void not against the Crown merely, but in a suit against a third person—*Travell* v. *Carteret* (*c*), *Alcock* v. *Cooke* (*d*). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson* (*e*), and *Brunton* v. *Hawkes* (*f*); for although the Statute invalidates a patent for want of novelty, and consequently by force of the Statute the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it" (*g*).

False suggestion avoids patent as against third party as well as against Crown.

Avoids patent altogether when one of two inventions old.

A statement of various grounds on which false suggestion avoids a patent will be found in the Index to Mr. Webster's Reports, p. 751, under the title, "False Suggestion."

The grounds on which proceedings might be instituted are stated by Mr. Webster to be "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent" (*h*).

Grounds of *scire facias*.

Thus *scire facias* would lie to repeal a patent when the invention, being a mere application of a known article to a new use, the mode of application not being new, was not the proper subject of a patent (*i*).

So also where the specification was insufficient, for the patent being granted on condition of filing a proper description of the invention, an insufficient specification was not a compliance with the condition (*k*).

Some of the above grounds for *scire facias* at the commencement of this Act were more or less dependent on recitals in the patent (*l*). There is also a distinction "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" (*m*). As the documents on which for the future patents will be granted under this Act, and the form of the patent itself, differ in many particulars from what were in use before this Act, there might have

(*c*) 3 Lev. 134.
(*d*) 5 Bing. 340.
(*e*) 8 Taunt. 375.
(*f*) 4 B. & A. 541.
(*g*) *Morgan* v. *Seaward*, 2 M. & W. 544; 1 Webst. 196.
(*h*) "Webster on the Law and Practice of Letters Patent for Inventions," p. 32.
(*i*) *R.* v. *Cutler*, Macr. P. C. 124.
(*k*) See *R.* v. *Arkwright*, 1 Webst. P. C. 66; *R.* v. *Cutler*, Macr. P. C. 137.
(*l*) See "Hindmarch on Patents," p. 106.
(*m*) 1 Webst. 42, n.

been questions how far such grounds of defence to an action for infringement as were founded on false suggestion are now available, but under this sub-section no such question can, it is submitted, arise.

In addition to the above grounds of defence and revocation there is now that contained in clause (*e*), which appears to be new (*n*).

Practice in *scire facias*.

Two parties could not have a *scire facias* for the same patent (*o*).

Where a patent was originally granted to two persons it was necessary to join both patentees as defendants, even though one had before the issue of the writ assigned all his share to his co-patentee (*p*).

In *R.* v. *Arkwright* (*q*) it was held that a suggestion on a writ of *scire facias* that "the grant is prejudicial and inconvenient to our subjects in general" was too vague, and evidence on this issue was refused. This was before particulars of objection were required.

Where the trial had ended in a verdict for the Crown it was no ground for a new trial that the patentee could bring further evidence on certain points, he not alleging surprise or any new discovery of evidence (*r*).

Under the old practice in *scire facias* the Lord Chancellor had power to stay proceedings, and apparently could order security for costs to be given (*s*), and if the action resulted in favour of the Crown, could order the patent to be restored into Chancery to be cancelled (*t*). There is no provision in the present Act for delivering up the patent in the event of revocation.

The fact of a *scire facias* pending was a ground for refusing a non-suit on an objection to a patent (*u*), and when a plaintiff had obtained a verdict in an action for infringement, and subsequently a *scire facias* was sued out, and a rule obtained to show cause why a non-suit in the action should not be entered, the Court refused to enlarge the time for this rule till after the trial in the *scire facias*; and Sir N. C. Tindal, C.J., said that even if the *scire facias* availed and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objection taken at the trial of the action for infringement (*x*).

(4.)

Action of reduction in Scotland, Lord Advocate's concurrence always required.

There appears to be a limitation on proceedings for revocation in Scotland which does not affect such proceedings in England or Ireland, inasmuch as by sect. 109 it is provided that proceedings in Scotland for revocation 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*

(*n*) See *Re Vincent's Patent*, L. R. 2 Ch. 341.

(*o*) *R.* v. *Neilson*, 1 Webst. 673.

(*p*) *R.* v. *Betts*, 15 Q. B. 540.

(*q*) 1 Webst. P. C. 64, n.

(*r*) *R.* v. *Arkwright*, 1 Webst. 74.

(*s*) *R.* v. *Neilson*, 1 Webst. 672; but see *R.* v. *Prosser*, 14 Bea. 306.

(*t*) *R.* v. *Newton*, "Hindmarch on Patents," p. 427. As to the jurisdiction of the Lord Chancellor after judgment, see *R.* v. *Eastern Archipelago Co.*, 4 D. M. G. 199.

(*u*) *Haworth* v. *Hardcastle*, 1 Webst. P. C. 485.

(*x*) *Ibid.* p. 486.

interest with his concurrence, which concurrence may be given on just cause shown only. On the principle stated by Jessel, M.R., in *Ex parte Stephens* (*y*), "that when there is a special affirmative power given which would not be required because there is a general power, it is always read to import the negative, and that nothing else can be done," it would seem, on comparing the present section with sect. 109 that the letter is to be read as limiting the former, and that in Scotland clauses (*c*), (*d*), and (*e*) are not available unless with the Lord Advocate's concurrence, and that revocation can only be had in the Scotch Courts under the conditions mentioned in sect. 109.

(4.) (*b.*) By sect. 109 the party at whose instance the proceedings are taken in Scotland must have *an interest.*

Attorney-General's fiat required in England.

The words do not occur in this sub-section as limiting the power of the Attorney-General to authorize proceedings, but under the old practice, although in the above case of *R.* v. *Mussory* (*z*) it is stated, on the authority of *Butler's Case* (*a*), that when a patent is granted to the prejudice of a subject, the King of right is to permit him upon his petition to use his name for the repeal of it, it was also said that the subject had not a right *mero motu* to have a *scire facias* (*b*); and the fiat of the Attorney-General was, in fact, necessary in all cases, and was not issued as of course (*c*).

Attorney-General's fiat refused.

In *Re Young's Patent* (*d*) the fiat was refused by Sir R. Bethell, A.G. In this case the patent was for the production of paraffin oil by the distillation of bituminous coal. The application for *scire facias* was made by the owner of a coal-field in Scotland, containing a certain mineral called the Torbane Hill mineral, the right to get which was leased to certain persons who sold to the patentee, by whom it was used in his manufacture. Under the terms of the lease, the applicant had a pecuniary interest in the quantity of the mineral raised. His application was based on allegations that the invention was not new, and that his interests were prejudicially affected by the patent and the use made thereof to interfere with the sale of the Torbane Hill mineral. It appeared also that the applicant had raised in Scotland an action of declaration and reduction (a proceeding analogous to the English *scire facias*) to repeal the patentee's Scotch patent for the same invention. The application was refused on the ground (1) that as a general rule the writ of *scire facias* ought to be used for public purposes only, and not with a view to promote any private end or interest; (2) that the action in Scotland being pending, the proper course was to allow that action to go on, and then to allow, or not allow, proceedings after its determination; and (3) that the patent was eleven years old, and had been the subject of several legal proceedings which had been compromised, and that no evidence of want of novelty was produced, and that

(*y*) 3 Ch. D. 660.
(*z*) 1 Webst. 41.
(*a*) 2 Ventr. 344.
(*b*) *R.* v. *Neilson*, 1 Webst. P. C. 672.
(*c*) 1 Webst. 671, n; *Ibid.* 672; *R.* v. *Prosser*, 14 Bea. 306.
(*d*) "Practical Mechanic's Journal," 2nd series, vol. 6, p. 98.

such a patent ought not to be lightly challenged. And again, in the same patent, on a fresh application for the writ of *scire facias*, made by the same applicants (*e*) after the abandonment of the original Scotch action, but after the institution of a second action for the same purpose which had not been formally, though it was alleged it had been virtually, abandoned, Sir W. Atherton, A.G., refused his fiat (*f*).

The Attorney-General had control over the prosecutor's proceedings, and it seems that he could direct a *nolle prosequi* to be entered as to certain parts of the writ if the prosecutor insisted on retaining them, and he was accustomed to afford similar relief in other cases, though his jurisdiction was exercised principally on the subject of security for costs (*g*).

(4.) (*c*), (*d*), (*e*). In these cases the fiat of the Attorney-General is not required.

"*In fraud of his rights*," such for instance, as in the cases of *Steedman* v. *Marsh* (*h*), *Ex parte Scott and Young* (*i*), *Re Vincent's Patent* (*k*).

(5), (6.)

See notes under sects. 29 (2), (3), (4), (5).

(7.)

A re-enactment of the latter part of sect. 41 of the Act of 1852.

In *scire facias* the burden of proof was on the prosecutor, and it was apparently not enough for him to make out merely a *primâ facie* case against the patentee (*l*).

(8.)

This provision is new.

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.

(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 those 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.

(*e*) *Re Young's Patent*, "Practical Mechanic's Journal," 2nd series, vol. 7, p. 44.

(*f*) See also *R.* v. *Neilson*, 1 Webst. P. C. 673, where it is said that after one party has sued out a *scire facias* another could not do it.

(*g*) *R.* v. *Newall*, 1 Webst. P. C. 671 n.

(*h*) 2 Jur. (N. S.) 391.

(*i*) L. R. 6 Ch. 274.

(*k*) L. R. 2 Ch. 341.

(*l*) See *R.* v. *Cutler*, Macr. P. C. 121, 133, 134.

This section does not apply to patents existing at the commencement of the Act, or granted on applications then pending, see sect. 45 (2). These patents will be subject to the law as laid down in *Feather* v. *The Queen* (*m*), where it was held by the Court of Queen's Bench, contrary to the opinion which formerly prevailed (*n*), that the ordinary form of grant in letters patent does not preclude the Crown from using the invention even without the assent of or compensation made to the patentee. And the patentee, therefore, cannot prevent the use of his invention by a Government Department. But persons contracting to supply the Crown with certain articles of manufacture are not servants of the Crown, doing the work of the Crown, and therefore, when contractors for the supply of rifles to the War Office made such rifles according to a patented invention, but without the licence of the patentee, it was held that they were liable to be sued by the patentee for infringement (*o*).

In future patents, however, *Feather* v. *The Queen* will not apply, and the case of contractors acting for a Government Department will be dealt with under sub-sect. (2).

In cases not within this sub-section, the patentee's remedy is not by petition of right, but by proceeding against the officers of the Crown using the patent (*p*). This also seems to have been the view of Lord Eldon in *Walker* v. *Congreve* (*q*).

Legal Proceedings.

Plaintiff need not apply to defendant before commencing proceedings.

A plaintiff is not bound, before commencing proceedings, to apply to the defendant and ascertain whether he will, without suit, do what is required (*r*); and as a general rule the Court takes no notice of negotiations before suit (save in cases of bad faith), unless they amount to a release or binding agreement with respect to the causes of action (*s*). Nor is a plaintiff compelled to rely on the promise of the offending party not to infringe again, but is entitled to the protection of an injunction (*t*). If, however, this right is exercised oppressively, the plaintiff may lose the costs of the action (*u*).

Limitation as to proceedings for infringement.

No proceedings are to be taken in respect of an infringement committed before the publication of the complete specification (*x*), and if the time for making any of the prescribed payments has been enlarged, the Court may refuse to award damages in respect of any infringement

(*m*) 6 B. & S. 257.

(*n*) *Walker* v. *Congreve*, 1 Carpmael Pat. Cases, 356; mentioned also in "Norman on Patents," p. 181. *In re Pellit Smith's Patent*, 7 Moo. P. C. 133; *In re Lancaster's Patent*, 2 Moo. P. C. C. (N. S.) 189.

(*o*) *Dixon* v. *London Small Arms Co.*, 1 App. Cas. 632.

(*p*) *Feather* v. *The Queen*, 6 B. & S. 257.

(*q*) *Ubi sup.*

(*r*) *Upmann* v. *Elkan*, L. R. 12 Eq. 146; *Burgess* v. *Hills*, 26 Bea. 244, 247; *Burgess* v. *Hately*, 26 Bea. 249; *Upmann* v. *Forrester*, 24 Ch. D. 231.

(*s*) *Edelsten* v. *Edelsten*, 1 D. J. S. 203; *Davenport* v. *Rylands*, L. R. 1 Eq. 305.

(*t*) *Losh* v. *Hague*, 1 Webst. P. C. 201; *Geary* v. *Norton*, 1 De G. & Sm. 9.

(*u*) See *post*, p. 83.

(*x*) Sect. 13, *ante*, p. 16.

committed after the failure to pay, and before the enlargement of the time for payment (*y*).

Several infringements at one time.

A patentee is often placed in serious difficulty when his patent is infringed by several persons at once. If he proceed by separate actions against the several infringers at the same time, he may have to try the validity of his patent in several distinct proceedings, in each of which different objections may be taken, and he will also be liable to the charge of oppressive litigation. On the other hand, if he does not file bills against the general body of infringers till he has established his patent in an action against one of them, there is not only the difficulty that each separate infringer is not bound by the proceedings in that action, and may require the patent to be established afresh against him (*z*), but the patentee, by reason of his laches (*a*), may be unable to obtain the interlocutory injunctions to which, having established his patent in one action, he would be otherwise entitled (*b*).

In such a state of things the course which has been suggested by Lord Hatherley, C. (*c*), is that a patentee in the position referred to should select the case which he thinks best to try the question fairly, and proceed to obtain an interlocutory injunction against that infringer. He should at the same time write to the other persons infringing, who were *in simili casu*, and say to them: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction, and if you will not object on the ground of delay, I do not mean to file bills against all of you at once."

All parties claiming interest should be joined in the action.

All parties claiming an interest in the letters patent, if they do not join as co-plaintiffs, may properly be made, and ought to be made, defendants to the action, in order that the infringing defendants may not be compelled to account twice, first to the plaintiff, and then to the other defendants who claim an interest (*d*). But no cause is to be defeated by reason of the mis-joinder or non-joinder of parties, and the Court may in every cause deal with the matter in controversy, so far as regards the rights and interests of the parties actually before it, and the Court or a Judge may order that the names of any parties improperly joined may be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the Court may be necessary in order to enable the Court effectually and completely to adjudicate upon and settle all the questions involved in the cause, be added (*e*).

Patent vested in trustees.

If the letters patent are vested in trustees for any person, the

(*y*) Sect. 17 (4) (*b*).

(*z*) *Borill* v. *Goodier* (2), L. R. 2 Eq. 195; *Borill* v. *Smith*, W. N. 1867, 340; *Croskill* v. *Tuxford*, 5 L. T. 342.

(*a*) See *post*.

(*b*) *Bovill* v. *Crate*, L. R. 1 Eq. 388.

(*c*) *Borill* v. *Crate*, *ubi sup*.

(*d*) *Westhead* v. *Keene*, 1 Bea. 287, 295; *Bergmann* v. *McMillan*, 17 Ch. D. 423; "Hindmarch on Patents," p. 308.

(*e*) Supreme Court Rules, 1883, Ord. XVI, Rule 11.

trustees may sue alone, but the Court or a Judge may at any stage of the proceedings order any of such persons to be made parties (*f*).

Where simple licences granted patentee can sue alone.

A patentee who has granted simple licences to work the invention may of course sue alone to restrain infringment, without bringing his licensees before the Court, for since the patentee may grant licences to whom he pleases, no injury is done to a licensee by infringement being permitted (*g*).

Right of patentee where exclusive licence granted.

An exclusive licence may sometimes amount to an assignment of the whole interest in a patent, but in general a power of revocation in the event of breach of covenant is reserved to the patentee. In virtue of this dominion over the patent it would seem that a patentee who has granted an exclusive licence may sue to restrain infringement without bringing his licensee before the Court. The injury done by the infringement to the patentee is distinct from that done to the licensee. The latter suffers by the direct competition with his trade, the former by the injury to the reputation of the patent, through infringement being permitted, and the consequent difficulty of restraining such infringement whenever the dominion is resumed, and also (where the exclusive licence is granted in consideration of royalties reserved) by the diminished returns which, from the interference with the licensee's trade, are made to the patentee. It would seem, therefore, that a patentee who has granted an exclusive licence ought to be allowed to sue to restrain infringement without bringing his licensee before the Court. The point has not been actually decided, but it is believed that such a form of action is quite usual.

Assignees *tenants in* common.

Where a patent has been assigned to two persons as tenants in common, there is a joint right of action in the two assignees, and in the event of the death of either it descends to the survivor, who may sue and recover damages for an infringement committed during the joint lives (*h*).

Assignee of distinct and several part of patent.

Where several heads of invention are included in one patent, the assignee of a distinct and severable part of the invention may sue alone for damages for infringement of that part of the patent without joining the persons interested in the other parts (*i*).

In *Walton* v. *Lavater* (*k*), the defendant, the original patentee, assigned a moiety of the patent right to the plaintiff, who ultimately became entitled to the other moiety, and then sued the defendant for infringing the patent. One of the grounds of defence was that the thing granted by the letters patent was one and indivisible, and that under the above-mentioned circumstances the patent right remained in the patentee, though he had no beneficial interest, and that the

(*f*) Supreme Court Rules, 1883, Ord. XVI, Rule 8.

(*g*) See *Newby* v. *Harrison*, before Lord Campbell, cited in *Renard* v. *Levinstein*, 2 H. & M. 628.

(*h*) *Smith* v. *London and North-Western Railway Co.*, 2 E. & B. 69; *s.c.* Macr. P. C. 207.

(*i*) *Dunnicliff and Mallet*, 7 C. B. (N. S.) 209.

(*k*) 8 C. B. (N. S.) 184.

plaintiff, therefore, had no right to sue. But it was held that the assignment of the moiety passed an interest in the patent, and that the plaintiff, having acquired the other moiety, had the whole right in him, and could therefore sustain the action.

This decision, it will be observed, does not decide anything as to the right of the assignee of a share in letters patent for a single invention which is not separable into parts to sue alone, but in *Smith* v. *London and North-Western Railway Co.* (*l*), where the right of the survivor of two persons to whom the patent had been assigned as tenants in common to sue at law for the whole damages was established, the ground of the decision was that if one of the assignees had not died the action must have been brought by both (*m*); and in *Bergmann* v. *McMillan* (*n*) it was held by Fry, J., that when an assignment is made of a share of profits arising from the working of a patent by licences, although the assignee is entitled to an account from the licensee, it must be taken, once for all, in the presence of all the parties interested, otherwise the account might have to be repeated at the instance of each of the other assignees. On the other hand, it was held by Malins, V.C., in *Sheehan* v. *Great Eastern Railway Co.* (*o*), that one of several co-owners of a patent could sue alone without making the other co-owners parties (*p*).

A mere licensee, having a simple licence to work the patented invention, cannot sue alone to restrain infringement, because since the patentee may grant a licence to other persons besides the plaintiff, and therefore to the defendant, the infringement is not an injury to the plaintiff but to the patentee (*q*), and this seems to have been admitted in the case of *Renard* v. *Levinstein* cited below. Nor can a person to whom foreign owners of an English patent, not assigned to him, have given the sole agency and control of the working of the patent in England maintain an action against infringers (*r*).

Actions by exclusive licensee.

But in *Renard* v. *Levinstein* (*s*) it was held that an exclusive licensee may sue alone, at all events if he bring the owner of the patent before the Court as a defendant. In that case a suit to restrain infringement was brought by owners of a patent and persons to whom they had granted an exclusive licence. After the institution of the suit the owners assigned the patent to third parties, and an unsuccessful

(*l*) Macr. P. C. 203.

(*m*) See also remarks of Jessel, M.R., in *Powell* v. *Head*, 12 Ch. D., a copyright case, 686.

(*n*) 17 Ch. D. 427.

(*o*) 16 Ch. D. 59, following the analogy of *Dent* v. *Turpin*, 2 J. & H. 139, a case of two owners of the same trade mark. See also "Lindley on Partnership," 4th ed., p. 68; *Davenport* v. *Richards*, 3 L. T. (N. S.) 503.

(*p*) 17 Ch. D. 427.

(*q*) *Newby* v. *Harrison*, before Lord Campbell, C., cited in the judgment in *Renard* v. *Levinstein*, 2 H. & M. 628. See also *Derome* v. *Fairie*, 1 Webst. P. C. 155, Webster's "Law and Practice of Letters Patent," pp. 24, 30.

(*r*) *Adams* v. *North British Railway Co*, 29 L. T. (N. S.) 367.

(*s*) 2 H. & M. 633.

attempt having been made to add the latter as co-plaintiffs, they were made defendants. It was objected that the plaintiffs had no right to sue, but the objection was overruled by Lord Hatherley, then Vice-Chancellor.

However, in the course of the litigation which followed the establishment of the validity of the rolling skate patent (*t*), where the practice of the patentee was to grant exclusive licences for particular districts in consideration of a lump sum, and an agreement by the licensees to purchase skates from the patentee at a particular price, Jessel, M.R., intimated an opinion that it was the safest course to join the patentee as a co-plaintiff with the licensee in an action to restrain infringement within the licensee's district, and this course was followed in all the actions. See the title to the consolidation order in *Plimpton* v. *Spiller*, Appendix, *post*.

As to the effect of the requirement of registration on the right to sue, see *post*, sect. 87.

Defendants to action for infringement.

The person by whom a patent has been infringed will, of course, be a defendant to the action, but it is not necessary to include as defendants workmen or others by whom the actual infringement is committed. The master is responsible for the acts of his workmen, even though he may have given them general directions not to violate a particular patent (*u*), and the common form of injunction against the master restrains the repetition of the infringement by him, his servants, agents, or workmen (*x*).

But anybody who takes part in a wrong of this description is liable to be restrained from committing the wrong, and therefore an agent infringing a patent, may be made a defendant to the action, and personally and individually be made to pay the costs of it, and it is no justification for him to say that his master ordered him to do it (*y*).

The master of a ship is not a mere agent; he has a possession of a particular nature, and he may be sued as a principal (*z*).

And where there was a patent for the construction of fancy rollers for carding machines by attaching strips of card at intervals to the periphery of the roller, and a cardmaker under a contract to clothe the rollers of a carding-machine made and supplied to a manufacturer cards of the ordinary construction, which were fastened on the rollers by a nailer whose trade was separate and distinct from that of the cardmaker, and who was selected by the manufacturer but paid by the cardmaker, and the cards were so nailed that the rollers when covered infringed the patent, it was held that the nailer was the agent, not of

(*t*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531.

(*u*) *Betts* v. *De Vitre*, L. R. 3 Ch. 442.

(*x*) "Seton on Decrees," 4th ed., p. 352.

(*y*) *Per* Sir W. P. Wood, V.C., *Betts* v. *De Vitre*, 11 Jur. (N.S.) 11; and see Judgment of Cotton, L.J., *Adair* v. *Young*, 12 Ch. D. 19. See also *Betts* v. *Neilson*, 6 N. R. 221.

(*z*) *Adair* v. *Young*, 12 Ch. D. 19.

the manufacturer, but of the cardmaker, and that the latter was properly sued for infringement (*a*).

But persons who being only Custom-house agents for foreign importers, and not themselves the importers of the goods complained of, and having neither possession nor control over the goods, are not liable to be sued as infringers (*b*).

Account against manufacturers no licence to purchasers from him.

An account directed against the manufacturer of a patented article does not license the use of the article in the hands of purchasers from him, and therefore, when a patent is infringed by a manufacturer who sells to others who make use of the article without the licence of the patentee, the latter was entitled to file separate bills against the manufacturer and the user, and might have an account of profits against the manufacturer and damages against the user (*c*).

Distinct infringements by different persons, separate actions necessary.

If there are distinct invasions of a patent by different persons, there must be separate actions against each infringer (*d*); but where one person at one time infringes several patents, there is no occasion for distinct actions upon each patent, the infringement of the various patents may be comprehended in one action (*e*).

Foreigners infringing.

Foreigners are in all cases subject to the laws of the country in which they may happen to be, and if a foreigner while in England infringes a patent, he may be restrained by injunction (*f*). But the Court has no jurisdiction to interfere with the property of a foreign Sovereign, and therefore, when certain shells made in Germany for the Mikado of Japan in infringement of an English patent were brought to this country to be placed on board a ship belonging to the Mikado of Japan, it was held that the Court would not interfere to prevent him removing the shells (*g*).

Company defendant, directors may be personally liable.

A company infringing a patent may, of course, be made defendants to an action, and where the directors actively interfere in the infringement they may be joined as co-defendants, and a decree may be made against them as well as against the company, and they may be ordered personally to pay the costs of the action (*h*).

Threat to infringe sufficient to found action.

A threat to infringe under a claim of right so to do is sufficient to found an action for an injunction, provided, of course, that what is threatened to be done is an infringement; and where a defendant had by his original statement of defence asserted a right and intention to continue the manufacture complained of, and afterwards omitted such

(*a*) *Sykes* v. *Howarth*, 12 Ch. D. 826.

(*b*) *Nobel's Explosive Co.* v. *Jones*, 8 App. Cas. 1.

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

(*d*) *Dilly* v. *Doig*, 2 Ves. 487.

(*e*) See the decree in *Lister* v. *Wood*, cited in "Seton on Decrees," 3rd ed., p. 909.

(*f*) *Caldwell* v. *Van Vlissengen*, 9 Ha. 415, said by Turner, L.J. (3 D. J. S. 87, 11 Jur. (N. S.) 680), to have been affirmed on appeal.

(*g*) *Vavasseur* v. *Krupp*, 9 Ch. D. 352.

(*h*) *Betts* v. *De Vitre*, 11 Jur. (N. S.) 9, affirmed L. R. 3 Ch. 442.

assertion from his amended defence, it was held that the original statement of defence might be used against him as evidence (*i*).

A defendant may be restrained from selling or using machines piratically made during the patent (*k*).

On the question of infringement the patent is assumed to be good (*l*).

Consolidation of actions against different infringers.

Where there are several actions on the same patent against different infringers, they may be consolidated so as to have the validity of the patent, and any other questions common to all the actions, tried once for all in one action (*m*); and by the Supreme Court Rules, 1883, Order XLIX, Rule 8, re-enacting Order LI, Rule 4, of the Judicature Rules, actions are to be consolidated in the manner in use before the Judicature Act in the Superior Courts of Common Law.

At common law actions could only be consolidated at the instance of defendants (*n*), and this is now the rule under the above Order (*o*). Nor could the plaintiff, according to the practice at common law, be bound without his consent by the result of the one action tried, and he might, after a verdict against him in one action, proceed with any of the others (*p*).

The order in *Foxwell* v. *Webster* was binding upon the plaintiff as well as the defendants (*q*), but it would appear from the Report (*r*) that the order was the subject of arrangement; and now that the practice at common law is to be followed in these cases, it would seem that the order for consolidation should, if made adversely, be framed so as only to bind the defendants (*s*).

At common law it was held that the consolidation order could be made as soon as the defendants had appeared, and before declaration (*t*), but in *Foxwell* v. *Webster*, on an application by defendants for consolidation, it was held that no consolidation order could be made until the defendants had given discovery by answer (*u*), and on appeal it was, at the suggestion of Lord Westbury, C., arranged that the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every combination of machine made, sold, or used by them, and whence obtained and when used, and undertaking to pay plaintiff royalty in case plaintiff should succeed; the defendants also to furnish verified models of every machine made. On these terms the application was to stand over, no proceedings to be taken in the meantime; but his Lordship remarked that in so

(*i*) *Frearson* v. *Loe*, 9 Ch. D. 66.

(*k*) *Crossley* v. *Beverley*, 1 Webst. 119; *Crossley* v. *Derby Gas Light Co.*, *ibid.*

(*l*) *Muntz* v. *Foster*, 2 Webst. P. C. 99.

(*m*) *Foxwell* v. *Webster*, 4 D. J. S. 77.

(*n*) "Lush's Practice," 3rd ed., p. 965.

(*o*) *Amos* v. *Chadwick*, 4 Ch. D. 869.

(*p*) "Lush's Practice," cited above.

(*q*) See the order in "Seton on Decrees," 4th ed., p. 347.

(*r*) 4 D. J. S. 83.

(*s*) See the orders in *Bovill* v. *Ainscough*, *Plimpton* v. *Spiller*, and *Johnasson* v. *Palgrave*, in the Appendix, *post*.

(*t*) "Lush's Practice," 965, 3rd ed.

(*u*) *Foxwell* v. *Webster*, 2 Dr. & Sm. 250.

restraining the plaintiff he was greatly stretching the power of the Court (*x*).

Where, by a consolidation order, the defendants in several actions, who all appeared by the same attorneys, bound themselves to abide by the result of a trial in one, and the plaintiff having succeeded in that action, the particular defendant therein neglected to prosecute an appeal, it was held that a defendant in one of the other actions had no equity to be allowed to carry the case to a superior Court (*y*).

But although actions can only be consolidated at the instance of defendants, the Court will, where several actions have been brought by different plaintiffs against the same defendants, make an order upon the application of the plaintiffs enlarging the time for taking the next step in several of the actions, and staying proceedings therein till after one has been tried as a test action (*z*).

If, however, the original test action fails to be a real trial of the issue between the plaintiffs and the defendants, the Court may substitute another of the actions as the test action (*a*).

In addition to the remedies by injunction and account of profits or damages (see sect. 30), the Court may, on making a final decree in favour of a patentee, direct an inquiry as to what articles made in infringement of the patent are in the possession of the defendant, and may order such articles to be destroyed in the presence of the plaintiff (*b*). But if the several parts of the machine may be innocently used for other purposes, it would seem that the proper course is not to order the destruction of the machines, but to order them to be marked so as to prevent the various parts from being afterwards used so as to continue the infringement (*c*).

Instead of ordering the destruction or marking of the articles made in infringement of the patent, they may be ordered to be delivered up to the plaintiff (*d*), or the Court may make an order in the alternative for delivery up or destruction of the articles complained of (*e*).

Hearing with assessor.

28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and

(*x*) *Foxwell* v. *Webster*, 4 D. J. S. 82. See the order in *Bovill* v. *Ainscough* in the Appendix, *post*.

(*y*) *Thomas* v. *Winter*, 17 L. T. (N. S.) 148.

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

(*a*) *Amos* v. *Chadwick*, 9 Ch. D. 459. The order in *Plimpton* v. *Spiller* (see Appendix) provides for this event. See also the order in *Bennett* v. *Lord Bury*, 5 C. P. D. 310.

(*b*) *Betts* v. *De Vitre*, 34 L. J. Ch. 289, 291; *s.c.* 11 Jur. (N. S.) 9, 217; "Seton on Decrees," 4th ed., p. 354; *Emperor of Austria* v. *Day*, 3 D. F. J. 217.

(*c*) *Needham* v. *Oxley*, 8 L. T. (N. S.) 604; "Pemberton on Judgments," 3rd ed., p. 236.

(*d*) *Tangye* v. *Stott*, 14 W. R. 386; *Young* v. *Fernie*, "Pemberton on Judgments," 3rd ed., p. 236.

(*e*) *Plimpton* v. *Malcolmson*, "Seton on Decrees," 4th ed., p. 354; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 176.

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.

(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 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.

This section removes the difficulty raised by the case of *Sugg* v. *Silber* (*f*), when a trial with assesors was refused, and it was held that there was no power under the Judicature Rules in a patent action brought in the Common Law Division to deprive the defendant of his right to a jury. In the Chancery Division an adverse order might be made for trial without a jury, since a patent action was before the Judicature Acts an action which, "without any consent of parties could be tried without a jury" (*g*). (See Order XXXVI, Rule 26, of the Judicature Rules, re-enacted in Order XXXVI, Rule 4, of the Supreme Court Rules, 1883.) The section, it will be observed, relates only to the trial of the action.

By Lord Cairns' Act (*h*) the Court of Chancery was empowered to order questions of fact to be tried by a jury before the Court itself, or before the Court itself without a jury; and by Sir John Rolt's Act (*i*) the Court of Chancery was required to determine every question of law or fact arising in the cause on the determination of which the plaintiff's title to relief depended. Issues.

Under these Acts the practice arose in the Court of Chancery of directing in patent cases the trial of certain issues involving the validity of the patent and the question of infringement, and these issues were tried sometimes before a Judge without a jury, and sometimes before a Judge with a jury. These Acts are now repealed (*k*),

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

(*g*) *Patent Marine Inventions Co*, v. *Chadburn*, L. R. 16 Eq. 447. See also *Swindell* v. *Birmingham Syndicate*, 3 Ch. D. 127; *Back* v. *Hay*, 5 Ch. D. 235; *Bordier* v. *Burrell*, 5 Ch. D. 515; cases under the Judicature Rules.

(*h*) 21 & 22 Vict. c. 27.

(*i*) 25 & 26 Vict. c. 42.

(*k*) 46 & 47 Vict. c. 49.

out by the 57th section of the Judicature Act, 1873, the Court may, in any cause or matter requiring scientific investigation, which cannot, in the opinion of the Court or a Judge, be conveniently made before a jury, or conducted by the Court through its ordinary officers (and a patent action has been held to be an action requiring scientific investigation within the meaning of this section) (*l*), order any question or issue of fact to be tried before an official referee; and by Order XXXVI, Rule 5, of the Supreme Court Rules, 1883, the Court or a Judge may order a trial without a jury of any cause, matter, *or issue*, requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in their or his opinion, be conveniently made with a jury. Further, a proviso at the end of Rule 7 (*a*) of the same Order empowers the Court or a Judge at any time to order any cause, matter, *or issue*, to be tried by a Judge with a jury, or by a Judge sitting with assessors, or by an official referee or a special referee with or without assessors. Issues may therefore still be granted in patent actions, but the more usual practice in such actions is not to direct issues, but to bring the action on for trial in the ordinary way.

By Order XXXIII, Rule 1, of the Supreme Court Rules, 1883, when in any cause or matter it appears to the Court or a Judge that the issues of fact in dispute are not sufficiently defined, the parties may be directed to prepare issues, and such issues shall, if the parties differ, be settled by the Court or a Judge. The usual questions of fact which, if issues are directed, are ordered to be tried in an action for infringement of patent, are in substance the following :—

1. Was the patentee the true and first inventor of the invention?
2. Was the invention new?
3. Is the specification sufficient?
4. Has the defendant infringed?

Other issues may, of course, be added, according to the nature of the defence set up (*m*).

The trial of issues may be directed at any stage of the action (*n*).

When questions of fact are referred for trial under sect. 57 of the Judicature Act, 1873, the particular issues need not be specified in the order, but the reference may be in general terms (*o*).

By the Supreme Court Rules, 1883, Order XXXIV, Rule 9, when the parties to a cause or matter are agreed as to the questions of fact to be

(*l*) *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28.

(*m*) For the technical form of the above issues, and for other issues in patent actions, see "Seton on Decrees," 4th ed., p. 347.

(*n*) Supreme Court Rules, 1883, Ord. XXXVI, Rule 7(*a*). See under the old practice *Henderson* v. *Runcorn, &c., Co.*, W. N. 1868, p. 250; 19 L. T. (N. S.) 277; *Arnold* v. *Bradbury*, W. N. 1871, p. 120; L. R. 6 Ch. 706.

(*o*) See the order of Sir H. Hawkins, *Saxby* v. *Gloucester Wagon Co.*, Appendix, *post*. See also *Curtis* v. *Platt*, 11 L. T. (N. S.) 250. See, however, now the forms in Supreme Court Rules, 1883, Appendix K, No. 33.

decided between them, they may, after writ issued and before judgment, by consent and order of the Court or a Judge, proceed to the trial of any such questions of fact without formal pleadings. If this course be adopted in a patent action, it is presumed that the order for trial will direct the delivery of particulars of breaches and notices of objections, as was done under the old practice, when issues were directed by the Court of Chancery under Sir J. Rolt's Act and Lord Cairns' Act (*p*). See *post*, sect. 29.

Sufficiency of specification treated as question of fact.

The question of the sufficiency of the specification is properly treated as a question of fact, for although the construction of all written instruments belongs to the Court alone, the specification of an invention contains generally, if not always, some technical terms, some phrases of art, some description of processes, which require the light to be derived from what are called surrounding circumstances, and these are matters of fact on which evidence may be given (*q*).

Upon an issue as to the sufficiency of the specification, an order has been made that a defendant should be at liberty to dispute the utility of parts of the alleged invention, although he had not raised the general issue as to utility (*r*).

Variance between provisional and complete specification.

The objection that there is a material variance between the provisional and the complete specification may be taken upon the issue that the specification does not completely describe and ascertain the nature of the invention (*s*).

Newness of manufacture and of invention separate issues.

An invention may be a new manufacture within the Statute of Monopolies (*t*), but the patentee may not be the true and first inventor, and the patent may consequently be void, and therefore a defendant may have the question of newness of manufacture tried apart from the question of newness of invention (*u*). But an issue that "the invention is not the subject of letters patent" is not a proper issue (*x*).

Not subject-matter—not proper issue.

Infringement.

An issue as to infringement was not directed by the Court of Chancery unless the infringement was denied by the defendants (*y*), nor was a defendant allowed to add a totally new question of fact not suggested by his answer to the questions of fact already directed to be tried. In such a case it was held that a supplemental answer must be filed (*z*).

Patent actions generally not cases for a jury.

"*Tried without a jury unless the Court otherwise direct.*" In the opinion of eminent Judges, patent cases are not, in general, such as to require the intervention of a jury.

(*p*) See the order in *Davenport* v. *Jepson*, "Seton on Decrees," 4th ed., p. 346; *Bovill* v. *Bird*, W. N. 1867, p. 96.

(*q*) *Hill* v. *Evans*, 4 D. F. J. 288, 293; *Betts* v. *Menzies*, 10 H. L. C.

(*r*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 536.

(*s*) *Penn* v. *Bibby*, L. R. 2 Ch. 127, 130.

(*t*) 21 Jac. 1 c. 3, s. 5.

(*u*) *Spencer* v. *Jack*, 3 D. J. S. 346. See also *Household Co.* v. *Neilson*, 1 Webst. 689.

(*x*) *Penn* v. *Jack*, 14 W. R. 760.

(*y*) *Davenport* v. *Phillips*, 5 N. R. 485.

(*z*) *Morgan* v. *Fuller* (1), L. R. 2 Eq. 296.

Thus, in *Bovill* v. *Hitchcock* (*a*), Lord Cairns, C., expressed an opinion that many patent cases could be disposed of by a Judge much more satisfactorily than by a jury.

And in *Patent Marine Inventions Co.* v. *Chadburn* (*b*), Lord Selborne, C., when refusing an application for a trial by a jury of issues in a patent case, said, "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the Judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence in such cases, is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the Judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a Judge as by any jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the Judge. It very rarely happens, if it ever does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the Judge, the direction of the Judge" (*c*).

Issues to a jury, when granted and when refused.

Before directing an issue to be tried by a jury, the Court must be satisfied by evidence that there is a real question to try (*d*). And in the case of *Henderson* v. *The Runcorn Soap and Alkali Co.* (*e*), Sir Geo. Giffard, V.C., said that he would never grant a trial of issues at the request of a defendant when the motion was opposed by the plaintiffs; and in *Roskell* v. *Whitworth* (*f*), it was held by the same learned Judge, then Lord Justice, that though there was no inflexible rule as to the stage of a cause at which issues would, on the application of a defendant, be directed to be tried by a jury, the Court would require strong proof that the case was one which it could not satisfactorily try if the defendant made the application, not on the occasion of a motion for injunction, or a motion to dissolve an injunction, but by an independent motion at any other time, and especially if it was after the disclosure of the plaintiff's evidence.

Where a patent had been the subject of previous proceedings, and on one occasion a trial had been heard before a jury, and the plaintiffs were nonsuited on the ground of the insufficiency of the specification, but ultimately the Court above held the specification good, and ordered

(*a*) L. R. 3 Ch. 417. See also *Young* v. *Fernie*, 1 D. J. S. 853; *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28; *Dowries* v. *Hughes & Co.*, 69 L. T. 150.

(*b*) L. R. 16 Eq. 447.

(*c*) See also observations of Cockburn, C.J., in *Sugg* v. *Silber*, 1 Q. B. D. 362.

(*d*) *Davenport* v. *Phillips*, 5 N. R. 485.

(*e*) W. N. 1868, p. 250; 19 L. T. (N. S.) 377.

(*f*) L. R. 5 Ch. 459.

the verdict to be entered for the plaintiffs, who then signed judgment and obtained a decree, and on a second occasion, in an action against another defendant, the jury disagreed, and in a subsequent action against the same defendant he did not appear, and a verdict was taken for the plaintiffs, and afterwards a decree was made in their favour, Sir W. P. Wood, V.C., in a suit against a third defendant who desired to contest over again all the points raised in the preceding actions, refused a reference to a jury (*g*).

But in the same case it was held that if there were a really doubtful question at issue, the Court would not decide it for itself if either party desired a jury.

Where in a suit to restrain infringement of a patent the plaintiff opened his case by stating that he should prove certain fraudulent acts on the part of the defendant, and the defendant's counsel stated that these charges were not raised by the pleadings, and asked to have the case tried by a jury, a trial by jury was ordered, and the cause was directed to stand over for that purpose (*h*).

Patent established in previous action, injunction granted, but issue as to novelty to be tried before a jury.

Where a patent had been repeatedly established in previous litigation against other defendants, Lord Romilly, M.R., being satisfied at the hearing of the sufficiency of the specification, the utility of the invention, and the fact of infringement, granted an injunction to restrain the defendant from infringing the patent, but directed an issue as to the novelty of the invention to be tried before a jury (*i*).

The circumstance that, as a matter of fact, a patent case arising in the Court of Chancery was, before Lord Cairns' Act (*k*) and Sir John Rolt's Act (*l*), tried by a jury did not, after the passing of those Acts, enable either party to insist on its then being so tried. The Court of Chancery did not require the legal question to be tried by a jury. "What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment; but these cases were sent to law, not that they might be tried by a jury, but because the Court had no jurisdiction to decide upon legal rights" (*m*).

Under the 2nd section of Sir John Rolt's Act, which empowered the Court to send issues to the assizes whenever it should appear that any question of fact might be more conveniently tried by a jury, it was held that this power was not to be exercised unless the Court was satisfied that the administration of justice in the particular suit would be more conveniently promoted by sending issues to be so tried (*n*).

By the 29th section of the Judicature Act, 1873, any party to any cause or matter involving the trial of a question or issue of fact, or

(*g*) *Davenport* v. *Goldberg*, 2 H. & M. 282.

(*h*) *Tangye* v. *Stott*, 14 W. R. 128.

(*i*) *Bovill* v. *Goodier*, L. R. 2 Eq. 195; and see Supreme Court Rules, 1883, Ord. XXXVI, Rule 8.

(*k*) 21 & 22 Vict. c. 27.

(*l*) 25 & 26 Vict. c. 42.

(*m*) *Per* Lord Cairns, C., L. R. 3 Ch. 419.

(*n*) *Young* v. *Fernie*, 1 D. J. S. 353.

partly of fact and partly of law, may, with the leave of the Judge or Judges to whose Division the cause or matter is assigned, require the question or issues to be tried at the assizes or at the sittings in London or Middlesex. See also Supreme Court Rules, 1883, Order XXXVI, Rule 44.

Trial by jury cannot be had before a Judge of the Chancery Division (*o*).

By Order XXXIV, Rule 2, of the Supreme Court Rules, 1883 (a re-enactment of the Judicature Rules, Order XXXIV, Rule 2), if it appear to the Court or a Judge that there is in any cause or matter a question of law which it would be convenient to have decided before any evidence is given or any question or issue of fact is tried, or before any reference is made to a referee or an arbitrator, the Court or Judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the Court, either by special case or in such manner as the Court or Judge may deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed.

By Order XXXVI, Rule 8, of the same Rules, the Court or a Judge may in any cause or matter at any time, or from time to time, order that different questions of fact arising therein be tried by different modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trial, and in all cases may order that one or more issues of fact may be tried before any other or others.

The first of the two Rules last above stated was said by Jessel, M.R., in *The Republic of Bolivia* v. *The National Bolivian Navigation Co.*, to be intended for cases where the Judge saw his way to the final determination of the action; for example, the question of the sufficiency of the specification in a patent case might be tried without any evidence at all, as where it is alleged that the specification is ambiguous or vague (*p*). But except in such a case as this, or in a case like *Bovill* v. *Goodier*, cited above, it is in general an inconvenient course to try the issues in a patent case separately, and before different Tribunals (*q*).

Court of Appeal will not in general interfere with Court below as to mode of trial.

If the Court below has decided that the case can be satisfactorily tried in any particular mode, the Court of Appeal is exceedingly disinclined to interfere with that decision (*r*).

And where a Judge had, under the 57th section of the Judicature Act, 1873, referred a question of fact in a patent action to the official

(*o*) *Warner* v. *Murdoch*, 4 Ch. D. 750.

(*p*) 24 W. R. 362.

(*q*) See Judgment of Lord Westbury, C., in *Young* v. *Fernie*, 1 D. J. S. 355.

(*r*) *Bovill* v. *Hitchcock*, L. R. 3 Ch. 419; *Williams* v. *Guest*, L. R. 10 Ch. 467; *Brooke* v. *Wigg*, 8 Ch. D. 510, 517; *Ruston* v. *Tobin*, 10 Ch. D. 558; *Wharton* v. *Boffin*, W. N. 1883, p. 97.

referee, the Court of Appeal refused to interfere with his discretion (*s*).

By the 56th section of the Judicature Act, 1873, any question arising in a cause may be referred for inquiry and report to an official or special referee, and the report of any such referee may be adopted wholly or partially by the Court (*t*).

This section was acted on by Pearson, J., in *Badische Anilin und Soda Fabrik* v. *Levinstein* (*u*), where certain experiments were directed to be performed by a special referee for the purpose of advising the Court.

Where issues have been tried, the plaintiff may at once set down a motion for judgment as soon as the issues have been determined; and where some only of the issues have been tried or determined, any party who considers that the result renders the trial or determination of the others unnecessary, or renders it desirable that such trial or determination should be postponed, may apply to the Court for leave to set down the action or motion for judgment without waiting for such trial or determination. And the Court may give such leave upon such terms as may appear just (*x*).

Practice where issues found in favour of plaintiff.

Where issues disposing of the whole question in the suit had been directed, and the cause was in the paper for hearing immediately after the trial of the issues, the Court made a decree in the suit, but directed it not to be drawn up till the time for moving for a new trial has expired (*y*); but if a motion for a new trial was refused, the injunction was at once granted (*z*).

Where an action (other than an action in the Probate, Divorce, and Admiralty Division), or any issue therein, has been tried by a jury, application for a new trial must be made to a Divisional Court of the Queen's Bench Division; where the trial has been without a jury, the application must be by appeal to the Court of Appeal (*a*).

Upon motion for a new trial the Court of Appeal would not consider whether the finding was proper, but merely whether there was sufficient evidence to warrant the verdict (*b*).

And if the motion were grounded on the improper rejection of evidence, the evidence ought to have been formally tendered to the Judge of the Court below, and rejected by him (*c*). And see now Supreme Court Rules, 1883, Order XXXIX, Rules 6, 7, and 8.

Where, after verdict for plaintiff, the Court, on an application for a

(*s*) *Saxby* v. *Gloucester Wagon Co.*, W. N. 1880, p. 28.

(*t*) See now Supreme Court Rules, 1883, Ord. XXXVI, Rule 55.

(*u*) 24 Ch. D. 156.

(*x*) Supreme Court Rules, 1883, Ord. XL, Rules 7, 8.

(*y*) *Macdougall* v. *General Sewage and Manure Co.*, W. N. 1875, 64, following *Fernie* v. *Young*, L. R. 1 H. L. 63, 84.

(*z*) *Tangye* v. *Stott*, 14 W. R. 387.

(*a*) Supreme Court Rules, 1883, Ord. XXXIX, Rule 1; and see *Hunt* v. *City of London Real Property Co.*, 3 Q. B. D. 19.

(*b*) *Penn* v. *Bibby*, L. R. 2 Ch. 127.

(*c*) *Penn* v. *Bibby*, *ubi sup.*

new trial, was of opinion that the plaintiff ought to have been non-suited, a new trial was only granted upon the terms that the costs of the new trial should be costs in the cause if the defendant obtained a verdict finally, but should not be costs in the cause if the plaintiff obtained a verdict (*d*).

On a trial of questions of fact under Lord Cairns' Act, the Court of Appeal had no power to reverse the findings of the Judge on the questions of fact, but could only direct a new trial (*e*). Where, however, the issues raised mixed questions of law and fact, then, if the decision of one of the questions discussed was sufficient to dispose of the case, the Court of Appeal might give a final judgment upon it, and, therefore, when the fact which in the judgment of the Court of Appeal showed the invalidity of the patent was proved and not denied by the patentee, it was held that the Court of Appeal was justified in deciding against the patent, without ordering a new trial (*f*). And now, by the Supreme Court Rules, 1883, Order LVIII, Rule 5, if, upon the hearing of an appeal, it shall appear to the Court of Appeal that a new trial ought to be had, the Court of Appeal may, if it shall think fit, order that the verdict and judgment shall be set aside, and that a new trial shall be had. And by Rule 4 of the same Order very full powers of dealing with the case are given to the Court of Appeal.

Where the issues were settled at the commencement of the trial, then, whether the Judge delivered his finding on the facts and his judgment on the whole case on separate days or at one time, his finding of fact was an interlocutory order which, under the Judicature Rules, Order LVIII, Rule 15 (*g*), could only be appealed within twenty-one days. But if no definite issues of fact were settled at the commencement of the trial, the finding of fact, as well as the judgment on the whole, could be appealed at any time within a year (*h*).

Where, under Lord Cairns' Act, questions of fact were tried before the Judge without a jury, the verdict of the Judge was conclusive, and could only be questioned by application for a new trial, as provided by the Act, and when this course had not been pursued, but the defendants in a patent suit appealed from a decree made against them, founded on a verdict of the Judge on a trial of questions of fact, it was held by the House of Lords that, as the decree merely stated the finding of the Judge, and did not refer to the evidence, the House could not look at the evidence to see if it afforded grounds for the findings or the decree (*i*).

(*d*) *Derosne* v. *Fairie*, 1 Webst. P. C. 160.

(*e*) *Simpson* v. *Holliday*, L. R. 1 H. L. 315.

(*f*) *Simpson* v. *Holliday*, cited above.

(*g*) Re-enacted with variations, Supreme Court Rules, 1883, Ord. LVIII, Rule 15.

(*h*) *Lowe* v. *Lowe*, 10 Ch. D. 432; *Krehl* v. *Burrell*, 10 Ch. D. 420.

(*i*) *Fernie* v. *Young*, L. R. 1 H. L. 63.

Delivery of particulars.

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; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

(1.)

Statement of claim.

"*Statement of claim.*" The plaintiff must state on the face of his statement of claim a sufficient case to justify the injunction asked (*k*).

The grant of the letters patent must be alleged, and if the plaintiff sues by a derivative title, his title must also be stated. It has been usual to allege the novelty of the invention, but this is not necessary, since the allegation of the grant and the production of the letters patent throws upon the defendant the *onus* of disputing the novelty (*l*). Nor has the Court required the plaintiff to allege that the stamp duties necessary for keeping the patent alive have been paid (*m*). It has been, however, usual to allege in general terms that the letters patent are, and since the grant thereof have remained, valid and subsisting, but

(*k*) See *Curtis* v. *Cutts*, 8 L. J. (N. S.) Ch. 184.

(*l*) *Amory* v. *Brown*, L.R. 8 Eq. 664.

(*m*) *Sarazin* v. *Hamel* (No. 1), 32 Bea. 145.

this allegation is not contained in the model form given in the Appendix to the Supreme Court Rules, 1883 (*n*).

There was, at one time, some question whether or not it was necessary to set out the specification in the plaintiff's pleadings, but if the pleadings contained an allegation that the specification duly described and ascertained the nature of the invention, and in what manner the same was to be performed, and that the same had been duly filed (thus showing that the conditions of the letters patent had been complied with), this was sufficient (*o*). It was, however, usual, at all events in bills in Chancery under the old practice, to set out at least so much of the specification as described in general terms the nature of the specification, but since the Judicature Acts this practice has become obsolete, and the model form above mentioned does not in any manner refer to the specification.

The plaintiff must also allege infringement, but in his statement of claim need only allege this in general terms. He must, however, go into detail in the particulars of breaches.

Particulars of breaches.

"*Particulars of breaches.*" The Courts of Common Law had always a general power to protect a defendant in an action for infringement of patent from surprise, by requiring the plaintiff to deliver particulars of the breaches of which he complained (*p*).

Act of 1852.

Particulars of breaches were required by the Act of 1852 (*q*), but were by that Statute only applicable to actions at law. However, under Lord Cairns' Act and Sir John Rolt's Act (*r*) (which enabled the Court of Chancery to try by itself, or with a jury, questions of fact, and required it to try all questions of law arising in a cause), the practice of requiring particulars of breaches and notices of objections was adopted by that Court, at all events when issues were directed (*s*). In *Finnegan* v. *James* (*t*), however, it was held that the practice prescribed by the Statute ought to be followed in all suits in equity as closely as circumstances would admit, and the practice was, since the Judicature Acts, uniformly followed in the Chancery Division, as well as in the other Divisions of the High Court of Justice.

Particulars of breaches adopted in Chancery.

Difference in requirements of particulars of breaches and notices of objections.

There was a difference in the requirements of the Act of 1852 (*u*) as to particulars of breaches and notices of objections, and this difference exists also in the present Act. In the former case it is simply enacted that particulars of breaches shall be given, but there is no enactment on the nature of those particulars, while considerable detail was and is required in the objections.

What detail required in particulars of breaches.

Thus, in *Talbot* v. *La Roche* (*x*), the Court of Common Pleas refused

(*n*) Appendix C, Form No. 6.

(*o*) *Kay* v. *Marshall*, 2 Webst. P. C. 39; *Westhead* v. *Keene*, 1 Bea. 287.

(*p*) *Electric Telegraph Co.* v. *Nott*, 4 C. B. 462; *Perry* v. *Mitchell*, 1 Webst. P. C. 269

(*q*) 15 & 16 Vict. c. 83, s. 41.

(*r*) 21 & 22 Vict. c. 27; 25 & 26 Vict. c. 42.

(*s*) *Curtis* v. *Platt*, 35 L. J. (N. S.) Ch. 853; see *Bovill* v. *Goodier*, L. R. 1 Eq. 35.

(*t*) L. R. 19 Eq. 72.

(*u*) 15 & 16 Vict. c. 83, s. 41.

(*x*) 15 C. B. 310.

to compel a plaintiff in his particulars of breaches to specify particularly the persons with respect to whom, and the occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed. And the Court rested their refusal on the ground that the defendant must know in what respects he had been guilty of infringement. And in an action for infringement a patentee will not be compelled to produce to the defendant a specimen of the patent article (*y*).

Again, in *Needham* v. *Oxley* (*z*) it was held by Lord Hatherley, then V.C., that when the particulars of breaches, taken together with the pleadings, give the defendant fair notice of the case to be made against him, they are sufficient. In that case the plaintiff simply pointed to certain specified machines, and stated in general terms that they infringed the plaintiff's patent, and it was contended, but unsuccessfully, that the plaintiff ought to specify in what respects the defendant's machines were an infringement.

So also in *Batley* v. *Kynock* (No. 2)(*a*), where the thing alleged to be an infringement had been made an exhibit in the cause, is was held that it was not necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. And where a motion for an injunction had been made in the Court of Chancery, the Court of Common Pleas considered that the defendants had sufficient information as to the alleged infringement, and refused to require the plaintiffs to give the particulars asked for (*b*).

But where a specification contained a description of a number of articles, the subject of the invention, a plaintiff has been ordered to point out what part of the specification he alleges to have been infringed.

Thus, in *Perry* v. *Mitchell* (*c*), a case before the Act of 1852, in a suit to restrain infringement of a patent for making pens, thirteen different sorts being mentioned in the specification, the plaintiff was ordered to specify the particular pens in respect of which infringement was alleged. And in *Lamb* v. *The Nottingham Manufacturers' Co.* (*d*), a case since the Act of 1852, a plaintiff was ordered to specify, by reference to pages and lines, the parts of his specification in respect of which the alleged breaches had been committed.

(2), (3.)

Defence to state all the grounds of defence.

"*Statement of defence.*" See notes on sect. 26 (3). A defendant in an action for infringement desiring to dispute the validity of the patent

(*y*) *Crofts* v. *Peach*, 1 Webst. 268.
(*z*) 1 H. & M. 248.
(*a*) L. R. 19 Eq. 229.
(*b*) *Electric Telegraph Co.* v. *Nott*, 4 C. B. 462. This case was, however, before the Patent Law Amendment Act, 1852.
(*c*) 1 Webst. P. C. 269.
(*d*) "Seton on Decrees," 4th ed., p. 349, cited in *Batley* v. *Kynock* (No. 2), L. R. 19 Eq. 229, where it is stated by counsel that there was an admission of infringement, and that there had been an inspection. See also *Jones* v. *Lee*, 25 L. J. (N. S.) Ex. 241.

must state in his pleadings the various grounds of defence relied on, or he will not be allowed to bring them forward at the trial. Thus, in a case in Chancery, where notices of objections had not been ordered, and a defendant, by his answer, denied the validity of the patent on various specified grounds, but did not mention an objection that the patent was for an invention included in an expired French patent, and was therefore void under 15 & 16 Vict. c. 83, s. 25 (*e*), the Court refused at the hearing to allow this objection to be raised (*f*). And a defendant who had, by his answer, disputed the validity of the patent upon certain specified grounds on which issues of fact were directed, was not allowed to add totally new issues of fact not suggested by the answer (*g*).

Form of pleas to raise particular issues.

The following cases have been decided upon the subject of the proper pleas to raise the issues in an action for infringement of patent.

The issue as to novelty of invention is distinct from the issue whether the patentee was the first inventor (*h*).

Invention not new manufacture.

In *Walton* v. *Potter* (*i*) it was held that a plea that the invention was not a new manufacture admitted the invention to be a novelty, and put in issue the novelty (*k*). But in *Bush* v. *Fox* (*l*) it was held by the House of Lords that this plea put in issue both the novelty of the invention and its being a new manufacture; and in *Spencer* v. *Jack* (*m*) the defendant was allowed to have the question of newness of manufacture tried apart from the question of newness of invention.

Under plea of not new manufacture, want of utility cannot be alleged.

Under a plea that the patentee was not the inventor, or that the invention was not a new manufacture, no objection can be taken to the specification (*n*). Nor will a plea that the invention is now a new manufacture allow the defendant to raise the defence of want of utility (*o*).

Plea of no subject-matter.

An objection that the invention is not the proper subject for a patent cannot be taken under a plea denying the novelty of the invention (*p*), or upon a plea denying infringement (*q*).

Proper plea to raise issue of utility.

Questions have been raised as to the proper form of pleading the defence of want of utility of the invention. The requirement of utility does not arise from express words to that effect in the Statute of Monopolies (*r*), but is rather an inference from the enactment in that

(*e*) Repealed, and not re-enacted in the present Act.

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

(*g*) *Morgan* v. *Fuller* (1), L. R. 2 Eq. 296.

(*h*) *Household Co.* v. *Neilson*, 1 Webst. 689.

(*i*) 1 Webst. 601, 611. See also 1 Webst. 598, *Note* (*h*).

(*k*) *Spilsbury* v. *Clough*, 1 Webst. 255.

(*l*) Macr. P. C. 179.

(*m*) 3 D. J. S. 346.

(*n*) *Bateman* v. *Gray*, Macr. P. C. 110.

(*o*) *Walton* v. *Bateman*, 1 Webst. 623.

(*p*) *Walton* v. *Potter*, 1 Webst. 598; *Household Co.* v. *Neilson*, 1 Webst. 677.

(*q*) *Household Co.* v. *Neilson*, 1 Webst. 677.

(*r*) 21 Jac. 1, c. 3, s. 6.

Statute that the monopoly granted must "not be mischievous to the State, or to the hurt of trade, or generally inconvenient" (*s*). And it seems to have been thought that the proper form of plea was to plead the Statute, and not merely the want of utility.

The practice at common law, however, appears to have been to put in a plea denying utility in general terms (*t*), and the practice was followed in the Court of Chancery (*u*).

Insufficiency of specification.

Every patent for a new invention has, at least since the time of Queen Anne, contained a condition making the same void if a specification were not filed within a definite time, or, in case a complete specification had been filed before the grant of the patent, then avoiding the patent if that specification were insufficient. Such a condition was not required by the common law or the Statute of Monopolies, but it was the practice to insert it in patents (*x*), and the practice was expressly recognized in the 10th section of the Act of 1852.

The condition required that the specification should "particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed," words which have been followed in sect. 5 (4) of this present Act.

The form of patent given in the first schedule to the present Act (which, however, is not compulsory (*y*)) contains no condition avoiding the patent if the specification be insufficient. A question may therefore arise whether the old objections to the specification can be still taken by way of defence to an action for infringement. It is to be observed that there is nothing in the Act which makes the examination and approval of the specification under sects. 6, 7, and 9, *ante*, conclusive, either as against the Crown or as between the patentee and third parties; and if the complete specification does not, in fact, particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed, then the statement in the specification (Patents Rules, 1883, Second Schedule, Form C), on the acceptance of which the patent has been granted, is untrue. So also, if the complete specification differs materially from the provisional, the Crown has granted a patent for an invention of which the nature was wrongly stated in the provisional specification (Patents Rules, 1883, Second Schedule, Form B). In either case the Crown has been deceived, and this was a ground for *scire facias* at the commencement of this Act, and by sect. 26 will therefore be available by way of defence to an action for infringement (*z*). See notes under sect. 26.

(*s*) *Morgan* v. *Seward*, 1 Webst. 197.

(*t*) "Hindmarch on Patents," 275, and the cases there cited.

(*u*) *Simpson* v. *Holliday*; *Renard* v. *Levinstein*; *Morgan* v. *Fuller*; "Seton on Decrees," 4th ed., p. 347; *Plimpton* v. *Malcolmson*, 3 Ch. D. 531, 536.

(*x*) See the Schedule to 15 & 16 Vict. c. 83, and "Hindmarch on Patents," p. 151.

(*y*) Sect. 33, *post*.

(*z*) See also Judgment of Buller, J., *R.* v. *Arkwright*, 1 Webst. 66.

Moreover, the new form of patent contains a recital (*a*) that the patentee has, by his complete specification, "particularly described the nature of his invention." If this recital be untrue, no doubt the grant is void (*b*).

But a question may arise whether, if the specification literally complies with the statements in the recital (which it will be observed does not go beyond what is required for the provisional specification), and describes only the nature of the invention, without ascertaining the manner in which it is to be performed, the grant is not still good.

It is submitted that the considerations above mentioned, arising from the recitals in the specification itself, show that the patent is in such a case invalid. On the whole, therefore, it is submitted that the old law as to specifications is still in force, though it may not, in patents in the form given in the First Schedule, rest as formerly on the express words of the patent itself. See also notes under sect. 9 (1), and sect. 26 (3).

Under a plea of the insufficiency of the specification, it has been held that it is not open to contend that the specification is not as large as the title (*c*), nor, apparently, that the patent is for a principle only, and therefore void (*d*), nor that the invention is not the subject-matter of letters patent (*e*).

Under plea of insufficiency of specification, objection of variance between final and provisional specification may be taken.

Upon an issue as to the sufficiency of the specification, it seems to have been doubted (*f*) whether a defendant could prove that the complete specification differed materially from the provisional specification, a fact which, if established, would invalidate the patent (*g*). But in *Penn* v. *Bibby* (*h*), Lord Chelmsford, C., allowed this to be done, and said that the specification did not particularly describe and ascertain the nature of the invention if the complete specification departed from the terms of the title or of the provisional specification, in which the nature of the invention must be described.

Ignorance no defence.

It is no defence to an action for infringement to say that the party charged was not aware of the existence of the patent (*i*), or was not aware that the article complained of was an infringement (*k*), or that the acts complained of were done by workmen employed by the defendant, but contrary to orders (*l*).

(*a*) See Form D, First Schedule.

(*b*) "Hindmarch on Patents," p.48.

(*c*) *Derosne* v. *Fairie*, 1 Webst. 161; *Neilson* v. *Harford*, 1 Webst. 312. See, however, *Penn* v. *Bibby*, L. R. 2 Ch. 127.

(*d*) *Jupe* v. *Pratt*, 1 Webst. 151.

(*e*) *Walton* v. *Potter*, 1 Webst. 598; *Household Co.* v. *Neilson*, 1 Webst. 677.

(*f*) *Morgan* v. *Fuller* (1), L. R. 2 Eq. 297; *Derosne* v. *Fairie*, 1 Webst. 161; *Neilson* v. *Harford*, 1 Webst. 312,

(*g*) *Foxwell* v. *Bostock*, 4 D. J. S. 298; *Bailey* v. *Roberton*, 3 App. Cas. 1055.

(*h*) L. R. 2 Ch. 127, 130.

(*i*) *Wright* v *Hitchcock*, L. R. 5 Ex. 37; *Davenport* v. *Rylands*, L. R. 1 Eq. 303.

(*k*) *Walton* v. *Lavater*, 8 C. B. (N. S.) 162; *Wright* v. *Hitchcock*, L. R. 5 Ex. 37; *Geary* v. *Norton*, 1 De G. & Sm. 9.

(*l*) *Betts* v. *De Vitre*, L. R. 3 Ch. 430.

Nor is the intention of the defendant material if he has, in fact, invaded the rights of the patentee (*m*); and the fact that the defendant did not intend to infringe is no answer to a motion to commit for breach of an injunction which restrained infringement (*n*).

Nor the fact of no intention to infringe.

And where the defendant, who was a dealer only, had bought the article complained of in open market without knowledge of the process of its manufacture, and on the plaintiffs bringing to his knowledge the fact of an infringement, had offered, if the plaintiffs would refrain from taking proceedings, to cease to purchase the article, except from the plaintiffs, and the defendant had complied with his promise, and had sold none of the patent article since that time, except the trifling residue he had in stock, and had since purchased a considerable quantity from the plaintiffs, who had, nevertheless, without further communication, filed their bill, it was held that there was nothing in these circumstances which could operate as accord and satisfaction for the wrong committed by the infringement, and the plaintiffs were held to be entitled to damages (*o*). In this case the patent had expired pending the litigation, and therefore no injunction could be granted.

When defendant infringed in ignorance, injunction not always granted.

But although a plaintiff may have his action against a defendant infringing in ignorance of the patent, it is not a matter of course that he should be entitled in such a case to an injunction; and therefore, where a retailer had unwittingly sold a few articles in infringement of the patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a bill for an injunction was dismissed, and he was left to his remedy in damages (*p*).

Particulars of objections.

"*Particulars of objections.*" By the 4 & 5 Wm. 4, c. 83, s. 5, it was enacted that in an action brought against any person for infringing letters patent, the defendant, on pleading thereto, should give to the plaintiff a notice of any objections on which he meant to rely at the trial of such action, and that no objection should be allowed to be made in behalf of such defendant at such trial unless he proved the objections stated in such notice. This Act (*q*) did not require any more detail in the objections than in the particulars of breaches.

Under Act of 1835

Upon this Statute it was soon decided that the particulars of objections delivered by a defendant were not conclusive at his peril; and that if they were insufficient the Court could compel delivery of fuller and better particulars (*r*).

(*m*) *Heath* v. *Unwin*, 15 Sim. 552, disapproving what had been said in the same case by the Court of Exchequer, 13 M. & W. 583; *Stead* v. *Anderson*, 2 Webst. 156. See also *Seed* v. *Higgins*, 5 Jur. (N. S.) 540, 543; 8 E. & B. 771.

(*n*) *Plimpton* v. *Spiller*, 4 Ch. D. 286, 288.

(*o*) *Davenport* v. *Rylands*, L. R. 1 Eq. 305.

(*p*) *Betts* v. *Willmott*, 18 W. R. 946; *Upmann* v. *Elkan*, L. R. 12 Eq. 145.

(*q*) Sect. 5.

(*r*) *Bulnois* v. *Mackenzie*, 1 Webst. P. C. 260.

And further, that the objections were intended to give more specific information than the pleas (*s*), and that in general a notice of objections in the terms of the pleas would be insufficient (*t*).

Some difference of opinion seems to have prevailed as to the detail which the Court, under the Act of Wm. 4, could require to be given of alleged prior user of the patented invention. In *Bulnois* v. *Mackenzie* (*u*) the Court of Common Pleas considered that they had no power to require the defendant to set out the names and addresses of those who were alleged to have used the invention previously to the patent. A similar view was taken in the cases of *Carpenter* v. *Walker* (*x*), *Heath* v. *Unwin* (*y*), and *R.* v. *Walton* (*z*). In *Jones* v. *Berger* (*a*), however, when the defendant's objections stated that the invention had been previously published by certain named persons in certain specifications, and "also by other persons in other books or writings," it was held that the defendant must specify the books relied on; and in *Galloway* v. *Bleaden* (*b*), the names, addresses, and descriptions of alleged prior users were ordered to be furnished. The question was again considered in *Russell* v. *Ledsam* (*c*), where the Court of Exchequer, upon a review of all the above-mentioned cases, decided that a defendant could not be compelled, in an objection for want of novelty, to state who was the first inventor, or when and in what place and under what circumstances the invention was used before.

Upon an objection that the specification is insufficient, it was held that if the plaintiff was contented to take that as notice, any objection showing insufficiency might be made at the trial (*d*).

And objections that the invention was not properly set forth in the specification (*e*), or that the specification is calculated to deceive (*f*), or that the specification does not sufficiently distinguish between what is new and what is old (*g*), or did not describe the most beneficial method with which the patentee was acquainted of practising his invention (*h*), or did not sufficiently describe the nature of the invention (*i*), or that the invention does not produce the effect stated (*k*), were all held sufficient without going into particulars.

But upon an objection that the invention for which the patent was granted was more extensive than that described in the specification, and

(*s*) *Bulnois* v. *Mackenzie*, *ubi sup.*; *Jones* v. *Berger*, 1 Webst. P. C. 544; and see Judgment of Cresswell, J., in *Walton* v. *Bateman*, 1 Webst. P. C. 616.

(*t*) *Neilson* v. *Harford*, 1 Webst. P. C. 370; *Betts* v. *Walker*, 14 Q B. 363, 368. See also *Walton* v. *Bateman*, 1 Webst. P. C. 268, n.

(*u*) 1 Webst. P. C. 260

(*x*) 1 Webst. P. C. 268, n.

(*y*) 10 M. & W. 684.

(*z*) 2 Q. B 969.

(*a*) 1 Webst. P. C. 544.

(*b*) 1 Webst. P. C. 268, n.

(*c*) 11 M. &. W. 647.

(*d*) *Neilson* v. *Harford*, 1 Webst. P. C. 332.

(*e*) *Heath* v. *Unwin*, 10 M. & W. 687,

(*f*) *Neilson* v. *Harford*, 1 Webst. P. C. 324, n.

(*g*) *Jones* v. *Berger*, 5 M. & G. 208.

(*h*) *Ibid.*; *s.c.* 1 Webst. P. C. 546.

(*i*) *Heath* v. *Unwin*, 1 Webst. P. C. 551, n.

(*k*) *Ibid.*

another objection founded on discrepancy between the drawings and specification, the defendant was required to call the plaintiff's attention to the particular parts (*l*). And where an objection alleged as to certain letters patent, the term of which had been extended by the Judicial Committee of the Privy Council, that such extension had been obtained by fraud, covin, and misrepresentation, the defendant was required to state the species of fraud, covin, and misrepresentation on which he relied (*m*).

Where a defendant in one objection alleged that the patentee had not, by his specification, sufficiently described the invention, and in a second objection that the patentee had not enrolled *any specification* sufficiently describing, &c., this was held not precise enough, and the word "*other*" was ordered to be inserted before the word "specification" in the second objection (*n*).

Particulars of objections under Act of 1852.

The Act of 1852 (*o*) defined the detail as to prior user necessary in particulars of objection, and required such particulars to state "the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent."

Several cases have been decided on this section, and these will probably form a guide to the construction to be placed on the words in the present sub-section, words which, though differing from and perhaps somewhat wider than the corresponding words of the Act of 1852, do not, it is submitted, carry the rules as to particulars of objection further than had been the practice under the latter Act.

Thus, in *Curtis* v. *Platt* (*p*), the defendants, under an order requiring them to state "the place where, and the earliest date at which," the machines they relied on as showing a prior user had been made, gave a list of thirteen persons and firms, with a general statement that the user had, in all the cases, been at the earliest from 1825 downwards, it was contended that they ought to state in each instance the place at which the first machine had been made, and the date of making. Lord Hatherley, then Sir W. P. Wood, V.C., ordered the particulars to be amended, observing that, as far as concerned the date of user and the place of use of the machines, the defendants were bound to *give the plaintiff all the information* they themselves had. And in the same case the defendants, having alleged in their objections prior publications in books, and done this by a mere general reference, were ordered to state the particular work or document, and the volume of that work, in which the alleged prior publication was found. So also, where a defendant relies on prior specifications as anticipating the plaintiff's patent, he must point out the particular pages and lines of the prior

Pages and lines.

(*l*) *Fisher* v. *Dewick*, 1 Webst. P. C. 551, n.

(*m*) *Russell* v. *Ledsam*, 11 M. & W. 647.

(*n*) *Leaf* v. *Topham*, 14 M. & W. 146.

(*o*) 15 & 16 Vict. c 83, s. 41.

(*p*) 8 L. T. (N. S.) 657.

specification on which he relies, and where he relies on prior user he must state which part of plaintiff's machine he alleges to have been so used (*q*).

Flower v. *Lloyd.*

It has, however, been held by the Court of Appeal that an order requiring further particulars of objection must in form be confined to the particulars mentioned in the Act, and therefore where an order had been made requiring the defendants to state *the names and addresses of the persons by whom*, and the places where, *and the dates at*, and the manner in which, the alleged prior user had taken place, it was held by the Court of Appeal that the order must be varied by omitting the particulars printed above in italics (*r*). The Court, however, intimated that under the order so varied the defendants would still be required to furnish full and sufficient particulars; and accordingly where the defendants, having, in alleged obedience to the last-mentioned order, given to the plaintiff particulars of prior user by three persons, the names and addresses of whom were furnished, added a statement that the invention had been used by "other persons in London and Birmingham," these words were held to be too indefinite, and the defendants were ordered to give more specific information or to submit to the words objected to being struck out (*s*). It has since been expressly held that to satisfy an order in the form settled in *Flower* v. *Lloyd* the defendant must give the names and addresses of prior users (*t*). And a plaintiff may, on making out a proper case, administer interrogatories to a defendant who has delivered particulars of objection, complying literally with the form of order as settled by *Flower* v. *Lloyd*, asking for the names and addresses of the alleged prior users, and whether the machines were in existence (*u*).

Limits of rule in *Flower* v. *Lloyd.*

And again, where a defendant relied on an objection that a prior American patent had been surrendered, and that the invention had been published in certain journals of specified dates, and in sketches and drawings deposited at a specified time in the Patent Office Library, it was held the defendant must state the date of the American patent, the name of the patentee, and the date of the alleged surrender, and specify also the pages but not the lines of the journals referred to, and that the drawings must be identified in writing, whether contained in books or not, the rest of the order to be in the terms of the above-cited case of *Flower* v. *Lloyd* (*x*).

Where names and addresses of prior users are given, the address must be the present residence of the alleged prior users (*y*).

Objections to be precise.

It has always been held that the objections must be precise and

(*q*) *Grover & Baker Sewing Machine Co.* v. *Wilson*, W. N. 1870, 78. See also *Fisher* v. *Dewick*, 1 Webst. P. C. 264.

(*r*) *Flower* v. *Lloyd*, 45 L. J. (N. S.) 746.

(*s*) 20 "Solicitor's Journal," 860.

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

(*u*) *Ibid.*

(*x*) *Plimpton* v. *Spiller*, 20 "Solicitor's Journal," 860.

(*y*) *Palmer* v. *Cooper*, 9 Ex. 236.

definite, and not in too general terms. Thus, it was not sufficient to say that "if any part of the invention were new, the same was useless," or that "the improvements in some of them had been used long before" (*z*). And where the prior user was alleged to be by persons named and "*divers other persons*" (*a*), or at Nottingham "*and elsewhere*" (*b*), or "*by other persons* in London and Birmingham" (*c*), the general words were in each case ordered to be struck out. So also a defendant has been compelled to state whether he objected to the whole of the alleged invention as being old, or whether the objection applied only to a particular part (*d*).

And a defendant has been ordered to state what portions of the specifications alleged as prior publications are alleged to anticipate the plaintiff's patent, with a reference to pages and lines of such specifications, and also what portions of plaintiff's inventions are alleged to have been published prior to the date of the letters patent, with reference to the claiming clauses of the specifications of such letters patent (*e*).

It would seem, however, from the case of *Penn* v. *Bibby* (*f*), that general words may sometimes be allowed in order to give the defendant the benefit of a general saving, and liberty to apply for leave to give particulars of prior user, if and when he may find them. In this case Lord Hatherley, then Sir W. P. Wood, V.C., refused to strike out from an objection alleging certain cases of prior user the words "*among other instances*," and in the previous case of *Curtis* v. *Platt* (*g*) the same learned Judge allowed the words "*amongst others*" to remain in an objection that the invention had been previously used by certain named persons. In this latter case, however, on the plaintiff objecting that if the words above mentioned were allowed to remain the defendant could go into any number of cases of which the plaintiff could have no notice, his Lordship observed that if anything of that sort were attempted at the trial the Court would know how to protect the plaintiff from surprise. This view appears to be at variance with the practice at common law (*h*). *Curtis* v. *Platt*, however, was not a case before a jury, and this fact appears to have influenced the decision.

When the user relied on is a general user it may be stated in general terms. Thus it was held a sufficient allegation of such user to say that the invention was used "*by candle-makers generally in London and the*

(*z*) *Fisher* v. *Dewick*, 1 Webst. P. C. 264; *Heath* v. *Unwin*, 1 Webst. P. C. 552, n; *Russell* v. *Ledsam*, 11 M. & W. 647.

(*a*) *Galloway* v. *Bleaden*, 2 Chit. Arch. Prac. 1031, cited 1 Webst. 268, n; *Fisher* v. *Dewick*, 1 Webst. P. C. 551, n.

(*b*) *Jones* v. *Berger*, 1 Webst. P. C. 544; *Holland* v. *Fox*, 1 C. L. Rep. 440.

(*c*) *Flower* v. *Lloyd*, 20 "Solicitor's Journal," 860.

(*d*) *Fisher* v. *Dewick*, 1 Webst. P. C. 264; *Russell* v. *Ledsam*, 11 M. & W. 647.

(*e*) *London & Leicester Hosiery Co. (Limited)* v. *Higham*, see order, *post*, Appendix.

(*f*) L. R. 1 Eq. 549.

(*g*) 8 L. T. (N. S.) 657.

(*h*) *Hull* v. *Bollard*, 1 H. & N. 134. See, however, *Carpenter* v. *Walker*, 1 Webst. 268, n.

vicinity thereof" (*i*). In such a case the plaintiff is not harmed, because to prove a general user proof by one person would not be enough, and "the plaintiff has no reason to complain of generality of statement, for the more general it is the more the defendant must prove under it" (*k*).

Allegation of general user when sufficient.

So also where the objection points to the general use of a particular preparation by a limited class. Thus, where the patent was for making starch, an objection that the invention had been used by persons engaged in the manufacture of lace "at Nottingham" was held sufficient (*l*).

But even an allegation of general user must not be too wide. Thus, where the patent was for improvements in the construction of carriages, objections alleging user by "*carriage-builders generally throughout Great Britain*," and user by "*various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain*," were held insufficient (*m*).

The best test of the sufficiency or insufficiency of objection will probably be found in the words of Parke, B., in *Palmer* v. *Cooper* (*n*): "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the places named."

An objection that the invention is not new is sufficient to enable a defendant to contend at the trial that one of two inventions described in the specification is not new (*o*).

Objections not in place of pleas.

It has been held that notices of objection cannot go beyond the pleas, and that such objections do not stand in the place of pleas (*p*); and where a defendant had only pleaded the general issue and want of novelty of the invention, and that the plaintiffs were not first and true inventors, he was not allowed to contend that the patent was illegal, although he had given notice of an objection to that effect (*q*).

"*Time and place.*" It will be noticed that these words differ from the words of the corresponding section of the Act of 1852, which required the *place* and *manner* of prior publication or user to be stated; but having regard to the cases cited above, and especially to the observation of the Court of Appeal in *Flower* v. *Lloyd*, it may be anticipated that the information necessary to satisfy the present Act will be, in substance, the same as what was required under the Act of 1852.

(4.)

A defendant will not be allowed, at the trial, to adduce evidence of prior user not disclosed by his particulars of objection, even though

(*i*) *Palmer* v. *Wagstaff*, 8 Ex. 841.

(*k*) *Per* Alderson, B., *Palmer* v. *Wagstaff*, 8 Ex. 841. See also observations of Erskine, J., *Jones* v. *Berger*, 1 Webst. P. C. 547; *Bentley* v. *Keighley*, 7 M. & G. 652; 8 Scott (N. R.) 372.

(*l*) *Jones* v. *Berger*, 1 Webst. P. C. 549. See also *Palmer* v. *Cooper*, 9 Ex 231.

(*m*) *Morgan* v. *Fuller* (2), L. R. 2 Eq. 297.

(*n*) 9 Ex. 236.

(*o*) *Sugg* v. *Silber*, 2 Q. B. D. 493.

(*p*) *Macnamara* v. *Hulse*, 2 Webst. P. C. 128, n; *Jones* v. *Berger*, 1 Webst. P. C. 544.

(*q*) *Gillett* v. *Wilby*, 1 Webst. P. C. 270.

such evidence has only come to his knowledge since the particulars were delivered. In such a case the right course is to apply at once, on learning the new evidence, for leave to amend the particulars (*r*).

A plaintiff's witness may, in cross-examination, be asked questions in a general form as to his knowledge of user of the invention prior to the patent, although this may not be mentioned in the objections, but the counsel for the defendant is not entitled to inquire of the plaintiff's witnesses as to any specific instance of prior user of which he has not given notice (*s*).

Evidence within literal meaning of particulars of objections admitted.

But if the evidence is within the literal meaning of the words of the particulars, however general the statement, the evidence will be received at the trial (*t*). The only question then is whether the words of the notice are sufficiently large to include the objection (*u*). Thus, where particulars of breaches alleged that the defendant had at divers times between specified dates infringed by the manufacture or sale or use of the patented article, and in particular alleged sales to two specified persons, and the defendant in answer to interrogatories admitted a sale to a third person, the plaintiff was allowed to give evidence at the trial, of the transactions with that third person (*x*).

And where the particulars of objection alleged that the invention had *been publicly used in corn-mills*, evidence of user in Cheshire was admitted (*y*).

Where specific acts of infringement were stated in the particulars, and the defence denied infringement at all, and the plaintiffs having proved their case, the defendants went into evidence on the wider issue raised by them, it was held that the Act of 1852, sect. 41, did not apply to such a case, and that as the defendants had not confined themselves to meeting the case set up against them, the plaintiffs were at liberty to adduce evidence in reply by giving instances of infringement other than those alleged in their particulars (*z*).

If the novelty or effect of the invention be disputed, the plaintiff must show in what his invention consists, and that he produced the effect proposed by his patent in the manner proposed. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification (*a*). For this purpose it will be sufficient for the plaintiff to call persons of science or workmen who say that the specification is intelligible to them, and that they can make the invention without further instruction than the specification (*b*).

(*r*) *Daw* v. *Eley*, L. R. 1 Eq. 38.

(*s*) *Penn* v. *Bibby*, L. R. 2 Ch. 127, 137.

(*t*) *Per* Pollock, C B., *Hull* v. *Bollard*, 1 H. & N. 134; *Curtis* v. *Platt*, 35 L. J. (N. S.) Ch. 852, 868; and see remarks of Mellish, L.J., *Sugg* v. *Silber* 2 Q. B. D. 495.

(*u*) *Per* Alderson, B., *Neilson* v *Harford*, 1 Webst. 332. See also p. 370.

(*x*) *Sykes* v. *Howarth*, 12 Ch. D. 826; 48 L. J. Ch. 769.

(*y*) *Hull* v. *Bollard*, *ubi sup.*

(*z*) *Adair* v. *Young*, W. N. 1879, p. 8.

(*a*) *Turner* v. *Winter*, 1 Webst. 81.

(*b*) *Cornish* v. *Keene*, 1 Webst. 503.

The parol evidence of the patentee has been held admissible to prove that the patent was not obtained for some of the things claimed in the specification (*c*).

Where the defendant denies the novelty of the invention, the affirmative of the issue thus raised rests with him (*d*).

The plaintiff can only make a *primâ facie* case as to novelty by calling persons conversant with the subject to show that they had not heard of the invention before the date of the patent. That is enough to call on the other side (*e*), and therefore the plaintiff will be allowed to call evidence in reply, for the purpose of rebutting the case set up by the defendant (*f*).

Where, however, a plaintiff has given a part of his evidence on the issue of novelty, and at the commencement of his case has had his attention called to a prior specification, he cannot, for the purpose of giving evidence as to the contents of it, recall, in reply, any witness who, when he gave his evidence, was acquainted with the specification in question (*g*).

But after the evidence of the defendant has been summed up, the defendant will not be allowed to adduce further evidence in answer to that given by the plaintiff in reply (*h*).

Evidence of infringement.

In ordinary cases the burden of proving infringement lies upon the plaintiff (*i*), and the patentee is bound to prove, not merely the user of the invention by the defendant, but also that such user was unauthorized, and therefore, where in an action to restrain the sale of a patented article the plaintiff proved the sale, but did not prove that the article complained of had not been made by himself or his agent, the bill was dismissed (*k*). But when the thing complained of is manufactured abroad, and the plaintiff has been unable to obtain inspection of the defendant's process, and can therefore only produce *primâ facie* evidence of infringement, it seems that it is the duty of the defendant to give evidence of a negative character, to show that the process used was of a different character from that which had been patented (*l*).

Evidence that an order was given in England, which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendants, is sufficient to satisfy an allegation that he made those articles (*m*).

(*c*) *Crossley* v. *Potter*, Macr. P. C. 253, 255. See also *Bateman* v. *Gray*, Macr. P. C. 111. See, however, *Hinks* v. *Safety Lighting Co.*, L. J. No. Ca. 1876, p. 213.

(*d*) *Penn* v. *Jack*, L. R. 2 Eq. 314; *Minter* v. *Wells*, 1 Webst. P. C. 129.

(*e*) *Galloway* v. *Bleaden*, 1 Webst. P. C. 526; *Cornish* v. *Keene*, 1 Webst. P. C. 509.

(*f*) *Penn* v. *Jack*, L. R. 2 Eq. 314.

(*g*) *Tetley* v. *Easton*, Macr. P. C. 61.

(*h*) *Penn* v. *Jack*, L. R. 2 Eq. 314.

(*i*) *Neilson* v. *Betts*, L. R. 5 H. L. 1, 11.

(*k*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

(*l*) *Neilson* v. *Betts*, L. R. 5 H. L. 1.

(*m*) *Gibson* v. *Brand*, 1 Webst. P. C. 631.

So also where, in an action for infringement of a method of improving lace and net by passing it over a flame of gas in a gassing machine, it was proved that the lace left with the defendant to be dressed had been returned in the state to which it would have been brought by the use of the plaintiff's process, and that similar lace had been offered for sale by the defendant, and that the defendant had one of the patented machines in his possession, it was held there was sufficient evidence of infringement (*n*).

Trade secret.

Where a trade secret is alleged by the defendant, and there has been no inspection by the plaintiff, similarity of structure in the patented article and the things produced by the defendant is *primâ facie* evidence of infringement (*o*).

But where a defendant stated that the alleged infringement was his own secret process, Pearson, J., allowed him to refuse answering questions on cross-examination which might disclose his process, but at the close of the evidence continued the trial *in camerâ* for the purpose of hearing the defendant state his process, which he elected to do. And in giving judgment for the plaintiff his Lordship avoided stating the alleged secret, and ordered the shorthand notes of the proceedings in Court where the case was being heard in private to be impounded in Court until there should be an appeal or until further order (*p*).

The Court looks with suspicion upon evidence which is only brought into existence for the purpose of a cause (*q*), as, for instance, experiments conducted with a view of making evidence for the trial (*r*), or experiments made in the course of the trial (*s*).

(5.)

Amendment of particulars.

Importance of requiring amendment when necessary.

If the particulars delivered are too general, it is the business of the parties who mean to object to them to procure an order for better particulars (*t*), and this is important, otherwise, as above stated, evidence within the literal meaning of the particulars may be admitted, although the particulars are, in fact, too general. There is a very large difference between a case where a Judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from "availing himself of an objection. If, wherever the Court could order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a Judge for further particulars" (*u*).

(*n*) *Hall* v. *Boot*, 1 Webst. P. C. 103.

(*o*) *Huddart* v. *Grimshaw*, 1 Webst. P. C. 91. See also *Davenport* v. *Richards*, 3 L. T. (N. S.) 503.

(*p*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 170.

(*q*) *Betts* v. *Neilson*, L. R. 3 Ch. 433.

(*r*) *Young* v. *Fernie*, 4 Giff. 609.

(*s*) *Plimpton* v. *Malcolmson*, 3 Ch. D. 576.

(*t*) *Per* Pollock, C.B., *Hull* v. *Bollard*, 1 H. & N. 134.

(*u*) *Per* Mellish, L.J., *Sugg* v. *Silber*, 2 Q. B. D. 495.

Allowed at any stage.

The Court will, at any time during the progress of a patent action, allow the defendant to raise a fresh issue on the discovery of facts which could not, with due diligence, have been discovered before (*x*), and has even permitted a defendant, during the progress of the trial, to give short notice of motion for leave to amend his particulars so as to admit the fresh evidence (*y*).

Terms on which amendment allowed.

The defendant will, however, have to pay the costs of, and occasioned by, such an application (*z*). And where a defendant, after amending his objections in compliance with an order to that effect, applied for leave to reamend by adding certain instances of prior user, leave was granted, but on the terms that defendant paid the costs of the application, and the additional costs occasioned by the re-amendment were reserved (*a*).

So also, where a cause was in the paper for hearing, a defendant was allowed, on application after notice to the plaintiff, to adduce evidence by affidavit of prior user discovered after the cause was in the paper, but upon terms insuring to the plaintiff an opportunity of filing affidavits in answer, the costs of and consequent on the application being reserved (*b*).

But in *Edison Telephone Co.* v. *India Rubber Co.* (*c*), where the application was not made till after the day of trial had been fixed, the Court gave the plaintiffs a time within which to elect whether they would discontinue the action, and ordered the defendants in the event of discontinuance to pay all costs incurred by the plaintiffs since delivery of the original particulars of objections; and only allowed the objections to be amended in the event of the plaintiffs not electing to discontinue, the defendants being also ordered to pay the costs of the application.

Where the Court is of opinion that the new objection is on the face of it unsustainable, leave to amend will be refused (*d*).

On new trial further particulars allowed.

Where a new trial has been directed the defendant will be allowed to bring forward further particulars on which to found, at the new trial, evidence of prior user not given at the first trial (*e*).

Costs of amending insufficient particulars.

As to amendment of particulars, see also Supreme Court Rules, 1883, Order XIX, Rule 7. The order to amend may be obtained on summons at Chambers, or by motion in Court (*f*). If the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (*g*). By Rule 8 of the last-

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

(*y*) *Daw* v. *Eley*, L. R. 3 Eq. 38. See also *Renard* v. *Levinstein*, 13 W. R. 229; *s.c.* 11 L. T. (N. S.) 505.

(*z*) *Renard* v. *Levinstein*, *ubi sup.*

(*a*) *Penn* v. *Bibby*, L. R. 1 Eq. 548.

(*b*) *Wilson* v. *Gunn*, W. N. 1875, p. 78.

(*c*) 17 Ch. D. 137, following *Baird* v. *Moule's Earth Closet Co.* (M.R., Feb. 3, 1876) and *Aveling* v. *Maclaren* (C. P. D., Dec. 23, 1880); both orders are printed 17 Ch. D. 139.

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

(*e*) *Bovill* v. *Goodier*, 36 L. J. (N. S.) Ch. 360.

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

(*g*) *Grover & Baker Sewing Machine Co.* v. *Wilson*, W. N. 1870, p. 78; *Penn* v. *Bibby*, L. R. 1 Eq. 548.

mentioned Order, an order for particulars does not, except as mentioned in the Rule, operate as a stay of proceedings or give any extension of time.

A plaintiff has been allowed to amend his statement of claim at the trial, so as to charge as Custom-house agents defendants who had been originally sued as importers, but who, as it appeared for the first time on their own evidence, were, in fact, Custom-house agents only (*h*).

(6.)

Costs of particulars.

"*Shall not be allowed any costs, &c., unless,*" *&c.* The words, "or to have been reasonable and proper," are in addition to the corresponding provisions of the Act of 1852 (*i*), of which this sub-section is substantially a re-enactment. Those provisions were held to apply only where there had been a trial; and where there was no trial matters were left as if there had been no such enactment, and therefore, when a plaintiff abandoned his action, after having given notice of trial, the defendant was held entitled to the costs of preparing his particulars of objection and evidence in support of them (*k*). But if there were a trial, and the plaintiff was non-suited, the defendant was not entitled to any costs in respect of his particulars of objections, unless the Judge certified that they had been proved (*l*). And where the patent was held void the Court would not certify that the plaintiff had proved his particulars of breaches, even though it was of opinion, on the evidence, that the defendant had infringed (*m*).

Where, in an action for alleged infringement of two patents, the defendants denied the validity of both patents upon the usual grounds, and also denied infringement, and at the trial the plaintiffs abandoned the action entirely as to one patent, and the defendants only argued on the other patent the question of insufficiency of specification, on which they succeeded, and the action was dismissed with general costs of action, it was held under the Act of 1852 that the defendants were to have from the plaintiffs their costs of the particulars of objections and particulars of breaches in the case of the patent on which the action was abandoned, and that the plaintiffs should have from the defendants the costs of the particulars of breaches of the other patent (*n*).

Where a plaintiff in a patent action succeeded on the issue as to validity of the patent, but failed as to infringement, the costs were apportioned (*o*). And where plaintiffs sued on two patents, and suc-

(*h*) *Nobel's Explosives Co.* v. *Krebs*, W. N. 1880, p. 77.

(*i*) 15 & 16 Vict. c. 83, s. 43.

(*k*) *Greaves* v. *The Eastern Counties Railway Co.*, 1 Ell. & Ell. 961; *s.c.* 28 L. J. (N. S.) Q. B. 290; *Batley* v. *Kynock*, L. R. 20 Eq. 632.

(*l*) *Honiball* v. *Bloomer*, 10 Ex. 538; *s.c.* 24 L. J. (N. S.) Ex 11.

(*m*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 721.

(*n*) *Wegmann* v. *Corcoran*, 27 W. R. 357, 362.

(*o*) *Simmonds* v. *Hitchman*, Eng. Rep. Jan. to Mar. 1881, p. xvi. See the order in the Appendix.

ceded as to one only, the action was dismissed with costs as to one patent, and an injunction was granted with costs as to the other (*p*). And by the Supreme Court Rules, 1883, Order LXV, Rule 2, it is provided that where issues of 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.

"*Certified by the Court or a Judge.*" See notes under sect. 31, *post.*

General rule as to costs.

"*General costs of the case.*" The rule as to costs has thus been stated by Jessel, M.R.: "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" (*q*).

No ground for refusing costs that defendant acted in ignorance, or had no notice of intended proceedings.

Thus it is no ground for refusing the plaintiff his costs that the defendant acted in ignorance of the plaintiff's rights (*r*), or never intended to do wrong (*s*). Nor will the plaintiff be refused costs because before suing he made no application to the defendant (*t*). It has never been laid down that a plaintiff entitled to relief must, before commencing proceedings, apply to the defendant and ascertain previously whether he will without suit do all that is required (*u*).

When defendant offers to submit.

Sometimes a person infringing a patent will, on complaint being made, offer to discontinue the infringement, and account for the profits he has made. A question then arises as to whether the patentee is bound to accept this promise, or is entitled to take proceedings for an injunction.

In *Losh* v. *Hague* (*x*) Shadwell, V.C., said: "I do not think it enough on a question of injunction for the defendant to say why he has done the thing complained of, but will not do it again. That is not the point, because if a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied, but if once the thing complained of has been done, I apprehend this Court

(*p*) *United Telephone Co.* v. *Harrison*, 21 Ch. D. 747.

(*q*) *Cooper* v. *Whittingham*, 15 Ch. D. 504. See also *Edelsten* v. *Edelsten*, 1 D. J. & S. 185, 204.

(*r*) *Burgess* v. *Hills*, 26 Beav. 244; *Collins' Co.* v. *Walker*, 7 W. R. 222; *Cooper* v *Whittingham*, 15 Ch. D. 505; *Upmann* v. *Forrester*, 24 Ch. D. 231.

(*s*) *Cooper* v *Whittingham*, 15 Ch. D. 507. See also *Davenport* v. *Rylands*, L. R. 1 Eq. 303.

(*t*) *Burgess* v. *Hateley*, 26 Beav. 249; *Upmann* v. *Forrester*, 24 Ch. D. 231.

(*u*) *Per* Lord Romilly, M.R., *Upmann* v. *Elkan*, L. R. 12 Eq. 146; *Cooper* v. *Whittingham*, 15 Ch. D. 505; *Upmann* v. *Forrester*, 24 Ch. D. 236.

(*x*) 1 Webst. P. C. 200.

interferes, notwithstanding any promise the defendant may make not to offend again."

And in *Geary* v. *Norton* (*y*), Sir J. L. Knight Bruce, V.C., asked "whether it had ever been decided where a right of this kind had been invaded, and the invading party says he is doing wrong and will do so no more, that the party complaining is barred as to his costs on filing a bill to have the protection of an injunction rather than the promise of the person." And in that case, where the defendant had before bill filed merely promised not to repeat the infringement, the plaintiff was held entitled to his costs of suit.

What costs innocent infringer must pay.

And in *Upmann* v. *Elkan* (*z*), a trade mark case, Lord Romilly, M.R., said that "a party using a forged trade mark, though innocently, is liable for the costs of setting that right up to the time when he first knew of the forgery; but if, after that time, he stops, and is willing to undertake not to go any further with the use of the mark, he is not liable for further costs." And again, "It is his duty at once to give the plaintiff all the information required, and to undertake that the goods shall not be removed or dealt with till the spurious brand has been removed, and to offer facilities for that purpose. If, after that, the person injured file a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit, he will not get from such defendants the costs of the suit, and he may have to pay them."

A plaintiff was not, under the old Chancery practice, bound to accept the defendant's affidavit as to the profits made by him, and had a right to an answer from the defendant, and might have his costs up to and including the answer (*a*).

And a plaintiff is also entitled in strictness to an account of profits at the hearing of the cause, though if the Court thinks the conduct of the plaintiff has been oppressive, it will only give such an account at the plaintiff's peril (*b*).

And the plaintiff may have his costs, even though the injunction is submitted to, and the plaintiff waives the account at the hearing (*c*).

But if plaintiff's conduct oppressive, he may be refused costs.

But where a defendant who had in ignorance infringed the plaintiff's patent offered before suit to discontinue the infringement, and to pay the amount of profits made, and to sell the stock to the plaintiff or to take it to pieces, and the plaintiff insisted on taking the account and on the destruction of the stock in hand, and a signed apology, and, on this being refused, instituted a suit for injunction and account, the Court, although the defendant submitted at the hearing to a perpetual injunction, gave the plaintiff no costs (*d*).

And if, after the commencement of the action, the defendant offers to

(*y*) 1 De G. & Sm. 9.
(*z*) L. R. 12 Eq. 144, 145, affirmed L. R. 7 Ch. 131.
(*a*) *Colburn* v. *Simms*, 2 Ha. 543.
(*b*) *Nunn* v. *D'Albuquerque*, 34 Bea. 595.
(*c*) *Burgess* v. *Hateley*, 26 Bea. 249; *Burgess* v. *Hills*, 26 Bea. 244; *Upmann* v. *Forrester*, 24 Ch. D. 236.
(*d*) *Nunn* v. *D'Albuquerque*, 34 Bea. 595. See also *Hudson* v. *Bennett*, 14 W. R. 911.

submit to all the relief to which the plaintiff is entitled, the plaintiff will not have the costs of the subsequent prosecution of the suit (*e*).

And in a trade mark case where the defendant, who had innocently infringed, offered immediately after service of the writ in an action brought without previous notice an undertaking in terms of the indorsement on the writ, and to withdraw the goods marked with the spurious mark from sale, and the plaintiff nevertheless moved for an injunction, it was held that the motion was unnecessary, the undertaking being as good as an injunction, but that the plaintiff was entitled to a small sum for costs, *e.g.*, for the costs of the writ, and 5*l.* only was allowed him for costs (*f*).

And may be made to pay costs.

And where, on an appeal to the House of Lords, the respondent continued the appeal after the appellant had offered to give him all to which he was entitled, the respondent, though successful, was ordered to pay the costs of the appeal subsequent to the date of the offer (*g*).

What defendant should do to avoid costs.

But the defendant, to bring himself within these principles, must offer to pay the plaintiff's costs of suit already incurred, or the plaintiff may bring the cause to a hearing, and the defendant will then have to pay the costs (*h*)—*à fortiori* if the defendant has actually refused to pay costs (*i*).

Where a defendant who has before suit promised not to infringe again raises after suit objections to the patent, which he afterwards abandons, he may be refused his costs, although the Court dismisses the Bill (*k*).

A defendant who desires to submit before suit ought to offer to pay the plaintiff's costs of consulting his solicitor (*l*).

Defendant bankrupt, trustees defending, and failing, pay costs.

Where a defendant became bankrupt after the commencement of proceedings, and then delivered a defence but did not appear at the trial, and his trustees in bankruptcy were made defendants, and an account of profits was asked against them, though there was no allegation that they had manufactured, and the trustees put in no defence, but appeared at the trial and objected that the amount to be found under the account was not provable in the bankruptcy, and cross-examined witnesses in order to show no infringement, it was held that, the plaintiff succeeding in the action, the trustees must pay the costs (*m*).

Directors of company may be made personally liable for costs.

The directors of a limited company may be made personally liable to the costs of an action against the company to restrain infringement of

(*e*) *Colburn* v. *Simms*, 2 Ha. 543.

(*f*) *Caruncho* v. *Highmore*, L. J. No. Ca. 1883, p. 15.

(*g*) *De Vitre* v. *Betts*, L. R. 6 H. L. 319, 326.

(*h*) *Burgess* v. *Hateley*, 26 Bea. 249; *Fradella* v. *Weller*, 2 R. & M. 247; *Geary* v. *Norton*, 1 De G. & Sm. 9, 12.

(*i*) *Burgess* v. *Hills*, 26 Bea. 248.

(*k*) *Betts* v. *Willmott*, 18 W. R. 946.

(*l*) *Nunn* v. *D'Albuquerque*. 34 Bea. 596.

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

a patent, even though they may show that the acts complained were done by workmen contrary to orders (*n*).

It seems that the Court will not make an order for costs when it is probable that proceedings in the cause may afterwards take place which will affect the decision of the Court upon the question of costs, and therefore when a bill to restrain infringement of a patent was, under the old Chancery practice, retained at the hearing, to give the plaintiff an opportunity of trying the right at law, the Court refused to make an order as to the costs of the evidence which had been adduced, and which costs were claimed by the plaintiff on the ground that the defendant had not required him to establish his title at law before the hearing (*o*).

Lien for costs.

In a trade mark case the plaintiff has been held entitled to a lien for his costs on the goods complained of (*p*). But this decision has since been questioned (*q*).

Costs on dismissal for want of prosecution.

Where the plaintiff obtained an injunction on motion, and the bill was ultimately dismissed with costs for want of prosecution, the defendant was held to be entitled to the costs of the motion (*r*).

So also where the motion for injunction was ordered to stand over till after the trial, and the plaintiff succeeded on the issue as to infringement, but failed as to the validity of the patent, and his bill was dismissed for want of prosecution (*s*).

Motion for injunction ordered to stand to hearing.

But where the motion for injunction was ordered to stand to the hearing, and at the hearing a decree was made for a perpetual injunction, and the defendant was ordered to pay the costs of the suit, it was held that the costs of the motion were costs in the cause (*t*).

Staying proceedings pending appeal.

The general rule is that the applicant must pay the costs of an application to stay proceedings pending an appeal (*u*); but where on an application by defendant to stay pending an appeal the proceedings under an account ordered on the trial of an action for infringement of patent, the proceedings were stayed, but the appeal was advanced, the Court, considering that the plaintiff had obtained a benefit by the order, directed the costs of the application to be costs in the appeal (*x*).

Party and party costs.

On taxation of costs as between party and party, the only costs chargeable are such as are necessary to enable the adverse party to conduct the litigation and no more. Any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them (*y*).

Costs for "luxuries" not allowed.

(*n*) *Betts* v. *De Vitre*, 11 Jur. (N. S.) 9, affirmed L. R. 3 Ch. 429, 442; 6 H. L. 319. See as to this *A. G.* v. *Vestry of Bermondsey*, 23 Ch. D. 60; *Mathias* v. *Yetts*, 46 L. T. 497.

(*o*) *Ward* v. *Key*, 10 Jur. 792.

(*p*) *Upmann* v. *Elkan*, L. R. 12 Eq. 140, affirmed 7 Ch. 131; *Moet* v. *Pickering*, 6 Ch. D. 770.

(*q*) *Moet* v. *Pickering*, 8 Ch. D. 372.

(*r*) *Stevens* v. *Keating*, 1 Mac. & G. 659.

(*s*) *Betts* v. *Clifford*, 1 J. & H. 74.

(*t*) *Mounsey* v. *Earl Lonsdale*, L. R. 6 Ch. 141.

(*u*) *Merry* v. *Nickalls*, L. R. 8 Ch. 205; *Cooper* v. *Cooper*, 2 Ch. D. 493.

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

(*y*) *Per* Sir R. Malins, V.C., *Smith* v. *Butler*, L. R. 19 Eq. 473.

Therefore, in a suit to restrain infringement of a patent in which the plaintiff failed, the costs of drawings and sections explanatory of the exhibits to the defendant's affidavits, which were only required for the purpose of being affixed to the margin of copies of the evidence supplied to counsel, were disallowed, and this notwithstanding the plaintiff himself took advantage of, and asked for copies of, the drawings (*z*).

Proper remuneration to scientific witnesses allowed.

But proper remuneration to scientific witnesses will be allowed, and also the expense of preparing a model for the trial (*a*). And the costs of reference by the Court to an expert will be costs in the cause (*b*).

Costs of preparing for trial.

The rule at common law was not to give to a defendant costs of preparing for trial until after notice of trial had been given (*c*); and in *Curtis* v. *Platt* (*d*), where a defendant had obtained further time to plead upon terms that the action should be put down for trial, and that short notice of trial should be given, and the pleas were delivered, and the plaintiff then discontinued the action before issue joined or notice of trial given, it was held by the Court of Common Pleas that the defendant's costs incurred before notice of trial could not be allowed; and with reference to the defendant's contention that as notice of objections was delivered with the pleas, the expenses ought to be allowed as accessory to those objections, Willes, J., after observing that he was not satisfied that these expenses were so connected, said: "One instance has been given, the looking into specifications of patents of a similar character, but the validity of such a claim would depend on whether the defendant knew, when he delivered the objections, the particulars of the invention, or whether he was merely making speculative inquiries. I have strong doubts whether such expenses should be allowed at all."

However, in *Batley* v. *Kynock* (*e*), where the plaintiff shortly before the hearing dismissed his bill with costs, and the taxing-master had allowed to the defendant the expenses of drawing particulars of objections (*f*) and settling same by counsel, on the ground that the defendant, by the course taken by the plaintiff dismissing his own bill, had no opportunity of applying for the certificate, Sir James Bacon, V.C., refused to review the taxing-master's decision, and said that up to the moment when the plaintiff chose to dismiss his own bill the defendant was bound to be on the *qui vive*, and to be prepared with sort of defence he could lawfully use. But his Lordship intimated that if complaint is made that the charge is unreasonable, or that the

(*z*) *Smith* v. *Buller*, L. R. 19 Eq. 473.

(*a*) *Batley* v. *Kynock*, L. R. 20 Eq. 632.

(*b*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 24 Ch. D. 156, 176.

(*c*) *Freeman* v. *Springham*, 14 C. B. (N. S.) 197.

(*d*) 10 Jur. (N. S.) 823; *s.c.* 33 L. J. (N. S.) C. P. 255.

(*e*) L. R. 20 Eq. 682.

(*f*) The report speaks of particulars of breaches, but this is clearly a clerical error.

defences are too long, too numerous, or too manifestly untenable on the face of them, the taxing-master ought to take such a complaint into consideration.

Costs in consolidated actions.

It is said that at common law, where several sections are consolidated, all the defendants are liable to the plaintiff for the costs of the action that is tried, and that they stand together in the relation of joint defendants so as to be liable to contribution for these costs (*g*). But where a number of actions had been brought by different plaintiffs against the same defendant, and one action was selected as a test action to try all the questions, it was held that in the absence of agreement the plaintiff in the test action had no right to be indemnified against costs by the other plaintiffs (*h*).

Order for inspection, &c., in action.

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.

This is substantially a re-enactment of the corresponding section of the Act of 1852 (*i*); but that section, although said by Lord Campbell to have been intended to vest in the Courts of Common Law the power as to these matters theretofore exclusively exercised by Courts of Equity (*k*), does not seem to have had the effect of enabling the plaintiff at common law to obtain such full relief, either by way of injunction (*l*) or inspection as he could have in equity (*m*). But now, by the Judicature Act, 1873, all the jurisdiction which could be exercised by all or any of the old Courts of Common Law and Chancery is transferred to the High Court of Justice, and by sect. 25 (11) it is provided that in case of conflict between the rules of equity and the rules of common law the rules of equity shall prevail.

By sect. 25 (8) of the same Act an injunction may be granted by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just and convenient that such order should be made, and any such order may be made either unconditionally or on such terms and conditions as the Court shall think just. And by the

(*g*) "Lush's Practice," 3rd ed., 965.

(*h*) *Amos* v. *Chadwick*, 9 Ch. D. 459.

(*i*) 15 & 16 Vict. c. 83, s. 42.

(*k*) *Holland* v. *Fox*, 3 E. & B. 977; *s.c.* 1 Jur. (N. S.) 13.

(*l*) *Gillins* v. *Symes*, 15 C. B. 362.

(*m*) Compare *Patent Type Founding Co.* v. *Lloyd*, 5 H. & N. 192 (where the Court of Law refused to permit a portion of certain type alleged to have been made in infringement of a patent to be carried away for analysis) with *Patent Type Founding Co.* v. *Walter*, Johnson, 727, when Sir W. P. Wood, V.C., allowed this to be done. See also *Vidi* v. *Smith*, 3 E. & B. 969; *s.c.* 1 Jur. (N. S.) 15.

Supreme Court Rules, 1883, Order L, Rule 12, it is provided that in any cause or matter in which an injunction has been or might have been claimed, the plaintiff may, before or after judgment, apply for an injunction to restrain the defendant or respondent from the repetition or continuance of the wrongful act or breach of contract complained of, or from the commission of any injury or breach of contract of a like kind relating to the same property or right, or arising out of the same contract, and the Court or a Judge may grant the injunction either upon or without terms as may be just.

By Rule 3 of the same Order the Court or a Judge is empowered, on the application of any party to a cause or matter, and upon such terms as may seem just, to make any order for the detention, preservation, or inspection of any property or thing being the subject of such cause or matter, or as to which any question may arise therein, and for all or any of the purposes aforesaid to authorize any persons to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or any of the purposes aforesaid to authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may seem necessary or expedient for the purpose of obtaining full information or evidence.

And by Rule 4 of the same Order any Judge by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal may inspect any property or thing concerning which any question may arise therein. And by Rule 5 of the same Order the provisions of Rule 3 mentioned above shall apply to inspection by a jury (*n*).

The result, therefore, is that each Division of the High Court of Justice has now the fullest powers of making orders for injunction, inspection, or account wherever it shall think proper so to do, and this jurisdiction can be exercised by any Judge of the Court (*o*). The powers conferred by this section and the rules cited above being given to "the Court or a Judge" may be exercised either on application in Court or on summons at Chambers (*p*), subject, however, to the provisions of Order LIV, Rule 12, and Order LV, Rule 15. No writ of injunction is for the future to be issued. An injunction is to be by judgment or order, and any such judgment or order is to have the effect which a writ of injunction previously had (*q*).

In *Vidi* v. *Smith* (*ante*, p. 87) it was held that the "inspection" mentioned in sect. 42 of the Act of 1852 referred to an inspection of the instrument or machinery manufactured or used by the parties with a view to evidence of infringement, and not to an inspection of books.

(*n*) See also Supreme Court Rules, 1883, Rule 6.

(*o*) *Beddow* v. *Beddow*, 9 Ch. D. 89; *Thomas* v. *Williams*, 14 Ch. D. 864; *Quartz Consolidated, &c., Co.* v. *Beall*, 20 Ch. D. 501.

(*p*) See *Frearson* v. *Loe*, 26 W. R. 138.

(*q*) Supreme Court Rules, 1883, Order L, Rule 11.

INJUNCTIONS (INTERLOCUTORY).

The rule as to granting interlocutory injunctions in patent actions is thus stated by Sir George Jessel, M.R. :—

"The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent" (*r*).

It will be convenient to consider these several cases in the order thus stated.

I. *Where the patent is old, and there has been long and undisturbed enjoyment.*

On this point the rule is laid down by Lord Eldon in the following terms :—

Rule as to long enjoyment.

"Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction without putting the party previously to establish his patent by an action at law. But when the patent is but of yesterday, and upon an application being made for an injunction it is endeavoured to be shown in opposition to it that there is no good specification or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent without the right having been ascertained by a previous trial" (*s*).

The ground of this presumption in favour of the patent when there has been long enjoyment is that anybody might have proceeded by *scire facias* to repeal the patent, and yet for a length of time no one has done so (*t*).

Again, Lord Cottenham, C., said that in the case of patents "the rule steps in and says long and uninterrupted possession shall be *primâ facie* evidence of title which ought to be respected. *Primâ facie* in that state of the case the Court is not at liberty to exercise a discretion as to whether the patent be good or not" (*u*).

(*r*) *Dudgeon* v. *Thomson*, 30 L. T. (N. S.) 244 ; s.c. 22 W. R. 464.

(*s*) *Hill* v. *Thompson*, 3 Mer. 622 ; s.c. 1 Webst. P. C. 229, 231. See also *Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 707 ; *Stevens* v. *Keating*, 2 Webst. 177 ; *Harmar* v. *Plane*, 14 Ves. 130 ; *Bickford* v. *Skewes*, 1 Webst. 211, 213 ; *Electric Telegraph Co.* v. *Nott*, 2 Coop. C. C 41 ; *Wilson* v. *Tindal*, 1 Webst. P. C. 730; *Renard* v. *Levinstein*, 10 L. T. (N. S.) 94; *Davenport* v. *Jepson*, 4 D. F. J. 440.

(*t*) *Per* Turner, L.J., *Davenport* v. *Jepson*, 4 D. F. J. 446 ; *Caldwell* v. *Vanvlissengen*, 9 Ha. 415, 424 ; *Electric Telegraph Co.* v. *Nott*, 2 Coop. Ch. Ca. 41.

(*u*) *Stevens* v. *Keating*, 2 Webst. 177.

Comparative inconvenience not considered in cases of long enjoyment.

In these cases the Court does not proceed on the ground of comparative inconvenience. In *Davenport* v. *Jepson* (*x*), Turner, L.J., said: "If the case turned on the question of comparative injury, see what the position of the plaintiff would be if an injunction were refused. Supposing his patent is valid, a number of persons are infringing it. If the Court refused an injunction in this case, it must refuse it in the case of each of the other infringers. Supposing the plaintiff to succeed at the hearing, the market will, in the meantime, have been flooded with articles wrongfully manufactured according to his patent." This appears to have been the view of Lord Eldon in *Harmar* v. *Plane* (*y*), and of Lord Cottenham in *Stevens* v. *Keating* (*z*).

But enjoyment must have been uninterrupted.

And there must also be clear evidence that the enjoyment by the patentee has been in fact uninterrupted and exclusive. When the evidence of this is not satisfactory, then, notwithstanding the patent may be of long standing, the interlocutory injunction will be refused till after the validity of the patent has been established (*a*). Thus, when a patent dated in 1825 was in 1838 assigned to the plaintiffs, who in that year filed a bill to restrain infringement and obtained an *ex parte* injunction against the defendant, but it was shown that for some years prior to the assignment the invention had been used by one of the plaintiffs without the licence of and adversely to the patentee, the injunction was dissolved (*b*).

And active not passive.

And the plaintiff must show not merely passive enjoyment of the patent, but an actual user of the invention. And therefore, where a patentee whose patent was ten years old applied for an injunction but did not produce any evidence of actual user except at a recent period, the application was refused (*c*).

Or dependent on substratum patent.

And where a patented invention was the subject of a prior substratum patent, and could not be used without the licence of the original patentee, it was held that the undisturbed enjoyment of the second patent only dated from the expiration of the substratum patent, and as on this view only one year's enjoyment could be shown, no injunction could be granted (*d*).

Injunction granted on long enjoyment, though validity of patent doubtful.

But when the enjoyment of the patent has been long and uninterrupted, the Court will grant the interlocutory injunction, notwithstanding there may be doubts as to the validity of the patent (*e*). Thus, in *The Universities of Oxford and Cambridge* v. *Richardson* (*f*), Lord Eldon, C., said: "In the case of patent rights, if the party gets his patent and puts his invention in execution, and has proceeded to a sale,

(*x*) 4 D. F. J. 448.
(*y*) 14 Ves. 130.
(*z*) 2 Webst. 177.
(*a*) *Collard* v. *Allison*, 4 My. & Cr. 487.
(*b*) *Curtis* v. *Cutts*, 8 L. J. (N. S.) 184; 2 Coop. C. C. 60.
(*c*) *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 38.
(*d*) *Heugh* v. *Magill*, W. N. 1877, 62.
(*e*) *Betts* v. *Menzies*, 3 Jur. (N. S.) 357, 359; *Dudgeon* v. *Thomson*, 30 L. T. (N. S.) 244.
(*f*) 6 Ves. 707. See also *Gardner* v. *Broadbent*, 2 Jur. (N. S.) 1041.

that may be called possession under it, however doubtful it may be whether the patent can be sustained, this Court has lately said possession under colour of title is ground enough to injoin, and to continue the injunction till it is proved at law that it is only colour and not real title."

And in *Losh* v. *Hague* (*g*) the injunction was granted although a prior specification was produced as an anticipation of the plaintiff's invention, which, on the face of it, seemed to be fatal to his patent (*h*).

So also, in *Muntz* v. *Foster*, the patentee having had long possession and enjoyment of his patent, an injunction to restrain infringement was granted by Sir J. L. Knight Bruce, V.C. On appeal, objections to the specification were made, but Lord Lyndhurst, C., sustained the injunction, saying, "The patentee has been in the possession of his exclusive privilege for several years, and the Court will not, on any suggested defect of the specification, allow the enjoyment of that privilege to be disturbed until the title has been decided in a Court of Law" (*i*).

What length of enjoyment sufficient for injunction.

The following cases may be consulted as to the time of undisputed possession of a patent on which the Court will grant an injunction before the patent has been established :—

In *Harmar* v. *Plane* (*k*) the patentee had had thirteen years' enjoyment ; in *Neilson* v. *Thompson* (*l*), twelve years ; in *Stevens* v. *Keating* (*m*), of one patent, thirteen years, of another, seven years ; in *Davenport* v. *Richards* (*n*), nine years ; in *Betts* v. *Menzies* (*o*), eight years ; in *Losh* v. *Hague* (*p*), seven years ; and in *Bickford* v. *Skewes* (*q*), six years. (In *Neilson* v. *Thompson*, *Stevens* v. *Keating*, and *Betts* v. *Menzies*, the injunctions were ultimately dissolved, but not on any ground affecting the question of long enjoyment.)

In *Renard* v. *Levenstein* (*r*), Lord Hatherley, C., then Vice-Chancellor, said that if the patent had been six or seven years old, and up to that time undisputed, the *primâ facie* right to an injunction would have been clear.

On the other hand, in *Hill* v. *Thompson*, the patent was dated July 1814, the bill was filed in 1817, but the plaintiff's works were not complete so as to enable him to carry on operations under the patent till July 1816. Under these circumstances Lord Eldon dissolved an injunction which had been obtained (*s*).

And in *Renard* v. *Levenstein* (*t*), where the patent was only two years old at the time of the filing of the bill, and its validity had not been

(*g*) 1 Webst. 201.
(*h*) See also *Beeston* v. *Ford*, 2 Coop. C. C. 58 ; *Bickford* v. *Skewes*, 1 Webst. P. C. 213.
(*i*) 2 Webst. 93, 95.
(*k*) 14 Ves. 130.
(*l*) 1 Webst. 279.
(*m*) 2 Webst. 176.
(*n*) 3 L. T. (N. S.) 503.
(*o*) 3 Jur. (N. S.) 357. See also L. R. 3 Eq., p. 312
(*p*) 1 Webst. 200.
(*q*) 1 Webst. 211, 213.
(*r*) 10 L. T. (N. S.) 94.
(*s*) 3 Mer. 622 ; 1 Webst. 232. See also *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37.
(*t*) 10 L. T. (N. S.) 177.

established in any proceeding, the Lords Justices refused to continue an injunction which had been granted by the Vice-Chancellor, notwithstanding the facts that the defendant had filed no affidavits in opposition to the original motion, and had since put in his answer and allowed three months to elapse before applying to dissolve the injunction, and although four infringers had submitted to the plaintiff's demands, one of those had bought the article complained of from the defendant's own agent (*u*). The defendant having suggested various defects in the plaintiff's specification, Knight Bruce, L.J., said, after referring to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant in such a case at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification." And after referring to the suggested objections, his Lordship continued: "It is only for the present purpose, the age of the patent considered, necessary to say, as far as I am concerned, that in my judgment, at least, the point is one of doubt and difficulty."

The circumstance that the Court itself now tries the whole case, the validity of the patent, without, as was the old practice of the Court of Chancery, sending the question of the validity of the patent to be tried at law, ought not, where there has been long and quiet enjoyment of the patent, to have any weight on the question whether or not an interlocutory injunction shall be granted (*x*).

II. *Where the validity of the patent has been established elsewhere, and the Court sees no reason to doubt the propriety of the result.*

Patent established in one action injunction granted in action against new infringer.

In some of the earlier cases, as, for instance, in *Croskill* v. *Tuxford* (*y*), *Croskill* v. *Evory* (*z*), it seems to have been considered that, notwithstanding previous suits establishing the patent against other persons, an interlocutory injunction could not be granted against a new infringer until after the patent had been established against him. This view, however, is inconsistent with the later cases, which lay down the rule that while the defendant in such a case may dispute the patent at the trial, the validity of the patent will be considered so far established by the previous suits as to warrant the Court in granting an interlocutory injunction (*b*).

The distinction is that, where the validity of the patent has not been made the subject of legal proceedings, then the patentee must prove its

(*u*) These facts appear from the report before the V.C., 10 L. T. (N. S.) 94.

(*x*) *Per* Turner, L.J., *Davenport* v. *Jepson*, 4 D. F. J. 447.

(*y*) 5 L. T. 342.

(*z*) 10 L. T. 459.

(*b*) *Newall* v. *Wilson*, 2 D. M. & G. 282; *Davenport* v. *Jepson*, 4 D. F. J. 440; *Davenport* v. *Goldberg*, 2 H. & M. 283; *Bovill* v. *Smith*, W. N. 1867, 240; *Dudgeon* v *Thomson*, 30 L. T. (N. S.) 244.

validity before a jury before the Court will protect him; but having once established its validity, then the Court will protect him against any other person until that person proves its invalidity (*c*).

Even though new facts alleged against patent.

In such a case the interlocutory injunction will be granted, although a fresh fact may be now brought forward tending to impeach the novelty of the invention (*d*).

In *Renard* v. *Levinstein* (*e*) it was held that the injunction ought to be granted notwithstanding the defendant offered to keep an account. In this case, it is true, the issues as to the validity of the patent which had been directed in the suit had been found in favour of the plaintiff, but there seems to be no reason why the rule should not apply in cases where credit for the purposes of the interlocutory injunction is given to the patent by reason of its having been established in previous suits against other persons.

An allegation as to the defendant's inability to be answerable in damages is not irrelevant upon a motion for injunction to restrain infringement (*f*).

And where a patentee had brought an action against a defendant, and on the trial an arbitration was agreed to, on which the arbitrator found in favour of the validity of a patent, the Court, upon a subsequent infringement by the same defendant, considered the validity of the patent as sufficiently established by the award, and granted an interlocutory injunction (*g*).

And the fact of an interdict having been granted by the Court of Session in Scotland against the defendant, restraining him from infringing the patent, is sufficient *primâ facie* evidence of its validity to warrant the grant of an interlocutory injunction by an English Court (*h*).

Issues found in plaintiff's favour, injunction granted.

Under the old practice in Chancery, where an interlocutory injunction had been originally refused, or, having been granted, had been dissolved on the terms that the plaintiff should bring an action to try the validity of his patent, it was almost a matter of course, if the action resulted in judgment for the plaintiff, that the injunction should be allowed (*i*), and this course has been followed under the practice under Sir John Rolt's Act and Lord Cairns' Act, and where the usual issues in a patent suit had been tried by the Court itself under those Acts, and the verdict had been in favour of the plaintiff, the latter was at once entitled to the interlocutory injunction, and this although the defendant volunteered to keep an account (*k*).

(*c*) *Per* Lord Romilly, M.R., *Bovill* v. *Goodier* (2), L. R. 2 Eq. 200.

(*d*) *Newall* v. *Wilson*, 2 D. M. G. 282.

(*e*) 2 H. & M. 628, 634.

(*f*) *Newall* v. *Wilson*, 2 D. M. G. 282.

(*g*) *Lister* v. *Eastwood*, 26 L. T. 4.

(*h*) *Dudgeon* v. *Thomson*, 30 L. T. (N. S.) 244.

(*i*) *Neilson* v. *Harford*, 1 Webst. P. C. 373; *Russell* v. *Cowley*, 1 Webst. P. C. 471.

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

And where the plaintiff, having been directed to bring an action, had obtained a verdict upon a case stated, but the Court of Common Law was equally divided upon the question of the validity of the patent, Lord Rosslyn, C., would not dissolve an injunction previously granted, but directed the patentee to bring a fresh action, and declined to impose terms on the plaintiff as to the Court in which the action should be brought (*l*).

But not if proceedings for new trial pending.

But where after verdict in favour of the plaintiff the defendant had obtained a rule *nisi* for a new trial (*m*), or had stated his intention to move for a new trial (*n*), or tendered a bill of exceptions (*o*), the motion for an interlocutory injunction was ordered to stand over till the result of the application to the Court of Common Law should be known.

And where an injunction which had been obtained by a plaintiff pending the trial of an action at law was continued by the Vice-Chancellor, notwithstanding the first decision of the Court of Law against the validity of the patent, it was dissolved upon such first decision being affirmed by the Court of Exchequer Chamber (*p*).

The rule, however, was not invariable, and in *Bridson* v. *Benecke* (*q*) it was held that the Court would act according to the circumstances of each particular case.

After patent established injunction granted on *primâ facie* evidence of infringement.

Where the validity of the patent has been established in another action, an injunction against a fresh infringer may be granted, if the Court, on the evidence before it, sees a *primâ facie* case of infringement, even though it reserves to itself the right to decide finally on the infringement at the trial (*r*).

But new defendant not bound by proceedings in former action.

Although an interlocutory injunction will, at the suit of a patentee who has established his patent against previous infringers, be granted against a new defendant, the latter is nevertheless not bound at the trial by the previous decisions to which he has been no party, and he is not to be driven to contest the validity of the patent by proceedings for its revocation (*s*).

But injunction may be granted and issue as to novelty directed.

But if, in such a case, the Court is satisfied of the sufficiency of the specification, the utility of the invention, and the fact of infringement, although it may grant an issue as to the novelty of the invention, it will grant an injunction restraining infringement, reserving the further hearing of the cause till after the trial of the issue (*t*).

(*l*) *Boulton* v. *Bull*, 3 Ves. 140.

(*m*) *Collard* v. *Allison*, 4 My. & Cr. 487, 490.

(*n*) *Hill* v. *Thompson*, 3 Mer. 631; *s.c.* 1 Webst. P. C. 235, 238.

(*o*) *Bridson* v. *McAlpine*, 8 Bea. 229.

(*p*) *Betts* v. *Menzies*, cited by Sir W. P. Wood, V.C., in *Penn* v. *Bilby*, L. R. 3 Eq. 308, 312.

(*q*) 12 Bea. 1.

(*r*) *Thorn* v. *Worthing Skating Rink Co.*, 6 Ch. D. 415, n.

(*s*) *Bovill* v. *Goodier* (2), L. R. 2 Eq. 195. See also *Russell* v. *Barnsley*, 1 Webst. 472; *s.c.* 2 Coop. C. C. 58. See, however, *Davenport* v. *Goldbery*, 2 H. & M. 286.

(*t*) *Borill* v. *Goodier*, *ubi sup.*

III. *Where the conduct of the defendant is such as to enable the Court to say that as against him there is no reason to doubt the validity of the patent.*

Licensee cannot dispute patent.

Thus, where a licence is granted by deed, and the deed contains a recital necessarily implying the validity of the letters patent, the licensee is thereby estopped for disputing the patent (*u*). And where the deed merely recited the grant of letters patent, it was held that a plea by an exclusive licensee in an action for royalties that the invention was of no utility and not new could not be sustained, no fraud being alleged, first, because the contract being by deed the failure of consideration was immaterial, and secondly, because it is not competent to a defendant by plea to deny the effect of a deed which he has executed (*x*).

And apart from any question of estoppel by deed, a licensee, during the continuance of the licence, and whilst he is using the patented invention, will not be allowed to dispute the validity of the letters patent (*y*).

Thus, in *Lawes* v. *Purser* (*z*), there was an agreement by the defendants to pay a royalty of 10*d.* per ton in respect of a certain substance manufactured according to the patented invention. The defendants used the invention, and on action by the patentee for the royalty pleaded that the letters patent were void. The plea was overruled, and Lord Campbell, C.J., said: "There having been such an agreement, as stated in the declaration, and permission to use the invention having been enjoyed under it, can it be permitted to the defendants, after such a contract and such acquiescence on their part of the plaintiff's claim, and such enjoyment by them of the invention, to say that they will not pay the stipulated price because the patent is void?" And it was held that the defendants, not denying that they had so used the invention, could not set up this defence.

So also, in *Noton* v. *Brooks* (*a*), a similar defence under similar circumstances was overruled, Sir F. Pollock, C.B., saying: "The defendant agrees to pay the plaintiffs a royalty if they will allow him to use their patent invention, and he does use it; then how can he turn round and say that it is worthless?"

Even when licence is verbal only.

And even when the agreement was only verbal, but the defendant used the invention, and afterwards in a suit for the royalties denied the validity of the patent, it was held by Sir W. P. Wood, V.C., and afterwards by the House of Lords, that this defence was not open to him. Lord Westbury, C., said: "It is an idle distinction that it is attempted to be set up by the respondent that he made an agreement and did not

(*u*) *Bowman* v. *Taylor*, 2 Ad. & E. 278; 1 Webst. 292. See also *Cutler* v. *Bower*, 11 Q. B. 973.

(*x*) *Smith* v. *Scott*, 6 C. B. (N. S.) 771; 5 Jur. (N. S.) 1358. See also *Hall* v. *Conder*, 2 C. B. (N. S.) 22.

(*y*) *Clark* v. *Adie* (No. 2), 2 App. Cas. 423; *Chavasse* v. *Stevens*, W. N. 1874, p. 193.

(*z*) 6 E. & B. 930.

(*a*) 7 H. & N. 499.

take a licence;" and Lord Chelmsford said: "The question is not whether the defendant is at liberty to dispute the right of the plaintiffs to their patent inventions, but whether, being under an agreement to pay royalties for goods manufactured by the plaintiffs' looms, and any other looms embodying their inventions, he is, while that agreement is subsisting, at liberty to use those inventions and to refuse to pay the royalties. I apprehend that he cannot do so. He cannot act under the agreement and at the same time repudiate it. He may, if he pleases, put an end to the agreement, and he may use the machines which he has purchased from the plaintiffs, but he must do so at his peril; he must do so under the liability to be treated as an infringer, and to be subject to an action for damages for that infringement" (*b*).

And the rule applies though patent declared bad in action against third party.

And the above rules will apply as between the plaintiff and the defendant, his licensee, even though subsequently to the commencement of the action the patent has, in another proceeding against a third person, been declared invalid (*c*).

Nor can licensee recover from patentee because patent bad.

And where a licensee had, under an agreement which recited the patent, used the invention and paid royalties, and it having turned out that the patent was void, brought an action to recover from the patentee the amount so paid, it was held that the action must fail; and Heath, J., said: "There never has been a case, and there never will be, in which the plaintiff, having received benefit from a thing which has afterwards been recovered from him, has been allowed to maintain an action for the consideration originally paid" (*d*).

But otherwise if licensee has not used the invention.

But where the defendant had agreed to pay an annuity of 400*l.* a-year as the consideration for using certain patented inventions, but in fact never used them, it was held in an action for payment of the annuity that he could plead the invalidity of one of the patents as a defence to the action. The consideration was entire, and the payment to be made by the defendant was entire. The consideration, by failing partially, failed entirely (*e*).

And in *Hayne* v. *Maltby* (*f*), where there was in an agreement a recital that the plaintiffs were assignees of a patent, and that the defendant had applied to the plaintiffs for permission to use the invention, to which they assented on condition of his working it in the manner described in the specification, and the defendant covenanted not to use any machines except one allowed to him by the agreement, and an action was brought on the agreement alleging two breaches of

(*b*) *Crossley* v. *Dixon*, 10 H. L. C. 293, 308, 310; *Clark* v. *Adie* (No. 2), 2 App. Cas. 423.

(*c*) *Grover and Baker Sewing Machine Co.* v. *Millard*, 8 Jur. (N. S.) 713.

(*d*) *Taylor* v. *Hare*, 1 B. & P. N. R. 260; 1 Webst. P. C. 292. See also *Collinge* v. *Bowman*, 1 Webst. P. C. 295.

(*e*) *Chanter* v. *Leese*, 4 M. & W. 295; 5 M. & W. 698; 1 Webst. P. C. 295.

(*f*) 3 T. R. 438; 1 Webst. P. C. 291.

covenant, one for using patent machines other than that by the agreement allowed, and the other for using machines resembling the patent machines, it was held that the defendant was not estopped from pleading the invalidity of the patent. Upon this case it was observed by Patteson, J., in *Bowman* v. *Taylor* (*g*), that the recital contained no assertion of right in the plaintiffs, except as assignees, and that the case was not properly one of estoppel; and by Lord Cottenham, C., in *Neilson* v. *Fothergill* (*h*), that the case of *Hayne* v. *Maltby* merely amounted to this, that although a party has dealt with a patentee, and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party an opportunity of disputing his right, and that if the defendant successfully dispute his right, notwithstanding he has been dealing under a contract, it is competent to the defendant to do so.

But licensee may dispute the patent when licence determined.

After the determination of a licence the licensee may dispute the validity of the patent as against his licensor (*i*).

And equitable assignees of an exclusive licence, who, having used the invention, disclaimed any further use of it, were, in an action brought to restrain them from selling the patented article otherwise than in conformity with the covenants of the licence, held to be not estopped from disputing the validity of the patent (*k*).

Licensee entitled to have ambit of licence determined.

A licensee, however, is entitled to have it ascertained what is the ambit, what is the field, which is covered by the specification of the patent (*l*).

Others besides licensee may be stopped from disputing patent.

A defendant, though not a licensee, may, by his acts, be prevented from disputing the patent on an application for interlocutory injunction.

Thus, where the patentee had at one time worked his invention in partnership with the defendants under an agreement reciting the patent, and during the subsistence of the partnership the defendants had joined the patentee as co-plaintiffs in suits against various infringers, it was held by Knight Bruce, V.C., that the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing his patent at law (*m*).

And where a patentee had worked his patent in partnership with the plaintiffs, and the partnership was dissolved and the patentee assigned to the plaintiffs all his interest in the patent, it was held that he could not set up the invalidity of the patent in a suit by the plaintiffs to

(*g*) 2 Ad. & E. 278; 1 Webst. 293.

(*h*) 1 Webst. P. C. 290.

(*i*) *Dangerfield* v. *Jones*, 13 L. R. (N. S.) 142; *Axmann* v. *Lund*, L. R. 18 Eq. 330; *Crossley* v. *Dixon*, *ubi sup.*

(*k*) *Pidding* v. *Franks*, 1 Mac. & G. 56.

(*l*) *Per* Lord Cairns, L.C., *Clark* v. *Adie* (No. 2), 2 App. Cas. 426.

(*m*) *Muntz* v. *Grenfell*, 2 Webst. P. C. 88, 91.

restrain infringement by him, and an interlocutory injunction was granted (*n*).

So also a patentee, who had assigned his patent, was not allowed to dispute its validity in an action brought against him by the assignee for infringement (*o*).

Again, where a plaintiff, a patentee, immediately after the grant of his patent and before filing his specification, employed the defendants to manufacture for him, and in course of such manufacture their servants discovered, as he alleged, an improvement which the defendants requested the plaintiff to introduce into his specification, and to allow them, in consideration of the improvement, a share of the profits of the patent, and on the plaintiff's refusal the defendants commenced working the plaintiff's invention, an application that the plaintiff might be ordered to try the validity of the patent at law was refused, and the injunction was granted, Sir J. Stuart, V.C., observing that it was not a mere matter of course because a patent was recent to call upon the patentee to establish his right at law before granting him the relief of an injunction, but it was in the discretion of the Court, according to the nature of the case, and that what had mainly or altogether led to the validity of the plaintiff's patent being disputed was his refusal of the proposition made by the defendants for amalgamation (*p*).

And where the defendant, a foreign manufacturer, had, in a previous action brought against his agent, declined to assist in the defence, and the agent had submitted to an injunction, and the plaintiff had had eight years' undisturbed enjoyment, an injunction was granted until the validity of the patent could be established (*q*).

And a defendant who, having been sued in Scotland in an action which was decided in favour of the validity of the patent, had not raised in that action the defence of want of novelty of the invention, was not allowed to set up this defence in answer to an application in England for an interlocutory injunction to restrain the infringement of the same patent (*r*).

But where proceedings in Chancery had been taken against a defendant, in the course of which the validity of the patent was questioned, and the matter being referred to arbitration, the arbitrator found that the patent was not void or invalid, it was held that in an action at law between the same parties to recover damages for infringement the defendant was not estopped from disputing the validity of the patent (*s*).

(*n*) *Chambers* v. *Crichley*, 33 Beav. 374.

(*o*) *Oldham* v. *Langmead*, cited 3 T. R. 439; *Walton* v. *Lavater*, 8 C. B. (N. S.) 162, 187.

(*p*) *Clark* v. *Ferguson*, 1 Giff. 184. See also *Gardner* v. *Broadbent*, 2 Jur. (N. S.) 1041.

(*q*) *Betts* v. *Menzies*, 3 Jur. (N. S.) 357.

(*r*) *Dudgeon* v. *Thomson*, 30 L. T. (N. S.) 244.

(*s*) *Newall* v. *Elliott*, 1 H. & C. 797.

And in *Axmann* v. *Lund* (*t*), where two persons had in partnership worked for their common benefit a patent belonging to one of them, and had together asserted its validity as against infringers, but having been advised that the specification was bad, had refrained from taking legal proceedings, it was held by Sir R. Malins, V.C., that after the determination of the partnership the other partner was at liberty to dispute the validity of the patent (*u*).

Although one of several partners may be debarred by his acts from disputing the patent, there is no estoppel against the other partners who have not been concerned in such acts, and therefore, where a plaintiff sued two partners for infringement of a patent which had been granted to one partner, and by him assigned to the plaintiff, it was held that, although one partner was estopped, the other partner was at liberty to dispute the validity of the patent (*x*).

Defendant may be estopped on application for interlocutory injunction, though not at the trial.

A defendant may, by his conduct, be estopped from disputing the validity of the patent on an application for an interlocutory injunction where he is not so estopped at the trial. Thus, when the defendants had submitted to an action for infringement, and given judgment and paid costs, it was held by Sir W. P. Wood, V.C., on the hearing of a suit against the same defendants for infringing the same patent, that if the present had been an interlocutory application, plaintiffs would have been entitled to an injunction till the hearing, but that the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred (*y*).

When real doubt as to infringement, injunction refused.

The rules above stated only apply where the sole question between the parties is the validity of the patent (*z*). If there is a real doubt as to whether the patent has been infringed, the interlocutory injunction will be refused.

Thus, where the plaintiffs sued upon certain patents, of one of which there had been ten, and of the others seven and five years' enjoyment, Lord Cottenham, C., refused the injunction entirely on the ground of uncertainty as to the infringement, and, referring to the evidence on this point, which was very conflicting, said: "It would be rash in me if I were to give any opinion coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If, in a question so open to doubt as this, I should interfere with the defendant,

(*t*) L. R. 18 Eq. 330.

(*u*) These circumstances appear to distinguish this case from *Mantz* v. *Grenfell*, *ante*, p. 97, which does not appear to have been cited in *Axmann* v. *Lund*.

(*x*) *Heugh* v. *Chamberlain*, 25 W. R. 742. See also *Goucher* v. *Clayton*, 11 Jur. (N. S.) 107.

(*y*) *Goucher* v. *Clayton*, 11 Jur. (N. S.) 107.

(*z*) *Electric Telegraph Co.* v. *Nott*, 11 Jur. 157; *s.c.* 2 Coop. C. C. 41; *Neilson* v. *Thompson*, 1 Webst. P. C. 277; *Stevens* v. *Keating*, 2 Webst. P. C. 179.

I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected with anything claimed by the plaintiffs. I may not be satisfied that these gentlemen are right or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering" (*a*).

So, where on a patent six years old an *ex parte* injunction had been obtained, and, on a motion to dissolve, the question of infringement was the only question raised, Sir L. Shadwell, V.C., dissolved the injunction, and, after pointing out that the alteration made by the defendants was not merely colourable, but *primâ facie* a decided improvement, said that that was the proper question for a jury to consider (*b*). And in *Muntz* v. *Vivian* (*c*), where the invention was the manufacture, by means of an alloy of zinc and copper in such proportions as will alone effect such purpose, of metal plates which may be rolled into slips at a red heat, and the defendants filed affidavits showing that they rolled cold, the same learned Judge refused an interlocutory injunction.

Where, however, upon the material before it, the Court can come to the conclusion that what is complained of is in substance an invasion of the plaintiff's patent, it will grant an interlocutory injunction, reserving to itself the right of finally deciding the question of infringement at the trial (*d*).

Expressed intention to infringe sufficient to found injunction.

But where there is a deliberate intention expressed and about to be carried into execution to infringe letters patent under the claim of a right to use the invention patented, the plaintiff will be entitled to an injunction without proving actual infringement, provided, of course, that what is threatened to be done would be an infringement (*e*).

And where an action was brought against the master of a ship which was fitted exclusively with pumps which were an infringement of a patent, but the defendant was not a part owner, and had had nothing to do with putting the pumps on board, and they had never been worked in British waters, it was held by the Court of Appeal (*dissentiente* James, L.J.), affirming a decision of Bacon, V.C., that the injunction must be granted on the ground that the master, under the circumstances, must be considered as intending to use the patented invention (*f*).

Evidence should clearly show infringement.

The plaintiff's evidence on an application for an injunction should show distinctly the manner in which the alleged infringement has taken place (*g*).

(*a*) *Electric Telegraph Co.* v. *Nott*, 11 Jur. 157; *s.c.* 2 Coop. C. C. 41.

(*b*) *Morgan* v. *Seward*, 1 Webst. P. C. 168.

(*c*) 2 Webst. P. C. 87.

(*d*) *Thorn* v. *Worthing Skating Rink Co.* 6 Ch. D. 415, 418, n.

(*e*) *Frearson* v. *Loe*, 9 Ch. D. 48, 65.

(*f*) *Adair* v. *Young*, 12 Ch. D. 13.

(*g*) *Hill* v. *Thompson*, 1 Webst. P. C. 231.

Where, under the old practice, the injunction was refused on the ground that the validity of the patent had not yet been established, and the plaintiff was directed to take steps to try the right, the defendant was directed to keep an account of all things made or sold by him according to the patented invention (*h*); and in *Jones* v. *Pearce* (*i*), Sir L. Shadwell, V.C., said that when this course would afford the Court ample means of doing justice to the plaintiff should his right be established, the Court rarely granted the interim injunction, the profits made by the defendant being generally no very inadequate compensation to the plaintiff for the infringement.

Injunction refused, defendant ordered to keep an account.

It appears at one time to have been unusual for the Court, in granting the interlocutory injunction, to require from the plaintiff any undertaking as to indemnifying the defendant in case it should ultimately turn out that the patent is bad, and that the injunction therefore ought not to have been granted (*k*), and there is no doubt of the competency of the Court to grant an interlocutory injunction *simpliciter* (*l*). But this undertaking was required by Sir J. L. Knight Bruce, V.C., in *Muntz* v. *Grenfell* (*m*).

Injunction granted, plaintiff required to give undertaking as to damages.

And it is now settled that the Court will always require it on granting the interlocutory injunction (*n*), and this not merely on *ex parte* applications, but also on injunctions granted upon motion after notice (*o*).

And the undertaking has been required even where the patent had been established in previous suits, and the defendant in the present suit was one of a number of persons who had formed themselves into an association for the purpose of contesting the patent, and who had actually found the funds for defending one of the previous suits in which the plaintiff had obtained a decree in his favour (*p*). So also where issues involving the validity of a patent had been directed in a suit and found in the plaintiff's favour, and the plaintiff applied for an interlocutory injunction, the undertaking as to damages was required, the defendant having offered to keep an account (*q*).

For the form of the undertaking see "Seton on Decrees," 4th ed., p. 171. The ultimate dismissal of the action does not put an end to the undertaking (*r*), but it is doubtful if it can be enforced when the injunction has been wrongly granted owing to a mistake of law by the Judge (*s*).

(*h*) *Hill* v. *Thompson*, 3 Mer. 662; *s.c.* 1 Webst. P. C. 232; *Morgan* v. *Seward*, 1 Webst. P. C. 169; *Neilson* v. *Thompson*, 1 Webst. P. C. 286. For the common form of order, see "Seton on Decrees," 4th ed., p. 344.

(*i*) 2 Coop. C. C. 58.

(*k*) *Bickford* v. *Skewes*, 1 Webst. 214; *Tuck* v. *Silver*, Johnson, 218.

(*l*) *Bacon* v. *Jones*, 4 My. Cr. 436; *Wilson* v. *Tindal*, 1 Webst. P. C. 730.

(*m*) 2 Webst. 91. See the order, 2 Coop. C. C. 59.

(*n*) *Chappell* v. *Davidson*, 8 D. M. G. 1.

(*o*) *Tuck* v. *Silver*, Johns. 218; *Wakefield* v. *Duke of Buccleuch*, 11 Jur. (N. S.) 524; *Graham* v. *Campbell*, 7 Ch. D. 491.

(*p*) *Bovill* v. *Smith*, W. N. 1867, 240.

(*q*) *Renard* v. *Levinstein*, 2 H. & M. 628, 634.

(*r*) *Newby* v. *Harrison*, 3 D. F. G. 287; *Graham* v. *Campbell*, *ubi sup.*

(*s*) *Smith* v. *Day*, 21 Ch. D. 421. *Ex parte Hall*, 23 Ch. D. 644.

Whether questions both as to validity of patent and fact of infringement.

It has been said by Lord Eldon that where there is one question as to whether the patent is valid, and another question whether it has been infringed, the Court would be going a long way if it took upon itself to grant an injunction (*t*). In such cases it depends on the degree of doubt which exists on these questions whether the Court will grant the interim injunction. It will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction (*u*). And in *Plimpton* v. *Malcolmson* (*v*) Sir George Jessel, M.R., said that when it appears that there is a serious question to be tried at the hearing, it is not the course of the Court to grant an injunction on an interlocutory application.

Court considers best mode of keeping things *in statu quo*.

The Court on the interlocutory application avoids as far as possible expressing an opinion on the merits of the case (*x*), and will endeavour to ascertain what is the best method of keeping things *in statu quo*, either by granting an injunction and requiring from the plaintiff the undertaking as to damages, or by refusing the injunction, and requiring the defendant to keep an account (*y*).

Circumstances leading to refusal of injunction.

Where granting the injunction would be extremely prejudicial to the defendant, and do no possible good to the plaintiff, the injunction will be refused (*z*).

Thus, in *Morgan* v. *Seward* (*a*), where a contract had been entered into by defendant, and justice could be done to the plaintiff by directing the defendant to keep an account, the injunction was refused.

Circumstances in favour of injunction.

But in estimating the balance of convenience and inconvenience the Court will consider as a circumstance in favour of an injunction that the defendant's trade is a new trade, and that if the injunction were refused the plaintiff would be driven to commence actions against the purchasers from and customers of the defendant (*b*).

The circumstance that the old practice (*c*) is no longer in force under which, except in special cases, an injunction was not granted until the patent had been established at law, has not altered the practice of the Court in granting interlocutory injunctions, though it may introduce considerations with which the Court must deal on the question whether an injunction ought to be granted or not (*d*). The patentee may, if the injunction be granted, be put upon terms to bring the action to trial as speedily as possible (*e*), and this course was adopted in *Renard* v. *Levinstein* (*f*).

(*t*) *Wood* v. *Cockerell*, 2 Coop. C. C. 58.

(*u*) *Per* Lord Langdale, *Bridson* v. *McAlpine*, 8 Ben. 230.

(*v*) L. R. 20 Eq. 38.

(*x*) *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 38.

(*y*) *Plimpton* v. *Spiller*, 4 Ch. D. 289.

(*z*) *Neilson* v. *Thompson*, 1 Webst. 275, 285.

(*a*) 1 Webst. 169.

(*b*) *Plimpton* v. *Spiller*, 4 Ch. D. 286, 292. See also *Read* v. *Richardson*, 45 L. T. 54, 58.

(*c*) *Bacon* v. *Jones*, 4 My. & Cr. 436; *Jones* v. *Pearce*, 2 Coop. C. C. 58.

(*d*) *Davenport* v. *Jepson*, 4 D. F. J. 440, 445, 446.

(*e*) *Davenport* v. *Jepson*, 4 D. F. J. 448.

(*f*) 10 L. T. (N. S.) 94; *s.c.* on App., *Ibid.* 177.

Under the old practice, if a plaintiff, having been put upon terms to try the action as speedily as possible, was guilty of undue delay, the injunction was dissolved (*g*).

Ex parte injunctions.

Where an injunction is applied for *ex parte* it is incumbent on the party making the application to swear at the time of making it that he is the original inventor, for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous application (*h*).

This rule was recognized by Lord Lyndhurst, C., in *Sturz* v. *De la Rue* (*i*), and though this was an application for an *ex parte* injunction, the words of the judgment are wide enough to include all cases of interlocutory injunction, whether applied for *ex parte* or on notice; and it is remarked by Mr. Hindmarch that the reason for the rule laid down by Lord Eldon in *Hill* v. *Thompson*, as above mentioned, is quite as much applicable to the case of an application after notice as to a motion for an injunction *ex parte*, and that there can be little doubt that the rule was intended to apply to all interlocutory applications for injunction (*k*), and this view appears to be correct (*l*).

The Court expects the utmost good faith from a plaintiff seeking an *ex parte* injunction. The plaintiff must state to the Court all the facts in his knowledge which are material to the question whether the injunction ought to be granted, and it is no excuse for the plaintiff to say that he was not aware of the importance of such facts, and the omission to bring those facts under the notice of the Court when the *ex parte* injunction was obtained is a sufficient ground for dissolving it (*m*).

According to the present practice *ex parte* injunctions are not very frequent. The Court more generally grants an interim order restraining the defendant till after a day named, liberty being given to the plaintiff to serve notice of motion for an injunction for such day. The plaintiff is also required to give an undertaking to abide by the order of the Court as to any damages the defendant may be put to by reason of the interim order, and such other terms are imposed on him as the case may require (*n*).

If two persons have obtained patents for the same invention, the

(*g*) *Stevens* v. *Keating*, 2 Ph. 333; 2 Webst. P. C. 180. See also *Bell* v. *Bell*, 14 Jur. 1129; *Heath* v. *Unwin*, 14 Jur. 1129; *Baker* v. *M'Clellan*, 27 L. J. (N. S.) 57; *Arnold* v. *Thomson*, 9 Jur. (N. S.) 436.

(*h*) *Hill* v. *Thompson*, 3 Mer. 329; *s.c.* 1 Webst. P. C.

(*i*) 5 Russ. 322, 329. See also *Gardner* v. *Broadbent*, 2 Jur. (N. S.) 1041.

(*k*) "Hindmarch on Patents," 334.

(*l*) *Whitton* v. *Jennings*, 1 Dr. & Sm. 110; *Mayer* v. *Spence*, 1 J. & H. 87.

(*m*) *Dalglish* v. *Jarvie*, 2 Mac. & G. 231. See *Curtis* v. *Cutts*, 3 Jur. 34.

(*n*) "Daniell's Chancery Practice," 4th ed., p. 1507.

Court would not interfere between them by interlocutory injunction, but left them to try the legal right by *scire facias* (*o*) (now by petition of revocation, sect. 26).

Application for injunction to be made without delay.

A patentee desiring to obtain an interlocutory injunction must apply to the Court without delay. If the application be *ex parte*, it should be at the earliest possible period, and if upon notice, it should be made early (*p*). If this rule be not complied with, the injunction will be refused. And the rule will be enforced even where there have been previous suits in which the validity of the patent has been established against other defendants. Thus, in *Bridson* v. *Benecke*, cited above, the patent had been established in a previous suit against one McAlpine, but the present bill was not filed till December, although the plaintiff knew of the infringement in January, and gave the defendant notice to desist. Lord Langdale, M.R., refused the injunction, notwithstanding he had a strong impression in favour of the plaintiff's right.

Delay fatal to injunction *even though* patent established in previous actions.

Again, in *Bovill* v. *Crate* (*q*), there had been several previous suits, but the plaintiff having knowledge in August of the defendant's proceedings, and having written in November to complain of the infringement, and being told by the defendant's solicitor in the following April that service of a bill would be accepted on defendant's behalf, did not file a bill till July, the injunction was refused on the ground of delay (*r*).

When delay no bar.

On the other hand, delay was held no bar to an interlocutory injunction where the plaintiff, having established his patent in several previous suits, and there being a combination of persons against him interested in resisting his claims, had not filed bills against the separate members of this combination until he had succeeded in again establishing his patent in a suit against one of them (*s*).

And where the plaintiff, having known of the infringement on the 23rd March, spent some time in making inquiries, on the 8th May gave notice to the defendant to desist, and, after some correspondence, filed his bill on the 7th July, he was held to have come in sufficient time, and the injunction was granted (*t*).

Acquiescence.

Acquiescence by the plaintiff in defendant's proceedings will also defeat the right to an interlocutory injunction. Thus, in *Neilson* v. *Thompson* (*u*), the plaintiff not being himself a manufacturer, and whose practice was not to work the invention himself, but to grant licences under his patent, had permitted the defendants to erect their works on the expectation that they would take a licence to use the invention on the same terms on which other licences had been granted,

(*o*) *Copeland* v. *Webb*, 11 W. R. 134; *s.c.* 1 N. R. 119. See also *Baskett* v. *Cunningham*, 2 Ed. 137.

(*p*) *Bacon* v. *Jones*, 4 My. & Cr. 438; *Bridson* v. *Benecke*, 12 Bea. 1, 3; *Baxter* v. *Coombe*, 1 Ir. Ch. R. 281.

(*q*) L. R. 1 Eq. 388.

(*r*) See also *Smith* v. *London and South-Western Railway Co.*, Macr. P. C. 209; *s.c.* Kay, 417.

(*s*) *Bovill* v. *Smith*, W. N. 1867, 240.

(*t*) *Losh* v. *Hague*, 1 Webst. P. C. 201.

(*u*) 1 Webst. 275, 285.

and had expressed his willingness to grant the defendants a licence on those terms. The defendants began to work the invention without the licence of the plaintiff, but it was held, upon the defendants' undertaking to keep an account and to deal with that account as the Court might direct, that the acquiescence was a bar to an injunction (*x*).

Delay no bar at trial.

At the trial, however, the Court decides on the rights of the parties, and therefore it may be that delay or acquiescence, which would be fatal to an interlocutory application, will not necessarily debar a plaintiff from obtaining an injunction at the trial (*y*). But acquiescence may be a ground for refusing an account of profits (*z*).

INJUNCTION (PERPETUAL).

Perpetual injunction.

If the plaintiff establishes the validity of his patent, and the fact of infringement, he will obtain judgment for a perpetual injunction to restrain infringement, and may also have further relief in the shape of damages or account of profits.

But the Court will not grant such perpetual injunction unless the validity of the patent has been conclusively established (*a*).

Not suspended pending appeal.

Where, after a trial before the Court without a jury the Vice-Chancellor found in favour of a plaintiff and a motion for a new trial was refused by the Vice-Chancellor, and afterwards by the Lord Chancellor, the Court refused to suspend the final order for injunction pending an appeal to the House of Lords (*b*). And a perpetual injunction granted after a trial will not be suspended pending an appeal, merely because the defendants may, by the injunction, be prevented from carrying out contracts already entered into by them to deliver the articles complained of, notwithstanding the defendants may offer to undertake as to damages (*c*).

For forms of orders for interlocutory and perpetual injunctions, and in patent cases, see "Seton on Decrees," 4th ed., pp. 343, 344, 352, and 353, and "Pemberton on Judgments," 3rd ed., pp. 235 and 236.

May by consent be obtained without bringing action to trial.

If a defendant desires to submit to the plaintiff's demands, it is not necessary to bring the action to trial in order to have the injunction made perpetual.

This may be done by motion (*d*), or, since the powers of this section are conferred on "the Court or a Judge," an order for a perpetual injunction may be made in Chambers (*e*), subject to the provisions of Order LIV, Rule 12, and Order LV, Rule 15.

(*x*) *Neilson* v. *Thompson*, 1 Webst. P. C. 287.

(*y*) *Johnson* v. *Wyatt*, 2 D. J. S. 18, 25; *Fullwood* v. *Fullwood*, 9 Ch. D. 176.

(*z*) *Crossley* v. *Beverley*, 1 Webst. 120.

(*a*) See *Hill* v. *Evans*, 4 D. F. J. 288, 289.

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

(*c*) *Flower* v. *Lloyd*, 36 L. T. (N. S.) 445.

(*d*) *Morrell* v. *Pearson*, 12 Ben. 284.

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

Breach of injunction.

It is, of course, open to a person charged with having committed a breach of an injunction restraining infringement of a patent to show that since the injunction the patent has ceased to be in force (*f*).

It seems that if, after an injunction, the defendant has infringed the patent, a contempt of Court has been committed, even though the defendant thought he was not infringing (*g*).

But cases may occur where breach of an injunction may be justified, and may even be a duty. Thus, where an injunction had been granted to restrain the master of a ship from using certain patented pumps with which exclusively the ship was fitted, and the judgment was affirmed by the majority of the Court of Appeal (*dissentiente* James, L.J.), the following remarks were, on a subsequent day, made in reference to this case by the last-named learned Judge: "Whatever appliances there may happen to be on board, however they came there, pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated, it is his (the master's) bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction), *salus navis est suprema lex.* And for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer" (*h*).

On a motion to commit for breach of a perpetual injunction restraining infringement of a patent for skates, the skate now complained of being different from that which was put in evidence at the trial, the Court, being of opinion that the new skate was also an infringement, but not then finally deciding the question, did not make an order for committal, but upon the plaintiff undertaking as to damages, granted an injunction restraining, until further order, the manufacture of the new skate, and this course was approved of by the majority of the Court of Appeal (*i*).

INSPECTION.

The earliest reported patent case in which inspection was ordered is *Brown* v. *Moore* (*k*), which appears (*l*) to be the same as that the judgment in which is reported, under the name of *Bovill* v. *Moore*, in 2 Cooper's Chancery Cases, p. 56. In that case Lord Eldon rests the jurisdiction on the necessity of inspection to enable the Court to have the case properly tried (*m*).

Inspection not a matter of right.

Inspection is not a matter of right, and the Court, before granting it, must be satisfied that there really is a case to be tried at the hearing of the cause.

(*f*) *Daw* v. *Eley*, L. R. 3 Eq. 497.
(*g*) *Plimpton* v. *Spiller*, 4 Ch. D. 288.
(*h*) *Adair* v. *Young*, 12 Ch. 21.
(*i*) *Plimpton* v. *Spiller*, 4 Ch. D. 287.
(*k*) 3 Bligh, 178.
(*l*) See *post*, p. 110.
(*m*) See also *Russell* v. *Cowley*, 1 Webst. 458.

What is required on application for inspection.

In *Piggott* v. *The Anglo-American Telegraph Co.* (*n*), the plaintiffs were owners of a patent for improvements in the mode of generating electric currents, manufacturing submarine telegraph cables, and transmitting signals. The invention was alleged to consist, not in the construction of any particular electric cable, but in the use of a cable in such a manner as that it should always retain a "static charge"; the plaintiffs insisted that the defendants so used their own cable (which was not alleged to be, and was, indeed, proved not to be, similar to the plaintiffs' cable) as to infringe the patent; and having filed a bill for an injunction, they moved for leave to inspect the defendants' mode of working; but Giffard, V.C., being of opinion, upon the specification and evidence, that the plaintiffs' patent was, in fact, only for the construction of a particular cable, and that in that view there could be no question of infringement to try at the hearing, refused the motion.

Inspection must be shown to be of material importance to plaintiff.

Moreover, before making an order for inspection, the Court will require to be satisfied that the inspection is of material importance to the plaintiff's case as made out by his evidence (*o*).

Thus, where in an action for infringing a patent for making cartridges the plaintiff did not allege that he could not make out his case without inspection, and the defendants filed an affidavit stating that they made several improved cartridges, many of which did not in any way resemble the plaintiff's, and stating further their belief that the inspection was not required for the purposes of the action, but for the purposes of copying their improvements, and the plaintiff did not meet this by any evidence, an application to inspect defendants' manufactory was refused (*p*).

And inspection will not be ordered upon an affidavit which simply states that the machine used by the defendants is the same for which the plaintiff has obtained a patent. Such an affidavit is too vague. It ought to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement (*q*). The plaintiff must also show what his own invention is; and an order for inspection was refused when the plaintiff merely stated the commencement of the action but did not disclose his invention, and the defendant stated on oath that he had used no machinery, and only employed the same process as had been used many years before the patent (*r*).

Nor will inspection be granted if the plaintiff has already had in an action against the defendant, which action he had discontinued, an inspection of the machinery complained of (*s*).

But inspection allowed if *primâ facie* case of infringement made out.

Where, however, a *primâ facie* case of infringement is made out

(*n*) 19 L. T. (N. S.) 46.

(*o*) *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. (N. S.) 46.

(*p*) *Batley* v. *Kynock*, L. R. 19 Eq. 91. See also *Amies* v. *Kelsey*, 22 L. J. Q. B. 84; *Meadows* v. *Kirkman*, 29 L. J. Ex. 205.

(*q*) *Shaw* v. *Bank of England*, 22 L. J. (N. S.) Ex. 26

(*r*) *Meadows* v. *Kirkman*, 29 L. J. Ex. 205.

(*s*) *Shaw* v. *Bank of England*, 22 L. J. (N. S.) Ex. 210.

against a defendant, an order for inspection is almost a matter of course (*t*), at all events, when such inspection is essential for the purpose of enabling the plaintiff to prove his case (*u*).

Inspection not allowed so as to be oppressive.

The Court will not, however, permit inspection to be made the means of oppressing a defendant, nor to be carried beyond what is necessary for the purposes of the cause. Thus, where a defendant who was sued for infringing the plaintiff's patent for a sewing-machine, and against whom a *primâ facie* case was made out, objected to an order which the plaintiff sought for inspection of all the sewing-machines of every kind on the defendant's premises, on the ground that such an order would be oppressive, the Court ordered the defendant to verify, on affidavit, the several classes of sewing-machines which he had sold or exposed for sale since the date of plaintiff's patent, and confined the inspection to one of each class (*x*).

And where a plaintiff asked, under the Judicature Rules, Order L, Rule 3 (of which Order L, Rule 3, of the Supreme Court Rules, 1883, is substantially a re-enactment), for an order to inspect defendant's works, and "upon and during such inspection to make such observations *and experiments* as might be necessary and expedient for the purpose of obtaining full information and evidence" as to the mode in which the articles complained of were made by the defendant, the order asked for was made, but with the omission of the words, "and experiments" (*y*).

And an inspection of defendant's books will not be ordered on affidavits which only show the mere possibility of thereby discovering matters advantageous to the plaintiff's case. Thus, where a plaintiff filed affidavits stating that defendants, who were charged with infringing a patent for railway wheels, had kept certain books called the wheel register books, containing particulars as to number, size, &c., of the wheels made by them, but the plaintiff did not show that the wheels mentioned in the books were infringements of the patent, an inspection of the books was refused (*z*).

Trade secrets.

An objection sometimes urged by a defendant, in answer to a motion for inspection, is that the inspection would lead to disclosures of trade secrets. In *Piggott* v. *Anglo-American Telegraph Co.* (*a*) some weight was given to this objection, but there were other reasons above stated for refusing the inspection asked.

But in general this allegation will be insufficient to bar the plaintiff's

(*t*) *Per* Lord Hatherley, *Singer Manufacturing Co.* v. *Wilson*, 13 W. R. 560; *s.c.* 5 N. R. 505.

(*u*) *Battley* v. *Kynock*, L. R. 19 Eq. 90, 92.

(*x*) *Singer Manufacturing Co.* v. *Wilson*, 13 W. R. 560; *s c.* 5 N. R. 505. See the order, "Pemberton on Judgments," 3rd ed., 236.

(*y*) *Flower* v. *Lloyd*, W. N. 1876, 169, 170.

(*z*) *Smith* v. *London and Great Western Railway Co.*, Macr. P. C. 223.

(*a*) 19 L. T. (N. S.) 46, *ubi sup.* See also *Smith* v. *London and Great Western Railway Co.*, *ubi sup.*

right to inspection if he be otherwise entitled thereto. Thus, in *Renard* v. *Levinstein* (*b*), discovery of the defendant's process was resisted on the ground that the plaintiffs would thereby obtain the defendant's secret, and ruin his trade. But Sir W. P. Wood, V.C., ordered the discovery to be given, observing that the Court would, at the proper time, be able to protect the defendant from an improper disclosure of his secret.

And in *Russell* v. *Crichton* (*c*), a Scotch case, inspection of defendant's manufactory was resisted on the ground that his manufacture involved a secret process, the value of which would be lost if inspection were permitted, but the Court said that some mode of inspection must be allowed, otherwise any patent might be infringed with impunity.

The Court will, however, endeavour to prevent the inspection being used to the injury of the defendant. Thus, in *Russell* v. *Crichton*, cited above, the Court of Session, when ordering the inspection, said that all those who were admitted to it must be aware of its being their bounden duty to make no further disclosure afterwards than was required for doing justice in the action.

And in *Flower* v. *Lloyd*, cited above (p. 108), the Court below had, notwithstanding an objection that the plaintiff was a trade competitor with the defendant, ordered that the plaintiff should himself be at liberty to inspect the defendant's works, but when the order came before the Court of Appeal, an arrangement was made that the defendant's works should be inspected by scientific men to be agreed upon, and not by the plaintiff (*d*).

This order is set out in "Seton on Decrees," 4th ed., p. 351, and it is there said that in the order as drawn up the words, "under the obligation of confidence," used by their Lordships, were not inserted; and on mentioning the matter to the Court, their Lordships stated that all they meant was that the inspectors were not to communicate to the plaintiff any special or secret process which the defendant might be using, but were to be at liberty to report to the solicitors whether the process was or was not, in their opinion, an infringement of plaintiff's patents, and state whether it was the ordinary process or not which defendant used. The order for inspection made by the Court of Session in *Russell* v. *Crichton*, cited above, did not contain any direction to the inspectors as to not disclosing the information they might acquire by the inspection. But such a direction may be inserted (*e*).

The inspector may be ordered to report to the Court if the defendant's machines are trade secrets (*f*), and he has been directed to state his opinion whether the defendant's machines are infringements (*g*),

(*b*) 10 L. T. (N. S.) 94.
(*c*) 15 Dec. of the Court of Session, 1st Series, p. 1270.
(*d*) W. N. 1876, 230.
(*e*) See order in *Plating Co.* v. *Farquharson*, Appendix.
(*f*) *Hill* v. *Tombs*, Appendix. See also an order in *Hall* v. *New Sidgwick Company*, M. R. 5 April, 1881.
(*g*) *Hill* v. *Tombs*, Appendix.

but this course has not been followed in later cases, and it is believed that the direction now usually given is, in general terms, that the inspector shall "report to the Court upon the facts, and his opinion founded upon them" (*h*).

What evidence sufficient to found inspection in cases of alleged trade secret.

The case of *Brown* v. *Moore* (*i*) is important as showing what evidence is sufficient to found an application for inspection when the defendant's manufacture is alleged to be a trade secret. In that case the plaintiff was the patentee of a machine for making bobbin net; and, suspecting infringement by the defendant, he bought a piece of his net, which, from certain peculiarities in the work, it was sworn by plaintiff's witnesses must have been manufactured by a frame essentially similar to the plaintiff's; moreover, certain parts of defendant's machine which had been shown to the plaintiff were exactly similar to the latter's patent machine; and a former partner of the defendant had explained to a witness the construction of the defendant's machine, which, according to that description, was exactly like the plaintiff's machine. An *ex parte* injunction having been obtained, a motion to dissolve it was made, but the injunction was continued, the plaintiff being put under terms to bring an action. The action was brough' 'd failed (*j*), partly for want of sufficient proof of the resemblance machines. Thereupon an application was made for an issue a: novelty of the invention. This was refused, but on the plaintiff's undertaking to bring an action against the defendant for infringement, it was ordered (on the undertaking of the defendant) that he should admit on the trial that since the trial of the former action he had made lace with the machines *inspected* by A. Upon these facts the reporter observes that there had been an inspection of defendant's machines, and that he had been informed by the plaintiff's solicitor that such inspection had been made under the order of the Court, but he had been unable to find it in the Registrar's book. He mentions, however, a subsequent order for an inspection of a model of the *plaintiff's* machine.

The report of the case cited in Cooper's Reports as *Bovill* v. *Moore* (*k*) appears, from the dates and other particulars, to refer to the judgment delivered by Lord Eldon on the occasion of the application for the issue, and it would seem most probable that it was on this occasion that the order to which the author of the report in Bligh refers was made. Lord Eldon's judgment, which alone is reported in 2 Cooper, was in the following terms :—

"The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article, and, as the plaintiff alleges, he is making it with a machine constructed on the

(*h*) *Plating Co.* v. *Farquharson*, Appendix.

(*i*) 3 Bligh, 178.

(*j*) This seems to be the action reported as *Bovill* v. *Moore* in Carpmael's Reports, pp. 320, 348.

(*k*) 2 Coop. C. C. 56.

principle of the machine protected by the plaintiff's patent. Now, the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy at present is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that the plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine, and see it work."

Samples allowed to be taken.

The Court, when it orders inspection, will not stop short of what is necessary to make the jurisdiction effectual, and therefore, in a proper case, it would give the plaintiff liberty to take and carry away samples of the article the manufacture of which is complained of.

Thus, in *Russell* v. *Cowley* (*l*) (which, however, appears to have been by consent), the order provided that the viewers should be at liberty to carry away with them any specimen of the tubes operated on by them as they might think proper, in order to their production in Court on the trial of the action. And this precedent was followed by Lord Hatherley, then Vice-Chancellor, in *The Patent Type Founding Co.* v. *Walter* (*m*), where, in a suit to restrain infringement of a patent for making type, the substance of the invention being the use of a large proportion of tin to give greater toughness, for which purpose a mixture of antimony and lead, with little or no tin, had been previously employed, the defendants were ordered to permit inspection of their type, and to deliver a competent part to the plaintiffs (*n*).

And this power to order samples to be taken is now expressly conferred by the Supreme Court Rules, 1883, Order L, Rule 3, cited above.

In *Morgan* v. *Seward* (*o*), a case of a patent relating to paddle-wheels, the defendant having entered into a contract to make certain paddle-wheels which plaintiffs alleged were a violation of their patent, it was ordered that the plaintiffs and their witnesses be at liberty to inspect, at all seasonable times, giving reasonable notice, the paddle-wheels or machinery relating to paddle-wheels made, or to be made, pursuant to the said contract.

Reasonable notice to be given.

The order for inspection usually provides for reasonable notice being given to the parties against whom it is made (*p*), and in the case of

(*l*) 1 Webst. 459.

(*m*) Johnson, 727.

(*n*) See also *Davenport* v. *Jepson*, 1 N. R. 308, where samples of chenille were ordered to be delivered. The orders in both these cases are given in "Pemberton on Judgments," 3rd ed., p. 236.

(*o*) 1 Webst. 169.

(*p*) *Russell* v. *Cowley*, 1 Webst. P. C. 458; *Davenport* v. *Jepson*, "Pemberton on Judgments," 3rd ed., p. 236; *Flower* v. *Lloyd*, "Seton on Decrees," 4th ed., p. 351.

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

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

Inspection by defendant of plaintiff's machines.

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

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

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

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

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

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

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

(*u*) "Pemberton on Judgments," 3rd ed., p. 236; *s.c.* 1 N. R. 308. See also *Russell* v. *Crichton*, 15 Dec. of Court of Session, p. 1270.

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

(*x*) Johnson, 728.

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

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

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

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

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

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

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

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

DISCOVERY.

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

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

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

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

(*d*) Johnson, 728.
(*e*) 4 My. & Cr. 433.
(*f*) Supreme Court Rules, 1883, Ord. L, Rule 3.
(*g*) *Hall* v. *Liardet*, W. N. 1883, 165.
(*h*) *Hall* v. *Liardet* (No. 2), W. N. 1883, 175, corrected *Ibid.* p. 194.
(*i*) Supreme Court Rules 1883, Ord. XXXI, Rules 25 to 27.
(*k*) *Anderson* v. *Bank of British Columbia*, 2 Ch. D. 644; *Saunders* v. *Jones*, 7 Ch. D. 435; *A.G.* v. *Gaskill*, 20 Ch. D. 519.

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

Must answer everything tending to show fact of infringement.

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

Names of customers.

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

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

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

(*n*) *Swinborne* v. *Nelson*, 16 Bea. 416. This decision as to profits is at variance with the decision in *De la Rue* v. *Dickinson*, 3 K. & J. 388, cited below. From statements of counsel in the latter case, it appears that *Swinborne* v. *Nelson* was appealed.

(*o*) *Crossley* v. *Stewart*, 1 N. R. 436; *s.c.* 7 L. T. (N. S.) 868.

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

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

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

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

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

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

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

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

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

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

(*t*) *De la Rue* v. *Dickinson*, 3 K. & J. 388. Compare *Elmer* v. *Creasy*, L. R. 9 Ch. 69, 73; and see now *Parker* v. *Wells*, 18 Ch. D. 477.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Trade secrets.

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

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

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

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

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

Interrogatories as to prior user notwithstanding particulars of objections delivered.

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

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

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

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

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

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

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

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

Limits of the discovery.

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

Interrogatories for examination of plaintiff.

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

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

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

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

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

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

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

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

(*r*) *Daw* v. *Eley*, 2 H. & M. 755.
(*s*) *Daw* v. *Eley*, cited above.
(*t*) *Birch* v. *Mather*, 22 Ch. D. 629.
(*u*) *Hoffmann* v. *Postill*, L. R. 4 Ch. 673. See also *Minet* v. *Morgan*, L. R. 8 Ch. 361, 364; *Commissioners of Sewers* v. *Glasse*, L. R. 15 Eq. 302; *Benbow* v. *Low*, 29 W. R. 265.

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

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

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

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

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

ACCOUNT.

Account in Court of Chancery.

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

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

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

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

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

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

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

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

(*b*) *Smith* v. *London and South-Western Railway*, Macr. P. C. 209; *s.c. Kay*, 417.

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

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

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

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

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

Plaintiff cannot have both account of profits and damages.

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

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

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

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

Extent of account of profits.

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

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

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

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

(*i*) *Per* Lord Westbury, *Neilson* v. *Betts*, L. R. 5 H. L. 1, 22. See also *Watson* v. *Holliday*, 30 W. R. 747.

(*k*) *De Vitre* v. *Betts*, L. R. 6 H. L. 319. See also *Holland* v. *Fox*, 3 E. & B. 977, *Vidi* v. *Smith*, 8 E. & B. 969, as to the practice of Courts of Common Law under the corresponding section of the Act of 1852.

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

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

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

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

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

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

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

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

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

Plaintiff not entitled to account of his own loss.

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

Inspection not ordered as taking account.

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

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

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

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

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

(*r*) 15 & 16 Vict. c. 83, s. 42.

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

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

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

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

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

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

But interrogatories may be ordered.

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

And books may be produced and administered.

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

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

Where plaintiff did not surcharge defendant to extent of one-sixth, plaintiff ordered to pay costs of inquiry.

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

Delay in suing may affect account of profits.

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

Account of profits in trade mark cases.

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

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

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

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

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

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

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

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

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

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

Same rule does not apply in patent cases.

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

Damages, form of inquiry.

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

Assessment of damages.

Where licence granted.

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

Where no licence.

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

Plaintiff cannot claim manufacturing profit and royalty.

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

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

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

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

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

(*l*) *Davenport* v. *Rylands*, L. R. 1 Eq. 304.

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

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

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

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

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

Defendant's profit not necessarily measure of plaintiff's loss.

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

Plaintiff may charge more to infringers than others.

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

Effect of former verdict against patent in reduction of damages.

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

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

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

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

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

Annoyance and vexation to plaintiff not taken into account.

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

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

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

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

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

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

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs charges and expenses as between

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

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

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

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

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

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

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

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

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

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

Certificate not granted if verdict by consent.

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

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

May now be given by Court of Appeal.

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

Section applies only to second action for infringement.

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

(*d*) 1 C. & K. 99.
(*e*) *Gillet* v. *Wilby*, 1 Webst. 270; s.c. 9 C. & P. 334.
(*f*) *Otto* v. *Linford*, Appendix, *post*.
(*g*) Judicature Act, 1873, s. 39.
(*h*) *Penn* v. *Bibby*, L. R. 3 Eq. 308.

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

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

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

But Court has discretion.

Refused if first action collusive.

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

Or not conclusive.

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

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

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

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

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

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

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

Remedy in case of groundless threats of legal proceedings.

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

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

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

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

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

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

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

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

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

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

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

(*q*) 19 Ch. D. 386, affirming decision of Jessel, M.R., 15 Ch. D. 514.
(*r*) L. R. 4 Q. B. 730.
(*s*) 19 Ch. D. 388.
(*t*) See Judgment of Baggallay, L.J., 19 Ch. D. 390.
(*u*) *Dicks* v. *Brooks*, 15 Ch. D. 22. See Judgment of Bramwell, L.J., pp. 39, 40.
(*x*) L. R. 13 Eq. 355.
(*y*) L. R. 18 Eq. 335.

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

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

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

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

These rules, it is presumed, will still apply.

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

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

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

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

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

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

(*c*) *Burnett* v. *Tak*, cited above; and see *Anderson* v. *Liebig's Extract of Meat Co.*, 45 L. T. (N. S.) 757, 759.

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

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

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

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

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

Miscellaneous.

Patent for one invention only.

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

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

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

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

Patent on application of representative of deceased inventor.

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.

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

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

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

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

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

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

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

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

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

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

Assignment for particular places.

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

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

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

Loss or destruction of patent.

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

(*i*) 3 Ex. D. 203.
(*k*) *Re Vincent's Patent*, L. R. 2 Ch. 341.
(*l*) *Bovill* v. *Finch*, L. R. 5 C. P. 533. See *post*, sect. 110.

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

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

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

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

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

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

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

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

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

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

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

(*o*) 4 My. & Cr. 511.

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

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

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

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

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

(*u*) *Re Adamson's Patent*, 6 De G. M. & G. 420; *s.c.* 25 L. J. Ch. 456.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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.

(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.

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 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 connection with the manufacture or prepara-

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

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

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

Assignment to Secretary for War of certain 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 (hereinafter referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

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

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

(*d*) 9 Ha. 415.

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

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

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

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

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

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

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

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

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

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

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

Existing Patents.

Provisions respecting existing patents.

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

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

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

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

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

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

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

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

Fees on existing patents.

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

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

Pending applications for disclaimer or extension would seem to be

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

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

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

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

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

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

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

Under that section it was held:—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(*o*) *Ibid.* 512.

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

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

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

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

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

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

Definitions.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention:

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

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

In Scotland "injunction" means "interdict."

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

PART III.

DESIGNS.

Registration of Designs.

Application for registration of designs.

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

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

(*s*) *Newton's Patent*, 15 Moo. P. C. 176; *Hill's Patent*, 1 Moo. P. C. C. (N. S.) 258; *Normand's Patent*, L. R. 3 P. C. C. 193.

(*t*) *Winan's Patent*, L. R. 4 P. C. C. 93; *Blake's Patent*, L. R. 4 P. C. C. 535.

(*u*) *Wallington* v. *Dale*, 7 Ex. 888.

(*v*) *Spilsbury* v. *Clough*, 1 Webst. 255.

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

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

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

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

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

(α) Designs Rules, 1883, *post*, r. 4.
(β) *Ibid.* r. 12; all communications may be signed by agents, r. 6.
(γ) *Ibid.* r. 9, and Form E, First Schedule to Designs Rules, *post*.
(δ) *Ibid.* r. 5 (for the classes see Third Schedule to Designs Rules, *post*).
(ε) *Ibid.* rr. 16–20.

(1.)

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

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

Definition of design.

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

(*w*) 24 & 25 Vict. c. 73, s. 1.
(*x*) 5 Jur. (N. S.) 1219; *s.c.* 4 H. & N. 815.

Combination designs.

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

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

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

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

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

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

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

And something novel must be introduced into the combination.

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

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

Article in two parts may be registered.

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

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

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

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

(*b*) *Ibid.*

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

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

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

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

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

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

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

Question of originality is for jury, and is matter of eyesight.

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

No analogy between patents and designs.

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

Novelty distinct from publication.

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

What is publication.

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

(2.)

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

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

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

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

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

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

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

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

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

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

(3), (4.)

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

(7.)

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

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

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

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

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

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

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

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

(1.)

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

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

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

(*s*) 21 & 22 Vict. c. 70, s. 5. In *Norton* v. *Nicholls*, 4 K. & J. 475, Wood, V.C., held that the registration of a specimen was registration of a copy within the 5 & 6 Vict. c. 100, s. 15, contrary to the opinion of the Court of Queen's Bench in the same case, 5 Jur. (N. S.) 1203.

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

(*u*) *Ibid.*

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

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

Certificate of registration.

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

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

See *post*, sect. 96.

Copyright in Registered Designs.

Copyright on registration.

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.

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

(1.)

"*Copyright*" is defined *post*, sect. 60.

(2.)

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

"*Shall cease.*" See *post*, sect. 51.

Marking registered designs.

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

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

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

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

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

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

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

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

Inspection of registered designs.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Information as to existence of copyright.

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

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

Cesser of copyright in certain events.

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.

Register of Designs.

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*).

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

(*a*) Designs Rules, 1883, rr. 21–28.

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

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

Fees.

Fees on registration, &c.

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

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

Industrial and International Exhibitions (a).

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

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

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

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

Legal Proceedings.

Penalty on piracy of registered design.

58. During the existence of copyright in any design—

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

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

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

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

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

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

Distinction between the manufacturer and retailer.

See also sect. 59.

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

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

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

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

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

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

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

(*h*) *Barran* v. *Lomas*, 28 W. R. 973. See also *Barran* v. *Lomas*, 28 W. R. 975.

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

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

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

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

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

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

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

Action for damages.

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

See sect. 58.

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

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

(*n*) *McCrea* v. *Holdsworth*, 2 De G. & Sm. 499; *s.c.* 12 Jur. 820. See the form of the decree also in "Pemberton on Judgments," 3rd ed., p. 231. See also *Crossley* v. *Beverley*, 1 Webst. 119, a patent case.

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

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

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

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

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

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

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

Definitions.

Definition of "design," "copyright."

60. In and for the purposes of this Act—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

See also sect. 58, *ante*.

Definition of proprietor.

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

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

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

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

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

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

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

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

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

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

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application for registration.

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

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

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

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

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

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

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

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

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

(γ) *Ibid.* rr. 13, 14.

(δ) *Ibid.* rr. 20–24.

(ε) *Ibid.* rr. 23, 44.

(1.)

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

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

(2.)

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

(4.)

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

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

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

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

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

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

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

(5.)

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

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

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

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 of the applicant, the application shall be deemed to be abandoned.

Conditions of registration of trade mark.

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

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

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

(*c.*) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

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

(*i*) 26 W. R. 261.

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

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

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

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

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

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

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

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

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

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

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

(2.)

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

(*m*) 8 Ch. D. 798.
(*n*) 4 App. Cas. 484.
(*o*) Trade Mark Rules, Aug. 1876, Rule 59.
(*p*) See also *Re Dugdale's* Application, 49 L. J. (N. S.) Ch. 303.
(*q*) *Ex parte Stephens*, 3 Ch. D. 659.
(*r*) *Re Maignan*, 28 W. R. 759.

(3.)

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

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

And see under sect. 73, *post*.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Representative registration.

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

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

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

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

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

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

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

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

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

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

Connection of trade mark with goods.

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

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

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.

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

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

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 (*a*).

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

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

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

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

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

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

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

Advertisement of application.

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

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

Opposition to registration.

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

(2.) Within two months after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

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

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

(*a*) Trade Marks Rules, 1883, *post*, Form J.

(*β*) *Ibid.* r. 29.

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

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

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

(4.)

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

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

Assignment and transmission of trade mark.

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

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

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

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

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 (*a*).

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

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

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

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

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

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

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

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

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

Restrictions on registration.

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

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

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

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

Subdivision of classes: "three mark" rule.

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

(*f*) *In re Powell, In re Pratt*, Seb. Dig., p. 357.
(*g*) *Benbow* v. *Low*, 29 W. R. 837.
(*h*) 2 J. & H. 139.
(*i*) *Re Dugdale's Application*, 49 L. J. (N. S.) Ch. 303.
(*j*) *Ex parte Barrow & Co.*, W. N. 1877, 119; *Re Jelley, Son, & Jones*, 51 L. J. (N. S.) Ch. 639, n.
(*k*) *Re Walkden Ærated Waters Co.*, Seb. Dig., p. 332; *Re Jelley, Son, & Jones*, 51 L. J. (N. S.) Ch. 639, n.
(*l*) *Re Hargreaves*, 11 Ch. D. 669.
(*m*) *Re F. Braby & Co.*, 21 Ch. D. 223; *s.c.* 51 L. J. (N. S.) 637; *Ex parte Barrow & Co.*, W. N. 1877, 119.
(*n*) *Re Jelley, Son, & Jones*, 51 L. J. (N. S.) Ch. 639, n.

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

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

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

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

(2.)

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

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

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

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

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

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

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

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

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

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

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

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

Further restriction on registration.

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

See also *post*, sect. 86.

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

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

As to fraudulent representation in the mark itself—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Of such are :—

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

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

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

Of these there are two classes :—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

(3.)

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

Effect of Registration.

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

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

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

76. The registration of a person as proprietor of a trade mark shall be *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. Right of first proprietor to exclusive use of trade mark.

Under the corresponding section of the Act of 1875 (*i*), it was held that a mark which is not a trade mark, and which therefore ought not to be registered, does not acquire the character of a trade mark by being on the register for five years, and may be removed from the register (*k*), and it would seem, though the point has not been decided, that a person sued for using a name which has been on the register for five years may defend himself on the ground that it is not a trade mark (*l*).

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment Restrictions on actions for infringement, and on defence to action in certain cases.

(*g*) *Re Jelley, Son, & Jones*, 51 L. J., Ch. (N. S.) 640, n.

(*h*) *Per* Lord Blackburn, *Orr Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 496.

(*i*) Sect. 3.

(*k*) *Re Palmer's Application*, 21 Ch. D. 48.

(*l*) "Sebastian on Trade Marks," p. 33; "Bryce on the Trade Marks Registration Acts, 1875 and 1876," p. 3, commented on by Jessel, M.R., in *Re Palmer's Application*, *ubi sup.*

repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request (*a*), and on payment of the prescribed fee, grant a certificate that such registration has been refused.

(*a*) See Trade Marks Rules, 1883, *post*, Form L.

This section differs considerably from the corresponding sections of the Acts of 1875 and 1876 (*m*). By those sections registration was required as a preliminary to suing only in cases of trade marks *as defined by the Act*, and as to *any device, mark, name, combination of words, or other matter or thing in use as a trade mark before the passing of the principal Act* (*n*), it was sufficient to obtain a certificate that registration had been refused. The result of these sections was that if the proprietor of a trade mark in use before the passing of the principal Act had been refused registration, he might, notwithstanding such refusal, institute proceedings either for prevention of, or damages for, the infringement of such trade mark, and need not wait till he had got the register rectified (*o*).

In the present section registration as a preliminary to suing is required in all cases of trade marks *capable of being registered under this Act*, while a certificate of refusal of registration is sufficient only in cases of "*any* OTHER *trade mark in use before the* 13*th August*, 1875."

If the words, "trade mark capable of being registered," are to be read as meaning the same thing as "defined by the Act," that is to say, trade marks consisting of or containing the essential particulars mentioned in sect. 64 (1) (*a*), (*b*), (*c*), with or without the additions referred to in sub-sect. (2), then the law as to suing has not been altered, but if (which it is submitted is the proper construction) they are to be taken to mean trade marks which can be put on the register, then they will include not merely all marks, whether new or old, within sect. 64 (1) and (2), but also all old marks which, under the authority given by sect. 64 (3), are allowed to be registered, and a certificate of refusal of registration will be sufficient only in the case of actions brought for infringement of *other trade marks in use, &c.*, that is, old marks which, though in use as trade marks before the 13th August, 1875, are not permitted to be registered, such, for instance, as the single letter in the case of *Re Mitchell's Trade Mark* (*p*) under the Act of 1875.

As to marks in this position, the owner, on obtaining a certificate that

(*m*) 38 & 39 Vict. c. 91, s. 1; 39 & 40 Vict. c. 33, s. 1.

(*n*) 13 Aug., 1875.

(*o*) *Per* Lord Blackburn, *Orr Ewing v. Registrar of Trade Marks*, 4 App. Cas. 498.

(*p*) 7 Ch. D. 36.

the registration has been refused, is in the same situation for suing for the protection of his trade mark as if the Act had not passed (*q*).

But there are two other cases to which the section does not appear to apply, viz. :—

(*α.*) New trade marks within the definition of sect. 64, sub-sect. (3), not capable of registration as new marks, but which, if old, could have been registered under that sub-section.

(*β.*) Names, whether new or old, which are "so appropriated by user as to come to mean the goods of a particular person, though 'the name' is not, and never was, impressed on the goods or on the packages in which they are contained, so as to be a trade mark properly so called, or within" the Trade Marks Registration Acts (*r*).

The principles on which the Court acts in preventing a man from passing off his goods as those of another have not been altered by the Trade Marks Registration Act (*s*), and therefore relief may still be had in classes (*α*) and (*β*) mentioned above, in cases where relief would have been given before the Acts. The principles referred to are thus laid down by Lord Kingsdown (*t*): "The fundamental rule is that one man has no right to put off his goods for sale as the goods of a rival trader, and he cannot therefore (in the language of Lord Langdale in *Perry* v. *Truefitt* (*u*)), 'be allowed to use names, marks, letters, or other *indicia* by which he may induce purchasers to believe that the goods which he is selling are the manufacture of another person.'" And again, in *The Singer Manufacturing Co.* v. *Loog* (*x*), Lord Blackburn said : "The original foundation of the whole law is this, that when one knowing that goods are not made by a particular trader sells them as and for the goods of that trader, he does that which injures that trader. At first it was put upon the ground that he did so when he sold inferior goods as and for the trader's ; but it is established alike at law, *Blofeld* v. *Payne* (*y*), and in equity, *Edelsten* v. *Edelsten* (*z*), that it is an actionable injury to pass off goods known not to be the plaintiff's as and for the plaintiff's, even though not inferior."

Upon these principles it was held that a question of alleged infringement of a trade mark registered as a white selvage could not be decided without considering whether the alleged infringement (which, in fact, was dark grey) was not according to the custom of the trade a white selvage, and if it was, then whether the differences in quality and position of the threads in the defendant's selvage were sufficient to dis-

(*q*) *Per* Malins, V.C., *Re Barrow's Trade Marks*, 5 Ch. D. 359.

(*r*) See *Singer Manufacturing Co.* v. *Loog*, Judgment of Lord Blackburn, 8 App. Cas. 32.

(*s*) *Mitchell* v. *Henry*, 15 Ch. D. 181.

(*t*) *Leather Cloth Co. (Limited)* v. *American Leather Cloth Co.*, 11 H. L. C. 538, cited with approval by Lord Blackburn, *Johnston* v. *Orr Ewing*, 7 App. Cas. 228.

(*u*) 6 Bea. 66, 73.

(*x*) 8 App. Cas. 15, 29.

(*y*) 4 B. & Ad. 410.

(*z*) 1 D. J. S. 185.

tinguish the defendant's goods from those of the plaintiff so as to prevent purchasers from being misled (*a*).

Notwithstanding the registration of a trade mark, the Court may, it is presumed, still act on the principles laid down before the passing of the Registration Acts, and refuse to extend its protection "to persons whose case is not founded in truth" (*b*).

Cases of false representation in the trade mark itself have been already dealt with under sect. 73. But the trade itself may be fraudulent, and in such a case the Court of Equity has been accustomed not to interfere (*c*).

Thus, in *Pidding* v. *How*, cited above, the plaintiff, a tea-dealer, who sold under the name of "Howqua's Mixture" a mixed tea composed of different kinds of teas, sought to restrain the defendant from selling teas under the same name and in packages with labels resembling the plaintiff's. The plaintiff, however, had stated in his labels and advertisements that the mixture was made by one *Howqua*, a celebrated Canton merchant, and was purchased from him and imported into this country in the packages in which it was sold, and that the tea which gave it its peculiar flavour was rare in China, and could not be procured in England. All these statements were proved to be untrue, and on that ground Vice-Chancellor Shadwell, although satisfied that the defendant's proceedings were improper, refused to interfere by injunction until the plaintiff had established his right at law.

So also in the case of *Perry* v. *Truefitt* (*d*), the plaintiff, a maker of a preparation which he called "Medicated Mexican Balm," sought to restrain the sale by a rival trader of a different preparation under the same name. The plaintiff's advertisement, however, having stated his preparation to have been "made from an original recipe of the learned J. F. Blumenbach, and recently presented to the proprietor by a very near relative of that illustrious physiologist," whereas, in fact, he had purchased the preparation from one Leathart; an injunction was refused, but the motion was ordered to stand to the hearing, with liberty for the plaintiff to bring an action at law (*e*).

But a merely collateral misrepresentation by the owner of the trade mark, as, for instance, a statement in invoices and a few advertisements that he was a patentee when he was not (*f*), or a statement, contrary to the fact, that he was a professor (*g*), was insufficient to disentitle the plaintiff to relief, either at law or in equity.

(*a*) *Mitchell* v. *Henry*, 15 Ch. D. 181.

(*b*) *Pidding* v. *How*, 8 Sim. 480.

(*c*) Nor apparently could the plaintiff have succeeded at law. See Judgment of Mellish, L.J., *Ford* v. *Foster*, L. R. 7 Ch. 630.

(*d*) 6 Bea. 66.

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

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

(*g*) *Holloway* v. *Holloway*, 13 Bea. 209.

The questions arising on the use of the word "patent" have been already considered under sect. 73.

The last part of the marginal heading to the section is an error.

If a trade mark consist of a device in combination with a word which, being merely descriptive, could not by itself be registered, the mark will only be infringed if the device itself is encroached upon (*h*).

Register of Trade Marks.

Register of trade marks.

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

(*a*) See Trade Marks Rules, 1883, rr. 30–48.

See sect. 81 as to the "Sheffield Register" for the registration of cutlery marks in applications by applicants in Hallamshire, or within 6 miles thereof. See also sect. 87.

Removal of trade mark after fourteen years unless fee paid.

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.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade mark from the register accept the said fee

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

as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the five years next after the date of such removal, be deemed to be a trade mark which is already registered (*a*).

(*a*) Trade Marks Rules, 1883, r. 48.

Substantially a re-enactment of Rules 29 to 32 of the Trade Marks Rules of March 1883.

Fees.

Fees for registration, &c.

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

(*a*) Trade Marks Rules, 1883, First Schedule, *post*.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company), and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that Company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875.

(3.) An application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company (*a*):

(4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court.

(6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if

the application had been made to the comptroller on that day:

(7.) The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register (β); and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register:

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks:

(12.) Any person aggrieved by a decision of the Cutlers'

Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm reverse or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court (γ):

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.

(α) Trade Marks Rules, 1883, rr. 53–56.
(β) *Ibid.* r. 56.
(γ) *Ibid.* Form W.

These provisions differ considerably from the corresponding provisions in the Act of 1875.

A list and short abstract of the Cutlers' Companies Acts is given in "Sebastian on Trade Marks," Appendix D.

When the Cutlers' Company opposed the registration of a trade mark for cutlery for three classes of goods on the ground that it so nearly resembled a Sheffield corporate mark previously assigned to another manufacturer of cutlery, and still used by him, as to be calculated to deceive, and in the Court of Appeal succeeded as to two of the classes, but abandoned their opposition as to the third class, it was held that applicant must pay the costs of the appeal, but that no costs of the motion in the Court below could be given (*i*).

(7.)

As to the assignment of a corporate trade mark granted by the Cutlers' Company, see *Bury* v. *Bedford* (*k*).

PART V.

GENERAL.

Patent Office and Proceedings thereat.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, Patent Office.

(i) *Re Rising*, Seb. Dig., p. 379.
(k) 4 De G. J. & S. 352. See also *In re Rabone Brothers*, Seb. Dig., p. 395.

which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3.) The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

See *ante*, sect. 12 (2).

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

The Patent Office has hitherto registered deeds of trust relating to patents (*l*). As regards trade marks, this section is an enactment of Rule 22 of the Rules of August 1876, re-enacted in Rule 23 of the Rules of March 1883.

(*l*) Johnson's "Patentees' Manual," 4th ed., p. 221.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality. Refusal to grant patent, &c., in certain cases.

The comptroller will also decline to register as part of any trade mark the Royal arms, or arms so nearly resembling them as to be calculated to deceive, or the words "Registered," "Registered Design," "Copyright," "Entered at Stationers' Hall," "To counterfeit this is Forgery," "Patent," "Patented," or, except as old marks or parts of old marks, representations of the Queen or Royal Family, or of the Crown or national arms or flags, or prize or exhibition medals (*m*).

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be (*a*). The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property. Entry of assignments and transmissions in registers.

(*a*) See Patents Rules, 1883, rr. 65–70; Designs Rules, rr. 22–28; Trade Marks Rules, 1883, rr. 34–39; *post*.

PATENTS.

"*Assignments.*" See sect. 36. The right of assignment depends on the words of the patent itself (*n*), and in the form in the First Schedule (*post*, p. 203) the grant is to the "patentee," which word, by a previous recital, is made to include his assigns.

A patentee may assign a distinct and separate part (*o*), or an undivided share (*p*) of a patent, and the assignee, whether of the entirety, or of a part or share, takes the legal interest, and is not to be considered merely as a licensee (*q*).

(*m*) See p. 334, *post*.
(*n*) "Hindmarch on Patents," p. 234.
(*o*) *Dunncliff* v. *Mallet*, 7 C. B. (N. S.) 209.
(*p*) *Walton* v. *Lavater*, 8 C. B. (N. S.) 162.
(*q*) *Per* Erle, C.J., *Walton* v *Lavater*, *Ibid.* p. 184.

An agreement by a vendor of a patent to assign to a purchaser all future patent rights which the vendor may hereafter acquire of a like nature to the patent sold is not void as against public policy (*r*).

The law as to the rights of co-owners of a patent is thus laid down by Lindley, L.J. (*s*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement, and can also work the patent himself and give licences (*t*) to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences."

Where two persons entered into a partnership for working a patent belonging to one, it was held by Bacon, V.C., that the patent was an asset of the partnership, and that neither partner could assign it without the other, but that both had a licence to work the invention, and when they separated each could work it on his own account (*u*).

By the Act of 1852 (*x*) a "register of proprietors" was required to be kept at the Great Seal Patent Office, in which an entry of all assignment of letters patent, or of any interest or share, is to be made, and all licences, &c., and it was provided that until such entry should have been made, the grantee of the letters patent should be deemed the sole proprietor thereof.

Under this section it was held, in *Chollet* v. *Hoffman* (*y*) that an assignee could not sue until his assignment had been registered, otherwise, as the Statute provides that before such registry the original patentee shall be deemed the sole owner, a defendant would be liable to be sued at one and the same time by the grantee and assignee of the letters patent. The reasoning in this case appears equally to apply to the present section, and it would seem that under this present Act, as under the Act of 1852, registration of the assignment is necessary to enable an assignee to maintain an action for infringement.

The case of *Chollet* v. *Hoffman* was, however, a case of litigation between the assignee of a patent and third parties. As between the assignor and assignee the rule was held not to apply, and an assignee might maintain a suit against the assignor and licensees from the assignor subsequent to and with notice of the assignment, although the assignment has not been registered (*z*).

It was not decided whether and how far the registration of an assigment related back. In *Chollet* v. *Hoffman* the Court expressly

(*r*) *Printing and Numerical Registering Co.* v. *Sampson*, L. R. 19 Eq. 462. See also *Leather Cloth Co.* v. *Lorsont*, L. R. 9 Eq. 345.

(*s*) "Lindley on Partnership," 4th ed., pp. 68, 69, citing *Dunnicliff* v. *Mallet*, 7 C. B. (N. S.) 209; *Walton* v. *Lavater*, 8 C. B. (N. S.) 162; *Mathers* v. *Green*, L. R. 1 Ch. 29. See also *Hancock* v. *Bewley*, Johns. 601.

(*t*) See, however, *Powell* v. *Head*, 12 Ch. D. 686, 690; and see p. 184, *post*.

(*u*) *Kenny's Patent Button-Hooking Co.* v. *Somervill*, 26 W. R. 787.

(*x*) 15 & 16 Vict. c. 83, s. 35.

(*y*) 7 E. & B. 636.

(*z*) *Hassall* v. *Wright*, L. R. 10 Eq. 510.

refused to decide the point, but in *Hassall* v. *Wright* it seems to have been the opinion of Sir Richard Malins, V.C., though it was not necessary actually to decide the point, that registration under the Act of 1852 related back to the date of the assignment, and that an assignee whose assignment was registered might maintain a suit to restrain infringement instituted after the date of the assignment and before registration.

An assignment by executors of a patentee made after probate but before the probate was registered, the assignment itself being registered after the registration of the probate, gave under the Act of 1852 a valid title to the assignee to sue (*a*).

Upon the bankruptcy of a patentee letters patent which have been granted to him will vest in the trustee (*b*), and he may therefore maintain a suit to restrain infringement committed before the bankruptcy, but it is presumed that the title of the trustee must be registered.

Letters patent granted to any person vest on his death in his executor or administrator (*c*), who may sue in respect of an infringement committed during the life of the patentee (*d*), the probate of the will being previously registered in the Great Seal Patent Office. See also sect. 34.

The register will apparently be conclusive as between persons interested in the patent and third parties, who, it would seem, may safely, in the absence of notice of other claims, deal with the persons appearing on the register.

DESIGNS.

Under the Act of 1843 it was held that a partial assignment of or a licence to use a design must be in writing, and could only be made by a registered proprietor (*e*). See now notes under Designs Rules, 1883, *post*, r. 22.

A design devolves on the executor of the proprietor (*f*).

In *Powell* v. *Head* (*g*) it was held by Jessel, M.R., that one part owner of the copyright of a dramatic entertainment could not grant a licence for its representation without the consent of all the other owners. This decision was grounded on the provision of the 3 & 4 Wm. 4, c. 15, forbidding representation except with the consent of the "author or other proprietor," which words, by the effect of sect. 4 of the same Statute, meant "authors or other proprietors." On similar grounds it would seem that since sect. 58 of the present Act requires the consent of the registered proprietor to the use of a registered design, and by 13 & 14 Vict. c. 21, s. 4, words in an Act of Parliament importing

(*a*) *Ellwood* v. *Christy*, 17 C. B. (N. S.) 754; 10 Jur. (N. S.) 1079.

(*b*) *Hesse* v. *Stevenson*, 3 Bos. & P. 565; *Bloxam* v. *Elsee*, 6 B. & C. 169; *s.c.* 9 Dowl. & R. 215.

(*c*) "Williams on Executors," 8th ed., vol. i, p. 824. See also Form D, *post*, p. 203.

(*d*) "Hindmarch on Patents," p. 252.

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

(*f*) *Jewitt* v. *Eckhardt*, *ubi sup.*, p. 409, and see s. 61.

(*g*) 12 Ch. D. 686.

the singular include the plural, the consent of all the registered proprietors is necessary, and that one of several registered co-owners cannot alone grant a licence for the use of a design.

Similar reasoning seems to show that whatever may have been the law hitherto, a valid licence for the use of an invention comprised in a joint patent can only be made with the concurrence of all the grantees whose names appear on the Register of Patents.

TRADE MARKS.

As to assignment of trade marks, see sect. 70.

Where two persons who carried on distinct trades at different places of business had derived from a common predecessor in the respective businesses the right to use one and the same particular name as a trade mark, each was held entitled separately to sue to restrain infringement (*h*).

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee (*a*).

(*a*) Patents Rules, 1883, r. 75; Marks Rules, 1883, r. 49; *post*. Designs Rules, 1883, r. 33; Trade

This section must be read (so far as it relates to the register of designs) as subject to the provisions of sects. 52 and 53.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents specifications disclaimers and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

A re-enactment, with alterations, of 16 & 17 Vict. c. 115, s. 4. By that Act the sealed copies were receivable in evidence in all proceedings relating to letters patent for inventions. The present section is general, and applies to all proceedings.

Rectification of registers by Court.

90. (1.) The Court may (*a*) on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such

(*h*) *Dent* v. *Turpin*, 2 J. & H. 139.

register, make such order for making expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

(a) Trade Marks Rules, 1883, *post*, rr. 44–48. The comptroller may publish, at the expense of the applicant, any order made under this section, r. 47.

This section combines the provisions of the Act of 1852, sect. 38, and the Act of 1875, sect. 5, and makes these provisions applicable to all the subjects of this Act. "Making" an entry is an addition to the old powers as to patents.

In a trade mark case it was held under the Act of 1875 that the powers of rectification of the register are only exerciseable in cases of mistake or error in the registration, and not where there is a mere devolution of interest (*i*). In such a case the proceeding should be under sect. 87, *ante*.

(1.)

PATENTS.

(See Patents Rules, 1883, *post*, r. 71.)

Under the corresponding section of the Act of 1852 (*j*), by which the jurisdiction was given to the Master of the Rolls alone, it was held that any entry fraudulently made on the register could be expunged, and that any facts relating to the proprietorship could be entered, but not the legal inferences from those facts (*k*).

Thus, where a patentee, having assigned his patent to persons who omitted to register the assignment, afterwards assigned the patent to his father, which assignment was registered at once, the Master of the Rolls ordered the entry of the latter assignment to be expunged (*l*). In this case it appears from the subsequent case of *Re Morey's Patent* (*m*) that there was evidence that the second assignment was clearly fraudulent.

And so also an entry made by one of two joint patentees of a deed whereby he assigned his share of the patent, and purported to release

(*i*) *Re Ward, Sturt, and Sharp's Trade Marks*, 29 W. R. 395.
(*j*) Sect. 38.
(*k*) *Re Morey's Patent*, 25 Bea. 581.
(*l*) *Re Green's Patent*, 24 Bea. 145.
(*m*) 25 Bea. 584.

his assignee from all claims by himself and his co-patentee, was expunged at the instance of the latter (*n*).

But where a patentee assigned half his patent to A., and afterwards assigned the whole to B. by a deed reciting that he had already granted a licence to A., and B.'s assignment was first registered, Lord Romilly, M.R., although holding that B. had on the face of the deed notice of A.'s right, would not (there being no other evidence of notice) enter a statement to that effect on the register, but ordered an entry to be made that the licence referred to in the assignment to B. was the deed of assignment to A. (*o*).

And where a deed is perfectly good and *bonâ fide*, it would seem that no entry could be made on the register qualifying its effect or giving it a construction (*p*).

In *Re Horsley and Knighton's Patent*, cited above, it was contended that the entry ought not to be expunged, as so far as the entry stated the deed to be an assignment it was correct. But Lord Romilly, M.R., held that, as he could not alter the deed, the only course was to strike out the whole entry.

In *Re Berdan's Patent* (*q*) it was held that the Master of the Rolls, as Keeper of the Records, had power to order a disclaimer which had been filed without the consent of the patentee to be taken off the file. This jurisdiction would seem to be strictly within the present section, "amendments" being entered in the register of patents (see sect. 23).

Orders made by the Master of the Rolls under the Act of 1852, sect. 38, were not, prior to the Judicature Acts, subject to Appeal (*r*), but by those Acts the jurisdiction was transferred to the High Court of Justice, and could be appealed like any order of the Court (*s*).

TRADE MARKS.

If a mark which is common to the trade, or which contains words or devices common to the trade, has got on the register, it may, on the application of other persons in the same trade, be removed (*t*), or a note may be added that a particular word (*u*), or particular words and devices (*x*) in the mark is common to the trade, or that a particular device in the mark is not claimed *per se*, but only in combination (*y*). This, however, will not be done in the absence of the registered owner without his consent (*z*). And see now sect. 74 (*ante*, p. 170).

Although an application to register a mark has been duly advertised,

(*n*) *Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*o*) *Re Morey's Patent*, 25 Bea. 581.

(*p*) *Per* Lord Romilly, M.R., *Re Morey's Patent*, 25 Bea. 584.

(*q*) L. R. 20 Eq. 347.

(*r*) *Re Horsley and Knighton's Patent*, L. R. 4 Ch. 784.

(*s*) *Re Morgan's Patent*, 24 W. R. 245; *Re Myers' Patent*, W. N. 1882 53, 56.

(*t*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 724; *In re Palmer's Trade Mark*, 24 Ch. D. 504; *Leonard* v. *Wells*, W. N. 1884. 5.

(*u*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

(*x*) *Re Leonardt*, Seb. Dig p. 373.

(*y*) *Re Kuhn & Co.*, Seb. Dig. p. 390.

(*z*) *Re Mitchell's Trade Mark*, W. N. 1878, 101.

a person who has not seen the advertisement, and who desires to rectify the register in respect of that mark, is not prejudiced by delay if he come to the Court with due diligence after the fact has come to his knowledge (*a*), but the delay must be accounted for (*b*).

Where a person has registered in his own name the trade mark of another person without the knowledge or consent of the true proprietor, the register of trade marks cannot be rectified by transferring the registration into the name of the true proprietor. The false entry will be expunged, and the true owner must apply in the usual way to register the mark (*c*).

Where a trade mark belonging to a firm has, on an application by one of the partners described as trading under the firm's name, been registered in the name of that partner, the register may be rectified by cancelling the name of that partner as registered proprietor, and inserting the names of all the partners trading under the firm's name (*d*). But this could not be done where the registration had been applied for and obtained through a mistake of the firm in the sole name of one of the partners, without any mention of the firm's right to the mark. In such a case the proper course was, under the old practice, for the registered partner to assign the trade mark to the firm (*e*).

Under the corresponding section of the Act of 1875 (*f*) it was held that the application should be by motion, of which two clear days' notice should be given, and that an affidavit of the applicant verifying his case would be all the evidence that was required (*g*).

"Person aggrieved."

Any dealer who has used a particular word in connection with or as descriptive of the article in which he deals is a "person aggrieved" by the entry of such a word on the register (*h*). But a foreigner not using or intending to use the mark in this country is not such a person (*i*).

COSTS.

Patents.—In *Re Green's Patent* (*ante*, p. 185) the original assignor and the second assignee, and in *Re Horsley and Knighton's Patent* the persons who put the wrong entry on the registry, were ordered to pay the costs of rectifying the register, but in *Re Morey's Patent* the order was made without costs.

Trade Marks.—Where a trade mark which had, in fact, been common to the trade, and had been registered as an old mark by a firm of traders, and it was shown that they had known of the user by other firms for above six years before registration, they were ordered to

(*a*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 726.

(*b*) *Ransome* v. *Graham*, 51 L. J. (N. S.) Ch. 903.

(*c*) *Ex parte Lawrence Brothers*, 29 W. R. 392.

(*d*) *Re Rust & Co.'s Trade Mark*, 29 W. R. 393.

(*e*) *Re Farina's Trade Mark*, 29 W. R. 391.

(*f*) 38 & 39 Vict. c. 91, s. 5.

(*g*) *Ex parte Stephens*, W. N. 1876, 202.

(*h*) *Rose* v. *Evans*, 48 L. J. Ch. 618; *In re Ralph's Trade Mark*, 32 W. R. 168, 49 L. T. (N. S.) 504.

(*i*) *Re Riviere's Trade Mark*, 49 L. T. (N. S.) 507.

pay the costs of a successful application for its removal from the register (*j*), and it was held that it was no objection to the allowance of the costs that the applicants, who had not seen the advertisements in the "Trade Marks Journal," had not opposed the registration (*k*), nor in a similar case that the applicants had not informed the person on the register of their intention to take action (*l*).

But if a mark has actually become common by being copied without the owner's permission, and is then registered by the original owner, it may be that the costs of an application to remove it will not be given (*m*).

Where on an opposition to registration of a trade mark in different classes the applicant succeeds as to some and fails as to others, no costs are given on either side (*n*). But an unsuccessful opponent must pay the costs, even though the opposition is by a public body in the public interest (*o*). And an application to rectify the register which fails will be dismissed with costs, including the costs of the registrar (*p*).

Under the Trade Marks Act, 1875, it was held that an applicant who, on the registrar objecting to register a particular mark, succeeded against the registrar on the matter being referred to the Court, must nevertheless pay the registrar's costs, there being no fund out of which the registrar could be paid (*q*).

And this was the case where the registrar appeared and did not oppose (*r*). But the costs thus to be paid were confined to the costs of proceedings in Court, and the applicant could not be ordered to pay the costs in the registrar's office (*s*). This distinction proceeded on the words of the Judicature Rules, 1875, Order LV, which provided that the costs of proceedings in the High Court should be in the discretion of the Court. The present section, it will be observed, is very wide, and gives the Court full jurisdiction over all the costs of the proceedings.

(2.)

See *Re Salamon* (*t*), where an action was directed.

The provision as to damages is new.

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee,—

(*a.*) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark (*a*); or

(*b.*) Correct any clerical error in the name style or address

(*j*) *Re Hyde & Co.'s Trade Mark*, 7 Ch. D. 725. See also *Re Kuhn & Co.*, Seb. Dig. p. 390.

(*k*) *Re Hyde & Co.'s Trade Mark*, *ubi sup.*

(*l*) *Re Kuhn & Co.*, Seb. Dig., p. 390.

(*m*) *Re Kuhn & Co.*, *ubi sup.*

(*n*) *Re Jelley, Son, and Jones*, 51 L. J. (N. S.) Ch. 639; Seb. Dig., p. 377; *Re Rosing*, Seb. Dig., p. 379.

(*o*) *Re Rosing*, *ubi sup.*

(*p*) *Re Riviere's Trade Mark*, W. N. 1883, 212.

(*q*) *Re Maignan*, 28 W. R. 759; *Rotherham's Trade Mark*, 14 Ch. D. 585.

(*r*) *Re Orr Ewing*, W. N. 1880. 24.

(*s*) *Re Braudreth's Trade Mark*, 9 Ch. D. 619; *Re Hargreaves*, 11 Ch. D. 675.

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

of the registered proprietor of a patent, design, or trade mark (β).

(c.) Cancel the entry or part of the entry of a trade mark on the register (γ): Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

(α) (β) Patents Rules, 1883, *post*, Form P; Designs Rules, 1883, *post*, Form M; Trade Marks Rules, 1883, *post*, r. 46 and Forms M and Q, In the case of designs and trade marks the Rules include amendment of drawings.

(γ) Trade Marks Rules, 1883, *post*, Forms O and P.

(a.) All documents for the amending which no special provision is made by the Act may be amended if and on such terms as the comptroller may think fit (Patents Rules, 1883, r. 18). This will include clerical errors in a specification, and apparently, whether provisional or complete (*Ibid.* Form P). See also Designs Rules, 1883, r. 30; Trade Marks Rules, 1883, r. 51.

(c.) If more than mere cancellation is required, the application must be made to the Court under sect. 92.

Under the old Act a mark might be struck out of the register on the application of the registered proprietor (u).

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 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, r. 48, Form N.

Substantially a re-enactment of Rules 34 and 35 of the Rules of March 1883.

Certain additions to the mark may be made by the comptroller under sect. 74, *ante*. But as to cases not within that section, and also, it would seem, where the comptroller refuses to make the addition asked, the applicant may proceed under this present section.

(u) *Ex parte Sales, Pollard, & Co.*, Seb. Dig., p. 378.

Under the Act of 1875 leave was given on the application of the registered proprietor to alter the mark by substituting in it a new for an existing word, denoting the address of the proprietor (*v*), and to rectify the register by limiting the registration to particular goods (*x*).

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

A re-enactment in substance of sect. 37 of the Act of 1852.

That section, however, only related to patents, but the present section applies to every register kept under this Act.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent (*a*).

(*a*) See Patents Rules, 1883, rr. 13–15; Trade Marks Rules, 1883, rr. 11–13; Designs Rules, 1883, rr. 17–19, *post*.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate (*a*) purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

(*a*) Patents Rules, 1883, *post*, Second Schedule, Form Q; Designs Rules, 1883, *post*, r. 34, Form J; Trade Marks Rules, 1883, *post*, r. 57, Form U.

A re-enactment of sect. 8 of the Act of 1875, making its provisions generally applicable to this Act.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorized or required to be left made or given at the

(*v*) *Ex parte Walker & Co.*, Seb. Dig., p. 381.

(*x*) *Re Lysaght*, Seb. Dig., p. 381.

Patent Office or to the comptroller, or to any other person under this Act (*a*), may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

(*a*) Or under the Rules, see Patents Rules, 1883, *post*, r. 19; Designs Rules, 1883, *post*, r. 12; Trade Marks Rules, 1883, r. 16.

Where a witness produced a copy of a letter which he said was made by him, and swore that he should, in the ordinary course of business, have posted the original, it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence (*y*).

Provision as to days for leaving documents at office.

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.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circum-

(*y*) *Trotter* v. *Maclean*, 13 Ch. D. 574.

stances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Taken from Rule 67 of the Trade Mark Rules of March 1883.

Transmission of certified printed copies of 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.

A re-enactment, with modifications, of 16 & 17 Vict. c. 115, s. 5.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

101. (1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a.*) For regulating the practice of registration under this Act (*a*):

(*b.*) For classifying goods for the purposes of designs and trade marks:

(*c.*) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(*d.*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents:

(*e.*) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other documents in the Patent

Office; and providing for the inspection of indexes and abridgments and other documents:

(*f.*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(*g.*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid (*β*).

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

(*α*) Patents Rules, 1883, Designs Rules, 1883, and Trade Marks Rules, 1883, *post*.

(*β*) This has been done as to certain Forms in the Schedule to the Act. See the various Rules, *post*.

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.

Provision for colonies and India.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(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.

This section is based on sect. 7 of the Act of 1835 (*z*) as to patents, and sect. 11 of the Act of 1843 as to designs. As to trade marks, see also the Merchandise Marks Act, 1862 (*a*).

As to false representation of a design as being registered, see *Barley* v. *Walford* (*b*).

The section does not apply to cases of false representation of an expired patent as being still subsisting, such as in *Cheavin* v. *Walker* (*c*), cited *ante*.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland; Ireland; &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the

(*z*) See *Myers* v. *Baker*, 3 H. & N. 802.
(*a*) 25 & 26 Vict. c. 88.
(*b*) 9 Q. B. 197.
(*c*) 5 Ch. D. 863.

instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

See *ante*, sect. 26.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only. **Reservation of remedies in Ireland.**

A re-enactment of the last clause of sect. 29 of the Act of 1852.

Before that Act it was the practice to grant separate patents for the three kingdoms, and under that practice it was held in *Brown* v. *Annandale* (*d*) that the public use of an invention in England prior to the date of letters patent for Scotland invalidated the letters patent.

Upon this case it is observed by Mr. Webster (*e*) that neither in *Roebuck's* nor in *Brown's Case* was the grantee of the letters patent the true and first inventor in England, and he suggests that the decision would not be held to apply to a case in which the true and first inventor in one part of the realm was the grantee of the letters patent in the other part; and this view was followed in *Magill* v. *Ewing* (*f*), where it was held by the Lord Chancellor of Ireland that where an inventor who had obtained letters patent in England subsequently obtained letters patent in Ireland for the same invention, the Irish patent was not invalid by reason of prior publication in England.

In *Bovill* v. *Finch* (*g*) it was held under the Act of 1852 and the amending Act of 1853 (*h*) that a prolongation patent, which, by those Acts, was under the Great Seal of the United Kingdom, was to be considered as granting three separate prolongations of three distinct patents, and that although the prolongation might be invalid as to one grant (the Scotch) by reason of the want of novelty in Scotland at the time of the original patent, it might be good as to the English and Irish grants. The Court did not, however, decide what would be the effect of want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal, which has been the case with all patents since 1852, and is continued by the present Act. See *ante*, sect. 36.

(*d*) 1 Webst. 433, following *Roebuck* v. *Stirling*, 1 Webst. 45. See also *Re Pow's Patent*, 2 Webst. 5; *s.c.* under name *Robinson's Patent*, 5 Moo. P. C. 65.

(*e*) 1 Webst. 454, *n.*

(*f*) 11 Ir. Jur. (N. S.) 104.

(*g*) L. R. 5 C. P. 523.

(*h*) 15 & 16 Vict. c. 83; 16 & 17 Vict. c. 115.

A strict construction of this section might lead to the conclusion that the patent can only be revoked as regards Ireland by an Irish Court. But such a construction cannot, it is submitted, be correct, since it is inconsistent with the general power given in sect. 26 (2), which is unlimited, and moreover would make it possible that there should at the same time be a patent in force in one branch of the United Kingdom while revoked in another, which, having regard to sect. 16, can hardly have been intended. It would appear, therefore, that the present section must be construed to relate only to patents which have never been revoked by any of the Courts mentioned in sect. 111 as included in the word "Court" where used in the Act.

General saving for jurisdiction of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the 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 these Courts;

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings.

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 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.

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 (*a*) altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

(*a*) Patents Rules, 1883, r. 78; Marks Rules, 1883, r. 60; *post.* Designs Rules, 1883, r. 37; Trade

Saving for prerogative.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

A re-enactment of part of sect. 16 of the Act of 1852.

The grant of a patent is discretionary in the Crown, and may be stopped at any stage of the proceedings (*i*).

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law Officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or

(*i*) "Hindmarch on Patents," p. 17.

of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

THE FIRST SCHEDULE.

Forms of Application, &c.

FORM A. (*k*)

Form of Application for Patent.

Section 5.

£1 Stamp.

(*a*) Here insert name, address and calling of inventor.

(*b*) Here insert title of invention.

I, (*a*) *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do solemnly and sincerely declare that I am in possession of an invention for (*b*) "*Improvements in Sewing Machines*"; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*c*) Signature of inventor.

(*c*) *John Smith.*

Declared at *Birmingham*, in the county of *Warwick*, this _____day of_____18___.

Before me,

(*d*) Signature and title of the officer before whom the declaration is made.

(*d*) *James Adams,*
Justice of the Peace.

Note.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted; and the declaration must be made before a British Consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

FORM B. (*k*)

Form of Provisional Specification.

Improvements in Sewing Machines. (*a*)

(*a*) Hereinsert title as in declaration.

(*b*) Here insert name, address, and calling of inventor as in declaration.

I, (*b*) *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do hereby declare the nature

(*k*) See note (*l*) p. 203.

of my invention for "*Improvements in Sewing Machines*," to be as follows (*c*) :—

* * * * *

(*d*) *John Smith.*

Dated this_____day of_____18___.

(*c*) Here insert short description of invention.
(*d*) Signature of inventor.

NOTE.—No stamp is required on this document.

FORM C. (*l*)

£3 Stamp.

FORM OF COMPLETE SPECIFICATION.

Improvements in Sewing Machines. (*a*)

I, (*b*) *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do hereby declare the nature of my invention for "*Improvements in Sewing Machines*," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (*c*) :—

* * * * *

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is (*d*).

1.
2.
3, &c.

(*c*) *John Smith.*

Dated this_____day of_____18___.

(*a*) Here insert title, as in declaration.
(*b*) Here insert name, address, and calling of inventor, as in declaration.
(*c*) Here insert full description of invention.
(*d*) Here state distinctly the features of novelty claimed.
(*e*) Signature of inventor.

FORM D.

Section 33.

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 decla-

(*l*) For this and Forms A and B, are now substituted Forms A, A1, B, and C in the Second Schedule to the Patents Rules, 1883, *post*, see r. 5.

ration represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

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

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the

same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted, shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the

advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this_____ one thousand eight hundred and_____and to be sealed as of the_____one thousand eight hundred and_____

(Seal of Patent Office.)

Section 47.

FORM E. (*m*)

FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

_____day of_____18___.

You are hereby requested to register the accompanying _____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 and address of the individual or firm.

Statement of nature of Design . . . . . .

Registration Fees enclosed £ „ *s.*

To the Comptroller,
Patent Office, 25, *Southampton Buildings,*
Chancery Lane, W.C.

(Signed) . . . . . .

(*m*) See now the Form E in the Second Schedule to the Designs Rules, 1883, *post*.

Section 62.

FORM F. (*n*)

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

[NOTE.—Each side of this square in the Schedule to the Act is 4 inches in length.]

(One representation to be fixed within this square, and two others on separate sheets of foolscap of same size.)

(Representations of a larger size may be folded, but must be mounted upon linen and affixed hereto.)

You are hereby requested to register the accompanying trade mark, [*In Class —Iron in bars, sheets, and plates; in Class —Steam engines and boilers; and in Class —Warming Apparatus*], in the name of (*a*)_____, who claims to be the proprietor thereof.

(a) Here insert legibly the name, address, and business of the individual or firm.

Registration Fees enclosed £ „ *s.*

To the Comptroller,
Patent Office, 25, *Southampton Buildings*,
Chancery Lane, W.C.

(Signed)_____

NOTE.—If the trade mark has been in use before August 13, 1875, state length of user.

(*n*) For this Form is now substituted Form F in the Second Schedule to the Trade Marks Rules, 1883, *post*, see r. 4.

THE SECOND SCHEDULE.

Fees on Instruments for obtaining Patents, and Renewal.

(a.) Up to sealing.

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification	3	0	0			
				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

THE THIRD SCHEDULE.

Enactments Repealed.

21 James 1, c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vict. c. 69. (*a*) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70. [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.

(*a*) NOTE.—Sections 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the Schedule the words and figures. "Certificate of the registration of a design .. £5 0 0 And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

PATENTS RULES, 1883.

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

Short Title.

1. These Rules may be cited as the Patents Rules, 1883. Short title.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of December 1883. Commencement.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Act shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned Act, in addition to the fees mentioned in the Second Schedule thereto, so far as it relates to patents, shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

Forms.

5. The Forms A, B, and C in the First Schedule to the said Act shall be altered or amended by the substitution 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.

See a list of these Forms, *post*, p. 230.

General.

Hours of business. 7. The Patent Office shall be open to the public every week-day during the hours of ten and four, except on the days and times following:—

Christmas Day.
Good Friday.
The day observed as Her Majesty's birthday.
The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency. 8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller and all attendances by the applicant upon the Comptroller may be made by or through an agent duly authorized to the satisfaction of the Comptroller, and if he so require resident in the United Kingdom.

Statement of address. 9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this Rule be in the United Kingdom.

Size, &c. of documents. 10. All documents and copies of documents sent to or left at the Patent Office or otherwise furnished to the Comptroller or to the Board of Trade shall be written or printed in large and legible characters in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand

part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

Exercise of discretionary power by Comptroller.

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

Notice of hearing.

Notice by applicant.

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.

See Form E, *post*, p. 236.

Comptroller may require statement, &c.

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.

Decision to be notified to parties.

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.

Definition of "applicant."

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.

Prior and second applicant may attend hearing

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.

Industrial or International Exhibitions.

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.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

See Form O, *post*, p. 247.

Power of amendment, &c.

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

This rule includes apparently amendment of clerical errors in a specification (Second Schedule, Form P, *post*, p. 248). These errors, which hitherto could be corrected only on application to the Master of the Rolls (*ante*, p. 23), are not mentioned in sect. 91 (*ante*, p. 188); but the rule appears to be within the powers of sect. 101 (1, *c*), *ante*, p. 193, and by that section has the force of an Act of Parliament.

Documents by post.

19. Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

Affidavits.

20. Affidavits may, except where otherwise prescribed by these Rules, be used as evidence in any proceedings

thereunder when sworn to in any of the following ways, viz.:—

(1.) In the United Kingdom before any person authorized to administer oaths in the Supreme Court of Judicature or before a justice of the peace for the county or place where it is sworn or made.

(2.) In any place in the British dominions out of the United Kingdom before any Court, Judge, or Justice of the Peace or any person authorized to administer oaths there in any Court.

(3.) In any place out of the British dominions before a British Minister, or person exercising the functions of a British Minister, or a British Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a Judge or magistrate.

Statutory declarations.

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).

Application with Provisional or Complete Specification.

Order of recording applications.

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.

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.

Application for separate patents by way of amendment.

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.

Every such application shall bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Act and by these Rules as if every such application had been originally made on that date for one invention only.

Application by representative of deceased inventor.

24. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative.

Notice and advertisement of acceptance.

25. On the acceptance of an application with a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Inspection on acceptance of complete specification.

26. Upon the publication of such advertisement of acceptance in the case of an application with a complete specification the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

Application on communication from Abroad.

Communication from abroad.

27. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the Second Schedule hereto.

Sizes and Methods of preparing Drawings accompanying Provisional or Complete Specifications.

Size of drawings.

28. The drawings accompanying provisional or complete specifications shall be made upon half-sheets or sheets of imperial drawing paper, to be within a border line of 19 inches by 12 inches, or 27 inches by 19 inches, with a margin of half an inch all round.

29. A copy of the drawings will be required upon *rolled* imperial drawing paper or upon thin Bristol board of the same dimensions as the original drawing or drawings. All the lines must be absolutely black, Indian ink of the best quality to be used, and the same strength or colour of the ink maintained throughout the drawing. Any shading must be in lines clearly and distinctly drawn and as open as is consistent with the required effect. Section lines should not be too closely drawn. No colour must be used for any purpose upon the copy of the drawings. All letters and figures of reference must be bold and distinct. The border line should be one fine line only. The drawings must not be folded, but must be delivered at the Patent Office either in a perfectly flat state or rolled upon a roller so as to be free from creases or breaks.* Copies of drawings.

30. Where a complete specification is left at the Patent Office after a provisional specification has been accepted the complete specification and drawing or drawings accompanying the same, as well as the copy thereof, must be prepared in accordance with Rules 10, 28, and 29.

Illustrated Journal.

31. Every applicant for the grant of a patent shall, in addition to the drawings to be furnished with his complete specification, furnish the Comptroller with a drawing illustrative of the feature or features of novelty constituting his invention. Such drawing must be prepared in the manner prescribed for the copy of the original drawing or drawings accompanying the specification, but must not cover a space exceeding 16 square inches. The drawing must be accompanied by a concise explanatory statement on foolscap paper and legibly written or printed. Additional drawing to be furnished.

This provision is new, and if enforced is likely to throw a considerable burden of trouble and expense on the patentee.

* As the drawings accompanying the provisional and complete specification respectively are copied at the Patent Office for publication by the process of photo-lithography, this rule must be strictly observed in order that correct copies may be made.

Opposition to Grants of Patents.

Notice of opposition.

32. A notice of opposition to the grant of a patent shall state the ground or grounds on which the person giving such notice (herein-after called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

See Form D, *post*, p. 235.

Copy for applicant.

33. On receipt of such notice a copy thereof shall be furnished by the Comptroller to the applicant.

If the applicant desires to be heard on the opposition, he must send the Comptroller the application Form E, *post*, p. 236.

Particulars of prior patent.

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

Opponent's evidence.

35. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent shall leave at the Patent Office statutory declarations in support of his opposition, and deliver to the applicant a list thereof.

Applicant's evidence.

36. Within 14 days from the delivery of such list the applicant shell 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

Evidence in reply.

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.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

Closing of evidence.

37. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application made to him for that purpose.

38. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

39. On the completion of the evidence the Comptroller shall appoint a time for the hearing of the case, and shall give to the parties seven days' notice at the least of such appointment. Notice of hearing.

40. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the title, number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition. Disallowance of opposition in certain cases.

41. The decision of the Comptroller in the case shall be notified by him to the parties. Decision to be notified to parties.

Certificates of Payment or Renewal.

42. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to make the prescribed payment for keeping the same in force, he shall seven days at least before such expiration give notice to the Comptroller of such intention, and shall, before the expiration of such fourth or eighth year, as the case may be, leave at the Patent Office a form of certificate of payment, duly stamped, subject as herein-after provided, with the prescribed fee of 50*l.* or 100*l.*, as the case may be. Payment of fees of 50*l.* and 100*l.* for continuance of patent.

See Form J, *post*, p. 242.

43. In the case of patents granted before the commencement of the said Act, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year." As to patents granted before commencement of Act.

44. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l.* and 100*l.*, he shall seven Payment of annual fees in lieu of 50*l.* and 100*l.*

days at least before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, give notice to the Comptroller of such intention, and shall, before the expiration of such respective periods as aforesaid, leave at the Patent Office a form of certificate of payment, duly stamped with the fee prescribed to be paid at such periods respectively.

See Form J, *post*, p. 242.

Certificate of payment.

45. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall give to the patentee a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

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

See Form K, *post*, p. 243.

In other cases.

47. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Amendment of Specification.

Request for leave to amend.

Advertisement.

48. A request for leave to amend a specification shall be signed by the applicant or patentee and accompanied by a copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in

such other manner (if any) as the Comptroller may in each case direct.

See Form F, *post*, p. 237.

Notice of opposition.

49. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (herein-after called the opponent) intends to oppose the amendment, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

See Form G, *post*, p. 238.

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 (herein-after called the applicant).

If the applicant or patentee desires to be heard on his application or on the opposition, he must send the Comptroller an application Form E, *post*, p. 236.

Opponent's evidence.

51. Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent shall leave at the Patent Office statutory declarations in support of his opposition and deliver to the applicant a list thereof.

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 may direct.

Compulsory Licences.

Petition for compulsory grant of licences.

57. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

See Form H1, *post*, p. 240.

To be left with evidence at Patent Office.

58. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

See Form H, *post*, p. 239.

Directions as to further proceedings unless petition refused.

59. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the Comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

60. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Petitioner's evidence.

61. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner. Patentee's evidence.

62. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the petitioner; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply. Evidence in reply.

63. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition. Further proceedings.

The provisions as to compulsory licences are new. They do not apply to patents granted before the commencement of the Act, or on applications then pending. (Sect. 44 (9), *ante*, p. 137.)

Neither the Act nor the Rules contain any provision as to costs, which, if the application be unfounded, may be a serious burden to the patentee.

The Act gives no appeal from the decision of the Board of Trade. But by sect. 22 (*ante*, p. 29) the order of the Board of Trade for a compulsory licence may be enforced by mandamus. A writ of mandamus is, however, a prerogative writ, and not a writ of right, and it is in this sense in the discretion of the Court whether it shall be granted or not. The Court may refuse to grant the writ, not only upon the merits, but upon some delay or other matter personal to the party applying for it (*o*), or possibly on matters connected with the conduct of the parties (*p*). The writ may also be refused where it is inequitable to grant it (*q*), and it was refused where performance of an order of the Board of Trade, which the applicant sought to enforce, was shown to be impossible owing to want of funds (*r*). It would seem, therefore, that where a compulsory licence has been ordered, the patentee may, on the application for a mandamus, obtain a review of the decision of the

(*o*) *R.* v. *Churchwardens of All Saints', Wigan*, 1 App. Cas. 611; Judgment of Lord Chelmsford, p. 621.

(*p*) *Ibid.* p. 622; Judgment of Lord Hatherley.

(*q*) *R.* v. *Garland*, L. R. 5 Q. B. 269.

(*r*) *Re The British and North Somerset Railway Co.*, 3 Q. B. D. 11.

Board of Trade. Where, however, the compulsory licence has been refused by the Board of Trade, the applicant has no remedy.

Register of Patents.

Entry of grant.

64. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

65. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

See Form L, *post*, p. 244.

Reading this Rule (which has the force of an Act of Parliament—see sect. 101 (3), *ante*, p. 193) in connection with sects. 23 and 87 (*ante*, pp. 30, 181), it would seem that the registration of assignments is now made compulsory, in order to their validity, not merely as against third parties, but also as between the parties themselves (*s*). A similar observation occurs as to licences. See Rule 74, *post*.

Signature of request.

66. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized in like manner.

Particulars to be stated in request.

67. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons

(*s*) For the law under the Act of 1852, see *ante*, pp. 181–183, 185, 186; and *Hassall* v. *Wright*, L. R. 10 Eq. 510.

to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

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 section 90 of the said Act or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.

"*Where an order*," &c., "*for extension of patent*." See Form S, *post*, p. 251.

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 fees.

73. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licences.

74. An examined copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

See Form M, *post*, p. 245.

"*Shall be left.*" From this it would appear that the registration of licences is compulsory. See *ante*, under Rule 65.

Hours of inspection of register.

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

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

(*b.*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office ;

(*c.*) Times when the register is required for any purpose of official use.

Certified copies of documents.

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

Power to dispense with Evidence, &c.

77. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any

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

Repeal.

78. All general rules made by the Lord Chancellor, or by 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. Repeal.

Dated the 21st day of December 1883.

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

FIRST SCHEDULE.

LIST OF FEES PAYABLE ON AND IN CONNEXION WITH LETTERS PATENT

	Up to Sealing.			£	s.	d.
1.	On application for provisional protection	£ 1	0	0		
2.	On filing complete specification . .	3	0	0 (*t*)		
					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 licence. By person applying				5	0	0
13.	On opposition to grant of compulsory licence. By patentee				5	0	0
14.	On certificate of renewal :— Before end of 4 years from date of patent . .				50	0	0
15.	Before end of 7 years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of 8 years from date of patent				100	0	0
	or in lieu of the fees of 50*l.* and 100*l.*, the following annual fees:—						

(*t*) These payments are in lieu of the fees under the Act of 1853, which, up to the specification, amounted to 25*l.*

		£	s.	d.
16.	Before the expiration of the 4th year from the date of the patent	10	0	0
17.	" " 5th " "	10	0	0
18.	" " 6th " "	10	0	0
19.	" " 7th " "	10	0	0
20.	" " 8th " "	15	0	0
21.	" " 9th " "	15	0	0
22.	" " 10th " "	20	0	0
23.	" " 11th " "	20	0	0
24.	" " 12th " "	20	0	0
25.	" " 13th " " (*u*)	20	0	0
	On enlargement of time for payment of renewal fees :—			
26.	Not exceeding 1 month	3	0	0
27.	" 2 months	7	0	0
28.	" 3 months	10	0	0
29.	For every entry of an assignment, transmission, agreement, licence or extension of patent . . .	0	10	0
30.	For duplicate of letters patent . . . each	2	0	0
31.	On notice to Comptroller of intended exhibition of a patent under section 39	0	10	0
32.	Search or inspection fee . . . . each	0	1	0
33.	For office copies . . . every 100 words (but never less than one shilling)	0	0	4
34.	" " 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 section 96 . .	0	5	0
38.	For altering address in register	0	5	0

(Signed) J. CHAMBERLAIN,
President of the Board of Trade.

21*st December*, 1883.

Approved:
(Signed) CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of Her Majesty's Treasury.

4*th December*, 1883.

(*u*) These payments will be in time if made before midnight on the anniversary of the day of the date of the patent (*Williams* v. *Nash*, 28 Bea. 93). (See also sect. 98.) In the case of existing patents the annual fees are payable only where the 50*l* duty has not already been paid. See *ante*, p. 139.

THE SECOND SCHEDULE.

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PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form A.

APPLICATION FOR PATENT.

(*a*)_____
_____
_____, do solemnly and sincerely declare that_____ in possession of an 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.

(*a*) Here insert name, full address, and calling of applicant or applicants.

(*b*) Here insert title of invention.

And_____ make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*c*)_____
_____
_____

(*c*) Signature of applicant or applicants.

Declared at (*d*)_____ in the_____
_____ this _____ day of
_____ 18___.

(*d*) If declared by more than one applicant and at different times or places, insert after "Declared" the words "by the above-named."

Before me,

(*e*)_____
_____

(*e*) Signature and title of the person before whom the declaration is made.

[Declared at (*d*)_____ in the_____
_____ this _____ day of
_____ 18___.

Before me,

(*e*) _____
_____
_____ (*f*)]

(*f*) If not required as in note (*d*), strike out part within brackets.

NOTE.—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted, and the declaration must be made before a British Consular Officer, or, where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form A1.

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

(a) Here insert name, full address, and calling of applicant.

I (a) _____

of _____ in the

county of _____ do solemnly and

(b) Here insert title of invention.

sincerely declare that I am in possession of an invention for (b) _____

(c) Here insert name, address, and calling of communicant.

which invention has been communicated to me from abroad by (c)

that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(d) Signature of applicant.

(d) _____

Declared at _____ in the county of _____ this _____ day of _____ 18___.

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 authorized in that behalf.

[To be issued with Form A or A 1.]

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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 said invention for _____

to be as follows (*c*): _____

(*c*) Here insert short description of invention.

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant or his agent on the last sheet, the date being first inserted as follows:—

"Dated this day of , 18 ."

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

(a) Here insert title, as in declaration.

(a) _____

(b) Here insert name, full address, and calling of applicant or applicants, as in declaration.

(b) _____

_____ do hereby declare the nature of _____ invention for _____

and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (c):—

(c) Here insert full description of invention, *which must end with a distinct statement of claim or claims, in the following form:*

"Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is,

(1.)
(2.)
(3.) ."

Here state distinctly the features of novelty claimed.

NOTE.—This document must form the commencement of the complete Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The complete Specification and the "Duplicate" thereof must be signed by the applicant or his agent on the last sheet, the date being first inserted as follows:—

"Dated this day of , 18 ."

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

[*To be accompanied by an unstamped copy.*]

I (*a*)_____

(*a*) Here state name and full address.

hereby give notice of my intention to oppose the grant of Letters Patent upon application No._____ of_____, applied for by

upon the ground (*b*)_____

(*b*) Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed.

(Signed) (*c*)_____

(*c*) Here insert signature of opponent or agent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Refusal to Accept, Opposition, or Application for Amendments, &c.

Sir,

(a) Here insert full address.

_____ of (a) _____

_____

hereby apply to be heard in reference to _____

_____

_____

_____

and request that I may receive due notice of the day fixed for the hearing.

_____

Sir,

Your obedient Servant,

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form F.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

(*a*)_____

_____

_____

_____

_____

(*a*) 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(*b*) _____

_____

_____

(*b*) 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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

[To be accompanied by an unstamped copy.]

(*a*) Here state name and full address of opponent.

(*a*) _____

_____

_____

_____

_____

_____

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No._____of 188____

(*b*) Here state reason of opposition.

for the following reason : (*b*) _____

_____

_____

_____

_____

_____

_____

_____

_____

(Signed)_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form H.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENCE.

[*To be accompanied by an unstamped copy.*]

(*a*) _____ (*a*) Here state name and full address of applicant.

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a licence to me by (*b*)_____ (*b*) Here state name and address of patentee, and number and date of his patent.

(Signed)_____

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* Form next page.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form H1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENCES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

THE PETITION of (*a*)_____ of _____ in the county of _____, being a person interested in the matter of this petition as hereinafter described :—

(*a*) Here insert name, full address, and description.

SHEWETH as follows :—

1. A patent dated _____ No. _____ was duly granted to _____ for an invention of (*b*) _____

(*b*) Here insert title of invention.

(*c*) Here state fully the nature of petitioner's interest.

2. The nature of my interest in the matter of this petition is as follows :—(*c*) _____

(*d*) Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licences on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

3. (*d*) _____

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licences on reasonable terms (*e*) _____

(*e*) Here state the ground or grounds on which relief is claimed in the language of section 22, subsections (*a*), (*b*), or (*c*), as the case may be.

Your petitioner therefore prays that an order may be made by the Board of Trade (*f*) _____

(*f*) Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form I.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENCE.

(a) _____

(a) Here state name and full address.

_____

_____

hereby give notice of objection to the application of _____

_____

_____

_____

for the compulsory grant of a Licence under Patent No. _____

of 188 .

(Signed)_____

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

_____

_____hereby transmit the fee prescribed for the continuation in force of_____Patent No._____, of 18 , for a further period of_____.

(a) Here insert name and full address of patentee or his agent.

Name (a)_____

Address_____

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 (b).

(b) See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

(Seal.)

Patent Office, London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form K.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

SIR,

I HEREBY apply for an enlargement of time for_____ month in which to make the _____ payment of £_____ upon my Patent, No._____, of 188 .

I am,

Sir,

Your obedient Servant,

(a)_____

_____

(a) Here insert full address to which receipt is to be sent.

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form L.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS, AND OF DECLARATIONS IN SUPPORT THEREOF.

(*a*) *Or* We. Here insert name, full address, and description.

I (*a*), _____

(*b*) My *or* our. (*c*) *Or* names.

hereby request that you will enter (*b*)_____name (*c*) in the Register of Patents :—

(*d*) I *or* We. (*e*) Here insert the nature of the claim.

(*d*)_____claim to be entitled (*e*) _____

(*f*) Here give name and address, &c., of Patentee or Patentees.

of the Patent No._____ of 188 , granted to (*f*)_____

(*g*) Here insert title of the invention.

for (*g*)_____

(*h*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.

by virtue of (*h*)_____

(*i*) Here insert the nature of the document.

(*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.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form M.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE IN THE REGISTER OF PATENTS.

SIR,

I HEREBY transmit an examined copy of a licence granted to me by _____

_____

under Patent No._____of 188 , as well as the original licence for verification, and I have to request that a notification thereof may be entered in the Register.

I am,

Sir,

Your obedient Servant,

(a)_____ (a) Here insert full address.

_____

_____

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form N.

APPLICATION FOR DUPLICATE OF PATENT.

Date _____

SIR,

I REGRET to have to inform you that the Letters Patent,

(a) Here insert date, No., name, and full address of Patentee.

dated (a) _____ No. _____

granted to _____

_____

(b) Here insert title of invention.

for an invention of (b) _____

_____

(c) Here insert the word "destroyed" or "lost," as the case may be.

have been (c) _____

I beg therefore to apply for the issue of a duplicate of such

(d) Here state interest possessed by applicant in the Letters Patent.

Letters Patent. (d) _____

_____

[Signature of Applicant.] _____

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

(*a*) _____

_____

_____

(*a*) Here state name and full address of applicant.

hereby give notice of my intention to exhibit a _____

of _____ at the _____

_____

_____

Exhibition, which (*b*) _____ of _____ 18____, under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

(*b*) State "opened" or "is to open."

_____ herewith inclose (*c*) _____

_____

_____

(*c*) Insert brief description of invention, with drawings if necessary.

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office,

London,

188 .

I,_____, Comptroller-General of Patents,

Designs, and Trade Marks, hereby certify_____

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

Sir,

(a) _____

_____

_____

_____

_____

(a) Here state name or names and full address of applicant or applicants.

hereby request that _____ address now upon the Register may be altered as follows :—

(b) _____

_____

_____

(b) Here insert full address.

_____

Sir,

Your obedient Servant,

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PATENT.

Form S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

(a) _____

(a) Here state name and full address of applicant.

hereby transmit an office copy of an Order in Council with reference to (b) _____

(b) Here state the purport of the order.

Sir,

Your obedient Servant,

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Form T.

FORM OF APPEAL TO LAW OFFICER.

(a) Here insert name and full address of appellant.

I, (a)_____ of (a)_____

_____

(b) Here insert "the decision" or "that part of the decision," as the case may be.

hereby give notice of my intention to appeal to the Law Officer from (b) _____

_____

(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.

of the Comptroller of the_____ day of_____ 188 , whereby he (c)_____

_____

(d) Insert number and year.

No. (d)_____ of the year 188 . (d)

Signature_____

Date_____

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

21*st December*, 1883.

(Signed) J. CHAMBERLAIN,

President of the Board of Trade.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. WHEN any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall within 14 days from the date of the decision appealed against file in the Patent Office, a notice of such his intention.

See Form T, *ante*, p. 252.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk at room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by

the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or opponents; and, when the Comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.
FARRER HERSCHELL, S.G.

JUDICIAL COMMITTEE RULES.

No Rules having been made under sect. 25 (6) *ante*, p. 31, the following, which were made under the repealed Acts, are still in force.

Rules to be observed in Proceedings before the Judicial Committee of the Privy Council under the Act of the 5th and 6th Wm. 4, *intituled "An Act to amend the Law touching Letters Patent for Inventions," cap.* 83.

RULE I.—A party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which

he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application, shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This Rule relates to the provisions for confirmation of letters patent contained in the repealed Acts, and not re-enacted in the present Act.

RULE II.—A party intending to apply by petition, under section 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

"*Section 4 of the said Act.*" This section contained full directions as to the advertisements to be issued, and required the petitioner to

"advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town."

The present Act (sect. 25 (1), *ante*, p. 31) refers for the regulations as to advertisements to Rules to be made, and does not itself prescribe any mode of advertising, but as the above directions of the repealed Act have hitherto regulated the "procedure and practice in patent matters of the Judicial Committee" as to advertisements, it would seem that until new Rules are made this method of advertising must still be followed. See sect. 25 (6), and Rule IV, *post*.

The advertisements are proved before the case is heard (*x*).

If the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in the places where the manufacture is actually carried on (*y*). The name of an equitable assignee of a co-petitioner must appear in the advertisements (*z*).

"*Time to be fixed for the hearing.*" Where on an application to fix hearing it appeared that the petition had been presented nearly eighteen months before the expiry of the patent, the application was ordered to stand over, as the profits accruing in the meantime might materially affect the question of extension (*a*). Whether on a renewal of such an application the notices served before the first application will be sufficient, *qu.* (*b*).

Under the repealed Acts it was required that the petition should be prosecuted with effect before the patent expired, otherwise, unless the petition was presented more than six months before the date of expiration (*c*), no extension could be granted, and "prosecuted with effect" meant obtaining the report of the Judicial Committee (*d*). There is no such requirement in the present Act, and it is submitted that if the petition is presented in time extension may be granted, although the hearing does not take place till the patent has expired (*e*).

RULE III.—Petitions under sections 2 and 4 of the said Act must be presented within one week from the

(*x*) *Perkins' Patent*, 2 Webst. 8.
(*y*) *Derosne's Patent*, 2 Webst. 2.
(*z*) *Noble's Patent*, 7 Moo. P. C. 191.
(*a*) *Mackintosh's Patent*, 1 Webst. 739, n.
(*b*) *Ibid.*
(*c*) 5 & 6 Wm. 4, c. 83, s. 4; 2 & 3 Vict. c. 67, s. 2. *Bodmer's Patent*, 1 Webst. 740.
(*d*) *Ledsam* v. *Russell*, 1 H. L. C. 687.
(*e*) Compare *Somerset and Walker's* Patent, 13 Ch. D. 397; *Johnson's Patent, Ibid.* 398, n.

insertion of the last of the advertisements required to be published in the *London Gazette*.

In a case of delay arising from mistake this Rule has not been insisted on (*f*). And a supplementary statement to correct errors in the petition has been allowed to be delivered before the hearing (*g*).

Where a petitioner who was entitled to a moiety of the patent, and who, with the assignees of the other moiety, had presented a petition for prolongation, died before the petition was heard, his widow, being executive and residuary legatee, was allowed to appear at the hearing without a supplemental petition, but the Judicial Committee directed, in case a prolongation should be granted, that sufficient proof should be afforded to enable the recital of the death and bequest to be inserted in the new letters patent (*h*).

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act, and the 1st and 2nd of these Rules, and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

RULE V.—All persons entering caveats under section 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

"*Caveats*." See *ante*, p. 34.

An alien resident abroad who was interested in an English patent by a foreign inventor, and who had had considerable dealings in this country in respect of sales of the patented machine and in granting

(*f*) *Hutchinson's Patent*, 14 Moo. 364.

(*g*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*h*) *Herbert's Patent*, L. R. 1 P. C. 399, 401.

licences, was held to have sufficient *locus standi* to oppose the extension of an English patent which would interfere with the first-mentioned patent. But it was not decided whether without such an interest he would have been entitled to inform the Crown in any matter touching letters patent (*i*).

"*Section 4 of the said Act,*" See now sect. 25, *ante*, p. 31.

"*All parties, &c. . . . . , under section 2 of the said Act.*" This relates to the repealed provisions as to confirmation.

"*Entitled to be served.*" The Rule extends to cases of applications to correct an irregularity in the service of the petition. In such a case a person who has entered a *caveat* must be served with notice of the application (*k*).

RULE VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Under this Rule it is sufficient to state the grounds of objection without stating the particulars of those objections (*l*).

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

RULE VIII.—The Registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

As to costs of this nature in actions for infringement, see *ante*, p. 86.

RULE IX.—A party applying for an extension of a patent, under section 4 of the said Act, must lodge at the Council Office six printed copies of the

(*i*) *In re Schlumberger*, 9 Moo, P. C. 1.

(*k*) *Hutchinson's Patent*, 14 Moo. P. C. 364.

(*l*) *Ball's Patent*, 4 App. Cas. 171.

specification, and also four copies of the balance-sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this Rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

"*Copies of the specification.*" See *In re Bell's Patent* (*m*).

"*Not less than one week.*" This Rule is imperative, and is necessary, that the Attorney-General may have the power of inspecting the accounts and making inquiries, and where the accounts had only been filed on the morning of hearing the Judicial Committee refused to go into the accounts, but allowed the hearing to be postponed (*n*).

"*The Attorney-General.*" See *ante*, pp. 34, 41. Where the invention is one which is not likely to be used except by the Government, the Judicial Committee rely very much on what is said in favour of the invention by those who represent the Crown (*o*).

It seems that the Attorney-General may adduce evidence impeaching the patent, irrespective of any notice of objections (*p*).

(*m*) 2 Webst. 159.

(*n*) *Johnson's and Atkinson's Patent*, L. R. 5 P. C. 88.

(*o*) *Hughes' Patent*, 4 App. Cas. 179, citing *Berrington's Case* and *Ruthven's Patent*.

(*p*) *Bull's Patent*, 4 App. Cas. 173, 174.

DESIGNS RULES, 1883.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules:—

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.

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. Classification of goods.

This is a re-enactment, with considerable alterations, of the classes contained in the 3rd section of the Act of 1842.

Application for Registration.

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 authorized to the satisfaction of the Comptroller. Agents.

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. Address of Comptroller.

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 one inch and a half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Size of papers.

The Comptroller may in any particular case vary the requirements of this Rule as he may think fit.

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. Sketches and drawings. Nature of design.

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.

"*Nature of the design.*" See form E, *post*, and *ante*, p. 147.
"*Shape or configuration.*" See *ante*, p. 154.

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 registration in the prescribed form, sealed with the seal of the Patent Office.

See Form G, Second Schedule, *post*, p. 275.

Applications may be sent by post.

12. 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.

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.

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.

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. Notice of appeal to Board of Trade.

See Form F; Second Schedule, *post*, p. 274.

17. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof. Statement on appeal.

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. Notice to Secretary of Board of Trade.

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.

"*For the Board of Trade.*" The Act (sect. 47 (7), *ante*, p. 143) requires "the Board of Trade" to hear the appeal, and contains no provision as to any hearing *for* the Board. It may be a question whether this Rule is within the powers conferred by sect. 101, *ante*, p. 193. The Rule differs from the corresponding Rule under sect. 63 (4) (see Trade Marks Rules, 1883, r. 23, *post*), which provides for directions being given for a hearing *by* the Board of Trade.

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.

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.

Subsequent proprietors.

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.

"*Share or interest therein.*" Under the Act of 1842, sects. 3 and 5 (substantially re-enacted in sects. 60 and 61 of the present Act, *ante*, pp. 154, 155), the exclusive right to apply the design might be the subject of licence, or might be assigned wholly or partially (*q*).

Moreover, the right might be divided so that a right might be given to apply the design to certain articles but not to others (*r*). This would appear, reading the present Rule in connection with sects. 60 and 61, above mentioned, and sect. 87 (*ante*, p. 181), to be still the law.

"*Assignment.*" Under the Act of 1842 it was also held that no assignment or licence could be made or granted by the proprietor before he himself had registered. There is no express enactment to this effect in the present Act, but looking to the 87th section, and to the fact that the provisions of the present Rule apply only to a "registered design" (see also Form K in the Second Schedule to these Rules), it would appear that the law remains the same in this respect also.

Under the Act of 1842, sect. 6, which contained forms of assignment, and required the "writing" to be produced to the registrar, it was held that an assignment or licence must be in writing (*s*). There is no such provision in the present Act or Rules, nor is there any requirement as to the mode of assignment. It would seem, therefore, that for a valid assignment or licence writing is not necessary.

"*Transmission.*" Copyright in a design may devolve on the executor of the proprietor (*t*).

Signature to request.

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 authorized to the satisfaction of the Comptroller; and in the case of a body corporate, by their agent authorized in like manner.

See Form K, Second Schedule, *post*, p. 278.

(*q*) *Jewitt* v. *Eckhardt*, 8 Ch. D. 404, 409.
(*r*) *Ibid.* p. 409.
(*s*) *Ibid.*
(*t*) *Ibid.*

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.

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. Statutory declaration with request.

26. The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction. Proof of title if required.

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

28. Where an order has been made by the Court, under section 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. Notice of order of Court.

Power to dispense with 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 Comptroller's discretion as to evidence.

think fit, to dispense with any such act or thing, document, declaration, or evidence.

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.

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}".

A re-enactment, with modifications simplifying details, of sect. 4 of the Act of 1842.

"*Before the delivery on sale.*" Under sect. 4 of the Act of 1842 the copyright ceased "unless after publication of such design" every article to which it was applied was duly marked. The words at the head of this note, and the corresponding words in sects. 50 (2) and 51, *ante*, p. 147, remove the doubt as to the meaning of the word "publication" expressed in *Dalglish* v. *Jarvie* (*u*), cited *ante*, p. 145.

"*Shall cause each such article to be marked,*" *&c.* See *ante*, p. 148.

(*u*) 2 Mac. & G. 231.

Inspection.

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. Office hours.

Certificate by Comptroller.

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 authorized 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. Certificate in legal proceeding.

See Forms H, I, J, Second Schedule, *post*, pp. 276, 277, 278.

Searches on Production of Sketch of Design.

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. Search.

See First Schedule (Fees), *post*, p. 271.

Industrial and International 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 Notice of exhibition.

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.

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.

J. CHAMBERLAIN,
President of the Board of Trade.

21*st December* 1883.

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 section 53 . . .	0	5	0
13. On request to enter new address	0	5	0
14. For office copy, every 100 words	0	0	4 (but never less than 1*s.*)
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.

J. CHAMBERLAIN,
President of the Board of Trade.

Approved,

CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of Her Majesty's Treasury.

4th December 1883.

SECOND SCHEDULE.

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PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

DESIGNS.

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.

(Signed) (*c*)_____

(*c*) To be signed by the applicant.

Dated the_____day of _____188__.

To the Comptroller,

Patent Office, Designs Branch,

25, *Southampton Buildings,*

Chancery Lane, London, W.C.

DESIGNS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

SEAL OF PATENT OFFICE.

G.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

DESIGNS.

I.

REQUEST FOR CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

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 inclosed was (*b*) _____

_____

(*b*) Here state the entry, matter, or thing which the writer wishes certified.

(Signed)_____

Dated the_____day of_____188___.

To the Comptroller,

Patent Office, Designs Branch,

25, *Southampton Buildings,*

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

J.

CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

In the matter of _____

_____

_____

No. _____

I, _____ 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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

DESIGNS.

K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF DESIGN, 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 Designs as Proprietor_____of the Design No._____in Class_____.

(*b*) My or our.
(*c*) or Names.

(*d*) I am, or We are.

(*d*)_____entitled as to the said Design (*e*)_____

(*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____ 189— made between So-and-so of the one part."

(*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.

(*f*) This paragraph is not required when the declaration is made out of the United Kingdom.

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*)_____

(*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, Designs Branch,
25, Southampton Buildings,
Chancery Lane, London, W.C.

DESIGNS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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 inclose a____ _____

(Signed)_____

Dated the_____day of_____188___.

To the Comptroller,

Patent Office, Designs Branch,

25, *Southampton Buildings,*

Chancery Lane, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

DESIGNS.

M.

REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR ENTRY OF NEW ADDRESS.

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.

21st December 1883.

J. CHAMBERLAIN,
President of the Board of Trade.

TRADE MARKS RULES, 1883.

By virtue of the provisions of the Patents, Designs, and Trade Marks Act, 1883, the Board of Trade do hereby make the following Rules:—

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.

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 (*a*).

If any doubt arises as to what class any particular description of goods belongs to, the doubt shall be determined by the Comptroller.

(*a*) See *ante*, p. 164.

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 authorized 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 respect of the goods mentioned in the application.

See *ante*, pp. 159, 164.

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.

Representations 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 marks 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 four 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 shown by a representation, and may refer thereto in the register in such manner as he may think fit.

See Form G, Second Schedule, *post*, p. 301.

Representations 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 men-

tioned 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.

See also *post*, r. 28, and *ante*, pp. 159–161.

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 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.

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.

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.

See Form H, Second Schedule, *post*, p. 302.

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.

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 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.

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 section 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 Comp-

troller 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.

(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.

Mode of giving notice that the matter has been brought before the Court.

See *ante*, p. 163. Under the old practice the initiative was in effect thrown on the opponent, who was required by the Registrar to apply for directions, whereupon the applicant who desired to register was directed to take out a summons (*x*). The summons was invariably adjourned into Court (*y*).

Register 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.

Time of registration of trade marks.

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

Where applicant dies before registration, the trade mark may be registered for successor to goodwill of business.

(*x*) *Re Simpson, Davies, & Sons' Trade Mark*, 15 Ch. D. 525.
(*y*) *Ibid.*

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.

See Form K, *post*, Second Schedule, and *ante*, p. 175.

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 authorized to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorized 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.

See Form K, *post*, Second Schedule, and *ante*, pp. 163, 185.

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 section 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.

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.

See Form T, Second Schedule, *post*, p. 314.

44. Where an order has been made by the Court in either of the following cases, viz.:—

(*a*) allowing an appeal under section 62 of the said Act;

(*b*) disallowing an opposition to registration under section 69; or,

(*c*) under the provisions of sections 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 section 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

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 section 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.

for alteration of trade mark under section 92 of Act.

Inspection of Register.

49. The Register of Trade Marks shall be open to the inspection of the public, on payment of the prescribed fee, on every weekday between the hours of ten and four, except on the days and at the times following:—

Hours of inspection.

(*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.

Power to dispense 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.

Dispensing with evidence.

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.

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 (*a*) or other special purpose (*β*) to give a certificate (*γ*) as to any entry, matter, or thing which he is authorized 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.

(*a*) See Forms S, V, *post*, pp. 313, 316.

(*β*) As for purpose of use in obtaining registration abroad, Form R, *post*, p. 312.

(*γ*) Form U, *post*, p. 315.

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 authorized 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 authorized 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, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a Judge or Magistrate.

Notice of seal of officer taking declaration to prove itself.

59. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorized to take such declaration in testimony of such 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.

J. CHAMBERLAIN,
President of the Board of Trade.

21*st December* 1883.

SCHEDULES.

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 any 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 fourteen 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
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

	£	s.	d.
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 2 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

J. CHAMBERLAIN,
President of the Board of Trade.

Approved,

CHARLES C. COTES,
HERBERT J. GLADSTONE,
Lords Commissioners of Her Majesty's Treasury.

4th December 1883.

SECOND SCHEDULE.

FORMS.

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TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

F.

APPLICATION FOR REGISTRATION OF TRADE MARK.

One representation 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.

NOTE.—In the Rules this figure is 4 inches wide and 3½ inches deep.

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*).

(*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, add 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."

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

(Signed) _____ (*d*)

Dated this_____ day of_____, 188____.

NOTE.—If the Trade Mark has been in use in respect of the goods since before August 13, 1875, state length of such user.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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 (on 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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

I.

FEE FOR REGISTRATION OF A TRADE MARK.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

K.

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF TRADE MARK UPON THE REGISTER, WITH DECLARATION IN SUPPORT THEREOF.

I, (*a*)_____

_____

_____

hereby request that you will enter (*b*)_____name___(*c*) in the Register of Trade Marks as proprietor_____of the Trade Mark No._____ in Class_____.

(*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.

(*e*)_____

_____

_____

_____

_____

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.

(*g*)_____

Declared at _____

_____

this_____day of_____188___.

Before me,

(*h*)_____

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

(*a*) *Or* We. Here insert name, full address, and description.

(*b*) My *or* our.
(*c*) *Or* names.

(*d*) I am, *or* We are.

(*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."

(*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.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

L.

REQUEST FOR CERTIFICATE OF REFUSAL TO REGISTER A TRADE MARK IN USE BEFORE 13 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.

(*a*) Signature of Applicant.

(*a*) _____

Dated this _____ day of _____ 188__.

To the Comptroller,

Patent Office, Trade Marks Branch.

25, *Southampton Buildings,*

London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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__.

(a) _____ (a) Signature of Proprietor.

To the Comptroller,

Patent Office, Trade Marks Branch,

25, Southampton Buildings,

London.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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 enclosed herewith.

Dated this_____day of_____, 188__.

(a)_____

(a) To be signed by the person interested or his agent.

To the Comptroller,

Patent Office, Trade Marks Branch,

25, *Southampton Buildings,*

London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

O.

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____.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

P.

FORM OF DECLARATION IN SUPPORT OF APPLICATION FOR CANCELLATION OF TRADE MARK BY OWNER.

I, _____ of _____ ; [*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 _____
_____ 188 ___.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

Q.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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 (*a*)_____

(*a*) Here state name of country in which registration is to be sought.

(*b*) Signature. (*b*)_____

Dated this_____day of_____188____.

To the Comptroller,

Patent Office, Trade Marks Branch,

25, Southampton Buildings,

London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

S.

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 (*a*)_____

_____

(*a*) Here state exact title of legal proceedings.

(*b*)_____

(*b*) Signature.

Dated this_____ day of_____188____.

To the Comptroller,
Patent Office, Trade Marks Branch,
25 *Southampton Buildings,*
London.

TRADE MARKS.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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 ___

(a) _____

(a) To be signed by both parties.

To the Comptroller,

Patent Office, Trade Marks Branch,

25, *Southampton Buildings,*

London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

U.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

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.

(a) Signature. (a)_____

Dated this_____day of_____188____.

To the Comptroller,
Patent Office, Trade Marks Branch,
25, *Southampton Buildings,*
London.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

TRADE MARKS.

W.

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.

(*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.

(*a*) Signature.

Dated this _____ day of _____ 188___.

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.

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.

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	

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.
CLASS 16.	
Porcelain and earthenware.	Such as— China. Stoneware. Terra 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.

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 (*z*).

Cotton yarn and thread.	Such as— Sewing cotton on spools or reels.

(*z*) In classes 23 to 35 four representations of each mark must be supplied by the applicant, three only being required in other cases (Trade Marks Rules, 1883, *ante*, r. 13).

	Sewing cotton not on spools or reels. Dyed cotton yarns.
CLASS 24.	
Cotton piece goods of all kinds.	Such as— Cotton shirtings. Long cloth.
CLASS 25 (*a*).	
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 33.	
Yarns of wool, worsted, or hair.	

(*a*) The late Manchester Committee of Experts, which was formed under the Act of 1875 to divide old cotton marks into two classes, viz., such as were, and such as were not, in the opinion of the Committee, trade marks within the Act, was not a judicial tribunal, and its decisions are not conclusive upon the Court (*Orr Ewing* v. *Registrar of Trade Marks*, 4 App. Cas. 479).

An office for recording trade marks for cotton goods has been opened at 48, Royal Exchange, Manchester.

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.
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.
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.
CLASS 50.	
Miscellaneous, including— (1.) Goods manufactured from ivory, bone, or wood, not included in other classes. (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.	Such as— Coopers' wares.

J. CHAMBERLAIN,
President of the Board of Trade.

21*st December* 1883.

APPENDIX.

ORDERS.

Consolidation of several Actions by same Plaintiff on same Patent against different Classes of Infringers. Order for Injunction meanwhile. *Bovill* v. *Ainscough* (and other actions). Wood, V.C., A. 1867, fo. 2241.

Upon motion this day made unto this Court by counsel for the defendants in all the above-mentioned causes, and upon hearing counsel for the plaintiff: This Court doth order that the several defendants in all the above-mentioned causes do, on or before the day of , deliver to the solicitors for the plaintiff a written statement of the names of such of the said defendants, and of their respective mills, and the number of pairs of stones at the said mills respectively, in respect of which the defendants mentioned in such statement admit that the mode of working, as regards the alleged infringement of the plaintiff's patent of 1849 in the bills mentioned, is the same as that adopted by A. C——, the defendant in the cause of *Bovill* v. *C*———, and that the defendants in such respective causes do enter into such admissions accordingly. And it is ordered that such of the defendants as shall not admit that their mode of working is the same as that adopted by the said A. C——, do severally, within the time aforesaid, make an affidavit or affidavits disclosing their mode of working in all particulars respecting which they severally have, or but for this order might have, been interrogated by the plaintiff as to the infringement of his patent; and that the plaintiff be at liberty at all seasonable times, upon giving reasonable notice, to inspect the machinery and mode of working of the several above-mentioned defendants' machinery. And it is ordered that the plaintiff do, within three weeks from the day on which the last of such admissions or of such affidavits respectively shall have been made, select one cause, representing each different class of infringement, in which he will proceed to decree, and give notice in writing thereof to the defendants' solicitors; and if the plaintiff shall select more than one cause in which he will proceed to decree, he is to give notice in writing to the defendants' solicitors in which of the said causes he will try the validity of the said patent; and the defendants by their counsel submitting to be bound in all respects by the ultimate decision of this Court in such selected cause or causes, subject only to appeal in such selected cause or causes, both as regards the validity of the plaintiff's patent and as regards the infringement thereof, so far as the infringement established in such selected cause or causes coincides

with the admissions and affidavits to be entered into and made as hereinbefore directed, and the plaintiff by his counsel undertaking to abide by any order this Court may make as to damages in case the Court shall hereafter be of opinion that the defendants or any of them shall have sustained any by reason of this order which the plaintiff ought to pay, and also undertaking to accept short notice of motion to discharge this order, this Court doth order that the several above-named defendants, their respective servants, agents, and workmen, be restrained until the hearing of the said cause or causes so to be selected from in any manner exercising or putting in practice, or continuing to use, exercise, or put in practice, at their respective mills in the several above-mentioned bills respectively described or elsewhere, the inventions and improvements for which the letters patent of 1849 and 1863 in the said bills respectively mentioned were granted, or any material part thereof, or any means, apparatus, or arrangement merely colourably differing therefrom. And it is ordered that all further proceedings in these causes, except for the purpose of carrying out this order, and except in regard to such selected cause or causes as aforesaid, be stayed until the hearing of such selected cause or causes, or until further order, with liberty to the plaintiff and any of the defendants to apply before the hearing of such selected cause or causes, and generally as they may be advised. And any of the defendants, in any suits commenced by the plaintiff against the members of the Manchester Association of Millers in the said bills mentioned in respect of infringement of the said patent, are to be at liberty to apply to be made parties to this order.

CONSOLIDATION OF SEVERAL ACTIONS ON SAME PATENT AGAINST DIFFERENT PERSONS INFRINGING IN SAME MANNER—OWNER OF PATENT BEING PLAINTIFF IN ALL THE ACTIONS, AND JOINED IN SOME OF THE ACTIONS WITH A DIFFERENT CO-PLAINTIFF. PROVISION IN CASE DEFENDANT IN ONE ACTION SUBMITS BEFORE TRIAL. *Plimpton* v. *Spiller*. 1876, P. 69. Jessel, M.R., at Chambers, B. 1876, fo. 1495 (five actions).

Between J. L. P., (*b*) Plaintiff,
A, F. S. and T. C., Defendants.
And between The L. and S. Skating Rink Co., and J. L. P. } Plaintiffs,
and
E. B. C., Defendant,

and three other actions.

Upon the application of the defendants in the above-mentioned actions other than the said action of *P.* v. *The H. R. B., &c., Co.*, and upon the application of the defendants in the last-mentioned action,

(*b*) J. L. P. was the patentee.

and upon hearing the solicitors for the respective applicants and for the plaintiffs in the said several actions, and the respective applicants by their solicitors admitting that they have, for their own profit and without the licence of any of the above-named plaintiffs, made or sold, or let for hire, or used skates being the same as the skates the manufacture, sale, or user of which is complained of in the first above-mentioned action: It is ordered that all proceedings in the four lastly above-mentioned actions be stayed, except for the purpose of enforcing the injunctions which have been already granted in the same actions, and of enforcing this order until judgment be obtained in the first above-mentioned action, the defendants in the several other actions hereby undertaking to be bound and concluded by the judgment after trial (subject to appeal) of the first above-mentioned action, both as regards the validity of the letters patent of A—— B—— mentioned in the several statements of claim delivered in the four firstly above-mentioned actions, and as regards the infringement thereof, so far as such infringement may consist in making, selling, using, or letting for hire the skates complained of in the first above-mentioned action, and in case the defendants in the first above-mentioned action shall submit to judgment in favour of the plaintiff without proceeding to trial, the defendant or defendants in the other actions shall be at liberty to set up the same defence as (but except by leave of a Judge no other defence than) that set up by the defendants in the said first-mentioned action, and shall deliver the statement of such defence within seven days after notice by the plaintiff or plaintiffs requiring him or them to deliver such statement of defence, and the defendants to the remaining actions are to be in like manner bound and concluded by the judgment (subject to appeal) which may be obtained in the action in which proceedings may be resumed, and so from time to time. And it is ordered that the costs of this order be costs in the first above-mentioned action.

CONSOLIDATION OF SEVERAL ACTIONS BY SAME PLAINTIFFS ON SAME PATENT AGAINST DIFFERENT PERSONS INFRINGING IN SAME MANNER. PROVISION IN CASE DEFENDANT IN ONE ACTION SUBMITS BEFORE TRIAL. *Johnasson* v. *Palgrave.* 1880, J., 1079, 1166, 1167. Jessel, M.R., at Chambers, A. 1880, fo. 2619 (three actions).

Upon the application of the defendants in all the above-mentioned actions, and upon hearing counsel for the applicants and for the plaintiffs in the said actions, and the applicants by their counsel admitting that they have, for their own profit and without the licence of any of the above-named plaintiffs, made or used machines similar to that inspected by the plaintiffs on board the ship M., and complained of in the statement of claim in the first-mentioned action: It is ordered that all proceedings in the second- and third-mentioned actions be stayed, except for

the purpose of enforcing this order, until judgment be obtained in the first-mentioned action, the defendants in the said second- and third-mentioned actions by their counsel undertaking to be bound and concluded by the judgment after trial (subject to appeal) of the said first-mentioned action, both as regards the validity of the letters patent of A. B. and C. D., mentioned in the statement of claim in the first-mentioned action, and in the several writs of summons in the second- and third-mentioned actions, and as regards the infringement thereof, so far as such infringement may consist in making or using the said machines complained of in the said statement of claim, and in case the defendants in the said first-mentioned action shall submit to judgment in favour of the plaintiffs without proceeding to trial, the defendants in the other actions are not to be at liberty to set up any defence thereto respectively without the leave of the Judge, and the costs of this application are to be costs in the said first-mentioned action.

ORDER REFERRING QUESTIONS AND ISSUES OF FACT TO OFFICIAL REFEREE UNDER JUDICATURE ACT, 1873, SECT. 57. *Saxby* v. *Gloucester Wagon Co.* 15 December, 1879.

High Court of Justice, Exchequer Division.

(Middlesex to wit.)

At a sitting held at Westminster on Wednesday, the day of November, , before the Honourable Sir Henry Hawkins:

It is ordered that this being an action requiring a prolonged scientific investigation, which cannot, in the opinion of the Judge, conveniently be made before a jury or conducted by the Court through its other ordinary officers, that the questions and issues of fact and of account (if any) arising herein be tried before one of the official referees, who shall inquire and report upon such questions and issues. It is further ordered that if the parties agree upon a special referee, instead of an official referee, such special referee be substituted for an official referee. *Saxby* v. *Gloucester Wagon Co.* 15 December, 1879.

ORDER FOR FURTHER PARTICULARS OF OBJECTIONS. *The London and Leicester Hosiery Co. Limited* v. *Higham.* Queen's Bench Division, 1882. L. No. 2680, 3 July, 1883. T. $\frac{6}{7}$.

Upon reading the order of the Honourable Mr. Baron Huddleston, dated the 25th day of June, 1883, and upon hearing counsel, &c., on the defendant's notice of motion, dated, &c., that the order of the Honourable Mr. Baron Huddleston, made by him on the 25th day of June, 1883, whereby it is ordered that the defendant do, within seven days, deliver further and better particulars of objections in this action, by stating what portions of the specifications in the particulars already delivered referred to are alleged to anticipate the plaintiffs' inventions, with a

reference to pages and lines of such specifications, and also what portions of the plaintiffs' inventions are alleged to have been published or used prior to the dates of the several letters patent therefor with reference to the claiming clauses of the specifications of such letters patent, and that the plaintiffs should have fourteen days' time to reply after delivery of such particulars, may be rescinded, and that the plaintiffs may be ordered to pay to the defendant his costs of and incident to the said order, and also his costs of and incident to this application: It is ordered that the defendant's application herein be dismissed, with costs, to be taxed by one of the masters, and paid by the said defendant to the said plaintiffs or their solicitor.

ORDER FOR INSPECTION OF MACHINERY AND APPLIANCES ALLEGED TO BE TRADE SECRETS. *Hill* v. *Tombs.* 1880, H. 105. Jessel, M.R., 26 November, 1880.

Upon motion, &c.: This Court doth order that the plaintiff and two of his scientific witnesses be at liberty, upon giving three days' notice, to inspect (but only one inspection of *each machine*) all the machinery and appliances, except as to those parts of such machinery and those appliances alleged by the defendants to be trade secrets, used by the defendants in the manufacturing pleats, frills, ruchings, and fancy trimmings, and to see the products manufactured by the machinery and appliances, and to take specimens of the manufactured products generally produced, and as to those parts of such machinery and those appliances alleged to be trade secrets, it is ordered that the same be inspected by A. B., of, &c., and the said A. B. is, within seven days from the completion of such inspection, to report to the Court, firstly, whether, in his opinion, such machinery or appliances, or any of them, are trade secrets; secondly, whether, in his opinion, they or any of them infringe (*c*) the plaintiff's patents; and it is ordered that the defendants do pay to the plaintiff his costs of this application, such costs to be taxed by the taxing master, and that the plaintiff's costs of the former inspection be plaintiff's costs as against the defendants in any event.

ORDER FOR INSPECTION OF DEFENDANTS' PROCESS ALLEGED TO BE TRADE SECRET. *The Plating Co.* v. *Farquharson.* 1879, P. 264, Jessel, M.R. B. 1880, fo. 460.

Upon motion, &c.: This Court doth order that A. B. 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 defendants two days' previous notice, to see the

(*c*) This form has not been followed in later orders. See *Plating Co.* v. *Farquharson, post.*

defendants' method of making their 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 A. B. 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; and the costs of the plaintiff's application by motion on the of , and of this motion, are to be costs in the action.

JUDGMENT FOR INJUNCTION TO RESTRAIN INFRINGEMENT OF PATENT, AND FOR REFERENCE TO ASSESS AND DIRECTION TO PAY DAMAGES. *Otto* v. *Linford.* 1880, 207, Court of Appeal, 27 January, 1882. 46 L. T. (N. S.) 35.

(After reversing Judgment of the Court below, which dismissed the action with costs.)

It is ordered and adjudged that the defendant C. L., his servants, agents, and workmen, be restrained during the continuance of the letters patent *granted to* A. B., *dated, &c., in the statement of claim mentioned,* from using or exercising, or causing or permitting to be used or exercised, the invention described in the specification and drawings of the said A. B., and from selling or making any profitable use, or permitting the sale or profitable use, of any gas motor engines not made by the plaintiff or his licensees, and arranged or constructed in manner described in the said specification and drawings, or differing therefrom only colourably and by the substitution of mere mechanical equivalents. And it is ordered that it be referred to X. Y., as special referee, to inquire and report what sum of money is fit to be awarded to the plaintiff in respect of any damage sustained by the plaintiff from the sale or use by the defendant of the said invention, or any apparatus in imitation of or being only a colourable deviation from the said invention; and it is ordered that the defendant C. L. do, within seven days after the adoption by the Judge of said special referee's report, pay to the plaintiff the sum so awarded. And (after directing defendant to pay costs of action and of appeal, and to refund costs paid by the plaintiff under the judgment of the Court below) the plaintiff is to be at liberty to apply to the Vice-Chancellor for a certificate that the validity of his patent came in question in this action, and that the plaintiff proved the breaches alleged in the particulars of breaches in this action. Liberty to either party to apply.

APPORTIONMENT OF COSTS. *Simmonds* v. *Hitchman.* 1879, Sect. 453. Bacon, V.C., 4 February, 1881.

This action coming on for trial, &c., in the presence of counsel, &c., and upon hearing, &c.: This Court doth order and adjudge that this action

and the counter-claim of the defendants respectively do stand dismissed out of this Court.

And it is ordered that it be referred to the taxing master to tax the costs of the plaintiff of this action, so far as they have been occasioned by the issues raised by the defendants impeaching the validity of the plaintiff's patent, and the costs of the plaintiff occasioned by the counter-claim of the defendants, and also the costs of the defendants of this action, so far as they have been occasioned by the issue raised by the plaintiff as to the infringement of the said patent by the defendants. And the taxing master is to set off such costs of the plaintiff and of the defendants when so taxed, and certify to whom after such set-off, the balance is due.

And it is ordered that the party from whom such balance shall be certified to be due do pay the amount thereof to the other party.

ORDER OF THE MASTER OF THE ROLLS TO AMEND A CLERICAL ERROR IN A SPECIFICATION. *Johnson's Patent.* 5 Ch. D. 503.

Upon the petition of the above-named, on the day of preferred unto the Right Honourable the Master of the Rolls, having the consent of Her Majesty's Attorney-General written on the said petition, and upon hearing counsel for the petitioner, and upon reading the said petition, the letters patent referred to in the title of this petition, a Queen's Printers' copy of the specification filed in the Great Seal Patent Office, pursuant to the said patent, an affidavit of the petitioners and the exhibits and therein referred to, an affidavit of and the exhibit therein referred to, his Lordship doth order that the proper officer of the Great Seal Patent Office do amend the said specification by inserting in the said specification, after the words occurring in line , page , of the Queen's Printers' copy of the said specification, the words ,

And notice of this Order is to be given to the Commissioners of Patents, in order that the said specification may be reprinted.

ORDER FOR REGISTRATION OF TRADE MARK, WITH WORDS REFERRING TO QUALITY. *Clippens Oil Co.'s Application.* Jessel, M.R., 11 March, 1881.

Upon motion, &c., and upon hearing counsel for the Registrar of Trade Marks, and upon reading an affidavit, &c.: This Court doth order that the said Company do amend their application by describing their mark as the device of a triangle inscribed in the innermost of two concentric circles, having added thereto between the circles the

words, &c. (certain words describing the applicants), and having in the triangle other words referring to the goods to which the said mark is applied.

And thereupon it is ordered that the Registrar of Trade Marks do proceed with the application of the said Clippeus Oil Company to be registered as proprietors of the trade mark described in such amended application. And it is ordered that the said Company do pay to the Registrar of Trade Marks his costs of this application, to be taxed by the taxing master in case the parties differ.

The following is an extract from the "Instructions to persons who wish to register trade marks" issued by the Patent Office—January 1884 :—

RESTRICTIONS 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. (*d*) 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.

(*d*) Under the Act of 1875 the office only declined to register the particulars mentioned in this and the preceding paragraph as parts of new marks ("Sebastian on Trade Marks," p. 221). It will be remembered that these "Instructions" are merely office regulations, and have not the force of rules made under sect. 103 of the Act (see *Re Rotherham's Trade Mark*, 11 Ch. D. 250; affirmed 14 Ch. D. 585). But as to some of the words mentioned, they merely express the decision of the Courts (see *Re Royal Baking Powder Co.* and *Re Meikle's Trade Mark*, *ante*, p. 159), and the analogy of these cases would seem to show that the above restrictions would be enforced as to the other words and devices referred to.

FORMS OF COUNTER-STATEMENT 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
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

34. 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.

PARTICULARS OF BREACHES IN PATENT ACTION.

IN THE HIGH COURT OF JUSTICE.
CHANCERY DIVISION.
MR. JUSTICE

BETWEEN A. B. . . . . *Plaintiff;*
AND
C. D. . . . . *Defendant.*

PARTICULARS OF BREACHES

Delivered by the Plaintiff with his Statement of Claim the day of

The following are particulars of the breaches complained of by the Plaintiff in this action that is to say :

That the Defendant has at divers times previously to the commencement of this action infringed the said letters patent granted to the Plaintiff as in the Statement of Claim mentioned and dated the day of and numbered by using or applying in or to certain mechanism being the same as the mechanism described in the Queen's Printers' copy of the specification filed under the said letters patent and claimed by the and claims thereof and by manufacturing or selling for his own profit having therein the mechanism aforesaid.

The Plaintiff complains in particular and by way of illustration of the sale of certain by the Defendant to one E. F. of &c. on the day of

The precise numbers dates and amounts of the Defendant's infringements are not at present known to the Plaintiff but the Plaintiff will claim to recover from the Defendant full compensation in respect of all such infringements.

PARTICULARS OF OBJECTIONS IN PATENT ACTION.

IN THE HIGH COURT OF JUSTICE.
CHANCERY DIVISION.
MR. JUSTICE

BETWEEN A. B. . . . . *Plaintiff;*

AND

C. D. . . . . *Defendant.*

PARTICULARS OF OBJECTIONS

Delivered by the Defendant with his Statement of Defence the day of

The Defendant besides denying that he has infringed the letters patent in the Statement of Claim mentioned will at the trial of this action rely on the following objections to the validity of the said letters patent :—

1. That the Plaintiff was not the true and first inventor of the alleged invention comprised in the said letters patent.

2. That the alleged invention was not new at the date of the said letters patent.

3. That the alleged invention is the mere application to of means previously well known for and is not the proper subject-matter of letters patent.

4. That the specification alleged to have been filed by the Plaintiff under the said letters patent does not sufficiently describe and ascertain the alleged invention and in what manner the same is to be performed and does not sufficiently distinguish which of the matters and things therein described the last named Plaintiff claims to have invented and which of the same he does not claim to have invented and admits to be old And that in other respects the said specification is insufficient ambiguous and framed so as to mislead.

(*State here other objections.*)

5. That the alleged invention was previously to the date of the said letters patent published within this realm in the following specifications and printed books that is to say :

The specification of G. H. filed under letters patent dated No. page lines and page lines

(*Add other specifications.*)

(*Title of book*) page lines

(*Add other books.*)

6. That the alleged invention was previously to the date of the said letters patent published within this realm by the manufacture and sale of articles made according to the alleged invention by the several persons hereinafter named at the times and places following that is to say :

By I. K. of in the year at in the county of

(*Add other prior users.*)

[For Forms of Statement of Claim and Statement of Defence in patent actions, see Supreme Court Rules, 1883, Appendix C, sect. VI, Form No. 6, and Appendix D, sect. VI.]

PETITION FOR EXTENSION OF TERM OF PATENT.

IN THE PRIVY COUNCIL.

Presented the day of

TO THE QUEEN'S MOST EXCELLENT MAJESTY IN COUNCIL.

IN THE MATTER OF LETTERS PATENT, granted to A. B., of, &c.,
for the invention of (*title of invention*)
dated the day of , 1867.

THE HUMBLE PETITION OF X. Y., of, &c.,
and of the above-named A. B.

SHEWETH,

That your Petitioner, the above-named A. B., previously to the grant of the Letters Patent hereinafter mentioned, invented after considerable personal application and cost certain Improvements in, &c. (*title of invention*) (hereinafter called "the said invention"), which invention was, and is, of great utility, and greatly beneficial to the public.

That your Majesty was graciously pleased by Letters Patent, under the Great Seal of the United Kingdom of Great Britain, bearing date the day of , to grant unto your Petitioner A. B., his executors, administrators, and assigns, the sole privilege and authority to use the said invention within the said United Kingdom, the Channel Islands, and Isle of Man, for the term of 14 years from the date of the said Letters Patent.

That your Petitioner, A. B., in compliance with a proviso in the said Letters Patent contained, duly made and caused to be filed in the Great Seal Patent Office within six calendar months from the date of the said Letters Patent, an instrument in writing under his hand and seal particularly describing and ascertaining the nature of his said invention, and the manner in which the same was to be performed.

That your Petitioner, A. B., also obtained Letters Patent or Brevets d'Invention for his said invention in France, dated the day of June, 1868.

(*Add other foreign patents, and state whether they are in force or expired.*)

That the said invention relates to improvements in the means of consuming smoke, and of effecting combustion in steam boilers, as also improvements in the means of supplying furnaces with fuel.

That your Petitioner, A. B., is a Civil Engineer, and he has for more

than 30 years past devoted his attention to smoke-consuming apparatus, and has given much time and labour, and expended very considerable sums of money in conducting experiments relating to the subject-matter of the said invention, and either alone or with his then partner, one , he obtained Letters Patent for apparatus relating thereto, all of which last-mentioned Letters Patent have expired or become void,

(*Add statements showing advantages of the invention.*)

(*Add statements showing interest of co-Petitioner.*)

That your Petitioner, A. B., has expended large sums of money and devoted great pains and labour in endeavouring to introduce the said invention to the public, and to bring the same into use.

(*State what was done by Petitioners.*)

That although under the circumstances aforesaid considerable numbers of fire doors made according to the said invention comprised in the said Letters Patent of the day of , were sold, yet the necessary expenses of introducing the said invention as aforesaid were so great, that it was only during the last year and nine months, or thereabouts, that is to say the years 1879 and 1880, that any profit was made from the said invention. In all other years since the date of the said Letters Patent, the working of the said Letters Patent and the manufacture and sale of fire doors made according to the said invention resulted in losses which far more than counterbalanced the profit of the years 1879 and 1880 aforesaid, and, on the whole, your Petitioner, A. B., instead of obtaining any profit from the said invention has sustained a very considerable loss.

That only one licence has ever been granted for the use of the said invention in the United Kingdom, that is to say a licence to one C. D., of Manchester and Oldham, which was granted by your Petitioner, A. B., in or about the month of November, 1873.

(*State whether any profit arose from licence.*)

(*Add circumstances showing difficulty of introducing invention to the public.*)

That of late years the utility of the said invention has been generally acknowledged.

(*Add other circumstances to show the invention is coming into use.*)

That under the circumstances aforesaid, your Petitioner, A. B., has, notwithstanding his considerable outlay upon the said invention, been unable to obtain any profit thereupon, nor has he obtained any emu-

neration for his expense and labour in perfecting the same ; but on the contrary, he has sustained considerable loss in relation to the said invention, and it is only now when the Letters Patent are about to expire, that the use of the said invention is becoming fully established and extending.

That your Petitioners have no doubt that if the term of the said Letters Patent should be extended, the said Letters Patent will now become productive, and your Petitioner, A. B., will be able to obtain a fair reimbursement and remuneration commensurate with the great public value and importance of the said invention.

That your Petitioners humbly submit that under the circumstances of the case an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your Petitioner, A. B.

That your Petitioners have given public notice by advertisements caused to be inserted the requisite number of times in the "London Gazette," and in metropolitan and country newspapers, pursuant to the statute in that case made and provided that it is their intention to present a petition to your Majesty in Council that their said Letters Patent may be extended for a further term.

Your Petitioners therefore humbly pray that your Majesty will be graciously pleased to take the case of your Petitioners into your Royal consideration, and to refer the same to the Judicial Committee of your Majesty's Most Honourable Privy Council, and that your Petitioners may be heard before such Committee by their Counsel and Witnesses, and that your Petitioners' Letters Patent may be extended for the further and additional term of fourteen years, or for such other term as to your Majesty shall seem fit.

And your Petitioners will ever pray, &c.

OBJECTIONS TO EXTENSION OF TERM OF PATENT.

IN THE PRIVY COUNCIL.

IN THE MATTER OF LETTERS PATENT granted to A. B., of, &c., for the invention of &c.,

AND

IN THE MATTER OF THE PETITION of for an extension of the term of the said Letters Patent.

THE GROUNDS OF OBJECTION of the several firms and persons following, namely :—

(*Add names and descriptions of opponents.*)

To the granting of the prayer of the above-mentioned Petition are as follows :—

That the alleged invention was not new at the date of the above-mentioned Letters Patent.

That the Petitioners have already received a full and adequate remuneration for the said alleged invention, and that in addition to the profits derived from the said Patent the Petitioners and their predecessors in title have derived large trade profits from a commercial undertaking established and created solely by the possession of the monopoly created by the said Letters Patent.

(*Add other objections.*)

That the allegations contained in the said Petition are incapable of proof.

Dated this day of January,

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NOTE.—The black figures with the prefix (s.) refer to the sections of the Act. The abbreviations, **P.R.**, **L.O.R.**, **J.C.R.**, **D.R.**, **T.M.R.**, refer to the Patents Rules, Law Officers' Rules, Judicial Committee Rules, Designs Rules, and Trade Marks Rules respectively, and the numbers appended to these abbreviations refer to the numbers of the Rules. The other figures refer to the pages of this book.

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