THE PATENTS, DESIGNS, AND TRADE MARKS ACTS

THE PRESENT LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS

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THE PATENTS, DESIGNS, AND TRADE MARKS ACTS

WITH NOTES ON ALL RECENT DECISIONS AND CHANGES IN LAW AND PRACTICE

BY

H. FLETCHER MOULTON

AND

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OF THE MIDDLE TEMPLE, BARRISTERS-AT-LAW

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PREFACE

THE recent Acts have introduced many and important changes in reference to Patents, Designs, and Trade Marks, chiefly by the amendment of clauses of the main Acts relating to these subjects. In order fully to comprehend the effect of the new provisions it is necessary, firstly, to compare them with the old provisions, and, secondly, to see how far the latter have been explained or extended by judicial decisions, and to consider how far those decisions are applicable to the new forms. The Authors have therefore printed each section of the main Acts both in the earlier and amended form, and have added notes as to the effect of the changes.

During the war the output of legal text-books has necessarily been restricted; while the decisions of the Courts have been accumulating. The Authors have therefore shown the effect of all important decisions since 1912 in the introductory chapters, and have also summarised in those chapters the changes introduced by these new Acts. In the case of Patents the introductory chapter is divided in accordance with the system adopted in Fletcher Moulton's "Law & Practice Relating to Letters Patent for Inventions," and the present book therefore brings this completely up to date, and incorporates all reported cases to the end of 1919.

H. F. M.
J. H. E. J.

11, KING'S BENCH WALK,
TEMPLE,
February, 1920.

METHOD OF REFERENCES, ETC.

REFERENCES to sections in the Patents & Designs Introduction and Acts are to sections of the 1907 Act, and in the Trade Marks portion to the 1905 Act unless otherwise stated.

References to reports are given by numbers corresponding to the number assigned to the case on the table of cases. Where the report in a particular Court is referred to the corresponding letter is added. Thus in the Patents & Designs portion the reference **92** would signify that the case referred to was *Osram Lamp Works* v. *Pope's Electric Lamp Works*, the reports of which will be found in the table of cases under **92**, while **92 C** (at p. 40) would refer to a special passage in the report of the same case at 33 R. P. C. p. 40. *The Tables of Patents & Designs cases and of Trade Marks cases are numbered separately.*

The portions of the 1905 and 1907 Acts which have been repealed are printed in square brackets or between black lines; the amendments are printed in italics.

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60. May *v.* May, 31 R. P. C. 324. *36.*
62. Moore's Application, 34 R. P. C. 154. *30.*
63. Moore's Modern Methods Application, 36 R. P. C. 6. *31.*
64. Mouson *v.* Boehm (1884), 26 C. D. 398. *130.*
65. Muratti's Application, 32 R. P. C. 77. *30.*
66. National Cash Register Co.'s Application, A. 34 R. P. C. 273; B. 34 R. P. C. 354, C. A. *30, 31.*
67. New Atlas Rubber Co.'s T.M., 35 R. P. C. 269. *31, 130.*
68. Neuchatel-Asphalte Co.'s Application, 30 R. P. C. 349. *31, 32, 34.*
69. Norton Co.'s Application, 36 R. P. C. 153. *31, 134.*
70. O. T. *v.* Cumming, 32 R. P. C. 69, O. H. *35.*
71. Oxo *v.* King, 34 R. P. C. 165. *34.*
72. Pearson Bros. *v.* Valentine & Co., 34 R. P. C. 267. *35.*
73. Pink *v.* Sherwood, 30 R. P. C. 725. *34, 36.*
74. Powell's T. M., A. 10 R. P. C. 63; B. 10 R. P. C. 195, C. A.; C. 11 R. P. C. 4, H. L. *131.*
75. Pullman *v.* Pullman, 36 R. P. C. 240. *36.*
76. Reddaway & Co.'s Application, 31 R. P. C. 147. *31, 33.*
77. Reddaway & Co. *v.* Flyn, 30 R. P. C. 16, C. A. *36.*
78. Roskill's T. M., 32 R. P. C. 577. *32, 109.*
79. Royal Warrant Holders' Association *v.* Matthews, 32 R. P. C. 81. *35.*

80. Royal Warrant Holders' Association *v.* Alexander Boguslavsky, 32 R. P. C. 83. *35.*
81. Sandow's Application, 31 R. P. C. 100. *32.*
82. Sharpe *v.* Solomon Bros., A. 31 R. P. C. 441; B. 32 R. P. C. 15, C. A. *30, 31.*
84. Sheffield Simplex Motor Works Application, 32 R. P. C. 145. *30.*
85. Short *v.* Short, 31 R. P. C. 204. *32.*
86. Shreeves, T. M., 31 R. P. C. 24. *32, 33.*
87. Slazongor's Application, 31 R. P. C. 501. *30, 31.*
88. Smith's Application, 30 R. P. C. 303. *32.*
89. Smith & Jones *v.* Service Reeve & Co., 31 R. P. C. 310. *34.*
90. Societe Anonyme Dubonnet's Application, A. 31 R. P. C. 453; B. 32 R. P. C. 241, C. A. *31, 32, 33, 34.*
91. Spalding & Bros. *v.* Gamage, A. 30 R. P. C. 388; B. 31 R. P. C. 125, C. A.; C. 32 R. P. C. 273, H. L.; D. 35 R. P. C. 101, C. A. *35.*
92. Spicer, Bros. *v.* Spalding & Hodge, 32 R. P. C. 52. *35.*
93. Standard Woven Fabric Co.'s Application, 35 R. P. C. 53. *30, 31.*
94. Stephens (William) *v.* Cassel, 30 R. P. C. 109. *35.*
95. Sunbeam Motor Car Co.'s Application, 33 R. P. C. 389. *30, 31, 33, 134.*
96. Tatem & Co. *v.* Gaumont Co., 34 R. 181, C. A. *34, 35.*
96*. Teofani *v.* Teofani & Co., A. 30 R. P. C. 70; B. 30 R. P. C. 440, C. A. *30.*
97. Terry *v.* Reddaway, A. 32 R. P. C. 445; B. 33 R. P. C. 209, C. A. *36.*
98. Texas Co.'s Application, 31 R. P. C. 53. *31, 32.*
99. Tokalon *v.* Davidson & Co., A. 31 R. P. C. 74, O. H.; B. 32 R. P. C. 133, I. H. *34.*
100. Universal Winding Co. *v.* Hattersley & Son, 32 R. P. C. 479. *35.*
101. W. & G. du Cros' Application, A. 28 R. P. C. 413; B. 29 R. P. C. 65, C. A.; C. 30 R. P. C. 660, H. L. *30, 31, 105.*
102. W. & G. du Cros *v.* Gold, 30 R. P. C. 117. *35.*
103. Waide & Co.'s Application, 33 R. P. C. 320. *32.*
104. Waring & Gillow *v.* Gillow & Gillow, 33 R. P. C. 173. *36.*
105. White, Tomkins & Courage *v.* United Confectionery Co., 31 R. P. C. 430. *35.*
106. Wigfull & Sons *v.* John Jackson & Son, 33 R. P. C. 97. *32.*
107. Williams' Application, A. 34 R. P. C. 1; B. 34 R. P. C. 197, C. A. *30, 31, 131.*
108. Winget's Application, 36 R. P. C. 75. *30.*
109. Woodward *v.* Boulton Macro & Co., 32 R. P. C. 173. *32, 34.*
110. Wood *v.* Hall, 33 R. P. C. 16. *36.*
111. Wright, Crossley & Co.'s Application, 17 R. P. C. 386. *130.*
112. Yalding Manufacturing Co.'s Application, 33 R. P. C. 285. *30, 31.*

PATENTS AND DESIGNS

INTRODUCTION

PROPERTY IN LETTERS PATENT (Moulton, Ch. I.)

Term of patent (p. 3).—This is now extended to sixteen years. 1919, sec. 6.

Patents of addition (p. 4).—If the original patent is revoked these may now be continued as independent patents. Sec. 19 (3).

Effect of patent against Crown (p. 5).—As to alterations in law, see sec. 29.

Charges on patents (p. 8).—A solicitor for successful respondents to a petition may be entitled to a charge for his costs, not only on their interests in the patent, but also on the interest of parties who did not defend. **25 B.**

Agreements as to patents (p. 9).—For a case where on the construction of an agreement parties were held entitled to challenge validity, see **74***. See also **35.**

Patent Register (p. 10).—As to necessity of registering agreements, etc., see sec. 71.

Rights of co-patentees (p. 11).—A licence by one of two co-owners is no defence to an action for infringement in default of acquiescence by the other co-owner. **130.**

See also notes on "True and First Inventor," *infra.*

NOVELTY AND SUBJECT-MATTER (Moulton, Ch. II.)

Manufacture (p. 15).—There have been a number of decisions in the Patent Office as to what is a manufacture. See notes on Patent Office Procedure, *infra.* Chemical substances, foods and medicines, can no longer be p ' nted *per se*, see sec. 38A.

Patent for .. principle (p. 18).—This question has been discussed in several recent cases. **22 C, 101, 34, 23.**

Validity of grant as a whole (p. 20).—See sec. 32 A.

Long felt want (p. 23). See **14**[*].

Processes of invention (p. 24 n. (r)).—A good example of a patent where it was held that the real merit of the invention lay in the clear appreciation of the problem to be solved ("apprehending the desideratum") will be found in **7**. See also **40**.

Analogous user (p. 30 *et seq.*).—In owing recent cases it has been held that the alleged invention was y a new use of an old device and was not subject-matter.

49. (Use of a form of holder already proposed for a thick razor blade with a thin one.) **131.** (Inserting eyelets into dolls for holding strings.) **88.** (Division of horizontal conveyers into sections to get improved balancing, similar divisions of inclined conveyers being old). **100.** (Use of tubes with slotted ends and screw grips for conduits, similar tubes having been used in bicycles.) **21.** (Use of friction brake for checking slide on boot machine.) **41.** (Use for punching cold blocks of a machine formerly used for punching hot blocks.) **77 A.** (Use of old method of reproducing pictures for reproducing letterpress.) **50.** (Making small air inlet in milking machine to prevent milk being held up by vacuum.) **22.** (Use, in a pulling-over machine, of a last in an inclined position as used in handwork.)

Special method of using machines, etc. (p. 36 n. (t)).—The need for protecting the public against patents limiting the method in which they may use ordinary articles or processes is illustrated in **19** (claim for treating tungsten while working it, it being common practice for metallurgists to test at what temperature a metal could be best worked) and **98** (claim for screwing on a detachable hub to a marked point).

Combinations (p. 41).—The addition of an obvious integer to a claim merely limits the claim without affording subject-matter. **98 C** (at p. 283).

A good illustration of a patentable combination is found in **62** (combination in lamp of heavy metallic nozzle and preheater in thermal connection, effect being to keep nozzle cool and preheater hot).

For illustrations of combinations held not patentable, see **64** (addition to drying machine of old apparatus for continually circulating same air.) and **45** (draw-string for curtains having on it the eyelets for inserting hooks, which eyelets were formerly fixed to the curtains themselves).

Invention by omission (p. 45).—The omission of a part whose use is clearly optional, or which is inserted for a special purpose, is not invention. **49 C** (at p. 481). **38**.

Invention which could not be foreseen (p. 46).—In the following cases the Court found subject-matter largely on the ground that provision of result was not possible:—**89** (at p. 226) (selective action of oil on minerals), **92** (application of method of filament making to metals of new group), **1** (substitution of "boiling" for "fusing" in making sulphur dye from di-nitro-phenol), **46** (at p. 135) (formation of bromo-cyanogen), **73** (application to acetylene lamp of principle of rate of flow being greater than that of ignition).

Result more important than means (p. 48).—For examples of apparently small differences which afforded subject-matter by making the difference between success and failure, see **118** (increase in size of detachable head of pile), **74** (separation of gases in marine flare), **14*** (omnibus guard).

Variations which are not patentable (p. 49).—See the following cases:—**29** (cutting blanks for dog nails in special shape), **98** (screwing detachable hub on outside of permanent hub instead of on inside), **46** (at p. 120) (use of *zinc dust instead of zinc filaments for extracting gold* from solution), **55** (change of shape of fan). See also **117** where, however, the decision was greatly affected by the form of claim.

PUBLIC KNOWLEDGE (Moulton, Ch. III.)

"Effect of publication" (p. 56 *et seq.*).—The Courts have in several instances emphasised that the publication of a combination is a publication of each of its parts. **98 C** (at pp. 277, 284). **71 B**, see also **49 C.**

"Knowledge of equivalents" (p. 56).—The Court may take judicial notice of certain items of general knowledge, *e.g.*, alternative use of nails and screws. **49 C** (at p. 478).

"Person to whom publication must be intelligible" (p. 61).—A prior publication must be taken as read by a man who understands the subject "*not* a mechanical genius but equally *not* a mechanical idiot." **49 C** (at p. 481).

Reading document in light of later knowledge (p. 62).—It now seems clear that an alleged anticipation must be construed in the light of the state of knowledge at the time it was published, and not in the light of the knowledge accumulated up to the date of the patent against which it is quoted. **89** (at p. 224); **75 B** (at p. 381).

Publication without consent of inventor (p. 66).—The law as to this has been somewhat modified. See sec. 41 (2).

Publication by exhibition (p. 66 n. (d)).—Where samples have been issued to the public, the constitution of which would have been revealed by analysis, this constitutes publication or prior user. **114 F.**

Prior user (p. 68).—If a prior user has been deliberate it is sufficient to invalidate a subsequent patent, although the person using the process may not have appreciated its true advantages. **19.**

Experimental user (p. 69 *et seq.*).—For recent cases on this see **114, 19.**

Scientific papers.—As to effect of publication in these, see sec. 45 (1).

TRUE AND FIRST INVENTOR (Moulton, Ch. IV.)

Equitable rights (p. 74 n. (9)).—Where in the course of his employment an engineer devised means to overcome a particular difficulty and took out a patent for the same it was held that he held this as a trustee for his employers. **16***. So where the managing director of a company took out a patent for an invention on which the staff of the company had been employed he was ordered to assign it. **58.** If in such a case the patentee will not execute the assignment this will be done by the Master, *ibid.*

Prior grant (p. 75 *et seq.*).—Where, in an earlier specification than that sued upon, the patentee had apparently shown and claimed the device covered by the later patent, but had also inserted a clause saying that he did not claim anything claimed in the later patent, it was held there was no prior grant. If there were ambiguity in the disclaimer the earlier, not the later, patent would be invalid. **98 B.**

UTILITY (Moulton, Ch. V.)

Failure to produce result claimed (p. 79 *et seq.*).—Where a patentee claimed that he could obtain moving pictures in "approximately natural colours" by the use of two colour filters, instead of the usual three, the patent was held bad for non-utility because the result was less successful than that previously obtained. **113***. This decision was affirmed in the H. L., and the view was also expressed that since the specification claimed to reproduce "approximately natural" colours the patent would be void if there were failure for any colour. **82.** Similarly a patent for a milk powder was held bad because the specification stated that the milk solids were unchanged, which was found to be untrue but not to affect the practical usefulness of the powder. **56.** For a case where a patent claiming to avoid waste was held bad for failure, see **29.**

Success under commercial, rather than scientific, conditions is the criterion taken. **92 C, 34.**

Onus (p. 83).—The onus on this issue is on the defendant or petitioner. **61 B** (at p. 387).

See also notes on "Sufficiency," *infra.*

SUFFICIENCY (Moulton, Ch. VI.)

Ambiguity (p. 37).—It has been held in several recent cases that ambiguity is in itself a fatal objection, *i.e.* if a claim is so drawn, whether intentionally or not, that it can be expanded or contracted at will the patent will be held bad apart from any question of novelty. **82** (at p. 266), **19 A** (at p. 153). See also **73**.

The objection that the claim does not define any invention can be taken whether pleaded or not. **117 A** (at p. 99), **82** (at p. 269).

Test of sufficiency (p. 88).—In the absence of directions to a contrary effect the terms and instructions must be taken as referring to the common knowledge of the day, and the practice of the trade will be held to be incorporated unless expressly varied. **113***, **46**. Where the patent claims to be for an improvement on a process described in a named specification the directions contained in the latter will be read in. **1 C**; but it is not sufficient to refer to a series of scientific papers and say that directions will be found in them. **34**.

Generally speaking, references will be considered as applying to commercial articles rather than to chemically pure substances, and success will be judged by practical rather than scientific standards. **34**, **92 D** (at p. 390).

Workman skilled in the art (p. 89).—The "competent workman" to whom the specification is addressed may be of a composite character, *e.g.*, he may be held to be both a mechanician, and an engineer. **92 D** (at p. 391). He may in some cases be considered to be capable of avoiding pitfalls, *e.g.*, a combination of unsuitable substances, permitted by the wording of the specification. **92 D.**†

Experiment should be unnecessary (p. 90).—This has been emphasised in **113***, **82**, **34**.

Exclusion of unlikely mistake (p. 93 n. (s)). See **92** D.

What need and need not be given (p. 95).—It has now been laid down that it is the *duty* of a patentee to point out the advantages of his invention so far as they are known to him. **29 C** (at p. 307); **64 B** (at p. 560). It is unnecessary to give theory, and even if it is given a mistake will not necessarily invalidate the patent. **92 D** (at p. 393), *aliter* as to statements of results produced. **113***, **82**, **56**.

False suggestions (p. 98). See **113***, **82**.

† This is not a decision which should be relied on in drafting specifications.

Effect of errors (p. 98 *et seq.*).—Errors in drawings may invalidate a patent even if the letterpress suggests how they should be corrected. **63.**

Other points.—The danger of relying on indefinite adjectives such as "deep," "shallow," etc., was pointed out in **117.**

If a direction amounts to "take such articles as will succeed," the specification is insufficient. **118* B** (at p. 250).

DISCONFORMITY (Moulton, Ch. VII.)

There have been no changes in the law or recent decisions on this subject.

CONSTRUCTION (Moulton, Ch. VIII.

Doctrines of construction (pp. 114–115).—In recent cases the Courts have stated that they do not regard a specification as they would a document *inter partes*, to which a meaning must be assigned if possible, but rather as a document drawn up by the patentee to define his rights, which if ambiguous is invalid. **113*, 82, 117.**

Construction of amended specification (p. 118).—The unamended specification may now be referred to for this purpose. Sec. 21 (7).

Patentee not allowed to extend his claim (p. 121).—Where it is proposed to put forward a claim as covering a principle this should be clearly stated. **101.** See also **24 B** and **C.** There have, however, been several instances where claims have been so construed (to the disadvantage of the patentee) owing to wide wording either in the claim or in the body of the specification. **113*, 82, 76, 75, 19.**

Claims primâ facie not coextensive (p. 125).—There have been several decisions showing the tendency of the Courts not to construe different claims as coextensive. **19, 21, 12**; but *cf.* **85.**

"**Substantially as described**" (p. 128).—For a case where claims containing these words were nevertheless construed as claiming a "principle" and the patent was held invalid, see **76.** See also **63.**

Other points.—Where a claim was for certain integers "with or without" another integer, and it was admittedly obvious that the apparatus could not act without this integer or its equivalent, it was nevertheless held that effect must be given to the words "or without" and the claim was held bad, **22 C.**

On the construction of "preferably" at the commencement of a paragraph, see **117 A** (at p. 102).

See also notes on "Sufficiency," *supra*, and "Infringement," *infra*.

INFRINGEMENT (Moulton, Ch. IX.)

Part I.—*Rights depending on the construction of the specification.*

Equivalence to be judged by state of knowledge at date of patent (p. 134 n. (h)).—For a good example of this principle see **1 C** (sodium di-nitro-phenolate held not to be equivalent of di-nitro-phenol). See also **41**.

Functional equivalence (p. 136).—For decisions on this point see **21, 105, 63.** For a case where principle was applied to a chemical patent see **92 D.**

Similarity of effect not necessarily infringement (p. 137 n. (q)).—The following recent decisions illustrate this principle. **89** (Both plaintiff and defendant separated metal from gangue by means of oil, but while patent described use of a large amount of oil, which would have been sufficient to float the metallic particles, defendant only used 1 per cent. of this amount and action depended on a different principle.) **101** (Milking machines in which vacuum periodically formed and relieved in lower chamber, but by different method.) **52** (Knitting machines. Plaintiff's principle applied with modifications to machine of different class.) **83** (Cooling in inverted burner obtained by different method.)

Substitution entailing loss of advantages (p. 140).—For recent cases where infringement was found though the apparatus used by the defendant did not give all the advantages of that patented, see **113** (pile driving), **72** (wireless), **40** (nests of shelves).

For other cases where equivalence not found, see **93** (coin freed apparatus), **87** (wire collar supports).

Accidental infringement (p. 152 n. (b)).—Where defendant's machine, normally acting on a different principle to the patented apparatus, occasionally and accidentally produced patented result it was held not to infringe. **85.**

Other points.—It has been suggested that in some cases the Court may base its decision on the fact that there is no patentable step between what was known before the date of the patent and the alleged infringement, and that therefore the action must fail whatever be the true construction of the specification. **49 C** (at p. 480).

Where a patentee specifies limits in his claim these will be strictly construed, and there is no infringement if the device or process does not come within these limits. **24.**

See also notes on "Construction," *supra.*

Part II.—*Rights depending on the construction of the grant.*

Mere possession (p. 159).—Mere possession and testing of articles with no intention to use them till after the expiry of the patent held not infringement. **94.**

See also notes on "Licenses," *infra.*

PRACTICE AND PROCEDURE (Moulton, Ch. X.)

Parties (p. 165).—*Semble* an exclusive licensee may sue an infringer, who has acted with knowledge of his licence, without making the patentee a party. **111.** For procedure in case of licensees under secs. 24 and 27, see those sections.

Particulars of Breaches (p. 167).—The courts have commented on the ordinary form of the first paragraph of these and expressed the view that it does not comply with the rules. **2.**

Defence (p. 168).—It is no longer permissible to plead non-working as a defence. See sec. 25.

It has been held that a defendant can plead that improper restrictive covenants have been inserted in a contract to which he was not a party. **108.** Nor is he estopped from pleading the insertion of such covenants by any admission that reasonable terms have been offered to him. See sec. 38 (1).

Particulars of objections (p. 169).—The fact that matters are alleged to be within the knowledge of the patentees is no excuse for not giving full particulars. **6 A** and **C.**

It is not permissible to say that defendants will rely on all matters raised in a former action. **6 C.** Full particulars must be given of matters of public knowledge unless they are pleaded as common general knowledge. **20.** Where prior user is pleaded and samples of articles relied on are exhibited it is unnecessary to say in what respects these anticipate **26.** As to particulars to be given where samples not produced, see **114 A.**

Discovery (p. 177).—This is limited to what is relevant to matters raised by pleadings. **6 B.** Documents relating to an amendment of the patent and pleadings in another action need not be disclosed, *ibid.* On

a petition a claim by the petitioners that documents not disclosed (apparently relating to prior user) only helped their case was upheld. **114 A.**

Interrogatories (p. 178).—Plaintiff may interrogate defendant as to whether he uses the various steps of his patented process, but may not ask, "If you do not do this what do you do?" **1 B, 92 A.** Interrogatories will not be allowed based on general allegations of infringement, but only on special instances alleged in Particulars. **2.** Nor will they be allowed as to details not affecting infringement. *Ibid.* Interrogatories allowed as to source from which defendant obtained goods where this might enable plaintiff to prove mode of manufacture. **91 A** and **B.** So also interrogatory allowed as to customers to whom articles constituting alleged prior user were sold, as this might enable patentee to get samples. **114 C.**

Interrogatory allowed as to alteration made in defendant's installation between a given date and time of inspection. **72 A.**

Inspection (p. 180).—As to what are sufficient grounds for an order or inspection of defendant's process and terms of order, see **90.**

Interim Injunction. Undertaking (p. 181).—Where the Secretary of State for War was plaintiff the Court continued an interim injunction without requiring an undertaking as to damages. **112.**

Assessor (p. 185).—An assessor may be appointed on the application of one party only and without evidence. **72 B.** But see sec. 31 (1).

Preliminary points (p. 186).—Though preliminary points of law may be ordered to be tried first the Court will not answer hypothetical questions. **116 B.** Where, after preliminary points had been decided in favour of defendant, the plaintiff applied for leave to discontinue, the action was dismissed. **108 B** (at p. 337).

Onus (p. 186).—The onus on the issue of utility is on defendant. **61 B** (at p. 387).

Evidence (187 *et seq.*).—The functions of expert witnesses were discussed in **34** (at p. 309). They should not be asked their opinion as to the issues in the action or as to the meaning of documents. *Ibid.*

Statements by the defendants in letters and circulars as to their apparatus, which if true would have shown it to be an infringement, were treated as threats to infringe. **24 A.** The higher Courts took a different view as to their effect. **24 B** and **C.**

Statements by the plaintiff before action brought were admitted to show failure of process in **56.**

Fresh evidence on Appeal (p. 190).—Leave to introduce fresh evidence on appeal given. **41 B.** A further application in H. L. refused, **41 C.** Leave refused. **56 B** and **C.**

Relief (p. 191).—Relief may now be granted as to claims held to be valid irrespective of the other claims. Sec. 32 A.

Injunction (p. 191).—Where patent is endorsed "Licences of Right" no injunction will be granted if the defendant is willing to take a licence on terms to be settled by the Comptroller. Sec. 24 (1) (e).

Damages and Profits (pp. 193 *et seq.*).—The right to an account of profits has been taken away. Sec. 34. As to limitation of damages, where patent endorsed "Licences of right," see sec. 24 (1) (e).

The measure of damages was very fully discussed in **129.** Though this is a matter of estimation a reasoned basis should be adopted where possible. The licence principle suggested in *Meters, Ltd.* v. *Metropolitan Gas Meters Ltd.*, **78**, was approved. *Ibid.*

Limitation of damages (p. 198).—Damages may now run from the date of acceptance. Sec. 13. As to damages where patent has been amended see secs. 23 and 32 A.

Certificate of validity (p. 198).—Granted where defendant did not appear at trial, **18**, and where case settled after plaintiff had given some evidence, **48.** Where in a petition for revocation the petitioners agreed to withdraw the petition if certain amendments were made a certificate was granted for the patent as amended, **25.** Where the action was dismissed on the ground of non-infringement a certificate was refused though the judge thought the patent valid, **52.** See *contra*, **89** (certificate granted to unsuccessful appellant). This may now be granted as to some claims only. Sec. 35.

Costs (p. 201 *et seq.*).—Successful defendants ordered to pay costs of issue of infringement, **45.** Refused costs of particulars of objections and ordered to pay costs of issue of non-working. **1 C.** Refused costs of particulars of objections, **56 A.** Costs for three counsel refused, **75 A.**

The fact that petitioners for revocation might have opposed is no ground for depriving them of costs. **10.** As to principles affecting taxation, see **114 G.**

Other points.—For a case where leave was given to defend though judgment had been entered in default of appearance, see **13.**

REVOCATION (Moulton, Ch. XI.)

Grounds (p. 213).—These no longer include non-working, or grounds on which a patent might be revoked as an alternative to a compulsory licence. Sec. 25 (2).

Parties (p. 214).—Licensees, even if exclusive, are not entitled to be heard, but may be if they have been served. **114 D.**

Practice (p. 217).—Where revocation is claimed by counterclaim it may be granted on motion in default of defence to counterclaim. **32.**

For revocation before the Comptroller, see "Patent Office Practice," *infra*. Licences, *infra*.

THREATS (Moulton, Ch. XII.)

The law with regard to these has been altered, so that a threat may be actionable if made by any person claiming to have an interest in the patent, and not merely by a person claiming to be patentee. If, however, such person commences and prosecutes an action with due diligence the *bona fides* of such action can no longer be questioned: See sec. 36.

For a case dealing with the question as to whether circulars were to be considered as general warnings or as directed against the plaintiff's goods, see **14.**

AMENDMENT (Moulton, Ch. XIII.)

Amendment by the Court (p. 232).—This may now be by way of disclaimer, correction or explanation as in the case of amendment when proceedings are not pending. Sec. 22.

As to amendment when some claims are found to be valid and to have been infringed, see sec. 32 A.

Where as the result of an amendment under sec. 21 a specific or statutory reference becomes unnecessary it will be struck out, but will remain in erased type. **80*.**

Construction of amended specification (p. 236).—The Court is now entitled to look at the specification as accepted and published for the purpose of construing an amended specification. Sec. 21.

Infringement before amendment (p. 236).—Damages can now be claimed as from the date of the decision allowing the amendment. Sec. 23. See also sec. 32 A.

The following points appear from recent decisions. An amendment which, whether by way of disclaimer or otherwise, introduces a new step

into the invention, will not be allowed, **17, 121**, nor will one fixing arbitrary limits, which give no advantage, but merely avoid a prior user. **114** F. It is not intended that by amendment a patentee should be enabled to convert a barren specification giving the public no useful information, into one having subject-matter. **17.** The C.A. will not lightly interfere with a judge's exercise of discretion on this subject. *Ibid.*

LICENCES (Moulton Ch. XIV.)

Who can grant (p. 239).—A licence by one co-owner is of no effect in the absence of acquiescence by the other co-owner. **130.**

Licensee suing (p. 240).—*Semble*, an exclusive licensee can sue without joining the patentee. **111.** When another licensee is sued he must be shown to have known of the exclusive licensee's rights when he took his licence, otherwise he may continue to act under it. *Ibid.*

Licence by sale (p. 243).—As to infringement by breach of restrictive conditions, see **30** and **31.**

Duty to keep patent in force (p. 244).—Where the licensor has undertaken to restrain infringement he is responsible for the payment of renewal fees unless otherwise agreed. **35**, following **67**, and distinguishing **80.**

Estoppel on licensee (p. 244).—*Quære* whether the licensee is estopped from disputing validity where the licensor has fraudulently asserted validity. **35.** See also **74*.**

Agreement not to use invention (p. 248).—For a case where an agreement not to use a special form was held not to bar a defence setting up invalidity, see **74*.**

Restrictive conditions (p. 248).—A party to an agreement in which there are such conditions is not estopped by any admission that he was offered a fair alternative. See sec. (38) (1). The existence of such clauses in contracts made by the patentee may be pleaded by any defendant, whether a party to such contract or not. **108.**

The existence of such clauses may give ground for an application for a compulsory licence or revocation. See sec. 27 (2) (*c*).

Compulsory licences (p. 251).—The grounds on which these may be sought have been greatly enlarged. See notes on sec. 27. The application is now made to the Comptroller, with an appeal to the Court. *Ibid.*

Compulsory "exclusive" licences may now be granted. *Ibid.* The only

decision on compulsory licences has been **104**, and the effect of this decision is much reduced by sec. 27, *q.v.*

"Licences of right"—Patents may now be so endorsed, and then only one half the usual renewal fees are charged. Licences under such patents may be obtained on terms fixed by the Comptroller. See sec. 24.

PATENT OFFICE PRACTICE (Moulton Ch. XV.)

Procedure (p. 253).—The following changes have been made in the ordinary procedure for the grant of patents:—

The time for lodging the complete specification has been extended to nine months, sec. 5, and the time for its acceptance has been extended to fifteen months, sec. 6 (5). In case of disconformity a new application may be lodged for the disconforming part, bearing the date when the complete specification was filed, sec. 6 (3). An appeal will lie as to any decision of the comptroller under secs. 6, 7 or 8. There would seem to be a doubt whether the comptroller is bound to hear the applicant before making a decision, but see note to sec. 7 (4).

The period for the sealing of a patent is extended to eighteen months; which may be extended in the case of opposition by the Comptroller without reference to the Law Officer. The time may also be extended (subject to the rules) where the applicant has failed to comply with any requirement. See also notes on "Opposition," *infra:*

Where the applicant has agreed to assign his rights in the patent the comptroller may allow the assignee to proceed with the application, and he may allow one joint applicant to proceed. Sec. 12 (1).

Office objections (p. 255).—There have been several recent decisions in the Patent Office as to what is a "manufacture." The following have been held not to be manufactures. Use of a known substance as insecticide, **3**, or as manure. **8**. A mere discovery, *e.g.*, as to the best rotation of crops. **54***. A scheme for arranging markings on buoys so that the position of a ship could be more easily determined. **128**.

In **8**, *supra*, it was practically laid down that the new use of an old substance was not patentable. This would appear to be in direct opposition to such cases as **81*** or **59***. See Moulton, p. 39 n. (l). An invention to be patentable must have some connection with trade or commerce. **27**. A method for extracting lead from the human body would not be patentable. *Ibid.*

A fresh ground of objection is now open to the office, viz. that there are claims for new chemical substances *per se*. Sec. 38 A.

Convention applications (p. 259).—Fraud outside this country will not be considered on these applications, **36**, **54**, but possibly a different rule

might apply if the Patent Office to which the first application was made had found fraud. 1918 C. An assignee can now apply, Patents and Designs Act, 1914, sec. 1. The Comptroller may ask if an assignment of rights has taken place, and, *semble*, if it has the assignee should apply. **39.** Amendments of such applications will only be allowed with great care. **5.** The date of application under the convention cannot be used for the purposes of opposition under sec. (1) (*d*) (Disconformity). 1918 A.

See also under "Opposition" and "Treaty Rights," *infra*.

Patents of addition (p. 262).—A patent of addition must be for an improvement in an invention covered by a patent owned by the applicant, and must not claim improvements in other inventions. **53.**

If the main patent is revoked the patent of addition may, if the Court or Comptroller so directs, become an independent patent expiring at the date when the main patent would have expired. Sec. 19 (3).

Opposition (p. 263).—There are two new grounds of opposition, viz. that the invention has been published in any document (other than a British Specification) published here prior to the application, sec. **11** (1) (*b*), or that, in the case of a convention application the specification claims an invention other than that originally applied for, and that the opponent has lodged an application for such invention in the interval. Sec. 11 (1) (*e*).

Locus (p. 264).—The ground (*b*) as extended would seem to give any person a locus, unless the rule of "manufacturing interest" is applied. See note on sec. 11 (1) (*b*).

Where the opposition is on ground of a trading interest there must be actual present use. Exhibition of an article with a view to forming a company to make it is not enough. **84.** The use of the opponents registered trade name gives a locus to oppose under sec. 11 (1) (*c*), 1914 A.

First ground (p. 265).—The Comptroller has now power to grant to the true inventor (of the whole or part) a patent for his invention bearing the date of the patent which had been refused. Sec. 15 (2).

Where the fraud is clear a patent will be refused, otherwise the opponent will be left to petition. The Law Officer will admit fresh evidence unless there is good reason to the contrary. **28.**

Second ground (p. 266).—If the inventions are really the same it does not matter that different terms are used. **86.**

Third ground (p. 271).—Where an invention was said to be for improvements in "Permutit," which was the opponents' registered Trade Mark,

this word was ordered to be struck out. 1914 A. Where an invention can be made out from the specification a patent will not be refused merely because the invention might have been expressed more clearly. Obscurity in translated specifications may be expected. **109.**

Fourth ground (p. 271).—A fair development of the original invention is no objection. **106.** The date of the opponent's "application" is that of the application in this country, and not the convention date. 1913 A.

References (p. 272 *et seq.*).—A reference will *not* be *inserted on the* ground of a "Master Patent" unless its absence would lead to confusion. **124, 102.** *Quære* whether the claim of a prior specification to be a "Master Patent" is affected by what is described, but not claimed, in a specification not published at its date. **65.**

Where the office insisted on a statutory reference and the applicant appealed, he was not allowed to amend, so as to avoid the reference. **51.**

Revocation (p. 279).—The new grounds for opposition are also of course grounds for revocation.

Revocation will be refused where the respondent's device would not infringe the applicant's patent. **11.** This would not now apply in an opposition on ground (*b*).

Amendment (p. 279).—Where as the result of an amendment under sec. 21 a specification or statutory reference becomes unnecessary it will be struck out, but will remain in erased type. **80*.**

See also notes on "Amendment," *supra.*

Appeal (p. 283).—An appeal to the Law Officer is a rehearing, and he will form his own opinion. **106.** In cases of fraud he will admit fresh evidence unless there is good ground for refusing it. **28.**

In the case of an appeal to the Court against an order revoking a patent, the right to further appeal is determined by whether or not the decision of the Court is for revocation. Sec. 92 (2).

Restoration (p. 282).—Delay will generally be reckoned from discovery of lapse. 1913 D. Here ten months held too long. Private considerations, *e.g.*, disputes as to liability to pay, cannot excuse delay. *Ibid.* See also Treaty Rights, *infra.*

Register (p. 286).—Unregistered documents are generally not receivable as evidence. Sec. 71.

Costs (p. 287).—The right of the Comptroller to give costs is now extended to all cases. Sec. 73 A (1). Where an opponent, applicant for

revocation, or appellant is not resident in this country he may be ordered to give security for costs. Sec. 78 A (2).

Patent agents (p. 288).—It is now an offence to practise as a patent agent unless registered. Sec. 84.

Patentee (p. 291).—This now means the person entered on the register as proprietor. Sec. 93.

Drafting of Specifications (p. 292). See note to sec. 38 A.

Other points.—The results of the searches made against any patent may now be disclosed. Sec. 68.

NON-WORKING (Moulton, Ch. XVI.)

The whole law dealing with this subject has been changed by the amendment of sec. 27. These changes, which are fully dealt with in the notes on this section, render many of the former decisions of little value. The following may, however, be noted :—

"Patented article" means article covered by any of the claims of the patent. Where non-working in this country was proved as to some claims only the patent was revoked, but the order was suspended to give the patentee an opportunity to apply to disclaim these claims. **126.** The argument that American castings more suitable to the machine rejected and commented on. It was held that advertisements and offers of licences were not sufficient. *Ibid.*

Where a portion only of a machine is covered by the patent, it is sufficient if this portion was made here and inserted into imported machine. The question of working after application but before hearing discussed. **127.**

Even where the claim is "in a . . . machine the use of . . ." a certain part, it is sufficient if the machines are made here, although they are used abroad. **57.**

The whole onus is on the applicant. **104.**

In cases of non-working compulsory licences, exclusive or not, are now the ordinary remedies, revocation only being ordered in exceptional cases. See sec. 27. The grounds on which such an order may be sought can no longer be pleaded in a petition for revocation or as to a defence to an action for infringement. Sec. 25 (2). See notes to sec. 27 and "Licences," *supra*.

PROLONGATION OF PATENTS (Moulton, Ch. XVII.)

Special provisions have been introduced for the benefit of patentees who have suffered as such through hostilities, whether the loss arose from difficulties in regard to manufacture or from the fact that the patentee was engaged on national service. In such cases the Court may confine itself solely to the question of the loss so suffered without necessarily considering special merit, general remuneration, etc. In those cases the application may be made by originating summons instead of by petition. Nationals of States which were at war with this country are excluded from the benefit of these provisions. Sec. 18 (6).

Essential matters (p. 305).—As to these see **43.**

Merit (p. 306).—As to great utility counterbalancing lack of any great novelty, see **44.** See also **59.**

Remuneration (p. 308).—In several recent cases prolongation has been granted where considerable profits have been made, *e.g.*, **120** (£17,000) **79** (£15,000), **33** (£12,000). For petitions refused on this ground, see *inter alia*, **43.** See also **103.**

Accounts (p. 309).—As to what should be included, see **97.** As to allowances, see **120.**

Efforts of patentee (p. 312).—Long delay in commercial development was held to be accounted for by the fact that the Government was the only possible customer, **33**, that the use of telephone lines had to be obtained, **103**, that a factory had to be built to produce the raw materials required. **120.**

The Court may take into account the loss or damage caused to the patentee by the war. See sec. 18 (4). This has already been done, *e.g.*, in **44** and **81.**

Validity not considered (p. 312).—Extension will not be granted when some claims are obviously bad. **125.** See also **43** (at p. 71).

Assignee (p. 313).—An assignee is in a less favourable position than the original inventor, **107**, but an extension was granted to a second assignee in **103.**

Uberrima Fides (p. 316).—See **97.**

Procedure (p. 317).—The Court has power to extend the time for the presentation of a petition. Sec. 18 (1).

A petition may by leave be served in the vacation. **115.** Leave has

been given to foreign petitioners to prove title, accounts, etc., by affidavit. **110.** As to procedure by originating summons, *vide supra*.

Order and condition (p. 318).—An extension may be as to certain claims only. **42.** Terms have been imposed providing for remuneration to original inventor, **103**; alterations in agreements, **42**; and licences. **42** and **37.**

Term of extension (p. 319).—This has been decreased to five years, or in exceptional cases ten years. Sec. 18 (5).

The following is a list of the cases where extensions have been granted since 1912 :—

33 (Wheatstone translator), **59** (Boiler), **42** (spinning machinery), **79** (thrust bearings), **81** (wheels and tyres), seven years.

103 (telautograph), **37** (producing vacuum and separating gases), **118** (range finders), five years.

120 (removing magnesium chloride, etc., from brine), **44** (improvements in otter boards), three years.

DESIGNS

There is a new definition of "design," sec. 93. It emphasises, as had already been done by the Courts, the fact that the registered features must appeal to, and be solely judged by, the eye. Modes and principles of construction are excluded from being registrable features, as is also "anything which is in substance a mere mechanical device." The effect of this last exclusion is not very clear, possibly it is meant to exclude cases where small alterations are made for merely mechanical reasons, *cf.* **4** and **16.**

Some small changes have been made in the procedure, etc., the most important of which are that an appeal against a refusal to register now goes to the Court, sec. 49 (3), and that where a design is registered in two or more classes at different times all the registrations expire simultaneously. Sec. 50.

An application to cancel a design on the ground of prior publication may now be made to the Comptroller. Sec. 58. The registration of a design is now effective against the Crown. Sec. 58 A.

There have been few recent decisions as to designs, and these have not been of general importance.

It has been decided that a fount of type may be registered as a design, **116 A**, but if so registered as a whole it only protects the use of the letters in the order there shown. *Ibid.*

Combination designs were discussed in **95**, and the rule was laid down that putting together the leading features of goods already on the market

(in this case rubber heels) where this involves no mental effort, does not constitute novelty.

If the design is really for a means of production it is bad. **96.** See also new definition of "Design" in sec. 93.

The right of the Court to find that the design was not novel on grounds not raised by the objections was affirmed in **122.**

The necessity for clearly showing the features on which novelty is founded was emphasised in **122** and **96.**

The principle that the utility of the alteration will not be considered was followed in **4** and **16.**

The fact that the new design has had a large sale may, however, be evidence of the materiality of the alteration. **95 B** (at p. 87).

In the following cases no novelty was found: **95** (rubber heels), **4** (control finger), **122** (switchboard cover), and **16** (trolley wire). The only contested case where novelty was found was **60**, and here the design was held not to be infringed.

Where a design had been sent to a customer before registration with a view to getting an order, this was held to be publication. **16.**

Accidental wrong marking was held not to invalidate a design. **122.**

Cancellation of a design by consent is not permitted while proceedings in Court are pending. **9.**

It is doubtful whether the Palatine Court can entertain an application for cancellation. **16.**

NON-WORKING

The Comptroller may now adjourn an application where he considers that there has not been sufficient time to develop manufacture here. He may also grant a compulsory licence in lieu of cancelling the design. See sec. 58.

Where an application for cancellation on this ground was made five months after registration, it was dismissed without costs. **119.** Generally the proprietor has the right to a reasonable time for commencing manufacture here, but there may be designs of an ephemeral nature where manufacture should commence immediately. *Ibid.*

CASES REFERRING TO ALIEN ENEMIES AND EMERGENCY LEGISLATION

Where an alien enemy is in the position of plaintiff or *actor* a case or appeal cannot be heard during hostilities, even if a British company is co-plaintiff, **1 D**, *aliter*, if the British company had sued alone, though trustee for enemy, *ibid.*, or if British company sues in name of enemy under right given by agreement. **76.**

Where the alien enemies are in the position of defendants or respondents to a petition they may be heard, may appeal and may take defensive steps such as applying to amend. **77 B, 114 B.**

It was held that the power to grant licences under enemy owned patents, etc., was not confined to cases where the whole interest was vested in enemies. **15.** As to prohibition, see **99.**

The Comptroller under emergency powers can extend the times for doing certain acts in the Courts, *e.g.*, for presenting a petition for prolongation. **182.**

TREATY RIGHTS

The Allied and Associated States which were parties to the recent treaties with Germany and Austria were the British Empire, France, Italy, Japan, and the U.S.A. (called the Principal Allied and Associated Powers), and Belgium, Bolivia,* Brazil,* China, Cuba, Ecuador,* Greece, Guatemala,* Haiti,* The Hedjas,* Honduras,* Liberia,* Nicaragua, Panama, Peru,* Poland, Portugal, Roumania, The Serb-Croat-Slovene State, Siam, Czecho-Slovakia and Uruguay.* The German Treaty came into force 10th January, 1920.

These treaties, however, only bind such powers as finally ratify them, while, on the other hand, other States may adhere to them.

The rights with regard to German owned patents or designs in this country are as follows :—

There can be no action for infringement during the war, and articles made prior to 28th June, 1919, may be sold in any Allied or Associated State up to 28th June, 1920, and any purchaser may continue to use the articles.

Any German owned patent or design which has expired owing to non-payment of fees, etc., may be revived, patents, etc., may be granted on applications made before or during the war, but such patents, etc., will be subject to all the powers as to licences, etc., which were given by emergency legislation during the war, and conditions may be imposed to protect persons who have manufactured. No additional fees are payable for such extensions or renewals.

All licences were terminated at the beginning of the war, but former licensees may demand fresh licences on terms to be settled by the Comptroller.

In the case of patents, applications, etc., owned by subjects of Allied and Associated States, and which had lapsed during the war, similar provisions apply except as to the powers given by emergency legislation. No action can be brought for infringements during the period of abeyance.

Where an application has been made in a Convention State the period

* These States signed the Treaty with Germany only.

for application in other States (if it had not expired before 1st August, 1914), is prolonged to six months after the German treaty came into force.

Generally speaking non-user between the beginning of the war and 10th January, 1922, will not lead to revocation. There are wide powers for the compulsory sale of enemy owned patents.

It must be remembered that these rights, etc., are given by States who have signed the Treaty to subjects of other signatory States. They do not necessarily bind a government as regards its own subjects. It is, however, understood that the British (and probably the Colonial) Patent Offices are extending to British subjects the same facilities for extensions, etc., as the Treaty gives to subjects of Allied States.*

The provisions of the Austrian Treaty are substantially the same as the German, but for the 28th June, 1919 and 1920, the 10th September in each year must be substituted, and times run from the date when this treaty comes into force, which date has not yet been fixed.

According to the practice of the British Patent Office these extensions do not apply to acts due to be done after the Treaties comes into force. Thus if a Convention specification should have been filed on 1st January, 1920, it may be filed (under the German Treaty) up to 10th July, 1920, but if the date were March 1st, 1920, it must be filed on that date. If a patent has become void for non-payment of fees, any fees which would have normally become due on it after 10th January, 1920, must be tendered on the due date, though the fees for past years may be paid up to 10th January, 1921. The patent will not be revived till all back fees have been paid, and if it is not revived the fee so tendered will *not* be returned.

Extensions may, however, still be granted under the Emergency Rules; but this will be done sparingly.

It would seem that Nationals of States that were parties to both Treaties could claim the longer extensions granted by the Austrian Treaty.

* For a fuller treatment of this subject see the Author's "The Business Man's Guide to the Peace Treaty" (Geo. Allen & Unwin).

TRADE MARKS

INTRODUCTION

REGISTRATION

Essential Particulars

Sec. 9 (1).—As to what is a particular or special manner, see **18, 10**; ordinary handwriting is not. **18.**

Sec. 9 (3).—The following have been held to be invented words: "Chocaroons," **107**; "Standwal," **93**; "Parlograph," **53.** "Arsenoid" was held not to be. **112.**

A mere reversal of a name as Gnidroc for "Cording" is not an invented word, but Nidroc was allowed to be registered. **28.**

Sec. 9 (4).—The following were held to be words not directly referring to the character or quality of the goods: "National," **66**; "Regimental," **47**; "Classic" and "Victor" were held to have such reference, **83, 59**, as was "Ribbon" for dental cream. **26.** "Standwal" held to be not geographical (though there is a village of Stanwell), **93**, nor "Berna" (Italian form of Berne). **11.**

Sec. 9 (5).—In future the Registrar will be able to register word marks which are in fact distinctive without the necessity of an order from the Board of Trade or the Court. See sec. 9 (5). He may in such cases advertise the mark before acceptance and take the application and opposition stages together. Sec. 13.

In the following cases proper names were put or kept on the register:—"Moore and Moore," **62**; "Muratti," **65**; "Burford," **19**; "Lodge," **56**; "Avery," **6**; "Winget," **108**; "Cadbury," **22**, and "Teofani," **96***. The following were refused:—"Slazenger," **87**; "Crawford," **29**; "Boardman's," **49.** Among the grounds influencing the Court were unusualness of name, **65, 96*, 108**, though this in itself not enough, **87**, length of user (the two shortest successful users were "Lodge," eleven years, **56**, "Burford," three years only in this country, **19**), and nature of trade. **19, 108.** The subject is well discussed in **19**, where also other names that have been registered are given. Letters are generally not adapted to distinguish, **101, 39**, but an unusual combination might be. **101, 5.** "W. & G" (either in block or script) was refused, **101**, also "Ogee," **39**, but "A.B.C." was supported. **5.** Combination words put on under this power include "Sheffield Simplex," **84**; "Sunbeam Coatalen." **95.**

Certain words, such as "Classic," have been held to be incapable of acquiring distinctiveness by any amount of user.† **88.**

As to what can be a distinctive mark, see **76** (red and blue lines in hose), **13 A** (at p. 61), **13 B** (at p. 596) (piece of Bowden wire in distinctive shape).

A new class of mark called Class B Mark with different essentials for registrability has been created. These marks are fully treated in the notes to sects. 1 to 5 of the 1919 Act.

Discretion of the Registrar

The fact that the mark comes within these definitions only makes a *primâ facie* case for registration, and the Registrar has a discretion to refuse any mark. **101, 39.** His discretion may be rightly exercised *in limine*, **101**, and will not be lightly overruled, **112**, but it is a judicial discretion, and the Courts should interfere when it is exercised on wrong principles or for fanciful reasons. **93, 66.** One ground on which such discretion has been freely exercised is that the word proposed to be registered has been used as the name of an article, whether patented or unpatented, and not as a mark of origin. Cases where this ground has prevailed are **107** (Chocaroons), **33** (Demos); for cases where it has not see **53** (Parlograph), **56** (Lodge), **95** (Sunbeam), **69** (Alundum). Words which are the name or only practicable description of a patented article or single chemical substance are not capable of being registered or remaining as Trade Marks, see 1919, sec. 6. Registration of a mark representing a patented article was refused in **63**, but *cf.* **13 A.** Again, where it appears that the applicant has no intention of using the mark registration will be refused.. **68.** See also **5.** Where the applicant is trading illegally (*e.g.* in defiance of the Registration of Business Names Act, 1916), registration may be refused, but should not be if the infringement is merely technical. **58.** On the other hand, the absence of merit in an opponent is immaterial. **43.** As to refusal of registration where there has been user by others, even if limited, see **67, 43.** Marks may be registered where there is an agreement as to division of the mark between different firms in respect to articles, **95**, or place, **11**, but apart from such agreement it is undesirable that a mark used abroad should be registered here by another proprietor. **67.**

Resemblance to Mark already Registered

Although it is still held that the onus is on the applicant to show that there is no risk of confusion, **44**, the Courts have in several recent cases said that they must consider probabilities rather than possibilities. **31, 98, 50, 68, 7, 90, 57.** Where the marks are really different, and there is no reason for suspicion as to the applicant's motives, the possibility of the new

† As to how far the user relied on has to be user as Trade Mark, see **87, 29, 39, 22.**

goods being called by a name which is, or may be, applied to the opponent's mark is insufficient for rejection, **90, 7, 68, 98.** This applies particularly where registration is sought under sec. 21 on the ground of concurrent use. **50, 57.** In the following cases of word marks the marks sought were held not too near the opponent's marks: "Anchola" to "Anchovette," **103**; "Swankie" to "Swan," **31**; "Herogen" to "Coregen," **16**; "Limit" to "Summit," **88.** On the other hand, "Mallagole" was held too near to "Mallat," **44**, and "Victor" to "Victory," **59.** See also cases under "Infringement," *infra*.

The fact that certain parts of the mark are likely to be obscured in use may tell for the applicant, **50**, or against him. **81.**

Marks Disentitled to Protection

The meaning of sec. 11 has been frequently discussed, and it has been held that a mark does not come within it because it lacks the characteristics required by sec. 9, or because it is common to the trade. The marks at which the section is aimed are those which are fraudulent or *contra bonos mores*. **46, 47,** overruling **106.** *Quære* whether a mark can come within this section by reason of legislation subsequent to its registration. **46 A.**

Old Marks

The Courts have now decided that sec. 41 bears its natural interpretation, and that original registrability of the Trade Mark cannot be attacked except where the registration was obtained by fraud, or the mark itself is fraudulent or *contra bonos mores*. **47,** overruling **106.** See also **46, 109, 85.**

Concurrent User

In order to justify registration such user must have been honest throughout. **25.** Generally this implies that it was in ignorance of the other person's use of the mark. *Ibid.*

It is doubtful whether user by permission of the owner of the other mark would suffice. **78.** The registrar could only register under sec. 20 when the applications were contemporaneous, and where a mark irregularly registered under this section the Court, although holding it had power to keep it on under sec. 21 removed it. *Ibid.*

Under the new Act the Registrar has additional powers in this respect. See Sec. 21:

Marks were registered under sec. 21 in the following cases: **50** and **57.**

Similar Goods

In deciding whether an application is in respect of similar goods the office system of classification is no criterion. **86.**

Motor cars and cycles were held not similar, **95**, as were pig products and condensed milk, though these would be sold in the same shops. **50**. Bandeaux for hats and corsets were held to be similar, and the Judge was of opinion that all articles of ladies' clothing might be considered as similar goods. **86**.

The Court, however, will not decide in what class a mark should be registered, but will leave this to the Registrar. **90 B** (at p. 254).

Modifications in Office Procedure

In future the Registrar will have power to put any registrable mark (except special marks registered under sec. 62) on the register without the necessity of an order of the Court or the Board of Trade. Secs. 9 (5) and 21. All appeals in contested cases are to be to the Court. See 1919, sec. 8.

The Registrar has power to impose limitations and conditions in all cases. See secs. 12, 13, 14, 23, etc.

He has power to consider evidence as to distinctiveness in fact, trade customs, etc. See secs. 9 (5) and 43.

All applications for rectification may be made to him, unless an action is pending, 1919, sec. 9.

He has power to award costs in all cases. 1919, sec. 10.

As to Class B marks, see 1919, secs. 1–5, and notes thereon.

Limitations.—As to limitations on form of user, see **76**.

The Registrar and Courts have increased powers as to limitations, as stated above, which render certain former decisions inapplicable.

Disclaimers.—The principles governing disclaimers were discussed in **23**, and it was there held that applicants need not disclaim the word "Tudor" in a label, though other firms used it. See also **21**.

Rectification

A mark may be expunged on the ground that the proprietor has misused it by granting a licence in gross. **13**. Applications for rectification may now be made in the first instance to the Registrar except where an action is pending. 1919, sec. 9. Power is given on such an application to transfer a mark from Class A to Class B. *Ibid.*

As to rectification where the mark is the name of certain articles, see 1919, sec. 6.

It is doubtful whether an association such as the Royal Warrant Holders' Association is a person aggrieved. **46**.

See also notes on "Old Marks," *supra*, and "Non-user," *infra*.

Non-User

It has been held that where the mark has been actually used on the goods it cannot be removed on the ground that it was merely used as a mark of quality and in conjunction with another Trade Mark. **5.**

Where there has been user on some articles only the Court may limit instead of expunging. **20.** Where the owner has abandoned trade the mark will be expunged, **78.** See also **35.**

Where the Mark has been registered without any intention of using it, it may be expunged on this ground. **5.** See also **68.**

As to non-user during the war, etc., see "Treaty Rights," *infra*.

Infringement

Word Marks.—In the following cases infringement was found: "Oxot" of "Oxo," **71**; "Onsoria" of "Anzora." **52.** In the following there was held to be no infringement: "The Regiment" of "Regimental," **47**; "Mendit" of "Mendine" (use of "Mend" disclaimed), **27**; "Lavroma" of "Lavona," **99**; "Rito" of "Lito" or "Y-To," **38**; "A.B.C." of "A." "B." or "AB." **5.**

The Court in a clear case will decide as to similarity without evidence. **99.** In judging similarity for infringement purposes it has been said that the fact that the plaintiff's goods have acquired a name, and that the defendant's marking suggests this name, is immaterial. **96.** *Aliter* in passing-off cases. *Ibid.* For effect of distinctive colouring, see **34.**

It has been doubted whether the protection afforded by sec. 44 extends to cases where the mark was registered before 1905, **109**, also as to whether it covers a case where the defendant has knowingly used the registered name, when other names equally appropriate were available. *Ibid.*

In the case of marks in Class B there are special defences open. See 1919, sec. 4.

Practice and Procedure in the Courts

In future all appeals from the Registrar will be to the Court, who will have all the discretionary powers of the Registrar. 1919, sec. 8. In all proceedings as to Trade Marks evidence of trade customs, get up, etc., will be receivable. Sec. 43.

Miscellaneous points.—It has been held that in Patent, Design, and Trade Mark cases publicity is desirable, and that the plaintiff is entitled to move for an injunction in Court even where the defendant is willing to consent. **89.** Where a Court decides in favour of registration, the mark will be registered at once, even though opponent appeals. **90 B.** An

innocent purchaser of goods bearing an infringing mark, who is sued for infringement, can claim indemnity from the person from whom he has purchased, and recover by third party procedure. **9.**

In practically all cases of appeals from Registrar, he has been given his costs in the first Court, but there is no fixed rule as to costs in the C. A. **19 B.**

Royal arms, etc.—For injunctions granted under sec. 68, see **79** and **80.**

Passing Off

Grounds of action.—An action is sustainable for representing goods of the plaintiffs of one quality as their goods of a superior quality, **91**, the damages in such case may include a sum for injury to reputation. **91 E.**

An action for representing an old song of the plaintiff as a more recent one failed, largely on the ground that there was no clear distinction between the two classes. **42.** Generally the action does not survive against an executor. **40.**

Acts giving cause of action.—Supplying books on a contract which stipulated that they should be bound in plaintiff's material, **17**, getting customers to hire defendant's cabs, **102**, supplying article not of plaintiff's manufacture, even though it bore a label showing this, **72**, but *cf.* **27.** As to misleading advertisements, see **91.** Where a misleading advertisement has been issued it may be held to affect the meaning of later ones, which are apparently unobjectionable. *Ibid.*

If A supplies B with articles with which B can deceive C, this may be actionable. **15.**

As to change of get-up where original trade legitimate, see **40.**

A master may be held responsible for the acts of his servants, even if against his orders. **14** and **70.**

Where there is no evidence of actual deception, the fact that the trade of the parties is in different goods, or in different qualities of the same goods, tells against the probability of confusion, **5**, **15**, but this is not decisive. **91**, **37.** Considerations of the impropriety of the defendant's conduct, except in so far as it tends to pass off his goods as the plaintiff's, are irrelevant. **5**, **45.**

Distinctive and descriptive names.—The following have been held to be descriptive: "Magazine of Fiction," **94**; "Universal Winder," **100**; "Bowden Control." **12.** "Goddard's Plate Powder" was held distinctive. **40.**

Similarity.—For cases as to similarity of get-up, etc., see **102**, **92**, where the plaintiffs succeeded, and **27**, **105**, where they failed. The question of whether the get-up would lead to the goods bearing the same name is relevant, **96**, but not decisive. **7**, **90.**

Other points.—As to amount of user necessary to establish plaintiff's title, see **27**, **40**.

As to the effect of local user by others, see **40**.

As to loss of rights through discontinuance of trade, see **73**, and **3**.

Trade Name

An action may be sustainable where the confusion caused is not to purchasers, but to persons who habitually sell raw materials to the company. **75**.

The following were held to be too near: "Buttercup Margarine Co." to "Buttercup Dairy Co.," **37**; "Albion Carriage and Motor Body Works" to "Albion Motor Car Co." **2**. An action by Baird & Tatlock (London), Ltd. against "Baird & Tatlock, Ltd." failed. **8**.

Where the plaintiff's name was the "A.G.S. Manufacturing Co." and the defendants the "Aeroplane General Sundries Co." an injunction was granted against the latter representing that the letters A.G.S. meant that Company. **1**. In another case it was held that the defendants must not call their premises by the name of the plaintiff's works. **75**.

Injunctions against the defendant trading in his own name were granted in **60** and **110**. Injunctions were refused in **15**, **104**, **8**.

Trade Secret

An employee who acquires in the course of his employment knowledge of a trade secret can be restrained from disclosing it, even in the absence of express agreement. **4**. See also **55**. Where a company had agreed not to disclose a secret process more than was reasonably necessary, it was held that the sale of such secret process in gross was a breach of contract, and that the damages were at large. **97**. *Quære* whether a disclosure on the transfer of their whole business would have been a breach. *Ibid.*

In an action a document referring to a trade secret must be produced if material, **77**, but *cf.* **4**, where an injunction against disclosure of a trade secret was granted without the process being disclosed to the Court.

Alien Enemies

For cases on this subject see Introduction to Patent Section.

Treaty Rights

The provisions are substantially similar to those with regard to Patents and Designs, *q.v.*, but no further licences may be granted under Enemy owned Trade Marks, and in the case of Trade Marks, owned by subjects of Allied and Associated States, which have been in abeyance, users during such abeyance are not necessarily protected.

PATENTS AND DESIGNS ACT, 1907.

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks. [28*th August*, 1907.]

BE it enacted by the King'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.

PATENTS.

Application for and Grant of Patent.

1. Application.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The 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 at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

2. Specifications.—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) In the case of any provisional or complete specification where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance

of the same, and such drawings shall be deemed to form part of the said specification.

(4) 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.

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.

3. Proceedings upon application.—(1) The Comptroller General of Patents, Designs, and Trade Marks (hereinafter referred to as the comptroller) shall refer every application to an examiner.

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings 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 refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

(3) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

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

4. Provisional protection.—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 invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

5. Time for leaving complete specification.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within [six] *nine* months from the date of the application:

Provided that where an application is made for an extension of the time for leaving a complete specification, the comptroller shall, on payment

of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

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

6. Comparison of provisional and complete specification.—(1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the comptroller may—

(*a*) refuse to accept the complete specification until it has been amended to his satisfaction; or

(*b*) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:

Provided that where the complete specification includes an invention not included in the provisional specification, the comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and [treat the claim] *allow an application* for the additional invention included in the complete specification *to be made and treated* as an application for that invention made on the date at which the complete specification was left.

(4) [A refusal of the comptroller to accept a complete specification shall be subject to appeal] *An appeal shall lie from the decision of the comptroller under this section* to the law officer, who 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.

(5) Unless a complete specification is accepted within [twelve] *fifteen* months from the date of the application, the application shall (except where an appeal has been lodged) become void:

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.

Sub-sec. (3). There seems to be no reason why there should not be one patent on the two applications. See sec. 16 (1).

Sub-sec. (4). The amendment makes it clear that there is an appeal when the Comptroller insists on the specification being divided under sub-sec. (3), and, in fact, in any case where there is not an unconditional acceptance.

7. Investigation of previous specifications in United Kingdom on applications for patents.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the comptroller is satisfied that an objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the comptroller is not so satisfied, he shall, [after hearing the applicant, and] unless the objection is removed by amending the specification to the satisfaction of the comptroller, determine whether a reference to any, and, if so, what prior specification ought to be made in the specification by way of notice to the public :

Provided that the comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.

(5) An appeal shall lie from the decision of the comptroller under this section to the law officer.

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connexion with, any such investigation or report, or any proceeding consequent thereon.

The words left out in sub-sec. (4) are probably omitted as unnecessary in view of sec. 73. Sub-sec. (6) is transferred to sec. 8.

8. Investigation of specifications published subsequently to application.

—(1) An investigation under the last proceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior application; and that section shall, subject to rules under this Act, have effect accordingly.

(1) *In addition to the investigation under the last preceding section, the examiner shall make an investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed in any specification published on or after the date of the application and deposited pursuant to a prior application.*

(2) [Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any publishod specification deposited pursuant to a prior application,] *Where on such further investigation it appears that the invention claimed has been wholly or in part claimed in any such specification*, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.

(3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.

(4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

(4) *An appeal shall lie from the decision of the comptroller under this section to the law officer.*

(5) *The investigations and reports required by this and the last preceding section shall not be held in any way to guarantee the validity of any patent and no liability shall be incurred by the Board of Trade or any officer thereof by reason of or in connection with any such investigation or report or any proceedings consequent thereon.*

These amendments would seem to be merely verbal and to make no change in the law.

9. Advertisement on acceptance of complete specification.—On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.

10. Effect of acceptance of complete specification.—After the acceptance

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

11. Opposition to grant of patent.—(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 any of the following grounds :—

(*a*) that the applicant obtained the invention from him, or from a person of whom he is the legal representative ; or

(*b*) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent ; or

(b) that the invention has been published in any complete specification, or in any provisional specification followed by a complete specification deposited pursuant to any application made in the United Kingdom within fifty years next before the date of the application for the patent the grant of which is being opposed, or has been made available to the public by publication in any document (other than a British specification) published in the United Kingdom prior to the application ; or

(bb) that the invention has been claimed in any complete specification for a British patent which though not published at the date of the application for a patent the grant of which is opposed was deposited pursuant to an application for a patent which is or will be of prior date to such patent ; or

(*c*) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification ; or

(*d*) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, or

(e) that in the case of an application under section ninety-one of this Act a specification describes or claims an invention other than that for which protection has been applied for in a foreign state or British

possession and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the application in the foreign state or British possession and the leaving of the application in the United Kingdom,

but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patent, and shall decide the case; and 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 may determine.

Sub-sec. (1) (*b*).—This immensely extends the grounds of opposition and will probably lead to a very greatly increased number of oppositions. It allows opposition on the ground of anticipation by any document other than a British specification more than fifty years old or a provisional specification not followed by a complete.

It is not clear, however, how far the Office will go into considerations of subject-matter, *i.e.* if there are variations between the invention for which protection is sought and the prior publication will the Office take upon itself to decide whether these variations constitute an invention which is patentable? Probably the Office, considering that a decision refusing the Patent is irrevocable, while if the patent is allowed the question of subject-matter can be decided in the Courts, will only refuse the patent in cases where there is very clearly no subject-matter in these variations.

It should be noted that where a provisional specification has been followed by a complete an opposition may be lodged if the invention claimed in the application appears in either.

The expression "made available to the public by publication in a document" would seem to exclude cases where although a document has been communicated to persons who are not bound to keep it secret, and would therefore be held a publication in the Courts, it has not been made available to the public at large. *Cf.* such cases as **61*** and **69.** In cases of doubt as to publication the patent would probably be granted and the opponent left to petition.

It is difficult to predict what requirements if any will be made as to locus in an opposition under this sub-section. The idea of locus under the old provisions would seem to have arisen from the proprietary nature of the opponent's interest, *i.e.* that he said "what you are now claiming is the subject of a claim of my own." As the question of claim has been wholly eliminated, and as in the case of alleged anticipation by any document other than a British specification it is difficult to see how there can be any limitation of the class of persons who might rely on it, it would seem probable that an opposition on this ground would be held to be open to all the world. The only other solution would be that the comptroller would require something in the nature of a "manufacturing interest." See **84** and Moulton, p. 264 n. (p).

Sub-sec. (1) (*bb*).—The effect of this is merely to preserve those provisions of the old sec. 1 (*b*) which have been omitted from the new form.

Sub-sec. (1) (*c*).—This removes the uncertainty that has prevailed as to the precise effect of sec. 91. See **70, 5,** and **54.** See also Moulton, p. 259.

It in effect provides that the specification lodged in the patent office of a foreign State or British possession shall be treated as if it were a provisional specification, and therefore in adjudicating on applications made under sec. 91 the ordinary rules as to disconformity will apply.

12. Grant and sealing of patent.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the comptroller shall cause the patent to be sealed with the seal of the Patent Office

Provided that where—

(a) an applicant has agreed in writing to assign a patent when granted to another party or a joint applicant and refuses to proceed with the application ; or

(b) disputes arise between joint applicants as to proceeding with an application ;

the comptroller on proof of such agreement to his satisfaction, or if satisfied that one or more of such joint applicants ought to be allowed to proceed alone, may allow such other party or joint applicant to proceed with the application, and may grant a patent to him, so however that all parties interested shall be entitled to be heard before the comptroller, and an appeal shall lie from the decision of the comptroller under this proviso to the law officer.

(2) A patent shall be sealed as soon as may be, and not after the expiration of [fifteen] *eighteen* months from the date of application, provided that—

(*a*) Where the comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said [fifteen] *eighteen* months shall be allowed for the sealing of the patent :

(*b*) 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 *or the comptroller as the case may be* may direct :

(*c*) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death.

(*d*) Where [in consequence of the neglect or failure of the applicant to pay any fee] *for any reason* a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall, in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.

Sub-sec. (1). Although the decision of the comptroller will regulate the proceedings in the Patent Office it will not necessarily determine the legal or equitable rights of the parties, and in some cases the unsuccessful party might apply to the Court for a declaration that the patentee hold the patent wholly or partly in trust for him or for other relief. See cases **16***, **58**, **123**, and cases collected at Moulton, pp. 74 and 75.

13. Date of patent.—Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application : Provided that no proceedings shall be taken in respect of an infringement committed before the [publication] *acceptance* of the complete specification.

The object of this amendment would seem to be to bring this section in line with sec. 10.

14. Effect, extent, and form of patent.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man :

Provided that 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.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim ; and 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 has been granted for more than one invention.

15. Fraudulent applications for patents.—(1) 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.

(2) Where a patent has been revoked [on the ground of fraud,] *by the court on the ground that it has been obtained in fraud of the true and first inventor or where the grant has been refused by the comptroller under the provisions of paragraph (a) of subsection* (1) *of section eleven of this Act or revoked on the same ground under the provisions of section twenty-six of this Act*, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent *for the whole or any part of the invention* in lieu of and bearing the same date as the patent so revoked *or as would have been borne by the patent if the grant thereof had not been refused :*

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

The power given to the Comptroller to grant a patent to the true inventor bearing the date of the patent opposed should prove useful. A similar course was occasionally taken by the law officers before the 1887 Act. A joint grant may also be made. As to the practice in these cases see Moulton, pp. 212 and 205.

16. Single patent for cognate inventions.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same [and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents] *and in determining other questions under this Act* the court or the comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.

One effect of the alteration will be that for the purposes of the searches made under secs. 7 and 8 each claim will be referred to the corresponding provisional. As to these patents see Moulton, p. 262.

Term of Patent.

17. Term of patent.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be [fourteen] *sixteen* years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the comptroller, upon the application of the patentee, shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

As to the application to existing patents see 1919, sec. 6. The total amount of fees payable has not been increased and it is probable that there will be no renewal fees till the seventh year. As to patents which have lapsed during the war see Introduction "Treaty Rights."

18. Extension of term of patent—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention

to do so, present a potition to the court praying that his patent may be extended for a furthor term, but such potition must be presented at least six months before the time limited for the oxpiration of the patent:

Provided that the court may in its discretion extend such period within which such a petition may be presented.

(2) Any person may give notice to the court of objection to the oxtension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

(4) The court, in considering its decision, shall 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 it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding [seven] *five*, or, in exceptional cases, [fourteen] *ten* years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.

(6) *Where, by reason of hostilities between His Majesty and any foreign state, the patentee as such has suffered loss or damage (including loss of opportunity of dealing in or developing his invention owing to his having been engaged in work of national importance connected with such hostilities) an application under this section may be made by originating summons instead of by petition, and the court in considering its decision may have regard solely to the loss or damage so suffered by the patentee:*

Provided that this sub-section shall not apply if the patentee is a subject of such foreign state as aforesaid, or is a company the business whereof is managed or controlled by such subjects or is carried on wholly or mainly for the benefit or on behalf of such subjects, notwithstanding that the company may be registered within His Majesty's Dominions.

Sec. 18.—The power to extend the period within which a petition may be presented has been exercised by the Comptroller during the war where the delay arose in connection with the war. See **132**.

Sub-sec. (6).—This marks a very substantial concession to patentees, firstly, by simplifying the procedure and, secondly, by enabling the Court to confine the matters considered to the simple one—has the patentee suffered loss or damage through hostilities, and so to avoid the elaborate investigation into such matters as special merit, etc. See Moulton, p. 305.

The cases dealt with by this sub-section are really on a different footing to those provided for by the remainder of the section. The patentee does not say here that the ordinary period is insufficient by reason of the special merit or peculiar nature of his invention, but that having been granted a monopoly for fourteen years part of this

term has been in effect taken away from him by causes beyond his control, since the years since the beginning of the war were really useless or only worth a fraction of their normal value.

The "loss or damage" to be proved is not restricted, and may be of many kinds. In some cases the patentee may prove actual loss of orders, but in a far more numerous class he will rely on the fact that war exigencies prevented or hindered the manufacture of, or demand for, the article. In many trades, of course, the work permitted to be done was controlled by Government, and in many others the labour available was monopolised by the production of the most essential articles. A further cause of loss might be the restriction of trade with foreign countries (including enemy countries) or the absence or short supply of the necessary raw materials. In other cases the patentee may rely upon the difficulty of finding capital for exploiting inventions in war time, or the lack of demand for certain articles.

"Patentee" means the registered proprietor for the time being and this would apply, both as regards the person who must have suffered loss or damage and as regards the persons excluded by the proviso. If, however, a British subject merely holds a patent in trust for an enemy, although he would not be technically prevented from applying for extension, he would generally be unable to prove that he had suffered loss or damage. Where there has been a transmission of interests otherwise than by sale, *e.g.*, where the patent has been held by a partnership with varying partners, it is probable that the Court would consider that loss suffered by any of these bodies of partners came within the section.

With regard to the proviso it would seem that where the patentee has by the terms of the Treaty become the subject of a friendly State, *e.g.*, in the case of an inhabitant of Alsace Lorraine, he would not be excluded. The companies excluded would seem to be practically those which are "enemy controlled corporations" within the meaning of the Trading with the Enemy Amendment Act, 1918.

The procedure by originating summons is governed by the Rules of the Supreme Court Orders 54 and 71. Shortly, the summons is taken out and would generally be intitled In the matter of the Patents and Designs Act, 1907, and In the matter of Smith's Letters Patent No. 100,000. In the absence of any further directions it would probably be sufficient if this was served on the Solicitor to the Board of Trade. The matter may be disposed of either in chambers or in Court, and all that would probably be needed in the first instance would be an affidavit setting out the circumstances of the case together with such accounts as were necessary. It is not clear how far the provisions of Order 53A apply to the procedure by summons. Some of these provisions are obviously inapplicable, but probably some form of advertisement would be required.

There is no statement as to the time when the application should be made. As the ground of the application is simply that there has been an actual loss during the war it would seem most convenient that it should be presented promptly when this point alone is relied on. The ordinary disinclination of the Courts to consider the extension of a patent till close on the time of its expiry is based on the fact that they have to consider the whole remuneration obtained by the patentee and this would not apply to applications on these special grounds.†

The right of the Court to grant an extension merely on the ground of damage during the war would not seem to be confined to cases where the application is by summons, but would also apply to cases of petitions. Such damage was considered in **44** & **81**.

19. Patents of addition.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

† An official notice has now been issued stating that these applications should not be made till towards the end of the term of the patent.

(2) Where an application containing such a request is made, a patent (herein-after referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal:

Provided that, if the patent for the original invention is revoked, then the patent of addition shall, if the court or comptroller so orders, become an independent patent, and the fees payable, and the dates when they become payable shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

Restoration of lapsed Patents.

20. Restoration of lapsed patents.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the comptroller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional and that no undue delay has occurred in the making of the application, the comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the comptroller shall hear the case and, [subject to an appeal to the court,] issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.

(6) *An appeal shall lie from the decision of the comptroller under this section to the court.*

Amendment of Specification.

21. Amendment of specification by comptroller.—(1) An applicant or a patentee may at any 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, and the reasons for, the proposed amendment.

(2) The request and the nature of the 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.

(3) Where such a notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

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

(5) The decision of the comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) 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.

(7) 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 be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification:

Provided that the court shall be entitled in construing a specification as amended to refer to the specification as accepted and published.

(8) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.

It is presumably only in cases where the construction of the amended specification is really doubtful that the Court will draw any inferences as to its true meaning from the unamended form. The rule of English law that a document is to be construed from the words remaining in, and not from those which have been excised, is so clear and beneficial that the Courts will hesitate to depart from it more than is absolutely necessary. As to the former practice, see Moulton, p. 236.

It should be noted that if there has been more than one amendment only the specification as accepted, and not the form after the earlier amendment, can be referred to.

22. Amendment of specification by the court.—In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his speci-

fication by way of disclaimer, *correction or explanation*, in such manner, and subject to such terms as to costs advertisement or otherwise, as the court may think fit :

Provided that no amendment shall be so 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 the amendment, and where an application for such an order is made to the court notice of the application shall be given to the comptroller, and the comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

23. Restriction on recovery of damages.—Where an amendment of a specification 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], *before the date of the decision allowing the amendment*, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

The effect of this section is modified by sec. 32 A. The alteration would only seem to confirm the prior practice, *cf.* **4***.

Compulsory Licences and Revocations.

24. Compulsory licences and revocation.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a primâ facie case has been made out, shall refer the petition to the court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the court :

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or

otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(*a*) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or

(*b*) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

†**24. Provision as to patents indorsed "licences of right."**—(1) *At any time after the sealing of a patent the comptroller shall, if the patentee so requests, cause the patent to be indorsed with the words 'licences of right,' and a corresponding entry to be made in the register, and thereupon—*

(*a*) *any person shall at any time thereafter be entitled as of right to a licence under the patent upon such terms as, in default of agreement, may be settled by the comptroller on the application of either the patentee or the applicant:*

Provided that any licence the terms of which are settled by agreement shall be deemed, unless otherwise expressly provided, to include the terms and conditions specified in paragraphs (c) and (d) of this subsection as if they had been imposed by the comptroller thereunder in like manner as if the terms had been settled by the comptroller:

(*b*) *in settling the terms of any such licence the comptroller shall be guided by the following considerations:—*

(i) *he shall, on the one hand, endeavour to secure the widest possible user of the invention in the United Kingdom consistent*

† The new section does not come into force till an order to that effect is published, see 1919, sec. 22.

with the patentee deriving a reasonable advantage from his patent rights ;

(ii) *he shall, on the other hand, endeavour to secure to the patentee the maximum advantage consistent with the invention being worked by the licensee at a reasonable profit in the United Kingdom ;*

(iii) *he shall also endeavour to secure equality of advantage among the several licensees, and for this purpose may, on due cause being shown, reduce the royalties or other payments accruing to the patentee under any licence previously granted :*

Provided that in considering the question of equality of advantage, the comptroller shall take into account any work done or outlay incurred by any prerious licensee with a view to testing the commercial value of the invention or to securing the working thereof on a commercial scale in the United Kingdom :

(c) *any such licence the terms of which are settled by the comptroller may be so framed as to preclude the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or those claiming under him, would be an infringement of the patent, and in such a case the patentee and all licensees under the patent shall be deemed to have mutually covenanted against such importation :*

(d) *every such licensee shall be entitled to call upon a patentee to take proceedings to prevent the infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his own name as though he were patentee, making the patentee a defendant : a patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given in the register.*

(e) *if in any action for infringement of a patent so indorsed the infringeing defendant is ready and willing to take a licence upon terms to be settled by the comptroller, no injunction against him shall be awarded, and the amount recoverable against him by way of damages (if any) shall not exceed double the amount which would have been recoverable against him as licensee if the licence had been dated prior to the earliest infringement :*

Provided that this paragraph shall not apply where the infringement consists of the importation of infringing goods :

(f) *the renewal fees payable by the patentee of a patent so indorsed shall, as from the date of the indorsement, be one moiety only of the fees which would otherwise have been payable.*

(2) *The comptroller shall, before acting on any request to indorse a patent made by the patentee under this section, advertise such request in the Illustrated Official Journal (Patents), and shall satisfy himself that the patentee is not precluded by contract from making such request, and for that purpose shall require from the patentee such evidence, by statutory declaration or otherwise, as he may deem necessary :*

Provided that a patentee shall not be deemed to be so precluded by reason only of his having granted a licence under the patent where the licence does not limit his right to grant other licences.

(3) *Any person, alleging that a request under this section has been made contrary to some contract in which he is interested, may apply to the comptroller within the prescribed time and in the prescribed manner, and the comptroller, if satisfied of the truth of such allegation, shall refuse to indorse the patent pursuant to the request or shall cause the indorsement, if already made, to be cancelled.*

Any order under this subsection shall be subject to appeal to the court.

(4) *All indorsements of patents under this section shall be entered on the register of patents and shall be published in the Illustrated Official Journal (Patents), and in such other manner as to the comptroller may seem desirable for the purpose of bringing the invention to the notice of manufacturers.*

(5) *If at any time it appears that in the case of a patent so indorsed there is no existing licence the comptroller may, if he thinks fit, on the application of the patentee and on payment by him of the unpaid moiety of all renewal fees which have become due since the indorsement, after due notice cancel the indorsement, and in that case the patentee's rights and liabilities shall be the same as if no such indorsement had been made.*

The advisability of adopting this course in the first instance is very doubtful. It will make no difference to the renewal fees whether the patent is so indorsed from the first or whether the patentee waits till immediately before such a fee is payable, and it may in many cases be the most disadvantageous that the patentee should be committed to the grant of licences on terms not settled by himself, as such a licence may have a very deterrent effect on capitalists who might assist to develop the invention. The disadvantage is to some extent diminished by sub-sec. (5).

Generally speaking, if any person requires a licence he will apply to the patentee for it even if there is no indorsement, so that the only advantage of the indorsement would appear to be firstly that it acts as an advertisement of the patentee's willingness to grant licences on fair terms, and, secondly, that it may be an advantage in the case of an application to revoke under sec. 27, *q.v.*

It would also be generally better for the would-be licensee to approach the patentee directly even if the patent is so indorsed, as if there is no prior licence the parties can probably agree on terms better for both of them, *e.g.*, for an exclusive licence, and the indorsement can then be withdrawn.

Sub-sec. (1) (*a*).—It would appear that the applicant must *bind himself* to take a licence on terms to be settled by the comptroller. The form of application will of course be settled by the rules.

Sub-sec. (1) (*b*).—The terms of such licence would generally be less favourable to the patentee than in the case of an exclusive licence under sec. 27 (4), since here the main consideration is the widest possible user, while there it is the maximum profit to the patentee.

In considering the licensee's profit the comptroller will naturally be influenced by

the hazardous nature of the speculation, and the fact that the licence, being based on the patent monopoly, is a wasting security. Further, once the success of the invention is established other persons will probably apply for licences of right, though of course the terms on which these are granted may not be so favourable. It must be remembered that while there is an existing "licence of right" the privilege of claiming such licence cannot be restricted, nor can the comptroller refuse any such application. Once settled, the comptroller has no further control over the licence except that given by sub-sec. (1) (*b*) (iii) in the case of the grant of fresh licences.

Sub-sec. (1) (*c*) and (*d*).—Unless expressly excluded these terms are incorporated into all licences by agreement, and will also generally be inserted by the comptroller. The effect of sub-sec. (1) (*c*) is peculiar as it enables the patentee, by indorsing his patent "*licence of right*" and then granting a licence, to preclude a prior licensee from importing, although he may be entitled to do so by the terms of his licence.

Sub-sec. (2).—This provision renders it advisable for any person taking licence under a patent to obtain from the patentee an undertaking that the patent shall not be endorsed "licences of right" without his consent.

Sub-sec. (5).—Presumably by existing licence is meant a licence under the provisions of this section.

25. Revocation of patent.—(1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

(*a*) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias ; [or

|(*b*) a patent may be revoked under this Act either by the comptroller or as an alternative to the grant of a compulsory licence ;|

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented—

(*a*) by the Attorney-General or any person authorised by him ; or

(*b*) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ; or

(ii) 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 ; or

(iii) 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.

Sec. 25.—This leaves the grounds on which the validity of a patent can be attacked in an action or petition as they were before the 1907 Act. "Non-working" is no longer a ground.

26. Power of comptroller to revoke patents on certain grounds.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled,

may, within two years from the date of the patent, [in the prescribed manner] apply to the comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed :

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

(2) The comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application ; but the comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court.

The grounds for the "belated oppositions" and the class of persons who may be applicants are both greatly enlarged by the changes in sec. 11, *q.v.*

27. Revocation of patents worked outside the United Kingdom.—(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(*a*) forthwith ; or

(*b*) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent :

Provided that no such order shall be made which is at variance with

any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

† **27. Provisions for the prevention of abuse of monopoly rights.** —(1) *Any person may at any time apply to the comptroller alleging in case of any patent that there has been abuse of the monopoly rights thereunder and asking for relief under this section.*

(2) *The monopoly rights under a patent shall be deemed to have been abused in any of the following circumstances :—*

(*a*) *If at any time after the expiration of four years from the date of the patent, the patented invention (being one capable of being worked in the United Kingdom), is not being worked within the United Kingdom on a commercial scale, and no satisfactory reason can be given for such non-working :*

Provided that if an application is presented to the comptroller on this ground, and the comptroller is of opinion that the time which has elapsed since the date of the patent has by reason of the nature of the invention or for any other cause been insufficient to enable the invention to be worked within the United Kingdom on a commercial scale, the comptroller may adjourn the application for such period as will in his opinion be sufficient for that purpose :

(*b*) *If the working of the invention within the United Kingdom on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by the patentee or persons claiming under him, or by persons directly or indirectly purchasing from him, or by other persons against whom the patentee is not taking or has not taken any proceedings for infringement :*

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

(*d*) *If, by reason of the refusal of the patentee to grant a licence or licences upon reasonable terms, the trade or industry of the United Kingdom or the trade of any person or class of persons trading in the United Kingdom, or the establishment of any new trade or industry in the*

† The new section does not come into force till an order to that effect is published, see 1919, sec. 22.

United Kingdom, is prejudiced, and it is in the public interest that a licence or licences should be granted :

(c) *If any trade or industry in the United Kingdom, or any person or class of persons engaged therein, is unfairly prejudiced by the conditions attached by the patentee, whether before or after the passing of this Act, to the purchase, hire, licence, or use of the patented article, or to the using or working of the patented process :*

Provided that for the purpose of determining whether there has been any abuse of the monopoly rights under a patent, it shall be taken that patents for new inventions are granted not only to encourage invention but to secure that new inventions shall so far as possible be worked on a commercial scale in the United Kingdom without undue delay.

(3) *On being satisfied that a case of abuse of the monopoly rights under a patent has been established, the comptroller may exercise any of the following powers as he may deem expedient in the circumstances :—*

(a) *He may order the patent to be indorsed with the words "licences of right" and thereupon the same rules shall apply as are provided in this Act in respect of patents so indorsed, and an exercise by the comptroller of this power shall entitle every existing licensee to apply to the comptroller for an order entitling him to surrender his licence in exchange for a licence to be settled by the comptroller in like manner as if the patent had been so indorsed at the request of the patentee, and the comptroller may make such order ; and an order that a patent be so indorsed may be made notwithstanding that there may be an agreement subsisting which would have precluded the indorsement of the patent at the request of the patentee :*

(b) *He may order the grant to the applicant of a licence on such terms as the comptroller may think expedient, including a term precluding the licensee from importing into the United Kingdom any goods the importation of which, if made by persons other than the patentee or persons claiming under him, would be an infringement of the patent, and in such case the patentee and all licensees for the time being shall be deemed to have mutually covenanted against such importation. A licensee under this paragraph shall be entitled to call upon the patentee to take proceedings to prevent infringement of the patent, and if the patentee refuses, or neglects to do so within two months after being so called upon, the licensee may institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant. A patentee so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings. Service on him may be effected by leaving the writ at his address for service given in the register.*

In settling the terms of a licence under this paragraph the comptroller shall be guided as far as may be by the same considerations as are specified in section twenty-four of this Act for his guidance in settling licences under that section :

(c) *If the comptroller is satisfied that the invention is not being worked on a commercial scale within the United Kingdom, and is such that it cannot be so worked without the expenditure of capital for the raising of which it will be necessary to rely on the patent monopoly, he may, unless the patentee or those claiming under him will undertake to find such capital, order the grant to the applicant, or any other person, or to the applicant and any other person or persons jointly, if able and willing to provide such capital, of an exclusive licence on such terms as the comptroller may think just, but subject as hereinafter provided :*

(d) *If the comptroller is satisfied that the objects of this section cannot be attained by the exercise of any of the foregoing powers, he may order the patent to be revoked, either forthwith or after such reasonable interval as may be specified in the order, unless in the meantime such conditions as may be prescribed in the order with a view to attaining the objects of this section are fulfilled, and the comptroller may, on reasonable cause shown in any case, by subsequent order extend the interval so specified :*

Provided that the comptroller shall make no order for revocation which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession :

(e) *If the comptroller is of opinion that the objects of this section will be best attained by making no order under the above provisions of this section, he may refuse the application and dispose of any question as to costs thereon as he thinks just.*

(4) *In settling the terms of any such exclusive licence as is provided in paragraph (c) of the last preceding sub-section, due regard shall be had to the risks undertaken by the licensee in providing the capital and working the invention, but subject thereto, the licence shall be so framed as—*

(a) *to secure to the patentee the maximum royalty compatible with the licensee working the invention within the United Kingdom on a commercial scale and at a reasonable profit ;*

(b) *to guarantee to the patentee a minimum yearly sum by way of royalty, if and so far as it is reasonable so to do, having regard to the capital requisite for the proper working of the invention and all the circumstances of the case ;*

and, in addition to any other powers expressed in the licence or order, the licence and the order granting the licence shall be made revocable at the discretion of the comptroller if the licensee fails to expend the amount specified in the licence

as being the amount which he is able and willing to provide for the purpose of working the invention on a commercial scale within the United Kingdom, or if he fails so to work the invention within the time specified in the order.

(5) *In deciding to whom such an exclusive licence is to be granted the comptroller shall, unless good reason is shown to the contrary, prefer an existing licensee to a person having no registered interest in the patent.*

(6) *The order granting an exclusive licence under this section shall operate to take away from the patentee any right which he may have as patentee to work or use the invention and to revoke all existing licences, unless otherwise provided in the order, but on granting an exclusive licence the comptroller may, if he thinks it fair and equitable, make it a condition that the licensee shall give proper compensation to be fixed by the comptroller for any money or labour expended by the patentee or any existing licensee in developing or exploiting the invention.*

(7) *Every application presented to the comptroller under this section must set out fully the nature of the applicant's interest and the facts upon which the applicant bases his case and the relief which he seeks. The application must be accompanied by statutory declarations verifying the applicant's interest and the facts set out in the application.*

(8) *The comptroller shall consider the matters alleged in the application and declarations, and, if satisfied that the applicant has a bonâ fide interest and that a primâ facie case for relief has been made out, he shall direct the applicant to serve copies of the application and declarations upon the patentee and upon any other persons appearing from the register to be interested in the patent, and shall advertise the application in the Illustrated Official Journal (Patents).*

(9) *If the patentee or any person is desirous of opposing the granting of any relief under this section, he shall, within such time as may be allowed by the comptroller or within such extended time as the comptroller may on application further allow, deliver to the comptroller a counter statement verified by a statutory declaration fully setting out the grounds on which the application is to be opposed.*

(10) *The comptroller shall consider the counter statement and declarations in support thereof and may thereupon dismiss the application if satisfied that the allegations in the application have been adequately answered, unless any of the parties demands a hearing or unless the comptroller himself appoints a hearing. In any case the comptroller may require the attendance before him of any of the declarants to be cross-examined or further examined upon matters relevant to the issues raised in the application and counter statement, and he may, subject to due precautions against disclosure of information to rivals in trade, require the production before him of books and documents relating to the matter in issue.*

(11) *All orders of the comptroller under this section shall be subject to*

appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(12) *In any case where the comptroller does not dismiss an application as hereinbefore provided, and*

(a) if the parties interested consent, or

(b) if the proceedings require any prolonged examination of documents or any scientific or local investigation which cannot in the opinion of the comptroller conveniently be made before him;

the comptroller may at any time order the whole proceedings or any question or issue of fact arising thereunder to be referred to an arbitrator agreed on by the parties, or in default of agreement appointed by the comptroller, and, where the whole proceedings are so referred, the award of such arbitrator shall, if all the parties consent, be final, but otherwise shall be subject to the same appeal as the decision of the comptroller under this section, and where a question or issue of fact is so referred, the arbitrator shall report his findings to the comptroller.

(13) *For the purposes of this section the expression 'patented article' includes articles made by a patented process.*

Sub-sec. (2) (*a*).—This is a very big change in the law. Formerly no action could be taken against the patentee who did nothing—it was only where he had given a preference to development in foreign countries that the application for revocation could be made.

The first condition is that the patent is capable of being worked in the country. Probably the only patents which will be held not to be capable of being worked are those dealing with products not found in this country, *e.g.*, recovery of gold, etc. The allegation that suitable labour cannot be found here has never been upheld. See **126**, and Moulton, p. 301 n. (*y*).

"Commercial scale" is defined in sec. 93, but it is of course a question of fact in each case whether this standard is attained. Where there has been any working abroad the rules laid down in prior cases (see Moulton, p. 300) and notes on "non-working" *supra*, will probably be followed. In cases where manufacture abroad is proceeding the question of whether there is a "satisfactory reason" for the absence of manufacture here will probably be decided in the light of the previous decisions (see Moulton, p. 300). Where there is no working anywhere the reasons generally advanced will be lack of demand and lack of capital.

In both cases the patentee will have to show that he has made efforts to bring about the exploitation of his invention.

No doubt the fact that the patent has been marked "Licences of right" would generally tell in his favour, but it must not be assumed that a contrary course shows any lack of desire to bring his invention into practical use, since in cases where the exploitation would entail the expenditure of any considerable capital the best chance of obtaining it is by keeping a real monopoly to offer to the capitalist.

Sub-sec. (2) (*b*).—There is no time limitation here, so that proceedings may be taken at any time after the grant of the patent. It is not sufficient to prove isolated instances of importation—the importation must be sufficient to prevent or hinder the working here. In some cases, *e.g.*, in the case of a foreign inventor who has naturally started to manufacture first in his own country, it may be that importation for a short time so far from hindering exploitation here tends to help it by creating a demand for the article.

The class of person importing seems to be quite general, but as the section is aimed at abuse of patent rights it would seem that there must be some acquiescence or laches on the part of the patentee, *i.e.* that he has had knowledge which would have enabled him to bring an action, and has unreasonably failed to do so. Probably it would be sufficient for the applicant to show that there had been infringement by importation, and the onus would then be on patentee to show why he had taken no action.

Sub-sec. (2) (*c*).—This is practically the same as sec. 24 (5) (*a*) of the 1907 Act. As to its application, see **104**.

It should be noted that in addition to the matters required to be proved for (*a*) it is here necessary to show that there is an existing demand.

Sub-sec. (2) (*d*).—The main portion of this paragraph was contained in sec. 24 (5) (*a*) of the 1907 Act, but there is added "or the trade of any person or class of person trading in the United Kingdom." The reason for this addition is probably a desire to counteract the effect of the decision in **104**, viz., that something more than individual hardship had to be proved, but it is to be noted, on the other hand, that in addition to establishing the prejudice, etc., the applicant has to show that "it is in the public interest that a licence or licences should be granted." If therefore the general public will be equally well served by the patentee or the applicant the Comptroller may refuse to make any order.

The grounds for an application fall under three heads: (1) Prejudice to trade generally; (2) prejudice to an existing trade, in which presumably the applicant must be engaged; (3) prejudice to a new trade which he is in a position to establish. Therefore a mere desire to establish himself as a competitor in an existing trade, *e.g.*, in the sale of the patented article itself, would not generally give the applicant a locus.

Sub-sec. (2) (*e*).—This again is a repetition of sec. 24 (5) (*b*) of the 1907 Act, with the addition of the words "or any person or class of persons engaged therein." The word "unfairly" will probably prove of considerable importance in the interpretation of this provision, and taken in conjunction with the general words preceding this sub-section, viz. that the object of the provision is to prevent "abuse" of monopoly rights, will be held to restrict the operation to cases where the patentee has forced terms on licensees with the object of injuring his rivals.

The proviso, which is in a somewhat unusual form, would not seem to extend the effect of the preceding paragraphs.

It should be noted that, except in the case of an application under sub-sec. (2) (*a*), there is no provision as to the time that must elapse before an application is made, nor is there power given to adjourn the application, though a conditional order for revocation may be made. A reasonable time would, however, be generally allowed to the patentee to establish manufacture, *cf.* **119**.

Sub-sec. (3) (*a*).—As to "licences of right," see sec. 24. The power of the Comptroller under the present section with regard to existing licences is, however, wider, as he can grant an entirely new licence, omitting restrictive covenants, terms as to minimum output, etc., whereas under sec. 24 he can only reduce royalties payable.

Sub-sec. (3) (*b*).—Paragraph (*a*) provides for equal rights to all the world, the present paragraph contemplates special rights being given to the applicant. The patentee, save for the grant of the licence and the prohibition on importation (which apparently *must* be inserted) retains all his other rights, and may continue to manufacture, grant fresh licences, etc., while the position of existing licences is unaffected (except as regards importation).

Sub-sec. (3) (*c*).—The provision as to compulsory exclusive licences marks an entirely new step in legislation, which, in the opinion of the authors, is a most useful one. It is a welcome recognition of the fact that where heavy expenditure of capital is necessary the only inducement in many cases that will attract the capitalist is the prospect of a real monopoly. Of course this exceptional power is only intended to be exercised sparingly, but the patentee will sometimes find its existence puts him on the horns of dilemma. Often the only answer to the allegation that the patent monopoly has been abused is that the patentee has been unable to obtain the large capital necessary for exploitation, and by this plea he prepares the way for an application for an exclusive licence. However, where the plea is true it may in many cases be the most beneficial course for the patentee that such an order should be made.

The Comptroller has absolute discretion as to the terms he may impose on the exclusive licensee, and doubtless they will generally include either a bond or other security that he will in fact start the manufacture on the scale promised.

The compensation to be given to the patentee or an existing licensee (see sub-sec. 6) will not necessarily be limited to the amount actually expended, but may include compensation for the profits that such expenditure of time or labour might have produced.

It is apparently assumed that such an exclusive licensee can sue without joining the patentee. See Introduction "Licences."

Sub-sec. (3) (*d*).—It is only where no form of licence would be effective that revocation can be ordered.

At present the only treaties, so far as the authors know, which prevent such an order are the recent Treaties of Peace. By Art. 307 of the treaty with Germany it is provided that no patent or design belonging to the nationals of the contracting parties shall be revoked solely on the ground of non-user between August 4th, 1914, and six months after the treaty, but it would seem that if there had been non-user before August 1st, 1914, further non-user during this period might be taken into consideration. The parties to the treaty are given in the introduction under "Treaty Rights," but of course this provision would only apply in the case of nationals of those countries which have ratified the treaty. The treaty with Austria is in similar terms.

By section V. of the International Convention, importation of patented objects is not in itself a ground for revocation of the patent, but it is provided that the patentee must work according to the laws of the country, so if a case is made under sub-sec. (2) (*c*) an order for revocation might be made.

There is a difference in procedure from that laid down by the rules under the 1907 Act. Under the present Act the applicant has to satisfy the Comptroller that his interest is a *bonâ fide* one, and that he has made out a *primâ facie* case, before the patentee is troubled at all. The interest of the applicant would probably be held sufficient if he is a trader in this country who suffers from the insufficient production, importation, etc.

Declarations in answer are not provided for. The only order that can be made without a hearing is one dismissing the application. The provision as to the production of trade books is new.

Although the only parties required to be served are those whose interests appear on the register, any person interested will probably be allowed to deliver a counter statement under sub-sec. (9).

Sub-sec. (11).—If the judge makes or confirms an order for revocation the patentee may appeal. See sec. 92.

Sub-sec. (12).—This is quite new. It is for the Comptroller to decide whether the reference shall be of the whole proceedings or of the issues of fact only. It would seem that findings on such issues are open to appeal. Presumably the costs of the Arbitrator will be paid by the Patent Office, *cf.* sec. 11 (3).

Sub-sec. (13).—This would probably not include articles made on a patented machine. *Cf.* 57, and see Moulton, p. 158.

27A. Enforcement of order for grant of licence.—*Any order for the grant of a licence under this Act shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence executed by the patentee and all other necessary parties.*

Register of Patents.

28. Register of patents.—(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 be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

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

(4) 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.

As to the effect of non-registration, see sec. 71.

Crown.

29. Patent to bind Crown.—A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

†**29. Right of Crown to use patented inventions.**—(1) *A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject :*

Provided that any Government department may, by themselves or by such of their agents, contractors, or others as may be authorised in writing by them at any time after the application, make, use or exercise the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or licence concluded between the inventor or patentee and any person other than a Government department, shall be inoperative so far as concerns the making, use or exercise of the invention for the service of the Crown :

Provided further, that where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, any Government department (such invention not having been communicated directly or indirectly by the applicant for the patent or the patentee), any Government department, or such of their agents, contractors, or others, as may be authorised in writing by them, may make, use and exercise the invention so recorded or tried for the service of the Crown, free of any royalty or other payment to the patentee, notwithstanding the existence of the patent. If in the opinion of the department the disclosure to the applicant or the patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon.

(2) *In case of any dispute as to the making, use or exercise of an*

† This section does not come into force till an order to that effect is issued, see 1919, sec. 22.

invention under this section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The court, referee, or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant and such Government department. The court, referee, or arbitrator, further in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the patentee, or any other person interested in the patent, may have received directly or indirectly from the Crown or from any Government department in respect of such patent.

(3) *The right to use an invention for the services of the Crown under the provisions of this section or any provisions for which this section is substituted shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Crown.*

(4) *Nothing in this section shall affect the right of the Crown or of any person deriving title directly or indirectly from the Crown to sell or use any articles forfeited under the laws relating to the customs or excise.*

Apart from these statutory provisions a patent has no effect against the Crown.

It is not easy to foresee what interpretation will be given to the words "duly recorded." They appear to contemplate some formal record being kept for the purposes of this section. It is to be observed that the section relates to inventions recorded *by*, not *in*, any Government Department. The effect of this is probably to exclude from the scope of the section such cases as letters received in a department and filed, but on which no action has been taken, *e.g.*, letters received during the war at the Inventions Board. Thus in the case of an invention being "duly recorded" by a Government Department even though no steps may have been taken with regard to testing the utility, etc., of the invention, and although it may be that the utility may only have been recognised as the result of the patentee's work, such Government Department would, it seems, be entitled to use such invention under the provisions of this section. All applications will be to the special judge, see sec. 92 (2). The corresponding section was pleaded as a defence in 87*.

The provision for sale was probably inserted in view of the large amount of surplus stores now being disposed of. It does not authorise manufacture merely for the purposes of sale.

30. Assignment to Secretary for War or the Admiralty of certain inventions.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty 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 or the Admiralty on behalf of His 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 or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the comptroller 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 or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, 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 or the Admiralty.

(5) The packet shall, until the expiration of the 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 the Admiralty or of the law officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

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

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty 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 Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time 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 the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty 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.

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

Legal Proceedings.

31. Hearing with assessor.—(1) In an action or proceeding for infringement or revocation of a patent, the court may, if it think fit, and shall on the request of [either] *all* of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the court otherwise directs.

(2) The Court of Appeal may, if they think fit, in any proceeding before them 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, as the case may be, and be paid as part of the expenses of the execution of this Act.

32. Power to counterclaim for revocation in an action for infringement. —A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.

32A. Power of court to grant relief in respect of particular claims. —*Notwithstanding anything to the contrary appearing in section twenty-three of this Act, if the court in any action for infringement of a patent finds that any one or more of the claims in the specification, in respect of which infringement is alleged, are valid, it shall, subject to its discretion as to costs and as to the date from which damages should be reckoned, and to such terms as to amendments as it may deem desirable, grant relief in respect of any of such claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion, the court may take*

into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

The obligation to grant relief is absolute though the court has a discretion as to terms in respect of amendment, damages and costs. There would seem no reason why the defendant should not by his particulars of objection attack any claim whether it is alleged to be infringed or not. In any case he can do so if he counter-claims for revocation. This latter course has the advantage that it compels the patentee to ask for leave to amend should any claim be held bad.

The power to grant damages before the date of amendment would apply to cases where the amendment had been before action.

33. Exemption of innocent infringer from liability for damages.—A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Provided that nothing in this section shall affect any proceedings for an injunction.

34. Order for inspection, &c., in action.—In an action for infringement of a patent, *the plaintiff shall be entitled to relief by way of injunction and damages but not to an account of profits, but subject as aforesaid* the court may on the application of either party make such order for an injunction [inspection or account] *or inspection* and impose such terms and give such directions respecting the same and the proceedings thereon as the court may see fit.

35. Certificate of validity questioned and costs thereon.—In an action for infringement of a patent, the court may certify that the validity of [the patent] *any claim in the specification of the patent* came in question; and, if the court so certifies, then in any subsequent action for infringement *of such claim* the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client *so far as that claim is concerned.*

36. Remedy in case of groundless threats of legal proceedings.—Where any person claiming [to be the patentee of an invention] *to have an interest in a patent*, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person 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 he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of [any legal rights of the person making such threats] *the patent*:

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.

Provided that this section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence.

This amendment remedies a defect in the law illustrated in **37***.

Miscellaneous.

37. Grant of patents to two or more persons.—Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

38. Avoidance of certain conditions attached to the sale, &c. of patented articles.—(1) It shall not be lawful in any contract made after the passing of this Act, in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(*a*) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(*b*) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy:

Provided that this subsection shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving

the other party three months' notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

In any action, application, or proceedings under this Act no person shall be estopped from applying for or obtaining relief by reason of any admission made by him as to the reasonableness of the terms offered to him under subsection (1) (i).

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months' notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) Nothing in this section shall—

(*a*) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(*b*) be construed as validating any contract which would, apart from this section, be invalid; or

(*c*) affect any right of determining a contract or condition in a contract exerciseable independently of this section; or

(*d*) affect any condition in a contract for the lease of or licence to

use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

The effect of the alteration is simply that no such admission is an estoppel. It is of course still admissible as evidence that in fact a reasonable alternative was offered.

†38A. Chemical products and substances intended for food or medicine.—(1) *In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents: Provided that in an action for infringement of a patent where the invention relates to the production of a new substance, any substance of the same chemical composition and constitution shall in the absence of proof to the contrary be deemed to have been produced by the patented process.*

(2) *In the case of any patent for an invention intended for or capable of being used for the preparation or production of food or medicine, the comptroller shall, unless he sees good reason to the contrary, grant to any person applying for the same, a licence limited to the use of the invention for the purposes of the preparation or production of food or medicine but not otherwise; and, in settling the terms of such licence and fixing the amount of royalty or other consideration payable, the comptroller shall have regard to the desirability of making the food or medicine available to the public at the lowest possible price consistent with giving to the inventor due reward for the research leading to the invention.*

Any decision of the comptroller under this subsection shall be subject to appeal to the court.

Sub-sec. (1).—This is, of course, the adoption of the German practice, and the new provisions will greatly increase the difficulty of drafting chemical patents. Owing to the very restricted application of the doctrine of equivalence in regard to such patents (*cf.* 1 and see Moulton, p. 146), it will be necessary in the case of a new substance to claim all practicable modes of preparing it, and each such claim opens a new avenue for attack on the grounds of non-utility and insufficiency. Further, the provisions of section 32A may not help the patentee as these only apply when a claim is held invalid, whereas a false representation as to a result being produced may be held to be a false suggestion affecting the grant as a whole, *cf.* 56, 113, 82, and see Moulton, p. 98.

The best course would seem to be to claim the best practicable method known to the patentee in the main patent, and to take out one or more patents of addition for the alternative processes. These should preferably be applied for before the publication of the first specification. The proviso would seem to apply if the substance is in fact new whether this is stated in the specification or not.

Sub-sec. (2).—This sub-section seems a curious addition to the law at a time when we hear so much of the need of encouraging commercial firms to take up scientific research.

The directions as to settling the terms of licences make it clear that the question of profits for the licensee is subsidiary to that of remuneration to the inventor and low price

† This section only applies to patents applied for after 23rd Dec., 1919. 1919, sec. 11 (2).

to the public. "Inventor" would seem to include a firm or company if they were applicants for the patents. In fact, where such a firm has maintained a laboratory for investigation purposes the "remuneration" for the research leading up to the invention could only be properly determined by considering the expense that they had incurred, since the individual who made the particular discovery patented may have only played a small part in the whole course of research that led up to it.

39. Costs and security for costs.—(1) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

See substituted section 73A.

40. Procedure on appeal to law officer.—The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer 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.

41. Provisions as to anticipation.—(1) An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof, having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

Provided that the protection afforded by this sub-section shall not extend to a patentee who has commercially worked his invention in the United Kingdom otherwise than for the purpose of reasonable trial of the invention prior to the application of the patent.

The alteration does not seem to make any substantial difference, since commercial—as opposed to experimental—working would in any case invalidate the patent. See Moulton, p. 67 n. (f), and p. 71.

The proviso does not apply in the case of patents granted before the passing of this Act, 1919, sec. 13 (2).

42. Disconformity.—A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

43. Patent on application of representative of deceased inventor.

(1) If the person claiming to be inventor of an invention dies without making an 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 must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

44. Loss or destruction of patent.—If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time seal a duplicate thereof.

45. Provisions as to exhibitions.—(1) 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, *or the reading of a paper by an inventor before a learned society or the publication of the paper in the society's transactions*, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

(*a*) the exhibitor, before exhibiting the invention, *or the person reading such paper or permitting such publication* gives the comptroller the prescribed notice of his intention to do so; and

(*b*) the application for a patent is made before or within six months from the date of the opening of the exhibition, *or the reading or publication of such paper*.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

The effect of the alteration would have been much greater if the proviso as to giving notice beforehand had been omitted. Very often the inventor may not realise that his discovery is of commercial value till after the paper has been read, and will consequently not have given notice.

"Learned society" is not defined in the Act. The form of notice will be prescribed by rules. Probably it will be sufficient to state that a paper on a named subject will be read (or published) which contains an account of an invention for which the author proposes to seek protection.

46. Publication of illustrated journal, indexes, &c.—(1) The comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he 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 in force, with any accompanying drawings.

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

47. Patent Museum.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education 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.

48. Foreign vessels in British waters.—(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 His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

PART II.

DESIGNS.

Registration of Designs.

49. Application for registration of designs.—(1) The comptroller may, on the application made in the prescribed form and manner 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 same design may be registered in more than one class, and, in case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(3) 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, *except where the refusal is given on a ground mentioned in section seventy-five of this Act*, appeal to the [Board of Trade] *court*, and the [Board] *court* shall, after hearing the applicant and the comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(4) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(5) A design when registered shall be registered as of the date of the application for registration.

Where a design is refused under sec. 75, *i.e.* as contrary to law or morality, an appeal lies to the law officer.

50. Registration of designs in new classes.—Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

(*a*) on the ground of the design not being a new [and] *or* original design, by reason only that it was so previously registered ; or

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

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from the previous registration.

51. Certificate of registration.—(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, furnish one or more copies of the certificate.

52. Register of designs. (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 be prescribed.

(2) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(3) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Copyright in registered Designs.

53. Copyright on registration.—(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) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller shall on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

54. Requirements before delivery on sale.—(1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

(*a*) (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 the copyright in the design shall cease; and

(*b*) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

(2) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as they think fit.

55. Effect of disclosure on copyright.—The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

56. Inspection of registered designs.—(1) During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in writing by him, or a person authorised by the comptroller or by the court, and furnishing such information as may enable the comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground

of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this section for different classes of goods.

57. Information as to existence of copyright. On the request of any person furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, the comptroller shall inform such person whether the registration still exists in respect of the design, and if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor.

58. Cancellation of registration of designs used wholly or mainly abroad.—(1) At any time after the registration of a design any person may apply to the comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an application is made the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the comptroller.

(2) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

58. Cancellation of registration of designs.—(1) *At any time after the registration of a design any person interested may apply to the comptroller for the cancellation of the registration of the design, on either of the following grounds :—*

(*a*) *That the design has been published in the United Kingdom prior to the date of registration :*

(*b*) *That the design is applied by manufacture to any article in a foreign country, and is not so applied by manufacture in the United Kingdom to such an extent as is reasonable in the circumstances of the case :*

Provided that, if the application be on the last-mentioned ground, and the comptroller is satisfied that the time which has elapsed from the date of registration has been insufficient for such application by manufacture in the United Kingdom, the comptroller may adjourn the application for such time as he may deem sufficient

for that purpose; and that in lieu of cancellation the comptroller may order the grant of a compulsory licence on such terms as he may consider just.

(2) *An appeal shall lie from any order of the comptroller under this section to the court, and the comptroller may at any time refer any such application to the court for trial.*

In the 1907 Act the words were "any person may apply." There are no reported cases as to how wide an interpretation should be given to these words. It is now provided that "any person interested may apply." As to the meaning of "interested" see sec. 27 (7) and (8), and notes thereto.

The main difference between this section and the provisions for revocation of patents on the ground that the manufacture is wholly or mainly abroad is that in the case of a patent the application may not be made until four years after the date of the patent whereas in the case of a design the application on this ground may be made at any time after registration. The section will not, however, be applied unreasonably. See **119** and Introduction "Designs."

58A. Registration of designs to bind the Crown. *The registration of a design shall have to all intents the like effect as against His Majesty the King as it has against a subject:*

Provided that the provisions of sec. 29 of this Act shall apply to registered designs as though those provisions were herein re-enacted and in terms made applicable to registered designs.

Industrial and International Exhibitions.

59. Provisions as to exhibitions.—(1) The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

(*a*) The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the comptroller the prescribed notice of his intention to do so; and

(*b*) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

Legal Proceedings.

60. Piracy of registered design.—(1) During the existence of copyright in any design it shall not be lawful for any person—

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

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

(2) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery of damages for such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

61. Application of certain provisions of the Act as to patents to designs. The provisions of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.

PART III.

GENERAL.

Patent Office and Proceedings thereat.

62. Patent Office.—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

63. Officers and clerks.—(1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may 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 those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

64. Seal of Patent Office.—Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Fees.

65. Fees.—There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such

fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Provisions as to Registers and other Documents in Patent Office.

66. Trust not to be entered in registers.—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.

67. Inspection of and extracts from registers.—Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and 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.

68. Privilege of reports of examiners.—Reports of examiners made under this Act 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, unless the court or officer having power to order discovery in such legal proceeding certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed. *Provided that, on an application being made by any person in the prescribed form, the comptroller may disclose the result of a search made under section seven or eight of this Act on any particular application for the grant of a patent.*

Probably all that will be disclosed under this proviso is the specifications referred to by the examiners; it is improbable that the actual reports of the examiners will be given.

69. Prohibition of publication of specification, drawings, &c. where application abandoned, &c.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens, left in connexion with the application shall not at any time be open to public inspection or be published by the comptroller.

70. Power for comptroller to correct clerical errors.—The comptroller may, on request in writing accompanied by the prescribed fee,—

(*a*) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification ;

(*b*) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered ;

(*c*) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

71. Entry of assignments and transmissions in registers.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence or dealing : Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

71.—(1) *Where a person becomes entitled by assignment, transmission, or other operation of law to a patent or to the copyright in a registered design, he shall make application to the comptroller to register his title, and the comptroller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title.*

(2) *Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, he shall make application to the comptroller to register his title, and the comptroller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be, with particulars of the instrument, if any, creating such interest.*

(3) *The person registered as the proprietor of a patent or design shall,*

subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to or otherwise deal with the patent or design, and to give effectual receipts for any consideration for any such assignment, licence or dealing:

Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

(4) Except in applications made under section seventy-two of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsections (1) *and* (2) *aforesaid, shall not be admitted in evidence in any court in proof of the title to a patent or copyright in a design or to any interest therein unless the court otherwise directs.*

The provision as to non-registered documents not being generally available as evidence is new. It is difficult to see its object as it does not make registration a necessity for obtaining rights, but only for enforcing them. An unregistered owner can obtain a legal title to a patent, and if the former owner of the patent sells it over again, the second purchaser apparently obtains no title. In view of sec. 66 this section can hardly apply to disputes as to equitable rights.

72. Rectification of registers by court.—(1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

Powers and Duties of Comptroller.

73. Exercise of discretionary power by comptroller.—Where any discretionary power is by or under 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 design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

73A.—(1) *The comptroller shall, in any proceedings before him under this Act, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of court.*

(2) *If any party giving notice of any opposition under this Act, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller under this Act, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or in case of appeal to the law officer or the court, the law officer or the court may require such party to give security for the costs of the proceedings or appeal, and in default of such security being given may proceed to treat the proceedings or appeal as abandoned.*

This extension of the power of giving costs will include such cases as applications for licences, rectification of the register, etc.

74. Power of comptroller to take directions of law officers.—The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

75. Refusal to grant patent, &c. in certain cases.—The comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality. *An appeal shall lie from the decision of the comptroller under this section to the Law Officer.*

76. Annual reports of comptroller.—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 the 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.

Evidence, &c.

77. Evidence before comptroller.—(1) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence vivâ voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before

the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken viva voce, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, *and discovery and production of documents*, be in the same position in all respects as an official referee of the Supreme Court.

Discovery and production can only be ordered when some evidence is taken *viva voce*.

78. Certificate of comptroller to be evidence.—A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

79. Evidence of documents in Patent Office.—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, 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 His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

80. Transmission of certified printed copies of specifications, &c.—(1) 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 they have been accepted or allowed at the Patent Office.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person 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.

81. Applications and notices by post.—Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.

82. Excluded days.—Where the last day fixed by this Act for doing

anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

88. Declaration by infant, lunatic, &c.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

84. Register of patent agents.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

84. Registration of patent agents.—(1) *No person shall practise, describe, or hold himself out, or permit himself to be described or held out, as a patent agent, unless—*

(a) in the case of an individual, he is registered as a patent agent in the register of patent agents ;

(b) in the case of a firm, every partner of the firm is so registered ;

(c) in the case of a company which commenced to carry on business as a patent agent after the seventeenth day of November nineteen

hundred and seventeen, every director and the manager (if any) of the company is so registered;

(d) *in the case of a company which commenced to carry on business as a patent agent before that date, a manager or a director of the company is so registered:*

Provided that in the last-mentioned case the name of such manager or director shall be mentioned as being a registered patent agent in all professional advertisements, circulars or letters in which the name of the company appears.

(2) *Every individual not registered as a patent agent before the fifteenth day of July nineteen hundred and nineteen who proves to the satisfaction of the Board of Trade that prior to the first day of August nineteen hundred and seventeen he was bonâ fide practising as a patent agent, whether individually or as member of a firm, or as a manager or director of an incorporated company, shall be entitled to be registered as a patent agent if he makes an application for the purpose within such time as may be fixed by the Board of Trade, unless after giving an applicant an opportunity of being heard the Board of Trade are satisfied that he has whilst so practising been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom.*

(3) *If any person contravenes the provisions of this section, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds, and in the case of a company every director, manager, secretary, or other officer of the company who is knowingly a party to the contravention shall be guilty of a like offence and liable to a like fine.*

(4) *For the purposes of this section, the expression "patent agent" means a person, firm, or company carrying on for gain in the United Kingdom the business of applying for or obtaining patents in the United Kingdom or elsewhere.*

(5) *Nothing in this section shall be taken to prohibit solicitors from taking such part as they have heretofore taken in any proceedings under this Act.*

(6) *No person not registered before the fifteenth day of July nineteen hundred and nineteen shall be registered as a patent agent unless he be a British subject.*

Sub-sec. (1). The prohibition of "practising" as a patent agent is new and meets the difficulty that unless it could be proved that the defendant had actually called himself a patent agent he could not be convicted. **47.**

The term "practise" implies a habitual course of conduct and the section would not seem to prevent a person acting as agent for another, *e.g.* for a friend abroad, in taking out a particular patent. Nor does it cover the case of gratuitous acts. See sub-sec. (4).

The provisions as to firms and companies have also been greatly strengthened.

Sub-sec. (2). The 1st of August, 1917, was the date when the Bill which first contained this clause was introduced, though it did not then become law.

Practice as a clerk (except as manager of a company) would not come within this sub-section. It should be noted that persons who can prove that they so practised before the 1st of August, 1917, even though they were not then entitled to call themselves

patent agents, will have a right to do so after registration. The proceedings in regard to disgraceful professional conduct are regulated by the Patent Agent Rules.

Sub-sec. (3). The chartered Institute can institute prosecutions under this section in Scotland. 68. In England the information could probably be laid by any persons. *Cf.* 47.

Sub-sec. (4). The former legislation applied to persons dealing with British Patents (see 68), the present action would seem to prevent a foreign firm having a branch here for the purpose of taking out patents abroad, unless the branch is conducted by registered Patent Agents.

A clerk or other employee of a firm taking out patents for that firm only would not come within the definition of carrying on a business.

The business prohibited is that of "applying for or taking out patents." Other work, *e.g.* advising on patents, making searches, paying renewal fees, etc., is not included, nor are acts relating to designs.

Sub-sec. (5). This would seem hardly necessary. Generally the part which has been taken by solicitors has been confined to such acts as representing parties at hearings, or on questions of rectification, etc., or other matter which would not come within sub-sec. (4).

85. Agents for patents.—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c. of Board of Trade.

86. Power for Board of Trade to make general rules.—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a*) For regulating the practice of registration under this Act :

(*b*) For classifying goods for the purposes of designs :

(*c*) For making or requiring duplicates of specifications, 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, 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 abridgements 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*) For regulating the keeping of the register of patent agents under this Act

(*h*) 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) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

87. Proceedings of the Board of Trade.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

88. Provision as to Order in Council.—An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take

effect as if it had been contained in this Act ; but may be revoked or varied by a subsequent Order.

Offences.

89. Offences.—(1) 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.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

90. Unauthorised assumption of Royal Arms.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connexion with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds :

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

International and Colonial Arrangements.

91. International and Colonial arrangements.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state, *or his legal representative or assignee*, shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state.

Provided that—

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state; and

(*b*) Nothing in this section shall entitled the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(*a*) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(*b*) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(*c*) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(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 or the Trade Marks Act, 1905: Provided that—

(*a*) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and

(*b*) 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 the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, [and] *or* trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

This amendment to sub-sec. (1) was made by the Patents and Designs Act, 1914 (4 & 5 Geo. 5, c. 18). As to extensions of the periods for applications made before or during the war, see Introduction "Treaty Rights."

Definitions.

92. Provisions as to "the court."—(1) In this Act, unless the context otherwise requires, "the court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, *except in the case of a petition for the revocation of a patent under section twenty-five of this Act, and* subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose. [and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.] *An appeal shall not lie from any decision of such judge except in the case of an order revoking or confirming the revocation of a patent.*

This alteration finally corrects the errors in sec. 92 of the 1907 Act. If, owing to the Court making or confirming an order for revocation, an appeal is made to the Court of Appeal either party can appeal to the House of Lords against this decision.

In the case of petitions to the Court for revocation there is an unlimited right of appeal.

93. Definitions.—In this Act, unless the context otherwise requires,—

"Law officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act:

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

["Patentee" means the person for the time being entitled to the benefit of a patent:]

"*Patentee*" *means the person for the time being entered on the register as the grantee or proprietor of the 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 :

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant :

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined :

"*Design*" *means only the features of shape, configuration, pattern, or ornament applied to any article by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye ; but does not include any mode or principle of construction, or anything which is in substance a mere mechanical device.*

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural :

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered :

"Proprietor of a new [and] *or* original design,"—

(*a*) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed ; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired ; and

(*c*) In any other case, means the author of the design ;

and where the property in, or the right to apply, the design has

devolved from the original proprietor upon any other person, includes that other person.

"*Working on a commercial scale*" *means the manufacture of the article or the carrying on of the process described and claimed in a specification for a patent in or by means of a definite and substantial establishment or organisation, and on a scale which is adequate and reasonable under all the circumstances.*

The new definition of "Patentee" has the merit of certainty. As to decisions on the meaning of this term as formerly defined, see Moulton, p. 201.
As to "Design," see Introduction, "Designs."

Application to Scotland, Ireland, and the Isle of Man.

94. Application to Scotland.—In the application of this Act to Scotland—

(1) 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 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; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence which concurrence may be given on just cause shown only, and 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:

(4) 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 in any proceedings relating to patents or to designs; and with reference to any such proceedings, 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 that Court:

(5) Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court, in

Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary :

(5) *Notwithstanding anything in this Act, the expression "the Court" shall in reference to proceedings in Scotland for the extension of the term of a patent mean any Lord Ordinary of the Court of Session.*

(6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt :

(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, 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 :

(8) The expression "injunction" means "interdict."

95. Application to Ireland.—In the application of this Act to Ireland—

(1) 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 :

(2) 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 Ireland in any proceedings relating to patents or to designs ; and with reference to any such proceedings the term "the Court" means the High Court in Ireland :

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, 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.

96. Isle of Man.—This Act shall extend to the Isle of Man, subject to the following modifications :—

(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 or design competent to those courts

(2) The punishment for a misdemeanour 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, Savings, and Short Title.

97. Saving for prerogative.—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.

98. Repeal and savings.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

(*a*) As respects the enactments mentioned in Part I. of that schedule, as from the commencement of this Act ;

(*b*) As respects the enactments mentioned in Part II. of that schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation ;

(*c*) As respects the enactments mentioned in Part III. of that schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation ;

and the enactments mentioned in Part II. and Part III. of that schedule shall, until so repealed, have effect as if they formed part of this Act :

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

99. Short title and commencement.—This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

The amendments take effect from the passing of the 1919 Act, *i.e.* 23rd December, 1919, except in the case of secs. 24, 27, and 29.

SCHEDULES.

FIRST 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
On the sealing of the patent in respect of investigations as to anticipation -		1 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 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

SECOND SCHEDULE.

Enactments Repealed.

Part I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except sub-sections (5), (6), and (7) of section twenty-six, section twenty-nine, sub-sections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 - -	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7. c. 18.	The Patents Act, 1901 - -	The whole Act.
2 Edw. 7. c. 34.	The Patents Act, 1902 - -	The whole Act.
7 Edw. 7. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (2) and (3) of section forty-seven and section forty-eight.

The renewal fees as charged at present are £5 for the fifth year, and amounts increasing £1 per year for each subsequent year.

PATENTS AND DESIGNS ACT, 1919.†

[28*rd December*, 1919].

Sec. 1 enacts sec. 27 of 1907 Act.
„ 2 „ sec. 24 of „ „
„ 3 „ sec. 27A of „ „
„ 4 amends sec. 11 of „ „
„ 5 „ sec. 12 of „ „

6. Term of patent.—(1) The term limiting the duration of patents shall be increased from fourteen to sixteen years, and accordingly in subsection (1) of section seventeen of the principal Act, for the word "fourteen" there shall be substituted the word "sixteen."

(2) Any patent the original term of which had not expired at the date of the commencement of this Act shall have effect as if the term mentioned therein was sixteen years instead of fourteen years, subject to the following conditions :—

(*a*) any licence existing at that date which has been granted for the term of the patent shall be treated as having been granted for the term as so extended if the licensee so desires ;

(*b*) if the patent would apart from this section have expired on or before the first day of January nineteen hundred and twenty, the patent shall, during the period of extension, be subject to all the provisions by this Act substituted for section twenty-four of the principal Act (except subsection (5) thereof) as if the patent had been endorsed "licences of right."

(3) Where any party to a contract with the patentee or any other person, entered into before the nineteenth day of November nineteen hundred and seventeen, is subjected to loss or liability by reason of the extension of the term of any patent under the provisions of this section, the court shall have power to determine in what manner and by which parties such loss or liability shall be borne.

As the licensee has the option he should notify the licensor if he requires the licence to continue. If he does not do so the licensor should inquire whether he wishes to remain a licensee or not.

The provisions of para. (*b*) only apply to the small number of patents expiring between 23rd December, 1919, and 1st January, 1920. The question of fees must be dealt by the rules, but probably where ten renewal fees have been paid no further fees will be required.

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† The sections of the 1907 Act have been printed as amended by this Act, as is directed in 1919, sec. 2 (2), so that it is unnecessary to repeat the amending sections here.

Sec.	7 amends	sec.	18	of	1907	Act.
,,	8 enacts	,,	29	,,	,,	
,,	9 ,,	,,	32A	,,	,,	
,,	10 amends	,,	34	,,	,,	
,,	11 enacts	,,	38A	,,	,,	
,,	12 repeals	,,	39 and enacts sec. 73A			of 1907 Act.
,,	13 amends	,,	41	of	1907	Act.
,,	14 enacts	,,	58	,,	,,	
,,	15 ,,	,,	58A	,,	,,	
,,	16 ,,	,,	71	,,	,,	
,,	17 amends	,,	75	,,	,,	
,,	18 enacts	,,	84	,,	,,	
,,	19 amends	,,	93	,,	,,	

20. Minor amendments of principal Act.—The amendments specified in the second column of the Schedule to this Act, which relate to minor details, shall be made in the provisions of the principal Act specified in the first column of that schedule.

21. Construction, printing, and repeal.—(1) This Act shall, except where otherwise expressly provided, apply to patents granted and applications for and specifications relating to patents made and deposited, and designs registered, before as well as after the passing of this Act.

(2) Where by this Act any enactments or words are directed to be added to or omitted from the principal Act, or to be substituted for any other enactments or words in the principal Act, copies of the principal Act printed under the authority of His Majesty's Stationery Office after such direction takes effect may be printed with the enactments or words added or omitted, or substituted for other enactments or words as such direction requires, and with the sections, subsections, and paragraphs thereof numbered in accordance with such directions; and the principal Act shall be construed as if it had at the time at which such direction takes effect been made with such addition, omission, or substitution.

(3) A reference in any Act of Parliament or other instrument to the principal Act shall, unless the context otherwise requires, be construed to refer to the principal Act as amended by this Act.

(4) The Patents and Designs Act, 1908, is hereby repealed.

22. Short title and commencement.—(1) This Act may be cited as the Patents and Designs Act, 1919, and the principal Act and this Act may be cited together as the Patents and Designs Acts, 1907 and 1919.

(2) The provisions by sections one and two of this Act substituted for sections twenty-seven and twenty-four of the principal Act shall not come

into operation until such time, not being later than one year after the passing of this Act, as may be fixed by Order of the Board of Trade, except so far as the provisions so substituted for the said section twenty-four are by subsection (2) of section six of this Act applied to the patents therein mentioned; and the provisions of this Act relating to the terms on which an invention or registered design can be made, used or exercised by or on behalf of a Government department shall not come into operation until such time as may be fixed by Order of the Board of Trade; save as aforesaid this Act shall come into operation on the passing thereof.

SCHEDULE.

This contains the amendments to sections 5, 6, 7, 8, 12, 13, 15, 16, 19, 20, 21, 22, 23, 25, 26, 31, 34, 35, 36, 38, 45 (1), 49 (3), 50, 68, 77, 91, 92, 93, and 94, as there shown.

TRADE MARKS ACT, 1905.

An Act to consolidate and amend the Law relating to Trade Marks.

[11*th August* 1905.]

BE it enacted by the King'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 :

1. Short title.—This Act may be cited as the Trade Marks Act, 1905.

2. Commencement of Act —This Act shall, save as otherwise expressly provided, come into operation on the first day of April one thousand nine hundred and six.

The amendments as shown to this Act come into force on the 1st April, 1920. See 1919, sec. 13.

PART 1.

Definitions.

3. Definitions.—In and for the purposes of this Act (unless the context otherwise requires) :—

A " mark " shall include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof :

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

A " registrable trade mark " shall mean a trade mark which is capable of registration under the provisions of this Act :

" The register " shall mean the register of trade marks kept under the provisions of this Act :

A " registered trade mark " shall mean a trade mark which is actually upon the register :

" Prescribed " shall mean, in relation to proceedings before the Court, prescribed by rules of court, and in other cases, prescribed by this Act or the Rules thereunder :

" The Court " shall mean (subject to the provisions for Scotland, Ireland, and the Isle of Man) His Majesty's High Court of Justice in England.

Register of Trade Marks.

4. Register of trade marks.—There shall be kept at the Patent Office for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations, and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Comptroller-General of Patents, Designs, and Trade Marks, who is in this Act referred to as the Registrar.

5. Trust not to be entered on register.—There shall not be entered in the register any notice of any trust expressed, implied, or constructive, nor shall any such notice be receivable by the Registrar.

6. Incorporation of ıg **register.**—The register of trade marks existing at the date of th ommencement of this Act, and all registers of trade marks kept under previous Acts, which are deemed part of the same book as such register, shall be incorporated with and form part of the register. Subject to the provisions of sections thirty-six and forty-one of this Act the validity of the original entry of any trade mark upon the registers so incorporated shall be determined in accordance with the statutes in force at the date of such entry, and such trade mark shall retain its original date, but for all other purposes it shall be deemed to be a trade mark registered under this Act.

7. Inspection of and extract from register.—The 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.

Registrable Trade Marks.

8. Trade mark must be for particular goods.—A trade mark must be registered in respect of particular goods or classes of goods.

9. Registrable trade marks.—A registrable trade mark must contain or consist of at least one of the following essential particulars:—

(1) The name of a company, individual, or firm represented in a special or particular manner;

(2) The signature of the applicant for registration or some predecessor in his business ;

(3) An invented word or invented words ;

(4) A word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname ;

(5) Any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraphs (1), (2), (3), and (4), shall not, [except by order of the Board of Trade or the Court, be deemed a distinctive mark :] *be registrable under the provisions of this paragraph, except upon evidence of its distinctiveness :*

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

For the purposes of this section " distinctive " shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the tribunal may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

The amendment has the advantage of shortening the proceedings in applications of this nature.

Under the 1905 Act the practice has been for the Registrar to refer such applications for marks coming within the subsection to the Board of Trade. The functions of the Board (or the Court) in this respect are now transferred to the Registrar. It is presumed that the Registrar will consider evidence of the distinctiveness of the mark when considering whether an application should be accepted under sec. 12. It would, however, be open to the Registrar to accept the mark subject to production of evidence of its distinctiveness and cause it to be advertised under sec. 13, a course which would seem to be contemplated by the amendment to that section. In the latter case when the mark is opposed the question of distinctiveness would, it is presumed, be considered at the hearing of the opposition. Distinctive is defined in sec. 9 as meaning adapted to distinguish. See **101** and cases collected in Laws of England, sub tit. "Trade Marks," vol. 27, p. 696.

10. Coloured trade marks.—A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by any tribunal having to decide in the distinctive character of such trade mark. If and so far as a

trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

11. Restriction on registration.—It shall not be lawful to register as a trade mark or part of a trade mark any matter, the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Registration of Trade Marks.

12. Application for registration.—(1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner.

(2) Subject to the provisions of this Act the Registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments, or modifications, *or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose.*

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Board of Trade or to the Court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the Board of Trade or the Court, as the case may be, shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments, or modifications, if any, *or to what limitations, if any, as to mode or place of user or otherwise* the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the Board of Trade or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connexion with the application, or may permit the applicant to amend his application upon such terms as they may think fit.

This restores the former practice by which such local limitations were imposed by the office till it was held that they had no power to do so. See **30.**

There is no reported case in the Courts showing how such limitations could be enforced. Possibly these powers may be exercised somewhat freely in the case of Class B

applications and applications under sec. 9 (5) where the applicant's evidence of user only relates to a limited area.

18. Advertisement of application.—When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions *and limitations*, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions *and limitations* subject to which the application has been accepted.

Provided that an application under the provisions of subsection (5) of section nine of this Act may be advertised by the Registrar on receipt of such application and before acceptance.

Where the last course is followed one hearing will suffice for both acceptance and opposition purposes.

14. Opposition to registration.—(1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant, and within the prescribed time after the receipt of such notice, the applicant shall send to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant sends such counter-statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, *or what limitations as to mode or place of user or otherwise* registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the Court [or, with the consent of the parties, to the Board of Trade].

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal [the Board of Trade or] the Court, [as the case may be,] shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, *or what limitations, if any, as to mode or place of user or otherwise*, registration is to be permitted.

(7) On the hearing of any such appeal any party may either in the manner prescribed or by special leave of the tribunal bring forward further material for the consideration of the tribunal.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as

herein-above provided except by leave of the tribunal hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(9) In any appeal under this section, the tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) The Registrar, or in the case of an appeal to the Board of Trade the Board of Trade, shall have power in proceedings under this section to award to any party such costs as they may consider reasonable, and to direct how and by what parties they are to be paid.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in the United Kingdom, the tribunal may require such party to give security for costs of the proceedings before it relative to such opposition or appeal, and in default of such security being duly given may treat the opposition or appeal as abandoned.

As to limitations see note to sec. 12.
As to appeals, see 1919, sec. 8.
As to costs, see 1919, sec. 10.

15. Disclaimers.—If a trade mark contains parts not separately registered by the proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the Board of Trade or the Court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any right to the exclusive use of any part or parts of such trade mark, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration: Provided always that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

16. Date of registration.—When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed the opposition has been decided in favour of the applicant, the Registrar shall, *unless the mark has been accepted in error or* unless the Board of Trade otherwise direct, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration.

17. Certificate of registration.—On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar, and sealed with the seal of the Patent Office.

18. Non-completion of registration.—Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Identical Trade Marks.

19. Identical marks.—Except by order of the Court or in the case of trade marks in use before the thirteenth day of August one thousand eight hundred and seventy-five, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive.

20. Rival claims to identical marks.—Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or (on appeal) by the Board of Trade.

21. Concurrent user.—In case of honest concurrent user or of other special circumstances which, in the opinion of the Court *or Registrar*, make it proper so to do, the Court *or Registrar* may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user or otherwise, [as it may think right to impose] *as the Court or the Registrar, as the case may be, may think it right to impose.*

This gives the Registrar the same powers of determination as are reserved to the Court under sec. 20. It should be observed that the amended section does not direct that the Registrar shall determine the rights in question; he may still proceed under sec. 20. As to former power of the Registrar see Introduction, "Concurrent User," and 78.

Assignment.

22. Assignment and transmission of trade marks.—A trade mark when registered shall be assigned and transmitted only in connexion with

the goodwill of the business concerned in the goods for which it has been registered and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any British possession or protectorate or foreign country in connexion with any goods for which it is registered together with the goodwill of the business therein in such goods *and the assignment of such right to use the same shall constitute the assignee a proprietor of a separate trade mark for the purpose of section twenty-one of this Act, subject to such conditions and limitations as may be imposed under that section.*

23. Apportionment of marks on dissolution of partnership.—In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks), on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, *and to such limitations, if any, as to mode or place of user*, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

As to limitations, etc., see note to section 12.

Associated Trade Marks.

24. Associated trade marks.—If application be made for the registration of a trade mark *identical with or* so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the tribunal hearing the application may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

25. Combined trade marks.—If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act

be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

26. Series of trade marks.—When a person claiming to be the proprietor of several trade marks for the same description of goods which while resembling each other in the material particulars thereof, yet differ in respect of—

(*a*) statements of the goods for which they are respectively used or proposed to be used ; or

(*b*) statements of number, price, quality, or names of places ; or

(*c*) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark ; or

(*d*) colour ;

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

27. Assignment and user of associated trade marks.—Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks. Provided that where under the provisions of this Act user of a registered trade mark is required to be proved for any purpose, the tribunal may if and so far as it shall think right accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Renewal of Registration.

28. Duration of registration.—The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

[29. Renewal of registration.—The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or of the last renewal of registration, as the case may be, which date is herein termed " the expiration of the last registration."

30. Procedure on expiry of period of registration.—At the prescribed time before the expiration of the last registration of a trade mark,

the Registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if at the expiration of the time prescribed in that behalf such conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

As to marks which have lapsed during the war, see Introduction "Treaty Rights."

31. Status of unrenewed trade mark.—Where a trade mark has been removed from the register for nonpayment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there had been no bonâ fide trade user of such trade mark during the two years immediately preceding such removal.

Correction and Rectification of the Register.

32. Correction of register.—The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled by law to act in his name,—

(1) Correct any error in the name or address of the registered proprietor of a trade mark; or

(2) Enter any change in the name or address of the person who is registered as proprietor of a trade mark; or

(3) Cancel the entry of a trade mark on the register; or

(4) Strike out any goods or classes of goods from those for which a trade mark is registered; or

(5) Enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

Any decision of the Registrar under this section shall be subject to appeal to the Board of Trade.

33. Registration of assignments, &c.—Subject to the provisions of this Act where a person becomes entitled to a registered trade mark by assignment, transmission, or other operation of law, the Registrar shall, on request made in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the Court or, with the consent of the parties, to the Board of Trade.

33.—(1) *Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of the trade mark, and shall cause an entry to be made in the prescribed manner on the register of the assignment, transmission, or other instrument affecting the title. Any decision of the Registrar under this section shall be subject to appeal to the Court.*

(2) *Except in cases of appeals under this section and applications made under section thirty-five of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection* (1) *aforesaid shall not be admitted in evidence in any court in proof of the title to a trade mark unless the Court otherwise directs.*

See note to section 71 of the Patents and Designs Act, 1907.

34. Alteration of registered trade mark.—The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave or may grant the same on such terms *and subject to such limitations as to mode or place of user* as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the Board of Trade. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

See note to section 12.

35. Rectification of register.—Subject to the provisions of this Act—

(1) The Court may on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, make such order for making, expunging, or varying such entry as it may think fit :

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of the register :

(3) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section :

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner, who shall upon receipt of such notice rectify the register accordingly.

These provisions give the applicant the option of a less expensive procedure. It is probable that in cases of real doubt the Registrar will refer the application to the court.

36. Trade marks registered under previous Acts.—No trade mark which is upon the register at the commencemnnet of this Act and which under this Act is a registrable trade mark shall be removed from the register on the ground that it was not registrable under the Acts in force at the date of its registration. But nothing in this section contained shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Acts then in force.

37. Non-user of trade mark.—A registered trade mark may, on the application to the court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any bonâ fide intention to use the same in connexion with such goods, and there has in fact been no bonâ fide user of the same in connexion therewith, or on the ground that there has been no bonâ fide user of such trade mark in connexion with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Effect of Registration.

38. Powers of registered proprietor.—Subject to the provision of this Act—

(1) The person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from such register to be vested in any other person, have power to assign the same, and to give effectual receipts for any consideration for such assignment :

(2) Any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

39. Rights of proprietor of trade mark.—Subject to the provisions of section forty-one of this Act and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the

use of such trade mark upon or in connexion with the goods in respect of which it is registered: Provided always that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

40. Registration to be primâ facie evidence of validity.—In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the fact that a person is registered as proprietor of such trade mark shall be primâ facie evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

41. Registration to be conclusive after seven years.—In all legal proceedings relating to a registered trade mark (including applications under section thirty-five of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section eleven of this Act:

Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connexion with goods upon or in connexion with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user *or registration, whichever is the earlier*, of the first-mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section twenty-one of this Act.

As to the interpretation put upon this section, see Introduction "Old Marks."
As to non-user after registration, see sec. 37 and Laws of England, sub tit. "Trade Marks," vol. 27, p. 717.

42. Unregistered trade marks—No persons shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark was in use before the thirteenth of August one thousand eight hundred and seventy-five, and has been refused registration under this Act. The Registrar

may, on request, grant a certificate that such registration has been refused.

43. Infringement.—In an action for the infringement of a trade mark the court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connexion with such goods by other persons.

In any action or proceeding relating to a trade mark or trade name the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

This would seem merely to sanction what has been largely done.

44. User of name, address, or description of goods.—No registration under this Act shall interfere with any bonâ fide use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any bonâ fide description of the character or quality of his goods.

45. "Passing-off" action.—Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

Legal Proceedings.

46. Certificate of validity.—In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade mark, the Court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless in such subsequent proceeding the Court certifies that he ought not to have the same.

47. Registrar to have notice of proceeding for rectification.—In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court. Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to

the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Costs.

48. Costs of proceedings before the Court.—In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the cost of any other of the parties.

Evidence.

49. Mode of giving evidence.—In any proceeding under this Act before the Board of Trade or the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which it shall think it right so to do, the tribunal may (with the consent of the parties) take evidence vivâ voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken vivâ voce the Board of Trade or the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as an Official Referee of the Supreme Court.

50. Sealed copies to be evidence.—Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

51. Certificate of Registrar to be evidence.—A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

52. Certificate of Board of Trade to be evidence.—(1) All documents purporting to be orders made by the Board of Trade and to be

sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(2) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Part II.

Powers and Duties of Registrar of Trade Marks.

53. Exercise of discretionary power by Registrar.—Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

54. Appeal from Registrar.—Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar otherwise than to the Board of Trade, but the Court, in dealing with any question of the rectification of the register (including all applications under the provisions of section thirty-five of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

55. Recognition of agents.—Where by this Act any act has to be done by or to any person in connexion with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases by special leave of the Board of Trade be done by or to an agent of such party duly authorised in the prescribed manner.

56. Registrar may take directions of law officers.—The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to His Majesty's Attorney-General or Solicitor-General for England for directions in the matter.

57. Annual reports of Comptroller.—The Comptroller General of Patents, Designs, and Trade Marks shall in his yearly report on the execution by or under him of the Patents, Designs, and Trade Marks Act, 1883, and Acts amending the same, include a report respecting the execution by or under him of this Act as though it formed a part of or was included in such Acts.

Powers and Duties of the Board of Trade.

58. Proceedings before Board of Trade.—All things required or authorised under this Act to be done by, to or before the Board of Trade may be done by, to or before the President or a secretary or an assistant secretary of the Board or any person authorised in that behalf by the President of the Board.

59. Appeals to Board of Trade.—Where under this Act an appeal is made to the Board of Trade, the Board of Trade may, if they think fit, refer any such appeal to the Court in lieu of hearing and deciding it themselves, but, unless the Board so refer the appeal, it shall be heard and decided by the Board, and the decision of the Board shall be final.

60. Power of Board of Trade to make rules.—(1) Subject to the provisions of this Act the Board of Trade may from time to time make such rules, prescribe such forms, and generally do such things as they think expedient—

(*a*) For regulating the practice under this Act :

(*b*) For classifying goods for the purposes of registration of trade marks ;

(*c*) For making or requiring duplicates of trade marks and other documents :

(*d*) For securing and regulating the publishing and selling or distributing in such manner as the Board of Trade think fit, of copies of trade marks and other documents :

(*e*) Generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar, or of the Board of Trade.

(2) Rules made under this section shall, whilst in force, be of the same effect as if they were contained in this Act.

(3) Before making any rules under this section the Board of Trade shall publish notice of their intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as the Board consider most expedient, so as to enable persons affected to make representations to the Board before the rules are finally settled.

(4) Any rules made in pursuance of this section shall be forthwith advertised twice in the Trade Marks Journal, and 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.

(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.

Fees.

61. Fees.—There shall be paid in respect of applications and registration and other matters under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade.

Special Trade Marks.

62. Standardization, &c., trade marks.—Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy, or other characteristic, and certifies the result of such examination by mark used upon or in connection with such goods, the Board of Trade may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such examination and certifying. *Where any association or person undertakes to certify the origin, material, mode of manufacture, quality, accuracy or other characteristic of any goods by mark used upon or in connection with such goods, the Board of Trade, if and so long as they are satisfied that such association or person is competent to certify as aforesaid, may, if they shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a goodwill in connection with such certifying.* When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be the proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Board of Trade.

There is now no obligation to examine, but as the Board of Trade have power at any time to withdraw the mark, it is probable that inaccuracies or carelessness on the part of the proprietor of any such mark would lead to the mark being withdrawn.

If any person should be doubtful as to or dissatisfied with the use made of any such mark, he should draw the attention of the Board of Trade to the matter.

Sheffield Marks.

63. Sheffield marks.—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 continue to keep at Sheffield the register of trade marks (in this Act called the Sheffield register) kept by them at the date of the commencement of this Act, and, save as otherwise provided by this Act, such register shall for all purposes form part of the register :

(2) The Cutlers' Company shall, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in such register before the passing of this Act :

(3) An application for registration of a trade mark used on metal goods 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 :

(4) Every application so made to the Cutlers' Company shall be notified to the Registrar in the prescribed manner, and, unless the Registrar within the prescribed time gives notice to the Cutlers' Company of any objection to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :

(5) If the Registrar gives notice of an objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may in the prescribed manner 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 Registrar, 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 Registrar on that day :

(7) The provisions of this Act, and of any rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section (and notwithstanding anything in any Act relating to the Cutlers' Company), apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto ; and this Act and any such rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers'

Company, the office of the Cutlers' Company, and the Sheffield register, for the Registrar, the Patent Office, and the Register of Trade Marks respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Registrar by the Cutlers' Company:

(8) When the Registrar 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 metal goods, he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9) 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 Court:

(10) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal:

(11) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the Master of the Cutlers' Company shall have the same effect as the certificate of the Registrar.

Cotton Marks.

64. Cotton marks.—(1) The Manchester Branch of the Trade Marks Registry of the Patent Office (herein-after called "the Manchester Branch") shall be continued according to its present constitution. A chief officer of the Manchester Branch shall be appointed who shall be styled "the Keeper of Cotton Marks," and shall act under the direction of the Registrar. The present keeper of the Manchester Branch shall be the first Keeper of Cotton Marks.

(2) As regards cotton goods which have hitherto constituted classes 23, 24, and 25, under the classification of goods under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, the Register of Trade Marks for all such goods, except such as may be prescribed, shall be called "the Manchester Register," and a duplicate thereof shall be kept at the Manchester Branch.

(3) All applications for registration of trade marks for such cotton goods in the said classes (herein-after referred to as "cotton marks") shall be made to the Manchester Branch.

(4) Every application so made to the Manchester Branch shall be notified to the Registrar in the prescribed manner together with the report of the Keeper of Cotton Marks thereon, and unless the Registrar, after considering the report and hearing, if so required, the applicant, within the

prescribed time gives notice to the Keeper of Cotton Marks of objection to the acceptance of the application, it shall be advertised by the Manchester Branch and shall be proceeded with in the prescribed manner.

(5) If the Registrar gives notice of objection as aforesaid the application shall not be proceeded with, but any person aggrieved may in the prescribed manner appeal to the Court or the Board of Trade, at the option of the applicant.

(6) Upon the registration of a trade mark in the Manchester Register the Keeper of Cotton Marks shall upon notice thereof from the Registrar thereupon enter the mark in the duplicate of the Manchester Register, and such registration shall bear date as of the day of application to the Manchester Branch, and shall have the same effect as if the application had been made to the Registrar on that day.

(7) When any mark is removed from or any cancellation or correction made in the Manchester Register notice thereof shall be given by the Registrar to the Keeper of Cotton Marks, who shall alter the duplicate register accordingly.

(8) For the purpose of all proceedings in relation to trade marks entered in the Manchester Register a certificate under the hand of the Keeper of Cotton Marks shall have the same effect as a certificate of the Registrar.

(9) In every application for registration of a cotton mark, if such mark has been used by the applicant or his predecessors in business prior to the date of application, the length of time of such user shall be stated on the application.

(10) As from the passing of this Act—

(*a*) In respect of cotton piece goods and cotton yarn no mark consisting of a word or words alone (whether invented or otherwise) shall be registered, and no word or words shall be deemed to be distinctive in respect of such goods :

(*b*) In respect of cotton piece goods no mark consisting of a line heading alone shall be registered and no line heading shall be deemed to be distinctive in respect of such goods :

(*c*) No registration of a cotton mark shall give any exclusive right to the use of any [word], letter, numeral, line heading, or any combination thereof.

(11) The right of inspection of the Manchester Register shall extend to and include the right to inspect all applications whatsoever that have been since the passing of the Trade Marks Registration Act, 1875, and hereafter shall have been made to the Manchester Branch in respect of cotton goods in classes 23, 24, and 25, whether registered, refused, lapsed, expired, withdrawn, abandoned, cancelled, or pending.

(12) The Keeper of Cotton Marks shall, on request, and on production of a facsimile of the mark, and on payment of the prescribed fee, issue a

certified copy of the application for registration of any cotton mark, setting forth in such certificate the length of time of user (if any) of such mark as stated on the application, and any other particulars he may deem necessary.

(13) As regards any rules or forms affecting cotton marks which are proposed by the Board of Trade to be made, the draft of the same shall be sent to the Keeper of Cotton Marks and also to the Manchester Chamber of Commerce. And the said Keeper, and also the said Chamber, shall, if they or either of them so request, be entitled to be heard by the Board of Trade upon such proposed rules before the same are carried into effect.

(14) The existing practice whereby the Keeper of the Manchester Branch consults the Trade and Merchandise Marks Committee appointed by the Manchester Chamber of Commerce upon questions of novelty or difficulty arising on applications to register cotton marks shall be continued by the Keeper of Cotton Marks.

International and Colonial Arrangements.

65. International and Colonial arrangements.—The provisions of sections one hundred and three and one hundred and four of the Patents, Designs, and Trade Marks Act, 1883 (as amended by the Patents, Designs, and Trade Marks (Amendment) Act, 1885), relating to the registration of trade marks both as enacted in such Acts and as applied by any Order in Council made thereunder, shall be construed as applying to trade marks registrable under this Act.

Offences.

66. Falsification of entries in register.—If any person makes or causes to be made a false entry in the 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.

67. Penalty on falsely representing a trade mark as registered.—(1) Any person who represents a trade mark 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 a trade mark is registered, if he uses in connection with the trade mark the word "registered," or any words expressing or implying that registration has been obtained for the trade mark.

Royal Arms.

68. Unauthorised assumption of Royal Arms.—If any person, without the authority of His Majesty, uses in connexion with any trade, business, calling, or profession, the Royal Arms (or arms so closely resembling the same as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Royal Arms, or if any person without the authority of His Majesty or of a member of the Royal Family, uses in connexion with any trade, business, calling, or profession any device, emblem, or title in such manner as to be calculated to lead to the belief that he is employed by or supplies goods to His Majesty or such member of the Royal Family, he may, at the suit of any person who is authorised to use such arms or such device, emblem, or title, or is authorised by the Lord Chamberlain to take proceedings in that behalf, be restrained by injunction or interdict from continuing so to use the same: Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such arms, device, emblem, or title to continue to use such trade mark.

Courts.

69. General saving for jurisdiction of Courts.—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 trade marks; and with reference to any such proceedings in Scotland the term "the Court" shall mean the Court of Session; and with reference to any such proceedings in Ireland the term "the Court" shall mean the High Court of Justice in Ireland.

70. Isle of Man.—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 trade mark competent to those 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.

71. Jurisdiction of Lancashire Palatine Court.—The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks, the registration whereof is applied for in the Manchester Branch, have the like jurisdiction under this Act as His Majesty's High Court of Justice in England, and the expression "the Court" in this Act shall be construed and have effect accordingly:

Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases.

72. Offences in Scotland.—In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Repeal; Savings.

73. Repeal and saving for rules, &c.—The enactments described in the schedule to this Act are repealed to the extent mentioned in the third column, but this repeal shall not affect any rule, table of fees, or classification of goods made under any enactment so repealed, but every such rule, table of fees, or classification of goods shall continue in force as if made under this Act until superseded by rules, tables of fees, or classification under this Act.

74. Application of 46 & 47 Vict. c. 57, ss. 82—84.—The provisions of sections eighty-two to eighty-four of the Patents, Designs, and Trade Marks Act, 1883, as amended by any subsequent enactment, shall continue to apply with respect to the administration at the Patent Office of the Law relating to the registration of trade marks, and shall accordingly be construed as if this Act formed part of that Act.

SCHEDULE.

Enactments Repealed.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sections sixty-two to eighty-one, and, so far as they respectively relate to trade marks, sections eighty-five to ninety-nine, one hundred and one, one hundred and two, one hundred and five, one hundred and eight, and one hundred and eleven to one hundred and seventeen.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	Sections eight to twenty, and, so far as they respectively relate to trade marks, sections twenty-one to twenty-six.

TRADE MARKS ACT, 1919.

Part I.

Registration of certain Trade Marks not Registrable under Principal Act.

1. Division of register of trade marks into two parts.—(1) The register of trade marks (including the Manchester Register) kept under the Trade Marks Act, 1905 (hereinafter referred to as the principal Act), shall be divided into two parts to be called respectively Part A. and Part B.

(2) Part A. of the register shall comprise all trade marks entered in the register of trade marks at the commencement of this Act and all trade marks which after the commencement of this Act may be registered under the provisions of the principal Act.

(3) Part B. shall comprise all trade marks registered under this Part of this Act, and all trade marks entered on or removed thereto under this Act.

The marks which will be affected by these new facilities for registration will be principally of two classes: firstly, marks which while in fact distinctive do not include any of the essential particulars laid down by sec. 9 of the 1905 Act, and secondly, marks which bear some resemblance to marks already registered, but which may be allowed to pass by the more lenient exercise of the power of rejection which these provisions indicate. See notes on sec. 2 (2), *infra*.

The registration of these marks here will greatly facilitate their registration in many foreign countries, and this is understood to be one of the chief objects of the change. It will also enable their proprietors to bring what is essentially a passing off action without having the onus of proving the significance of their mark.

2. Registration of trade marks in Part B.—(1) Where any mark has for not less than two years been bonâ fide used in the United Kingdom upon or in connection with any goods (whether for sale in the United Kingdom or exportation abroad), for the purpose of indicating that they are the goods of the proprietor of the mark by virtue of manufacture, selection, certification, dealing with or offering for sale, the person claiming to be the proprietor of the mark may apply in writing to the registrar in the prescribed manner to have the mark entered as his registered trade mark in Part B. of the register in respect of such goods.

(2) The Registrar shall consider every such application for registration of a trade mark in Part B. of the register, and if it appears to him, after such search, if any, as he may deem necessary that the application is

inconsistent with the provisions of section eleven or section nineteen of the principal Act, or if he is not satisfied that the mark has been so used as aforesaid, or that it is capable of distinguishing the goods of the applicant, he may refuse the application or may accept it subject to conditions, amendments or modifications as to the goods or classes of goods in respect of which the mark is to be registered, or to such limitations, if any, as to mode or place of user or otherwise as he may think right to impose, and in any other case he shall accept the application.

(3) Every such application shall be accompanied by a statutory declaration verifying the user, including the date of first user, and such date shall be entered on the register.

(4) Any such refusal or conditional acceptance shall be subject to appeal to the court, and if the ground for refusal is insufficiency of evidence as to user, such refusal shall be without prejudice to any application for registration of the trade mark under the provisions of the principal Act.

(5) Every such application shall, if accepted, be advertised in accordance with the provisions of the principal Act.

(6) A mark may be registered in Part B. notwithstanding any registration in Part A. by the same proprietor of the same mark or any part or parts thereof.

Subsec. (1). The necessary conditions for registration are—

(1) That the mark has been used for at least two years in the United Kingdom.
(2) That this user has been for the purpose of indicating origin ; and probably
(3) that the mark is in fact capable of distinguishing the goods of the applicant from the goods of his competitors.

As to the first condition nothing is said about the two years being continuous or extending up to the period of registration and these conditions would not seem to be necessary unless the cessation of user has been sufficient to constitute abandonment. **64, 111.** The mark must have been used here in the sense of being physically on the goods (or their containers), but it is not necessary that its function of indicating the origin of the goods should have been exercised here. Thus where a foreign merchant had his mark placed on goods made here which were sent to him in Italy for sale, it was held that there had been user of the mark in this country sufficient to prevent registration by others. **67.**

User on goods imported and exhibited here, though intended for re-exportation, is sufficient, **41** ; but not user on goods merely opened in bond. **41.**

The second condition, in view of the definition of trade mark in sec. 1, is equivalent to saying that the user has been user as a trade mark. What amounts to such user has been frequently discussed in regard to the registration of marks as "Old Marks," registration under sec. 9 (5), and "non-user." See Introduction and cases collected in The Laws of England, sub tit. "Trade Marks," vol. 27, at pp. 692, 694, and 717. The older decisions on this point laid down very strict rules, including the rule that to constitute such user the mark must have been the only mark of origin on the goods, though this rule could hardly have been strictly applied, since, except in the case of very small articles, the label nearly always contains the name and address of the manufacturer. Recently a broader view has been taken and the C. A. has said that even where a word mark has been used together with the maker's name in the possessive case, *e.g.* "Smith's Regimental Cigarettes," such word, *i.e.* "Regimental," may have been used as a trade mark. **47.** The real criterion is whether the mark is what the public looks for as indicating the origin, and in many cases the best evidence on this point is afforded by

their method of asking for the goods.† Where a mark is used to indicate both origin and quality this is user as a trade mark. 5. Where a name indicates a particular form of an article, whether patented or not, it is not registrable. 107. See also 1919, sec. 6 (1).

The present section is not limited to marks consisting of letters and figures as in the case of "Old Marks" (see sec. 9 (5)), so that labels, etc., can be registered. The mark should have been used on the goods as they reached the public, not merely on packing cases. 74. The mark must have apparently been used for the two years exactly in the form proposed to be registered, as there are no words (as in the case of "Old Marks") permitting small alterations. Possibly registration might be permitted with the omission of details liable to variation which do not indicate origin, *e.g.* weights, dates, addresses, etc. The user may have been by the applicant or a predecessor. The registration may only be for the goods on which the mark has been used for two years. In the case of "Old Marks" this rule was very strictly applied, thus user on garden shears did not justify registration for sheep shears, though user on hatchets was held to cover axes. 48.

The third condition is curiously enough not set out in subsec. (1) as a condition, but from subsec. (2) it appears that if the Registrar is not satisfied that the mark is distinctive he may refuse registration. In order to satisfy him on this point it will probably be necessary in the case of word marks which do not come within sec. 9 (3) or (4) to produce evidence showing that the mark has become distinctive, and the inquiry will be conducted on the principles applicable to marks registered under the special powers given by sec. 9 (5), with this difference that, as is pointed out below, the discretion of the Registrar would probably be exercised in the applicant's favour rather than against him.

The question may, however, arise whether, after the Registrar has been so satisfied, and the mark is registered, an application could be made to take it off on the ground that it is not distinctive in view of the omission of any requirement on this point in subsec. (1). Of course this might be raised as a defence as showing that the use of the mark by the defendant was not liable to deceive, *vide* sec. 4.

Subsec. (2). These provisions differ considerably from those referring to Class A marks. An application in Class B *shall* be accepted except in certain circumstances when it *may* be refused, but for registration under A the mark *must* satisfy various criteria and even if it does so the Registrar has a discretion to refuse it (see Introduction, "Discretion of Registrar"). This distinction is made advisedly since the object of the section is to permit marks to be registered which could not survive the tests imposed on Class A marks. The decisions as to the onus on the applicant and his position being *in petitorio* must be used with caution in considering applications in this class.

Compliance with the conditions of sec. 11 means that the mark must not be fraudulent, or scandalous (see Introduction, "Marks Disentitled to Protection"), compliance with the provisions of sec. 19 would appear to raise all the questions of similarity to registered marks which have led to the rejection of so many applications. If this is strictly interpreted it may greatly diminish the number of marks admitted to the B class, but it must be remembered that the Registrar is no longer bound to reject a mark on this ground, though he may do so, and probably in many border-line cases where the office would have formerly rejected a doubtful mark the application will now be allowed to proceed, and if the owner of the conflicting mark does not object the new mark will be registered. Further, the fact that the office is no longer bound to make an exhaustive search will facilitate matters. The conditions and limitations which may be imposed are only as to class of goods or mode or place of user, no change can be made in the mark itself, nor can any disclaimer be required. See 1919, sec. 3.

The search is not compulsory. The search may of course be among marks in both classes, and a search in the case of Class A applications will include Class B marks.

Subsec. (3).—Any error in such declaration might afford a ground for rectification.

Subsec. (4).—Some difficulty may arise if more than one ground for refusal is given, *e.g.* if the Registrar says that the evidence as to user was insufficient, and also that the proposed mark resembled too closely a mark already registered. It may be that it would

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† But undoubtedly it will be found easier to establish such user where words have been used by themselves and the name and address of the maker in another part of the label.

be hopeless to appeal on the first point, but if the applicant does not do so, and makes an application in Class A, the decision on the second point would estop him. See 59.

Subsec. (5).—From this point onward the procedure would seem to be in accordance with the principal Act. An opponent can allege that the mark fails to comply with the conditions laid down in subsec. (1) or that sec. 11 or 19 prevents its registration.

3. Application of certain provisions of principal Act to Part B. trade marks.—The provisions of the principal Act, as amended by this Act, with the exception of those set out in the First Schedule to this Act, shall, subject to the provisions of this Part of this Act, apply in respect of trade marks to which this Part of this Act applies as if they were herein re-enacted and in terms made applicable to this Part of this Act.

By reason of the non-application of certain sections the proposed mark need not have any of the essential particulars required for marks in Class A, no requirements can be made as to disclaimers or association, and the mark if registered may be attacked even after seven years.

4. Effect of registration in Part B.—The registration of a person as the proprietor of a trade mark in Part B. of the register shall be primâ facie evidence that that person has the exclusive right to the use of that trade mark, but, in any action for infringement of a trade mark entered in Part B. of the register, no injunction, interdict or other relief shall be granted to the owner of the trade mark in respect of such registration, if the defendant establishes to the satisfaction of the Court that the user of which the plaintiff complains is not calculated to deceive or to lead to the belief that the goods the subject of such user were goods manufactured, selected, certified, dealt with or offered for sale by the proprietor of the trade mark.

This in effect gives the proprietor a *primâ facie* title to a common law trade mark.

Primâ facie would seem to imply that the plaintiff's claim to the monopoly of the use of the trade mark can be displaced, *i.e.* that objections to the mark can be raised in the defence without its being necessary to move to rectify the register. The practice under the 1883 Act, which contained similar words, was never definitely settled, there being decisions, *e.g.* **51,** that objections to the mark can be raised in the defence without its being necessary to move to rectify the register and also decisions to the contrary effect, *e.g.* **5*.**

The other line of defence in a passing off action, *i.e.* that the defendant's use of the mark was not calculated to deceive, can also be raised.

It should be noticed that the protection accorded to the defendant only applies to civil proceedings. It would seem doubtful whether on a prosecution under sections 4 or 5 of the Merchandise Marks Act, 1887, the defendant could challenge the title to the trade mark, or set up the defence that his user was not liable to deceive, though he could apply to expunge the mark.

5. Power to treat applications for registration in Part A. as applications for registration in Part B.—If any person applies for the registration of a trade mark under the principal Act in Part A. of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B. of the register under this Part of this Act and deal with the application accordingly.

Part II.

Provision for the Prevention of Abuses of Trade Marks.

6. Removal from register of word trade marks used as names of articles.—(1) Where in the case of an article or substance manufactured under any patent in force at or granted after the passing of this Act, a word trade mark registered under the principal Act or Part I. of this Act is the name or only practicable name of the article or substance so manufactured, all rights to the exclusive use of such trade mark, whether under the common law or by registration (and notwithstanding the provisions of section forty-one of the principal Act), shall cease upon the expiration or determination of the patent, and thereafter such word shall not be deemed a distinctive mark, and may be removed by the court from the register on the application of any person aggrieved.

(2) No word which is the only practicable name or description of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark, and any such word now or hereafter on the register may, notwithstanding section forty-one of the principal Act, be removed by the Court from the register on the application of any person aggrieved :

Provided that—

(*a*) the provisions of this subsection shall not apply where the mark is used to denote only the proprietor's brand or make of such substance, as distinguished from the substance as made by others, and in association with a suitable and practicable name open to the public use ; and

(*b*) in the case of marks registered before the passing of this Act, no application under this section for the removal of the mark from the register shall be entertained until after the expiration of four years from the passing of this Act.

(3) The power to remove a trade mark from the register conferred by this section shall be in addition to and not in derogation of any other powers of the court in respect of the removal of trade marks from the register.

(4) The provisions contained in Part III. of this Act authorising applications for the rectification of the register to be made in the first instance to the Registrar instead of to the Court shall apply to applications under this section.

It was probably an oversight that the 1905 Act did not except the names of patented

articles from the seven years' rule. If the mark was really the name of a patented article it was not protected at common law. **54.** See Laws of England, sub tit. "Trade Marks," vol. 27, at p. 605. This rule would probably not apply where only part of the article was subject to a patent, *e.g.* as in the case of a motor car, (see **95**), or where the article has merely been produced by a patented machine. See **69**.

It will probably be found that only a small number of marks are affected by these provisions and that these nearly all refer to articles used for medicine, though possibly a few dyes may be included.

The restriction to single chemical substances excludes such marks as Vasoline (a mixture of paraffines) from the operation of the section. *Cf.* **24.**

Except in the case of patented articles it will generally be found that there are several names for these medicines, etc., so that the mark cannot be classed as the only practicable name.

The meaning of the proviso is not very clear, but it is probably intended to protect the seller who first introduces the article from a claim that any mark he has put on it has become the name of the article and has ceased to be a trade mark.

Sec. 7 amends sec. 9 (5) of 1905 Act.

8. Appeals.—(1) All appeals from the decisions of the Registrar under section fourteen of the principal Act and under section thirty-three of the principal Act shall be made to the Court, and an appeal shall not lie from any such decision to the Board of Trade, and accordingly those sections shall have effect, subject to the modifications set forth in the Second Schedule to this Act :

Provided that nothing in this subsection shall affect any appeal which may be pending at the commencement of this Act.

(2) In any appeal from the decision of the Registrar to the Court under the principal Act or this Act the Court shall have and exercise the same discretionary powers as under the principal Act or this Act are conferred upon the Registrar.

Possibly subsec. (2) may lead to the Courts acting more freely in regard to doubtful decisions. See *Introduction*, "*Discretion of the Registrar.*"

9. Rectification of register.—(1) Any application for the rectification of the register or the removal of any trade mark from the register in respect of any goods which, under section thirty-five or section thirty-seven of the principal Act or under Part II. of this Act, is to be made to the Court, may, at the option of the applicant, be made in the first instance to the Registrar :

Provided that no such application shall be made otherwise than to the Court where an action concerning the trade mark in question is pending.

(2) The Registrar may, at any stage of the proceedings, refer any such application to the Court or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

(3) In any proceedings for the rectification of the register under this Act or under section thirty-five of the principal Act as amended by this section the Court or the Registrar shall, in addition to the powers conferred

by that section as so amended have power to direct a trade mark entered in Part A. of the register to be removed to Part B. of the register.

10. Costs.—In all the proceedings before the Registrar under the principal Act or this Act the Registrar shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of Court.

Sec. 11 enacts sec. 33 of 1905 Act.

12. Minor amendments of principal Act.—The amendments specified in the second column of the Second Schedule to this Act, which relate to minor details, shall be made in the provisions of the principal Act specified in the first column of that Schedule.

13. Short title, construction, and commencement.—(1) This Act may be cited as the Trade Marks Act, 1919, and the Trade Marks Acts, 1905 and 1914, and so much of the Patents and Designs Acts, 1907 to 1919, as relates to trade marks, and this Act may be cited together as the Trade Marks Acts, 1905 to 1919.

(2) This Act shall be construed as one with the principal Act and shall come into operation on the first day of April nineteen hundred and twenty.

SCHEDULES.

FIRST SCHEDULE.

Provisions of Principal Act not Applied.

No. of Section.	Subject-matter.
1 – – – – –	Short title.
2 – – – – –	Commencement of Act.
6 – – – – –	Incorporation of existing register.
9 – – – – –	Registrable trade marks.
12 – – – – –	Application for registration.
14 (9) – – – –	Modification of trade mark on appeals.
15 – – – – –	Disclaimers.
24 – – – – –	Associated trade marks.
25 – – – – –	Combined trade marks.
27 – – – – –	Assignment and user of associated trade marks.
31 – – – – –	Status of unrenewed trade marks.
36 – – – – –	Trade marks registered under previous Acts.
39 (except proviso) – –	Rights of proprietor of trade mark.
41 down to the words "against the provisions "of section eleven of "this Act."	Registration to be conclusive after seven years.
42 – – – – –	Unregistered trade mark.
62 – – – – –	Standardization, etc., trade marks.
73 – – – – –	Repeal and saving for rules, etc.

SECOND SCHEDULE.

This contains the amendments to the sections 12, 13, 14, 16, 21, 22, 23, 24, 34, 41, 43, 62 and 64 of the 1905 Act as there shown.

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