THE

LAW AND PRACTICE

OF

LETTERS PATENT FOR INVENTIONS

WITH THE

PATENTS ACTS AND RULES ANNOTATED,

AND THE

INTERNATIONAL CONVENTION, A FULL COLLECTION OF STATUTES, FORMS AND PRECEDENTS, AND AN OUTLINE OF FOREIGN AND COLONIAL PATENT LAWS, &c.

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PREFACE.

SINCE the publication in 1846 of the well-known work of Hindmarch on the Law of Patents, no comprehensive treatise upon the law and practice of Patents for Inventions has appeared, although there have been numerous books dealing with the subject in a more limited manner.

Hindmarch's work was written before the Patent Law Amendment Act of 1852, which made many important changes in the law. This Act has since given way to the Patents Act, 1883, and the practice as regards applications for and grants of patents is now, in almost every respect, different from the practice at the time when Hindmarch wrote.

The simplification of the procedure and the great reduction in the Government fees, have caused an enormous increase in the number of patents annually obtained. The annual number of grants is now about 10,000, whereas before 1852 it was about 450. This great increase has correspondingly added to the importance and volume of patent law.

A large Government office, the Patent Office, is now devoted exclusively to the official business connected with patents, and a body of professional patent agents may be said to have come into existence, as the separate practice of this profession was before 1852 confined to a very few persons.

It seems, therefore, that a comprehensive treatise is

called for, and it is in the hope of supplying this deficiency that I have prepared the present work.

It is divided into three parts.

PART I. treats generally of Patent Law and Practice. It commences with an account of the old common law prerogative of the Crown, and after considering the effect of the Statute of Monopolies, passed in the reign of James I., goes on to treat of the subject-matter of patentable inventions.

The growth and functions of the existing Patent Office are then described at length; and an outline of the procedure necessary to obtain a patent is given for the convenience of those who have no previous acquaintance with this branch of the law, and as a key to subsequent chapters. The application, the specification, the amendment thereof, and oppositions to the grant, are next discussed in detail; after which assignments and licences and the Register of Patents are dealt with.

The Infringement of patents and the Action of Infringement are then treated at considerable length, and every effort has been made to present these subjects in a practical, convenient, and, as far as possible, exhaustive form. The Action to Restrain Threats of Legal Proceedings, the Revocation, the Extension, and the Confirmation of patent grants, with chapters on the International and Colonial Arrangements, and on the General Features of Foreign and Colonial Patents, complete this part of the work.

In PART II. the Patents, Designs, and Trade Marks Acts, 1883—1888, are given, so far as they relate to patents, with full notes and cross references to other parts of the work. The principal Act of 1883, and the amending Acts of 1885, 1886, and 1888, have been consolidated into one text. The type is so arranged that the repealed portions of the Act of 1883, and the additions or alterations effected

by the amending Acts, can be seen at a glance, and in every case the amending Act and section are quoted in the margin. The complete text of the consolidated Acts, unencumbered by notes, is given in the Appendix, and the amending Acts also are there printed separately.

The form of patent grant in the Schedule to the Act of 1883 has been fully annotated, and I hope that the notes will be found of considerable practical importance as well as of intrinsic interest.

In connection with the Schedule of Fees an account is given of the payments for patents before 1852, showing the complexity of the law at that time, by which three separate patents were required for England, Scotland, and Ireland, and the excessive expenses thrown upon patentees. Under the Patent Law Amendment Act the cost of obtaining a patent was greatly lessened, and there was a further reduction in 1883. Patentees still, however, suffer an anomalous and heavy taxation in the form of renewal fees, which begin to be payable before the end of the fourth year.

The *Patents Rules, 1890, with notes and cross references*, where necessary, follow; then the Law Officers' Rules, the Privy Council Rules relating to Extensions and Confirmations, and the International Convention, with the Declaration of the Accession of Great Britain, the Acceptance of the Accession, and the Order in Council applying the provisions of the Patents Acts which relate to International and Colonial Arrangements made by the Sovereign.

PART III. contains an Appendix of Statutes, Forms, Foreign and Colonial Patent Laws, &c.

In the Appendix of Statutes all the Acts relating to Patents will be found, the repealed statutes being in small type. Any work on patent law, as a whole, without the text of the repealed Acts of 1835 and 1852 would be

incomplete, as these statutes must be constantly referred to, and the present effect of many cases decided under them can only be understood by a reference to the text. The remaining repealed statutes, occupying a few pages only, are sometimes of considerable interest in themselves, and are occasionally referred to in the body of the work.

The Appendix of Forms has been made as complete as possible. It contains the forms under the Patents Rules, 1890, and a large number of precedents in litigation and other matters connected with patents. Many of these have been selected from forms actually used in important cases in recent years.

The Appendix of Foreign and Colonial Patent Laws does not pretend to be more than an abstract of the principal provisions of those States where patent privileges may be obtained. The great increase in the number of applications by British inventors for patents in foreign countries renders some account of subject-matter, duration, payment of fees, &c., in connection with foreign grants, a matter of interest.

The text contains all the patent cases which are now of any importance. The dates of cases are given in the references on each page and in the Table of Cases, where the principal contemporary references are also cited.

Much care has been bestowed on the Index, and every effort has been made to render it an efficient and convenient guide to the contents of the volume.

Although great attention has been paid to all the minute details of patent practice, which, I believe, are more completely treated here than in any other work, it has been my constant aim to present something more than a mere compilation, and to deal at convenient points with the history of this peculiarly interesting branch of the law, and to describe the difficulties which had to be surmounted, and the object of many of the statutory provisions. The

work is so arranged that confusion can nowhere arise as to what is obsolete and what existing law. I hope that the contents of this volume will thereby be rendered of more interest to the very large number of persons whose professional or official life is largely devoted to the consideration of patents for inventions.

Throughout the whole progress of this work I have been indebted to my friend, Mr. A. Wood Renton, Barrister-at-Law, for most able, constant, and untiring assistance; and I wish to express here my great obligations to him.

By the courtesy of the Comptroller-General of Patents, Mr. H. Reader Lack, many opportunities have been afforded me of completing the information on the details of the practice in the Patent Office. In so doing, I have met with every assistance from the officials connected with that department of the Board of Trade.

Mr. G. P. Wheeler, Barrister-at-Law, of the Judicial Department of the Privy Council, has revised the proofs of the chapters on Extension and Confirmation, and I have also to thank him for several forms which appear in the Appendix.

Mr. John Imray, M.A., and Mr. Oliver Imray, have read the whole of the proofs, and I am obliged to them for many practical observations and useful suggestions.

Mr. E. W. Hulme, of the Patent Office Library, has provided numerous references and footnotes.

L. E.

1, Garden Court, Temple,
May, 1890.

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Part I.

PATENT LAW AND PRACTICE.

CHAPTER I.

INTRODUCTION.

Royal grants.

THE Sovereign, as the fountain of honour, office, and privilege, the arbiter of trade, and the chief guardian of the common weal, has from time immemorial exercised this prerogative of the Crown in making grants to subjects. Such grants are in general made by *letters patent* (*litteræ patentes*), that is, according to Blackstone, "open letters; so called because they are not sealed up, but exposed to open view with the Great Seal pendent (*a*) at the bottom; and are usually addressed by the Sovereign to all the subjects of the realm." Letters patent commence with the formula, "VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith: *To all to whom these presents shall come, greeting*," and then, after such recitals as may be necessary, proceed to grant the privilege which is conferred, "of Our *especial grace*, certain knowledge, and *mere motion*."

Examples of royal grants by letters patent.

Among grants which are made by letters patent, we may cite as examples of titles of honour, peerages and baronetcies; of appointments to offices, those of many of the ministers of the Crown and of the judges of the Superior Courts; of special privileges, charters of incorporation to bodies of persons (*b*); and, vastly more numerous for many years past than all other grants by letters patent taken together, letters patent for the monopoly of "making, using, exercising, and vending" (*c*) new inventions, to the true and first inventors thereof (*d*). It is this last form of royal grant which it is the object of this work to discuss.

(*a*) Patents for inventions are now sealed with the seal of the Patent Office, which is to have the same effect as if the Great Seal of the United Kingdom were appended: Act 1883, sect. 12. Many letters patent for other grants are now sealed with the Wafer Great Seal. See Crown Office Act, 1877, sect. 5, and the orders made pursuant thereto, London Gazettes of March 5th, and August 13th, 1878.

(*b*) Charters of incorporation are less freely granted than formerly, because of the Companies Acts and other statutes, which provide other means for obtaining incorporation.

(*c*) See the words of the patent, p. 531.

(*d*) The following is a list of some of

Procedure to obtain patents for inventions has diverged.

In consequence of the very numerous grants of patents for inventions, the word "patent" has, in common parlance, come to suggest a patent for an invention only, and it is in this sense that we shall generally use it hereafter (*e*). Patents for inventions have been dealt with by numerous statutes, and the procedure to obtain them has diverged into a channel of its own. With the exception of patents for inventions, the royal grants still made by letters patent pass through a series of formal stages before they receive the Great Seal (*f*). These stages are of very great antiquity, and, though considerably simplified in recent years, are still numerous and technical. The procedure is a simplified form of that for patents of invention before 1852 (*g*).

Constituents of existing law of patents.

In order to understand completely the present position of patent privileges for inventions, it is necessary to consider the limits of the ancient common law prerogative of the crown with regard to monopolies, under which all patents for inventions are still granted, and then to trace the effect of subsequent statutory enactments. This ancient common law prerogative, as effected in 1624 by the Statute of Monopolies, and more recently by the Patents Act of 1883, and the amending Acts of 1885, 1886 and 1888, together with the rules of practice made thereunder, and the very numerous decisions of Courts of Law upon the construction of these statutes, especially of the Statute of Monopolies, make up the present body of patent law and practice. We propose, in

Plan of next three chapters.

the next chapter, to give an account of patents for monopolies before the Statute of Monopolies, and in the succeeding chapter to deal with the statute itself. After this we shall be in a position to consider the subject-matter of valid letters patent for inventions.

the principal grants by letters patent at the present time. Many of them are under the Wafer Great Seal, as provided by the Orders in Council under the Crown Office Act, 1877, see note (*a*), *sup.* Offices in the Herald's College, knights bachelor, the Lord Lieutenant and the Custos Rotulorum of counties, justices of the High Court, the Queen's counsel, the Crown livings, the Attorney and Solicitor-Generals, annuities to judges of the High Court, Constable of the Tower, Chancellor of the Exchequer, Treasury Commission, Admiralty Commission, charters of incorporation to universities or other learned bodies, and to trading companies, peerages, baronetcies, grants of separate Courts of Quarter Sessions, Commander-in-chief, Queen's printer, Master of the Horse, Keeper of Privy Seal, Postmaster-General, royal pardons. All these patents are enrolled on the Patent Rolls, which date back for a very long period. They may be seen at the Record Office, or in the case of very recent patents, at the Chancery Enrolment Office.

(*e*) See also Patents Act, 1883, s. 46.

(*f*) Or the Wafer Great Seal.

(*g*) For which see pp. 49—51.

CHAPTER II.

MONOPOLIES AT COMMON LAW.

SECT. 1. EARLY GRANTS.
SECT. 2. LIMITATIONS TO THE PREROGATIVE AT COMMON LAW.
SECT. 3. ATTEMPTS TO EXTEND PREROGATIVE.
SECT. 4. PROTESTS AGAINST MONOPOLIES.

SECT. 1.—EARLY GRANTS.

Ancient grants.

IT is difficult or impossible to determine with certainty when monopolies were first granted to inventors, although the exercise of the prerogative in this way is undoubtedly very ancient.

Thus, in a case decided in the reign of Edward III. (*a*), it is said that arts and sciences which are for the public good are greatly favoured in law, and the King, as chief guardian of the common weal, has power and authority by his prerogative to grant many privileges for the sake of the public good, although *primâ facie* they appear to be clearly against common right.

It is also stated that King Edward III., on the representation of some alchemists, granted a commission to two friars and two aldermen to inquire whether a philosopher's stone might be made, and on their reporting that the project was feasible, granted to the two aldermen a patent of privilege, that they and their assignees should have the sole making of the philosopher's stone (*b*).

The earliest form of these grants of privileges seems to have been that of exclusively conducting new trades or dealing in objects of commerce hitherto unknown, and the prerogative was apparently used in some cases as a means of raising money (*c*).

(*a*) Year Book, Part iv., 40 Edw. III. fol. 17, 18; Hindmarch, p. 4.

(*b*) Moor, p. 675; *Darcy* v. *Allin*.

(*c*) Professor S. R. Gardiner (History of England, from 1603—1642, vol. iv., pp. 1 *et seq.*), holds that many of the monopolies and grants which were complained of, under James I., were quite defensible in principle, and that the chief public grievances arose from the abuse of their privileges by the patentees, and the difficulty or impossibility of obtaining redress.

Sect. 2.—Limitations to the Prerogative at Common Law.

To this royal prerogative there came to be, however, certain well-defined limits—

Limits to prerogative.

(1) The Sovereign could not grant the sole right to sell articles in common use. Thus, letters patent granting to one John Pechey the sole importation of sweet wines into London were, at a Parliament held 50 Edw. III., adjudged to be void (*d*).

(2) Again, a grant of the sole right to exercise a known occupation was illegal. This was decided as to the manufacture and importation of playing cards in *Darcy* v. *Allin* (*e*).

(3) Further, it was necessary that the grantee should be at least the *introducer* of the invention within the realm.

(4) The term must be for some limited period, such as might be sufficient for the instruction of others.

(5) The subject-matter must be such as, in the result, led to a new trade or manufacture.

(6) The subject-matter must also possess the incidents of utility and novelty, and must not be prejudicial or inconvenient (*f*).

Darcy v. *Allin.*

The conditions of the validity of a patent before the Statute of Monopolies cannot be better stated than in the words of the report of *Darcy* v. *Allin* (*g*): "Where any man, by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm, in such cases the King may grant to him a monopoly patent, for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not."

Cloth-workers of Ipswich Case.

In *The Cloth-workers of Ipswich Case* (*h*), it was said:—"If a man hath brought in a new *invention* and a new *trade* within the kingdom in peril of his life, and consumption of his estate or stock, or if a man hath made a new discovery of anything, in such cases *the king, of his grace and favour*, in recompense of his costs and travail, *may* grant by charter

(*d*) 3 Inst., 181; Noy, 173; 11 Co. 84; H. of Com. Jour. 1614, i. 470; 1 Web. P. C. 4.

(*e*) An. 44 Eliz. 11; 11 Co. R. 84; Noy, 178.

(*f*) 1 Web. P. C. 7, n.

(*g*) A.D. 1602, Noy, R. 182; 1 Web. P. C. 6.

(*h*) A.D. 1615, Godbolt's R. 252.

unto him that he only shall use such a trade or traffic *for a certain time*, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it, but when the patent is expired, the King cannot make a new grant thereof; for when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it."

Sect. 3.—Attempts to extend Prerogative.

The royal prerogative, which was afterwards defined in *Darcy* v. *Allin*, was, however, frequently extended beyond the limits therein laid down, and, under the pretence of providing for the better government of trade, the Crown sanctioned the most oppressive monopolies, with a view to reward favourites, or to raise money. The position of matters in the reign of Elizabeth is thus described by Hume (*h*):

Hume on monopolies under Elizabeth.

"It is astonishing to consider the number and importance of those commodities which were thus assigned over to patentees. Currants, salt, iron, powder, cards, calf-skin, pouldavies, ox shin bones, train oil, lists of cloth, potashes, aniseeds, vinegar, sea coals, steel, aqua vitæ, brushes, pots, bottles, saltpetre, lead, accidences, oil, calamme stone, oil of blubber, glasses, paper, starch, tin, sulphur, new drapery, dried pilchards, transportation of iron ordnance, of beer, of horn, of leather; importation of Spanish wool, of Irish yarn. These are but a part of the commodities which had been appropriated to monopolists. When this list was read in the House, a member cried, 'Is not bread in the number?' 'Bread,' said every one with astonishment. 'Yes; I assure you,' replied he, 'if affairs go on at this rate, we shall have bread reduced to a monopoly before next Parliament.' These monopolists were so exorbitant in their demands that in some places they raised the price of salt from sixteen pence a bushel to fourteen or fifteen shillings. Such high profits naturally begat intruders upon their commerce, and in order to secure themselves against encroachments, the patentees were armed with high and arbitrary powers by the Council, by which they were enabled to oppress the people at pleasure, and to exact money from such as they thought proper to accuse of interfering with their patent. The patentees of saltpetre, having the power of entering every house and of committing what havoc they pleased in stables, cellars, or wheresoever they

Salt monopolies.

Powers of patentees.

(*h*) 5 Hume, 386; cf. also 4 Parl. Hist. 452.

suspected saltpetre might be gathered, commonly extorted money from those who desired to free themselves from this damage or trouble, and while all domestic intercourse was thus restrained, lest any scope should remain for industry, almost every species of foreign commerce was confined to exclusive companies, who bought and sold at any price they themselves thought proper to offer or exact."

Sect. 4.—Protests against Monopolies.

These grievances aroused the attention of the House of Commons, and a petition was presented to the Queen complaining of the patents, but she still persisted in defending the monopolists.

Bill for abolition of monopolies.

Accordingly, a Bill was introduced into the Lower House, abolishing all the obnoxious grants, and "as the former application had been unsuccessful, a law was insisted on as the only certain expedient for correcting these abuses. The courtiers, on the other hand, maintained that this matter regarded the prerogative, and that the Commons could never hope for success if they did not make application in the most humble and respectful manner to the Queen's goodness and beneficence. . . . It was asserted that the Queen inherited both an enlarging and a restraining power: by her prerogative she might restrain what was otherwise at liberty: that the royal prerogative was not to be canvassed, nor disputed, nor examined, and did not even admit of any limitation: that absolute princes, such as the Sovereigns of England, were a species of Divinity: that it was in vain to attempt tying the Queen's hands by laws or statutes, since by means of her dispensing power she could loosen herself at pleasure; and that even if a clause should be annexed to a statute excluding her dispensing power she could first dispense with that clause; and then with the statute. After all this discourse, more worthy of a Turkish divan than of an English House of Commons . . . . the Queen, who perceived how odious monopolies had become, sent for the Speaker,

Patents cancelled.

and advised him to acquaint the House that she would immediately cancel the most grievous of these patents" (*i*). An address of thanks was at once voted, and was delivered to her Majesty by the Speaker, attended by about 180 members, on November 30th, 1601. The following extract from the Queen's answer shows how clearly she understood the limits to her prerogative: "I never put

(*i*) Hume, *ubi supra*. See Cecil's speech, Parl. Hist. 1601, i. 934, and Lord John Russell's Hist. Eng. Govt., p. 477.

my pen to any grant, but upon pretence and semblance made unto me, that it was both good and beneficial to the subjects in general, though a private profit to some of my ancient servants who had deserved well: but the contrary being found by experience, I am exceedingly beholden to such subjects as would move the same at first. . . . . That the grants should be grievous to the people, and oppressions, &c., be privileged under colour of our patents, our kingly dignity shall not suffer it: and when I heard of it I could give no rest to the thoughts till I had reformed it" (*k*). Queen Elizabeth's answer.

It would appear, however (*l*), that the Queen did not revoke all of the monopolies complained against, and a list of them, dated May, 1603, seems to imply there were still some in existence (*m*).

Matters did not improve on the accession of James I. The manufacture of alum had been introduced into England from abroad, and exercised without much success till about 1600, when Sir Thomas Chaloner discovered a mine in Yorkshire, and the art was brought to perfection by Sir John Bourchier. The importation of alum was prohibited by proclamation; the King took the whole trade into his own hands, and made it the subject of letters patent (1608) (*n*). Accession of James I. Alum patents.

Other monopolies were granted, and Parliament again protested against the abuse of the royal prerogative. In 1610, the King published a book (*o*), in which he declared that monopolies were things against the laws of the realm, and (as if to fortify himself against cupidity) expressly commanded that no suitor should presume to move him to any grant thereof. Book published by James I.

The grants, however, continued. The case of Mompesson and Mitchell is the most flagrant instance. According to Rapin, a patent was granted to Sir Giles Mompesson and Sir Francis Mitchell for the sole making and selling of gold and silver lace. The patentees grossly abused their privilege, "making sophisticated lace of copper and base materials, and procuring others (who made good lace) to be fined and imprisoned for infringing their patent. Great complaints were made to Parliament; and in consequence Mitchell was imprisoned, but Mompesson escaped, and a proclamation was issued, offering a reward for his apprehension. The Gold and silver lace patents.

(*k*) Cobbet's Parl. Hist. of Eng., i. 923.

(*l*) Rymer, xvi. 540; Carte, iii. 702.

(*m*) Lodge, iii. 159; Hallam, Const. Hist., i. 357, n.

(*n*) Parl. Report, &c. 1829, Appendix, 167. See Statute of Monopolies, sect. 11, *infra*, p. 634.

(*o*) 11 Co. Rep. 88 C. Coke says, that the judgment given in *Darcy* v. *Allin* was the principal motive of the publishing of the King's book.

King informed the Parliament that he was ignorant of the abuse of his patent and would revoke it. The Lords confiscated the estate of Mompesson, who had escaped, and degraded him of his knighthood. Mitchell was also degraded, fined 1,000*l.*, carried through the streets of London on a horse, with his face to the tail, and imprisoned for life. The patent for gold and silver lace and some others were revoked by royal proclamation" (*p*).

(*p*) Parliamentary Report, 1829, p. 167.

CHAPTER III.

THE STATUTE OF MONOPOLIES.

In 1624 (*a*) advantage was taken of the good feeling then existing between James and his Parliament (*b*), and of the declaration to which he had committed himself in 1610 (*c*), to secure the enactment of the Statute of Monopolies (21 Jac. I. c. 3) (*d*).

Statute of Monopolies, sect. 1.

This famous statute deserves somewhat minute consideration. After reciting the King's gracious declaration against grants of monopolies in 1610, and that "yet, nevertheless, upon misinformations and untrue pretences of public good, many such grants have been unduly obtained and unlawfully put in execution," the Act declares and enacts, that "all monopolies and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give licence or toleration to do, use or exercise anything against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, licence or toleration to be had or made, or to agree or compound with any others for any penalty or forfeiture limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty or sum of money that is or shall be due by any statute before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, further-

Declaration against monopolies of every description.

(*a*) Previous to 33 Geo. III. c. 13, every Act was considered as passed upon and relates back to the first day of the Session, unless otherwise provided for by the Act. Hence the Statute of Monopolies is said to have passed in 1623, although really passed in 1624.

(*b*) Web. Lett. Pat., p. 7.

(*c*) Coke, 3 Inst. 182.

(*d*) See Appendix, pp. 628—635, where the whole statute is given. The repealed sections are printed in smaller type.

ing, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution."

Coke's definition of monopoly.

The monopolies against which this Act was directed are those defined by Lord Coke as being against the common law and the commonwealth, *i.e.*, unlawful monopolies. The following is Coke's definition (*e*): "A monopoly is an institution or allowance by the king, by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of anything whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade."

Darcy v. *Allin.*

To this may be added an extract from the judgment of the Court in *Darcy* v. *Allin* (*f*): "There are three inseparable incidents to every monopoly against the commonwealth; that the price of the same commodity will be raised, for he who has the sole selling of any commodity may and will make the price as he pleases; that after the monopoly granted the commodity is not so good and merchantable as it was before, for, the patentee having the sole trade, regards only his private benefit and not the commonwealth; that it tends to the impoverishment of divers artificers and others, who, before, by the labour of their hands in their art or trade, had maintained themselves and their families, who now will of necessity be restrained to live in idleness and beggary."

In prohibiting all such grants of monopolies, the statute was merely declaratory of the common law, already clearly established by the decisions in *Pechey's case* (*g*), in *Bircot's case* (*h*),

Sect. 3.

and in *Darcy* v. *Allin* (*i*). Sect. 3 enacted that "all persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled and incapable to have (*i.e.*, to take) (*k*), exercise, or put in use any monopoly, or any such commission, grant, licence, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty, grounded or pretended to be grounded upon them or any of them."

(*e*) 3 Inst. 181, c. 85.
(*f*) 11 Co. R. 84; Web. P. C. at p. 3.
(*g*) 50 Edw. III.; 3 Inst. 181.
(*h*) 15 Eliz.; 3 Inst. 184.
(*i*) Co. R. 84.
(*k*) Coke, 3 Inst. 183.

Sect. 2. Validity of grants to be tried at common law.

The Statute of Monopolies further provided that the force and validity of disputed grants should be examined and determined according to the common law, in the Courts of common law, and not at the Council Table, Star Chamber, Chancery, Exchequer Chamber, or any other Court of like nature. The necessity for this provision is well explained by Lord Coke: "Such boldness," he observes, "the monopolists took, that often at the Council Table, Star Chamber, Chancery, and Exchequer Chamber, petitions, informations, and bills were preferred, pretending a contempt for not obeying the commandments and clauses of the said grant of monopolies, and of the proclamation concerning the same" (*l*). The Court of Star Chamber also had considered all infringements of patents and grants of the Crown as contempt of royal authority, and on that principle had supported any patent the Crown thought fit to grant (*m*).

Having laid down a general prohibition of monopolies, the statute proceeds (sects. 5—14) to except certain grants from its operation. As Lord Coke has pointed out (*n*), the word "sole" is applied in sect. 1 to five separate things, "whereof four are special, and the fifth, 'sole using,' is so general that no monopoly can be raised which will be beyond the reach of the statute," and yet for more caution the words "or of any other monopolies" are added. The words also "of anything" in the same section are of so large an extent as to necessitate the provisoes contained in the subsequent sections.

Sect. 6. Proviso in favour of inventors.

Letters patent for inventions depend upon the provisions of sect. 6 (*o*), which expressly enacts that no declaration contained in the statute shall extend "to any letters patent and grants of privilege, for the term of fourteen years or under, thereafter to be made, of the sole working or making of any manner of new manufactures within the realm, to the true and first inventor or inventors, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or to the hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patent or grants of such privileges thereafter to be made, but that the same shall be of

(*l*) 3 Inst. 182, 183.
(*m*) Web. Letters Patent, p. 42, n. (*y*).
(*n*) 3 Inst. 187.
(*o*) Sect. 5 relates to patents granted for periods not exceeding twenty-one years, and in force at the time of the statutes being passed. With these exceptions, the words of sects. 5 and 6 are the same. See Coke, 3 Inst. 181.

such force as they should be if that Act had never been made, and no other."

The basis of patent right.

It is upon the wording of this proviso and the great number of decisions upon its meaning, that patent right in inventions now mainly rests. We shall deal more fully with the interpretation of this proviso in the next chapter. For the present, we may observe that it appears from the language of this section that a valid grant of letters patent must possess seven properties (*o*) :—

(1) It must be for a term of fourteen years or under;
(2) It must be granted to the true and first inventor;
(3) It must be of such manufactures "which any other, at the time of making such letters patent, did not use; for, albeit, it were newly invented, yet if any other did use it before the making of the letters patent, or grant of the privilege, it is declared and enacted to be void by this Act" (*p*), *i.e.*, there must be novelty;
(4) The privilege must not be contrary to law;
(5) It must not be mischievous to the State, by raising the prices of commodities at home. "In every such new manufacture that deserves a privilege, there must be *urgens necessitas et evidens utilitas*" (*q*);
(6) The privilege must not be to the hurt of trade;
(7) It must not be generally inconvenient.

"If any of these seven qualities fail, the privilege is declared and enacted to be void by this Act: and yet this Act, if they have all these properties, set them in no better case than they were before."

Lord Coke on policy of patent privileges.

"The cause," Lord Coke continues (*r*), "wherefore the privileges of new manufactures, either before this Act granted, or which after this Act should be granted, having these seven properties, were declared to be good, was, for that the reason wherefore such a privilege is good in law is, because the inventor bringeth to and for the commonwealth a new manufacture, by his invention, costs, and charges, and therefore it is reasonable that he should have a privilege for his reward (and the encouragement of others in the like) for a convenient time: but it was thought that the times limited by this Act were too long for the private, before the commonwealth should be partaker thereof, and such as served such privileged

(*o*) The interpretation given to these conditions by subsequent decisions will be considered more fully under the next chapter.

(*p*) Coke, *ubi supra*.
(*q*) *Ibid.*
(*r*) *Ibid.* 184.

persons by the space of seven years, in making or working of the new manufacture (which is the time limited by law of apprenticehood), must be apprentices or servants still, during the residue of the privilege, by means whereof such numbers of men would not apply themselves thereunto as should be requisite for the commonwealth after the privilege ended. And this was the true cause whereof both for the time passed and the time to come, they were left of such force as they were before the making of this Act."

Lord Coke's objection to the term of fourteen years as too long rests substantially on the grounds that those who have been apprenticed to learn the trade must continue apprenticed till the end of the term, and that consequently a sufficient number of persons would not devote themselves to the manufacture to supply the wants of the public at the end of the term.

Lord Coke's objection to term of fourteen years.

The terms of the prohibition in the declaratory part of the Statute of Monopolies were so wide that it was deemed necessary to except from their scope various grants and privileges which were not intended to be annulled. This was done by sections 7—14 (*s*).

Statute of Monopolies, sects. 7—14.

Section 7 related to all grants, privileges, or authority made or confirmed by Acts of Parliament, so long as such Acts should continue in force.

Section 8 excepted all warrants under Privy Seal made by his Majesty or his successors to the justices of the Courts of law, or justices of the peace, &c., giving power to hear and determine offences against any penal statute.

Judges.

Section 9 saved the charters of the City of London, and other boroughs and corporate towns, and of corporations of any art, trade or mystery, and of any company of merchants erected for the maintenance of any trade.

Corporate privileges.

Section 10 saved letters patent concerning printing, digging for and making saltpetre or gunpowder; and casting or making of ordnance, or shot for ordnance; and also letters patent for offices.

Saltpetre, &c.

Section 11 saved letters patent for digging and making alum, and for alum mines.

Alum.

Section 12 saved all privileges heretofore enjoyed by the boastmen of the town of Newcastle-upon-Tyne for selling, carrying,

Newcastle-on-Tyne, &c.

(*s*) See *infra*, pp. 633—635.

and shipping any pit coals out of the river Tyne. It also saved commissions for the licensing of taverns.

Mansell's glass patent.

Section 13 excepted letters patent for making of glass, granted to Admiral Sir Robert Mansell, dated 22nd May, in the 21 Jas. I. (*u*); and other letters patent granted to Jas. Maxwell, Esq., concerning the transportation of calve skins, dated 12th June, in the 13th Jas. I.

Baker's smalt patent.

Lord Dudley's patent.

Section 14 saved letters patent, granted to Abraham Baker, concerning the making of smalt, dated 16th Feb., 16 Jas. I. (*x*); also letters patent granted to Edward Lord Dudley, concerning the smelting of iron ore, and making the same into cast works or bars, with sea coals, or pit coals, dated 22nd Feb., 19 Jas. I. (*y*).

(*u*) Mansell's patent is printed in full in 1 Web. P. C. at p. 17. See observations upon, and proceeding in connection with, this patent in 1 Web. P. C. 27 n. and 32 n. (*q*).

(*x*) See this patent printed in full, and observations thereon, in 1 Web. P. C., p. 12, and p. 32 n. (*r*).

(*y*) 1 Web. P. C. 14, and p. 33 n. (*r*).

CHAPTER IV.

THE SUBJECT-MATTER OF LETTERS PATENT.

SECT. 1. GENERAL.
SECT. 2. INTERPRETATION OF "ANY MANNER OF MANUFACTURE."
(1.) *Process or Product.*
(2.) *Processes.*
(3.) *Principles and Discoveries.*
(4.) *Amount of Invention.*
(5.) *Combinations in General.*
(6.) *Applications and Combinations of Old Materials, &c.*
(7.) *Additions.*
SECT. 3. NOVELTY.
(1.) *General.*
(2.) *Prior Publication.*
(3.) *Prior User.*
SECT. 4. UTILITY, &c.

SECT. 1.—GENERAL.

Sources of this branch of the law.

As we have explained in the last two chapters the sources of this branch of patent law are the prerogative, enjoyed and exercised by the Crown at least since the reign of Edward III. (*a*) —of rewarding and encouraging inventors by the grant of limited monopolies in their inventions, and the Statute of Monopolies (21 Jac. I. c. 3, s. 6 (*b*)), by which that prerogative was defined and restricted, but not created (*c*), and the numerous judicial decisions upon the construction of that statute.

(*a*) Cp. Year Book, Part IV.; 40 Edw. 3, fols. 17, 18; Moore, p. 675.

(*b*) Cp. the statute itself in the Appendix and Chapter III.

(*c*) The Patents Act, 1883, does not extend the subject-matter of letters patent: cp. sect. 46.

Proviso of sect. 6 of Statute of Monopolies.

Sect. 6 of the Statute of Monopolies preserves and defines the royal prerogative to grant letters patent for inventions in these terms:—

"Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, *of the sole working or making of any manner of new manufactures* within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accounted from the date of the first letters patent or grants of such privilege hereafter to be made, but that *the same shall be of such force as they would be if this Act had never been made and of none other*" (*d*).

General effect of the proviso on the common law.

The effect of this section of the Act is in substance that such letters patent and grants of privilege as it describes are not, on the one hand, to be taken to be within the meaning of the preceding sections, which, in very general terms, declare the illegality of all monopolies whatsoever; nor are they, on the other hand, to be rendered valid by virtue of the Act, but they are to be of precisely the same force as if the Act had not been passed, and no more. An invention which may legally be made the subject of a patent privilege must, therefore, not only be of such a nature as to come within the meaning of the exception contained in the statute, but it must also be such an invention as at common law the Crown possesses the prerogative of granting the sole use of (*e*).

It will be observed, that what the Statute of Monopolies does is to except from the operation of the prior invalidating clauses grants of privilege relating to "*the sole working or making of any manner of new manufactures*" within the realm. This is the most succinct and yet at the same time the most comprehensive definition that can be given of the subject-matter of letters patent. We shall, therefore, consider in the first place the meaning and extent of the words *any manner of manufacture*, and then proceed to discuss novelty, utility, and the other incidents of patentable inventions.

Definition of *subject-matter of letters patent.*

Novelty, utility.

(*d*) Upon the construction of this statute, see Coke, 3 Inst. 181; 11 Co. R. 88 b; *Mitchell* v. *Reynolds*, 1713, 1 Mod. R. 130.

(*e*) Hindmarch, p. 79.

SECT. 2.—INTERPRETATION OF "ANY MANNER OF MANUFACTURE."

(1) *Process or Product.*

Interpretation of "manufacture."

Having regard to the common law,—at which any new art of producing an article of trade or commerce might be made the subject of a patent privilege,—and to the construction warranted by the express language and by the context of the Statute of Monopolies, one would have expected a wide and generous interpretation of the word "manufacture" by the Courts of law. The earliest reported decisions, the *dicta* of the best institutional writers, the obvious intent of the common law, and the emphasis placed by the Statute of Monopolies upon "the working" as well as upon "the making" of any manner of new manufacture, clearly indicate that the term was meant to be taken in its ordinary double signification of an art, or anything made by art (*f*), *i.e.*, a process as well as a product. It may be interesting and instructive to trace shortly, and in chronological order, the cases bearing upon this point.

Includes anything made by art.

Process—Product.

(2) *Processes.*

"Manufacture" includes process as well as product.

A.D. 1795.

In *Boulton* v. *Bull* (*g*), Mr Justice Heath, speaking of the word "manufacture" in 21 Jac. I. c. 3, s. 6, said: "What, then, falls within the scope of the proviso? Such manufactures as are reducible to two classes; the first class includes machinery, the second substances (such as medicines) formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form. . . . I approve of the term manufacture in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso, that it was introduced for the benefit of trade."

"Things made," and "practice of making."

In the same case, Chief Justice Eyre observed: "It was admitted in the argument at the bar that the word 'manufacture' in the statute was of extensive signification; that it applied not only to things made, but to the practice of making; to principles carried into practice in a new manner; to new results of principles carried into practice."

A.D. 1819.

In *Rex* v. *Wheeler* (*h*), Chief Justice Abbott said: "The word 'manufacture' has been generally understood to denote either *a thing made*, which is useful for its own sake, and vendible as such—

(*f*) This natural interpretation was not, however, at first clearly recognized or admitted.

(*g*) 1795, 2 H. Bl. 482, 493; cp. *Hornblower* v. *Boulton*, 1799, 8 T. R. 99.

(*h*) 1819, 2 B. & Ald. 349.

as a medicine, a stove, a telescope, and many others—or to mean an *engine or* instrument, or some part of an engine or instrument, to be employed either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam engine for raising water from mines."

A.D. 1837. The language of Baron Parke in *Morgan* v. *Seaward* (*i*) is equally emphatic—"The word 'manufacture' in the statute—21 Jac. I. c. 3, s. 6—must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine."

A.D. 1842. In a few cases (*k*), some degree of hesitation was evinced by the judges in accepting that interpretation which extended the language of the statute to processes, but the difficulty was finally *Crane* v. *Price*. settled by the Court of Common Pleas in *Crane* v. *Price* (*l*). Here the invention, in respect of which a patent was claimed, consisted in the application of anthracite or stone coal, combined with a hot air-blast in the smelting or manufacture of iron from ironstone, mine, or ore. In delivering the judgment of the Court, Chief Justice Tindal said: "The question is whether, admitting the use of the hot air-blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite or stone coal to have been known before in the manufacture of iron with cold blast, but that the combination of the two together—the hot blast and the anthracite—was not known before in the manufacture of iron,—such a combination can be the subject of a patent.

"We are of opinion that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public than that produced before by the old method, that such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent" (*m*).

(*i*) 1837, 2 M. & W. 558.

(*k*) *Hill* v. *Thompson*, 1817, 3 Mer. 626; *Gibson* v. *Brand*, 1841, 4 M. & G. 179; cp. Godson, Patents and Copyrights, p. 82.

(*l*) 1842, 4 M. & G. 580. The particular decision in *Crane* v. *Price* was questioned in *Horton* v. *Mabon*, 1862, 12 C. B. N. S. 448, and in *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 584; but the principle on which that case was decided has never been impeached.

(*m*) Cp. also *Stead* v. *Williams*, 1843, 2 Web. P. C. 134; *Heath* v. *Unwin*, 1844, 25 L. J. C. P. 20; *Crossley* v. *Potter*, 1853, Macr. P. C. 240, where the connection between this part of the subject, and the questions of "novelty" and "utility," is clearly indicated by Pollock, C. B. "It is very true that patents are continually taken out for what are called *methods* or *processes*, but the real object of the patent . . . is a new manufacture. Everybody who takes out a patent under the name of a process really takes it out for that which is the result of the process for the thing that is manufactured, or the process by which it is produced." *Bush* v. *Fox*, 1834, Macr. P. C. 160; *Harwood* v. *G. N. Rail. Co.*, 1860, 29 L. J. Q. B. 202; *Ralston* v. *Smith*, 1865, 11 H. L. 223.

While it hardly seems necessary to labour a point which has been so emphatically decided, the following authorities and illustrations may be given:—

Application was made for a patent for an improvement in the manufacture of gas, viz., making gas *direct* from seeds, leaves, nuts, fruits, and other substances containing oil or oily matter, instead of from oils, resins, and gums previously extracted from such substances. The Court held that, assuming the invention to be new, it was a good subject-matter for a patent (*n*). Other cases.

"A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance valuable for medical or other qualities, would afford a good ground for a patent. A discovery of some machinery, whereby such a mixture may be more quickly or more effectually accomplished might be the foundation of another patent" (*o*).

In a patent for "improvements in the preparation of red and purple dyes," the specification thus declared the nature of the invention: "I mix aniline with dry arsenic acid and allow the mixture to stand for some time: or I accelerate the operation by heating it to, or nearly to, the boiling point, until it assumes a rich purple colour." The patentee claimed the "manufacture or preparation of red and purple dyes by treating aniline dyes with arsenic acid as hereinbefore described." Lord Chancellor Chelmsford said, "there is nothing upon the face of the specification to show that the invention described is not in every part of it the subject of a patent" (*p*).

In *Stevens* v. *Keating* (*q*), Pollock, C.B., said: "All patents must be for a manufacture. The real invention may be not so much for the thing when produced as for the mode in which it is produced; and its novelty may consist not so much in its existence as a new substance as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture, of that there cannot be a doubt; and therefore, although the language of the Act has been said to apply only to manufactures and not to processes, when you come Thing produced, or mode in which produced.

(*n*) *Booth* v. *Kennard*, 1856, 1 H. & N. 527. The patent was afterwards set aside for want of novelty: 1857, 2 H. & N. 84.

(*o*) *Bewley* v. *Hancock*, 1856, 6 De G. M. & G. 402; cp. also *Bovill* v. *Pimm*, 1856, 11 Exch. 739. See *Wallington* v. *Dale*, 1851–2, 7 Exch. R. 888; *Newall* v. *Elliott*, 1864, 13 W. R. 11.

(*p*) *Simpson* v. *Holliday*, 1866, L. R. 1 H. L. 315; and *Cammington* v. *Nuttall*, 1871, L. R., 5 H. L. at p. 252.

(*q*) 1847, 2 Web. P. C. 182.

to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture."

There are cases, however, to which the explanation that a patent for a process is merely a patent for a new thing manufactured scarcely applies.

Thus, in *Forsyth* v. *Riviere* (*r*), the application of a known detonating powder to the discharge of known kinds of fire-arms, was held to be patentable. Again, the application of plates of metal and wire to the several parts of buildings and ships, so as to prevent the access of fire and the current of air, has been held good subject-matter (*s*).

In *The Electric Telegraph Co.* v. *Brett* (*t*), a method of giving duplicate signals at intermediate stations was declared to be patentable.

In none of these three cases was any new substance produced, the bare process being held good subject-matter for a patent.

Manufacture includes chemical processes.

Since it was settled in *Crane* v. *Price* (*u*) that the word "manufactured" in the Statute of Monopolies (*v*) included "process," no doubt (*x*) has existed that a chemical invention is *ceteris paribus* patentable. In the case, however, of *Badische Anilin* v. *Levinstein* (*y*), a point was incidentally decided which appears to justify the treatment of *chemical* inventions separately from other processes, viz., that the prior user of an *analogous* invention will not go far towards destroying the novelty of a similar invention subsequently patented. In the case under consideration, the invention was for a series of red and brown colouring

(*r*) 1819, 1 Web. P. C. 97; 1 Carp. P. C. 401; Johns. Pat. Man. 15.

(*s*) *Hartley's Patent*, 1 Web. P. C. 54. The subject-matter of this patent was considered by Eyre, C. J., in his judgment in *Boulton and Watts* v. *Bull* (2 H. Bl. 493), and placed in the general class of patents for methods of operating and manufacturing, producing no new substances, and employing no new machinery. See, however, Webster's note on this case, *ubi supra*.

(*t*) 1851, 10 C. B. 838; 20 L. J. C. P. 123.

(*u*) 1842, 4 M. & G. 580; 5 Scott, N. R. 338; 12 L. J. C. P. 81; 1 Web. P. C. 393; 2 Carp. P. C. 669.

(*v*) 21 Jac. 1, c. 3, s. 6.

(*x*) See Godson's Patents for Inventions, pp. 96—98; cp. also *Muntz* v. *Foster*, 1843, 2 Web. P. C. 93; *Steiner* v. *Heald*, 1851, 6 Exch. 607; 17 Jur. 875; 20 L. J. Ex. 410; *Bewley* v. *Hancock*, 1856, 6 De G. M. & G. 391; 2 Jur. N. S. 289; 4 W. R. 334; *Hills* v. *London Gas Light Co.*, 1857, 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409; *Higgs* v. *Goodwin*, 1858, 27 L. J. Q. B. 421; 5 Jur. N. S. 97; E. B. & E. 529; *Young* v. *Fernie*, 1863, 4 De G. J. & S. 353; 9 L. T. N. S. 590; 12 W. R. 221; 10 Jur. N. S. 58; 33 L. J. Ch. 192; 3 N. R. 270; *Simpson* v. *Holliday*, 1864, 20 New. Lon. Jour. N. S. 105; *Bailey* v. *Roberton*, 1878, L. R. 3 A. C. 1055.

(*y*) 1887, 4 P. O. R. 449; 1889, 6 P. O. R. 387.

matters, which the patentee termed "sulpho-acids of oxy-azo-naphthaline," for the production of which he relied, *inter alia*, upon the following process:—Napthalamine was diazoed, combined with naphthol, and the compound sulphonated. The defendants alleged, and it was admitted, that the same reaction had been obtained, but with phenol instead of naphthol. Dr. Griess deposed, "I distinctly state that by the combination of diazo benzol and phenol, dye was obtained, and, if I had been a little cleverer, *analogy* would have induced me to prepare the very dye which is now under consideration. But analogy did not lead me to do that. *Analogy does not go a long way in chemistry.*"

(3) *Principles and Discoveries.*

Principles.

A mere principle, *i.e.*, an abstract law of nature, a fundamental law of mechanics, chemistry, or any other science, cannot be made the subject of a valid patent grant (1) because such principles are capable of an endless variety of uses and applications, and are the common property of all men; (2) because no primary law of science can, apart from the practical application of it, be capable of producing any vendible article or manufacture, "and, therefore, unless a person who discovers such a principle or law makes some practical use of it, so as to produce some article which the public requires and will purchase, he cannot give the public the consideration which the law requires to be given for the grant of a sole privilege. The object of the law was not to reward mere speculative discovery, but to encourage industry and procure for the public the benefit of new manufactures" (*z*).

Why not subject-matter of valid patent.

A principle, however, so far embodied and connected with corporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or manual occupation is undoubtedly patentable (*a*). In the case of *Otto* v. *Linford* (*b*), the late Master of the Rolls, Sir George Jessel, put the distinction, which is here referred to, with his accustomed clearness: "If you have a new principle or a new idea

A principle applied can.

(*z*) Hindmarch, p. 90.

(*a*) *Boulton* v. *Bull*, 1795, 2 H. Bl. 496; *Hornblower* v. *Boulton*, 1799, 8 T. Rep. 101; *Jupe* v. *Pratt*, 1837, 1 Web. P. C. 146; *Neilson* v. *Harford*, 1841, per Alderson, B., 1 Web. P. C. 342; *The Houschill Co.* v. *Neilson*, 1843, 1 Web. P. C. 673; 9 C. & F. 788; *Electric Telegraph Co.* v. *Brett*, 1851, 10 C. B. 838; *Crossley* v. *Potter*, 1853, Macrory, P. C. 240; *Dangerfield* v. *Jones*, 1865, per Wood, V.-C., 13 L. T. N. S. 142.

(*b*) 1881, 46 L. T. 39; cp. *Badische Anilin* v. *Levinstein*, 1885, 2 P. O. R. 91; 4 P. O. R. 449.

Principles in practice.

as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new.

"One of the strongest illustrations that I know of is the patent for the hot blast in the iron manufacture (*c*), where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel would produce most remarkable results in the shape of economy in the purchase of iron. The inventor or discoverer could not patent that, but what he did was this: he said, 'I will patent that idea in combination with the mode of carrying it out; that is, I tell you you may heat your air in a closed vessel next your furnace, and then that will effect the object.' It was held that that would do" (*d*).

Minter v. *Wells* (*e*) is a case in point. This was an action for the infringement of a patent for "an improvement in the construction of chairs." The claim was for "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair."

A rule *nisi* to enter a non-suit on the ground that the patent was bad as claiming a principle in mechanics, was refused by the Court of Exchequer. "Every invention of this kind," said Lord Lyndhurst, C. B., "must include the application of some principle; and here the application of the principle of the lever to the construction of a reclining chair constitutes the machine, the invention of which the plaintiff claims. He does not, as is asserted, claim the principle in the summing-up of his specification, but he claims the invention of applying that principle in a certain manner and by certain machinery."

Discoveries.

It is sometimes said that a *discovery* cannot be the subject of letters patent. In this statement "discovery" is used synonymously with "principle." For instance, the persons who "discovered" abstract phenomena of electricity, or magnetism; the expansive power of steam; the fact that in the expansion of a gas in the performance of work there is a fall of temperature; or the existence of a metal or a medicinal herb; could not patent these "dis-

(*c*) The case here referred to is *Neilson* v. *Harford*, 1841, *ubi supra*.

(*d*) 1881, 46 L. T. 39; cp. *Badische Anilin* v. *Levinstein*, 1885, 2 P. O. R. 91; 4 P. O. R. 449.

(*e*) 1834, 1 Web. P. C. 127.

coveries," though any mode of applying them would, *cæteris paribus*, be patentable (*f*).

(4) *Amount of Invention.*

The only subject now remaining for consideration in this general sketch of the judicial interpretation of the words *any manner of manufacture* is this: How far is the application of known materials or appliances to new uses, and to produce new results, patentable? "It is impracticable," said Mr. Justice Chitty, in *Lister* v. *Norton* (*g*), "to frame propositions of a scientific character on this point. Every case must be decided on its peculiar merits, and with reference to its own special circumstances. The authorities are necessarily decisions on particular cases, and are useful only as affording some guide to the decision of the case before the Court." No general rule.

The question under discussion invariably resolves itself into this: Does the art or manufacture which it is sought to patent display such an amount of invention as, in the circumstances, to entitle the inventor to a patent grant? In the judicial application of this test, it has been held (*h*) that (a) the *application* of old materials Amount of invention.

(*f*) Cp. Trans. Inst. P. A., vol. vi. p. 232, 1887–88, G. B. Ellis.

(*g*) 1886, 3 P. O. R. at p. 205.

(*h*) Authorities for (a): *Hartley's Case* (after 1773), 2 H. Bl. 493; *Macintosh* v. *Everington*, 6 Rep. Arts. N. S. 317, 365; *Brunton* v. *Hawkes*, 1821, 1 Carp. P. C. 405; *Hall* v. *Jarvis*, 1822 (1 Web. P. C. 100), 4 B. & Ald. 541; *Kay* v. *Marshall*, 1841, 2 Web. P. C. 82; *Walton* v. *Potter*, 1841, 4 Scott, N. C. 91; 3 M. & G. 411; 1 Web. P. C. 597; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 103; *Pow* v. *Taunton*, 1845, 9 Jur. 1056; *Reg.* v. *Cutler*, 1847, Macr. P. C. 124; 3 C. & K. 215; 14 Q. B. 372, n.; *Steiner* v. *Heald*, 1851, 6 Exch. 607; 11 Jur. 875; 20 L. J. Exch. 410; *Bush* v. *Fox*, 1852–56, Macr. P. C. 164; 2 Jur. N. S. 1029; 23 L. J. Ex. 257; 5 H. L. C. 707; 25 L. J. Ex. 251; Macr. P. C. 178; *Mackelcan* v. *Rennie*, 1862, 13 C. B. N. S. 52; *Penn* v. *Bibby*, *Penn* v. *Jack*, 1866, L. R. 2 Ch. 127; 37 L. J. Ch. 455; 15 W. R. 208; 15 L. T. N. S. 399; *White* v. *Toms*, 1867, 36 L. J. Ch. 204; 17 L. T. N. S. 348; *Rushton* v. *Crawley*, 1870, L. R. 10 Eq. 522. *Note.*—There must be an amount of invention, deemed sufficient by the Court, to make a merely new application of old materials or machinery patentable. Cp. *Brook* v. *Aston*, 1857, 8 E. & B. 478; 27 L. J. Q. B. 145; 28 L. J. Q. B. 175; *Harwood* v. *The G. N. Rail. Co.*, 1860, 2 B. & S. 194, 222; 11 H. L. C. 654; 29 L. J. Q. B. 193; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27; *Saxby* v. *The Gloucester Waggon Co.*, 1881, L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577; *Penn* v. *Bibby*, *ubi supra*, per Lord Chelmsford, L. C., L. R. 2 Ch. at p. 136; *Bamlett* v. *Picksley*, 1875, Griffin, P. C. 40.

Authorities for (b): *Edison and Swan Co.* v. *Woodhouse and Rawson*, 1887, 4 P. O. R. 79.

Authority for (c): *Moss* v. *Malings*, 1886, 3 P. O. R. 373.

Authorities for (d): *Morris* v. *Bransom*, 1776, Bull. N. P. 76; 1 Carp. P. C. 30; 1 Web. P. C. 51; *R.* v. *Arkwright*, 1785, 1 Web. P. C. 71; *Boulton* v. *Bull*, 1795, 2 H. Bl. 489; *Jessop's Case* (before 1795), cited 2 H. Bl. 489; *Hornblower* v. *Boulton*, 1799, 8 Term Rep. 101; Dav. P. C. 233; *Ex parte Fox*, 1812, 1 V. & B. 67; 1 Web. P. C. 431; *Bovill* v. *Moore*, 1815–16, 2 Coop. Ch. Ca. 56; Dav. P. C. 361; 2 Marsh. R. 211; *Lister* v. *Leather*, 1857, 8 E. & B. 1017; *Ralston* v. *Smith*, 1865, 11 H. L. C. 223; *Fox* v. *Dellestable*, 1866, 15 W. R. 195; cp. *Bircot's Case*, 3 Inst. 184.

Authorities for (e): *Boulton* v. *Bull*, 1795, 2 H. Bl. 487; *Huddart* v. *Grimshaw*, 1803, Dav. P. C. 267; *Hill* v.

What patentable.

or methods to the production of new and useful results; (b) the modification of one element in an old combination; (c) a slight alteration in the shape of an old instrument, being new and very useful; (d) a new addition to an existing machine; and (e) a *combination* of old materials, by which a new, or a better or a cheaper, article is given to the public—may be patented.

What not patentable.

Upon the other hand (*i*), (a) a particular application of an old contrivance; (b) an application of a known article to a known or analogous purpose; (c) an old combination with immaterial variations—are not patentable, unless they clearly involve an exercise of the inventive faculty and are not merely obvious.

In the interpretation of the statute, the word "manufacture" is almost synonymous with "invention" (*j*).

Thompson, 1817, 1 Web. P. C. 237; *Brunton* v. *Hawkes*, 1821, 4 B. & A. 550; *Lewis* v. *Davis*, 1829, 3 C. & P. 502; 1 Web. P. C. 488; 1 Carp. P. C. 471; *Saunders* v. *Aston*, 1832, 1 Carp. P. C. 510; *Carpenter* v. *Smith*, 1841, 1 Web. P. C. 538; 11 L. J. Ex. 213; *Crane* v. *Price*, 1840-42, per Tindal, C. J., 1 Web. P. C. 408; *Allen* v. *Rawson*, 1845, 1 C. B. 551; *Bovill* v. *Keyworth*, 1857, 7 E. & B. 725; 29 L. T. 194; 3 Jur. N. S. 817; *Lister* v. *Leather*, *ubi supra*; *Spencer* v. *Jack*, 1862-64, 3 De G. J. & S. 346; 11 L. T. N. S. 242; *Watling* v. *Stevens*, 1886, 3 P. O. R. 37; *Moseley* v. *Victoria Rubber Co.*, 1887, 4 P. O. R. 251; *Morton* v. *Middleton*, 1863, 1 Ct. of S. 3rd Ser. 721; *Foxwell* v. *Bostock*, 1864, 12 W. R. 725; *Wright* v. *Hitchcock*, 1870, L. R. 5 Ex. 37; 39 L. J. Ex. 97; *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 577.

(*i*) Authorities for (a): *Reg.* v. *Cutler*, 1847-49, 14 Q. B. 372, n.; Macr. P. C. at p. 133; *Sharp* v. *Brawer*, 1886, 3 P. O. R. at p. 196. Hero Bacon, V.-C., said: "There is not a suggestion that this gentleman, who is the plaintiff in the patent action, has invented anything in the world. He has been examined very fully, and upon his own statement it is clear and evident to me that he did not invent anything; but a luminous idea occurred to him that this old-fashioned thing (a screen), that everybody might have made and used whenever he liked, and wherever he liked, would be very handy if it was applied to a window, and so it is applied to a window. It is equally applicable to a fireplace." His lordship then held that there was no valid patent.

Authorities for (b): See cases cited *supra*; and, besides, *Losh* v. *Hague*, 1838, 1 Web. P. C. 207; *Tetley* v. *Easton*, 1857, 2 C. B. N. S. 706; 26 L. J. C. P. 269; *The Patent Bottle Envelope Co.* v. *Seymer*, 1858, 5 C. B. N. S. 164; 28 L. J. C. P. 22; 5 Jur. N. S. 174. "Analogous purpose": *Kay* v. *Marshall*, 1839-48, 5 Bing. N. C. 492; 7 Scott, 548; 8 L. J. C. P. 261; 2 Web. P. C. 71; judgment affirmed in the House of Lords, 8 C. & F. 245; West. 682; 5 Jur. 1028; 2 Web. P. C. 79; *Horton* v. *Mabon*, 1862, 31 L. J. C. P. 255; 12 C. B. N. S. 437; 10 W. R. 582; 6 L. T. N. S. 289; affirmed on appeal, 16 C. B. N. S. 141; 12 W. R. 491; 9 L. T. N. S. 815; *Ormson* v. *Clarke*, 1862, 32 L. J. C. P. 8; 13 C. B. N. S. 337; 9 Jur. N. S. 749; 11 W. R. 118; 7 L. T. N. S. 361; affirmed in the Exchequer Chamber, 32 L. J. C. P. 291; 14 C. B. N. S. 475; 10 Jur. N. S. 128; 11 W. R. 787; *Willis* v. *Davison*, 1863, 1 N. R. 234; *Harwood* v. *The G. N. Rail. Co.*, 1860-65, *ubi supra*; *Ralston* v. *Smith*, 1865, 11 H. L. C. 223; 20 C. B. N. S. 28; 13 L. T. N. S. 1; 35 L. J. C. P. 49; *Jordan* v. *Moore*, 1866, L. R. 1 C. P. 624; 13 Jur. N. S. 766; 35 L. J. C. P. 268; 14 W. R. 769; *Parkes* v. *Stevens*, 1869, L. R. 5 Ch. 36; 18 W. R. 233; 22 L. T. N. S. 635; *Cropper* v. *Smith*, 1884, 1 P. O. R. at p. 90.

Authority for (c): *Rowcliffe* v. *Longford Wire Co.*, 1887, 4 P. O. R. at p. 281.

(*j*) *Cornish* v. *Keene*, 1837, per Tindal, C. J., 1 Web. P. C. at p. 508; 6 L. J. C. P. 225; and cp. *Bush* v. *Fox*, 1854, per Coleridge, J., Macr. P. C. 176; and *Ralston* v. *Smith*, 1865, per Lord Westbury, 11 H. L. C. 223.

Patent or design?

It may sometimes be a question whether an article is properly subject-matter for a patent, or should be registered as a design. A design may be registered although it be for something which might have been patented (*k*). This point was considered in *Walker* v. *The Falkirk Iron Co.* (*l*). In that case, the proprietor of a registered design for kitchen-range fire-doors, brought an action for infringement thereof in the Court of Session. The defender pleaded, *inter alia*, that what was registered might have been patented, and therefore could not be properly registered as a design. It was held by the judge of first instance, Lord Maclaren, that the design was novel, and not patentable, and was properly registered, and that the pursuer was entitled to succeed. On the defender appealing, it was held by the Inner House that the design was novel, and that the fact that the pursuer might have obtained a patent was immaterial.

(5) *Combinations in general.*

Classification of patentable inventions.

It may be said generally that every invention is either a combination, or the result of a combination.

Definition of combination.

The term "combination" (*m*), therefore, requires definition and analysis before we proceed any further.

This word signifies by derivation the putting of two things together, so as to convert a double into a single. Its original meaning has, however, been extended, and it now, in common parlance, imports the putting together, not of two only, but of any number of things, so as to form a single group, and indeed the putting together of any number of groups.

The meaning of "combination" in the law of patents is somewhat narrower. It is not the mere putting things together in the sense of juxtaposition: it includes also connection of some kind, so that the group, in consequence of the connection of its members, has properties or effects different from those possessed by its members separately.

Classes of combinations.

Combinations may be divided roughly into five classes:—(1) New compounds, resulting from the chemical combination of two or

(*k*) Registration protects the form, shape, pattern, or configuration of an article.

(*l*) 1887, 4 P. O. R. 390.

(*m*) See paper on "Combinations as subjects of Patent Claims," J. Imray, Trans. I. P. A. vol. i. 130, from which the definition and classification here given of combinations have been largely adapted. See also Chapter on Claims, at p. 97.

more known substances, *e. g.*, the anilino dyes produced by combining anilino and its analogues with metallic salts; (2) a new mixturo without actual chemical combination, *e. g.*, an alloy of two or more metals producing a compound metal presenting particular qualities; (3) a mechanical union of two or more materials, *e. g.*, macintosh cloth, resulting from the combination of a fabric with a film of caoutchouc; (4) dynamical combinations, including "machines" properly so called; and (5) processes, that is to say, combinations of operations, pursued in regular sequence. A process may be mechanical, *e. g.*, printing, or chemical, *e. g.*, soap making, or mechanical and chemical, *e. g.*, paper making.

(6) *Applications and Combinations of Old Materials, &c.*

The following kinds of inventions have been held to be good subject-matter for letters patent.

Applications.

The application of old materials or methods to the production of new and useful results (*n*).

The authorities for this statement are collected above, see p. 23, note (*h*) (a). A few illustrations, however, may with advantage be given here.

Cases. Good subject-matter.

A method of disposing plates of iron, so as to produce a useful effect, viz., to secure buildings from fire, is patentable, although here the application alone is new (*o*). But it may be doubted how far this is now good law.

A claim for the application of india-rubber in a state of solution as a cement between two fabrics to make a waterproof covering, is good, notwithstanding the application of other substances, and of india-rubber in other states to the same purpose (*p*).

In *Muntz* v. *Foster* (*q*), an action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships," Tindal, C. J., directed the jury in the following terms: "The plaintiff has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing, by reason and by means of its oxydating just in sufficient quantity; that is, not too much, so as

(*n*) In *Luckie* v. *Robson* (2 Jur. 201), it was held that a new adaptation of old materials is sufficient to ground an injunction against the infringement of a patent. Cp. *Re Martin and Hyam*, 1845, 3 W. R. 433; *Reynolds* v. *Amos*, 1886, 3 P. O. R. 215.

(*o*) *Hartley's Patent* (after 1773), 2 H. Bl. 493; 1 Web. P. C. 54—56.

(*p*) *Macintosh* v. *Everington*, 6 Reports, Arts. N. S. 317, 365.

(*q*) 1844, 2 Web. P. C. 103.

to wear away and impair the sheathing and render the vessel unsafe, but enough, at the same time, to keep, by its wearing, the bottom of the vessel clean from those impurities which before attached to it. . . . I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal, as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined that where such unknown qualities have from the result of experiments been applied to useful purposes of life, that such application has been considered as the ground, and a proper ground, of a patent; and therefore when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless there has been some application of them before to this very useful purpose."

No subject-matter.

On the other hand, the application of an old invention to a new purpose is not patentable, unless there is some novelty in the application (*r*), *i.e.*, unless the new application lies so much out of the track of the former use as not naturally to suggest itself to the mind of a person turning his thoughts to the subject (*s*).

Cases.

In *Thompson* v. *James*, a suit to restrain the infringement of a patent for crinolines, it appeared that the invention consisted merely in the substitution of steel springs for whalebone and other elastic materials; Romilly, M. R., held that there was no subject-matter (*t*).

So, where a patentee claimed the application of either iron or steel tubes—when coated with copper, brass, or other alloys of copper—in the construction of tubular flues for steam boilers, and admitted that the coated tubes mentioned in the specification were not new, nothing more than the mere application of the tubes being claimed; Denman, C. J., held that the patent was invalid (*u*).

Again, in *Bush* v. *Fox* (*x*), an action for the infringement of a

(*r*) *Brook* v. *Aston*, 1859, per Campbell, C. J., 8 E. & B. at p. 485.

(*s*) *Penn* v. *Bibby*, 1866, L. R. 2 Ch. 127, per Lord Chelmsford. Cp. *Harwood* v. *G. N. Ry. Co.*, 1860-65, per Cockburn, C. J., 2 B. & S. 208. Where there is merely an improvement in a mode of manufacture, and no invention, that is not a proper subject for a patent: *White* v. *Toms*, 1867, per Malins, V.-C., 37 L. J. Ch. 204.

(*t*) 1863, 32 Beav. 570; cp. *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 367; affirmed on appeal, L. R. 5 Ch. 36; *Rushton* v. *Crawley*, 1870, L. R. 10 Eq. 522.

(*u*) *Reg.* v. *Cutler*, 1847, Macr. P. C. 124; *Slazenger* v. *Feltham*, 1889, 6 P. O. R. 130; *Cole* v. *Saqui*, 1889, 6 P. O. R. 41; reversing decision of Kekewich, J., 1888, 5 P. O. R. 489.

(*x*) 1852-56, Macr. P. C. 164—166, 178.

patent for improvements in the means of, and in the apparatus for, building and working under water, where the invention consisted in the use of a caisson or hollow cylinder, so constructed that the workpeople might be supplied with compressed air; and it was proved that an apparatus described in the specification of a prior patent was the same in all material respects as the plaintiff's, and that they differed only in their application—the one being for building on land, the other for constructing foundations under water; Pollock, C. B., directed the jury that the alleged invention was not a new manufacture, and this ruling was affirmed in the Exchequer Chamber and in the House of Lords.

In *Harwood* v. *The Great Northern Rail. Co.* (*y*), a patent for the application of "fishes," in order to connect the rails of railways, was held to be bad, because a similar contrivance had previously been applied to the purpose of connecting and fastening timbers placed vertically upon one another, or placed horizontally side by side.

In *Ormson* v. *Clarke* (*z*), a patent for an improvement in the manufacture of cast tubular boilers was held invalid, under the following circumstances: Tubular boilers, such as those in question, were perfectly well known, and had long been used for the heating of horticultural buildings. The only novelty was the casting in one piece that which used formerly to be cast in several pieces. There was no claim for novelty in the process of casting. In a later case (*a*), it was held that iron and wood having long been used for the construction of the frame and coating of vessels, the application of wooden planking to the iron frame of a vessel without any peculiarity in the nature of that planking could not be the subject of a patent. "It is not only," said Byles, J., "the substitution of one well-known and analogous material for another, that is, wood for iron, to effect the same purpose on an iron vessel, but it is the application of the same old invention, viz., planking with timber, which was formerly done on a wooden frame, to

(*y*) 1860, 2 B & S. 194, 22; 11 H. L. C. 654. Cp. *Losh* v. *Hague*, 1838, 1 Web. P. C. 208; *Kay* v. *Marshall*, 1839–48, 2 Web. P. C. 71—79; *Horton* v. *Mabon*, 1862, 12 C. B. N. S. 437; 16 C. B. N. S. 141.

(*z*) 1862, 1863, 13 C. B. 339; 14 C. B. 490. Cp. *Williams* v. *Nye*, 1890, 7 P. O. R. 62.

(*a*) *Jordan* v. *Moore*, 1866, L. R. 1 C. P. 624. Cp. 1 *Hill* v. *Tombs*, Engineer, April 15, 1881, p. 274, cited Johns. Pat. Man. 48; *Calvert* v. *Ashburn*, Pract. Mech. Jour. Vol. 7, 2nd ser. 971; *ib.* 49; *Hyde* v. *Trent*, Newt. Lond. Jour. Vol. 45, 135; Johns. Pat. Man. 45; *Oddy* v. *Smith*, 1888, 5 P. O. R. 503; *Longbottom* v. *Shaw*, 1888, *ib.* 497; L. R. 43 Ch. D. 46; *Tickelpenny* v. *Army and Navy Co-operative Society*, 1888, *ib.* 405.

an analogous purpose, or rather the same purpose on an iron frame."

The doctrine that a patent cannot be claimed for applying an old machine to an analogous purpose is not applicable where there is a new machine, although that new machine may contain old and well-known mechanical appliances (*b*). In *Thomson* v. *Batty* (*c*), it was held that an invention to steady a compass by means of a bowl filled with a viscous fluid, which operated by the friction of the fluid against the sides of the bowl in which the fluid was itself contained, was not anticipated by an invention in which a compass bowl was steadied by being placed in another bowl filled with a viscous fluid, where the steadying effect was produced by the resistance of the fluid to the sides of the compass bowl.

Combination of old materials.

A combination of old materials, by which a new, or a better, or a cheaper, article is given to the public, is good subject-matter (*d*).

Thus, in *Allen* v. *Rawson* (*e*), a patent for improvements in the treatment of felted fabrics, which consisted in the application of soap and water in combination with rollers in the process of fulling, was held valid, although the use of *acidulated* water was known, and the use of rollers was also known.

In *Wright* v. *Hitchcock* (*f*), an action for the infringement of a patent for improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein, it was proved that anterior to the date of the patent those articles were made by hand, the material being folded by a knife, and then sewn so as to keep it permanently folded. According to the plaintiff's invention the fabric was folded by a reciprocating knife, and the folds stitched by the sewing machine, so as to be kept permanently in their place. The invention was admitted to be novel, and to produce the result more cheaply and conveniently than the method previously known. It was held that there was good subject-matter for a patent.

Material variation of element of combination.

The modification of one element in an old combination may be patentable.

In *Edison and Swan Co.* v. *Woodhouse* (*g*), an action for the

(*b*) *Siddell* v. *Vickers*, 1888, 5 P. O. R. 430.

(*c*) 1889, 6 P. O. R. 84.

(*d*) See authorities collected *supra*, pp. 23, 24; *Crane* v. *Price*, 1842, 1 Web. P. C. 393. It seems that such a combination is patentable, although the constituent parts are already known in combination: *Carpenter* v. *Smith*, 1841, per Lord Abinger, C. B., 1 Web. P. C. 538.

(*e*) 1845, 1 C. B. 551.

(*f*) 1870, L. R. 5 Ex. 37.

(*g*) 1887, 4 P. O. R. 79. Cp. *Moss* v. *Malings*, 1886, per North, J., 3 P. O. R. at pp. 378, 379.

infringement of patents for improvements in electric lamps and in the method of manufacturing the same, the plaintiffs' second claim was for "the combination of a carbon filament within a receiver made entirely of glass, through which the leading wires pass, and from which receiver the air is exhausted for the purposes set forth." In two prior instances of alleged anticipation, substantially the same instrument had been constructed, the use of a filament of carbon instead of a rod of carbon being the sole change introduced by Mr. Edison. It appeared, however, that this modification was no casual matter, but was intended to bring about, and did bring about, a result which a rod could never produce, viz. high resistance to the electric current with great durability. It was held by Fry and Bowen, L.JJ. (Cotton, L. J., dissenting), that the subject-matter of the plaintiffs' patent was good.

Immaterial variations of element of combination.

An old combination, however, with immaterial variations, is not patentable.

Thus, in *Roucliffe* v. *Longford Wire Co.* (*h*), the grantee of a patent for improvements in frames for woven or elastic wire-web mattresses brought an action for infringement. The defendants denied the alleged infringement, and alleged the patent to be invalid, *inter alia*, on the ground of want of subject-matter. The patent claimed a rectangular framework, which was substantially that of the old four-post bedstead, and differed from that only—in not having any legs or posts; in having the transverse sliding piece on the top of the sides instead of in grooves along the sides; and in having the feet and head raised above instead of being flush with the sides. It was held by Kay, J., that the alleged invention was not the subject-matter of a patent.

In *Herrburger* v. *Squire* (*i*), it was held that the mere alteration of the position of the centre of a bent lever is not patentable.

The substitution of a pivot for a hinge in a machine for punching nails is not sufficient to support a patent (*k*).

(7) *Additions.*

A new addition to an existing machine is patentable. The history of the law upon this point is conveniently summarized in the judgment of Buller, J., in *Boulton* v. *Bull* (*l*), "That a patent for

(*h*) 1887, 4 P. O. R. 281.
(*i*) 1889, per Fry, L. J., 6 P. O. R. at p. 194.
(*k*) *United Horsenail Co.* v. *Swedish Horsenail Co.*, 1889, 6 P. O. R. 1.
(*l*) 1795, 2 H. Bl. 489.

an addition or improvement may be maintained is a point which has never been directly decided, and *Bircot's Case* (3 Inst. 184) is an express authority against it, which case was decided in the Exchequer Chamber. What were the particular facts of that case we are not informed (*m*), and there seems to me to be more quaintness than solidity in the reason assigned, which is, that it was to put but a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put was old. But, in truth, arts and sciences at that period were at so low an ebb, in comparison with that point to which they have been since advanced, and the effect and utility of improvement so little known, that I do not think that case ought to preclude the question. In later times, whenever the point has arisen, the inclination of the Court has been in favour of the patent for the improvement, and the parties have acquiesced where the objection might have been brought directly before the Court. In *Morris* v. *Branson*, which was tried at the sittings after Easter Term, 1776, the patent was for making eyelet holes of network in silk, thread, cotton, or worsted: and the defendant objected that it was not a new invention, it being only an addition to the old stocking frame. Lord Mansfield said: 'After one of the former trials on this patent, I received a very sensible letter from one of the gentlemen who was upon the jury, on the subject whether, on principles of public policy, there could be a patent for an addition only. I paid great attention to it, and mentioned it to all the judges. . . . . That objection would go to repeal almost every patent that ever was granted.' There was a verdict for the plaintiff, with 500*l.* damages, and no motion was made in arrest of judgment. Though his lordship did not mention what were the opinions of the judges, or give any direct opinion himself, yet we may safely collect that he thought, on great consideration, the patent was good; and the defendant's counsel, though they had made the objection at the trial, did not afterwards persist in it. Since that time it has been the generally received opinion in Westminster Hall that a patent for an addition is good. But then it must be for the addition only, and not for the old

Boulton v. *Bull.*

Morris v. *Branson.*

(*m*) The patent in *Bircot's Case* related to the preparing and melting of lead ore: 3 Inst. 181; 1 Web. P. C. 31, n. (*p*).

machine too. In *Jessop's Case* . . . . the patent was held to be void, because it extended to the whole watch, and the invention was of a particular movement only."

That a new addition to an existing invention is patentable no longer rests on judicial opinion, but has been affirmed in a series of cases, extending from *Ex parte Fox* (*n*), in 1812, to the present day.

The dictum of Malins, V.-C., in *Fox* v. *Dellestable* (*o*) must be borne in mind:

Position of patentee of improvement on a patented invention.

"No doubt a man may make an invention which is partly covered by an existing patent, but he cannot use it without the license of the patentee. He may wait for the expiration of the patent, and take out one himself if his invention be novel, and that patent will be valid."

Sect. 3.—Novelty.

(1) *General.*

Novelty of subject-matter.

"The only thing which a patentee gives to the public is a knowledge of his invention, and a patent is, in effect, a bargain between the patentee and the public, in which the public, in consideration of an inventor communicating to them a knowledge of his invention, so that they may afterwards be enabled to practise it, grant to him the sole use of his invention for a limited time. But if an invention is not new, the patentee does not communicate anything to the public which they did not know before, and therefore the patentee gives them nothing which can be considered as a consideration for the grant, and therefore the patent is wholly void" (*p*).

Consideration for the grant.

Want of novelty in material part of invention avoids grant.

Want of novelty in any material part of an art or invention renders the patent grant void, even as to those parts of the invention which may be new, and otherwise proper subjects for a patent grant—because the consideration for a patent is *entire*, and also because in such a case there is a false suggestion or representation appearing on the face of the patent (*q*).

(*n*) 1 V. & B. 67; 1 Web. P. C. 431.

(*o*) 1866, 15 W. R. 195. Cp. *Ex parte Fox*, 1812, 1 V. & B. 67; *Lister* v. *Leather*, 1857, per Campbell, C. J., 8 E. & B. 1017.

(*p*) Hindmarch, pp. 103, 104.

(*q*) Cp. Hindmarch, p. 115; also *Hill* v. *Thompson*, 1818, 2 B. Moo. 457; 8

Authority, as well as reason, is clear upon this point. That the grant of a privilege in a known art or trade is illegal, was decided in several cases before the Statute of Monopolies (*r*), is distinctly recognized by the language of that statute, and has uniformly been held by the Courts of Law ever since.

The law before Statute of Monopolies.

A more difficult question is raised, however, when we seek to define the necessary *degree* of novelty, and it is, of course, impossible to lay down rules which will absolutely and clearly govern every case that may arise.

Degree of novelty.

Still, it may be affirmed, with sufficient accuracy for general purposes, that an invention once brought to the knowledge of the public cannot be made the subject of a valid patent grant. "If the public," says Hindmarch (*s*), in language approved of and adopted by Lord Blackburn (*t*), "once become possessed of an invention by any means whatever, no subsequent patent can be granted for it, either to the true or first inventor himself, or to any other person; for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give."

General principle.

The public may obtain this knowledge by prior publication, or by prior user, either of the invention itself, or of another invention so closely analogous to it that nothing substantially new remains to be disclosed.

Prior publication and user.

(2) *Prior Publication.*

Publication of an invention in a book, pamphlet, newspaper, &c., or in a specification, will invalidate a patent granted on an application made after such publication.

Prior publication.

Taunt. 401; 1 Web. P. C. 249; *Brunton* v. *Hawker*, 1821, 4 B. & Ald. 541; 1 Carp. P. C. 405; *Lewis* v. *Marling*, 1829, 10 B. & C. 27; 5 M. & R. 70; 4 C. & P. 58; 1 Web. P. C. 497; *Kay* v. *Marshall*, 1839, 5 Bing. N. C. 501; 7 Scott, 561; *Gibson* v. *Brand*, 1842, 4 M. & G. 179; 4 Scott, N. R. 844; 1 Web. P. C. 631; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 112; *Templeton* v. *Macfarlane*, 1848, 1 H. L. C. 595; *McCormick* v. *Gray*, 1861, 7 H. & N. 25; 31 L. J. Ex. 42; *United Horse Nail Co.* v. *Stewart*, 1885, 2 P. O. R. 132.

(*r*) *Hastings' Patent*, 1561, Noy, R. 182; 1 Web. P. C. 6; *Matthey's Patent*, Eliz., Noy, R. 178; 1 Web. P. C. 6; *Humphrey's Patent*, Noy, R. 183; 1 Web. P. C. 7; *Darcy* v. *Allin*, 1602, Noy, R. 182; 1 Web. P. C. 6; *Clothworkers of Ipswich Case*, 1615, Godb. 254; 1 Rol. R. 4.

(*s*) Page 33.

(*t*) *Patterson* v. *The Gas Light and Coke Co.*, 1875, 3 App. Cas. at p. 244. See *infra*, p. 493, as to publication at international and industrial exhibitions; also as to applications under International Convention, see p. 408.

Cases on prior publication in books, &c.

Rex v. *Arkwright* (*y*). Here a part of the alleged invention had been described in *Emerson's* book on mechanics, published long before the date of the patent, and it was held, therefore, not patentable.

Hill v. *Thompson* (*z*). The Court of Common Pleas held that a book printed and published prior to the grant of the patent, which *in substance* informed the public of what the specification of the patent professed to inform them, completely negatived the novelty of the alleged invention (*a*).

It must, however, be noted that a mere barren general suggestion published in some book will not avoid, for want of novelty, a subsequent practical application of it in an invention productive of beneficial results. The principle laid down in the cases (*b*) decided upon this point cannot be better stated than in the language of Mr. Justice Grove in *Philpott* v. *Hanbury* (*c*). "I am willing to rest my definition or description of what anticipates a patent on this: that there must be a publication which, when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it, perhaps, to those in the trade who are most skilled—the higher class of skilled workmen), would enable them to understand it. If it be such, it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description, that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent. But if it reasonably discloses what the invention is, so that a person skilled in the trade can practice the invention from it, then I am of opinion that there is anticipation."

Imported foreign books.

The importation of a foreign book into this country, containing a description of an invention, would not be sufficient to defeat a subsequent patent for it, unless the work was actually published and sold here prior to the date of the patent; *or* deposited in some place to which the public can, and naturally do, resort for information upon such subjects. In either case the book must be written in a language generally understood.

(*y*) 1785, Dav. P. C. 61; 1 Web. P. C. 64; 1 Carp. P. C. 53.

(*z*) 1818, 2 B. Moo. 449; 8 Taunt. 375; 1 Web. P. C. 244.

(*a*) Cp. also *Gibson* v. *Brand*, 1842, 1 Webs. P. C. p. 628; per Tindal, C. J., *The Household Co.* v. *Neilson*, 1843, 1 Web. P. C. 718, n.; *R.* v. *Steiner*, 1851, 40 Newton's London Journal, 71.

(*b*) *Betts* v. *Menzies*, 1857, 1 E. & E. 1038; 10 H. L. C. 157; 31 L. J. Q. B. 233; *Hills* v. *Evans*, 1862, 31 L. J. Ch. 463; 8 Jur. N. S. 529; 6 L. T. N. S. 93; *Betts* v. *Neilson*, 1868, L. R. 3 Ch. 429; 37 L. J. Ch. 321; *Neilson* v. *Betts*, 1871, 5 H. L. 2; 40 L. J. Ch. 317; *Plimpton* v. *Malcolmson*, 1875, per Jessel, M. R., 3 Ch. D. 566.

(*c*) 1885, 2 P. O. R. at p. 43.

Heurteloup's Patent (*d*). The deposit of a foreign work in the British Museum, containing the specification of a French patent for an invention, in great part the same as that for which a patent had subsequently been obtained in England, was sufficient to vitiate the latter patent on the ground of want of novelty.

The Household Company v. *Neilson* (*e*).—Lord Brougham's statement, "It must not be a foreign book," is qualified and explained by the succeeding clause "but published in England."

Otto v. *Steel* (*f*).—Here the defendant sought to give in evidence, in proof of anticipation, a French book which was in the Inner Library of the British Museum. It was held by Mr. Justice Pearson that as the defendant adduced no evidence of such book having been actually used, or of any other copies of it having been introduced into England, it was inadmissible. On this point Justice Pearson said: "The question is, whether or not this book has been published in this country in such a way as to become part of the public stock of knowledge in this country. It is not, to my mind, necessary for that purpose to show that it has been read by a great many people, or that any person in particular has got from it the exact information which it is said would have enabled Dr. Otto" (the plaintiff) "in this case to have made his engine. But to my mind it must be published in such a way as that there may be a reasonable probability that any person, and amongst such persons Dr. Otto, might have obtained that knowledge from it."

Cases on prior publication in specifications.

Jones v. *Berger* (*g*). "I think it is an objection to the patent, and not evidence simply of an objection, that there has been a previous patent and a specification enrolled, and therefore published, being enrolled, containing the invention."

Muntz v. *Foster* (*h*). If a patentee has had his mind furnished with the material of his invention by a prior specification, and has merely put it into a more detailed shape, it would neither be a new invention, nor would he be the first and true inventor.

Dobbs v. *Penn* (*i*). A patent granted to A. for "improve-

(*d*) 1836, 1 Web. P. C. 563.

(*e*) 1843, 1 Web. P. C. 718, n.

(*f*) 1886, 3 P. O. R. 109. If a person has drawn a picture of a machine without describing it, and published that picture in a book, and that picture was one which any mechanist would understand, and make a machine from that picture alone, then a person cannot take out a patent in respect of a machine substantially the same: per the Master of the Rolls, *Herrburger* v. *Squire*, 1889, 6 P. O. R. 194. See also *Lang* v. *Gisborne*, 1862, 21 L. J. Ch. 769; and *Plimpton* v. *Malcolmson*, 1875, L. R. 3 Ch. D. 531.

(*g*) 1843, 1 Web. P. C. 550; 6 Scott, N. R. 219, per Maule, J.; cp. *Cornish* v. *Keene*, 1835, per Tindal, C. J., 1 Web. P. C. 510; *King* v. *Anglo-American Brush Co.*, 1889, 6 P. O. R. 423.

(*h*) 1844, 2 Web. P. C. 107.

(*i*) 1849, 3 Exch. 427.

Prior publication in specifications.

ments in the construction of racks and pulleys for window blinds, and other useful purposes," besides claiming a mode of making the frames by constructing them in a particular manner of drawn open metal tubes, claimed a mode of fixing the pulley in the frame by turning the knob of the spindle upon which the pulley revolved, and thereby of screwing a piece of metal, made to slide within the frame, tight to the edge of the frame, by which means the pulley spindle became firmly fixed to the frame. By a patent previously granted to B., the same object was effected by a similar method, but with the addition merely of a piece of thin metal, called an escutcheon, which worked outside the frame; but the specification stated that the pulleys might be made without the escutcheon. It was held that the two patents were substantially the same as to one of the things claimed, and therefore that A.'s patent was void.

Betts v. *Menzies* (*i*). "To defeat a new patent, it must be clear that the antecedent specification disclosed a practical mode of producing the result, which was the object and effect of the subsequent discovery."

Publication by provisional specification.

Laurence v. *Perry* (*j*). The plaintiff, as assignee of a patent for "improvements in lead and crayon holders," brought an action for infringement against the defendants, who alleged that there had been prior publication of the invention, *inter alia*, by fifteen specifications. It was held by Justice North, that two of these specifications anticipated the plaintiff's patent, which was therefore declared invalid. In dealing with one of the specifications, his lordship said (*k*), that the "publication of a provisional specification may be a sufficient anticipation of a subsequent patent is clear from the remarks of Sir George Jessel in *Stonor* v. *Todd* (*l*), if any authority were necessary on such a point. In this case . . . . I find a clear description how to construct an instrument which is completely covered by the first claiming clause of the plaintiff, and this is, in my opinion, quite sufficient to prevent their being subsequent first and true inventors within the realm of the instrument so described." Anticipation of an invention by a foreign specification published in England has already been mentioned on the last page. A leading case upon the subject is:—

United Horse Nail Co. v. *Stewart & Co.* (*m*). The only ques-

(*i*) 1858-62, 10 H. L. C. 117, per Lord Westbury.
(*j*) 1885, 2 P. O. R. 179.
(*k*) At p. 187.
(*l*) 1876, L. R. 4 Ch. D. 58; 46 L. J. Ch. 32.
(*m*) 1885, 2 P. O. R 133, per Lord Kinnear, distinguishing *Plimpton* v. *Spiller*, 1876-77, L. R. 4 Ch. D. 286, where an American book, said to have been de-

tion, therefore, is whether the American specification has been shown to have come within the knowledge of persons interested in the subject-matter in this country. *A.'s* evidence is that a full copy of the specification and drawings, as contained in a volume which he exhibited, was deposited in February, 1876, in the Library of the Patent Office; that the library is open to the public, and that the volume was so placed as to be accessible to all persons making use of the library. It appears to me that a specification deposited for so long a time in the public library of the Patent Office must be considered to have been brought within the knowledge of persons interested in the subject of the patent.

American specification in Patent Office Library.

A strong *primâ facie* case of novelty, attested by commercial success, will not be defeated by the mere production of models anticipating the patentee's invention—no proof being given as to the persons by whom the instructions under which, and the purpose for which, such models were made (*n*).

In *Herrburger* v. *Squire* (*o*), an invention which was held to be merely the adjustment in a more beneficial manner of the distance between two of the working parts of a known machine, was held to be anticipated by a drawing in a previous specification which showed the same position of parts, though the subject of that invention was the substitution of metal for wood.

Where the only anticipation alleged is by description in a specification or otherwise, it must be such as would enable any competent person to make from it the machine for which protection is claimed (*p*).

Previous description must be adequate.

A patentee does not anticipate himself by merely telling the public before the date of his patent that a particular result is desirable without disclosing any means of attaining it (*q*).

A patent is not anticipated by prior specifications dealing with analogous applications of the same subject-matter, but not describing a practical mode of producing the patented article (*r*).

posited in the Patent Office Library, was held by the Court never to have been there in the sense of being accessible to that portion of the public which consists of persons conversant with this particular subject.

(*n*) *Ehrlich* v. *Ihlee*, 1888, per Kekewich, J., 5 P. O. R., at pp. 206, 207.

(*o*) 1888, 5 P. O. R. 393.

(*p*) *Ehrlich* v. *Ihlee*, per Cotton, L. J., 5 P. O. R. 450. In this case, it appeared that circular cards and longitudinal bands were both well known and used in looms; and that longitudinal bands had been long used in musical instruments. It was held that there was invention in applying the circular cards to musical instruments.

(*q*) *Thomson* v. *Batty*, 1889, 6 P. O. R. 84.

(*r*) *Thomson* v. *American Braided Wire Co.*, 1889, 6 P. O. R. 518; *Winby* v. *Manchester, &c., Steam Tramway Co.*, 1889–90, 6 P. O. R. 559; 7 P. O. R. 30.

German specifications in Patent Office Library.

Harris v. *Rothwell* (*t*).—Two specifications, in the German language, of German patents for plaiting and knitting machines, together with drawings, were deposited in the Patent Office Library, the one considerably more than two years, and the other forty days, before a patent obtained in England. Entries of such specifications were duly published in the Patents Journal amongst the list of German Patents, and described therein as patents for plaiting and knitting machines, a footnote being appended to the list stating that the specifications might be consulted at the Free Public Library of the Patent Office. It was held that having regard to the facilities of access to the library, to the information given in the Patents Journal, and the length of time during which the specifications had been available for inspection, the question whether there had been previous publication in England so as to avoid the English patent must be answered in the affirmative; and that in determining a question of prior publication, it was immaterial whether the publication was in German or in English, or in any other language, so long as it was in a language generally understood (*u*).

Novelty—is it a question of evidence or construction.

Is the novelty of an invention a question of evidence or of construction? It is thought that the following proposition accurately expresses the law upon this subject (*x*).

Where the two inventions are described in common language which the judge is sure that he understands, and are plainly identical, "novelty" is a question to be determined by the Court alone; but where in the description of the two conflicting inventions there occur terms of art or commerce, upon which experts must be examined and evidence led, "novelty" is a question of fact, and must be determined by the jury if there be one.

(3) *Prior User.*

Prior user.

Prior user of an invention in public, by the public, or by the inventor himself, is sufficient to invalidate a subsequent grant.

(*t*) 1886, 3 P. O. R. 383; also 1888, 4 P. O. R. 225.

(*u*) Page 389; cp. also *Lang* v. *Gisborne*, 1862, per Romilly, M. R., 31 Beav. 135; 31 L. J. Ch. 769. Observations on that case per Jessel, M. R., in *Plimpton* v. *Malcolmson*, 1875, L. R. 3 Ch. D. 561; *United Telephone Co.* v. *Harrison*, 1882–83, L. R. 21 Ch. D. 720; 51 L. J. Ch. 705.

(*x*) *Bramah* v. *Hardcastle*, 1789, Holroyd, 81; 1 Carp. P. C. 168; *Cornish* v. *Keene*, 1837, 1 Web. P. C. 519; 2 Hodg. 294; 3 Bing. N. C. 588; *Elliott* v. *Aston*, 1840, 1 Web. P. C. 222; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 107; *Booth* v. *Kennard*, 1856–57, 2 H. & N. 95; *Betts* v. *Menzies*, 1857–58, 10 H. L. C. p. 152, per Lord Westbury, L. C.; *Thomas* v. *Foxwell*, 1858–59, 5 Jur. N. S. 37; 6 Jur. N. S. 271.

Reasons for the rule.

The reasons for this rule cannot be better stated than in the language of Hindmarch (*y*), "A public use of an invention is sufficient to avoid a subsequent patent for it for three reasons: *firstly*, because the public use of an invention is evidence of a public knowledge of it; *secondly*, because the Statute of Monopolies expressly requires that an invention granted by patent shall be such as others (than the inventor), at the time of making the patent or grant, *do not use;* and *thirdly*, because every patent expressly requires that the invention comprised in it shall be new as to the public use of it."

Prior public user.

The novelty of an invention is destroyed by prior public user of the same or a similar invention.

Carpenter v. *Smith* (*z*). This was an action for the infringement of a patent for improvements in locks. It was shown that a lock substantially the same as the plaintiff's had been put upon a gate in a public place, and used by Mr. Davies for many years before the date of the patent. Verdict for the defendants at *nisi prius*. Motion for a new trial on the ground of misdirection dismissed by the Court of Exchequer (*a*).

Disclosure with user.

There must be *user* of the invention, and there is no user in the eye of the law without evidence of both *disclosure* and *actual use*.

Cases.

Dollond's Patent (*b*). Case for the infringement of a patent for a new method of making the object-glasses of refracting telescopes. At the trial it was proved that one Dr. Hall had made such glasses in 1720, but had not disclosed the secret. The patent was supported.

Bentley v. *Fleming* (*c*). Case for the infringement of a patent of 21st December, 1841, No. 9207, for improvements in machinery for making cards for carding cotton, &c. It was contended by the defendant that the patent was avoided by the public use of the machine in a public room before the grant, and that a machine which was in complete working order for a long period before the grant was not the subject for a patent. Justice Cresswell overruled both objections, and as to the latter, which

(*y*) Page 108.

(*z*) 1842, 1 Web. P. C. 534, 540; 9 M. & W. 300.

(*a*) Cp. *Stead* v. *Williams*, 1843, 2 Web. P. C. 136; *Stead* v. *Anderson*, 1846, 2 Web. P. C. 146; *Heath* v. *Smith*, 1854, 2 Web. P. C. 268; 3 E. & B. 256; 2 C. L. R. 1584; 18 Jur. 601; 23 L. J. Q. B. 167; *Re Adamson's Patent*, 1856, 6 De G. M. & G. 420; 25 L. J. Ch. 456. See an interesting comment on *Carpenter* v. *Smith*, in Hindmarch, p. 111.

(*b*) 1776, cited 2 H. Bl. 470, 487; Parl. Rep. 182; 1 Web. P. C. 43. See also this case commented upon in Godson, Patents for Inventions, p. 62; and in *Boulton and Watt* v. *Bull*, 1793–99, Dav. P. C. 162.

(*c*) 1844-45, 1 Car. & K. 587; 1 C. B. 479.

is the one in point, said, "You cannot contend that if a man were to keep his invention shut up in a room for twenty years, that circumstance merely would deprive him of his right to obtain a patent for it."

Betts v. *Menzies* (*d*). Here the plaintiff had manufactured a quantity of the capsules—which were the subject-matter of his patent—before the date of the patent, but the manufacture was not carried on openly in the course of business, and none of the capsules had been sold. Held, that there was no "user" of the invention.

User in public necessary.

Again, the invention must have been used *in public*. The language of Baron Pollock, in *Croysdale* v. *Fisher* (*e*), is of considerable importance, as bearing upon the definition of the term "public." "It is obvious that in almost all cases of user, it does not profess that there is a publication to the world, as there is in the case of a specification, or in the case of a book that is largely disseminated; because the more, perhaps, as different modes of refinement, variations and improvements continue to multiply, the more does it happen that one portion of the manufacturing world does not know what is going on or what is being done by another portion. Certainly, still more does the public not know with very great nicety, unless concerned either as manufacturers or traders, what is going on in the different laboratories or manufactories attached to any particular trade. When it is said that a process has been disclosed, or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public, that is to say, in such a way as contradistinguished from a mere experimental user, with a view of patenting a thing which may or may not be existing."

Test of prior user sufficient to avoid patent.

In *Humpherson* v. *Syer* (*f*), Lord Justice Fry suggests what, it is submitted, will be found to be an accurate test whether or not there has been prior public user of an invention. Is it a fair conclusion from the evidence that some English people, under no obligation of secrecy, arising from confidence or good faith towards the patentee, knew of the invention at the date of the patent?

(*d*) 1857-62, 8 E. & B. 937; 1 E. & E. 990, 1008; *Betts* v. *Neilson*, 1868–71, per Lord Chelmsford, L. C., 3 Ch. 431.

(*e*) 1884, 1 P. O. R. at p. 21.

(*f*) 1887, 4 P. O. R. 407. In *Tickelpenny* v. *Army and Navy Co-operative Society*, 1888, 5 P. O. R., at p. 410, Kekewich, J., doubted whether, having regard to *Humpherson* v. *Syer*, *supra*, the mere preparation and discussion of plans between directors and their architects could be an anticipation. See instances of prior user, *Hutchison* v. *Pattullo*, 1888, 5 P. O. R. 351; *Podmore* v. *Wright & Co.*, 1888, *ibid.* 380; *Hollins* v. *Capper & Co.*, 1888, *ibid.* 289; *Edmond's Patent*, 1889, 6 P. O. R. 353.

Notorious prior user of an invention may invalidate subsequent letters patent, although such user has been discontinued before the date of the patent grant (*g*). If the prior user, however, was discontinued under such circumstances that the invention was entirely lost sight of, and unknown to the public, a different question would be raised (*h*).

Mere experimental user.

Jones v. *Pearce* (*i*). The patent related to the application of the suspension principle to the wheels of carriages. At the trial it appeared that a pair of wheels on the suspension principle had been made by a Mr. Strutt in 1814, and applied to a cart used for carrying stones on the public roads. Mr. Justice Patteson directed the jury: "If this wheel, constructed by Mr. Strutt's order in 1814, was a wheel on the same principles, and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that was used openly in public, so that everybody might see it, *and the use had continued up to the time of taking out the patent* (*k*), undoubtedly that would be a ground to say that the plaintiff's invention was not new. But if you are of opinion that Mr. Strutt's invention was an experiment, that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and no one else followed it up, and that the plaintiff's invention which came afterwards was his own invention, and remedied the defects of Mr. Strutt's wheel, then there is no reason for saying that the plaintiff's patent is not good."

Murray v. *Clayton* (*l*). "I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out a failure, can be held to affect the rights of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines."

A worthless and abandoned experiment may be an anticipation of a subsequent invention if it describe that invention in terms which fully and sufficiently disclose it, and the manner in which it is to be practised (*m*).

(*g*) *The Househill Co.* v. *Neilson*, 1843, 1 Web. P. C. 709, 710, 717; *Morgan* v. *Windover*, 1888, 5 P. O. R. 296.

(*h*) Cp. Lord Lyndhurst, L. C., at p. 717, *supra*; also *Carpenter* v. *Smith*, 1841–42, per Alderson, B., 1 Web. P. C. 534; *Shaw* v. *Jones*, 1889, 6 P. O. R. 336.

(*i*) 1832, 2 Coop. Ch. Ca. 58; 1 Web. P. C. 121.

(*k*) As to this, see the comment of Baron Alderson in *Carpenter* v. *Smith*, *ubi supra*.

(*l*) 1872–73, per James, L. J., L. R. 7 Ch. at p. 581.

(*m*) *Kaye* v. *Chubb*, 1888, 5 P. O. R. 641; cp. *Haslam Co.* v. *Hall*, 1888, 5 P. O. R., at p. 19; *Barlow* v. *Baylis*, 1870, Griffin P. C. 44.

Experimental user.

The utilisation for electric lighting of a product previously discovered in experiments unconnected with electric lighting, has been held to be good subject-matter for a patent (*n*).

The novelty of an invention is not destroyed by prior experimental, or confidential user.

Lewis v. *Marling* (*o*). Action for the infringement of a patent for certain improvements on shearing machines. It was proved by the defendant that the specification of a similar machine had previously been enrolled in America, that a model of an exactly similar machine had been exhibited to three or four persons in England, and that a manufacturer in England had commenced the construction of a machine from the American specification. Patent supported (*p*).

Bentley v. *Fleming* (*q*). If the inventor of a machine lend it to another in order to have its qualities tested, and that other use it for some weeks in a public workroom, this is not giving the invention such publicity as to deprive the inventor of his right to obtain letters patent for it.

Newall v. *Elliott and Glass* (*r*). "Is an experiment performed in the presence of others, which not only turns out to be successful, but beneficial, in the particular instance, necessarily a gift of the invention to the world? We think it is not. . . . A necessary and unavoidable disclosure to others, and, as here appears, if it be only made in the course of mere experiments, is no publication; although the same disclosure, if made in the course of a profitable use of an invention previously ascertained to be useful, would be a publication."

Confidential user.

Morgan v. *Seaward* (*s*). Patent for certain improvements in steam engines, and in machinery for propelling vessels. It was proved at the trial that before the date of the patent, Galloway,

(*n*) *Edison & Swan Co.* v. *Holland*, 1888, 5 P. O. R. 482.

(*o*) 1829, 4 C. & P. 55; 1 Web. P. C. 492; 1 Carp. P. C. 477; also 10 B. & C. 26; 5 M. & R. 69; cp. *Bramah* v. *Hardcastle*, 1789, Holroyd, 81; 1 Web. P. C. 44, n.

(*p*) The decision in this case has been doubted (cp. *Carpenter* v. *Smith*, 1 Web. P. C. 543; and *Morgan* v. *Seaward*, 1 Web. P. C. 190; 2 M. & W. 553); and to say, as Lord Tenterden is reported, in 4 C. & P. 52, to have said, that an invention must be *generally* known or used in order to avoid a subsequent grant of it by patent, would certainly be inaccurate. It is sufficient if it was *publicly* known or used before the date of the patent. *Carpenter* v. *Smith*, 1842, 1 Web. P. C. 534, per Abinger, C. B.

(*q*) 1844, 1 C. & K. 587; cp. also *Galloway* v. *Bleaden*, 1839, 1 Web. P. C. 524, per Tindal, C. J.; *Smith* v. *Davidson*, 1857, 19 C. B. 691; *Hills* v. *London Gas Light Co.*, 1860, 5 H. & N. 336.

(*r*) 1858, 4 C. B. N. S. p. 293; 27 L. J. C. P. 337, per Byles, J. See also *In re Adamson*, 25 L. J. Ch. 456.

(*s*) 1837, 2 M. & W. 544; 1 Web. P. C. 187; H. & M. 55; 1 Jur. 527.

the patentee, ordered an engineer, under an injunction of secrecy, to make two pairs of paddle wheels upon the principle of the patent. The wheels, when completed, were packed at the engineer's factory and sold to and exported by the plaintiff, who was the assignee of the patent, and the managing director of a foreign company by whom the paddle wheels were used *abroad*. The plaintiff paid the engineer for the wheels. It was held: that there was no use of the machine as a machine in England, or indeed abroad, *before* the date of the patent; and that there had been no use or exercise "in public" of the mode of constructing the machine.

Prior public sale.

The novelty of an invention is destroyed by the prior public sale in this country of the same or a similar invention, whether manufactured here or abroad (*t*).

Wood v. *Zimmer* (*u*). Here the patent was for a new mode of making verdigrease, to be called *British* Imperial Verdigrease. It was shown that the patentees had sold an article composed precisely in the same manner as that for which the patent had been obtained, under the name of *Dutch* Imperial Green. The patent was pronounced against.

Losh v. *Hague* (*x*). The publicly making and selling an article to one individual, though there be no demand or use for it by the public, will vitiate a subsequent patent.

Hancock v. *Somervell* (*y*). An invention may come into public use by being handed about the country for the purpose of attracting customers, although no actual sale has taken place.

Jensen v. *Smith* (*z*). J., in 1878, took out a patent for a lubricating apparatus, and in 1885, brought an action against S. for infringing it. It was proved at the trial that, prior to the date of the patent, lubricators substantially similar to the patented invention had been sold in England by the agents of a foreign firm; and that lubricators substantially similar to the patented invention had been used by a firm of engineers in England on

(*t*) *Lister* v. *Norton*, 1886, 3 P. O. R. 208—210; *Deutsche Nähmaschinen Fabrik &c.* v. *Pfaff*, 1890, 7 P. O. R. 16.

(*u*) 1815, 1 Holt, N. P. C. 60; 1 Web. P. C. 44; 1 Carp. P. C. 294; cp. the language of Gibbs, C. J., in this case. See also *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. 254, 399.

(*x*) 1838, 1 Web. P. C. 205.

(*y*) 1851, 39 New. Lon. Jour. 158; cp. also *Mullins* v. *Hart*, 1852, 3 Car. & K. 297; *Oxley* v. *Holden*, 1860, 8 C. B. N. S. 666; 30 L. J. C. P. 68, where Byles, J., expressed the *opinion* that the offering even a sample for sale was a *user*; *Lister* v. *Norton*, 1886, 3 P. O. R. 208—210; *American Braided Wire Co.* v. *Thomson*, 1888, 5 P. O. R. 120.

(*z*) 1885, 2 P. O. R. 249; *Fletcher* v. *Arden*, 1888, 5 P. O. R. 46.

machines used by them. It was held by Kay, J., that the patent was bad upon both grounds.

In *The American Braided Wire Co.* v. *Thomson* (*a*), the owners of a patent for improvements in bustles or dress improvers, which consisted substantially in the application of tubular sections of braided hard wire to bustles, brought an action against the defendants, alleging that they had infringed, and asking for an injunction. The defendants admitted that they had made bustles identical with those made in accordance with the patent, but denied infringement, and alleged that the patent was invalid on the grounds (*inter alia*) that the alleged invention was not useful, and had been anticipated by prior user and publications, including among the latter the specification of one J., which specified certain applications of braided wire to satchel handles and other articles, and mentioned that the material might be applied to bustles. The defendants tendered no evidence in support of their allegations of inutility and prior user. It was held at the trial, that the alleged invention was only the application of the material specified by J. to an analogous purpose pointed out by the specification, and that the method of clamping the wires adopted by the plaintiffs was not sufficiently of an inventive character to save the patent. The plaintiffs appealed. On the appeal further evidence was admitted as to the state of public knowledge at the date of the patent, from which it appeared that one L. had specified the application of braided hard wire to cushions and pillows, that it was known that hard wire could be braided in the same manner as soft wire, *i. e.*, in a tubular form on a core, but that there had not been any use of tubular sections of braided hard wire within the realm. It was held that the invention was not anticipated by either of the alleged prior publications of J. and L., and that it was good subject-matter of a patent.

Anticipation may be proved by single witness.

Anticipation may be proved by a single witness. In *Badham* v. *Bird* (*b*), the owner of a patent for improvements in combined manhole covers and ventilators for sewers, brought an action for alleged

(*a*) 1888, 5 P. O. R. 113. In considering whether there is invention in applying an old article to a new subject, it is very material to consider whether the article is only described in print or is actually to be seen and handled, *S. C.*, at p. 123. Affirmed on appeal, 1889, 6 P. O. R. 518.

(*b*) 1888, 5 P. O. R. 238. See also *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. 254, 399. It is not necessary or proper to prove multiplied instances of anticipation, if one or two are sufficient. *Cole* v. *Saqui*, 1888, 5 P. O. R. 489; reversed on question of subject-matter, 6 P. O. R. 41; op. *Thomson* v. *Batty*, 1889, 6 P. O. R. 84.

infringement. The defendant put in issue the validity of the patent on the ground, amongst other things, of anticipation by prior user. At the close of the examination of the plaintiff, who was called as first witness, the defendant's counsel undertook to prove user of articles admitted to be similar in all essential points to the patented article. A witness was accordingly examined on behalf of the defendant who had superintended the manufacture of such articles for some years prior to the date of the patent. The learned judge dismissed the action.

SECT. 4.—UTILITY, &c.

Utility.

The grounds on which patents are granted (*c*), the common law (*d*), the Statute of Monopolies and all the recorded decisions (*e*), upon the point before and since the passing of that Act, make it clear that the subject-matter of a valid patent grant must be "useful and beneficial to the public." The absence of utility, as of novelty, in any *material* part of the invention claimed, will be fatal to the patent (*f*).

Cases.

Young v. *Rosenthal* (*g*). This was an action for the infringement of a patent for improvements in stays and corsets. Mr. Justice Grove charged the jury in the following terms:—"I think in law utility means an invention better than the preceding knowledge of the trade as to a particular fabric. It does not mean abstract utility. Therefore, even if you are of opinion . . . . that stays are very bad things, you must not say this is useless because stays are bad things."

Meaning of utility.

Losh v. *Hague* (*h*). This was an action for the infringement of

(*c*) See Form of Grant, p. 531.

(*d*) Shephard's Abridgment, Part III. 61; Coke, 3 Inst. 184.

(*e*) *Darcy* v. *Allin*, 1602, Noy, R. 182; *Edyeberry* v. *Stephen*, 1691, 1 Web. P. C. 35; Dav. P. C. 36; *Rex* v. *Arkwright*, 1785, Dav. P. C. 138; 1 Web. P. C. 72; *Turner* v. *Winter*, 1787, Dav. P. C. 151; 1 Term Rep. 605; 1 Web. P. C. 80; *Boulton* v. *Bull*, 1795, 2 H. Bl. 498; *Huddart* v. *Grimshaw*, 1803, 1 Web. P. C. 86; Dav. P. C. 278; *Manton* v. *Manton*, 1815, Dav. P. C. 348; *Bovill* v. *Moore*, 1816, Dav. P. C. 399; *Hill* v. *Thompson*, 1817–18, 8 Taunt. 401; 2 B. Moo. 457; 1 Web. P. C. 249; *Lewis* v. *Marling*, 1829, 10 B. & C. 28; 4 C. & P. 58; 1 Web. P. C. 497; *Minter* v. *Wells*, 1834, 1 Web. P. C. 129; *Russell* v. *Cowley*, 1835, 1 Web. P. C. 467; *Morgan* v. *Seaward*, 1837, 2 M. & W. 562; Mur. & H. 61; 1 Jur. 529; 1 Web. P. C. 597; *Re Cutler's Patent*, 1839, 1 Web. P. C. 426; *Crane* v. *Price*, 1842, 4 M. & G. 605; 1 Web. P. C. 411; *Walton* v. *Bateman*, 1842, 1 Web. P. C. 623; *Pow* v. *Taunton*, 1844, 9 Jur. 1056; *Simpson* v. *Holliday*, 1864, 20 New. Lon. Jour. N. S. 107, 120.

(*f*) *Lewis* v. *Marling*, 1829, 1 Web. P. C. 496, per Bayley, J., p. 496; *Morgan* v. *Seaward*, 1837, 1 Web. P. C. 197, per Alderson, B.; also 2 M. & W. 561, per Parke, B.; *United Horse Nail Co.* v. *Swedish Horse Nail Co.*, 1889, 6 P.O.R. 8.

(*g*) 1884, 1 P. O. R. 34.

(*h*) 1838, 1 Web. P. C. 202.

Cases on "utility."

a patent for certain improvements in the construction of wheels for carriages to be used on railways. The defendants pleaded, *inter alia*, "that the said supposed improvements are only trifling and insignificant alterations in the mode of making wheels before then known and in public use, and are not legal subjects for the grant of the said letters patent." In directing the jury, Chief Baron Abinger said, "I observe one of the pleas states that the improvements are something trifling and insignificant. If that is the improvement, you will consider whether it is worth a patent or not."

Neilson v. *Harford* (*k*). An invention to support a patent must be productive practically of some beneficial result, no matter how great, provided it is sufficient to make it worth while (the expense being taken into consideration) to adopt it.

Tetley v. *Easton* (*l*). Where a machine can do that which apparently no other machine can be got to do, it must be pronounced useful, even though its cost is very considerable.

Haworth v. *Hardcastle* (*m*). In an action for the infringement of a patent, the jury found as follows: "The invention is new and useful upon the whole; but they also find that the machine is not useful in some cases for taking off goods." Verdict for the plaintiff, subsequently supported by the Court of Common Pleas.

Cornish v. *Keene* (*n*). This was an action for the infringement of a patent for improvements in the manufacture of elastic goods or fabrics. Chief Justice Tindal said: "It is a circumstance in the case that it is found useful for surgical purposes. The patent, however, is not taken out for that purpose, and it would not be sufficient, in order to maintain the patent, on the ground of its being an improvement, to show that it was an improvement, in surgical cases, for bandages only, because the patent is not only confined to that, but they must also prove that it is generally an improvement with respect to the general uses of that fabric or manufacture which was intended, that is, with respect to braces, garters, and other articles that are made of it."

Evidence of utility.

Lucas v. *Miller* (*o*). "As to the utility, I have not heard much said; and if anything had been said I should have answered it as I have intimated already, by saying that better evidence of the

(*k*) 1841, 1 Web. P. C. 314.
(*l*) 1352, Macr. P. C. 63.
(*m*) 1834, 1 Web. P. C. 483; 1 M. & Sc. 732; 1 Bing. N. C. 189.
(*n*) 1835, 1 Web. P. C. 506; cp. also *Easterbrook* v *The G. W. Rail. Co.*, 1885, 2 P. O. R. 201; *Badische Anilin* v. *Levinstein*, 1885, 2 P. O. R. 73.
(*o*) 1885, 2 P. O. R., per Kay, J., at p. 160.

utility of an invention cannot possibly be had than the fact that the defendant has attempted to infringe it."

Attempts to infringe.

Pecuniary success, especially where the improvement claimed rests wholly or partially upon increased cheapness in production, is cogent, but not conclusive, evidence of utility (*p*).

Pecuniary success.

It may be shown, for example—as may happen in the history of even the most original and valuable inventions—that the inventions first claimed were immediately superseded by simpler constructions involving the same principle (*q*).

The mere fact of a thing being done which has not been done before is not sufficient to justify a patent. It must be a question whether there be sufficient invention to justify a monopoly being granted by the Crown (*r*).

Amount of invention.

Where there has been for some time a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained uncomplied with, is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem from the mere existence of the unsatisfied demand to have existed somewhere or in some shape (*s*).

The *utility* of an invention is a question of fact (*t*).

Utility a question of fact.

Where the judge of first instance held on the evidence that there was utility, the Court of Appeal refused to disturb his judgment (*u*).

Utility of separate claims.

Where there is general utility in an invention, it is necessary to show very little utility to support a second claim, which is only subsidiary, and it is not a fatal objection to the patent that one part of the claim is not so useful as the other (*v*).

Material part of invention of no utility.

In *United Horse Nail Co.* v. *Swedish Horse Nail Co.* (*x*), a patent was, however, held void on the ground that a part of the invention separately and distinctly claimed was of no utility.

(*p*) *American Braided Wire Co.* v. *Thomson*, 1888, 5 P. O. R. 113; *Ehrlich* v. *Ihlee*, 1888, 5 P. O. R. at p. 205; *Cole* v. *Saqui*, 1888, 5 P. O. R. 495; *Siddell* v. *Vickers*, 1888, *ibid.* 95; *Blakey* v. *Latham*, 1889, 6 P. O. R. 29; *Badische Anilin* v. *Levinstein*, 1887, 4 P. O. R. 449; *Edison Co.* v. *Holland*, 1889, 6 P. O. R. 257.

(*q*) Cp. *Renard* v. *Levinstein*, 1864, 11 L. T. N. S. 505; *Otto* v. *Linford*, 1881, per Jessel, M. R., 46 L. T. p. 41; *United Telephone Co.* v. *Bassano*, 1886, 3 P. O. R. at p. 313.

(*r*) *Britain* v. *Hirsch*, 1888, 5 P. O. R. 226.

(*s*) *Gosnell* v. *Bishop*, 1888, per Bowen, L. J., 5 P. O. R. at p. 158.

(*t*) *Hill* v. *Thompson*, 1817, 3 Mer. 630; 1 Web. P. C. 237; *Bloxam* v. *Elsee*, 1825, 1 C. & P. 565; *Cornish* v. *Keene*, 1835, 1 Web. P. C. 506; *Macnamara* v. *Hulse*, 1842, 2 Web. P. C. 128, n; Car. & M. 471.

(*u*) *Siddell* v. *Vickers*, 1888, 5 P. O. R. at p. 430.

(*v*) *Ehrlich* v. *Ihlee*, 1888, 5 P. O. R. 203, 455.

(*x*) 1889, 6 P. O. R. 8.

Subsequent inventions destroying utility.

A patent is not to be defeated because subsequent inventions have improved the patented article, or because, in consequence of such improvements, practically no articles were made in accordance with the specification (*y*).

Subject-matter must be vendible,

The subject-matter of a valid patent grant must be vendible—because, otherwise, the invention will not be *used*, and will therefore not give any new employment to the people, and the public will receive no benefit from the invention; and because the intent of the patent is to reward the inventor by means of the profit arising from making and selling the patent articles during the continuance of the privilege (*z*).

—and generally convenient.

An invention which is "mischievous to the State, to the hurt of trade, or generally inconvenient," cannot be the subject-matter of a valid patent (*a*).

Upon the grounds set forth in this proposition would be avoided a patent for an invention altogether useless: *Morgan* v. *Seaward* (*b*); and it has been said, a patent taken out so extensively as to deprive mechanics of the materials used in their trades (*c*); or to embrace *methods that may thereafter be discovered* of arriving at the result patented (*d*); and any patent for illegal inventions, such as a housebreaker's implement (*e*).

(*y*) *Edison Co.* v. *Holland*, 1889, 6 P. O. R. 277; *Thomson* v. *Batty*, 1889, 6 P. O. R. 84, 100.

(*z*) Hindmarch, pp. 101, 102; Godson's Patents for Inventions, pp. 65, 66; cp. also per Heath, J., in *Boulton* v. *Bull*, 1795, 2 H. Bl. 463; per Abbott, C. J., in *R.* v. *Wheeler*, 1819, 2 B. & Ald. 349; *Cornish* v. *Keene*, 1835, 3 Bing. N. C. 570.

(*a*) 21 Jac. 1, c. 3, s. 6.

(*b*) 1835–37, 2 M. & W. 544.

(*c*) Godson on Patents for Inventions, p. 87.

(*d*) Cp. *Walton* v. *Potter*, 1841, per Tindal, C. J., 1 Web. P. C. 601; 3 M. & G. 411; 11 L. J. C. P. 138; *Crossley* v. *Potter*, 1853, Macr. P. C. 245; *Curtis* v. *Platt*, 1863, per Lord Westbury, L. C., L. R. 3 Ch. D. 139; also 8 L. T. N. S. 657; 33 L. J. C. P. 255; 11 L. T. N. S. 245; 35 L. J. Ch. 852; L. R. 1 H. L. 337; *Dudgeon* v. *Thompson*, 1877, 30 L. T. N. S. 244; L. R. 3 App. Cas. 34.

(*e*) Hindmarch, p. 142.

CHAPTER V.

THE PATENT OFFICE.

SECT. 1. PATENT OFFICES BEFORE ACT OF 1852.
SECT. 2. THE GREAT SEAL PATENT OFFICE, 1852—1883.
SECT. 3. THE PATENT OFFICE UNDER ACT OF 1883.

WE propose to give in this Chapter an account of the offices in which the business of obtaining patents for inventions has been and is now conducted. In doing this the chapter will most conveniently be divided up in the periods marked out by the Act of 1852 and the Act of 1883.

SECT. 1.—PATENT OFFICES BEFORE ACT OF 1852 (*a*).

Under the early procedure for taking out letters patent for inventions—which was regulated partly by statute (27 Hen. VIII. c. 11),

(*a*) The account given is applicable to the procedure as it existed about 1837. For a satirical account of which, see *Bentham, Manual of Political Economy*, Chap. III., and Dickens' Poor Man's Tale of a Patent.

The history of patents is said to begin in the reign of Edward III., who appointed a committee to enquire into a scheme for obtaining the Philosopher's Stone, and granted a patent on it. Little or nothing is known at present of the number of patents granted from that date down to 1617, which is the date of the Woodcroft Series. There are three papers in The Antiquary (July, August, and September, 1885, by T. Fairman Ordish) relating to early English inventors in the reigns of Elizabeth and James I., and from glimpses which we obtain of early inventions in such works as the "Pleasant History of First Inventors" Lond. 1686, and Turner's "History of Remarkable Providences," Part III., London, 1697, it is evident that foreigners were in the habit of bringing their inventions over to England, presumably on account of the better protection afforded them by the common law. That the majority of inventions were actually brought over by the foreign inventors themselves, or imported by travellers from abroad, is probable. The Statute of James evidently is intended as an encouragement to the introduction of new arts in order to foster trade rather than as any acknowledgment of the inherent rights of an inventor in his own invention. The benefits which accrued from the Huguenot settlements in the reign of Elizabeth were probably felt at the time, and a similar protection had been accorded the weavers of Brabant in the reign of Edward III. There has been no systematic search made through the records prior to the time of Elizabeth, hence it is unsafe to dogmatise; but many works dealing with the subject of patents ignore the existence of such an early period.

The proviso of the patent, making it incumbent upon the inventor to file a description of his invention, was the most important modification of the patent system between 1621 and 1851.

Petition and declaration lodged at Home Office.

and partly by long established practice—there were six offices through which an application for a patent passed, before the grant was issued under the Great Seal. The petition and declaration were lodged at the *Home Office*. There was then a reference of the petition to the *Chambers of the Attorney or Solicitor-General* (*b*) for report. Upon the report of the law officer, the report was taken, with the petition, back to the Secretary of State for the Queen's warrant. This was an echo of the report, and gave authority to the law officer to prepare a bill. The warrant then issued, and was taken to the *Patent Bill Office* as an authorization for the preparation of the Queen's Bill. The Patent Bill Office was in Old Buildings, and afterwards in Serle Street, Lincoln's Inn: it was an office of the Attorney and Solicitor-Generals for the preparation of bills for patents which were to pass the Great Seal, and was usually, but incorrectly, called the Patent Office. The clerks of the Patent Bill Office were appointed by the Attorney-General for the time being, and prepared all bills for patents as his deputies. The Queen's Bill, which was a draft of the patent, having been duly prepared, and two copies engrossed, one for the Privy Seal Office, and one for the Signet Office, was taken to the Home Office, and laid before her Majesty by the Secretary of State for the sign manual, which was always affixed at the commencement of the instrument. The Queen's Bill was next taken to the *Signet Office* (*c*) to be passed (*d*). The signet was a royal seal which was always in the custody of the Secretary of State, and he had clerks under him called clerks of the signet, whose duty it was (*d*) to pass the Queen's Bill or to the *Privy Seal Office* within eight days after its receipt at the Signet Office. There were at first four clerks of the signet, who attended, in person or by deputy, in rotation for three months at a time; but the office of one was abolished, and the attendance of the remaining clerks was fixed at four months a year. The business of the office was chiefly transacted, however, by the record clerk. The Queen's Bill, which was compared with copy previously filed, was filed at the Signet Office as the warrant to the clerk of the signet to prepare the Signet Bill, and issue it to the Lord Privy Seal. The Signet Bill having been completed, was taken to the *Privy Seal Office*, which was in the same building as the Signet Office; and

Reference to Attorney-General.

Report of Attorney-General.

Queen's Warrant.

Patent Bill Office.

Queen's Bill.

Signet Office.

Privy Seal Office.

(*b*) Caveats were also entered at the chambers of the law officer.

(*c*) At 28, Abingdon Street, Westminster, and afterwards at Somerset House.

(*d*) 27 Hen. VIII. c. 11, s. 1.

the clerk of the Privy Seal, under the provisions of 27 Hen. VIII. c. 11, sect. 2, prepared the Privy Seal Bill, which, having been duly sealed by the Lord Keeper, or one of his officers in the case of his absence, was taken to the *Letters Patent Office*—the Patent Office properly so called—in Quality Court, Chancery Lane. Here the patent was prepared by the clerk of patents, in pursuance of the Privy Seal Bill, which then went to the *Lord Chancellor's Office* (*e*), and in due course the impression of the Great Seal was attached to it.

Patent Office.

Lord Chancellor's Office.

The fees on obtaining an English patent amounted to about 100*l.*; but if a protection was required in Scotland or Ireland, separate applications had to be made, and the fees were about 300*l.* in all. See *infra*, pp. 551—555.

The policy of this multiplication of offices is thus stated by Lord Coke (*f*): "Such was the wisdom of prudent antiquity that whatsoever should pass the Great Seal, should come through so many hands, to the end that nothing should pass the Great Seal, that is so highly esteemed and accounted of in law, that was against law or inconvenient; or that anything should pass from the King anyways, which he intended not, by undue and surreptitious means"(*g*). This reasoning obviously lost its force when letters patent came to be granted at the peril of the grantee, and when, after the introduction of the practice of enrolling a specification, the patentee was judged upon his own deed; but the number of offices was not reduced till the Patent Law Amendment Act of 1852, and these offices seem largely to have existed for the purpose of extracting fees from the patentee at the various stages. Under that statute they were reduced to the Office of the Commissioners of Patents, in which all proceedings took place.

Policy of multiplication of offices.

After having passed the Great Seal, the patent itself was delivered to the grantee, in order that he might have evidence of his title, and immediate possession of his privilege; and the patent was then enrolled from the Privy Seal Bill upon the rolls. The patent rolls were kept about two years in the *Enrolment Office*; thereafter they were transferred to the *Petty Bag Office*, along with the Privy Seal Bills and dockets, and having remained there till they were about fifteen years old, were finally sent to the *office of the Rolls*

Enrolment Office.

Petty Bag Office.

(*e*) Formerly, the Privy Seal Bill went to the Hanaper Office, but this stage was afterwards dispensed with—the Hanaper fees being paid over by the Clerk of Patents at the Great Seal.

(*f*) 2 Inst. 556.

(*g*) Compare 27 Hen. VIII., c. 11, Appendix, p. 624.

Office of Rolls Chapel.

Chapel, together with the Privy Seal Bills. In one of these three offices was also enrolled the specification, which, from about 1712 to 1852, a patentee was required to enrol within six months after the date of his grant. Up to 1st January, 1849, a specification might be entered at the Enrolment Office, the Petty Bag Office, or the Rolls Chapel, indifferently at the option of the patentee. There were, however, differences between these offices in points of detail. (1.) A specification intended to be enrolled in the Enrolment Office required to be acknowledged before a Master (ordinary or extraordinary) in Chancery. At the Petty Bag and Rolls Chapel Offices, no acknowledgment was demanded. (2.) After 1 & 2 Vict. c. 94, the Rolls Office became a branch of the Public Record Office, created by that statute, and an enrolment could be proved by an authenticated copy, whereas a specification in the Enrolment or Petty Bag Office required to be proved by an examined copy. (3.) At the Enrolment Office, specifications were entered upon what were called the Close Rolls, because upon those writs close were enrolled. In each of the other offices there was a roll, called the Roll of Specifications and Surrenders, upon which specifications and other instruments were entered together. (4.) By an alteration introduced by Lord Langdale, M. R., a party inspecting the rolls at the Rolls Chapel Office was allowed to take extracts from, or copy any part of, the enrolment of a specification in pencil. This facility was not enjoyed at either of the other offices. (5.) After 1st January, 1849, all specifications were, by order of Lord Langdale, M. R., enrolled at the Enrolment Office.

Enrolment.

Differences between Enrolment Office, Rolls Chapel, and Petty Bag Office.

Sect. 2.—The Great Seal Patent Office, 1852 to 1883.

Origin of 15 & 16 Vict. c. 83.

The Patent Law Amendment Act, 1852, was founded practically upon three bills, which were under consideration by a Select Committee of the House of Commons in 1851: (1) Lord Granville's Bill, (2) Lord Brougham's Bill, and (3) these two bills modified and consolidated by Mr. Webster, at the request of the Committee (*g*). In the last-named bill, it was proposed that the Patent Offices should be reduced to two in number. Mr. Webster thus expressed his views upon the matter before the Select Committee (*h*):—

"According to this bill, there would be but two offices.

(*g*) See a full account of the history of the Patent Law Amendment Act, 1852, *infra*, pp. 53 *et seq.*, and see Appendix, pp. 646—669.

(*h*) Report, &c., 1851, pp. 373, 374.

The Attorney-General expressed himself very anxious, in a consultation I had with him, the Solicitor-General being present, that there should be but one office; that appeared to me to be impracticable; first of all, there must be an office in the nature of a Record Office, to which the public should not be admitted; secondly, there must be an office which might be called the Commissioners' Office, to which the public will be admitted. Those two offices would register one against the other, and I think you could not reduce the number to less than two with security to the public. Then, having regard to the existing offices, the only office which is, in its present state, well adapted to the business, is the Great Seal Patent Office, and inasmuch as the patent is to bear date from the day of application, I think that the first application should be made at the Great Seal Office, and that that should be, as much as possible, the office of record, because the Lord Chancellor, in the event of any application being made to him, would have the original application in the same office with the warrant for granting the patent, which he must have also in his own office, unless the present practice be entirely changed: therefore I would suggest that . . . . the first application should be made to the Great Seal Patent Office, as the last must be there, and that all the intermediate proceedings, viz., the advertisement and the consulting of documents and indices by the public, and everything of a public nature, should be at what we may call the Commissioners' Office. I would suggest, therefore, that the petitions, declarations, and provisional specifications should be left at the Great Seal Patent Office. In consequence of a conference with the Attorney and Solicitor-Generals, and with Lord Granville, the bill was altered so as to leave it open to the commissioners to regulate all the proceedings from the commencement; but a strong desire exists to have the bill made as certain and definite as possible, and I think it will be found more convenient for the first step to be taken at the Great Seal Patent Office, inasmuch as the last step must be taken there."

In the parliamentary session of 1851, Mr. Webster's Bill, owing to its being returned too late from the House of Commons, was lost. But in the following year two other Bills were prepared, one for Lord Colchester—the Government having changed—the other for Lord Brougham, and the two resulted in the Patent Law Amendment Act of 1852, which constituted the Patent Commission. Sect. 1 provided that the commission should consist of Constitution

of Patent Commission.

certain *ex officio* commissioners, viz.: the Lord Chancellor, the Master of the Rolls, and the law officers of the Crown for England, Scotland, and Ireland, together with such other person or persons as may be from time to time appointed by Her Majesty by warrant under the sign manual (*i*). The consolidated Bill contained a provision for the appointment of examiners, which was struck out by the committee of the House of Commons, under the supposition that special commissioners would be appointed under sect. 1 above mentioned. Lord St. Leonards, L. C., Sir John Romilly, M. R., Sir Frederick Thesiger, A.-G., and Sir Fitzroy Kelly, S.-G., were the first four acting commissioners, and they brought the act into operation by various rules and orders issued from time to time. The first section of the Act, however, empowering the appointment of special commissioners became a dead letter; the law officers of Scotland and Ireland were excluded and compensated; and the practical result was to devolve the whole responsibility upon the Lord Chancellor, the Master of the Rolls, and the Attorney and Solicitor-Generals of England, whose other official duties were so numerous and engrossing as to prohibit their affording that attention to the development of a system confessedly so difficult as to be incapable of adequate administration without the co-operation of persons practically acquainted with its requirements (*k*).

Offices under 15 & 16 Vict. c. 83.

Under the provisions of the Patent Law Amendment Act, 1852, three separate offices for the passing of patents might have been either continued in operation or newly constituted—the Great Seal Patent Office, the office of the Attorney-General for making the warrants, both of which were already in existence, and the office of the commissioners, which was new. The commissioners, however, upon consideration, decided that one office only should be constituted for the whole business of passing the patents, and

(*i*) It is said that an actual attempt was made by the law officers to give effect to this provision, and that application was made to the Royal Society, Chemical Society and Institute to advise on the selection of one member from each society to act as examiners. As, however, it was proposed that the services should be given gratuitously, the proposal fell through. See Bramwell's Expediency of Protection for Inventions, 1875, p. 54.

(*k*) Report, &c., 1872, Appendix (p. 156). The sums paid by way of compensation to the Irish law officers, the Lord Advocate of Scotland, and their clerks, will be found in the Commissioners' Reports from 1854 to 1876 inclusive, when they were discontinued. In their Report of 1854 the commissioners say: "The law officers of Scotland and Ireland, not being in England at the commencement of the Act, took no part in the proceedings, and as the functions of these officers in respect of patents for inventions are entirely abolished, it is not to be supposed they will be called upon at any future time to act as commissioners": p. 3.

accordingly, they ordered (*l*) that their office should be combined with the Great Seal Patent Office; and by a subsequent order the Attorney and Solicitor-General directed that the warrant of the law officer should be made in the combined offices. The commissioners appointed the clerk of the patents for the time being to be the clerk of the commissioners, and upon him the whole duties of the office came to be imposed. They also, with the consent of the Treasury under the Act, appointed a staff of clerks, and an officer designated the superintendent of specifications, for the printing of specifications and other works. In pursuance of these orders the whole business of the commissioners relating to patents, from the petition for the allowance of provisional protection to the printing, publication, and sale of the specification, was conducted in one office. By the consolidation of the three offices a large saving was effected in the salaries of officers and clerks, and in the rent and furnishing of offices; the business was placed under the immediate control of the Lord Chancellor and the commissioners: they communicated with one office. Simplicity and uniformity of practice was secured, and the applicant had the great advantage of one office of resort and for information in all stages of the patent (*m*).

One office for patents.

The 4th section of the Patent Law Amendment Act, 1852, enacted that it should be lawful "for the Commissioners of Her Majesty's Treasury to provide and appoint from time to time proper places or buildings for an office or offices for the purposes of the said Act." The offices originally provided were the ground-floor rooms of the offices in Southampton Buildings, Chancery Lane, theretofore occupied by the Masters in Chancery, abolished by 15 & 16 Vict. c. 80.

Under the Act of 1852, the work of the Patent Office was as follows: It was divided into several departments, *the front or public office*, in which applications, &c., were left, and where office copies might be obtained or specifications inspected; the *Register office*, where documents were registered before being transmitted to the law officers; the *printing department*, under the superintendent of specifications; and the *sale department*, which was simply a warehouse, with some clerks who kept a record of the sales. There was a strong room, where patents were kept for fourteen years

Work of Patent Office under 15 & 16 Vict. c. 83.

(*l*) First set of Regulations, dated 1st October, 1852, r. VI. Cp. also Report, &c., 1865, p. 26.

(*m*) On 1st January, 1876, the Act 38 & 39 Vict. c. 93 came into operation, transferring to the Commissioners of Patents all powers, duties, and authorities of the Board of Trade under the Copyright of Designs Act.

prior to sending to the Record Office. Also the Free Library and the Museum at South Kensington.

Procedure under Act of 1852.

The procedure consisted of several stages (*n*); applications were made personally at the Patent Office, were duly registered, and then sent on to the law officers, who reported on them. On the receipt of the returned document from the law officers, notices to proceed were published in the Commissioners of Patents Journal, and at one time in the Gazette, and notices of opposition, if any, were entered and transmitted to the law officers for hearing. Then there might also be opposition before sealing, in which case the office acted in a similar manner. When all oppositions were removed, the patents were sent down by a messenger to be sealed, to the House of Lords, and thereafter were returned to the Patent Office, and kept till the agents or patentees called for them. Letters patent were often left for a long time in the Patent Office, on the ground of its security. All that was done, therefore, by the Patent Office, from the first application to the final sealing, was the mere receipt of documents, the advertising, and the transmitting them to the proper officer. Besides this "forwarding work," as it was called, the Patent Office prepared and published indexes (at first once a year, but latterly once a month), specifications, and the Commissioners of Patents Journal.

Indexes, &c.

Origin of Patent Museum.

The origin of the Patent Museum is thus traced by Mr. Cole, Secretary to the Science and Art Department, in his evidence before the Select Committee of 1865 (*o*). After the Exhibition of 1851, a considerable amount of public opinion began to be formed on the necessity of industrial education; memorials were presented from the great towns of England, noticing the advantages of the *Conservatoire des Arts et Métiers*, and the Central School of Arts and Manufactures at Paris, and praying that a great central college should be established in London, and that a museum of arts and manufactures should be formed at the college. These memorials were supported by resolution passed by the chief British jurors at the Paris Exhibition, and by the report of a committee appointed by the Commissioners of 1851 to consider the best mode of aiding in establishing a museum of inventions. Mr. Bennet Woodcroft (*p*), at that time professor of machinery at University College,

(*n*) For a tabular statement of the procedure, see p. 208, note (*b*), where an extract from the Register of Patents is given.

(*o*) Report, &c., 1865, pp. 116 *et seq.*

(*p*) Bennet Woodcroft's Evidence, *ibid.* at p. 3.

had a collection of models, partly belonging to himself, and partly lent to him for use at his lectures. Upon being appointed assistant to the Commissioners in 1852, he transferred some of those models to his own room at the Patent Office. The interest of the engineering public was aroused, and a very large number of other models was supplied to the Commissioners of Patents. The Commissioners of the Exhibition of 1851 were also in possession of many valuable models. The whole collection was preserved first in Kensington Palace, then in Gore House, and afterwards in the Iron Museum—popularly known as "The Boilers"—which was erected for the purpose of receiving it. This Patent Museum, which was opened to the public in 1855, had no connection with the Board of Trade, or the Science and Art Department, and it consisted solely of the collections given by the exhibitors of 1851 and the patent models belonging to Mr. Bennet Woodcroft and the Commissioners of 1851. It was found necessary, however, to remove the Science and Art Department out of Marlborough House in order to provide for the repairing of that place for the Prince of Wales, and the Marlborough House establishment, which had been open for four years, was then moved up to South Kensington, Parliament granting a vote of £10,000 for that particular purpose.

The Museum at Marlborough House having thus been transferred to the iron building, the Commissioners of 1851 handed over their collection to the charge of the Science and Art Department, and the rules which were in force at Marlborough House were put into force at Kensington. Owing, however, to a dispute between the Commissioners of Patents and the Science and Art Department, as to a rule enforced by the latter, making a charge of 6*d.* for admission to the Museum on three days of the week, part of the Museum buildings at South Kensington was reserved for the Commissioners of Patents and called the Patent Museum, to which the public were admitted without charge.

Mr. Bennet Woodcroft was superintendent of the Museum, as well as of specifications.

Origin of Patent Office Library.

In 1855 the Commissioners of Patents established a public library of research within the Patent Office. It embraced works of science in all languages, the publications of the commissioners, and publications connected with patented inventions throughout the Colonies. The library increased so rapidly by purchases and loans that there was soon not even standing room, and readers complained that they could not open out the drawings for the number of per-

sons who came. The library was choked up with a confused mass of specifications, some of the floors were nearly, and many of the tables were entirely, covered with books; and in consequence of the very cramped state of the room, and the impossibility of properly exhibiting the specifications, many inventions were frequently re-patented (*q*).

Journal. From the commencement of January, 1854, the Commissioners of Patents Journal was published on the evenings of Tuesday and Friday in each week; it contained the following information:—(1) grants of provisional protection for six months; (2) inventions protected for six months on deposit of a complete specification; (3) notices to proceed for patent; (4) patents sealed; (5) patents extended; (6) lists of foreign patents; (7) official advertisements and various notices.

Indexes. Under sect. 8 of 16 Vict. c. 5, the commissioners purchased for 1,000*l.* (*r*) Mr. Bennet Woodcroft's chronological and alphabetical indexes of all the specifications of patents enrolled in Chancery from 1617 to 1st October, 1852—14,359 in number. These were published in three imperial octavo volumes (*s*).

Specifications. The whole series of specifications of patents for reaping machines, from the first enrolled 4th July, 1799, firearms, cannon, shot, shells, cartridges, weapons, accoutrements, and the machinery for their manufacture, from the earliest recorded, 15th May, 1718, and the drawings accompanying the same, were printed and published. The old specifications of patents for the consumption of smoke in furnaces, and for the making of drainage tiles applicable to sewerage, were by order of the Home Secretary, and the specifications of patents for improvements in propelling ships, were by order of the Board of Admiralty, republished. Pending the publication of the old specifications, printed certified copies, for

(*q*) Cp. also the evidence before the Select Committee on Patent Office Library and Museum, 1864, p. 34, *Answer* 661. "At the present time you cannot get your books in the library; you cannot get your specifications, and when you go to buy them you have to wait two or three hours, and then to send again, because they lie all piled one on top of another, so as not to be accessible. The rooms in the houses hired in Cursitor Street are so crowded that her Majesty's Commissioners of the Board of Works, through their architect and surveyor, have refused to allow them to be loaded any more, lest they should break down. The floors are sprung one inch now. The iron store room at the back of the Patent Office, which is a mere temporary thing, is so full that the passages are being filled full of parcels of those specifications."

(*r*) Cp. Report of the Commissioners for 1852-53, p. 21. See a description of Mr. Bennet Woodcroft's Index, Report of Committee, 1851, p. 221.

(*s*) The sale branch was formerly in Southampton Buildings, and was afterwards removed to Cursitor Street.

evidence in Courts of justice, for the use of counsel, and for other purposes, of any of the old specifications might be obtained on application at the Patent Office, the applicant paying the cost of putting the drawings upon the stone, and colouring the number of prints he might require, and the commissioners paying the cost of letterpress and paper, or, in the absence of drawings, the applicant paying the cost of letterpress and paper.

Indexes to specifications.

Indexes of all specifications filed in the Patent Office under the new law were also made in continuation of Mr. Bennet Woodcroft's collection, and were published periodically. The chronological, alphabetical, and subject-matter form adopted by Mr. Woodcroft was followed. At first abstracts of the subject-matter of specifications were made under the authority of the law officers, and printed from time to time. Those abstracts were prepared by junior barristers, manufacturers, and others, patent agents being disqualified from making them. On 17th December, 1866, however, the Commissioners of Patents made an order (*t*), throwing this work on the inventor, and virtually on patent agents, who had no inducement to do it well, and frequently discharged the duty in a most perfunctory manner. There was no one whose duty it was to see that the abridgment was in conformity with the provisional specification. The rule was that the applicant with his specification deposited an abridgment or abstract of it, and then abstracts were published (*u*) in quarterly, and from 1st January, 1871, in weekly, volumes, and advertised in the Commissioners of Patents Journal. The weekly publication of abstracts adopted in 1871 gave increased facilities to persons making searches. Each number contained an index of the names of the applicants belonging to the abridgments in that number, and also an index of the subjects, and each successive index included all the preceding ones up to the end of the year, so that a person would not have to look at the indexes of twenty or thirty numbers, but could obtain all that he wanted from the index of the last number.

Abridgments.

Abstracts left by applicants.

How subject-matter indexes prepared.

Before the specifications of patents were printed by the commissioners, the subject-matter index was prepared from the titles only; afterwards it was made from the specifications themselves.

(*t*) See Commissioners' Report, 1866, p. 9.

(*u*) The volumes for the years 1867 and 1868, were published under the title of "Descriptive Index." In 1869 it was changed to "Chronological and Descriptive Index of Patents applied for and Patents granted." The publication was discontinued in 1875.

Copies of specifications sent to Edinburgh and Dublin.

Printed certified copies of all the specifications filed in the office, from 1st October, 1852, onwards, with coloured printed copies of drawings, were sent to the office of the Director of Chancery in Edinburgh, and the Enrolment Office of the Court of Chancery in Dublin, pursuant to the Act of 1852, and the Act of 16 & 17 Vict. c. 115, and these copies were open to the inspection of the public in the respective offices.

Assignments, &c.

Certified copies of all the patents passed since the commencement of the Act, and of the record books of assignments and licences, with copies of such assignments and licences, were also sent to the Chancery Offices in Edinburgh and Dublin, pursuant to the Act.

Sect. 3.—The Patent Office under Act of 1883.

With the view of providing for the due administration of the new Act, which invests the Patent Office with some of the functions of a Court of law, a joint committee was appointed in the autumn of 1883 by the Board of Trade and the Treasury, to advise as to the re-construction of the staff of the Office of the Commissioners of Patents, and as to the formation of a properly qualified staff of examiners. The recommendations of the committee having been generally approved, a staff, including the majority of the officers of the Commissioners of Patents staff, was appointed by the Board of Trade, with the approval of the Treasury, under the 82nd and 83rd sections of the Act, in readiness to undertake the work of the new office, which was open to the public at 10 a.m. on 1st January, 1884, as required by the third section of the Act (*v*).

Comptroller-General.

The whole office is under the control of the Comptroller-General of Patents (*x*), subject to the Board of Trade.

Examiners.

There is a large staff of examiners, who perform the examining functions thrown upon the office by the new Act. The growth of the examining staff is thus traced by the present Comptroller-General, in his evidence before the Select Committee of 1887 (*y*).

"Assistant-examiners" are the "examiners" of the Act.

"We started with one superintendent, with one assistant, and twenty assistant examiners. They are called in the Act examiners, but in the office assistant examiners. Then we found

(*v*) See 1st Report of the comptroller-general, 1884, pp. 3, 10, Appendix A. There were numerous competitors for the first application under the new Act. No. 1 was eventually obtained by a Scotchman who came from Glasgow, and arrived at the Patent Office overnight, and was the first person to enter the Office at its opening at 10 a.m. on the following morning.

(*x*) Mr. H. Reader Lack.

(*y*) Report, &c., 1887, p. 10.

that the superintendent was not able to manage the whole of the work, and he had two assistants, who were called examiners. We also had to increase the number of the staff, but it was a long time before we could get them. In 1884, the Treasury gave us permission to work overtime for so many months. At the end of 1884, we found that we were still not up to time, and we appointed another examiner, and some additional assistant examiners, bringing them up at the present time to one superintendent, one assistant, three examiners, and six assistants to examiners or supervisors, who are allowed a special duty pay (z) to assist the examiners. We have really one superintendent, one assistant superintendent, and three examiners, and then each examiner has two assistant examiners to assist; that is the present staff, and forty-six assistant examiners."

Distribution of business among examiners.

The distribution of the business of the Patent Office among these officials may now be shortly described. Upon the receipt of the application, after numbering and dating the application, the first thing that has to be done by the Patent Office is the examination of the specification and the application left with it. The papers are sent up from the registry-room to an official superintendent, who sorts them out according to the subjects which have been allotted to the different examiners. The examining staff, it should be remarked, is divided into three groups, and different subjects are assigned to different assistant examiners in those groups.

Duties of assistant examiners.

The duties of the assistant examiner at this stage are as follows:—(1) to see that the formal documents are in proper order; (2) to ascertain whether the nature of the invention has been fairly described, and the application, specification and drawings, if any, have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention; (3) to see that the specification describes one invention only. Under subsect. 5 of sect. 7 of the Act of 1883, the examiner was required to report to the comptroller as to the similarity of rival applications, in order that notice of interference, as it was called, might be given to the applicants. The reason for inserting that provision, which was done in committee, was this: patent agents said that there was a period in the existence of an application, that is, during the period of provisional protection, when they knew nothing about what was being done, while the Patent Office was in possession of that information, and therefore they

Rival applications.

(z) £50.

thought it only reasonable, when the examiner was looking through the applications for patents, that he should use some part of his knowledge for their advantage, and give the second person notice that a prior application had been made, in order that he might not waste his time and money in going on with the second application, if he thought fit. This notice of interference saved him the trouble of constantly watching the Patent Office Journal to see whether anything like his own was coming out, and directed his attention to a particular number of a particular year. The procedure relating to notices of interference had, however, many disadvantages. (a) If the second applicant published his complete specification before the first, the latter could adopt as his invention all the matter of the second application, though he might not otherwise have thought of it; (b) notice of interference was sometimes given when there was in reality no similarity; (c) on the other hand, owing to the necessary generality of the provisional specification, similarity between two inventions sometimes escaped notice; (d) this procedure made a serious drain on the examiners' time, and it was estimated that no less than ten assistant examiners were employed solely in carrying out this particular work. On the recommendation, therefore, of the Committee of 1887, sub-sect. 5 of sect. 7 was repealed by the Act of 1888, sect. 2.

Notice of interference.

Difficulties.

If the assistant examiner is satisfied that the specification and drawings have not been prepared in the prescribed manner, he makes a report to that effect by a minute attached to the specification. That minute is sent to one of the examiners, who either personally or by one of his duty paid assistants looks over it in a general way to see whether he thinks the assistant examiner is right. If he is right, the papers are passed over to the letter department, where a letter is drafted from the examiner's report, and is then sent down to be signed either by the comptroller-general or by the chief examiner, who therefore see all the requirements made by the office.

Report.

In the event of the examiner differing from the opinion of the assistant examiner as to the sufficiency of a specification, &c., the matter would be discussed by them, and in the event of their being unable to agree would be settled by the chief examiner.

If the assistant examiner reports that the requirements have been complied with, the specification is revised by one of the examiners, in accordance with an official minute of the Board of

Trade in 1884. The Committee of 1887 recommended that a revision from time to time of a percentage sufficient to ascertain that the work was being carefully and intelligently performed would meet all the requirements of the case. But this recommendation does not appear to have been yet adopted. The examiner's report would here be at once passed on to the letter department.

When the answer to the objection communicated by letter is received, it is registered according to date, and is then sent from the registry to the room of the same examiner who first dealt with it. If the applicant requests to be heard, or if the comptroller refuses the application and offers a hearing, the applicant and the examiner or assistant-examiner are heard at the Patent Office before the comptroller or chief examiner, from whose decision an appeal lies to the law officer. In the case of such an appeal, all the papers are transmitted to the law officer's clerk.

Hearing before comptroller.

Where a complete specification is left after a provisional, the two are referred to the same assistant examiner who had the first application. His duties are to see whether the complete specification has been prepared in the prescribed form, and to satisfy himself that the invention particularly described in the complete specification is substantially the same as that which is described in the provisional. The examiners used at first to examine the claims, but the comptroller-general was instructed by the law officers, on 31st March, 1885, that the examiners had no power under sect. 9, sub-sect. (1), to deal with the claims at the end of the complete specification, that their duty was confined to seeing that there were claims, and that they were not to compare them, or see that the description bore out the claims of the specification.

Second report of examiner where complete specification left subsequently.

The question is again considered whether a complete specification claims more than one invention (sect. 33). This point, however, has been dealt with on the provisional primarily, and is only indirectly dealt with on the complete, by the examination as to similarity with provisional.

The examining staff also assist the comptroller-general as expert assessors in the case of oppositions under sect. 11, and of amendments of specifications under sect. 18.

Duties of examiners in hearings before the comptroller.

The assistant examiner who reports whether the complete corresponds with the provisional specification, at the same time makes the index and the abridgment notes. Formerly, the abridgment

Index and abridgements.

Abridgments of specification.

work was done out of the office by special abridgers, and supervised by a small staff in the Patent Office. Since the 1st January, 1884, however, the assistant examiners have produced the abridgment and the index notes as they go along. The proceeding is as follows: When a complete specification has been passed by an assistant examiner, he writes an abridgment of the specification on a form for the purpose, and then, upon another form, he assigns the specification to one or more of the index headings in the key. This index and abridgment is further checked by the examiner or his deputy who checks the report.

At the present time, the indexing of a complete specification is completed by the assistant examiner to whom the specification is referred. The applications received at the office are distributed over a large number of headings in order to facilitate search; and the work of seeing that each application is fully indexed is considerable. When, however, the abridgment and the subject-matter index forms for any particular application have been filled in and countersigned, there is a complete index to that specification or abridgment for any publication the Patent Office may produce.

Patent Museum transferred to Science and Art Department.

In accordance with sect. 41 of the Act of 1883, the Patent Museum (*z*) and its contents were, on 1st January, 1884, transferred to the Science and Art Department, South Kensington, under whose management it has since remained (*a*). It no longer forms a separate section, but has been incorporated with the General Science Collections of the South Kensington Museum. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention, on payment to the patentee of the cost of the manufacture of the model, the amount to be settled in case of dispute by the Board of Trade (*b*). This power is rarely, if ever, exercised at the present time.

Models.

Library.

In addition to the printed specifications of British and many foreign and colonial patents, the library contains the best collection of works relating to the applied sciences at present accessible to the

(*z*) The Patent Museum is a collection of models, apparatus, and machines which have been the subject of patents.

(*a*) It is open to the public *free* daily, and the hours of admission are as follow:—

During January, February, November, and December, 10 a.m, to 4 p.m.

During March and October, 10 a.m. to 5 p.m.

During April, May, June, July, August, and September, 10 a.m. to 6 p.m.

The reading rooms of the free public library in the Patent Office are open daily from 10 a.m. till 10 p.m., except on Sundays, Good Friday and Christmas Day.

(*b*) Act 1883, sect. 42.

general public, and is especially rich in foreign technical and periodical literature. The annual number of readers is not far short of 100,000.

Publications of Patent Office Acts and Rules.

The following is a list of the more important of Patent Office publications so far as they relate to patents:—

1. The Patents, Designs, and Trade Marks Acts and the Rules made thereunder.

2. Specifications.

Specifications.

(a) 1617—1852:—

Specifications of inventions, disclaimers, &c., enrolled under the old law from A.D. 1617 to September 30th, 1852, comprised in 13,561 blue books, or 690 thick volumes.

(b) 1852—1883:—

Specifications of inventions, disclaimers, &c., deposited and filed under the Patent Law Amendment Act, from October 1st, 1852, to December 31st, 1883, comprised in about 130,000 blue books, or 3,005 thick volumes.

(c) 1884 (*and subsequent years*):—

Accepted complete specifications, amendments, &c., under the Patents, Designs, and Trade Marks Act, 1883 (*c*).

3. Indexes.

Indexes.

(a) Under the old law from 1617—1852:—

Chronological Index of titles. 2 Vols.

Name Index. 1 Vol.

Subject-matter Index (*d*).

(*c*) Down to the end of 1875 the specifications were printed uniformly in pica type, on paper of imp. 8vo. size, with outline lithographic reproductions of the drawings the same size as the originals. In 1876 a new system was adopted, whereby a smaller type was used, and the size of the drawings reduced by photo-lithography to the imp. 8vo. or 4to. size. The specifications were also put up into vols. of 100, for distribution among public libraries, &c., and each vol. was accompanied by a title page and index of authors and subjects. This index was discontinued in 1882. Prior to 1852 the provisional specification was unknown: from 1852 to 1883 all provisional specifications deposited were printed, but this was discontinued under sect. 4 of the 1885 Act. The number of these applications which never become patents is now nearly one half of the whole number of applications. The drawings are now mounted on a sheet of blank paper, so that they may be read continuously with the specification. The familiar blue covers have been discontinued since 1888. Only specifications of patents *in force* or dated *during last fourteen years* are kept in stock or will be printed at the expense of the office. Specifications of earlier patents which are out of print will be reprinted only at the cost of the purchaser.

(*d*) The following is a fuller account of the subject-matter Indexes:—

(i) Subject-matter Index of patents of invention, A.D. 1617—1852, 2 pts. (prepared from titles only).

Reference Index of patents of inventions, pointing out the books in which specifications, law proceedings, and other subjects connected with inventions have been noticed.

Appendix to the Reference Index, containing abstracts from such of the early patents and signet bills, as, in the absence of enrolled specifications, describe the nature of the invention.

(b) Under the Patent Law Amendment Act from 1852—1883:—

Chronological Index of titles, 1852—1868.

Chronological and Descriptive Indexes, 1867—1873.

Name Indexes, 1852—1883.

Subject-matter Indexes (*d*), 1852—1883.

(c) Under Patents Act, 1883, from 1884 to date:—

Name Indexes of applicants.

Subject-matter Indexes of applications, compiled from titles only, 1884—1887.

Subject-matter Indexes of accepted complete specifications (*d*).

Illustrated Official Journals.

4. Journals.

(a) The Illustrated Official Journal (*e*) of the Patent Office,

(ii) Subject-matter Index of patents applied for and patents granted, 1852—1883.

The Indexes for the years 1852—1870 were prepared from the specifications, and were in the form of a classified Index of subjects, accompanied by separate synopsis and key. The only Indexes for the years 1870—1873 were the Indexes intended to accompany the chronological and descriptive Indexes. From 1874 a fuller Index was again published down to 1883, the years 1882 and 1883 being made from titles only.

(iii) Subject-matter Index of applications for patents, 1884—1887 (discontinued after this date).

(iv) Subject-matter Index of accepted complete specifications, 1884—1886.

(v) Monthly consolidated subject-matter Index (in course of publication).

(*d*) See note (*d*), *ante*, p. 65.

(*e*) The following is a list of the journals of the Patent Office, past and present.

(i) Commissioners of Patents Journal, 1854—1883. 38 vols. imp. 8vo.

(ii) Official Journal of the Patent Office, 1884—1888. 10 vols. imp. 8vo.

Continued now in the Illustrated Official Journal.

(iii) Illustrated Journal of Patented Inventions (including complete specifications accepted), 1884—1887. Imp. 8vo.

Continued now in Illustrated Official Journal.

(iv) Reports of Patent Cases (after Vol. 3, including Reports of Design and Trade Mark Cases), 1884—1888. 5 vols. imp. 8vo.

Continued now in Illustrated Official Journal.

(v) Illustrated Official Journal (Patents), incorporating Nos. (ii), (iii) and (iv). From 1889, in continuation. Imp. 8vo.

The Commissioners' Journal commenced in January, 1854, and was published on the evenings of Tuesday and Friday in each week. It contained in-

published every Saturday, contains (1) applications for patents; (2) acceptances of provisional specifications; (3) acceptances of complete specifications; (4) patents sealed; (5) patents on which renewal fee has been paid; (6) patents void through nonpayment of renewal fee; (7) amendments; (8) abandoned and void applications; (9) designs registered; (10) official notices, advertisements and rules; (11) price lists of printed specifications; (12) index of names of applicants; (13) index of titles of applications; (14) Illustrated Journal of Patented Inventions; (15) Reports of Patent, Design, and Trade Mark Cases.

Catalogues, &c.

5.—(a) Catalogue of the Library of the Patent Office, arranged alphabetically in two volumes—Vol. I. Authors; Vol. II. Subjects.

(b) Index to all inventions patented in England from 1617 to 1852 inclusive, arranged under the greatest number of heads, with parallel references to inventions and discoveries described in the scientific works of various nations, as classified by Professor Schubarth.—By B. Woodcroft, F.R.S.

(c) Supplement to letters patent for inventions, granted from 1617 to 1852, consisting for the most part of reprints of scarce pamphlets.

Abridgments.

6. Abridgments of specifications, with a key thereto (*f*).

formation relating to each stage of patent procedure from the date of application to the voiding of the patent. In addition, the patent lists of leading foreign countries and colonies were translated and printed, with their laws and regulations, and much other useful information. In 1884 the scope of the work was restricted entirely to an official record of the various stages through which a patent has to pass. In the same year the Illustrated Journal, containing abridgments of all complete specifications accepted, and the Reports of Patent Cases, *both new publications*, were issued, the latter originally as a supplement to the Official Journal, but subsequently as a separate publication. In 1889 these three journals were merged into one, and the price of the amalgamated journal was fixed at 6*d*. for each number. Each section, however, at the end of the year forms a separate volume. The index to official section is divided into two parts, Part I. being the name index of applicants for the year; Part II. recording the different stages subsequent to the acceptance of the provisional specification. An inventor, therefore, by the annual payment of 1*l*. 15*s*. obtains—I. A name index of all applications for the year. II. A record of all official stages through which an application has to pass. III. An illustrated abridgment of accepted complete specifications. IV. Reports of all patent cases occurring in the year.

(*f*) Abridgments (in classes and chronologically arranged) of specifications of patented inventions, from the earliest enrolled to those published under the Act of 1852.

These books are of 12mo size, and each is limited to inventions of one class only. They are arranged so as to form at once a chronological, alphabetical and subject-matter index to the class to which they relate. Before applying for

Sale Office.

The Sale Office took the place of the Stationery Office in 1884, as the sole office for the sale of the Patent Office publications.

Contents of library.

In addition to the printed specifications, indexes, and other publications of the Patent Office, the library contains a collection of the leading British and foreign scientific journals, transactions of learned societies, and text-books of science and art.

a patent it is generally advisable to consult the classes of abridgments of specifications which relate to the subjects of the invention, and by the aid of these works to select the specifications which it may be considered necessary to examine in order to ascertain if the invention is novel. The preface of each volume explains (in most cases) the scope of the series of abridgments which it contains.

The majority of classes have been prepared as far as 1866, many as far as 1876, and a few down to 1883. The prefaces in the early volumes often contain a valuable introduction to the history of the Act, and are of considerable literary and antiquarian value. Since 1884 abridgments of specifications have appeared in the Illustrated Journal in chronological order.

CHAPTER VI.

OUTLINE PROCEDURE TO OBTAIN A PATENT.

Scope of chapter.

It is proposed in this chapter to give a general account of the procedure to obtain letters patent, without any reference to the statutes and judicial decisions. These are fully considered in the general body of this work, and in the notes to the Acts of 1883—1888.

The application.

A patent may be applied for—

Inventors.

(1) By one or more inventors;

(2) By one or more inventors with applicants who are not inventors, and in this case a corporate body may be one of the joint applicants;

Importers.

(3) By an importer from abroad, and apparently in conjunction with other applicants, if desired;

International arrangements.

(4) By an inventor with or without other applicants under the international and colonial arrangements, whereby the patent, when obtained, dates back to the date of the first foreign application.

Form of application.

The applicants desirous of taking out a British patent must first of all leave at the Patent Office an application in the proper form, which can be obtained either there or through any money order office in the United Kingdom.

Declaration.

The application (see Form A. to Patents Rules, 1890, Appendix, p. 737) consists of a declaration by the applicant that he is in possession of an invention for "improvements in," &c., or as the case may be, setting out the title of the invention; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of his knowledge and belief; and it concludes with a prayer that a patent may be granted in respect thereof.

Joint application.

Where an application is made by two or more persons jointly, the declaration must state which one of the applicants, or, if necessary, which two or more of them, is or are the inventor or inventors.

Importers.

The word "inventor" includes the *importer* of an invention communicated from abroad. An applicant for letters patent for a communicated invention ought to make use of Form A1 of the Patents Rules, 1890, *infra*, p. 738. But it would appear that an importer is entitled to make the declaration in Form A. (see p. 737), and not to disclose the fact that he is an importer. This point, however, has not been judicially decided. Advantage is taken by agents of the law as to importers, who, in the case of inventions communicated by clients abroad, frequently make the application in their own names on Form A1, and when the patent is sealed assign it, if desired, to their clients.

Communications from abroad.

Signature of applicant.

The application must be signed by the applicant himself, or, if more than one applicant, by each applicant, all further proceedings may be conducted through an agent duly authorized in writing. This authority may be given at the time of signing the application, or at any other time. Where one of the applicants is a company or corporation, the secretary or other principal officer should, after his signature, add the words, "for the ——" (naming the company or corporation). If a firm are applicants, each member of the firm should sign the application.

Authority to agent.

Applications under International Convention, &c.

An application under the international or colonial arrangements must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. It must be on Form A2 (see p. 739), and must be accompanied by a provisional or complete specification, like other applications. It must also be accompanied by a copy or copies of the specification and drawings, as filed in the patent office of the foreign state or British possession in respect of the first foreign application, duly certified by the official chief of such patent office, or otherwise verified to the satisfaction of the comptroller. There must also be a statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification be in a foreign language, a translation must be annexed to and verified by the statutory declaration (*a*).

Provisional or complete specification?

When filling up the proper form of application, the applicant should decide whether to leave a provisional (*b*) or a complete specification (*b*) in the first instance.

(*a*) Patent Office Circular.

(*b*) For forms, see p. 740.

The relative advantages of these two courses may be briefly stated.

Advantages of filing provisional specification with application.

An application for provisional protection involves less immediate outlay, and thus costs less to an applicant who desires for any reason to abandon his application before the date at which a complete specification becomes due.

The provisional specification is not accessible to the public until the complete specification has been accepted; and if the application for any reason is not completed, it is never open to the public at all. In case an inventor is unable or unwilling to proceed with his application, or is from any cause unwilling to do so, the provisional specification is not published. He is thereby enabled to repeat his application at any subsequent period he may think fit; always provided he has not by his own act rendered a subsequent application invalid by publication, by sale or user, or otherwise; and that between the date of his two applications an application has not been made by another inventor for an invention wholly or partly covering his.

In a provisional specification only a general description of the nature of the invention is required. The inventor has, therefore, time to mature the details of his invention, and is also able without the expense of a disclaimer to leave out of his complete specification any part of his invention which may have been anticipated.

A provisional specification is of use when an inventor—(a) wishes to bring his invention into the market at a trifling cost, and test its commercial value before patenting it; or (b) is still undecided as to whether he will file applications for letters patent abroad; or (c) desires to have before him the exhaustive report of the Patent Office Examiner in the United States in determining what to claim in his complete specification; or (d) when through fear of anticipation he desires to secure an early date for an invention, the details of which he has not had time to mature.

Only one invention in patent.

Only one invention may be comprised in a patent, but it is not competent for any person in an action or other proceeding to take any objection to a patent upon this ground when the specifications have been passed by the examiner.

When a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend it so as to apply to one invention only, and may make application for separate patents for each such invention accordingly. Every such application bears the date of the first application, unless

the comptroller otherwise orders, when the later applications may bear date on the days they are actually made.

Advantages of complete specification in first instance.

A provisional specification, on the other hand, protects an applicant merely against the objection that his invention has been anticipated by his own publication and use of it, before letters patent have been granted to him. It gives him none of the rights of a patentee. He cannot prosecute infringers unless and until he has obtained a patent, and even then an action will not lie in respect of any infringement committed before the date of the publication of the complete specification.

But after the acceptance of the complete specification, and until the date of sealing, or the expiration of the time for sealing the patent, the applicant has all the privileges of a patentee except an immediate right to institute legal proceedings.

Infringements committed after the acceptance of the complete specification are actionable; and an action may be brought whenever a patent has been sealed. After the acceptance of a complete specification an inventor is entitled to mark his invention as patented.

The mode of procedure by filing a provisional specification, although less expensive in the first instance, ultimately costs a little more than that by filing a complete specification at once, as two specifications have to be drawn. The stamp fees are the same in each case, 1*l.* being upon the application form and 3*l.* upon the complete specification. There is no stamp on the provisional.

A complete specification may with advantage be filed at once by an applicant whose invention is fully matured, who is anxious to put it in the market at once, and to secure himself from infringement, and who has decided for what foreign patents to apply.

Procedure at the Patent Office.

Date and number of application.

Upon the application being left at the Patent Office, the applicant gets an official receipt, bearing the date of application and a number, which become the date and the number of the patent itself, when ultimately granted. The specifications when filed have to be in duplicate.

Communications through post.

Papers may be transmitted to the Patent Office through the post by prepaid letter.

The application is advertised in the Illustrated Official Journal.

Each application is numbered in the order of its receipt; the numbers beginning with 1 at the commencement of every year.

First reference to examiner.

Every application is referred by the comptroller to an examiner, who ascertains and reports to him whether: (1) the nature of the

invention has been fairly described; (2) the application, specification, and drawings, if any, have been prepared in the prescribed manner; (3) the title sufficiently indicates the subject-matter of the invention; and (4) whether the specification describes more than one invention. Examiner's report.

These are the only points which the examiner has to ascertain. He is neither required nor entitled to pronounce upon the novelty or utility of the invention as described in the specification. No report as to novelty or utility.

The comptroller-general, however, may refuse to grant a patent for any invention of which the use would, in his opinion, be contrary to law or morality, and from such refusal no appeal is provided. Refusal of patent.

If the examiner report against the applicant upon any of the points mentioned above, the comptroller-general may require that the application, specification, or drawings be amended before he proceeds with the application. Amendment required.

Against this decision the applicant may appeal to the law officer, whose judgment is final. The fee payable for such an appeal is 3*l.* on Form T., Patents Rules, 1890 (*a*).

Before the Act of 1888, if, after an application had been made, but before a patent had been sealed, an application was made accompanied by a specification bearing the same or a similar title, it was the duty of the examiner to report to the comptroller whether the specification appeared to him to comprise the same invention. If the examiner reported in the affirmative, the comptroller was required to give notice to the applicants that the examiner had so reported, and thereafter might refuse to seal a patent to the second applicant. This refusal was liable to be appealed against to the law officer upon the usual terms. The Act of 1888 abolished these "notices of interference" (*b*), as they were called. Former notices of interference.

If, however, the examiner report in the affirmative upon each of the issues submitted to him, the application is accepted, and notice of such acceptance is given to the applicant. The number of the application and the name of the applicant is advertised in the Illustrated Official Journal (*c*). Acceptance of application, &c. Advertisement of application.

Subsequent procedure varies according as a provisional or complete specification is left in first instance by the applicant. An applicant who has filed a provisional specification only must, within When provisional specification left in first instance.

(*a*) See p. 586 and p. 749.
(*b*) See also p. 62.
(*c*) In case of any alteration in the title of the application it is again advertised in full.

Filing of complete specification subsequently.

nine months from the date of his application, deposit at the Patent Office a complete specification particularly describing (a) the nature of the invention, and (b) the best method known to the inventor of carrying it out, and ending with a distinct statement of the invention claimed. The comptroller has power to extend for one month, but no longer, the time for filing the complete specification, if he is satisfied that the delay required is reasonable. The fee payable for such extension is 2*l*.

Extension of time.

Abandoned application.

Unless a complete specification is left within the prescribed or extended time, the application is deemed to be abandoned.

A list of the numbers of abandoned applications is published monthly in the Illustrated Official Journal.

The complete specification.

A complete specification filed by an applicant who has already obtained provisional protection bears a stamp duty of 3*l*. It is filed in duplicate, and is at once referred by the comptroller to an examiner, in order to be compared with the provisional specification.

Report of examiner.

If the examiner report that the complete specification (1) does not fairly describe the invention; (2) does not terminate with a distinct claim or claims; (3) claims more than one invention; or (4) is substantially larger than that contained in the provisional, the comptroller may refuse to accept it unless and until amended to his satisfaction.

Amendment required.

From such a refusal the applicant may, on payment of a fee of 3*l*., appeal to the law officer, who may reverse or vary the order of the comptroller, and whose decision is final.

Complete specification must be accepted in twelve months.

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

Extension of time.

The comptroller will, however, enlarge the time for a period not exceeding three months on payment of fees of 2*l*., 4*l*., or 6*l*., according as the period does not exceed one, two, or three months.

Examination of claims.

Provided the specification ends with a statement of the invention claimed, distinct from the description of the invention, there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. There must be a real statement of the invention claimed; and if there is such a statement, it is not competent for the Patent Office to inquire whether it goes beyond or is in conformity with the description of the invention.

When provisional

When an application is accompanied with a complete specifica-

tion in the first instance, the necessary documents and drawings must be filed, and the full fee of 4*l.* is payable at once, being 1*l.* on the application and 3*l.* on the complete specification.

specification not filed.

When the complete specification, whether filed alone in the first instance or in pursuance of a previous provisional specification, has been accepted, the comptroller at once advertises the acceptance, and hands it to the Queen's printers for publication. The specification is usually printed within three weeks from the date of acceptance; and as a patent is not sealed until after the expiration of two months from the publication of the acceptance of the complete specification, there is ample time for inspection and if need be opposition by the public.

Acceptance of complete specification.

Specification printed.

The duplicates of the complete specification and the provisional (if any) and the application are open to public inspection from the date of the advertisement of the acceptance of the complete specification.

Inspection.

Printed copies of complete specifications may be purchased at the Patent Office (Sale Branch) for a small sum, generally not exceeding one shilling for each copy.

The patent, if unopposed, is sealed about ten weeks after the acceptance of the complete specification.

Sealing.

Within two months after the advertisement of the acceptance of a complete specification, any person may oppose the grant of a patent on any one or more of the following grounds:—

Opposition:

(1) That the applicant had obtained the invention from the opponent, or from some person of whom he is the legal representative;

Grounds of.

(2) That the invention had been patented in this country on an application of prior date;

(3) 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 and the leaving of the complete specification, but on no other ground.

The rules and practice relating to opposition may be shortly stated as follows:—

Notice of opposition.

Having settled the ground of his opposition, an opponent should fill in the proper form, Form D, Patents Rules 1890 (*d*), which

(*d*) Appendix, p. 741.

may be obtained at the Patent Office, and which should be signed by himself.

A notice of opposition must state the grounds on which the person giving it intends to oppose the grant of a patent, and the opponent's address for service in the United Kingdom.

If one of the grounds of opposition is that the invention has been patented in this country on a prior application, the title, numbers, and date of the patent so granted must be specified in the notice.

A notice of opposition bears a stamp of 10*s*.

Who may oppose. Any person may oppose before the comptroller-general, but only persons having a special interest in the patent will be heard on an appeal to the law officer.

Procedure. On receiving notice of opposition, the comptroller forwards a copy of the notice to the applicant.

Statutory declarations. Within fourteen days after the expiration of two months from the advertisement of the acceptance of the complete specification, an opponent may file statutory declarations in support of his opposition, and must deliver to the applicant a list thereof.

Within fourteen days from the delivery of such list, the applicant may leave at the Patent Office statutory declarations in answer, and deliver to the opponent a list thereof, and within seven days from such delivery the opponent may file statutory declarations in reply, giving the applicant a list of such declarations as before.

Further evidence. No further evidence may be left on either side except by leave of the comptroller, or by written consent of the parties duly notified to him.

The comptroller's leave will not be obtained unless he is satisfied that the further evidence it is desired to leave was not reasonably obtainable, or was not within the knowledge of the party within the time previously allowed.

The comptroller has power to extend the times above mentioned on such terms as he thinks fit.

The hearing. On the completion of the evidence the comptroller, on the application of either party, appoints a time for the hearing of the case, and gives the parties seven days' notice of such appointment.

Each party has to pay a fee of 1*l*. for the hearing.

The comptroller has no power to allow costs.

Comptroller's decision. The comptroller's decision is given in writing, is duly notified by him to the parties, and may be appealed against to one of the law officers.

Appeal to law officer.

Any person intending to appeal (*a*) to the law officer must file in the Patent Office a notice of such intention within fourteen days from the date of the decision appealed against, or within such further time as the comptroller may allow.

Such notice states the nature of the decision appealed against, and also whether the appeal is from the whole or a part, and if so what part of such decision.

A copy of the notice of appeal must be sent by the appellant to the law officer's clerk, at Room 549, Royal Courts of Justice, London, and also to the respondent. Upon notice of appeal being filed, the comptroller transmits all the necessary papers to the law officer's clerk, who gives at least seven days' notice to the parties of the time and place appointed for the hearing of the appeal.

Evidence.

The evidence used on appeal to the law officer is the same as that used at the hearing before the comptroller.

Further evidence.

No further evidence may be given (save as to matters which have occurred or come to the knowledge of either party after the date of the decision appealed against), except with the law officer's leave upon application for that purpose.

Cross-examination of declarants.

The law officer is required, at the request of either party, to order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter to which the appeal relates, unless, in his opinion, there is good ground for not making such order.

Conduct money.

When such an order is desired, a list of the persons whose attendance is required should be left with the law officer's clerk, with a request for an order; and copies of the list and the request should be sent to the other side. Any person requiring the attendance of a witness for cross-examination must tender to such witness a reasonable sum for conduct money.

Costs.

The law officer, in making an order as to costs, may either fix the amount, or direct by whom and in what manner the amount of such costs shall be ascertained.

Enforcement of order for costs.

If the law officer's order as to costs be not complied with in the time fixed therein, or within fourteen days after the amount has been fixed or ascertained, the party to whom such costs are to be paid may apply to the law officer for an order for payment. To enforce this order it may be made a rule of the High Court of Justice, when the processes of execution to enforce orders of the High Court are available.

(*a*) See Form T, p. 749.

Any notice or other document required to be given to the law officer's clerk may be sent by a prepaid letter through the post.

The fee payable by an appellant from the comptroller to the law officer is 3*l*.

Sealing of the patent.

If no opposition be entered, or if opposition, though entered, is successfully met, the comptroller will cause a patent to be sealed with the seal of the Patent Office, and dated as of the day of the original application.

The term of a patent is fourteen years from its date.

Every patent, when sealed, has effect throughout the United Kingdom and the Isle of Man.

Delay in sealing patent.

A patent must issue within fifteen months from the date of application. To this rule there are three exceptions:

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

(2) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the original applicant.

(3) If the comptroller has allowed an extension of time for the leaving or acceptance of the complete specification, he may allow a further extension of time equal to the sum of the extensions allowed in leaving and accepting the complete specifications, after the said fifteen months for the sealing of the patent.

Renewal fees.

The privilege granted by a patent under the Act of 1883 will expire at the end of four years, unless a certificate of renewal has been obtained.

The following is a list of the fees payable on Form J., Patents Rules, 1890 (*a*).

On a certificate of renewal—

Before the end of 4 years from the date of patent (*b*)	-	£50
,, ,, 8 years ,, ,, (*c*)	-	100

(*a*) See Appendix, p. 744.

(*b*) *I. e.*, the date of application.

(*c*) In the case of patents dated prior to 1884, on which a £50 fee has been paid, the annual fees are (if a £100 fee be not paid before the end of the *seventh* year)—

	£
Before the end of the 7th year	10
,, ,, 8th year	10
,, ,, 9th year	10
,, ,, 10th year	15
,, ,, 11th year	15
,, ,, 12th year	20
,, ,, 13th year	20

or in lieu of the above, the following annual fees:— Renewal fees.

Before the expiration of the—

4th year	from the date of the patent	-	-	£10
5th year	,,	,,	-	10
6th year	,,	,,	-	10
7th year	,,	,,	-	10
8th year	,,	,,	-	15
9th year	,,	,,	-	15
10th year	,,	,,	-	20
11th year	,,	,,	-	20
12th year	,,	,,	-	20
13th year	,,	,,	-	20

A patent ceases if the patentee fails to make the prescribed payment within the prescribed times.

Enlargement of time for payment of renewal fees.

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

The comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee (*d*) for enlargement not exceeding 10*l*., enlarge the time accordingly, subject to the following conditions:—

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

Infringement.

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

In case the last day for paying one of the prescribed fees should fall on Christmas Day, Good Friday, or on a Saturday, or on a day observed as a holiday at the Bank of England, or as a public fast or thanksgiving day, the fee may be paid on the day next following.

Loss 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

(*d*) The fees at present prescribed are—

	£
For an enlargement not exceeding 1 month.....	3
,, ,, ,, 2 months	7
,, ,, ,, 10 months	10

any time cause a duplicate thereof to be sealed, on payment of a fee of 2*l.*

Amendment of specification, &c.

Specifications and drawings may be amended by way of disclaimer, correction, or explanation. Shortly stated, the practice is as follows:—

The applicant leaves at the Patent Office a written request, Form F., Patents Rules, 1890 (*e*), stating the nature of the proposed amendment, and his reasons for the same. The Patent Office fee is 1*l.* 10*s.* or 3*l.*, according as the application to amend is made before or after the sealing of the patent.

The request and the proposed amendment are advertised in the Official Journal (*f*). Any person may give notice at the Patent Office of opposition to the amendment. Such notice should be in Form G., Patents Rules, 1890 (*g*), and bears a stamp of 10*s.* The comptroller gives notice of the opposition to the applicant, and hears and decides the case, subject to an appeal to the law officer, whose decision is final. Only an interested party will be heard in opposition before the law officer.

Where notice of opposition is not given or is not prosecuted, the comptroller determines whether the proposed amendment should be allowed. The decision of the comptroller may be appealed against to the law officer, as before.

No amendment will be allowed that materially enlarges the scope of the invention originally claimed.

Clerical errors can be amended at any time. The application is made on Form P., Patents Rules, 1890 (*h*).

(*e*) See Appendix, p. 742.

(*f*) The fee for correction of a clerical error is 5*s.* up to, and 1*l.* after, the sealing of the patent.

(*g*) See Appendix, p. 742.

(*h*) See Appendix, p. 747.

CHAPTER VII.

APPLICATIONS FOR PATENTS.

Scope of chapter.

THE law and practice as to applications for letters patent will be fully treated in different parts of this work, and need not be recapitulated here in detail.

A general account of the application has already been given in the last chapter.

It is therefore proposed simply to state the chief points which arise in this connection, and to refer the reader to the chapters or headings where they are fully considered.

Who may be patentee.

It may be laid down as a general rule, that any one may be an applicant for letters patent. (See note to sect. 4, sub-sect. (1), of the Act of 1883, p. 428.)

Persons under disability.

Infancy, lunacy, and coverture create no incapacity. (Page 512.)

As to declarations on behalf of infants, lunatics, &c., see sect. 99, p. 512.

Possible exceptions.

Possible exceptions to this general rule in the case of the sovereign, an alien enemy, a beneficed clergyman, and a person who has arrived at a discovery by information officially acquired, are noticed at pp. 428, 429.

Joint applicants.

Two or more persons may make a joint application. (Sect. 4, sub-sect. (2), p. 427.)

As to co-ownership of patents, see pp. 192—194.

Importer of invention.

The importer of an invention from abroad, as well as an inventor, may be an applicant under sect. 4, sub-sect. (1) (see pp. 430—433); but not under sect. 103 and the International and Colonial arrangements. (See p. 517.)

Legal representative.

The legal representatives of a deceased inventor may apply for letters patent, or may proceed with an application already made. As to the practice in such cases, see p. 491.

Applications under sects. 103 and 104.

As to applications under sects. 103 and 104 of Patents Act, 1883, and the International and Colonial arrangements, see pp. 516—518, and pp. 408—416.

Rival applications.

In case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications does not prevent the sealing of a patent on an earlier application. (Act of 1883, sect. 13, p. 451.)

As to rival applications, see pp. 438 and 440.

Examination and amendment of applications.

As to the examination and amendment of applications, see sects. 6 and 7, pp. 436—439.

Forms.

The various forms of application for letters patent will be found in the Appendix, pp. 737—739. They are the Forms A, A1, A2, of the Patents Rules, 1890.

Procedure.

The procedure connected with applications is discussed at pp. 69 *et seq.*, and also in the notes to sects. 4—7, pp. 427—440.

As to fees, see p. 486, and also p. 550.

CHAPTER VIII.

SPECIFICATION OF AN INVENTION.

SECT. 1. ORIGIN AND DEVELOPMENT OF SPECIFICATION.
SECT. 2. THE TITLE.
SECT. 3. PROVISIONAL SPECIFICATION.
SECT. 4. COMPLETE SPECIFICATION AND CLAIMS.
(1) *Relation of Provisional and Complete Specifications.*
(2) *Sufficiency of Complete Specification.*
(3) *Construction of Complete Specification.*
(4) *The Claims.*
SECT. 5. AMENDMENT OF SPECIFICATION.
(1) *Former Law as to Amendments, Disclaimers, and Clerical Errors.*
(2) *Existing Law.*
(a) *Amendment generally.*
(b) *Disclaimer pending Action.*

SECT. 1—.ORIGIN AND DEVELOPMENT OF SPECIFICATION.

Specification the consideration for the grant.

THE instruction of the public in the manufacture or exercise of a patented invention has always been considered part of the motive or policy of the grant, and different means of attaining this object have been adopted at different stages in the history of patent law. The earliest practice, and that to which Lord Coke refers, was to insert in the grant a proviso requiring the inventor and his assignee to take apprentices during the last seven years of the term, and to teach them "the knowledge and mystery" of his invention (*a*).

Formerly no specification.

There was, however, no obligation upon a patentee to define clearly the objects to which his patent extended, and the public at once were exposed to the danger of unconsciously infringing the privilege, and had no security for acquiring the invention on the

(*a*) See 1 Web. P. C. p. 36. Buck's invention.

expiration of the patent (*a*). The only indications to the public of the scope of the invention were the short recitals in the letters patent themselves. And there is little doubt that a patent without such a recital, and also without a condition requiring a specification or description of the invention in some way or other for the use of the public, would be absolutely void for want of consideration (*b*).

Introduction of proviso for specification.

The description of inventions which were formerly contained in patents were, however, very meagre and unsatisfactory (*c*), and the practice being found inconvenient, it became the custom, near the end of the reign of Queen Anne, to insert a proviso into all patents, obliging the patentee within a given time after the date of his grant, to "particularly describe and ascertain the nature of his invention, and in what manner the same is to be performed," by an instrument under his hand and seal, called a "specification," and to enrol the said specification in the Court of Chancery. The authority by which this clause was introduced does not appear, and was not, at any rate, parliamentary. It was probably suggested by the Attorney or Solicitor-General of the day (*d*). According to Webster (*e*), the earliest patent containing the proviso for a specification was that granted 3rd October, 1711 (*f*), to John Nasmyth. The specification or description of a patent invention by instrument enrolled, is not required either by the common law or by the Statute of Monopolies, but is only a condition or proviso which is contained in the patent itself.

Nasmyth's Patent, 3rd October, 1711.

After the grant of the patent, with the proviso as above, the enrolment of the specification could not be dispensed with except by Act of Parliament. Such an Act was passed in 1813 (53

(*a*) It must, however, be remembered that though at common law no instrument was required to be enrolled, it was nevertheless necessary that the party should be in possession of a mode of putting his invention into practice, for otherwise the patent would be void for false suggestion and failure of consideration. (Web. P. C. p. 8, n.)

(*b*) Hindmarch, p. 151.

(*c*) See the form of grant, p. 530.

(*d*) Report, &c., 1829; Appendix, p. 170; Web. Letts. Pat. p. 6, n. (*o*). It is to be observed that some years before this a duty upon all parchment writings was granted to the Crown. It may be that the obtaining of an extra duty upon the specification was one of the objects in providing for the enrolment of a separate deed of specification. See the memorandum at end of Nasmith's Specification, A.D. 1711, No. 387.

(*e*) 1 P. C. p. 36, n. (*e*).

(*f*) An inspection of the specifications at the Patent Office bears out Webster's statement. The date of enrolment of the specification was the 1st April, 1712, as appears from the printed specification, No. 387, A.D. 1711. Nasmith's case was not, however, consistently followed at first, but very soon it became usual to insert the proviso for enrolment of a specification in all cases. The specification in Nasmith's case was extremely short, being only a few lines, not more than the recital of the invention in the letters patent, usual at the time.

Geo. III. c. 179), in the case of James Lee, who had obtained patents in 1812 for certain new methods of preparing hemp and flax, with provisoes for the enrolment of specifications within fifteen months of their dates respectively (*g*). An Act of Parliament was obtained dispensing with these provisoes and substituting others, on the grounds that if the specifications should be enrolled in the usual manner, foreign agents might obtain copies of them and send them abroad.

James Lee's Patent Act, 1813.

The substituted conditions are of sufficient interest to justify citation. The patentee was required by the Act, instead of enrolling his specification, to deliver the same to the Lord Chancellor within fifteen months from the date of the first patent, with an affidavit that the whole of the invention and the method of using the same was therein described. The specification and affidavit were then to be enclosed in a cover, under the seal of the Lord Chancellor, and lodged in the office of one of the Masters of Chancery, to be nominated by the Lord Chancellor, and were to be preserved by that master. (Sect. 1.) The said packet was not to be removed from the custody of the said master on any pretence, except by order of the Lord Chancellor, who was empowered to call for and open the same whenever it might be necessary, on account of applications for patents for inventions of a similar nature; or on account of any trial at law; and after such use being made, the packet was to be sealed up again and deposited with the master as before. (Sect. 2.) Two copies of the said specification, with affidavits by the patentee that they were true copies, were to be delivered under cover, sealed by the patentee, one to the Lord Chancellor of Ireland (who was required to deposit the same in the custody of one of the Masters of Chancery in Ireland), and the other to the Lord Chief Baron of the Exchequer in Scotland (to be deposited by him in the custody of the King's Remembrancer in the Exchequer in Scotland). (Sect. 3.) The said packets so deposited were to be kept as before directed, for the original, and might be opened and examined, when necessary, by the Lord Chancellor in Ireland and the Lord Chief Baron in Scotland, and then sealed up again and deposited as before. (Sect. 4.) The

Provisions in place of enrolment in Lee's Patent Act.

(*g*) Cf. Booth's Act, 1792, 32 Geo. III. c. 73. Booth intended to operate by machinery upon a tissue or web of carded wool, so as to interlace or entangle, and felt the fibres together, and thus form cloth, or rather felt, without the previous operation of spinning and weaving. Booth's invention was tried on a large scale at Taunton, also near Salisbury, and again at Merton, near London, but without success, the felt not having any of the strength and durability of woollen cloth. (Report, &c., 1829; Appendix, p. 175.)

several packets so deposited were to be kept, as aforesaid, until the expiration of seven years from the passing of the Act, and were then to be enrolled by the persons having custody of the same and by the patentee or his executors, administrators, or assignees, in the Courts of Chancery in England, Scotland, and Ireland, as directed by the patents respectively. (Sect. 5.) The delivery of the said specifications, and the enrolment thereof within four months after the expiration of the seven years aforesaid, were to be deemed an effectual fulfilment of the provisoes in the patents. (Sect. 6.) A doquet or abstract of the said several letters patent, containing the date and the words in which the invention is therein described, was, within four months from the passing of the Act, to be enrolled in place of the specifications. (Sect. 7.) In case a specification of the invention was not duly enrolled in pursuance of each patent, within four months after the said term of seven years from the passing of the Act, the patent was to become void (*f*). (Sect. 8.)

Lord Eldon on Lee's Patent Act.

Referring to this case (*g*), Lord Eldon said that it was a very peculiar one, the Act being intended to secure to the State in time of war the benefit of a most important discovery, and added that, in his opinion, the Legislature would pause a long time before they passed such an Act in future.

Endeavours to avoid enrolment of specification.

No private Act of the same kind appears to have passed subsequently (*h*). Applications to the Lord Chancellor to dispense with the enrolment of the specifications of letters patent were frequently made, but without success. Thus, in *Ex parte Koops* (*i*), a petition that the enrolment might be dispensed with, or some provision made for preventing the specification being made public, on the ground that foreigners would obtain the invention, was dismissed. In pronouncing judgment, Lord Eldon said: "As to the worth of the apprehension suggested, a man has nothing more to do than to pirate your invention in a single instance, and he will then force you to bring an action, and then the specification must be pro-

(*f*) Cf. Report, &c., 1829; Appendix, p. 178. "Mr. Lee's invention was tried on a large scale, but did not prove successful; it was intended to prepare flax for spinning, without previous dew rotting or water rotting": *Ibid.*

(*g*) *In re Lacy*, 29 Rep. Arts, N. S. 250; Web. P. C. 431.

(*h*) In *Ex parte Koops*, 1802, 6 Ves. 595, Lord Eldon said: "Either upon this or some other case in the last session a clause for this purpose (in dispensing with the enrolment of a specification) was inserted in an Act of Parliament, and upon the motion of Lord Thurlow, upon reasons applying not only to that but to all cases, and seconded by Lord Rosslyn, the clause was universally rejected, and rejected, as it appeared to me, upon very substantial grounds, in which I readily concur."

(*i*) 1802, 6 Ves. 595.

duced. But with regard to the king's subjects a very strong objection occurs, which makes it necessary that the specification should be capable of being produced. They have a right to apply to the Patent Office to see the specification, that they may not throw away their time and labour, perhaps at a great expense, upon an invention upon which the patentee might afterwards come with his specification, alleging an infringement of his patent, when, if those persons had seen the specification, they never would have engaged in their project. The enrolment is, therefore, for the benefit of the public."

Specifications were formerly framed in the manner usual with deeds-poll (*k*), commencing "To all to whom these presents shall come," &c.

Policy of concealing specifications. Foreign piracy.

The difficulty of preserving inventions from foreign piracy led, about 1819, to the introduction of a Bill into the House of Commons for concealing the specifications of all inventions for which patents were granted, from public inspection, in order that they might not be sent abroad (*l*). It was thrown out. A few years later (1822) a petition was presented to the House of Commons, praying for some amendments in the law relative to patents for inventions, and a Bill was brought in for that purpose. One of its principal provisions was to give security to the inventor from the time of his first application for a patent during a certain time allowed for making experiments before the date of the patent. This measure, however, was lost on the second reading (*m*).

Specifications might be enrolled in three offices.

The risk of piracy was not, however, the only, or the chief, disadvantage of the methods of enrolling specifications which prevailed from the reign of Anne till 1852. It was attended with serious inconveniences to the public as well as to the patentee. Specifications were originally enrolled in the Enrolment Office, the Rolls Chapel, or the Petty Bag Office, at the option of the grantee, and could thus be discovered and inspected by the public only after laborious searches. The statutes, 11 & 12 Vict. c. 94, s. 14, and 12 & 13 Vict. c. 109, s. 15, which directed their enrolment in the Enrolment Office of the Court of Chancery alone, left the evil without a remedy, so far as former specifications were concerned. Again, a patentee was not obliged to enrol his specification for a certain time, usually six months, after obtaining his patent. The result was well stated by a witness in his evidence before the Com-

(*k*) See Appendix, p. 854.
(*l*) See also Act of 1883, sect. 44.
(*m*) See Appendix p. 179 of the Report, &c., 1829.

mittee of 1851 (*m*). "A man gets hold of an idea; he runs immediately to the Patent Office before he has made any attempt to perfect his process. He gets a protection for six months, and he goes about examining every publication connected with the particulars, and getting all the information he can; and when the time for delivering in his specification comes he has entirely altered the original view he entertained."

Provisional protection under Act of 1852.

The Patent Law Amendment Act, 1852, adopted a practice in force in several continental countries, and which was strongly recommended by most of the witnesses who gave evidence before the Committees of 1829 and 1851, provided that a petition for the grant of letters patent should be accompanied by a statement in writing, describing the nature of the invention which it was sought to patent: this statement was called the provisional specification (*n*). The effect of the procedure prescribed by the Act was that a patentee might use his invention for six months without prejudice to his patent by that user, but he obtained no rights against the public until his patent had been sealed, and even then the patent would not relate back to acts done in the interval. The patentee was only protected against the consequences of his own publication, and then might employ workmen and obtain machinery, without the risk of being betrayed (*o*).

Provisional specification.

Complete specification.

In lieu of a provisional specification, an inventor was empowered to deposit, in the first instance, an instrument in writing under his hand and seal, called a complete specification, particularly describing and ascertaining the nature of his invention, and in what manner it was to be performed. The effect of such deposit was to protect the invention for a period of six months from the date of the application, and to give the applicant during such period the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention, duly sealed as of the day of the date of such application (*p*).

Provisional protection and specifications under Patents Acts, 1883—1888.

Under the Patents Acts, 1883—1888, substantially the same procedure prevails, except that (1) the provisional protection extends, not as before, for a term of six months from the date of application, but for the period between the date of application and the date of sealing (*q*); and, (2) that if the applicant does not leave a com-

(*m*) Mr. John Fairrie, p. 145, Answer 916.

(*n*) Act of 1852, sect. 6.

(*o*) *Ibid.* sect. 8; and see *Ex parte Bates and Redgate*, L. R. 4 Ch. 578 (per Lord Hatherley, L. C.).

(*p*) Patent Law Amendment Act, 1852, sect. 9.

(*q*) Act of 1883, sect. 14.

plete specification in the first instance he may leave it at any subsequent time within nine months from the date of application (*r*), or within such extended time, not exceeding one month, after the said nine months, as the comptroller may, on payment of the prescribed fee, allow (*s*).

Provisional specifications of abandoned application now secret.

Under the Act of 1885 (*t*) it is provided that where an application for a patent has been abandoned or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application shall not at any time be open to public inspection, or be published by the comptroller. All the provisional specifications under the Act of 1852 were published.

Sect. 2.—The Title.

The title of a patent is intended to, and must, disclose the subject-matter of the invention (*u*).

Report of examiner on title.

Under the Patents Act, 1883 (sect. 6), the duty is imposed upon the official examiner (to whom an application for letters patent is referred) of ascertaining and reporting upon the sufficiency of the title, and if his report is adverse, the Comptroller-General may refuse the application, unless and until it is amended to his satisfaction. This refusal may be appealed against to the law officer, whose decision is final.

Insufficiency in an applicant's title is not a ground of opposition; and in view of the power to require and admit amendments vested in the Comptroller-General by sect. 7 of the present Act, it is improbable that many applications for letters patent will be finally rejected for defects in the title. But an inventor may still bring upon himself considerable trouble and delay by failure to frame his title with care. It will be advisable, therefore, to refer to the leading cases bearing upon the subject.

Title must describe nature of invention.

The title of an invention ought accurately to describe the nature of it, and should neither be so large as to include anything more than the patentee has actually invented, nor so narrow as to exclude any part of the invention (*x*).

Mere generality not fatal to patent.

Mere generality in the terms of a title, if the description was not in any respect inaccurate, was formerly held to be no ground for avoiding a patent already granted (*y*). Where, therefore, a

(*r*) Act of 1883, sect. 8, sub-sect. 1.
(*s*) Act of 1885, sect. 3.
(*t*) Sect. 4.
(*u*) *Household Co.* v. *Neilson*, 1843, 1 Web. P. C. 678.
(*x*) Hindmarch, p. 43.
(*y*) *Cook* v. *Pearce*, 1844, per Tindal, C. J., 8 Q. B. 1064, reversing the deci-

patent had been taken out "for improvements in carriages," and the invention consisted in an improvement in pinion shutters which could only be used in some kinds of carriages, the title was held by the Exchequer Chamber to be sufficient.

But *semble*, a ground for amendment.

But Tindal, C. J., who delivered the judgment of the Court, observed that an objection to such a title might well have been taken on the part of the Crown before it granted a patent for the invention; and in *Newall* v. *Elliott* (*z*), Pollock, C. B., stated that he had, when Attorney-General, refused an application for a patent for "an improvement in locomotion," on the ground that the title was too general.

Title indefinite or too large.

Objection will in all probability be taken to a title which is so large and indefinite in its terms as to be calculated to deceive any person reading it as to the extent or object of the grant (*a*).

Thus, in *Cochrane* v. *Smethurst* (*b*), a patent had been granted for "a method or methods of more completely lighting cities, towns and villages." The invention consisted in improvements in street lamps. The title was held to be too large.

So, in *Campion* v. *Benyon* (*c*), when a patent had been obtained for "a new and improved method of making and manufacturing double canvas and sailcloth with hemp and flax, without any starch whatever," and it appeared that sailcloth had been made without starch before, it was held that the title was too large, as it embraced more than the patentee had actually discovered.

Bloxam v. *Elsee* (*d*) is another illustration of the point in question. This was an action for the infringement of two patents for "an invention of making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length." It appeared, however, that the machine described in the specification would work to one width only. It was held by the Court of King's Bench that the consideration for the grant was the invention of a machine for making paper in sheets of width and length varying within the limits designated, and that there had been a failure in a material part of the patentee's representation.

sion of Denman, C. J., *ib.* at p. 1050; and cp. *Sturtz* v. *De la Rue*, 1828, 1 Web. P. C. 83; 5 Russ. 322; *Nickels* v. *Haslam*, 1844, 13 L. J. C. P. 146; 8 Scott, N. R. 97; *Beard* v. *Egerton*, 1846, 3 C. B. 97; 15 L. J. C. P. 270; *Reg.* v. *Mill*, 1850, 10 C. B. 379; *Crossley* v. *Potter*, 1853, Macr. P. C. 242; *Hills* v. *London Gas Light Co.*, 1860, 5 H. & N. 370.

(*z*) 1864, 13 W. R. 15.

(*a*) Cp. Hindmarch, p. 46; *R.* v. *Else*, 1785, 1 Web. P. C. 76.

(*b*) 1816, Dav. P. C. 354.

(*c*) 1821, 6 B. Moo. 71; *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 352—358.

(*d*) 1825, 6 B. & C. 169, 178; cp. *Felton* v. *Greaves*, 1829, 3 C. & P. 611.

Again, in *Bainbridge* v. *Wigley* (*e*), the title of the patent was "certain improvements in the flageolet or English flute, whereby the fingering will be rendered more easy, and notes produced that were never before produced." At the trial it appeared that, while the instrument was a great improvement, only one new note was produced. Lord Ellenborough held that there was a failure of the consideration for the patent, which was fatal to the grant.

Title may be restricted by specification.

The generality of the words in a title may be restricted by the specification (*f*).

Variance between title and specification.

The specification cannot, however, so extend the meaning of the title as to make the grant include anything not within the natural and ordinary meaning of the language made use of in the patent to describe the invention (*g*).

Cases.

Illustrations.—1. The title of a patent was, "An invention for the improved application of air to produce heat in fires, forges and furnaces where bellows and other blowing apparatus are required." The invention consisted in passing the air from the blowing apparatus into an artificially heated receptacle, and then into the furnace. It was objected, on the trial of an action for the infringement of this patent, that it was doubtful whether the patent was for the invention of the application of hot air, or only for an improved mode of applying hot air. Upon this question coming before the Court of Exchequer, it was held that, although the title of the patent was ambiguous, it was sufficiently explained by the specification, and was not at variance with it, as was the case in *R.* v. *Wheeler* (*h*).

2. *R.* v. *Wheeler* (*i*) was a *scire facias* for the repeal of letters patent "for a new and improved method of drying and preparing malt." In the specification, the patentee claimed to be the inventor, not of a method of drying or preparing malt, but of a method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree, viz., the qualities of being soluble in water, and colouring the liquor in which it should be dissolved, which latter was the object in view. This was to be effected by a second and additional process, the application of a very high degree of heat.

(*e*) 1810, Parl. Rep. 1829, 197; 1 Carp. P. C. 270.

(*f*) *Hornblower* v. *Bolton*, 1799, Dav. P. C. 230; *Newton* v. *Voucher*, 1851, 21 L. J. Ex. 305; 6 Ex. 866.

(*g*) Hindmarch, p. 47.

(*h*) *Neilson* v. *Harford*, 1841, 8 M. & W. 806; cp. *Beard* v. *Egerton*, 1846, 3 C. B. 97.

(*i*) 1819, 2 B. & Ald. 345. See next illustration.

Variance between title and specification.

It was held by the Court of King's Bench that the invention mentioned in the specification was so entirely different from that mentioned in the patent as that the latter remained wholly undescribed and unspecified (*k*).

3. In *Rex* v. *Metcalf* (*l*)—another *scire facias*—the defendant had obtained a patent for the manufacture of hair brushes which were described as "tapering." The specification described a method of making brushes in which the bristles would be of unequal length. Lord Ellenborough said: "If the word tapering be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be used in its perverted sense." No such evidence having been given, Lord Ellenborough directed the jury to find that it was not a *tapering*, but only an unequal, brush, and there was a verdict for the Crown.

4. In *Fisher* v. *Dewick* (*m*), tried before Coltman, J., the patent was for improvements in machinery for making bobbin net-lace. Sir John Campbell, for the defendant, objected that the title misdescribed the subject-matter, the invention being only for making a spot during a particular part in the process, and being useless where that addition was not wanted: and he said the title should have been, "for a mode of making spots in bobbin net-lace." But the learned judge said: "Is the invention applicable to anything but the making of bobbin net-lace? and is it not an improvement?" and he overruled the objection, and the Court of Common Pleas supported his ruling, Tindal, C. J., observing that it could not, without great refinement, be said that the invention was not an improvement in the manufacture of bobbin net-lace.

5. In *Croll* v. *Edge* (*n*), a patent had been granted "for certain improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas." A specification was enrolled in which the words "therein and" were interpolated between "used" and "when." The Court of Common Pleas held that the patent was bad.

"The title," said Maule, J., "did not profess to comprehend improvements in any apparatus used in making gas. The patentees, in representing to the Crown the nature of the invention

(*k*) *Ubi supra*, at p. 351.
(*l*) 1817, 1 Web. P. C. 141 n.; 2 Stark. R. 249.
(*m*) 1838. Not reported on this point, but cited by Pollock, A.-G., in the course of his argument in *Cook* v. *Pearce*, 8 Q. B. 1056.
(*n*) 1847–50, 19 L. J. C. P. 261; 9 C. B. 479, 490, 492.

which they had discovered, did not give the Crown notice that they claimed the exclusive use of any apparatus for making gas. . . . . When the body of the specification is looked at, one main part of the patentee's claim consists of what may be, and probably is, a new mode of manufacturing clay retorts—an apparatus used in the manufacture, and not in the transmitting and measuring, of gas. . . . . No patent at all has been granted to them for that. It seems to us that they have specified for a more extensive and a different patent from that which was granted to them."

6. In *Oxley* v. *Holden* (*o*), the title of the patent was for "improvements in the doors and sashes of carriages." In his specification the inventor stated: "I have shown my invention as applied to railway carriage doors and window fittings, although equally applicable to the doors and windows of any other carriages, or in any position where windows and doors are subject to jar and vibration." It was objected that the specification claimed more than the patent. But the Court of Common Pleas overruled this objection. "The invention," said Erle, C. J., "specified and claimed, is truly an improvement in the doors and windows of carriages, not the less because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined accordingly to the doors and windows of carriages."

Amendment of title.

The amendment of the title of letters patent is very fully and clearly dealt with by Sir Richard Webster, A.-G., in two recent cases, *Dart's Patent* (*p*) and *Jones's Patent* (*q*). It may be desirable to notice them in turn.

Decisions of law officer.

Dart's Patent (*p*). Here the question was—what is the proper course to be adopted where the applicant desires to omit a part of his invention, as covered by the original title prior to the time that the complete specification has been accepted by the office?

Webster, A.-G., said, "If the applicant merely desires to omit part of the invention described in the original title and provisional specification, I do not see that any amendment of the title and provisional specification is of necessity required, as I think that a

(*o*) 1860, 8 C. B. N. S. 666, 705; cp. *Patent Bottle Envelope Co.* v. *Seymer*, 1858, 23 L. J. C. P. 22; *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358; *Wright* v. *Hitchcock*, 1870, L. R. 5 Ex. 37.

(*p*) Griffin, P. C. p. 307; cp. Trans. I. P. A., Vol. V. pp. 52—56, A. V. Newton.

(*q*) *Ib.* p. 313.

proper disclaiming clause might be inserted in the complete, indicating that part only of the invention originally covered by the title of the provisional was intended to be claimed. But should the applicant think that some risk to the validity of his patent might be occasioned by such a course being adopted, it is open to him to lodge a complete, omitting the part desired to be left out, and open to the Patent Office, under the powers of sub-sects. 7 and 9 (of the Patents Act, 1883), to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain.

"It must, however, be distinctly understood that such an amendment in the title and provisional ought, in my opinion, to be confined to excision only, and not to amendment or other explanation, and the excision must be such as does not extend the scope of the title"(*r*).

Jones's Patent (*s*). In this case a question of some difficulty was raised on a point of practice. Application was made for letters patent on September 18th, 1885. The application and provisional specification having been accepted by the Patent Office, a complete specification was lodged on June 18th, 1886, being at the expiration of the usual period of nine months and no extension of time having been obtained under the Act of 1885.

After lodging the complete specification, and before it was accepted by the Patent Office, the applicant desired to amend the complete specification in certain particulars. The Comptroller-General declined to allow the proposed amendments, and from this decision an appeal was brought.

Upon the hearing, a preliminary question arose as to whether, under the circumstances, any amendment of the specification could be admitted, except under sect. 18, and consequently as the application to amend had not been advertised, whether any amendment could properly be made.

Amendments when under sects. 7 and 9 or sect. 18.

Webster, A.-G., said, "The language of sect. 18 of the Act is somewhat obscure, but I am of opinion, having regard to the earlier sections, particularly 7 and 9, that sect. 18 was intended to apply

(*r*) In this case an incidental question arose respecting the payment of a fee required by the Patent Office on *Dart's Application*. Webster, Att.-Gen., said: "The matter is not exactly for me to determine, but in the view which I take, viz. that this matter ought to be dealt with under sects. 7 and 9, and not under sect. 18, I am of opinion that no fee was properly chargeable as in the case of an application to amend."

(*s*) *Ubi supra;* and Transactions of the Inst. of Pat. Agents, Vol. V. at p. 55.

to the amendment of specifications after they had become public property. Any other amendments must, in my opinion, be dealt with under sects. 7 and 9 and not under sect. 18."

In re Brown (*t*) was an application for letters patent for "improvements in casks and tubs." The specification stated that the invention was applicable to barrels, casks, tubs and analogous vessels; the claims were for a peculiar method of fastening in the heads and bottoms of vessels formed of staves.

The Comptroller-General required the applicant to amend his title by inserting the words "and analogous vessels."

On appeal, however, Webster, A.-G., passed the patent with the original title and said that he expressed no opinion as to whether the applicant could claim anything more than that which was covered by his title and claims, but inasmuch as he had elected to stand by his title and the claims were specific that was sufficient.

Sect. 3.—Provisional Specification.

Origin of.

The provisional specification was introduced by the Patent Law Amendment Act, 1852, of which sect. 6 required a specification describing the nature of the invention to be left with the petition for letters patent.

The specification was then referred to one of the law officers who, if satisfied as to its sufficiency and formal correctness, certified that the applicant's petition should be allowed, and in due course the desired grant was made (*u*).

Proviso for filing specification under Act of 1852.

Under the Act of 1852, it was a condition of the patent grant that the patentee should file, within six months, a full specification particularly describing and ascertaining the nature of the invention and in what manner it was to be performed. On the patentee's failure to comply with this condition, his letters patent were to become void.

According to this mode of procedure an inventor received from the Crown the consideration for disclosing his invention before he had fully disclosed it (*v*).

Under the Act of 1883, this process was reversed, and the filing

(*t*) 1887, Griffin, A. P. C. 1.

(*u*) For the formal steps, see an example, p. 208, note (*b*).

(*v*) See Transactions of the Inst. of Pat. Agents, Vol. IV. p. 155, G. G. M. Hardingham.

of a complete specification became a condition precedent to the sealing of a patent.

Office of provisional specification under the Act of 1852.

Sect. 6 of the Patent Law Amendment Act, 1852, provided as follows: "There shall be left (at the office of the commissioners) a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the applicant for letters patent, *describing the nature of the invention;*" and sect. 8 made the grant of provisional protection depend upon the law officer "being satisfied that the provisional specification" did accurately "*describe the nature of the invention*" (*x*).

The sufficiency of the provisional specification turned, therefore, upon the meaning which was to be attached to the words in italics.

Law officer's rule.

The following rule of practice was adopted by the law officers: "The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprised of the improvement and of the means by which it is to be carried into effect" (*y*).

Scope of provisional specification.

The scope of the provisional specification under the Act of 1852, was clearly defined in several leading cases. "The office of the provisional specification," said Byles, J., in *Re Newall and Elliott* (*z*), "is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out: otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation."

In a subsequent case between the same parties (*Newall* v. *Elliott* (*a*), Pollock, C. B., expressed himself more fully to the same effect:

"The object of the statute, which requires a provisional specification, is nothing more than a legislative recognition of the custom which called upon every patentee when he applies for the patent to give some notion of what his invention is. That has been followed up by an Act of Parliament requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and to make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in

(*x*) This the law officer certified by a "certificate of allowance."

(*y*) There is an interesting discussion on the effect of this rule upon the statutory provisions in the Transactions of the Institute of Patent Agents (Vol. I. pp. 68 *et seq.*, W. Spence).

(*z*) 1858, 4 C. B. N. S. 269.

(*a*) 1864, 10 Jur. N. S. at p. 955.

the first instance. . . . . I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention, so as to enable the Attorney-General, and in fact to enable a jury ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification."

In the same case (*b*), Channell, B., added: "I entirely adopt the test which my Lord Chief Baron suggested—that the question is as to the identity of the invention, which is disclosed by the full specification with that of which a short note or minute was made in the provisional specification."

Office of provisional specification under Act of 1883.

The Act of 1883, s. 5, sub-s. 3, repeats in substance the provisions of sect. 6 of the Patent Law Amendment Act, 1852; the language of Byles, J., in *Re Newall and Elliott* (*c*), was adopted by Kay, J., in a recent leading case (*d*), and, generally, the tests of the sufficiency of a provisional specification remain unaltered.

"A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention, so as to protect the inventor until the time for filing the final or complete specification, but permitting him, in the meantime, to perfect any details, to modify, supplement, and develop his invention, always keeping within what I may call the ambit of his invention, as disclosed in his provisional specification" (*e*).

Sect. 4.—Complete Specification and Claims.

1. *Relation of Provisional and Complete Specifications.*

Relation of provisional to complete specification.

The relation between the provisional and the complete specification has already been touched upon (*f*), but may with advantage be briefly referred to again.

The office of the provisional specification is to describe "the nature of the invention" which it is sought to patent. Nothing more is required in it. The object of its introduction was to enable

(*b*) *Ubi supra*, at p. 960; cp. *Penn* v. *Bibby*, *Penn* v. *Jack*, 1866, per Lord Chelmsford, L. C., L. R. 2 Ch. 134.

(*c*) *Ubi supra*.

(*d*) Cp. *Lucas* v. *Miller*, 1885, per Kay, J., 2 P. O. R. at p. 159.

(*e*) *Woodward* v. *Sansum*, 1887, per Cotton, L. J., 4 P. O. R. at p. 178; followed in *Siddell* v. *Vickers*, 1888, 5 P. O. R. at p. 426; and cp. *Stonor* v. *Todd*, 1876, per Jessel, M. R., 4 Ch. D. at p. 59.

(*f*) *Supra*, p. 96.

an inventor to obtain protection for his invention for a period of six months, during which time he might use and publish it without prejudice to any letters patent subsequently granted therefor.

The office of a complete specification is very different. It must "particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed" (*g*).

The contrast between the provisional and the complete specification is marked and clearly defined in plain language alike by the Patent Law Amendment Act, 1852, and by the Act of 1883.

Effect of variance under present Act.

The question whether, under the Act of 1883, nonconformity between the provisional and the complete specifications may invalidate a patent granted under that Act, has given rise to considerable discussion, and cannot yet be said to have been finally settled (*h*).

Rules of law as to variance.

The following rules are thought to present an accurate statement of the law as to variance between the provisional and complete specifications:—

Keeping in view the offices of the provisional and complete specifications respectively, the Court will construe the former with the aid of the knowledge of what has been claimed by the latter, and will decide whether, on a fair interpretation, each essential part of the claim is covered by the provisional specification (*i*).

There is no variance where the inventions described by the two documents are substantially one and the same (*k*), or where the excess, if any, in the complete specification is attributable to the legitimate functions of that document (*l*), or where the complete specification is a legitimate development of the provisional (*m*).

By way of illustration, reference may be made to one or two leading cases.

Cases.

In *Penn* v. *Bibby* (*n*), the provisional specification described the

(*g*) Cp. *Mosley* v. *The Victoria Rubber Co.*, 1887, per Chitty, J., 4 P. O. R. at p. 248.

(*h*) *Siddell* v. *Vickers*, 1888, per Cotton, L. J., 5 P. O. R. at p. 426. And see *Woodward* v. *Sansum*, 1887, 4 R. P. C. p. 166. In *Goulard and Gibbs' Patent* (1889, 6 P. O. R. 215), a discrepancy between the provisional and complete specifications as amended, was held to be a fatal variance: cp. *King* v. *The Anglo-American Brush Corporation*, 1889, 6 P. O. R. 414; and cp. Trans. I. P. A., Vol. VI. p. 53, Mr. J. C. Mewburn.

(*i*) *Siddell* v. *Vickers*, 1888, per Cotton, L. J., 5 P. O. R. at p. 98. "The question is not whether the provisional is defective, but whether the complete is excessive." *S. C.*

(*k*) *Moseley* v. *The Victoria Rubber Co.*, 1887, per Chitty, J., 4 P. O. R. at p. 251; cp. *Watling* v. *Stevens*, 1886, 3 P. O. R. 37, 41.

(*l*) *Ibid.*

(*m*) *Horrocks* v. *Stubbs*, 1886, 3 P. O. R. pp. 233, 236; *Moseley* v. *Victoria Rubber Co.*, *ubi supra*; *Woodward* v. *Sansum*, 1887, 4 P. O. R. at p. 178.

(*n*) 1866, per Lord Chelmsford, L. C., 2 Ch. at pp. 130, 135.

nature of the invention in the most general terms to consist in employing wood in the construction of the bearings and the bushes for the shafts of screw and submerged propellers. The complete specification described a particular mode of employing wood to prevent the parts of a propeller shaft which are within the bearings from coming in contact with the metal of the bearings, and to cause them to revolve against pieces of wood, and between the inner surfaces of the metal bearings and the outer surfaces of the propelling shaft. The claim at the end of the specification was, "the employing of wood in the construction of the bearings and bushes for propelling shafts as herein described." It was argued for the defendant that if the words "herein described" were to be disregarded, the patent was void, as the claim would then be for the employment of wood in every possible way in the bearings and bushes of propellers; on the other hand, if those words limited the claim to the precise description in the specification, that was not what was described in the provisional specification, and the plaintiff had, therefore, obtained a patent for one thing, and specified another. Lord Chelmsford's judgment in this case is instructive.

Variance of provisional and complete specifications.

Penn v. *Bibby.*

"There can be no doubt," says his lordship, "that the claim in the specification must be read with the limitation produced by the words "herein described," and that the question thereupon rises whether this occasions a departure from the provisional specification so as to render the patent void.

"It seems clear that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officer what is to be the subject-matter of the patent.

"It is not at all necessary that the provisional specification should describe the mode or modes in which the invention is to be worked or carried out. That is left to the complete specification.

"Nor is it at all necessary that the complete specification should extend to everything comprehended within the provisional specification. . . . .

"It is clear, therefore, that unless the complete specification in this case claims something different from the provisional specification, the objection to the patent under consideration cannot prevail. But there is not the slightest foundation for the objection in point of fact, and each specification appears to me faithfully to fulfil its own office.

"But it was said that one part of the complete specification

Variance of provisional and complete specifications.

went beyond the provisional, and extended to something which could not be included in it, viz., the application of wood to the shaft, so as to revolve therewith, the provisional specification confining the employment of wood to the bearings and bushes. If wood applied in this manner to the shaft may be properly called a bearing, then there is no excess in this part of the specification. But if, strictly speaking, this application of wood would not come within the description of a bearing, then the answer to the objection is that it is not claimed, the claim being limited to the employment of wood in the construction of bearings and bushes. There is, therefore, no departure from the provisional specification in the complete specification."

Thomas v. *Welch*.

In *Thomas* v. *Welch* (*o*), an action for the infringement of a patent for sewing machines, the provisional specification stated that a certain instrument, or *another acting therewith*, acted to hold the work during the insertion of the needle, and again during its withdrawal. The complete specification contained drawings of sewing machines with details of parts thereof, and concluded with five separate claims. Thereafter the plaintiff disclaimed all the claiming clauses, and the amended specification stated "*g* is the instrument by which the work is held during the insertion of the needle." Three forms of *g* were described and the specification continued, "It is the arranging an instrument *g as herein described*, which while it is the means of holding the fabric during the insertion and withdrawal of the needle is also the means by which the step by step movement is given to the fabric or material for the succession of stitches, which constitutes *the* peculiarity of the invention." The words in italics were inserted for the first time in the amended specification, *the* taking the place of *another* in the original specification.

Erle, C. J., in delivering judgment, said: "The provisional specification describes an instrument and then says that this *or another acting therewith* acts to hold the work during the insertion of the needle. It is said that the complete specification contains nothing corresponding to this second alternative. Assuming that this is so (*p*), I do not think the objection ought to prevail. The difference is a slight one and injured nobody, and it may be

(*o*) 1866, L. R. 1 C. P. 192.

(*p*) His lordship, however, suggested another view: "it may be that one form of *g* mentioned in the complete specification, which is in two parts, is what was referred to in the expression, 'and another acting therewith.'"

that the patentee had something in his mind when he filed his provisional specification, which he found afterwards would be useless. As he could not disclaim formally part of the provisional specification he might, I think in such a case as the present, have omitted it from his complete specification."

Variance of provisional and complete specifications.

In *Wright* v. *Hitchcock* (*q*), an action for the improvement of a patent for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein," the alleged variance consisted in the addition in the complete specification of the word *trimmings* to the words *frills* or *ruffles* which appeared alone in the provisional. Kelly, C. B., said: "By whatever name it is described the thing is in itself identical: it is something attached to any part of the dress, either of men or women, whether it is called the frill of a sleeve or the ruffle of a shirt or the trimming of a lady's dress. These are all *ejusdem generis*, and the description is only important for the purpose of showing for what purpose the product may be ultimately used when it has been manufactured by means of the plaintiff's invention."

Wright v. *Hitchcock.*

The last case to which it is necessary to refer is *Lucas* v. *Miller* (*r*). Here the plaintiff, who was the patentee of an improved form of bicycle lamp, brought an action against the defendant for infringing this patent. The complete specification comprised a method of attaching washers to the lamp, which was not mentioned in the provisional specification. This the defendant alleged invalidated the patent. It was held, however, by Kay, J., that the patent was valid as the method of attaching the washers was only a matter of detail which the patentee had a right to add to his specified invention and not a separate invention.

Although a patentee putting in a provisional specification showing the nature of his invention is not bound to describe therein any mode of carrying it into effect, yet, if he does do so, and before filing his complete specification, discovers an improvement in such mode, or discovers a different mode, he is bound to give to the public, in his complete specification, the benefit of what he has discovered as to the mode of carrying the invention into effect (*s*).

It is essential that the nature of the invention described in the two specifications shall be the same, but upon principle and upon authority it is clear that improvements in the arrangement of mechanism, in the relative position and adaptation of the different

(*q*) 1870, L. R. 5 Exch. 37, 46.
(*r*) 1885, 2 P. O. R. 155.
(*s*) *Woodward* v. *Sansum*, 1887, per Cotton, L. J., 4 P. O. R. at p. 175.

Variance of provisional and complete specifications.

parts, with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification, are allowable, and cannot be successfully relied on for the purpose of invalidating a patent for disconformity (*t*).

Crampton v. *Patents Investment Co.*

In *Crampton* v. *The Patents Investment Co.* (*u*), Field, J., expresses himself to the same effect.

"If, in the course of the time between the complete and the provisional specification, (the inventor) discovers the invention he claims to be the inventor of can be better performed or better done or improved by any further addition to it, not in the shape of a new invention . . . it is not only his privilege, but it is his duty to the public, to do it, because the object of the complete specification, whether it is filed with the application or six months after, is to tell the public how the thing is done. That is the price which the man who wants to be a patentee has to pay to the public for it."

An objection of variance should be stated in the particulars, and will probably be rejected unless it is so stated (*v*). A mere general allegation of disconformity is not sufficient. Thus, in

Anglo-American Brush, &c. Co. v. *Crompton.*

The Anglo-American Brush Electric Light Corporation v. *Crompton* (*w*), the defendants delivered particulars of objection, of which one was as follows: "That the alleged invention described in the complete specification, as amended, is a different invention from that described in the provisional specification." Bacon, V.-C., made an order for further and better particulars of the alleged disconformity, and this order was confirmed by the Court of Appeal. "The defendants," said Cotton, L. J., "ought to give such particulars as would inform the plaintiffs of the nature and scope of this objection of nonconformity. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them. Each case must depend on its own circumstances."

(*t*) *S. C.*, per Lopes, L. J., at p. 178; cp. *Lucas* v. *Miller*, 1885, 2 P. O. R. at p. 155.

(*u*) 1888, 5 P. O. R. at p. 397; affirmed on appeal, 1889, 6 P. O. R. 287.

(*v*) *Watling* v. *Stevens*, 1886, 3 P. O. R. at p. 152.

(*w*) 1887, 4 P. O. R. 27.

2. *Sufficiency of the Complete Specification.*

Objects of complete specification.

The aim of the legislature in requiring a patentee particularly to describe and ascertain the nature of his invention and the manner in which it is to be performed (*x*), appears to be threefold: (1) to prevent any person from inadvertently infringing the patent right during the term of the monopoly (*y*); (2) to put the public in possession of the patentee's secret on the expiry of the patent term (*z*); (3) to prevent patents being granted for known inventions (*a*).

Requisites of complete specification.

Keeping clearly in view the purposes for which the complete specification exists, we shall find little difficulty in understanding its requisites.

It will be seen that the whole case-law relating to the sufficiency of the complete specification can be discussed with reference to those heads.

Utmost good faith necessary.

Perhaps the shortest as well as the most comprehensive statement of the duty of a patentee with regard to the specification of the invention is, that he must treat the public generally with the utmost good faith.

Ambiguity—specification.

The simplest breach of this duty is ambiguity in the complete specification.

"The object of the specification," said Tindal, C. J., in *Walton* v. *Potter* (*b*), "is that it is the price which the party who obtains the patent pays for it, and it would be a hard bargain on the part of the public if he were allowed to clothe his discovery and his description in characters so dark and so ambiguous that no one could make from it when the fourteen years have expired, and he should not have paid the price for which he enjoyed the exclusive privilege, but that he should have it in his hands for as long a period as he chooses; and therefore it is always a proper answer, when a

(*x*) *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 556; *Walton* v. *Potter*, 1841, 1 Web. P. C. 595; *Thomas* v. *Welch*, 1866, L. R. 1 C. P. 201. One set of words may sufficiently disclose both the nature of the invention and the mode of performing it, as in *Boulton* v. *Bull*, 1795, Dav. P. C. 162; cp. *Edison Co.* v. *Holland*, 1889, per Cotton, L. J., 6 P. O. R. at p. 280.

(*y*) *Holmes* v. *L. & N. W. Rail. Co.*, 1852, per Jervis, C. J., Macr. P. C. 16; 22 L. J. C. P. 57; cp. *Morgan* v. *Seaward*, 1836, per Alderson, B., 1 Web. P. C. 173; *Neilson* v. *Thompson*, 1841, 1 Web. P. C. 283; *Morton* v. *Middleton*, 1863, 1 Court of Sess. 3rd series, 721.

(*z*) *Arkwright* v. *Nightingale*, 1785, 1 Web. P. C. 60; Dav. P. C. 55; *Hornblower* v. *Boulton*, 1799, 8 T. R. 100; *Newbery* v. *James*, 1817, 2 Mer. 451; 1 Carp. P. C. 367.

(*a*) *Hills* v. *London Gas Light Co.*, per Pollock, C. B., 5 H. & N. 340.

(*b*) 1841, 1 Web. P. C. 595; cp. *Galloway* v. *Bleaden*, 1839, 1 Web. P. C. 524.

patent is set up, to say that you have not so described it that it may be understood."

in the description of invention.

The specification in a patent, relating to a windlass, stated that the object was "to hold, without slipping, *a chain cable of any size.*" Before the date of this patent no cable-holder was known which would hold chains of different sizes, and the claim was for an invention by which a single windlass might raise cables of different diameters. It appeared that a windlass capable of holding a chain cable of a given size was not new. The Court of Queen's Benoh held that the specification did not unequivocally show that the object was to construct a single windlass capable of holding different ohain cables whatever their size, and that such a windlass was not therefore protected by the patent (*c*).

In *Gandy* v. *Reddaway* (*d*), the claim was for making *belts or bands for driving machinery of cotton canvas woven hard*, stitched and saturated with oil. The result of the evidence was that a workable belt for machinery could not be made out of the whole, but only out of a particular sub-division, of the class known as cotton canvas "woven hard," and there was no proof that a workman of ordinary skill would have rejected every other sort of "hard" canvas but that particular kind. It was held that in the absence of such proofs (*e*) the specification was insufficient.

Ambiguity in statement of proportions.

In the *Patent Typefounding Co.* v. *Richards* (*f*), a suit to restrain from infringing a patent for "improvements in the manufacture of type," the specification stated, "The object of the invention is to make type harder, tougher, and more enduring by employing tin in

(*c*) *Hastings* v. *Brown*, 1853, 22 L. J. Q. B. 161; 1 E. & B. 450; Higgins's Dig. p. 196; cp. *Mackelcan* v. *Rennie*, 1862, 13 C. B. N. S. 59. In *Philpott* v. *Hanbury*, 1885, 2 P. O. R. at p. 38, Grove, J., suggested the following test of sufficiency in the language of a complete specification: "Is this specification such that a fair man willing or wishing to understand the specification can reasonably gather from it what the patentee considers his invention, and what he says, he prohibits the public from using?" A specification which does not differentiate the useful from the useless at its various stages is bad for ambiguity. *Badische Anilin und Soda Fabrik* v. *Levinstein*, 1885, 2 P. O. R. at p. 115, per Bowen and Fry, L.JJ., cp. *Fairburn* v. *Household*, 1886, 3 P. O. R. 128.

(*d*) 1885, 2 P. O. R. 49. On a question of sufficiency, instructions issued by a patentee to workmen as to the mode of working his patented process are material. *Pooley* v. *Pointon*, 1885, 2 P. O. R. at p. 172.

(*e*) "If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court, and not for a workman to construe the specification, but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that as regards clearness of description the specification is in point of law sufficient," per Lindley, L. J., *Edison and Swan, &c. Co.* v. *Woodhouse*, 1887, 4 P. O. R. at p. 108.

(*f*) 1859, 1 Johns. 381.

large proportions with antimony and to greatly reduce or omit the use of lead. The best proportions I am acquainted with are seventy-five of tin, and twenty-five of antimony; but this may be to some extent varied; and when lead is also used, I find that it must not exceed fifty parts in one hundred of the combined metals employed."

A demurrer on the ground that this specification was bad for uncertainty was overruled.

"What I have to determine," said Wood, V.-C., "is whether this specification is so clearly and manifestly bad that no explanation by workmen or other experts . . . . could induce the Court to hold that this is a new invention set forth with sufficient clearness and precision. . . . A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say, 'I limit my claim to these precise proportions.' Even if the patentee had in terms absolutely tied himself down to 25 per cent. as a minimum in the place of 1 or 2 per cent.—supposing that to be the proportion previously used—a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent.

Reasonable latitude allowed.

"It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a useful practice, whether anything of the kind was ever done before, and whether a variation from the given proportion to others slightly different, would not be a colourable evasion. These are all questions for a jury. The only opinion I express is *that the specification is not void on the face of it*" (*g*).

Exact proportions sometimes unnecessary.

Not only is a reasonable latitude in the statement of proportion permissible, but there are cases in which the exact proportions are not necessary in order to make the complete specification intelligible.

Thus, in the *British Dynamite Co.* v. *Krebs* (*h*), a suit for the infringement of a patent for "improvements in explosive compounds and in the means of igniting the same," the specification stated "the invention relates to the use of nitro-glycerine in an altered condition which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances . . . .

(*g*) See also *Betts* v. *Neilson*, 1868-71, per Lord Westbury, 5 H. L. at p. 21.

(*h*) 1875-79, Goodeve, P. C. 88; cp. *Otto* v. *Linford*, 1881-82, per Jessel, M. R., 46 L. T. 40.

whereby it is converted into a powder, which I call dynamite or Nobel's safety powder." It was objected that there was no sufficient statement of the quantity of the liquid to be absorbed. The House of Lords, however, restoring the order of Fry, J., which had been reversed by the Court of Appeal, held that the specification was sufficient.

"When you speak," said Lord Cairns, L. C., "of a porous substance absorbing a fluid, if the porous substance is in one piece, you naturally expect that the absorption will continue up to the point when the porous substance can hold no more; and when the porous substance is to continue a powder, the act of absorption itself will show the point at which the absorption must stop, lest the absorbing substance should become not a powder but a paste."

Ambiguity in the statement of materials.

In *Ralston* v. *Smith* (*i*), objections were raised to the specification, and particularly with regard to the uncertainty of the material, the language of the amended specification being that the plaintiff took "a roller of hard metal or other suitable material."

Lord Westbury said, "I do not think those words 'or other suitable material,' contain anything like such a generality of direction as would be fatal to the patent; 'other suitable material'; no doubt would mean any material equally sufficient for the purpose with hard metal."

Upon the same principle of *ejusdem generis*, specifications referring to "other combustible matter" (*k*), and "other substances" (*l*), have been supported.

In *Macnamara* v. *Hulse* (*m*), where the specification stated that the invention consisted in an improved method of cutting or forming stone, *or other suitable material*, for paving roads, Lord Abinger, C. B., observed, "I think that the words '*any other suitable material*' include a wood pavement, though probably the plaintiff never contemplated it."

In *Sturtz* v. *De la Rue* (*n*), a suit to restrain the infringement of a patent for "improvements in copper and other plate printing," the subject-matter was a method of preparing a glazed surface on paper by coating it with a mixture of white lead and size before the application of pressure. The specification directed that the white lead used should be "the finest and purest chemical white lead." The evidence showed that ordinary white lead would not answer

(*i*) 1865, 11 H. L. C. 248.
(*k*) *Bickford* v. *Skewes*, 1837-39, 8 L. J. Ch. 188; 4 My. & C. 498.
(*l*) *Crossley* v. *Beverley*, 1829, 9 B. & C. 63.
(*m*) 1842, Car. & M. 471.
(*n*) 1828, 1 Web. P. C. 83; Goodeve, P. C. p. 448.

the purpose, and that only a purer material imported from Germany, and sold at one particular shop in London, would produce the required effect. It was held that the specification was insufficient.

Full disclosure of materials necessary.

"It is a principle of patent law," said Lord Lyndhurst, L. C., "that there must be the utmost good faith in the specification. It must describe the invention in such a way that a person of ordinary skill in the trade shall be able to carry on the process. Here the specification says that there is to be added to the size certain proportions 'of the finest and purest chemical white lead.' A workman would naturally go to a chemist's shop, and ask for 'the finest and purest chemical white lead'; the answer which he would receive would be that there was no substance known in the trade by that name. He would be compelled to ask for the purest and finest white lead, and according to the evidence the purest and finest white lead that can be procured in London will not answer the purpose. It is said that there is a substance prepared on the continent, which is white lead or some preparation of white lead, and that by using it in the manner described in the specification the desired effect is produced. If that be so, the patentee ought to have directed the attention of the public to that circumstance. He ought to have said 'the purest white lead which can be obtained in the shops of London will not do; but there is a purer white lead prepared on the continent, and imported into this country, which alone must be used.' 'The purest and finest chemical white lead' must mean the finest and purest white lead usually gotten in the general market for that commodity, unless the public be put on their guard by a statement that what would be called very fine and pure white lead in the ordinary sense of the trade will not answer, but that the white lead used must be of a superlatively pure and fine quality prepared in a particular way, and to be gotten only in a particular place. If the article is not made in this country, but may be imported, it would be necessary to mention that circumstance."

Drawings.

As to the effect of drawings annexed to the specification, the law upon the subject is now tolerably clear. It may be stated as follows:—

An inventor is not tied down to make such a specification as, by words only, would enable a workman of ordinary skill to make his invention, but is allowed to call in aid the drawings (if any) (*o*)

(*o*) Cp. *Boulton* v. *Bull*, 1795, per Rooke, J., 2 H. Bl. 481; *Ex parte Fox*, 1812, per Lord Eldon, L. C., 1 V. & B. 67.

which he annexes to the specification (*q*). The drawings are to be taken as part of the specification (*r*), and are admissible to explain an ambiguity in the written description of the invention (*s*).

Fairburn v. *Household.*

The extent to which drawings can be relied on where there is ambiguity in a complete specification was considered in the recent case of *Fairburn* v. *Household* (*t*).

The question at issue here was, whether the patentee of an invention for "improvements in fluid injectors" had sufficiently claimed in his specification a lift for water by means of steam, "lifting the water, in the first instance, by a divided column into a vacuum chamber."

The plaintiff admitted that the claim was ambiguous, but contended that the ambiguity was removed by words in the specification referring to the drawings, that the Courts were therefore thrown back upon the description in the specification and annexed drawing, that on going back to the description they would find a steam lifter J. referred to, which appeared in the drawing as a transverse tube, and that every one would know what the effect of that tube would be, viz. to divide the rising column of water, and so make it into a double column.

The Court of Appeal, however, repelled these contentions, and held that the plaintiff had not sufficiently in his specification indicated that he claimed the transverse pipe dividing the column of water.

"A man," said Cotton, L. J., "in his specification ought to point out that which he says is the essential invention comprised here in more definite and explicit terms so as really to show what his invention is, and what he has claimed by the specification."

Verbal errors in complete specification.

A specification is not vitiated by a mere verbal error in the specification which cannot mislead, as where air is called an imponderable substance, or sulphur a mineral (*u*), nor by a mistake in a matter foreign to the invention, nor by the inaccurate use of

(*q*) *Bloxam* v. *Elsee*, 1825, per Abbott, C. J., 1 C. & P. 564.

(*r*) *Morgan* v. *Seaward*, 1836, 1 Web. P. C. 173; *Morton* v. *Middleton*, 1863, 1 Court of Sess. 3rd Series, 722, 724. Indeed, it seems that a specification might formerly consist of drawings alone. *Foxwell* v. *Bostock*, 1864, 4 De G. J. & S. 303; *Poupard* v. *Fardell*, 1869, 18 W. R. 129, overruling *Ex parte Fox*, *supra*; cp. *Brunton* v. *Hawkes*, 1820, 1 Carp. P. C. 410, per Abbott, C. J.: "If a drawing or figure enables workmen of ordinary skill to construct the improvement, it is as good as any written description." Now, however, claims at least would also be required.

(*s*) *Hastings* v. *Brown*, 1853, 1 E. & B. 454; *Daw* v. *Eley*, 1867, L. R. 3 Eq. 500, n.

(*t*) 1886, 3 P. O. R. 263.

(*u*) *Neilson* v. *Harford*, 1841, 1 Web. P. C. 331; Higgins's Dig. p. 221; cp. *Minter* v. *Mower*, 1835, 1 Web. P. C. 141.

words which are explained by the context, as where the word "discolouring" was used to signify depriving of colour, and the word "baked" to signify crystallized (*x*).

What errors are immaterial.

"When it is stated," said Lord Westbury, L. C., in *Simpson* v. *Holliday* (*y*), "that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture, and the reason is because such errors can not possibly mislead (*z*). But the proposition is not a correct statement of the law if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject."

Intentional surplusage.

The last form of ambiguity which it seems necessary to notice is intentional surplusage.

The insertion or representation of anything in a specification as being material, which is not so in fact, will vitiate the specification for insufficiency (*a*).

"It is incumbent on the patentee," said Ashhurst, J., in *Turner* v. *Winter* (*b*), "to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void."

So in *R.* v. *Arkwright* (*c*)—a *scire facias* to repeal a patent for improvements in the spinning jenny—where it was alleged that certain parts of the machine described were useless, Buller, J., directed the jury, "If those (parts) are of no use, but to be thrown in merely to puzzle, I have no difficulty in saying upon that ground alone that the patent is void. . . . . If four things only

(*x*) *Derosne* v. *Fairie*, 1835, 1 Web. P. C. 158.

(*y*) 1865, 13 W. R. 578.

(*z*) The Courts do not encourage verbal objections to the wording of specifications in the case of patents, which have stood for a long time the test of inquiry. *Betts* v. *Neilson*, 1868-71, per Lord Westbury, 5 H. L. 21.

(*a*) *Huddart* v. *Grimshaw*, 1803, 1 Web. P. C. at p. 93; *Harmar* v. *Playne*, 1809, 11 East, 107; *Campion* v. *Benyon*, 1821, 6 B. Moo. 71.

(*b*) 1787, 1 Web. P. C. 80.

(*c*) 1785, 1 Web. P. C. at pp. 66, 70; cp. *Lewis* v. *Marling*, 1829, per Lord Tenterden, C. J., 1 Web. P. C. at p. 495.

were necessary instead of ten, the specification does not contain a good account of the invention."

Misleading statements or omissions.

A patentee may break faith with the public by inserting in his specification statements which are misleading, and not merely ambiguous, or by failing to make a full and fair communication of his secret, and the best means of working it known to him at the time.

The cases which fall under this head may best be treated as illustrations of a series of short propositions.

Proposition.

I. It is the duty of anyone to whom a patent is granted to point out in his specification the plainest and most easy way known to the patentee at the time, of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts (*d*).

Specification must state plainest way of producing invention.

In *Savory* v. *Price* (*d*)—an action for the infringement of a patent for a method of making seidlitz powders—the specification gave three distinct recipes for preparing the ingredients, and then directed two scruples of each of the three ingredients resulting from those recipes to be dissolved in half a pint of water to produce the imitation of water from the medicinal springs at Seidlitz. It was proved that, by following the directions given in the specification, the result was obtained, and that it was new and useful. It appeared that the three recipes were only common processes for preparing three well-known substances, viz., Rochelle salts, carbonate of soda, and tartaric acid, which were sold in shops before the date of the patent, and those three substances being used as directed constituted the patent seidlitz powder, the specification did not give any name to the ingredients resulting from the three recipes, *but gave those recipes without comment, as if they were part of the method of making the seidlitz powder.* It was held that the patent could not be supported. "By reading this specification," said Abbott, C. J., "we are led to suppose a laborious process necessary to the production of the ingredients, when, in fact, we might go to any chemist's shop, and buy the same things ready made. The public are misled by this specification, which tends to make people believe that an elaborate process is essential to the invention."

In the case of an invention of little novelty or merit, the obligation to specify the easiest and best mode of working it is peculiarly binding upon the inventor.

(*d*) *Savory* v. *Price*, 1823, per Abbott, C. J., 1 Ry. & Mo. 3; and 1 Web. P. C. at p. 83.

"When you have such a little trumpery invention (as this)," said Jessel, M. R., in *Hinks* v. *Safety Lighting Co.* (*e*), "the whole merit of which is very small indeed, if you are to tell people how to do things better, you must tell them in a proper way without the exercise of any invention or much trouble."

Specification must disclose patentee's own way of producing invention.

Again, in *Wood* v. *Zimmer* (*f*), an action to try the validity of Zinck's patent for "a method of making verdigris." It appeared that the method described in the specification was sufficient to make the verdigris, but that Zinck had been accustomed *clandestinely* to put aquafortis, into the boiler whereby one of the ingredients (copper) was dissolved more rapidly, but the verdigris so produced was neither better nor cheaper than that made according to the specification. It was held that the patent was bad. In delivering judgment Gibbs, C. J., said:

"It is said that the method described makes verdigris, and that the specification is, therefore, sufficient. The law is not so: a man who applies for a patent and possesses a mode of carrying on that invention in the most beneficial manner must disclose the means of producing it in equal perfection and with as little expense and labour as it costs the inventor himself. The price that he pays for the patent is that he will enable the public at the expiration of his privilege to make it in the same way and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without *aquafortis* as with it, still, inasmuch as it would be made with more labour by the omission of *aquafortis*, it is a prejudicial concealment and a breach of the terms which the patentee makes with the public."

So, too, if the patentee make the article for which the patent is granted with *cheaper* materials than those which he has enumerated although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention or enable them to derive the same benefit which he himself does (*g*).

Specification must disclose

An inventor is not only at liberty, but is bound to give in his

(*e*) 1876, L. R. 4 Ch. D. 677; *Fletcher* v. *Arden*, 1888, per Bristowe, V.-C., 5 P. O. R. at p. 57.

(*f*) 1815, 1 Web. P. C. 82; cp. *R.* v. *Arkwright*, 1785, 1 Web. P. C. 66; *Tetley* v. *Easton*, 1852, Macr. P. C. 76. "A man has no right to patent a principle, and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it."

(*g*) *Turner* v. *Winter*, 1787, 1 Web. P. C. 81.

best way of producing invention known to patentee at time of specifying.

specification the most improved state of his invention known to him up to the time of specifying (*h*).

In the case of a communicated invention, the importer and not the foreign communicator is, for the purposes of this rule as for other purposes, the patentee, and the completeness of the disclosure is judged by the state of his knowledge alone (*i*).

But an imported invention must be communicated with sufficient exactitude to enable the importer to describe it so that the public in England reading the specification may be able to understand it (*k*).

Proposition. Method described must answer.

II. The specification must not contain a statement of any alleged method of producing the invention described therein which will not answer that purpose, and the deficiency of which is either known to the patentee, or would not be detected by an ordinary workman without further inquiry and experiment.

Thus in *Crompton* v. *Ibbotson* (*l*), the plaintiff's patent was for "an improved method of dyeing and finishing paper," and the specification described the invention to consist in conducting paper by means of cloth or cloths against a heated cylinder, and contained the following words: "which cloth may be made of any suitable material, but I prefer it to be made of linen, warp, and woollen weft." The patentee knew from repeated trials that no other substance would do.

Lord Tenterden, C. J., held that the specification was bad. "Other persons," said his lordship, "misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail; and the public, therefore, has not the full and certain benefit of the invention."

In the same case, Bayley, J., observed: "A party knowing that given materials will not answer the purpose, he is bound in his specification so to word it as to prevent parties from trying experiments on that which he knows will not answer" (*m*).

(*h*) *Bovill* v. *Moore*, 1816, per Gibbs, C. J., Dav. P. C. 400; *Lewis* v. *Marling*, 1829, per Bayley, J., 10 B. & C. 26; *Crossley* v. *Beverley*, 1830, 1 Web. P. C. 117; *Jones* v. *Heaton*, per Tindal, C. J., 1 Web. P. C. 404, *n.*; *Morgan* v. *Seaward*, 1836, per Alderson, B., 1 Web. P. C. 174; *Walton* v. *Bateman*, 1842, 1 Web. P. C. 622.

(*i*) *Plimpton* v. *Malcolmson*, 1875, per Jessel, M. R., 3 Ch. D. 576.

(*k*) *Wegmann* v. *Corcoran*, 1878–79, per Fry, J., 13 Ch. D. at p. 77.

(*l*) 1828, 1 Web. P. C. 83.

(*m*) *S. C.*, 1 Carp. P. C. 462; cp. *Derosne* v. *Fairie*, 1835, 1 Web. P. C. 165, side-note. "A specification must state at least one method which will succeed." *Beard* v. *Egerton*, 1846-49, per Maule, J., 19 L. J. at p. 39: "If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad." In *Cole* v. *Saqui*, 1888, 5 P. O. R. at p. 494, Kekewich, J., said, "I can see no objection to a patentee stating in his

Perhaps the clearest statement of the law on this question is that given in *Simpson* v. *Holliday* (*n*). *Simpson* v. *Holliday.*

The patentee of an invention for "improvements in the preparation of red and purple dyes," stated in his specification: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, *or* I accelerate the operation by heating it to, or near to, its boiling point." It was proved in evidence, and admitted by the plaintiff, that the operation would not succeed if conducted by the first of these methods, viz., without heat. Wood, V.-C., found that the specification was sufficient, and gave the following statement of the law. "If the Court had any notion whatever that (the first method) was put in with an intent to mislead, then without doubt or hesitation it would hold the patent to be bad, because there are two points in these cases of somewhat confused description in specifications which the Court mainly attends to—whether or no it has been put in with a fraudulent intent to mislead, which at once leads the Court to decide against the validity of the patent; or on the other hand whether, although put in innocently by mistake and without any fraudulent intent, it is such a description as will or can mislead any ordinary workman in the operation that he has to carry on."

On appeal, however, to the House of Lords, the findings of the Vice-Chancellor were reversed, and Lord Westbury, L. C., said (*o*):

"If the true construction of the specification be that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is therefore invalid and bad at law.

"If a specification alleges that a particular process which may be slow, troublesome, and expensive, is efficient, and the statement is untrue, the vice is not removed by the fact that the same specification also describes another process which is efficient, and which is stated to be speedy, certain, and economical."

specification that what he has invented with reference to some particular machine may be applied to other machines."

(*n*) 1864-66, Higgins's Dig. p. 194; 20 Newt. Lon. Jour. N. S. 108.

(*o*) *S. C.*, 5 N. R. p. 340; cp. *Bickford* v. *Skewes*, 1841, 1 Web. P. C. 218; *Neilson* v. *Harford*, 1841, 8 M. & W. 806; *Morgan* v. *Seaward*, 1835-37, per Alderson, B., 1 Web. P. C. 174; *Hinks* v. *Safety Lighting Co.*, 1876, per Jessel, M. R., 4 Ch. D. at p. 615; *British Dynamite Co.* v. *Krebs*, 1875-79, per James, L. J., Goodeve's P. C. p. 90; *Otto* v. *Linford*, 1881-82, per Jessel, M. R., 46 L. T. p. 40; *Philpott* v. *Hanbury*, 1885, 2 P. O. R. 33; *United Horsenail Co.* v. *Stewart*, 1885, 2 P. O. R. 122, 132, 133; *Coles* v. *Baylis*, 1886, 3 P. O. R. p. 180; *Kurtz* v. *Spence*, 1888, 5 P. O. R. at p. 183.

Proposition. Omission of material part of process.

III. The omission of any material part of a process is fatal to a specification.

Thus in a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, viz., rubbing it with tallow, and for want of that Lord Mansfield held the patent void (*p*).

Specification should distinguish novel and useful elements.

A specification should distinguish between what is new and what is old (*q*), what is useful and what is useless (*r*), in the invention which it describes.

Novel elements to be distinguished.

In *Holmes* v. *The L. & N. W. Rail. Co.* (*s*), the plaintiff had obtained a patent for "an improved turning table for railway purposes," all the component parts of which, except one, were comprised in a prior specification. The plaintiff claimed "the improved turning table hereinbefore described," without making any distinction between the various parts. The jury found that the introduction of certain suspending rods made the table a new instrument. The patent was, however, upset on the ground that the plaintiff had not complied with the rule which requires a patentee distinctly to state what is new and what is old.

Reasons for this rule.

One reason for this rule is stated by Abinger, C. B., in *Carpenter* v. *Smith* (*t*). "It is required as a condition of every patent that the patentee shall set forth in his specification a true account and description of his patent or invention, and it is necessary in that specification that he should state what his invention is, what he claims to be new, and what he admits to be old; for if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part or the combination of the whole as new, why then his patent must be taken to be a patent for the whole, and for each particular part, and his patent will be void if any particular part turns out to be old, or the combination itself not new."

Protection of patentee.

Protection of the public from actions

Another reason for the rule under consideration is thus defined by Cresswell, J., in *Gibson* v. *Brand* (*u*), "Every party is bound to

(*p*) *Liardet* v. *Johnson*, 1778, 1 Web. P. C. 53; *Potter* v. *Parr*, 1860, 2 B. & S. 216, n.

(*q*) *Manton* v. *Manton*, 1815, Dav. P. C. 349; *Carpenter* v. *Smith*, 1841, 1 Web. P. C. 532; *Crane* v. *Price*, 1842, 4 M. & G. 580, 608; *Tetley* v. *Easton*, 1853, Macr. P. C. 82, 87; *Newall* v. *Elliott*, 1864, per Pollock, C. B., 10 Jur. N. S. 956; *Renard* v. *Levinstein*, 1864, per Knight-Bruce, L. J., 10 L. T. N. S. 177; *Dangerfield* v. *Jones*, 1865, 13 L. T. N. S. 144.

(*r*) *Easterbrook* v. *G. W. Rail. Co.*, 1885, 2 P. O. R. 210.

(*s*) 1852, Macr. P. C. 13; Higgins's Dig. 199.

(*t*) *Ubi supra.*

(*u*) 1842, 1 Web. P. C. 640: cp. *Manton* v. *Manton*, 1815, per Gibbs, C. J., Dav. P.

tell the public clearly, by his specification, what he claims, and what they may do or not do without risk of an action for infringing his patent."

for infringement.

In the specification of a patent for an *improved* instrument or invention, the improvement must be distinctly pointed out.

Specification must point out improvements.

The earliest authority for this proposition is *Williams* v. *Brodie* (*x*).

Illustrative cases.

The plaintiff's invention, which was admitted to be ingenious and useful, consisted in the insertion of a pipe into an old stove for conveying the air into it, but the letters patent and the specification embraced the whole apparatus, and did not confine the invention to the application or addition of the pipe to an old stove, the patent was held void.

Williams v. *Brodie.*

In *Harmar* v. *Playne* (*y*), it was held that a specification describing a whole machine, the subject of two patents, but not referring to the former specification, or pointing out the particular improvement, the subject of the latter patent, was a sufficient compliance with the proviso of the second letters patent, which recited the former letters patent. The principle of this decision appears to have been that, inasmuch as in the second patent the plaintiff had recited the first patent, and the specification under it, the recital, being in immediate comparison with the new specification, furnished *in gremio* of the new patent the means of distinguishing the new from the old (*z*).

Harmar v. *Playne.*

Macfarlane v. *Price* (*a*) was an action for the infringement of the plaintiff's patent for "certain improvements in the making of umbrellas and parasols." The specification and accompanying drawings contained a minute detail of the mode of constructing the improved umbrellas and parasols, but no distinction was made between what was new and what was old. One of the annexed

Macfarlane v. *Price.*

C. 349. "It is necessary that the patentee should show that he has accurately explained the nature of his invention in his specification, separating that which is new from that which is old, so as to enable a person of tolerable skill to make the thing by means of his specification."

(*x*) Before 1785, 1 Web. P. C. 75; Higgins's Dig. 210; Dav. P. C. 96; cp. *Hornblower* v. *Boulton*, 1799, 8 T. R. 103; *Hill* v. *Thompson*, 1818, 1 Web. P. C. 247.

(*y*) 1809, 1 Web. P. C. 75; 11 East, 101.

(*z*) Per Lord Westbury, L. C., in *Foxwell* v. *Bostock*, 1864, 4 De G. J. & S. at p. 311.

(*a*) 1816. "This case," says Mr. Webster, "has been occasionally cited as an authority against a drawing accompanying the specification being considered as part of the specification, but it is no authority for such a doctrine; and Lord Lyndhurst, C. B., on one occasion remarked 'that the above was a complicated case, and that the rule was to be applied with certain limits, not where the thing is quite obvious and apparent.' It is now perfectly settled that a drawing alone may be a sufficient specification." 1 Web. P. C. 75.

drawings showed the particular part which had been pirated, and which was the substance of the invention. Lord Ellenborough, C. J., non-suited the plaintiff, on the ground that it would exceed the wit of man, unless he were previously acquainted with the construction of the instrument, to collect, from the whole of the figures, in what the improvement consisted (*b*).

Foxwell v. *Bostock.*

Here (*c*) the patent was for "improvements in machinery or apparatus for sewing or stitching," and the specification described the invention as consisting in "an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle." The drawings and the description exhibited and described an entire machine, and the composition and working of its several constituent parts, without in any manner indicating where the improvement lay, or in what it consisted. Westbury, L. C., held that the specification was insufficient.

"It must follow," said his Lordship in giving judgment, "that an accurate knowledge of all needle and shuttle machines which were known and used in England at the date of this patent is necessary in order to discover the differences and novelties that existed in this improved combination. The law requires that the specification should be intelligible to a workman of ordinary skill and information upon the subject. A new combination or improved arrangement of machinery, therefore, should be so described as that a person of ordinary knowledge on the subject may be able at once, on reading the specification, to perceive the invention and the manner in which it is to be performed. It is not sufficient to say that a person possessed of all the knowledge existing at the time of the patent on the subject of sewing machines will discern the improvement. . . .

"I must, therefore, lay down the rule which is consistent with and in reality a mere sequence from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty otherwise and in a more specific form than by the general description of the entire machine; it must, to use a logical phrase, assign the *differentia* of the new combination This obligation flows directly from the condition of the patent."

(*b*) Cp. *Bovill* v. *Moore*, 1816, Dav. P. C. 361; *Saunders* v. *Aston*, 1832, per Littledale, J., 3 B. & Ad. 881; *Kay* v. *Marshall*, 1836, 1 Web. P. C. 75.

(*c*) 1864, 4 De G. J. & S. 298, 309, 313; cp. *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358; *Rowcliffe* v. *Morris*, 1886, 3 P. O. R. at p. 23.

Sir W. M. James, V.-C., expressed himself to the same effect in *Parkes* v. *Stevens* (*d*). *Parkes v. Stevens.*

"It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new, and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and common-place—all that was the subject of other patents or of other improvements—bringing to the subject not only the knowledge of an ordinary skilled artisan, but of a patent lawyer or agent."

To the rule that a specification must distinguish the new elements in an invention from the old there are several exceptions or limitations. Limitations to rule.

A patentee need not disclaim matters which manifestly form no part of the invention (*e*). Immaterial elements.

"The rule may perhaps admit of some modification in favour of the patentee in respect of things incidentally mentioned which are old and universally known to be so; for if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new" (*f*). Elements known to be old.

If, taking the whole specification together, and giving its words a fair and reasonable interpretation, the Court can see that the specification only claims an improvement on an old machine, it will be sufficient (*g*). Specification sufficient if Court can see that only improvement claimed.

When a patentee takes out a fresh patent for improvements on his original invention, it is sufficient if an ordinary skilled artisan, reading the second specification with the first, would have no substantial difficulty in ascertaining what is claimed (*h*). Specification sufficient if intelligible to ordinary skilled artisan.

In *Shaw* v. *Jones* (*i*), a specification alleged not to particularly describe and ascertain the nature of an invention, and the manner in which it was to be performed, was held sufficient, on the evidence of witnesses who had done the very thing indicated in the specification, without other instructions than the specification itself.

Where a patentee claims a new combination only, and not the subordinate elements included in that combination, if the In patent for new combination only,

(*d*) *Supra.*
(*e*) *Lister* v. *Leather*, 1858, 8 E. & B. 1031; *Watling* v. *Stevens*, 1886, 3 P. O. R. 153.
(*f*) *Tetley* v. *Easton*, 1853, per Coleridge, J., Macr. P. C. 87.
(*g*) *McAlpine* v. *Mangnall*, 1846, 15 L. J. C. P. 298; 3 C. B. 518.
(*h*) *Parkes* v. *Stevens*, 1869, per James, V.-C., 8 Eq. at p. 365.
(*i*) 1889, 6 P. O. R. 335.

specification need not distinguish subordinate elements.

combination and the mode of working it are properly described, it is not necessary to specify which of the subordinate elements are new (*k*).

Novel elements distinguished by implication.

Again, if it appears from the reading of the specification that, although the patentee does not in so many words say, "I limit my claim to so and so," yet, if it plainly enough appears that he actually does only claim so and so, that is enough (*l*).

Specification must distinguish useful elements.

In *Easterbrook* v. *G. W. Rail. Co.* (*m*), an action for the infringement of a patent for "improvements in machinery or apparatus for actuating and controlling railway points or signals," it was proved at the trial that the plaintiff's apparatus could be so worked as to give conflicting signals, or signals conflicting with the points. It was strongly urged, however, on behalf of the plaintiff, that, inasmuch as the apparatus, when applied to very simple constructions of points and signals at Leigh, had performed its work for three or four years without accident, and was shown to have some utility, and that as a very small degree of utility was enough to support a patent, it was not bad on the ground of inutility. In disposing of this contention, Wills, J., said, "The specification here points to its universal application for railway signalling, including its use at the most complicated junctions and sidings. If it be useful for one very small and insignificant section of its proposed work, and for the rest is, as in my opinion it is proved to be, fraught with danger and death, the specification is bad as not distinguishing between its useful and its useless application (*n*). It is as consonant with good sense as I believe it to be with good law, that an inventor who invites the indiscriminate use of apparatus sure to bring about disaster in the long run, if generally applied according to his invitation, cannot maintain a patent for his invention because it will do some useful work at places and under circumstances where mechanical appliances for preventing conflict of signals are scarcely necessary at all, whilst elsewhere it is full of danger to the public."

To whom complete

The following proposition is submitted to be an accurate state-

(*k*) *Moore* v. *Bennett*, 1884, 1 P. O. R. 129. Where a specification claims a combination, of which part is new, the new part may be pointed out either in the body of the specification or in one of the claims. *Nordenfelt* v. *Gardner*, 1884, 1 P. O. R. 74; *Watling* v. *Stevens*, 1886, 3 P. O. R. p. 41; *Kaye* v. *Chubb*, 1888, 5 P. O. R. at p. 649; per Lord Watson in argument, "if you claim a combination you need not say which of the parts are old."

(*l*) *Morton* v. *Middleton*, 1863, 1 Court of Sess. 3rd series, 722.

(*m*) 1885-6, 2 P. O. R. 201; 3 P. O. R. 94.

(*n*) Cp. *Badische Anilin Fabrik* v. *Levinstein*, 1885, L. R. 29 Ch. D. 366; 2 P. O. R. pp. 115, 116.

ment of what may be called "the ordinary workman test" of the sufficiency of a complete specification :—

specification must be intelligible.

A complete specification is, and the Courts must declare it to be (*o*), sufficient in law, where the directions contained in it will enable the processes described to be successfully followed out, without the exercise of further inquiry, experiment, or invention by any careful workman, having a competent degree of knowledge upon the subject-matter to which the patent relates (*p*).

"The ordinary workman test" stated.

From the proposition above stated, the following rules are logically deducible :—

The person upon whose ability to understand a specification its sufficiency depends, is neither, upon the one hand, simply an uninstructed member of the general public (*q*), nor, upon the other hand, an eminent specialist or scientific workman, but to the workman of ordinary skill and information upon the subject (*r*).

Definition of ordinary workman.

"It is plain," said Jessel, M. R., in *Plimpton* v. *Malcolmson* (*s*), "that the specification of a patent is not addressed to people who are ignorant of the subject-matter. If it is a mechanical invention, you have, first of all, scientific mechanicians of the first class—eminent engineers; then you have scientific mechanicians of the second class—managers of great manufactories, great employers of labour, persons who have studied mechanics . . . and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant, even from slight hints and still more imperfect descriptions, and would be able to supplement, so as to succeed, even from a defective description, and even more than that, would be able to correct an erroneous description. . . . The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a

Specification not addressed to persons ignorant of subject-matter.

Test of sufficiency.

(*o*) *Edison and Swan, &c. Co.* v. *Woodhouse*, 1887, per Lindley, L. J., 4 P. O. R. at p. 108.

(*p*) *Bray* v. *Gardner*, 1887, 4 P. O. R. at p. 406; cp. *Wallington* v. *Dale*, 1851–52, per Alderson, B., 7 Ex. R. 888; *Edison Co.* v. *Holland*, 1889, 6 P. O. R. 243.

(*q*) *Arkwright* v. *Nightingale*, 1785, 1 Web. P. C. 60; *Harmar* v. *Playne*, 1809, Dav. P. C. 316, 318; *Neilson* v. *Harford*, 1841, 1 Web. P. C. 314.

(*r*) See cases cited under last note, and *R.* v. *Arkwright*, 1785, 1 Web. P. C. 66; *Hornblower* v. *Boulton*, 1799, Dav. P. C. 228; *Manton* v. *Manton*, 1815, Dav. P. C. 349; *Sturtz* v. *De la Rue*, 1828, 5 Russ. 327; *Morgan* v. *Seaward*, 1836, 1 Web. P. C. 176; *Galloway* v. *Bleaden*, 1839, 1 Web. P. C. 524; *Elliott* v. *Aston*, 1841, 1 Q. B. 938; *Gibson* v. *Brand*, 1842, 1 Web. P. C. 629; *Household Co.* v. *Neilson*, 1842, 1 Web. P. C. 676, 692; *Heath* v. *Unwin*, 1852, 2 Web. P. C. 245; *Foxwell* v. *Bostock*, 1864, 10 L. T. N. S. 147.

(*s*) 1875, L. R. 4 Ch. D. at p. 568; cp. *Bray* v. *Gardner*, 1887, 4 P. O. R. at p. 406.

careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. . . . It will be a bad specification if the first two classes only understand it, and if the third class do not."

Workman must bring his knowledge to bear on specification.

The ordinary workman, as above defined, must not only possess competent knowledge, but must bring it to bear on the specification before him (*t*), and a specification need not explain any facts with which an ordinary workman must necessarily be acquainted (*u*).

Thus, in *Crossley* v. *Beverley* (*x*), an action for the infringement of a patent for an "improved gas apparatus." An objection that the gas-making apparatus was incomplete, because the specification gave no directions respecting a condenser, was overruled. "A workman," said Lord Tenterden, C. J., "who was capable of making a gas apparatus would know that he must put in a condenser. The specification does not tell you to leave it out."

Workman not bound to exercise invention or ingenuity.

But while a workman is bound to exercise all the actual existing knowledge common to the trade, he cannot be called upon to exercise anything more. He cannot be called upon to tax his ingenuity or invention (*y*), and if experiments are necessary in order to produce any beneficial effect from an invention at all, the specification will be bad (*z*).

In *Macnamara* v. *Hulse* (*a*), an action for the infringement of a patent for "certain improvements in paving, pitching, or covering streets, roads, and other ways," the specification stated, "My invention consists in an improved mode of cutting or forming stone, or other suitable material for paving or covering roads or other places," and directed the blocks to be used for paving to be bevelled both inwards and outwards, but said nothing as to the angle at which the bevels were to be made.

Lord Abinger, C. B., said, "It will be for the jury to say whether any particular angle is essential, or whether any angle whatever is useful and beneficial. . . . *If the specification leaves it to*

(*t*) "A specification," said Maule, J., during the argument in *Beard* v. *Egerton*, 1849, 19 L. J. C. P. 36, "is not to compel a person who is determined to misunderstand to learn, but to direct one who is willing to understand."

(*u*) *Badische Anilin Fabrik* v. *Levinstein*, 1887, per Lord Herschell, 4 P. O. R. at p. 469.

(*x*) 1829, 3 C. & P. 513; *Morgan* v. *Seaward*, 1836, 1 Web. P. C. 176.

(*y*) *Morgan* v. *Seaward*, 1836, per Alderson, B., 1 Web. P. C. 174; cp. *R.* v. *Arkwright*, 1785, 1 Web. P. C. 67; *R.* v. *Wheeler*, 1819, per Abbott, C. J., 2 B. & Ald. 354; *Macnamara* v. *Hulse*, 1842, 1 C. & M. 477; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 109.

(*z*) *Neilson* v. *Harford*, 1841, per Parke, B., 1 Web. P. C. 371.

(*a*) 1842, 2 Web. P. C. 128, 129.

experiment to determine what is the proper angle, it is not good, but if any angle is a benefit, it will do."

And so, where in his specification a patentee said that a bowl might be filled or partially filled with a liquid to produce a certain effect, and it appeared that the effect was best procured when the bowl was partially filled, but that there was some effect when it was completely filled, it was held that the specification was sufficient (*b*).

Patent actions are now tried without a jury unless the Court otherwise directs (*c*). In a jury trial, the construction of the specification would be for the judge, its sufficiency would be for the jury, to determine (*d*).

Questions of law and fact in regard to comparison of specifications.

The law as to the respective functions of judge and jury in regard to the comparison of specifications was very clearly stated by Wilde, B., in his answers to the questions put to the judges by the House of Lords in *Betts* v. *Menzies* (*e*) :—"If the terms of the two specifications are identical, and if it is not disputed that the terms of art used in the one have the same meaning as the same terms used in the other, which, from the lapse of time between the dates of the two patents may not always be the case, the Court ought to determine that the first publication anticipated the second, without evidence, and without any proof that either the first or second was practicable. If, though not identical, the language used in the two, when construed by the Court, describes identically the same process, machine, or manufacture, the Court may, subject to the same remark as to the terms of art, decide at once upon the question of anticipation. But if after construction, and after the meaning of the parties in the two documents has been ascertained by the Court, there be any difference between the two things described, which may be essential or material to the invention, and which is contended by either of the parties to be essential or material to the invention, the Court cannot decide such a controversy; it has neither materials nor means for so doing, and it

(*b*) *Thomson* v. *Batty*, 1889, 6 P. O. R. 84, 97.

(*c*) Act of 1883, s. 28, sub-s. (1).

(*d*) *Hill* v. *Thompson*, 1817, 1 Web. P. C. 235; *Bickford* v. *Skewes*, 1841, 1 Web. P. C. 214; *Neilson* v. *Harford*, 1841, 1 Web. P. C. 295; *Walton* v. *Bateman*, 1842, 1 Web. P. C. 621; *Beard* v. *Egerton*, 1848, 19 L. J. C. P. 38; *Wallington* v. *Dale*, 1852, 7 Ex. 888; *Morton* v. *Middleton*, 1863, 1 Ct. of Sess., 3rd ser. 721; *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358.

(*e*) 1862, 10 H. L. C. 134; cp. *Muntz* v. *Foster*, 1842, per Tindal, C. J., 2 Web. P. C. 105; *Allen* v. *Rawson*, 1845, 1 C. B. 571; *Tetley* v. *Easton*, 1852, Macr. P. C. 68; *Bush* v. *Fox*, 1856, Macr. P. C. 178; *Booth* v. *Kennard*, 1857, 2 H. & N. 84; *Thomas* v. *Foxwell*, 1858, 5 Jur. N. S. 38; 8 Jur. N. S. 271; *Hills* v. *London Gas Light Co.*, 1860, 5 H. & N. 363; *Hills* v. *Evans*, 1862, 31 L. J. Ch. 457.

must go to a jury. In a word, the Court can pronounce two identical descriptions to portray two identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence."

3. *Construction of Complete Specification.*

Various ideas of construction.

Various ideas have prevailed, in the development of our patent law, as to the principles on which the specification of an invention ought to be construed.

Strict interpretation.

In early times, it was the fashion of the Courts of justice to lean in favour of the public against the patentee, under the notions that a patent was a monopoly, that all monopolies were odious, and that the specification could not, therefore, be too critically scanned (*f*).

Benevolent interpretation.

About the year 1830 (*g*), the theory of strict interpretation was abandoned: the Courts seemed rather to lean in favour of the patentee against the public, and expressions were used which encouraged the idea that a peculiarly favourable construction was to be placed upon the language of specifications, so as, if possible, to support the patents to which they related (*h*).

With regard to this doctrine of "benevolent interpretation," it must be observed that the evidence for its existence rests chiefly on isolated dicta (*i*), and that a strong counter-current of authorities supports the modern theory of construction which will be dealt with later on.

Thus, in *Harworth* v. *Hardcastle* (*k*), Tindal, C. J., said: "There can be no rule of law which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts would warrant; on the

(*f*) *Hullett* v. *Hague*, 1831, 2 B. & Ad. 377; *Neilson* v. *Harford*, 1841, 1 Web. P. C. 310; *Stevens* v. *Keating*, 1847, per Pollock, C. B., 2 Web. P. C. 187; *Cropper* v. *Smith*, 1884, per Bowen, L. J., 1 P. O. R. pp. 90, 91.

(*g*) Cp. *Neilson* v. *Harford*, 1841, per Parke, B., 1 Web. P. C. at p. 310. "Within the last ten years or more the Courts have not been so strict in taking objections to the specification, and they have endeavoured to hold a fair hand between the patentee and the public, being willing to give to the patentee on his part the reward of a valuable patent, but taking care to secure to the public on the other hand the benefit of that proviso which is introduced into the patent for their advantage."

(*h*) *Stevens* v. *Keating*, *ubi supra*.

(*i*) Thus in *Sellers* v. *Dickinson*, 1850, 20 L. J. Ex. 417; 5 Ex. 324, Pollock, C. B., observed: "The specification should be met with candour and indulgence," and in *Palmer* v. *Wagstaffe*, 1854, 9 Exch. 501, 23 L. J. Ex. 217, his lordship said: "I think that every patent should be expounded favourably to the patentee." But in each case the scope of the dictum is limited by the context, and the modern theory of construction, which will be noticed immediately, was very clearly foreshadowed by the same learned judge. Cp. *Stevens* v. *Keating*, 1847, 2 Web. P. C. 187; *Tetley* v. *Easton*, 1852, Macr. P. C. 74, 76.

(*k*) 1834, 1 Web. P. C. 485.

contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent."

Again, in *Russell* v. *Cowley* (*l*), Alderson, B., said: "The specification ought to be taken as a whole, and fairly and candidly construed, without astuteness to pick holes in it"; and in *Elliott* v. *Turner* (*m*), Parke, B., told the jury that the language of a specification ought to be construed according to its ordinary and proper sense, unless it be shown by something in the context (which may be explained by evidence) that a different construction ought to be adopted.

Jessel, M.R., on the "benevolent interpretation" of specifications.

A new definition of the benevolent interpretation theory was given by the late Master of the Rolls.

In *Hinks* v. *Safety Lighting Co.* (*n*), his lordship said: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections, or on mere cavillings with the language of the specification, so as to deprive the inventor of the benefit of his invention.

"Judicial anxiety" to support a useful invention.

"This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly, with *a judicial anxiety* to support a really useful invention, and it can be supported on a reasonable construction of the patent. Beyond that the benevolent mode of construction does not go. It was never intended to make use of ambiguous expressions with a view of protecting that which was not intended to be so protected by law, whether or not it was an invention unknown to himself."

Substantial invention of merit.

In *Plimpton* v. *Spiller* (*o*), Sir George Jessel, said: "When the judge sees that there is a real substantial invention of great merit, and the description is fairly made, so that a competent workman can make the invention, it is not his duty to endeavour to construe the patent so as to make it claim that which it is utterly absurd to

(*l*) 1834, 1 Web. P. C. 470. In the same case Parke, B., observed: "In the construction of a patent, the Court is bound to read the specification so as to support it, if it can fairly be done."

(*m*) 1845, 15 L. J. C. P. 49; 2 C. B. 461; cp. *Household Co.* v. *Neilson*, 1843, 1 Web. P. C. 679; *Beard* v. *Egerton*, 1848, 8 C. B. 165; *Trotman* v. *Wood*, 1864, per Willes, J., 16 C. B. at p. 503; *Simpson* v. *Holliday*, 1866, 13 W. R. 678; *Adie* v. *Clark*, 1876, per James, L. J., L. R. 3 C. D. at p. 142.

(*n*) 1876, L. R. 4 C. D. at p. 412.

(*o*) 1876-77, L. R. 4 C. D. at p. 422.

suppose would be claimed because it is so well known as a matter of public notoriety that nobody would think of claiming such a thing."

These passages should be compared with the language of the same learned judge in *Otto* v. *Linford* (*p*).

"I have heard judges say, and I have read that other judges have said, that there should be a benevolent interpretation of specifications. What does this mean? I think, as I have explained elsewhere, it means this: when the judges are convinced that there is a genuine great and important invention, which, as in some cases, one might almost say produces a revolution in a given art or manufacture, the judges are not to be astute to find defects in the specification (*q*), but, on the contrary, if it is possible consistently with the ordinary rules of construction, to put such a construction on the patent as will support it. They are to prefer that construction to another which might possibly commend itself to their minds if the patent was of little worth and of very little importance. That has been carried out over and over again, not only by the Lord Chancellor on appeal, but by the House of Lords. There is, if I may say so, and I think there ought to be, a bias, as between two different constructions, in favour of the real improvement and genuine invention, to adopt that construction which supports an invention. Beyond that I think the rule ought not to go."

Cropper v. *Smith*.

Bowen, L. J., on "benevolent construction."

In *Cropper* v. *Smith* (*r*) the doctrine of benevolent interpretation was reduced to its proper proportions. "We were pressed very earnestly," said Bowen, L. J., "to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts, it became necessary for the tribunal to warn itself that patentees must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special

(*p*) 1881-82, 46 L. T. at p. 39.
(*q*) Cp. *Bickford* v. *Skewes*, 1841, 1 Web. P. C. 219.
(*r*) 1884, 1 P. O. R. at pp. 89, 90; *Sugg* v. *Bray*, 1885, per North, J., 2 P. O. R. at pp. 230, 231.

to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Shepperd's Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign. '*Verba debent intelligi cum effectu ut res magis valeat quam pereat*' (*s*). Now that is only a caution against excessive formalism; it only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by their deed, and you must not defeat it if effect can be given to their intention by a fair construction of the whole of the document. It is almost always coupled with another maxim which seems to me really to be the same thing in another shape. '*Verba intentioni debent inservire.*' You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it, when the validity of a patent is in question, it certainly never can be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document; it is not an excuse to justify you in misconstruing a document" (*t*).

Present theory of construction.

The leading principles applicable to the construction of a specification have now been clearly settled.

"It ought to be construed like any other legal document as a whole," said Chitty, J., in *Lister* v. *Norton* (*u*), "It certainly ought not to be construed malevolently; I will not say it ought to be construed benevolently; I do say it ought to be construed fairly. It must be read by a mind willing to understand, not by a mind desirous of misunderstanding. Inventors, and those

(*s*) Cp. *Boulton and Watt* v. *Bull*, 1793-99, per Eyre, C. J., Dav. P. C. at p. 212; *Thomas* v. *Foxwell*, 1858-59, per Pollock, C. B., 6 Jur. at p. 272.

(*t*) In *Newton* v. *Grand Junction Rail. Co.*, 1845-46, 5 Ex. at p. 335, Rolfe, B., said: "The defendant's counsel discussed and scanned the language of the specification in the same sort of spirit as if it were a plea or replication specially demurred. That is not the spirit in which a specification should be inspected. The proper mode is to construe it, and see what is the good sense of it, and whether that which the patentee claims as his invention is there distinctly and clearly explained." See 20 L. J. Ex. 427, n. Cp. *Automatic Weighing Co.* v. *Knight*, 1889, per Lindley, L. J., 6 P. O. R., at p. 307.

(*u*) 1886, 3 P. O. R. at p. 203.

who assist them, are seldom skilled adepts in the use of language; faults of expression may be got over where there is no substantial doubt as to the meaning. The persons to whom a specification is particularly addressed are those who are conversant with the business to which the invention relates. The specification is sufficient if a person of ordinary skill and intelligence in the business can understand the directions and work upon them without experiments. The specification must define in reasonable terms the ambit of the invention, and thus give fair warning to the public what the invention is for which the monopoly is claimed."

Needham v. *Johnson.*

In *Needham* v. *Johnson* (*x*), Lindley, L. J., said: "I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but, of course, if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid. There is no particular benevolence in that. It is a general principle of interpretation applicable to all documents; but, of course, those who talk about the benevolent interpretation do not mean more than that. They do not mean you are to put upon a specification a benevolent interpretation which will turn that into an infringement which is not an infringement. Benevolent interpretation has nothing to do with infringement: it has to do with the validity of specifications."

Perhaps the most terse statement of the present law is that given by Lord Chelmsford in *Harrison* v. *Anderston Foundry Co.* (*y*).

"In the construction of a specification it appears to me that it ought not to be subjected to what has been called a benign interpretation or to a strict one. The language should be construed according to its ordinary meaning—the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention—and if the specification is thus sufficiently intelligible it performs all that is required of it."

Construction in particular cases.

The construction of particular specifications cannot profitably be considered here. Each case is dealt with upon its own merits (*z*).

(*x*) 1884, 1 P. O. R. at p. 58.

(*y*) 1876, 1 App. Cas. at p. 579; cp. *Adie* v. *Clark*, 1876, per James, L. J., 3 Ch. D. at p. 142; *S. C.*, per Lord Hatherley, 2 App. Cas. at p. 433; *S. C.*, per Lord Blackburn, 2 App. Cas. at p. 436; *Dudgeon* v. *Thomson*, 1877, per Lord Blackburn, 3 App. Cas. at p. 53; *Roberts* v. *Heywood*, 1879, 27 W. R. 454.

(*z*) See *Forsyth* v. *Riviere*, 1819, 1 Web. P. C. 97; *Minter* v. *Wells*, 1834, 1 Web. P. C. 134; *Russell* v. *Cowley*, 1835,

4. *The Claims.*

A claim is a short clause inserted in a specification, whereby the patentee particularly points out what he claims as his invention. Definition of claim.

Regarded from the point of view of the specification, "a claim is," in the language of Mr. Justice Kay in *Lucas* v. *Miller* (*a*), "in point of fact a disclaimer; it shows what parts, and what parts only, of the whole invention you mean to protect by your patent." Function of claim.

"The claim," said Lord Cottenham, L. C., in *Kay* v. *Marshall* (*b*), "is introduced lest, in describing and ascertaining the nature of his invention, and by what means the same is to be performed . . . . the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new."

Prior to the Patents Act, 1883, although usual, it was unnecessary to insert claiming clauses in the specification of inventions. Thus, in *Lister* v. *Leather* (*c*), Williams, J., said, "Neither a claim nor a disclaimer is essential to a specification; that which appears to be the invention or part of it will be protected, though there be no claim." Origin of claims.

The Act of 1883, s. 5, sub-s. 5, however, provides that a complete specification "must end with a distinct statement of the invention claimed." Act of 1883, s. 5, sub-s. 5.

Several points of importance have been decided under this subsection.

Provided the specification ends with a statement of the invention

1 Web. P. C. 463; *Gibson* v. *Brand*, 1842, 1 Web. P. C. 631; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 104; *Elliott* v. *Turner*, 1845, 2 C. B. 446; *McAlpine* v. *Mangnall*, 1846, 3 C. B. 496; *Barker* v. *Grace*, 1847, 17 L. J. Ex. 122; 1 Ex. 339, 344; *Stevens* v. *Keating*, 1848, 2 Exch. 772; *Beard* v. *Egerton*, 1849, 8 C. B. 165; *Holmes* v. *L. & N. W. Rail. Co.*, 1852, Macr. P. C. 27; *Hills* v. *London Gas Light Co.*, 1857, 27 L. J. Ex. 60, and 1860, 29 L. J. Ex. 409; *Thomas* v. *Foxwell*, 1859, 5 H. & N. 368; *Oxley* v. *Holden*, 1860, 8 C. B. N. S. 666; *Ralston* v. *Smith*, 1865, 11 H. L. C. 223; *Thomas* v. *Welch*, 1866, L. R. 1 C. P. 192; *Jordan* v. *Moore*, 1866, L. R. 1 C. P. 624; *Binney* v. *Feldt*, 1871-75, Griffin, P. C. 49; *Spencer* v. *Ancoats, &c., Co.*, 1889, 6 P. O. R. 46; *Automatic Weighing Co.* v. *Knight*, 1889, *ubi sup.*, at p. 297; *Boyd* v. *Horrocks*, 1889, 6 P. O. R. 159; *Hocking Co.* v. *Hocking*, 1889, 6 P. O. R. 69; *Thomson* v. *American Braided Wire Co.*, 1889, 6 P. O. R. 525.

(*a*) 1885, 2 P. O. R. at p. 159; cp. *Plimpton* v. *Spiller*, 1876-77, per James, L. J., 6 Ch. D. at p. 426.

(*b*) 1836, 2 Web. P. C. 39: *Jackson* v. *Wolstenholmes*, 1884, 1 P. O. R. at p. 108; *Easterbrook* v. *G. W. Rail. Co.*, per Wills, J., 1885, 2 P. O. R. at p. 208.

(*c*) 1858, 1 E. & B. at p. 1033.

claimed distinct from the description of the invention contained in the specification, sub-sect. 5 of sect. 5 is complied with, and there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given (*d*). There must, however, be a real statement of the invention claimed, and not merely a colourable compliance with the terms of the statute, as by reference to the previous description, *e. g.*, "I claim the invention described in the specification," would not be regarded as sufficient (*e*).

"A distinct statement" means something more than a separate paragraph. The Legislature contemplated a distinct summary of the main features of the invention, something to which the reader might readily refer and learn therefrom, without referring to the body of the invention, what the characteristic features of the invention claimed were (*f*).

Although a complete specification does not conclude with "a distinct statement" as above defined, that is a matter purely directory; it is not made a ground of avoidance under the 26th section of the Act, and cannot be urged as an objection to the validity of a patent (*g*).

General rules. A few general rules may be laid down as to the requisites and characteristics of a valid claiming clause.

Claim must not go beyond invention.

1. The claim must not go beyond the invention.

Thus, a patentee must not claim what someone else has invented. In *Minter* v. *Mower* (*h*), the patent was taken out for "an improvement in the construction, making, or manufacturing of chairs." The specification concluded, "what I claim as my in-

(*d*) *Aliter* in America and Germany. The official interference with claims which in England is practically non-existent, is in America often very minute and harassing. In Germany patent claims are drawn by the official examiners themselves.

(*e*) *Re Smith*, per Herschell, S.-G., Griffin, P. C. 268.

(*f*) *Siddell* v. *Vickers*, 1888, per Lopes, L. J., 5 P. O. R. at p. 433. In this case a majority of the Court of Appeal held a claim for "the general construction, adaptation, or application, and the combination and use of the several parts in the whole constituting improved, more simple and efficient appliances, or means for working or operating on iron or steel forgings substantially as hereinbefore set forth, and as illustrated in the accompanying drawings," not to be "a distinct statement" within this subsection.

(*g*) *S. C.*, *ubi supra*, per Fry, L. J.

(*h*) 1837, 1 Web. P. C. 142; *R.* v. *Else*, 1785, 1 Web. P. C. 76; *Huddard* v. *Grimshaw*, 1803, 1 Web. P. C. 86; *Bovill* v. *Moore*, 1816, Dav. P. C. 404. If the patentee has claimed too much it is immaterial whether he has done so fraudulently, or inadvertently: *Ibid.* 414; *Hill* v. *Thompson*, 1817, 1 Web. P. C. 237; *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169: *Gibson* v. *Brand*, 1842, 1 Web. P. C. 613, 634; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 110; *Gamble* v. *Kurtz*, 1846, 3 C. B. 425; *Thomas* v. *Foxwell*, 1858, 5 Jur. N. S. 37, affirmed 6 Jur. N. S. 271; *Rushton* v. *Crawley*, 1870, L. R. 10 Eq. 527.

vention is, the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as above described." It was clear upon the evidence that the description applied to a chair (acting on the same principle as that which the patentee claimed) which had been constructed and sold by a person of the name of Brown, before the date of the patent: this chair had, however, been encumbered by additional machinery. It was held that the specification was bad.

"The specification," said Denman, C. J., "claimed more than the plaintiff had invented, and would have actually precluded Brown from continuing to make the same chair that he had made before the patentee's discovery. We are far from thinking that the patentee might not have established his title by showing that a part of Brown's chair could have effected that for which the whole was designed. But his claim is not for an improvement upon Brown's leverage, but for a leverage so described that the description comprehended Brown's."

Again, the patentee must not claim more than he has himself invented.

In *Bloxam* v. *Elsee* (*i*), the patent was for a machine for "making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length." It was held by the Court of King's Bench that the meaning of this was that paper of various widths might be obtained from one and the same machine, and that as the evidence showed that the patentee was not, at the time of taking out the patent, possessed of any machine capable of accomplishing this object, the claim was bad.

2. A patent was formerly held not to be void because the patentee claimed as part of his invention something which was not described as essential, and which proved to be useless (*k*). But this is now not the law.

In *Reg.* v. *Cutler* (*l*), the case of *Lewis* v. *Marling* (*k*) was quoted as establishing the doctrine that if the specification of a patent described two modes of performing one part of the invention, if either of those methods were proved to be satisfactory, the patent might be good, notwithstanding the imperfection of the other; and

Reg. v. *Cutler.*

(*i*) 1827, 6 B. & C. 169.
(*k*) *Lewis* v. *Marling*, 1829, per Lord Tenterden, C. J., 10 B. & C. at p. 25.
(*l*) 1849, 14 Q. B. 372, n.; *Beard* v. *Egerton*, 1849, per Maule, J., 19 L. J. C. P. 40.

Denman, C. J., had directed the jury that this was the law. The Court of Queen's Bench, however, held that this was a misdirection.

"The Court," said Denman, C. J., referring to *Lewis* v. *Marling* (*l*), "there only said that the claim of some part of the machine which turned out to be useless did not vitiate the patent. This is certainly a very different thing from describing a part of the machine as capable of co-operating in the work, when in fact it is incapable, even though at the same time other means are described which might be effectually employed. The reader of the specification relying upon it might attempt to use the former mode in constructing the machinery, which would fail of its purpose from being too accurately made according to the patentee's instructions."

Simpson v. *Holliday* (*m*) is a conclusive authority in favour of the law laid down by the Court of King's Bench in *Reg.* v. *Cutler*. This was a suit to restrain the infringement of a patent for "improvements in the preparation of red and purple dyes." The specification stated: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, *or* I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour." It was proved in evidence, and admitted by the plaintiff, that the latter process would not succeed. It was held that the patent was invalid.

"If the true construction of the specification," said Lord Westbury, L. C., "be that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is therefore invalid and bad at law."

Claim must not be too wide—

3. A claim must not be too wide, either in itself or upon the evidence.

either apart from the evidence,

In *Wyeth* v. *Stone*, an American case mentioned by Mr. Justice Curtis in his work on *Patents* (*n*), a person, who had invented some mode of cutting ice, stated in his claim, "I claim every mode of cutting ice, except by human power." "If a man," said Lord Hatherley, L. C., in *Arnold* v. *Bradbury* (*o*), "chooses to put forward his claim in so preposterous a form as that, of course he

(*l*) 1829, per Lord Tenterden, C. J., 10 B. & C. at p. 25.
(*m*) 1866, 5 N. R. 340.
(*n*) Sect. 148, and 1 Story, 273.
(*o*) 1871, L. R. 6 Ch. at p. 711. A claim for a principle to be carried into effect any way you will would be bad: per Alderson, B., in *Neilson* v. *Harford*, 1841, 1 Web. P. C. at p. 355.

must take the consequences." . . . "A claim," added his lordship, "must be very large and very vague indeed to justify any Court in saying that it is impossible to sustain a patent based upon it."

Jordan v. *Moore* (*p*) is the nearest case in the English law books of a claim being held too large, independently of the external evidence, but it falls short of being a precedent, and comes under the second part of the rule. There the patentee claimed in one part of the claim "an iron frame for vessels, in combination with a certain arrangement of wood, forming a lining either without or within this iron frame," and in another part of the claim he spoke of "the iron frame as herein described." It was held that by using the two forms of claim he showed that he intended the first to be more general than the second, and that his object was in the first to make a general claim to every ship constructed with an iron frame, and which was lined within or without with wood. Therefore the Court, having evidence before it that there had existed ships with iron framings similar to that which the plaintiff had claimed, held that the claim was too large.

or upon the evidence.

In *Patterson* v. *The Gas Light and Coke Co.* (*q*)—a suit to restrain the infringement of a patent for "improvements in the purification of coal gas"—the patentee's second claim was for "a method or system of employing lime purifiers in the manner hereinbefore described, whereby the contents of all the said purifiers, or any required number of them, can be converted into sulphides of calcium, and also (if required) be maintained in that condition." It was held by the Court of Appeal that this claim was too general. "There is (here)," said James, L. J., "no suggestion of any new apparatus, of any new process. There is no device or scheme of any kind. Lime purifiers in succession were in general, almost universal, use, wherever lime could be freely used. The gas entered one, passed from that to another, and then generally or sometimes to a third; the gas, partly purified in the washers and scrubbers, passed through the series of lime purifiers into an oxide of iron purifier. That was the process before, and that is to remain the process after and under the plaintiff's patent. What he claims to have discovered is, that if the carbonic acid which is the first thing taken up by the lime, is not wholly taken up at the beginning, and is allowed to enter the last purifier or purifiers, it in fact poisons the latter, decomposes the sulphide of calcium

Claim too general.

(*p*) 1866, L. R. 1 C. P. 624; and per Lord Hatherley, *ubi supra*.

(*q*) 1875-76, L. R. 2 Ch. D. 812, 834.

already formed, disengages the other sulphur absorbed by the sulphide, and of course fills the gas again with the sulphur impurities which had been removed. . . . This may be a direction and instruction of the greatest possible value and utility, but it is utterly impossible to make such a direction and instruction, however valuable the subject of a patent. How could an infringement of such a patent be predicated? Could the Court say in words (if not in words, could it in effect say), 'We restrain you from working your lime purifying process in any such way as will not allow the carbonic acid to enter the last purifier in sufficient quantity to do substantial mischief, or in less quantity on an average than it used to do in former times on an average'? No one has a right to prevent a workman from using care to keep his tools in the most efficient state. No one has a right to prevent a manufacturer from cleansing his vessels and throwing away the useless contents whenever he likes, or to ask him his motives or intentions in doing so" (*r*).

Construction of claim.

A claim must always be construed with reference to the whole context of a specification (*s*). The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. If, therefore, the specification, as containing the description, be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they professed to be part of the description (*t*).

General claim may be modified by specification,

In *Arnold* v. *Bradbury* (*u*), the patentee by his specification described an improved ruffle or frill, and the machinery by which he proposed to make such ruffle, and to fasten it to a plain fabric by a single series of stitches, and claimed "the production by machinery of ruffles, and the simultaneous attachment of them to a plain fabric by a single series of stitches"; it was held that the claim was not, on the face of it, too large.

In *Edison and Swan, &c. Co.* v. *Woodhouse* (*v*), the patentee claimed "the herein described method of preparing the illuminating part of an electric lamp, consisting of electrically heating the

(*r*) *Bailey* v. *Roberton*, 1878, 3 App. Cas. 1055; *Gandy* v. *Reddaway*, 1885, 2 P. O. R. 49, 52.

(*s*) *Plimpton* v. *Spiller*, 1876-77, per James, L. J., L. R. 6 Ch. D. at p. 426.

(*t*) *Kay* v. *Marshall*, 1836, per Lord Cottenham, L. C., 2 Web. P. C. 39; *Walton* v. *Bateman*, 1842, per Cresswell, J., 1 Web. P. C. at p. 622; cp. *Heath* v. *Unwin*, 1855, per Pollock, C. B., 5 H. L. C. 540.

(*u*) 1871, L. R. 6 Ch. D. 706.

(*v*) 1887, 4 P. O. R. 99, 107. In *Newton* v. *Vaucher*, 1851, 6 Exch. at p. 864, it was said that a patentee's claim, which would otherwise have avoided the patent as being too wide, might be limited by the title read in conjunction with the specification.

same while it is surrounded by *a carbon gas* or fluid." It was objected that the expression *carbon gas* would include "carbonic acid gas" and "carbonic oxide," which were proved to be utterly unsuitable materials. The Court of Appeal, however, repelled this objection.

"Every claim in every patent," said Lindley, L. J., "must be read and construed with reference to the specification, and not as if the claim was an isolated sentence having no connection with or reference to what precedes it. To see what is meant by carbon gas or liquid, we must turn to the specification, and when we do so we cannot conceive that anyone reading this specification fairly with a view to understanding it, would ever dream for a moment that 'carbonic oxide' or 'carbonic acid' would answer the purpose, or could be meant by carbon gas."

or by evidence.

In *Gandy* v. *Reddaway* (*x*), the patentee claimed "an invention for constructing belts or bands, for driving machinery, of cotton canvas, or duck, woven hard." The Court of Appeal held this claim to mean "that if you take any of that class of cotton canvas known in the market as *hard woven canvas*, to make belting for machinery in the ordinary way for an ordinary machine, that will do."

Then Lord Esher, M. R., adds:—

"If that is the construction on the face of it, could that construction be altered or modified by evidence? I think it might. If it could be shown that although those words 'cotton canvas, woven hard,' do, on the face and surface of them, claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, why then I should say that the effect would be that this would be a claim not for that part which no ordinary workman would ever take, because that would be absurd and make it bad at once, but it would bring the true construction of the specification and claim, with that knowledge, to be only for that part which an ordinary workman might take."

The words "substantially as hereinbefore described."

Patentees frequently make use of the words "substantially as hereinbefore described," in claiming a particular arrangement set out in the body of the specification.

Mr. Justice Grove, in a comparatively recent case (*y*), commented adversely upon the use of "substantially."

(*x*) 1883-85, 2 P. O. R. 52.
(*y*) *Young* v. *Rosenthal*, 1884, 1 P. O. R. at p. 33; *Westinghouse* v. *L. & Y. Rail. Co.*, 1884, 1 P. O. R. at p. 241.

"That word to my mind is an utterly and entirely useless word, because the law gives it to (the patentee) without (his) using it. The law says, if a man, although not literally infringing the letter of the patent, yet substantially infringes it, it is an infringement."

The words "or some mechanical equivalent."

In a large majority of cases the words "or any mechanical equivalent," are wholly useless, and, being useless, regard being had to the strictness with which in some senses patents are construed, ought to be left out. They amount simply to this—that if anything is claimed which is a mechanical equivalent in the largest sense, then the claim must be too large; and in favour of the patentee the Court could only construe them so as to give him the benefit that he would have had without inserting them (*z*).

What can be claimed.

A principle, coupled with some mode of carrying it into effect, may be the subject of a claim (*a*).

A principle applied.

"If you have a new principle," said Jessel, M. R., in *Otto* v. *Linford* (*b*), "or a new idea as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new.

Comments on *Neilson* v. *Harford*.

"One of the strongest illustrations that I know of is the patent for the hot blast (*Neilson* v. *Harford* (*c*)), where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel would produce most remarkable results in the shape of economy in the manufacture of iron. The inventor or discoverer could not patent that, but what he did was this, he said, 'I will patent that idea in combination with the mode of carrying it out; that is, I tell you you may heat your air in a closed vessel next your furnace, and then that will effect the object.' It was held that that would do."

Otto v. *Linford*.

In *Otto* v. *Linford* (*d*), an action for the infringement of a patent for "improvements in gas motor engines," the claim was—"admitting to the cylinder a mixture of combustible gas or vapour

(*z*) *Curtis* v. *Platt*, 1863, per Wood, V.-C., 3 Ch. D. at p. 137, n. In *Shaw* v. *Jones* (1869, 6 P. O. R. 333), a claim for "the production of printing surfaces, &c., &c., was held not to be vague, the '&c.'s' having been put in not for the purpose of misleading, but *ex abundanti cautelâ*."

(*a*) *Boulton* v. *Bull*, 1793-99, per Buller, J., Dav. P. C. at p. 198; *Jupe* v. *Pratt*, 1837, per Alderson, B., 1 Web. P. C. 145; *Household Co.* v. *Neilson*, 1843, per Lord Justice Clerk Hope, 1 Web. P. C. 685; *Easterbrook* v. *G. W. Rail. Co.*, 1885, 2 P. O. R. 207. See a full discussion of the cases relating to this branch of the law under subject-matter of letters patent, *ante*, p. 21.

(*b*) 1881-82, 46 L. T. 39.

(*c*) 1841, 1 Web. P. C. 370.

(*d*) *Ubi supra*; *Minter* v. *Wells*, 1834, 1 Web. P. C. 134.

with air, separate from a charge of air or incombustible gas, so that the development of heat and the expansion or increase of pressure produced by the combustion are rendered gradual, substantially as and for the purposes set forth." It was objected that this was not the subject-matter of a patent, being merely a claim for a principle. "It is said," observed Jessel, M. R., "that what is claimed is . . . . the idea of putting a cushion of air between the explosive mixture and the piston of the gas motor engine, so as to regulate, detain, or make gradual what would otherwise be a sudden explosion. Of course that could not be patented. I do not read the patent so. I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out, but he also describes other kinds of machines which will carry it out; and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent." Then, after referring to *Neilson* v. *Harford* (*e*), his lordship adds: "Now that is a much stronger illustration than this of the validity of a patent as regards the subject-matter. . . . . In the case of the hot blast the man did not pretend to invent anything; he said, a machine of any shape in which you can heat air is sufficient. Mr. Otto does allege he has invented a machine. It appears that he did, although a machine which *per se* was not of sufficient novelty probably to support a patent. It comes, therefore, to this—that we have a principle and a mode of carrying it out, and, I will assume for this purpose, sufficiently described, and that is a good subject-matter for a patent."

Claim for combinations.

Combination defined.

A combination is not a mere collection of independent groups, nor is it simply "a putting together" of two or more things in the sense of juxtaposition; it involves also connection of some kind, so that the group, in consequence of the connection of its members, has properties or effects different from those possessed by its members separately.

Incommensurable combinations.

The kinds of things that may properly be combined are only three in number—material, machinery, and method. "There may be a combination of materials chemically combined, or mechanically mingled or united, or compounded partly by chemical composition, partly by mechanical mixture. But there can be no combination of material with machinery, nor of material with method of operat-

(*e*) *Ubi supra.*

ing; nor can there be a combination of machinery with method. The three kinds are incommensurable" (*g*).

Classes of combinations.

The combinations which form so large a part of the subject-matter of patent claims may be roughly grouped in five classes.

New compounds.

1. New compounds resulting from the chemical combination of two or more substances, *e.g.*, anilyne dyes or nitro-glycerine.

What the patentee generally claims in such cases is the product.

New mixtures.

2. New mixtures without actual chemical combination.

"Thus, an alloy of two or more metals producing a compound metal presenting particular qualities may be fairly considered an invention, provided that there is some particular rule as to proportions, temperatures, or modes of fusion, which is not obvious, but must have required experiment and observation for its determination. It would not do for a patentee to say, 'I melt together lead and tin, and so produce pewter, which I claim'; because if lead and tin were put together in a ladle and sufficiently heated, they would melt and mingle independently of any invention whatever. But if a person found that by melting lead and tin together in certain proportions, or by melting them in a particular way, he could produce an alloy having some special character, he might fairly claim that special product" (*h*).

Mechanical union of materials.

3. A mechanical union of two or more materials—*e.g.*, macintosh cloth, made by a film of caoutchouc put on fabric, so as to render it waterproof.

Here not only the special process necessary to effect the union, but the product itself, if new and useful, might be claimed.

Machines.

4. Machines.

Processes.

5. Processes.

A process is a combination of operations pursued in regular sequence which may be either chemical (*e.g.*, soap making), or mechanical (*e.g.*, printing), or both (*e.g.*, paper-making).

Here the process, and if it is special in character, the apparatus by which it is carried on, may be claimed.

(*g*) See an interesting paper "On Combinations as Subjects of Patent Claims," by J. Imray, in Transactions I. P. A., vol. i. p. 135. Many years ago, in a case against the Bank of England for infringing, by the use of certain numbering machines, Chief Baron Pollock said, "You cannot have a valid claim for combination of 2½*d.* with a pound of butter." See also paper on "Patent Claims," by the same writer, in Trans. I. P. A., vol. vi. p. 203; cp. *Clark* v. *Adie*, 1873-75, per James, L. J., L. R. 10 Ch. at p. 676, and *S. C.*, per Lord Cairns, L. C., 2 App. Cas. at p. 326.

(*h*) Imray on "Combination," *ubi supra*, Trans. Inst. P. A., vol. i.

A combination which is new and useful is good subject-matter for a patent although each principle, process, or material part in it is old (*i*).

Law as to claims for combinations.

The law as to claims for combinations must now be stated.

Foxwell v. *Bostock*.

In *Foxwell* v. *Bostock* (*k*), Lord Westbury, L. C., said:

"The term *combination of machinery*, which has become a favourite form of words with patentees, is nothing but an extended expression of the word *machine*. It is the word *machine* writ large; and as a patent for an improved machine, in the specification of which the improvement was not particularly stated and described, would hardly be attempted to be supported, so neither, in my judgment, can the patent for an improved arrangement or combination be supported, in the specification of which there is nothing to distinguish the new from the old. . . . I must therefore lay down the rule, which is consistent with and in reality a mere sequence from the decided cases, that in a patent for an improved arrangement or new combination of machinery the specification must describe the improvement and define the novelty otherwise and in a more specific form than by the general description of the entire machine; it must, to use a logical phrase, assign the *differentia* of the new combination."

Foxwell v. *Bostock* was discussed and explained in two later cases.

In *Harrison* v. *Anderston Foundry Co.* (*l*), Lord Cairns, L. C., said:—

"It is said to have been determined in that case that where there is a patent for a combination, there must be a discovery or explanation of the novelty, and the specification must show what is the novelty, and what the merit of the invention. I cannot think that, as applied to a patent for a combination, that is or was meant to be the effect of the decision in *Foxwell* v. *Bostock*. If there is a patent for a combination, the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In *Moore* v. *Bennett* (*m*), a positive interpretation of *Foxwell* v. *Bostock* was given.

(*i*) *Crane* v. *Price*, 1840-42; per Tindal, C. J., 1 Web. P. C. at p. 408; *Cannington* v. *Nuttal*, 1871, 5 H. L. 205; *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 P. O. R. 114, affirmed 5 Times R. 359.

(*k*) 1864, 4 De G. J. & S. 298, 311, 313.

(*l*) 1876, L. R. 1 A. C. at pp. 577, 583; cp. *Parkes* v. *Stevens*, 1869-70; per James, V.-C., L. R. 8 Eq. at p. 365.

(*m*) 1884, 1 P. O. R. at p. 143;

Meaning of *Foxwell* v. *Bostock*.

"It appears to me," said the Earl of Selborne, L. C., "to amount to no more than this, that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must confine yourself to that which is improved. For example, if . . . some particular improvement, say in the arrangement of a cog, or in the arrangement, it may be, of some other portion of an old combination, which was new and useful, had been made, the general combination remaining the same, then, according to the decision in *Foxwell* v. *Bostock*, by describing it as a new combination, you would be misdescribing it, because, indeed, the thing discovered would be a particular improvement upon a particular part or element of that combination."

"For example (*n*), supposing that a compensation pendulum was now for the first time invented, it would not do to patent improvements in clocks in general terms, and give a specification of the whole machinery of a clock, introducing somewhere, in the course of the description, the mode of making a compensation pendulum, and then end by claiming the arrangement and combination aforesaid. He must say expressly, 'I claim the invention of a compensation pendulum, and make it thus'" (*o*).

But "where the claim is for a combination (*p*), and not for particular subordinate things included in that combination, if the combination is a new one in substance and in truth, and if the manner of arriving at it and working it and the purpose for which it is useful, are all properly, sufficiently and correctly described in the specification, so that any one acquainted with the subject will know in what respect it differs from the things which have gone before, then it would be contrary to the whole policy which allows such combinations, though no part of them is new, to be the subject of a patent, to say that, besides describing clearly and

Cartsburn Sugar, &c. Co. v. *Sharp*, 1884, per Lord Kinnear, 1 P. O. R. at p. 185, cp.

(*n*) Per James, V.-C., in *Parkes* v. *Stevens*, 1869-70, L. R. 8 Eq. at p. 305; and cp. *Harrison* v. *The Anderston Foundry Co.*, 1876, per Lord Hatherley, 1 A. C. at p. 583.

(*o*) In *Nordenfelt* v. *Gardner*, 1884, 1 P. O. R. at pp. 69, 74, a case decided before the present Act came into operation, it was held that the new improvement might be pointed out either in the body of the specification or in one of the claims. Under sect. 5, sub-sect. 5 of the Act of 1883, it seems that an improvement must be specified in the claim. Cp. *Siddell* v. *Vickers*, 1888, 5 P. O. R. at p. 432.

(*p*) Per Lord Selborne, L. C., in *Moore* v. *Bennett*, *ubi supra*.

sufficiently the manner of doing it, which would show every one acquainted with the subject what was the novelty in the thing, you are to go on, and though you do not want to claim subordinate parts of the combination as distinct from the entire combination, nevertheless you must specify the subordinate parts of it as constituting new elements and a new thing."

Combination must be claimed *qua* combination.

Stated shortly, therefore, the meaning of *Foxwell* v. *Bostock* is that "where you have a claim for a patent resting upon a combination, you must have that so clearly made out upon the specification that the public can know that what you claim is in truth the combination, not the specified things which make up the combination but the combination itself" (*q*).

In *Rowcliffe* v. *Morris* (*q*), accordingly, a claim for "the construction of frame work for spring mattresses, substantially as hereinbefore described, and illustrated on the accompanying drawing, *or any mere modification of the same*," was held to be insufficient as a claim to a combination.

But in *Murray* v. *Clayton* (*r*), the following claim was held to be good:—

Claim.—"The arrangement and construction of parts herein set forth for cutting clay into bricks. I claim particularly cutting the clay into the form of bricks by forcing the clay forwards by means of a pushing board against a series of fixed wires, so arranged that the clay is forced past the wires on to a moveable board provided with handles, so that twelve or any convenient number of bricks may be removed at the same time."

"I am of opinion," said James, L. J., "that the plain meaning of the specification is that the plaintiff claims the machine. The claim is not to any particular part. It is a claim for the entire machine, produced by the arrangement and construction of the parts set forth" (*s*).

Claim for subordinate integers.

The law as to "subordinate integers" was very clearly put by Lord Cairns, L. C., in *Clark* v. *Adie* (*t*).

"Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step or a number of steps

(*q*) *Rowcliffe* v. *Morris*, 1886, per Bristowe, V.-C., 3 P. O. R. at p. 24.
(*r*) 1872-73, L. R. 7 Ch. 570, 578.
(*s*) Cp. *Westinghouse* v. *L. & Y. Rail. Co.*, 1884, 1 P. O. R. 229, 241; *Watling* v. *Stevens*, 1886, 3 P. O. R. 32.
(*t*) 1873-75, 2 App. Cas. at p. 320; followed by Cotton, L. J., in *Cropper* v. *Smith*, 1884, 1 P. O. R. at p. 87.

in the whole, which is or are perfectly new; or the subordinate integer may not consist of new steps, but may consist of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term 'combination.' Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A., B., C., D., he may at the same time claim that as to one of those parts, D., it is itself a new thing; and that as to another of those parts, C., it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind, the monopoly would or might be held to be granted not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind, and has intended to claim protection for, those subordinate integers, and moreover he is . . . . at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

A subordinate integer may be claimed either *in gross* as a separate invention, or as appendant to the entire combination.

Claim for subordinate integer *in gross*.

"When one does find in a claim," said Cotton, L. J., in *Cropper* v. *Smith* (*u*), "particular subdivisions, viz., first, second, and third, I am of opinion that it would not be right to say that when the first is as to general combination, the second and third are only to be considered as pointing out, though they are put by way of claim, that which the patentee considers material. Undoubtedly in his description he may do that as he pleases; but when we do find that he claims first of all the general combination, with a previous declaration, 'I declare that I claim, first, so and so; second, so and so; and third, so and so,' in my opinion, according to the fair construction of the language, and having regard to the use of the claim, it would be wrong to say that he is not intending to claim, as that which he protects, one, two, and three; . . . . that is to say, he treats his claim not only as a claim for the entire combination, but also as a claim to those subordinate combinations

(*u*) L. R. 16 C. D. 426.

which are introduced into it, and help, together with other things, to make the entire combination."

Plimpton v. *Spiller* explained.

Plimpton v. *Spiller* (*v*) is an apparent exception to the principle here laid down. In that case the subordinate claim formed and was numbered as a distinct and substantive invention. The plaintiff was the patentee of an invention for "improvements in the construction of skates." The patent related to an improvement in roller-skates, whereby the lateral tilting of the foot-stock to the right or left caused the roller axles to converge on the side towards which the skate was inclining, and the skate ran in a curve. Thus the various evolutions practised with an ordinary skate could be readily accomplished with a skate running like a carriage upon four wheels. The plaintiff's second claim was for "the mode of securing the runners, and making them reversible as above described." It was held by the Court of Appeal that this claim was so stated as to be confined to the runners of the particular skate of the patentee in the same patent.

"It is too absurd," said James, L. J., "for any one to suppose that a man was claiming in the year 1865 (the date of the plaintiff's patent), as a distinct and substantive invention, the putting of a piece of metal between two pieces of wood, and tightening them so as to hold that piece of metal fixed."

So Brett, L. J., said (*x*): "If you can say that the subsidiary claim in the patent *cannot under any circumstances increase the monopoly of the patent itself* . . . . it seems to me that the subsidiary claim is unimportant, is futile, has no effect, and, therefore, does not raise any objection to the patent."

"*Plimpton's Case*," said Bowen, L. J., in *Cropper* v. *Smith* (*y*), "seems to me . . . . only to be an authority upon the construction to be placed upon Plimpton's specification. It may be used as instructive to show to what length the Court will go in allowing the general spirit of a specification to govern and prevail over the clumsy use of particular language; but except for that instructive purpose, it seems to me no more than an authority upon the true construction of *Plimpton's Patent*."

(*v*) 1876-77, L. R. 6 Ch. D. at p. 426.

(*x*) *S. C.*, L. R. 6 Ch. D. at p. 433; cp. *Betts* v. *Neilson*, 1868-71, 5 H. L. at p. 21. The specification of a patent described a process and a material, claimed the material as the result of the process, and concluded with a claim for a particular manufacture out of the material. "If a claim to the material," said Lord Westbury, "can be substantiated by the patent, the specification of a particular user of it, comprehended in the general user claimed, cannot for a moment be accepted as a ground for vitiating the patent."

(*y*) 1884, 1 P. O. R. at p. 90.

If a claim can be read in two ways, one claiming something that has the merit of novelty, and the other claiming something which would show the man to be ignorant of all the ordinary appliances used in every workshop in the world, it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible rather than that construction which makes the patent utterly absurd (*z*).

Claims for subordinate integers as appendant.

When a subordinate integer is part and parcel of the invention, which a patentee is bound to give to the public as a means of working his patent, a claim for that integer will not be construed as a claim for a separate and independent invention (*a*).

Thus in *The British Dynamite Co.* v. *Krebs* (*a*), the patentee had claimed in his specification the mode of manufacturing dynamite, and also the modes of firing the same by special ignition therein set forth. It was held by the House of Lords that he claimed the means of explosion not in gross, but only as appendant to dynamite.

Claim for specific improvement.

If a specific mechanical improvement is claimed, the inventor must be held strictly to that particular mechanical device which he has claimed for effecting the object he had in view; and if he says it is to be done in one precise and particular way, to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed (*b*).

Seed v. *Higgins.*

Thus, in *Seed* v. *Higgins* (*c*), the patentee had claimed by his specification "*the application of the principle of centrifugal force* to the flyers employed in certain machinery for roving cotton and other fibrous substances," although his drawings and the specification represented only "one particular and practicable mode of applying his invention." He afterwards disclaimed all application of the law or principle of centrifugal force, except by the

(*x*) *Plimpton* v. *Spiller*, 1876, per Jessel, M. R., 6 Ch. D. at p. 423; *Westinghouse* v. *L. & Y. Rail. Co.*, 1884, 1 P. O. R. 101; *Edison* v. *Woodhouse*, 1887, 4 P. O. R. 96.

(*a*) *British Dynamite Co.* v. *Krebs*, 1878-79; Goodeve's P. C. 93, 94; cp. *Britain* v. *Hirsch*, 1888, per Kay, J., 5 P. O. R. at p. 76.

(*b*) *Curtis* v. *Platt*, 1863 (per Wood, V.-C., commenting on *Seed* v. *Higgins*, *infra*), L. R. 3 C. D. at p. 136, n.; and see also p. 139; cp. *Palmer* v. *Wagstaffe*, 1853, 8 Ex. R. 840; 9 Ex. R. 601, 502; *Proctor* v. *Bennis*, 1888, L. R. 36 C. D. 740; *Ehrlich* v. *Ihlee*, 1888, 5 P. O. R. 437, 453.

(*c*) 1860, 27 L. J. Q. B. 145, 411; 8 H. L. C. 550; cp. *Daw* v. *Eley*, 1865, 3 Eq. at p. 512. When a specification has been the subject of a disclaimer, the specification and disclaimer are to be construed fairly and not strictly. *Hocking and Co.* v. *Hocking*, 1888, per Cotton, L. J., 4 P. O. R. at p. 439.

particular means described in the specification. It was held that the claim was strictly limited thereto.

Everything not claimed is disclaimed.

Everything which is not claimed is disclaimed (*d*).

"If a man has described in his specification a dozen new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven; and he has no right to be protected as regards any one of the other eleven if he wishes to recall that gift which he has made by publishing the specification" (*e*).

In *Harrison* v. *Anderston Foundry Co.* (*f*), where the patentees claimed for a combination under their first claim, and in their second, third, and fourth claims specified the subordinate or subsidiary parts which they claimed as novel, it was held that the specification of these parts excluded the possibility of a claim for any other parts as novel.

Lister v. *Leather* explained,

In *Lister* v. *Leather* (*g*) it was laid down by Lord Campbell, C. J. (*h*), that "a valid patent for an entire combination for a process gives protection to each part thereof that is new and material to that process without any express claim of particular parts, and notwithstanding that parts of the combination are old."

in *Parkes* v. *Stevens*,

"This is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention, and the question in every case is a question of fact—Is it really and substantially a part of the invention? . . . . Supposing that a clock was now for the first time invented and patented as a machine for measuring and indicating time, a man could not evade the patentee's right by substituting a spring for a weight, or by leaving out the whole of the striking apparatus" (*i*).

and *Clark* v. *Adie*.

"A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles as every other patent. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form; and that invention may be pirated by a

(*d*) *Harrison* v. *Anderston Foundry Co.*, 1870, per Lord Chelmsford, 1 App. Cas. at p. 580; cp. *Jackson* v. *Woolstenhulmes*, 1884, 1 P. O. R. 105.

(*e*) *Hinks* v. *Safety Lighting Co.*, 1876, per Jessel, M. R., L. R. 4 C. D. at p. 612; cp. *United Telephone Co.* v. *Harrison*, 1882-83, per Fry, J., L. R. 21 C. D. at p. 741.

(*f*) *Ubi supra*, at p. 577, per Lord Cairns, L. C.

(*g*) 1858, 8 E. & B. 1018, 1023.

(*h*) On the authority of *Newton* v. *Grand Junction Rail. Co.*, 1845-46, 5 Ex. R. 331; *Sellers* v. *Dickinson*, 1850, 5 Ex. R. 312; *Smith* v. *L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69.

(*i*) *Parkes* v. *Stevens*, 1869, per James, V.-C., 8 Eq. at p. 367.

theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination" (*j*).

Sect. 5.—Amendment of Specification.

1. *Former Law as to Amendments, Disclaimers, and Clerical Errors.*

Early law as to amendments.

A patent was originally a record of the Court of Chancery containing the Queen's grant, made by the Court in pursuance of the writ of Privy Seal. That writ was directed to the Lord Chancellor alone, and conferred authority upon no other person: the letters patent which he made in pursuance of such a writ never passed into the custody of the Master of the Rolls; and

Alteration of patent.

therefore the Master of the Rolls had no jurisdiction whatever over the patent whenever a patent itself had to be altered or amended in any respect, the alteration or amendment could only be made by the Lord Chancellor, and he gave effect to it by the same means that he had made the patent, viz., by affixing to it, as altered, the Great Seal, which was in his custody (*k*).

Alteration of enrolment.

Clerical errors in the enrolment of letters patent or specifications were alterable by the Master of the Rolls. "It would seem," said Lord Langdale, M. R., in *Re Sharp's Patent* (*l*), "that it

(*j*) *Clark* v. *Adie*, 1873-75, per James, L. J., 10 Ch. at p. 675; cp. *Laurence* v. *Perry*, 1866, per North, J., 2 P. O. R. at p. 184. "There might well be an infringement of a patent for an infringement of A. and B., although the infringer adopted a different mode of combination to that of the patentee."

(*k*) Hindmarch, 214 *et seq.*; cp. *Ex parte Beck*, 1784, 1 Web. P. C. 430; 1 Bro. C. C. 578.

(*l*) 1840, 1 Web. P. C. at p. 647; 10 L. J. Ch. 80. Though the Master of the Rolls had no jurisdiction to do more by a memorandum of alteration than to amend clerical errors, yet where a disclaimer had been filed without the consent of the patentee, it was held that the Master of the Rolls had jurisdiction, without bill filed, to order it to be taken off the file: *Re Berdan*, 1875, L. R. 20 Eq. 346.

The following are a few of the earlier cases of amendment of enrolments, a complete list of which is given by Webster, *ubi sup.*, n. (*l*):—

1. Pat. 2 Hen. VII. p. 1, n. 5. This is a warrant, attached to the enrolment under the king's hand, and addressed to John, Archbishop of Canterbury, his Chancellor, reciting a grant of the office of ranger of a forest, and that in the bill and letters patent the name was mistaken and called "Kyngere" instead of "Kingesbere," and directing "the said name to be reformed, as well in our bill assigned as in our letters patent and enrolment of the same." The amendment not made.

2. Pat. 8 Hen. VIII. p. 2, n. 4. Warrant under the king's hand, attached to the enrolment, "to Cuthbert Tunstall, clerk, Master and Keeper of our Rolls and Records in our Chancery, and, in his absence, to his depute there for the time being," reciting the grant of the office of attorney in the town of "Herefordwest," the which word was misnamed and miswritten for "Haverfordwest," and directing the former word to be erased and the latter inserted, "as well in our said letters patent and the enrolment of the same, as in our Privy Seal, whereby our said letters patent were made."

has always been usual to amend clerical errors. When errors have been made in grants, as was said, *per incuriam et ex inani inadvertentia scriptoris*, they have been amended by the Master of the Rolls, sometimes under the authority of a warrant from the

3. Pat. 35 Hen. VIII. p. 1. Date of the grant amended in the enrolment by order of Julius Cæsar, M. R., in the presence of Sir Robert Heath, Attorney-General, and others. The roll is signed by the Master of the Rolls and the Attorney-General. The date is stated to have been omitted *per incuriam*, and the enrolment made to correspond with the Privy Seal and letters patent.

4. Pat. 36 Hen. VIII. p. 4. The enrolment amended by order of Sir Thomas Egerton, Lord Keeper and Master of the Rolls, in the presence of himself and Sir Edw. Coke, Attorney-General. The roll signed by both. A word omitted *per incuriam scriptoris*, supplied so as to make the enrolment correspond with the Privy Seal and letters patent.

5. Pat. 36 Hen. VIII. p. 12. Several words, omitted in the enrolment, but contained in the Privy Seal bill, inserted by order of Lord Bruce, Chancellor and Master of the Rolls, in the presence of himself and a Master in Chancery, and signed by both, so as to make the enrolment correspond with the Privy Seal and letters patent.

6. Pat. 37 Hen. VIII. p. 3, n. 24. The name of a county amended by order of Lord Bruce, so as to make the enrolment correspond with the Privy Seal and letters patent.

7. Pat. 2 Edw. VI. p. 4. Several words omitted *per incuriam* inserted in the presence of Lord Bruce and the Six Clerks. Roll signed by Lord Bruce, so as to make the enrolment correspond with the Privy Seal and letters patent.

8. Pat. 2 Edw. VI. p. 5. Roll amended (by the insertion of words omitted *per incuriam*), in the presence of the Lord Bruce and two of the Six Clerks, and another person, all of whom inspected the king's bill and the letters patent, and signed the roll.

9. Pat. 1 & 2 Ph. & M. p. 3. Enrolment amended in a date, upon petition to Lord Keeper Guildford, who referred it (9th of May, 1684) to the Master of the Rolls. In the margin of the enrolment is a memorandum signed by Sir H. Grimston, M. R., stating the amendment to be made by his order and in his presence.

The above petition by the Governors and Fellowship of English Merchants, for the discovery of new trades, stated the grant of letters patent, 26th of February, 1 & 2 Ph. & M., incorporating the company; that by Act of Parliament, 8 El., the privileges by the said letters patent granted were confirmed; that the said letters patent were destroyed in the fire of London, and the petitioners having occasion to make use of the enrolment thereof, discovered the date to be written the "6th" instead of the "26th;" that it appears by the Privy Seal or warrant of the enrolment, that the *recepi* thereof is dated the 26th, and by the recital in the Act of Parliament remaining in the Rolls' Chapel. The petition was accompanied by an affidavit of the Secretary of the Company, stating that he had perused several ancient entries of the said letters patent, describing them as dated the 26th of February.

10. Pat. 1 El. p. 9. The original enrolment, on a comparison with the warrant of the queen's bill and the letters patent, being found full of gross errors, was cancelled, and the new enrolment placed in front of it by order of Sir Edward Phelips, M. R., and the memorandum signed by him.

In the margin of the second enrolment is the following: "Memorandum. The first enrolment of these letters patent being examined both with the warrant of the queen's bill signed, and the letters patent themselves under the great seal of England, the same was found full of many very gross errors and mistakings, differing both from the said warrant and letters patent. Whereupon it was prayed, that a new enrolment might be made agreeable to the letters patent under the great seal, and to the said warrant."

11. Pat. 5 El. p. 7. A single letter in the enrolment of letters patent amended, "R" instead of "L" having been written as the first letter in the name of a place. The petition to King James, setting forth the error, was referred to Sir H. Yelverton, Attorney-General, who reported that the amendment might be safely made, and that the course to have this effected was by warrant under the Signet or Privy Seal, to be directed to the Master of the Rolls to amend the same. The warrant was made out and the enrolment amended accordingly.

Amendments of specifications.

Crown, sometimes with the consent of the Attorney-General, sometimes in consequence of a reference to him by the Lord Chancellor, and there is an instance of an amendment being made by an order of the Lord Chancellor, pursuant to an order of the King. The errors have been proved and rectified by comparison with the writ of Privy Seal, or with the signed bill, or with the original grant. . . . In a case before Lord Gifford in 1824 (*m*), the word 'wire' had been written instead of 'fire,' and he ordered the specification to be amended. In the case of *Redmund* (*n*), an erroneous transposition of numbers was amended by order of Sir John Leach, M. R., who, in a subsequent case, ordered to be amended two errors, by one of which the word 'which' was written instead of 'wheel,' and by the other of which the word 'increase' had been written instead of 'inverse.' I have had similar cases before me in which there have been errors more or less numerous, but all of the same kind. And in every case which has occurred, it has plainly been intended to do no more than amend mere slips or clerical errors made by the parties, or the agents of the parties, who, intending to make an accurate enrolment, have, by mere inadvertence, made an enrolment which was not what it purported to be, a true statement of that which the party intended at the time; and not only has strict evidence of error been required, but in order to enable any third party to dispute the validity of the amendment, and of the order, it has been directed that the order itself should be endorsed on the enrolment (*o*). It does not appear that the Master of the Rolls, as Keeper of the Records in Chancery, has ever exercised any greater authority than I have stated in matters of this kind."

Disclaimers.

According to common law, letters patent were wholly void for

(*m*) *Whitehouse's Patent*, 1830, 1 Web. P. C. 455.

(*n*) July 25th, 1828, Letters Patent, 9th November, 1821, to David Redmund, "for an improvement in the construction or manufacture of hinges for doors." The patentee stated in his petition that within the last month he had discovered that the copying clerk, in engrossing the specification and the plan annexed to it, had by mistake transposed the numbers by which, in the specification, reference was made to the plan, and that no office copy of the specification had been taken. The petition prayed that this clerical error in the enrolment might be amended. Ordered as prayed, 5 Russ. 44; cp. *In re Rubery's Patent*, 1837, 1 Web. P. C. 640, n. (*z*); *Nickel's Patent*, 1841, 1 Web. P. C. 650; *Dismore's Patent*, 1853, 18 Beav. 538; *Adam's Patent*, 1853, 21 L. T. 38. In *Re Blamond*, 1860 (3 L. T. N. S. 800), an application for amendment of a patent, granted in 1856, by rectifying an error in the spelling of the name of the patentee, was refused by Lord Campbell, L. C., on the ground of culpable delay.

(*o*) Evidence was required by the Master of the Rolls that the error was "clerical." The practice was to produce, where possible, the original draft of the specification, and to explain how the mistake in the filed copy had arisen: *Re Dixon*, 1881, Eng. Rep. Jan. to Mar. xvi.; *Re Johnson*, 1888, ib. April to June, xiii.; Lawson, 59.

any defect in part, not being a mere clerical error which the Master of the Rolls had authority to amend, and the patentee was liable to be deprived of his patent from the failure of some condition, such as want of novelty in a very small part of the invention, insufficient description, ambiguous terms, uselessness of parts, inadequacy of means, indefinite claims, surplusage, no proper distinction between new and old, or some objection to the specification as not being a true, full, clear, and faithful account of the invention (*p*). The necessity of providing some mode of escape from the defects which inevitably arose from the secret and hurried manner in which experiments were formerly conducted, and the technical difficulties surrounding the correction of the public records in this department (*q*), were so impressed upon the Legislature by the evidence contained in the Report of the Select Committee of 1829, that, mainly by the exertions of Lord Brougham, an Act was passed to relieve patentees from the hardships of the common law (*r*). It is known as Lord Brougham's Act (5 & 6 Will. IV. c. 83), and will be further referred to in connection with the prolongation and confirmation of letters patent (*s*). By sect. 1 of that statute the patentee was enabled to enter with the clerk of patents, by permission of the Crown, signified by the *fiat* of the law officer (*t*), a disclaimer of any part of the title or a memorandum of any alteration therein, which, upon being filed (*u*) by the clerk of patents and enrolled with the specification, was deemed and taken to be part of the letters patent or specification in all Courts whatever.

Lord Brougham's Act, 1835.

Permission to enter such disclaimer or memorandum of altera- Discretion of law officer in

(*p*) Web. Letts. Pat., p. 17.

(*q*) The cost of altering the word "pressing" into "dressing" is mentioned as having amounted to 30*l*. Coryton, p. 181.

(*r*) The Report of the Committee of the House of Commons was ordered to be printed June 12th, 1829. The Act in question, introduced by Lord Brougham, received the Royal Assent September 10th, 1835.

(*s*) See Chapters XVIII. and XIX., *infra*, pp. 373, 404.

(*t*) The original Act provided for the signification of the Royal Assent by the fiat and signature of the Attorney or Solicitor-General in the case of an English, of the Lord Advocate or Solicitor-General of Scotland in the case of a Scotch, and of the Attorney or Solicitor-General of Ireland in that of an Irish, patent. Under the Patent Law Amendment Act, 1852, patents were granted for the United Kingdom, and the assent of the Attorney or Solicitor-General alone was required for patents granted under that Act. Disclaimers, however, required the assent of the same law officers as before: sect. 39.

(*u*) This was the construction put upon the Act in *Perry* v. *Skinner*, 1837, 1 Web. P. C., at p. 253; and *Stocker* v. *Waller*, 1843, 14 L. J. C. P. 148; 9 Jur. 138 (reported as *Stocker* v. *Warner*, in 1 C. B. 148). Cp. *Clark* v. *Kenrick*, 1843, 13 L. J. Ex. 6; 12 M. & W. 221. *Perry* v. *Skinner* was questioned, however, in *R.* v. *Mill*, 1850—1851, 10 C. B., p. 389, per Jervis, C. J., in which it was held that the disclaimer must be read as part of the specification as from the date of the letters patent. See 15 & 16 Vict. c. 83, s. 39.

allowing disclaimers, &c.

tion was left in the discretion of the law officer of the Crown, who considered its effect and consequent legality, and the propriety of advertising to warn other persons of the intentions of the patentee. This formed a check upon the enrolment of specifications with illegal claims, in the hope of being able at any time to file a disclaimer, should it be necessary. Whenever the law officers of the Crown had reason to presume want of fairness on the part of the patentee in this respect they had power of refusing the prayer of the petition altogether, or ordering suitable advertisements, that the public might be fully apprised of the patentee's intentions (*x*).

Further statutes. Changes in law.

The practice relating to disclaimers and memoranda of alterations was further regulated by the following statutes: 7 & 8 Vict. c. 94, 12 & 13 Vict. c. 109, 15 & 16 Vict. c. 83, 16 & 17 Vict. c. 115. The chief points of difference introduced by these enactments were: (1) In *Spilsbury* v. *Clough* (*y*), where it was decided that the grantee of letters patent, though having entirely parted with his interest, might enter a disclaimer, the judges were understood to express their opinion that, irrespective of his interest in the patent, the patentee was the proper party to disclaim. 7 & 8 Vict. c. 69, s. 5, resolving the doubt raised by that case, enacted that a disclaimer or memorandum of alteration might be made by an assignee either alone or jointly with the patentee where the latter had assigned only part of his interest. (2) By 11 & 12 Vict. c. 94, and 12 & 13 Vict. c. 109, disclaimers and memoranda of alterations were directed to be enrolled in the Enrolment Office of the Court of Chancery, whether the specifications of the invention to which such disclaimer or memorandum of alteration related had been enrolled there or not. (3) The general changes introduced by the Patent Law Amendment Act, 1852, affected the practice to the extent of substituting filing in the office appointed for filing specifications in Chancery for the filing and enrolling required by preceding Acts. The Patent Law Amendment Act provided also (sect. 39), that no action should be brought upon any letters patent in which, or on the specification of which, any disclaimer or memorandum of alteration had been filed in respect of any infringement committed prior thereto, without the leave of the law officer certified in his fiat (*z*). In

7 & 8 Vict. c. 69.

11 & 12 Vict. c. 94.

12 & 13 Vict. c. 109.

(*x*) Web. Letts. Pat., p. 55, n. (*n*).

(*y*) 1842, 11 L. J. Q. B. 109; 1 Web. P. C. 255; *Wallington* v. *Dale*, 1852, 7 Ex. 88C.

(*z*) The defects of the old law as to disclaimers were these: 1. A disclaimer was merely the renunciation of some previous claim actually or apparently made, or supposed to be made. The patentee had no power to add to or en-

Re Lucas (*a*), Sir A. E. Cockburn, A.-G., said that there were exceptional cases in which a disclaimer should be made retrospective, as where a person having obtained his information from the patentee presumed upon a defect in his specification, and infringed the valuable part of his patent. (4) 16 & 17 Vict. c. 115, provided for the production as evidence of certified and sealed copies of disclaimers and memoranda, without further proof or production of the originals. 5 & 6 Will. IV. c. 83, s. 1, prohibited the allowance of any disclaimer or alteration which would extend the exclusive right granted by the letters patent, which, or the specification relating to which, it was sought to amend.

16 & 17 Vict. c. 115.

It lay, however, upon the party applying for a certificate that would make his disclaimer retrospective to satisfy the law officer that this course should be followed.

In spite of Lord Brougham's Act, the emendation of clerical errors by the Master of the Rolls continued (*b*). How far the power to make such corrections was affected by that statute is discussed by Lord Langdale, M. R., in *Re Sharp's Patent* (*c*). "If it were alleged that the enrolled memorandum of alteration, by mistake of the writer, contained verbal or clerical errors, by means of which something was enrolled contrary to the true intent

Clerical errors still corrected by Master of Rolls

large the terms of his specification: *Ralston* v. *Smith*, 1865, 11 H. L. C. 223, per Lord Chelmsford; *Foxwell* v. *Bostock*, 1864, 4 De G. F. & J. 298, 306. The object of the disclaimer was merely to relieve him of insignificant, immaterial, or useless parts of his patent: *In re Dervaine*, 1835, 1 Carp. P. C. 698; *Morgan* v. *Seaward*, 1838, 2 Carp. P. C. 104; *Reg.* v. *Wheeler*, 1850, per Maule, J., 10 C. B. 395; *Reg.* v. *Mill*, 1851, per Romilly, M. R., 14 Beav. 315; *Bateman's Patent*, 1854, Macr. P. C. 116; *In re Lucas*, 1854, Macr. P. C. 235; *Lister* v. *Leather*, 1858, 8 El. & B. 1034; *Thomas* v. *Welch*, 1866, L. R. 1 C. P. 192.

2. The disclaimer could not be read as explanatory of the remainder of the specification; *Tetley* v. *Easton*, 1857, 2 C. B. N. S. 706.

3. Except with the leave of the law officer the amendment was not retrospective, 15 & 16 Vict. c. 83, s. 39; *In re Harrison*, 1853, Macr. P. C. 32; *In re Lucas*, *ubi supra*; *In re Smith*, 1855, Macr. P. C. 232; *Lister* v. *Leather*, 1857, 3 Jur. N. S. 433; *Seed* v. *Higgins*, 1860, 27 L. J. Q. B. 145, 411; 8 H. L. C. 550; *In re Mollock*, 1865, Newton's Lon. Jour. N. S. vol. 22, p. 69; *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205, 227.

It may be convenient to refer here to the present law by way of contrast:—(1) The power of amendment is not restricted to mere rejection, but the amended specification must not claim an invention substantially larger than, or different from, that which was included in the original specification: Act of 1883, s. 18, sub-s. 8. (2) The amendment, in all Courts and for all purposes, is deemed to be part of the specification: *ibid.* sub-s. 9. (3) The amended specification has now a retrospective effect, subject to such conditions as may be imposed on the applicant or patentee on his obtaining leave to amend: *ibid.* sub-ss. 4, 5, 7. (4) A restriction on the right to recover damages is now substituted (sect. 20) for the leave of the law officer required by 15 & 16 Vict. c. 83, s. 39. (5) Every amendment of a specification is advertised.

(*a*) 1854, Macr. P. C. 235.

(*b*) Cf. *Rubery's Patent*, 1837, 1 Web. P. C. 649, n.; *In re Nickel's Patent*, 1841, 1 Web. P. C. 650; *Re Adams' Patent*, 1853, 21 L. T. 36.

(*c*) 1840, 1 Web. P. C. at p. 646.

of the party, and if sufficient evidence were given of the fact, I should think myself authorized by precedent to correct the error, and make the enrolment accord with the proved intention of the party at the time of enrolment. But it has never been supposed that the Master of the Rolls, as Keeper of the Records, had power to permit or to order an erroneous claim to be expunged or amended. The party may have claimed too much, and thereby made his patent good for nothing, or may have omitted to claim something which he was justly entitled to: but on such grounds the Keeper of the Records could not interfere on his behalf or at his instance; and I apprehend that no attempt has ever been made to induce the Keeper of the Records to expunge by his authority some claim which the patentee desired to sustain, and was willing to defend in the course of law. Under the late statute the disclaimer is not to be such as shall extend the exclusive right granted by the letters patent. But the Keeper of the Records, as such, has no authority to decide whether there is any extension; nor has he, in that character, any means of investigating the truth and justice of the case. It is no part of his duty, when he receives the enrolment into his custody, to consider whether the Attorney or Solicitor-General has improperly given leave to file the memorandum, nor can he afterwards determine any such question."

2. *Existing Law.*

(a) *Amendment generally.*

Present jurisdiction of Master of Rolls.

Sect. 18 of the Patents Act, 1883, did not affect the power of the Master of the Rolls to allow amendments of the character above described (*d*); nor was that power transferred by the Judicature Act to the High Court of Justice (*e*).

So long, however, as the specification is in the Patent Office, and before the patent is sealed, the proceedings under sect. 18 should be the only proceedings taken by anyone asking for amendment within that section (*d*).

In *Re Dixon's Patent* (*f*), where the errors which it was sought

(*d*) *Re Gare*, 1884, per Brett, M. R. 26 Ch. D. 105. Cp. *Re Johnson*, 1877, per Jessel, M. R., L. R. 5 Ch. D. 503. In this case notice of the order was given to the Commissioners of Patents, so that the specification might be reprinted. See also *Sharp's Patent*, 1840, 1 Web. P. C. 640; *Re Dixon*, 1881, Eng. Rep. January to March, 1881, vol. xvi.; Lawson, p. 59.

(*e*) Jud. Act, 1873, s. 17, sub-s. 6; *Re Morgan*, 24 W. R. 245.

(*f*) *Ubi sup.*

to correct were alleged to be material, an order was only made upon the petitioner giving an undertaking not to sue any person in respect of infringements committed before the date of the order. In the later case, *Johnson's Patent* (*g*), however, such an undertaking was not required.

In the case of *Abel's Specification* (*h*), 1876, No. 2081, where it was proved, on the trial of *Otto* v. *Linford* (*i*), that the drawing filed with the specification contained draughtsman's errors, and that in the parts where these errors occurred the drawing was not in conformity with the description, but that a competent workman following the description could easily find out the errors and put them right; Sir George Jessel, M. R., on the petition of the agents for the patentee, praying that they might be permitted to substitute for the drawing filed with the specification a new drawing in which the errors were corrected, allowed the new drawing to be filed in addition to the original one. (6 March, 1883.)

Present law as to amendments and disclaimers.

The following are the chief provisions as to amendments (*j*) and disclaimers under the existing law:—

Amendment by disclaimer, correction, or explanation.

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

Amendment by disclaimer pending proceedings.

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

Restriction on recovery of damages.

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

(*g*) 1831, Eng. Rep. April to June, vol. xiii.
(*h*) Cited by Lawson, p. 59.
(*i*) 1881-82, 46 L. T. N. S. 35.
(*j*) Amendments of titles are fully dealt with at p. 93.
(*k*) Sect. 18, sub-sect. 1.
(*l*) Sect. 19.
(*m*) Sect. 20.

Amendment by comptroller of clerical error.

(4) The comptroller may, on request in writing, accompanied by the prescribed fee, correct any clerical error in or in connexion with an application for a patent (*n*).

Amendment of other documents.

(5) Any document for the amending of which no special provision is made by the Acts, may be amended, if and on such terms as the comptroller may think fit (*o*).

Request for leave to amend.

A request for leave to amend a specification is required to be signed by the applicant or patentee, and accompanied by a copy of the duly certified printed original specification and drawings, showing in red ink the proposed amendment, and to be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct (*p*).

Sect. 18, to what amendments applicable.

Sect. 18 of the Act of 1883, applies to the amendment of specifications after they have become public property; any other amendment must be dealt with under sects. 7 and 9 (*q*).

The construction of this section was considered in *Jones's Patent* (*q*). There a complete specification had been filed after a provisional, the full time (9 months) allowed by the Act for so doing being taken by the applicant. Ten weeks subsequent to the filing of the complete and prior to its acceptance, the applicant asked leave to amend under sect. 18. The comptroller did not require the application for leave to amend and the nature of the proposed amendment to be advertised, on the ground that the complete had not yet been accepted, and was therefore not open to public inspection at the date of the application for leave to amend. Webster, A.-G., held that the fact of the office not having signified its acceptance of the complete specification as lodged was immaterial, and that any proceedings for amendment must be taken in pursuance of sect. 18.

Grounds of application to amend.

The most usual grounds (*r*) on which application is made under

(*n*) Act of 1883, sect. 91 (a).

(*o*) P. R. 1890, r. 16. This was rule 18 in the P. R. 1883.

(*p*) P. R. 1890, r. 52, and Form F, p. 742. Applications may be sent to the Patent Office by prepaid letter. P. R. 1890, r. 16 a.

(*q*) *Jones's Patent*, Griffin, P. C. 313.

(*r*) It may be interesting to extract a few of the actual advertisements of applications to amend from the Illustrated Official Journal (Patents) for 1889. Each list of applications has the following heading:—*Notice is hereby given that any person or persons intending to oppose any of the under-mentioned applications must leave at the Patent Office, within one month from the date of this journal, notice (on Form G.) of his or their objections thereto.* N.B.—*The paging referred to is that of the printed specifications.* Then follow the advertisements.

E. g. (1) "No. ——, 15th July, 1889. Improved grids or supporting frames of electric accumulators.

E—— C——, has applied for leave to amend the specification above referred to, alleging as his reasons: 'That my

sect. 18 for the amendment of specifications are that it is desired to correct sundry errors, clerical and otherwise, which interfere with the due comprehension of the specification, that it is doubted whether the subject-matter of one of the claims is good and novel, that the claims might be construed as covering subject-matter which was of doubtful novelty at the date of the patent, that the applicant desires to make the specification more clear, and to limit the scope of the claims which as they stand are too wide, that the applicant has since discovered that his specification claims more than he desired, that it is proposed to insert in the original application the name of a joint applicant, that reference to prior patents was omitted in the former specification.

Duty of patentee.

That a patentee desires the principle upon which his invention is based to be fully understood is not a sufficient reason for an amendment. It is the duty of a patentee to fulfil the condition of his patent and to file a proper and sufficient specification (*s*).

An amendment will not be disallowed merely because the reasons given for it are insufficient (*t*).

The plain language of the operative part of a disclaimer is not

instructions were misunderstood by the draughtsman, and the draughtsman's error has been to some extent followed by the writer of the specification in order to make it agree with the drawing. Also that I am not acquainted with the English language.'

The proposed amendments are as follows:—

On page 1

Line 7. To strike out '. . . .'

Line 38. To insert '. . . .'" &c.

(2) "No. ——, 26th January, 1888. Improvements in matchboxes.

J. B. and A. A. B. have applied for leave to amend the specification of letters patent above referred to, alleging as their reasons: 'That we have ascertained that the specification of a foreign patent, which was open to inspection in the United Kingdom before the date of our said patent, referred to an invention having some of the features contained in the modification described under Figures 2 and 3 of the original mode of carrying out our invention described under Figure 1, and that the aforesaid foreign patent might be considered as an anticipation of such parts,'" &c.

(Amendments set out as before.)

(3) "No. ——, 26th August, 1884. Improvements in machines for producing stereotype matrices, and for printing.

J. B. (assignee) has applied for leave to amend the specification of letters patent granted to O. M. above referred to, alleging as his reasons; 'That I am advised that there are certain clerical errors and inaccuracies in the language of the specification, which interfere with its real meaning, that parts of the specification and claims may receive an erroneous interpretation, and that all the reference letters in the specification donot appear throughout the figures,'" &c.

(Amendments set out as before.)

(4) "No. ——, 5th March, 1889. Improvements in and connected with watch bows and pendants.

F. G. F. has applied for leave to amend the specification of letters patent above referred to, alleging as his reasons: 'That I desire to better explain and define the scope of the invention, to exclude a part of the invention claimed, and to correct an omission on the drawings,'" &c.

(Amendments set out as before.)

(*s*) *Re Nordenfelt*, 1887, per Webster, A.-G., Griffin, A. P. C. at pp. 20, 21. Here the law officer's decision was influenced by the fact that a complete specification had been filed in the first instance.

(*t*) *Re Ashcorth*, 1886, per Davey, S.-G., Griffin, A. P. C. p. 7.

to be controlled or modified by any introductory sentences with which the patentee may think fit to preface such disclaimer. The reason for a disclaimer is no part of the disclaimer itself (*u*).

Who may apply for amendment under sect. 18.

The persons who may apply for the amendment of a specification under this section are (1) an applicant who has filed his complete specification; and (2) a patentee, *i.e.*, "the person for the time being entitled to the benefit of a patent" (*x*).

Under this definition of patentee, it is clear that an assignee and a mortgagee may be applicants for leave to amend. It was formerly held that a patentee could disclaim even after wholly (*y*), or partially (*z*), assigning his interest in a patent.

Second disclaimers.

Second disclaimers are clearly permissible (*a*), but are not to be encouraged if they can possibly be avoided. And the Law Officer on appeal may refuse to make an order as to costs in favour of a successful applicant (*b*).

In *Re Arnold* (*c*), an application for leave to amend had been made in 1885, had been refused by the comptroller, and had not been appealed against. Two years later a second application, for substantially the same amendment, was made by the same applicant. The comptroller refused to allow it, and an appeal was taken to the Law Officer. Webster, A.-G., said that he thought the proposed amendments were such as he would allow to be made, but required an explanation of there having been no appeal against the former decision of the comptroller. The case was accordingly adjourned and declarations were put in alleging that the applicant was ignorant of patent law, and that he was not aware until after the comptroller had rejected his second application that he could have appealed on the former occasion. The Attorney-General held that this was not a sufficient explanation, and dismissed the appeal.

Amendment by explanation.

The function of an "explanation" within sect. 18 is to permit a man to amend, correct, and explain the enunciation of his invention as he intended originally to give it. It was not intended that he should put in subsequently ascertained knowledge (*d*).

(*u*) *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205, 227, 228.
(*x*) Act of 1883, s. 46.
(*y*) *Wallington* v. *Dale*, 1851–52, 7 Ex. R. at p. 910.
(*z*) *Spilsbury* v. *Clough*, 1842, 1 Web. P. C. 255.
(*a*) Act of 1883, s. 18, sub-s. 1.
(*b*) *Re Haddan*, 1885, Griffin, A. P. C. 13.
(*c*) 1887, Griffin, A. P. C. 5.
(*d*) *In re Beck and Justice's Patent*, 1886, Griffin, A. P. C. 10. But an explanation will be allowed, which is necessary to remove an ambiguity which prevents the real meaning of a patentee from being understood. *Re Ashworth*, 1886, Griffin, A. P. C. 6. So if a specification is on the face of it clearly capable

Must not give subsequently ascertained knowledge.

In *Re Beck and Justice's Patent* (*e*), an unopposed application to amend the specification of a patent for "improvements in nozzles for the escape of steam or gases under pressure," one proposed amendment was a rider giving detailed measurements relating to gas engines. There was no mention of gas engines in the original: and the applicant admitted that a good deal of the information given was necessitated by the development of the discovery of the gas engines, or by gas engines being more largely used and developed. This amendment was refused.

Must be consistent with fulfilment of condition of patent.

The defect which is to be cured by an explanation must be one which is consistent with the patentee intending to fulfil the condition of his patent by properly describing his invention (*f*).

Re Nordenfelt (*f*), was an application for leave to amend the specification of a patent for improvements in the manufacture of castings for wrought iron and steel. The invention consisted in the admixture of metallic aluminium or aluminium alloy with molten iron or steel before casting the same into moulds. The applicant proposed to add a long explanatory statement of the proportions required, and of the character of an alloy in which the aluminium might be introduced, if not introduced pure. Both amendments were rejected. "Before the patentee," said Webster, A.-G., "can insert anything into a description which if the invention were new was sufficient, and if not was open to serious objection, I think he must show that there is a real reason for requiring it. The principle of his invention was in my opinion amply described in his original complete specification."

A statement in an amendment imputing faults to all formerly used or patented methods will not be allowed (*g*).

In any question of doubt it is not the duty of the law officer to disallow an amendment, because his decision, being final, might thereby deprive a patentee of valuable rights, whereas the patentee takes the amendment at his peril (*h*).

of two constructions, it is open to the person applying to satisfy the law officer or the comptroller, on the face of the specification, that he desires to limit the claim to one or more of them. *Re Ryland*, 1888, per Webster, A.-G., 5 P. O. R. at p. 668. In *Bateman's Patent*, 1854, Macr. P. C. 116, where there was some evidence upon the face of a specification that the patentees intended their invention to comprise an entire apparatus, but at the end of the specification they claimed the several parts of the apparatus, Bethell, S.-G., allowed a disclaimer, the effect of which was to convert the claim into one for the combination. Higgins's Dig. p. 251.

(*e*) 1886, Griffin, A. P. C. 10.

(*f*) *Re Nordenfelt*, 1887, Griffin, A. P. C. 18.

(*g*) *Re Hampton and Facer*, 1887, per Clarke, S.-G., Griffin, A. P. C. at p. 15.

(*h*) *Re Lake*, 1887, per Webster, A.-G., Griffin, A. P. C. 16; cp. *Bateman's Patent*, 1854, Macr. P. C. 116.

Opposition to amendments.

Notice of opposition to a proposed amendment may be given at any time within one month from the first advertisement above referred to (*h*).

Grounds of opposition.

The notice of opposition must state the ground or grounds on which the person giving notice intends to oppose, and must be signed by him, state his address for service, and be accompanied by an unstamped copy (*i*).

Statutory declarations.

This copy is forwarded by the comptroller to the applicant (*k*). Within fourteen days after the expiration of one month from the first advertisement of the proposed amendment the opponent may leave at the Patent Office, and on so doing shall deliver to the applicant a list of statutory declarations in support of his opposition (*l*). The applicant has fourteen days thereafter to lodge at the Patent Office and deliver to the opponent statutory declarations in answer, and within fourteen days from such delivery the opponent may lodge statutory declarations in reply, which must be confined to matters strictly in reply. The evidence is then closed on either side except by leave of the comptroller on the written consent of the parties or on special application to him. Ten days notice, at least, of the date of hearing is given by the comptroller to the parties (*m*), and the comptroller then hears and decides upon the case subject to an appeal to the law officer (*n*), whose decision is final.

Conditions imposed.

As the decision of a case does not necessarily involve an absolute refusal or an absolute allowance, the comptroller is at liberty to impose conditions (*o*), and he has the same power in this respect as the law officer on appeal (*p*). The comptroller has, however, no power to make the payment of costs a condition of allowing an amendment (*q*).

Persons entitled to be heard.

Only a person "being in the opinion of the law officer entitled to be heard," can oppose the amendment of a specification before the law officer (*r*). It is doubtful whether this limitation of opposition applies to proceedings before the comptroller;

(*h*) Act of 1883, s. 18, sub-s. 2.
(*i*) P. R. 1890, r. 53.
(*k*) *Ibid.* r. 54.
(*l*) *Ibid.* r. 55.
(*m*) *Ibid.* r. 56, and r. 41.
(*n*) Act of 1883, s. 18, sub-s. 3. The law officer is not a court, and no prohibition lies to prevent him allowing an amendment forbidden by sect. 18 of the Act of 1883. *Re Van Gelder*, 1889, 6 P. O. R. 22; reported as *Ex parte Simon*, 4 Times Rep. 764. A prior patentee may oppose on the ground that an amendment if allowed would have a prejudicial effect upon his rights under a patent. *Re Hampton and Facer*, 1887, Griffin, A. P. C. 13.

(*o*) *Hearson's Patent*, 1884, Griffin, P. C. 309.

(*p*) *Re Pietschmann*, 1884, Griffin, P. C. 314.

(*q*) *Re Pietschmann*, 1884, Griffin, P. C. 314, impliedly overruling *Re Codd*, 1884, Griffin, P. C. 303.

(*r*) Act of 1883, s. 18, sub-s. 4. See Chapter IX., pp. 175—178, where the question of who is "entitled to be heard" before the law officer is considered.

but in the case of *Re Bell* (*s*), the comptroller went into the question of the opponent's interest, although it was not directly raised.

Amendment and opposition contemporaneous.

In *Re Cochrane* (*t*), subsequent to notice of opposition to a grant, and prior to the hearing of such opposition, the applicant applied under sect. 18 for leave to amend. The two oppositions were fixed for hearing on the same day, and the question arose as to which should be heard first. The applicant urged that the amendment should be heard first, on the ground that probably if the amendment were allowed the sting would be taken out of the opposition to the grant of the patent. The comptroller took this view, and the amendment case was taken first.

Appeal in unopposed cases.

Where no notice of opposition is given, or the opponent does not appear, an applicant or patentee may nevertheless appeal to the law officer against the comptroller's decision refusing leave to amend (*u*).

Comptroller's costs.

In such cases, unless under very special circumstances, the Comptroller-General neither gives nor receives costs (*x*).

In *Re Morgan* (*y*), an unopposed application for leave to amend the specification of a patent ten years old, rejected by the comptroller, was allowed by the law officer. The applicant then asked for an order for a return of the stamp on the notice of appeal, but this was refused. "This was a case," said Webster, A.-G., "in which the Comptroller-General was quite right in declining to allow it in the first instance and to leave it to the law officer. There was quite sufficient difficulty about it. It is a ten year old patent, and therefore I should not be disposed to make a special order."

Evidence before the law officer.

The evidence brought before the law officer on appeal must be the same as that brought before the comptroller, and no further evidence may be given except with the law officer's leave, save as to matters which have occurred or come to the knowledge of either party since the date of the decision appealed against (*z*).

Thus, in *Re Cheesebrough* (*a*), it appeared that certain words were objected to by the opponents before the comptroller, and were struck out. On appeal, the opponents objected that the original notice as advertised did not request that these words should be struck out, and that they could not now be excised. Herschell, S.-G., held, however, that as the retention of these words had been objected

(*s*) 1887, Griffin, A. P. C. 11.
(*t*) 1885, Griffin, P. C. 304.
(*u*) Act of 1883, s. 18, sub-ss. 5—7.
(*x*) *Re Lake*, 1887, per Webster, A.-G., Griffin, A. P. C. at p. 17.
(*y*) 1886, Griffin, A. P. C. 17.
(*z*) L. O. R. r. 8; *Re Hampton and Facer*, 1887, Griffin, A. P. C. 13.
(*a*) 1884, Griffin, P. C. 303.

to by the opponents before the comptroller and he had struck them out, the opponents could not now object to their omission.

Costs before law officer.

Under sect. 38 of the Act of 1883, the law officer may order payment of costs (*b*). The comptroller has no power to award costs.

In *Re Ashworth* (*c*), where the specification was loosely framed, Davey, S.-G., although allowing an amendment, refused to give any costs of the appeal.

Conditions of amendment.

In the case of patents granted under the old law,—as a general rule and apart from special circumstances, which any party is at liberty to bring forward (*d*),—a condition when desired will be imposed that no action shall be brought or other proceeding taken for any infringement prior to 1st January, 1884 (*e*).

Such a condition protects the continued user of articles made by the opponents prior to 1st January, 1884, subsequent to that date, and also the sale of articles in stock and unsold prior to 1st January, 1884 (*f*).

Special circumstances.

The nearest approach to a definition of "special circumstances" is that given by Davey, S.-G., in *Re Ashworth* (*g*): "If I saw, or if there was any evidence before me that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons, and endeavouring to prevent persons from making or selling (the subject-matter of the patent in question, viz.,) wire hardened and tempered in a mode different from that which was claimed, I should consider that a special circumstance, and under those circumstances, as far as I am personally concerned,

(*b*) *Aliter* under the Act of 1835; *Kynoch* v. *National Small Arms Co.*, 1877, 37 L. T. N. S. 31.

(*c*) 1886, Griffin, A. P. C. at p. 9.

(*d*) *Re Haddan*, 1885, per Webster, A.-G., Griffin, A. P. C. at p. 13.

(*e*) *Re Hearson*, 1884, 1 P. O. R. 213; cp. *Re Cheesebrough*, 1884, Griffin, P. C. 303; *Re Westinghouse*, 1885, Griffin, P. C. 315; *Re Ashworth*, 1886, Griffin, A. P. C. 6.

(*f*) *Re Cheesebrough*, *ubi supra*, per Herschell, S.-G.: "If the opponents, however, had been making the (articles) after notice that the patentee was going to disclaim, there would be a good deal to be said for not protecting them." *S. C.*; cp. *Re Harrison*, 1853, Macr. P. C. 31; *Re Medlock*, 1865, Newt. Lond. Jour. N. S. vol. 22, p. 69. In *Re Smith*, 1855, Cockburn, A.-G., said, that the undertaking not to sue in respect of past infringements must be wide enough to include not only opponents but everyone. He refused, however, to protect persons who had contracted to supply the patented articles, and claimed immunity up to the time of the termination of their contracts. Macr. P. C. 232, 234; *Re Tranter*, 1873, John. Pat. Man. 191; *Re Jones*, 1881, *ibid.* 192; *Re Crabtree*, 1881, Eng. Rep. Jan. to Mar. 1881; *Re Westinghouse*, 1885, Griffin, P. C. 315.

(*g*) 1886, Griffin, P. C. at p. 9.

I should impose the condition that no action should be brought for anything done at any time before the amendment."

"I do not think," said Webster, A.-G., in *Re Haddan* (*h*), "any law officer or Comptroller-General can put down what are the most convenient means of identifying machines. . . . What would be sufficient in one case would be wholly inapplicable in another. It would be much better that the parties should agree upon a form which will be applicable to their special business, and submit that to the Comptroller-General, rather than to leave the language to be settled by him, especially as it is not desirable to have appeals upon the question of terms. The agreed words should be sent to the patent clerk to be embodied in the order." Identification of protected articles.

In *Re Edison* (*i*) the instruments allowed to be used were ordered to be marked with identifying marks.

In *Re Westinghouse* (*k*), an application for leave to amend the specification of a patent for "improvements in apparatus for working brakes and communicating signals on railway trains," James, A.-G., imposed a condition that no action should be brought in respect of certain specified apparatus made in alleged accordance with the said specification, and fitted to rolling stock prior to 1st January, 1884, and ordered each opponent to furnish the patentee with a full statement of the locomotives and other vehicles belonging to them respectively, and fitted with the protected apparatus, with numbers and other distinguishing marks, and to give notice, from time to time during the subsistence of the patent, of any change in any apparatus so fitted, except mere renewals of parts.

In the case of patents issued since the passing of the Act of 1883, no condition will be imposed as to the bringing of actions for infringement prior to the date of the amendment, but the matter will be dealt with by the Court under sect. 20 (*l*).

The Act of 1835 (*m*) provided that no disclaimer or alteration should be allowed which *extended* the exclusive right granted by the letters patent. Act of 1835. No amendment must extend grant.

The meaning of the word "extend" was considered in *Ralston* v. *Smith* (*n*). R. took out a patent for "improvements in embossing and finishing woven fabrics, *and in the machinery and apparatus*

(*h*) 1885, Griffin, A. P. C. 12.
(*i*) Lawson, p. 64.
(*k*) 1885, Griffin, P. C. 315.
(*l*) *Re Allen*, 1887, per Clarke, S.-G., Griffin, A. P. C. 3.
(*m*) 5 & 6 Will. IV. c. 83, s. 1.
(*n*) 1865, 11 H. L. C. 293.

No amendment must extend grant.

employed therein." In his specification, he stated: "I employ a roller of metal, *wood*, or other suitable material, and groove, flute, engrave, mill, or otherwise indent upon it any desired design." R. afterwards entered a disclaimer, in which he disclaimed from the title and from the description of the roller the words in italics, and restricted the grooves or flutes on the roller to those of a circular kind. It appeared that R. had discovered that any other grooves would not only not produce the desired effect on the fabric, but would destroy it. It was held by the House of Lords that the disclaimer extended the exclusive right, and consequently was bad.

Meaning of "extend."

"The word 'extend,'" said Lord Chelmsford, "in 5 & 6 Will. IV. c. 83, cannot be used only in its ordinary sense of 'adding to' or 'enlarging,' because the exact meaning of the term 'disclaimer,' to which it is applied, is the renunciation of some previous claim actually or apparently made or supposed to be made (*o*). It must, therefore, be intended to comprehend a case where the disclaimer would give the patentee a right which he could not have enjoyed under the specification as originally formed. Here the specification was conceived in general terms, embracing an infinite variety of modes of indenting upon all descriptions of rollers any desired design. The plaintiff afterwards discovered that no other rollers but those which had circular grooves, flutings, or indentations around their surfaces would answer, and he therefore, by his disclaimer, limited his invention to this description of rollers only. Now, as these were not specifically described in the original specification, but were merely involved in the general terms which were used, the plaintiff had not complied with the condition of the letters patent in particularly describing and ascertaining the nature of his invention. When, therefore, by his disclaimer he confines his claim to circular grooved rollers as his sole invention, though in one sense he may be said to narrow a right, yet he really extends it, because he thereby describes his alleged invention sufficiently to enable him now to assert a right under the patent which he never could have successfully maintained upon the patent alone."

Where, however, the patentee of "improvements in machinery

(*o*) But the mere fact of a disclaimer being made by a party to whom a grant has been made, does not necessarily import that the original patent was void. *Stocker* v. *Waller*, 1845, per Tindal, C. J., 9 Jur. 138, reported as *Stocker* v. *Warner*, in 1 C. B. 148.

for preparing, slubbing, and roving fibrous substances," described in his specification a particular method for the application of centrifugal force, and claimed (1) the method so described, and (2) every other application of centrifugal force to the purpose set forth, it was held that a subsequent disclaimer of every application of the law or principle of centrifugal force, except that only described in the specification, did not extend the right granted by the patent (*p*).

Act of 1883. No amendment may make invention larger.

Under the present Act (*q*) it is provided that no amendment will be allowed that would make the specification as amended claim an invention substantially larger than or different from the invention claimed by the specification as it stood before amendment (*q*).

Present practice substantially the same.

Although these words are apparently wider than the corresponding proviso in the Act of 1835, the practice does not seem to have been materially altered under the new law, and any amendment or disclaimer will in general be allowed, which merely (1) removes an ambiguity rather than a defect in the original claim; (2) restricts or does not enlarge the original claim, or (3) alters part of the description without affecting the claim.

Cases.

Reference to a few cases will make the modern practice clear.

Re Allen.

In *Re Allen* (*r*) a patentee who had claimed "the use of pipes of *novel* form, constructed of earthenware, to form, as herein above stated and described, a direct connection . . . . with the main drain," asked leave to omit from the title the words "of novel form"; to insert before claim, "I do not claim as novel pipes one, two, and three respectively," and to alter the claim to "the use of pipes of the above form constructed of earthenware." The patentee contended that he had worded his original specification in perfect good faith and with such skill and knowledge as he possessed, but as he had not had professional assistance in the matter, he, without meaning to do so, claimed the *form* of the pipes as novel, as well as claiming the use and application of them, which was all he intended and wished to claim. Clarke, S.-G., allowed the proposed amendments. "I think," he said, "that my business in this case is to look at the specification, to take into consideration the declaration which has been made by the patentee as to the way in which he drew it up, and as to his intention, and to exercise my judgment as to what I should fairly have considered, upon reading the speci-

(*p*) *Seed* v. *Higgins*, 1858, per Lord Chelmsford, 8 H. L. C. at p. 603; cp. *Reg.* v. *Mill*, 1850-51, 10 C. B. 379.

(*q*) Act of 1883, s. 18, sub-s. 8.

(*r*) 1887, Griffin, A. P. C. 3.

fication, he intended to claim. . . . However clumsily the specification was expressed, I think that substantially it claimed the arrangement of the pipes, and not the form of the particular pipes, and I therefore think that the amendment will not enlarge the claim, and will not make it a claim for a different invention, but will remove ambiguity rather than defect in the original claim "(s).

Re Cochrane. In *Re Cochrane* (t), where the original specification, describing an invention for an improvement in moulds for cooling and discharging slag, claimed all angular or wedge-shaped slag boxes, an amendment was allowed confining the claim to a particular class of slag box, which was included with a number of other slag boxes in the previous claim.

"If you have got a claim," said Davey, S.-G., "for A, B, C, D, E, and F, and you confine it to F, that is a narrower claim than the original, and it is not different because it is included in the old claim."

Re Nordenfelt. In *Re Nordenfelt* (u), the original specification directed the addition of aluminium, or alloy of aluminium, to metal when molten, shortly before it was to be poured, and then stated that *the addition might, however, be made earlier*. The patentee was allowed to disclaim the words in italics. "It is clear," said Webster, A.-G., "that that could not extend the claim, whereas now it stands as a claim to put in the aluminium at the melting point or earlier; the striking out of those words would limit it to the time indicated—the melting point."

Re Lake. In *Re Lake* (x) it was proposed to amend the specification of a patent for "improvements in and relating to the manufacture of colouring matter," by altering part of the description of the process without amending the claim. Webster, A.-G., allowed the amendment, on the ground that on the information before him he was unable to see that it extended the grant.

Re Morgan. In *Re Morgan* (y) an application was made to amend the specification of a patent for "improved watch-keys." In the original description the applicant had misdescribed one of the figures, No. 3, in the sheet of drawings. He proposed to insert a correct

(s) The Solicitor-General added, however, "Inasmuch as these proceedings have been rendered necessary by the misfortune (to say the least of it) of the patentee in preparing his specification in the way he did, of course I shall say nothing about costs."

(t) 1885, Griffin, P. C. 304, 305; *Re Ashcorth*, 1886, Griffin, A. P. C. 6; *Re Rylands*, 1888, 5 P. O. R. 665.

(u) 1887, Griffin, A. P. C. 20.

(x) 1887, Griffin, A. P. C. 16.

(y) 1886, Griffin, A. P. C. 17.

description of it, and to add at the end of his claim the words *and as illustrated in the accompanying drawings.* Figure 3 was included in the provisional and also in the claim of the complete specification. Webster, A.-G., held that the amendment should be allowed, as it was included in the original claim.

But the applicant will not be allowed to amend his specification by disclaiming the main part of the original invention, even if he merely claims an obvious alternative resting on the part which he proposes to omit (*z*).

Again, the insertion of a single word, which introduces, however, an entirely new feature into the original specification, will not be permitted (*a*), and when there is a distinct and specific claim, without any claim being made to a minor arrangement of parts, a patentee cannot strike out the whole of his claim and insert an independent claim to a subordinate part (*b*).

Leave to amend conclusive.

Leave to amend is conclusive as to the right of the party to make the amendment allowed, except in the case of fraud, and the amendment, in all Courts and for all purposes, is deemed to form part of the specification (*c*).

In the previous Acts, and down to the present Act, the leave of the law officer did not give validity to a disclaimer which extended the scope of the invention, or altered it substantially. That was decided in the case of *Dudgeon* v. *Thomson* (*d*), by the judgment of Lord Blackburn, and also by the language of the then Attorney-General, Sir Richard Bethell, in *Bateman's Patent* (*e*). In the present Act the language of the old statutes is to some extent recast; but no *prohibition* will issue against the law officer on the ground that he has allowed an amendment improperly, and if an amendment be allowed contrary to the terms of sub-sect. 8 of sect. 18 of the Patents Act, 1883, the amendment can be questioned in any subsequent proceedings. This was laid down in the well-known case of *Van Gelder's Patent* (*f*).

No prohibition to law officer for improper amendment.

In this case, V. having applied at the Patent Office for leave to amend his patent, S. opposed. The comptroller allowed the proposed amendment. S. appealed to the law officer, and the Attorney-General then intimated that the amendment should be allowed. S. applied to the Court of Queen's Bench for a prohibition to pro-

(*z*) *Re Heath and Frost*, 1886, per Clarke, S.-G., Griffin, P. C. 312.
(*a*) *Re Walker*, Griffin, A. P. C. 22.
(*b*) *Re Serrell*, 1889, 6 P. O. R. 101.
(*c*) Act of 1883, s. 18, sub-s. 9.
(*d*) 1874, L. R. 3 A. C. 34.
(*e*) 1854, Macr. P. C. 116.
(*f*) 1889, 6 P. O. R. p. 22.

hibit the Attorney-General from allowing the amendment, on the grounds (1) that the amendment, if allowed, would make the specification claim a larger invention than that originally patented; (2) that the amendment proposed to be allowed had not been advertised. Held, by the Divisional Court, that a rule nisi for a prohibition ought to be granted on the second ground, but not on the first. S. appealed to the Court of Appeal, who intimated that the owners of the patent and the Attorney-General ought to be heard on the matter, and directed them to be served with notice of motion. This having been done, and the matter argued—held (1), that no prohibition would issue against the Attorney-General in the matter; (2), that if an amendment of the specification were allowed, which was contrary to sub-sect. 8 of sect. 18 of the Patents, &c. Act, 1883, it could be questioned in a subsequent action (*f*).

(b) *Disclaimer pending Action.*

Disclaimer pending action.

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

Practice under sect. 19.

Liberty to apply to amend (*i*) will not be given to one party proceeding for revocation, are going on at the same time, the comptroller cannot refuse leave to amend on the ground that liberty to apply has been obtained in one of them only. *Re Hall, ubi supra*, overruling impliedly *Re Codd*, 1884, Griffin, P. C. 305; *Goulard* v. *Gibbs*, 1888, 5 P. O. R. 196. In *Re Codd*, where it was held that leave must be obtained in each of two such actions as aforesaid, the original office copy of the order previously made in the first action was admitted at the second hearing. The comptroller decided that such order was not exhausted, the application for amendment having been refused not on its own merits, but upon a technical point.

(*f*) It would seem that in any case where on the hearing an amendment is proposed to be allowed, which has not been advertised, it should be forthwith advertised, to give other parties an opportunity of opposing.

(*g*) Act of 1883, s. 18, sub-s. 10; Act of 1888, s. 5; *Singer* v. *Stassen*, 1884, 1 P. O. R. 121, 124; *Cropper* v. *Smith* (No. 2), 1886, 28 Ch. D. 148, 151; *Re Hall*, 1888, 21 Q. B. D. 137. "Pending" means "before final judgment." *Cropper* v. *Smith, ubi supra*; cp. *Singer* v. *Stassen*, *ubi supra*; *Lawrence* v. *Perry*, 1885, 2 P. O. R. 188; *Haslam Co.* v. *Hall*, 1888, 5 P. O. R. 1, 24.

(*h*) Act of 1883, s. 19. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order must be left with the request at the Patent Office. P. R. 1890, r. 58.

Where two actions for infringement, or an action and infringement, and a

(*i*) The application may be made in chambers. *Singer* v. *Stassen*, 1884, W. N. 1884, p. 63. Only a disclaimer appears to be allowable under this section.

without the Court or the judge (*k*) seeing that no injustice is done to the other thereby (*l*).

Conditions imposed.

It is, therefore, usually made a condition of leave being granted that (a) the costs of and occasioned by the application for leave to disclaim (*m*); (b) the costs also of the action up to the time of leave being obtained (*n*), should be paid in any event by the applicant.

Apart from the practice as to imposing costs (*o*), no hard and fast rule has been laid down as to the manner in which the discretion given by the 19th section should be exercised (*p*).

A condition that the amended specification should not be given in evidence at the trial is a reasonable one, and is often imposed, unless special circumstances are made out in order to justify such an indulgence (*p*).

Whenever the Court or a judge exercises discretion upon the particular facts of the case, the Court of Appeal will not interfere with the exercise of that discretion unless in their view it was absolutely wrong (*p*).

The judge has an absolute discretion in imposing terms under sect. 19. In *Lang* v. *Whitecross Co.* (*q*), the owners of a patent for wire ropes brought an action for infringement. After the delivery of the defence, they applied for liberty to apply at the Patent Office to amend their specification by way of disclaimer. The judge in chambers gave them liberty to apply, and to use the amended specification as evidence on condition that no damages be recovered, or claim for injunction founded on anything done before disclaimer, and that the costs of the action up to the time

(*k*) See sect. 117. *Semble*, the House of Lords has no jurisdiction to entertain such an application. *Cropper* v. *Smith*, 1883-84, 28 Ch. D. 148.

(*l*) *Goulard* v. *Lindsay*, 1888, per Cotton, L. J., 38 Ch. D. at p. 41; op. *Bray* v. *Gardner*, 1887, 34 Ch. D. 668.

(*m*) *Winter* v. *Baybut*, 1884, 1 P. O. R. 76; *Singer* v. *Staasen*, 1884, ib. 121; *Codd* v. *Bratby*, 1884, ib. 211.

(*n*) *Fusee Vesta Co.* v. *Bryant and May*, 1887-88, 34 Ch. D. 458; 37 Ch. D. 120; 4 P. O. R. 73; *Haslam, &c. Co.* v. *Goodfellow*, 1888, 37 Ch. D. 118, 123. In this case the applicant was required to pay costs of the action only in so far as the previous proceedings could not be used in the amended action. See *Goulard* v. *Lindsay*, *ubi supra*, 38; 5 P. O. R. 194. Here the Court of Appeal refused to give costs on the higher scale. *Ubi supra*, at p. 197. In the case of *Fusee Vesta Co.* v. *Bryant and May*, *ubi supra*, at p. 461, Kay, J., refused to give any direction as to costs of obtaining the disclaimer before the comptroller.

(*o*) Sometimes no terms, except as to costs, are imposed. *Winter* v. *Baybut*, *ubi supra*; *Re Hearson*, 1884, 1 P. O. R. 213; *Fusee Vesta Co.* v. *Bryant and May*, *ubi supra*.

(*p*) *Allen* v. *Doulton*, 1887, per Lord Esher, M. R., 4 P. O. R. 383, explaining *Singer* v. *Staasen*, 1884, 1 P. O. R. 121; and *Bray* v. *Gardner*, 1887, 34 Ch. D. 668; op. *Re Hearson*, 1884, per Herschell, S.-G., Griffin, P. C. at p. 310. See also special terms in *Haslam, &c. Co.* v. *Goodfellow*, 1888, 5 P. O. R. 38; *Re Goulard and Gibbs*, 1888, *ib.* 189.

(*q*) 1889, 6 P. O. R. 570.

(if disclaimer used) be the defendants' costs in the cause. The judge also ordered that the costs of the application and the costs caused in the action by disclaimer be defendants' in any event, and that proceedings be stayed pending the disclaimer. The plaintiffs appealed from this order, and contended that the conditions imposed would prevent them from deriving any advantage from continuing the present action, and that the condition as to damages was not within the jurisdiction of the judge at chambers. Held, that the judge had absolute discretion under sect. 19 to impose terms, and that the order ought not to be interfered with.

Restriction on recovery of damages.

Where an amendment by way of disclaimer, correction, or explanation has been allowed, no damages will be given in respect of the use of the invention before the disclaimer, correction, or explanation unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge (*r*).

Where leave to amend is given, the applicant must, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawing as amended (*s*).

Every amendment of a specification is forthwith advertised by the comptroller in the Official Journal of the Patent Office, and in such other manner, if any, as the comptroller may direct (*t*).

Power of comptroller to correct clerical errors.

The comptroller may, on request in writing (*u*), accompanied by the prescribed fee (*x*), correct any clerical error in, or in connection with, an application for a patent, or in the name, style, or address of the registered proprietor of a patent (*y*).

(*r*) Act of 1883, s. 20.
(*s*) P. R. 1890, r. 57.
(*t*) P. R. 1890, r. 59.
(*u*) P. R. 1890, Form P., p. 747.
(*x*) See p. 587.
(*y*) Act of 1883, s. 91.

CHAPTER IX.

OPPOSITION TO GRANT (*a*).

THERE may be opposition either to the grant of a patent, or to the amendment of a specification. It is here proposed to consider the first of these subjects. The amendment of the specification and oppositions thereto are considered elsewhere (*b*).

The law and procedure in oppositions to the grant are regulated by sect. 11 of the Patents Act, 1883; by the Patents Rules, 1890, rr. 34 to 44 (*c*); and in case of an appeal to the law officer, by the Law Officer's Rules (*d*). An outline of the subject has already been given in Chapter VI. (*e*), to which the reader is referred.

When specifications, &c., may be inspected.

On the acceptance of the complete specification, the comptroller advertises the acceptance in the Illustrated Official Journal, and the application and specifications with the drawings (if any) are open to public inspection (*f*). The specifications and drawings being left in duplicate, one set goes to the printers and the other set is open to inspection. So soon as the specifications are printed and the drawings reproduced, they can be purchased (*g*).

The file.

The application and the original specifications and drawings remain permanently on view at the Patent Office. These documents, and others subsequently affecting the patent, are kept together in a packet, called "the file," and may be inspected on payment of the prescribed fee.

Time within which notice of opposition may be given.

At any time within two months (*h*) from the date of the advertisement of the acceptance of a complete specification, notice of

(*a*) Opposition to the extension of letters patent is fully dealt with at pp. 386 *et seq.* The oppositions under the old law are treated in the notes to the Act of 1852, sect. 12, n. (b), pp. 650—651.

(*b*) Chapter VIII., pp. 145 *et seq.*

(*c*) Pp. 573—575.

(*d*) Pp. 569—593.

(*e*) Pp. 57 *et seq.*

(*f*) Act 1883, s. 10.

(*g*) At the Patent Office (Sale Branch).

(*h*) It is frequently the practice for the opponent to delay the giving of notice of opposition until nearly the end of the two months, as by this means less time elapses between the date of the notice and date of hearing the opposition.

opposition to the grant of the patent may be given at the Patent Office. The notice must set out the grounds of opposition (*i*).

Grounds of opposition.

The *only* grounds of opposition are those given in sect. 11 of Act of 1883 (*k*), as amended by Act of 1888, s. 4, viz.:—

Invention obtained from opponent.

1. That the applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.

Patent of prior date.

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

Complete specification intended to cover opponent's application in interval.

3. That (*l*) 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.

Third ground of opposition under Act of 1883, now repealed.

Under the Act of 1883, the third ground of opposition was that the examiner had reported to the comptroller that the applicant's specification appeared to him to comprise the same invention as was comprised in a specification bearing the same or a similar title and accompanying a previous application.

This provision gave rise to, and was probably altered in consequence of, cases of hardship, such as the following:

Green's Patent.

Green's Patent (*m*). An application by G. for a patent for "improvements in and connected with fuel economisers," was opposed by L. and S., on the ground that a prior patent had been granted to them for parts of the invention claimed by the applicant.

It was admitted by G. that the parts in his specification to which L. and S. took exception were included in their complete specification; but he contended that as these parts were not specially described in their provisional specification, the opponents had included in their complete, subject-matter which was not in their provisional.

The Comptroller-General refused to seal a patent to the applicant until the claims to and description of those parts had been excised from his specification. This order was confirmed by Webster, A.-G., on appeal. "It is said that the opponents have included in their complete, subject-matter which was not in their provisional. If that

(*i*) Act of 1883, s. 11, sub-s. 1. See also Form D., Patents Rules, 1890, p. 741.

(*k*) *Ibid.*

(*l*) Act of 1888, s. 4, sub-s. 1.

(*m*) 1885, Griffin, P. C. 286.

is so, that is an objection to the validity of the opponent's patent, which will be available to the applicant or to anybody else in the event of any proceedings being taken; but it is wholly impossible for me on the present application to alter, deal with, or interfere with the specification of the opponent's patent as allowed. It may be a misfortune, but the opponent is unfortunately in the position in which other applicants have been."

Sufficiency of notice.

Sufficiency of notice of opposition.—A notice of opposition to the grant of a patent must state the ground or grounds on which the opponent intends to oppose the grant, and must be signed by him. Such notice must also state his address for service in the United Kingdom, and be accompanied by an unstamped copy (*n*).

Where the grounds or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the title, number and date of the patent granted in such prior application is required to be specified in the notice (*o*).

Insufficiency not a fatal defect.

Insufficiency in the notice of opposition is not, however, generally a fatal defect.

Amendment by comptroller of documents.

The Patents Rules provide (*p*) that any document for the amending of which no provision is made by the Acts, may be amended; and any irregularity in procedure, which, in the opinion of the comptroller, may be obviated without detriment to the interests of any person may be corrected, if and on such terms as the comptroller may think fit.

A few cases will serve to illustrate the circumstances under which this power has been exercised.

Cases.

In *Re Airey* (*q*) an application for a patent was opposed by S. on the ground that the applicant's "claims Nos. 1 and 2 are the same as my claims in Patent No. 4726—86, for a machine for measuring the height of human beings automatically." It was objected that the notice was not drawn in conformity with the rules, neither the date nor the title of the patent being distinctly given. The applicant had, however, before him the means of referring to the opponent's specification. The comptroller gave leave to amend at the hearing.

(*n*) P. R., 1890, r. 34.
(*o*) P. R., 1890. r. 36.
(*p*) P. R., 1890, r. 16.
(*q*) 1888, 5 P. O. R. 346; cp. *In re Daniel*, 1888, 5 P. O. R. 413. In this case the examiner had reported interference. The comptroller gave leave to amend an informal notice of opposition on the ground that, under s. 7, sub-s. 6 of the Act of 1883, and rules 11, 12, 13, and 15 of the P. R. 1883, he had power to hear and determine the point raised by the opponent as to whether the inventions were the same, irrespective of any opposition: *Re Welch*, 1889, Goodeve, P. P. 10.

In *Re Lake* (*r*) an application for a patent was opposed by *Wrigley*, as agent for *Black*, the real opponent, on the grounds of (1) prior patents; (2) report by examiner of interference. The notice of opposition began, "I, *Thomas Wrigley*," and was signed "*Thomas Wrigley*, . . . agent to opponent." At the hearing it transpired that *Wrigley* had died, and *Black* applied for leave to amend the notice of opposition. Notwithstanding objection on the part of the applicant, the comptroller allowed the notice to be amended by the substitution of *Black's* name for *Wrigley's*—*Black* signing the notice.

In *Re Fawcett* (*s*) an application for a patent was opposed on the ground "that the invention, *or material parts thereof*, had been patented in this country on applications of prior date." The notice was objected to on account of the insertion of the words in italics. The comptroller gave leave to strike them out, and the case proceeded.

In *Re Warman* (*t*) an interesting point arose as to the practice where an opponent does not appear owing to the miscarriage in the post of the comptroller's letter giving notice of hearing. An application for a patent was opposed on the ground of a prior patent for the same invention. At the hearing the opponent failed to appear, and the comptroller decided to seal the patent. Subsequently the opponent's agent informed the Comptroller-General that he had not received any notice of the appointment for hearing, and filed a declaration to that effect. The Comptroller-General refused to re-open the case, but suggested that if the opponent appealed the law officer might, under the circumstances, send the case back to him for re-hearing. On appeal, Webster, A.-G., gave a direction to this effect.

Opposition proceedings before comptroller.

Delivery of declarations: in support of opposition;

On receipt of the notice of opposition, a copy of the same is transmitted by the comptroller to the applicant (*u*). Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations

(*r*) 1886, Griffin, A. P. C. 35.

(*s*) 1889, Goodeve, P. P. 10, 11; cp. *Re Jones*, 1885, Griffin, A. P. C. 33, 34. Here the opponent stated that the applicant's invention was "the same, or *substantially the same*," as his own. Davey, S.-G., said that the notice of opposition was wrong in inserting the words in italics which raised the question of infringement, and added: "I am not entitled to express an opinion as to whether Mr. Jones's patent is novel, or even whether it is an infringement of yours, unless you show me that it is the same invention—I mean identical"; *Re Cumming*, 1884, Griffin, P. C. 277.

(*t*) 1885, Griffin, A. P. C. 43.

(*u*) P. R., 1890, r. 35.

in support of his opposition, and on so leaving shall deliver to the applicant a list thereof (*x*).

in support of application;

Within fourteen days thereafter the applicant must lodge declarations in answer, and must at the same time deliver a list of such declarations to the opponent. Within seven days from the delivery of the last-named list, the opponent must lodge declarations in reply, and such declarations must be confined *strictly* to matters in reply (*y*). If the opponent fail to deliver declarations, the comptroller will decide the case on a comparison of the documents before him, and if these are insufficient to support the objections taken, the opposition will fail (*z*).

in reply.

Where declaration necessary.

Thus, opposition based on the ground that the applicant had obtained the invention from the opponent requires evidence to be filed in support of it. When, however, the opposition is based on the existence of a prior patented invention of which the opponent is patentee, statutory declarations are sometimes dispensed with (*a*).

In cases of fraud there must be declarations in support.

In cases where the ground of an opposition is that the applicants have obtained the invention from the opponent or a person of whom he is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by the rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith (*b*).

Exhibits.

Anything which is relied on by a party, as showing the state of public knowledge prior to the date of the application, ought to, and any prior specification which it is desired to put in evidence must, be made an exhibit in order that it may be referred to.

In *Re Lancaster* (*c*)—an application for a patent for "improvements in pistons and plungers," opposed by B., as grantee of a prior expired patent for the same invention—the applicant produced specimens of his packing which had not been made exhibits.

Gorst, S.-G., said that the specimens, not being exhibits, could not be admitted in evidence, but that he would look at them for the purpose of enabling him the better to understand the drawings. It assisted him very much to see the specimens, but he did not go by them. When he came to determine whether the two inventions were the same, he would go by the drawings and specifications.

(*x*) P. R. 1890, r. 37. As to the form of such statutory declarations, see r. 17A.

(*y*) *Ibid.*, r. 36. Copies of the declaration mentioned in this and the last preceding rule may be obtained either from the Patent Office or from the opposite party. If the declarations in reply do not conform to the conditions above set forth, they may be ordered to be removed from the file.

(*z*) See Goodeve, P. P. 20.

(*a*) *Re Dundon*, 1885, Griffin, P. C. 278.

(*b*) P. R., 1890, r. 43.

(*c*) 1884, Griffin, P. C. 293, 294.

In *Re Jones* (*c*)—an application for a patent for "the more efficiently fastening the frames of writing-slates," opposed by D. on the ground that the invention was substantially identical with that comprised in a prior patent of his own—certain specifications of prior date to D.'s were referred to in the declarations, but D. objected to their being admitted in evidence.

Davey, S.-G., said, "You must first find out what D.'s invention is, and for the purpose of finding out what D.'s invention is, of course I can read his specification, and understand it; but for the purpose of ascertaining what his invention is, it is extremely material to know the state of knowledge upon the question of securing the frames of slates prior to and at the date of his patent."

No evidence after reply except by leave.

No further evidence shall be left on either side except by leave of the comptroller, upon the written consent of the parties duly notified to him, or by special leave of the comptroller, on application in writing made to him for that purpose (*d*). Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application (*e*). Further evidence by leave will not in general be admitted, unless the comptroller is satisfied that it was not within the knowledge of, or reasonably obtainable by, the applicant within the times previously mentioned.

Appointment for hearing.

On the completion of the evidence, the comptroller shall appoint a time for the hearing of the case, and give to the parties ten days' notice, at least, of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E. (*f*). If neither party applies to be heard the comptroller will decide the case (*g*).

Right to begin.

On an opposition before the comptroller, the applicant begins, but where fraud is alleged as a ground of opposition, the *onus probandi* rests on the opponent (*h*).

On the hearing of the case, no opposition shall be allowed in respect of any ground not stated in the notice of opposition; and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground, unless the title,

(*c*) 1885, Griffin, A. P. C. 34.
(*d*) P. R., 1890, r. 39.
(*e*) *Ibid.*, r. 40.
(*f*) See p. 741.
(*g*) P. R., 1890, r. 41. Formerly in practice it generally rested with the applicant to apply for a hearing, as so long as the patent was not sealed the opponent's object is generally obtained. In some recent cases the law officer had commented strongly on delay by the applicant in applying for a hearing.
(*h*) *Luke's Patent*, 1886, Griffin, P. C. 294.

number, and date of the patent granted on such prior application shall have been duly specified in the notice of opposition (*i*).

The decision of the comptroller in the case shall be notified by him to the parties (*k*), and may be appealed against to the law officer (*l*). Decision of comptroller communicated to parties.

The comptroller has no power to award costs. Costs.

Any person intending to appeal to the law officer from a decision of the comptroller must file in the Patent Office, within fourteen days from the date of the decision appealed against, a notice of such intention (*m*), stating the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so what part of such decision (*n*). Appeals to law officer.

A copy of such notice of intention to appeal must be sent by the appellant to the law officer's clerk, at room 549, Royal Courts of Justice, London, and to the opponent or opponents (*o*).

Notice of appeal signed by an authorized agent is sufficient (*p*).

In *Re Anderson and McKinnell* (*p*), Clarke, S.-G., held that this rule (rule 3) did not require any notice of appeal to be sent to an applicant.

This decision was discussed in *Re Hill* (*q*). "My attention," said Webster, A.-G., "has been drawn to this rule (L. O. R., No. III.), which, although there is no date to it, appears to have been issued by the law officers shortly after the passing of the Act. My attention has also been called to the decision (*p*) of the Solicitor-General, Sir Edward Clarke, that notice need not be given to the respondent in the appeal, if he was the applicant before the comptroller. . . . I agree with the construction put upon the rule in terms by the learned Solicitor-General; but I cannot but think that the late law officers overlooked the fact that the appellants might very frequently be one or more of the opponents, and it is equally necessary, if they (*i.e.*, the applicants) are to defend their contention, that they should be summoned before the law officer. With regard to that I will either give a direction to the Patent Office or to the official clerk that notice be sent, or I will consider with the Solicitor-General the necessity of issuing a supplemental rule." Notice of appeal to applicant where opponent appeals.

In cases where by his decision the comptroller requires an amendment to be made, and does not in his decision specify the Where comptroller requires amendment.

(*i*) P. R. 1890, r. 42.
(*k*) P. R. 1890, r. 44.
(*l*) Act of 1883, s. 11, sub-s. (2).
(*m*) L. O. R., r. 1.
(*n*) *Ibid.*, r. 2.
(*o*) *Ibid.*, r. 3.
(*p*) *Re Anderson and McKinnell*, 1886, Griffin, A. P. C. 23.
(*q*) 1888, 5 P. O. R. 599, 601.

terms thereof, the time for appealing is regarded as dating from the day of forwarding to the opponent a copy of the amendment approved by the comptroller (*r*).

Appeal limited to terms of notice or counter-notice.

The effect of the Law Officer's Rules, 1 and 2, is to limit the hearing before the law officers to points specifically raised by the notice of appeal; and where a notice of appeal is given as to part only of the comptroller's decision, the person receiving such notice and desiring to question other parts of the comptroller's decision must give a counter-notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter-notice may be extended under rule 5 (*s*).

Upon notice of appeal being given, the comptroller transmits to the law officer's clerk all the papers relating to the matter of the application in respect of which such appeal is made (*t*).

Notice of hearing.

Seven days' notice at least (*u*) of the time and place appointed for the hearing of the appeal is given by the law officer's clerk to the comptroller, the appellant and the opponent (*x*).

Evidence on appeal.

The evidence used on appeal to the law officer is required to be the same as that used at the hearing before the comptroller, and no further evidence will be admitted, save as to matters which have occurred or come to the knowledge of either party after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose (*y*).

In *Re Bailey* (*z*) the appellant asked leave under this rule (rule 8) to put in a specification which had come to his knowledge since the hearing before the comptroller, but Davey, S.-G., refused to admit it, inasmuch as the rule related to evidence, and the specification was not evidence, but an additional ground of opposition.

Assistance of expert.

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

(*r*) *Re Chandler*, 1886, Griffin, P. C. 273.

(*s*) *Re Bairstow*, 1888, per Clarke, S.-G., 5 P. O. R. at p. 289. Rule 5 provides that no appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave, upon application to the law officer. See p. 591.

(*t*) L. O. R., r. 4.

(*u*) Unless special leave for shorter notice be given by the law officer; L. O. R., r. 6.

(*x*) *Ibid.*, rr. 6, 7.

(*y*) *Ibid.*, r. 8. In *Re Sielaff*, 1888, 5 P. O. R. 484, Webster, A.-G., stated that it was desirable that each party should hand in to the official desk a statement of the fees which had been paid before the law officer.

(*z*) 1884, Griffin, P. C. 269. Rules 9 and 10 relate to the attendance, cross-examination, and expenses of witnesses; see p. 592.

(*a*) Act of 1883, s. 11, sub-s. 4.

In *Lake's Patent* (*b*), which was an opposition on the ground that the invention had been patented on an application of prior date, strongly controverted questions of anticipation, involving many highly technical chemical questions, the desirability of calling in the assistance of an expert to assist the law officer was considered; Clarke, S.-G., said, "This is a very interesting case; it involves a good deal of difficulty. The first question for me to decide is, whether I am to exercise my power of having an expert to advise me with regard to the matters which are here in discussion and dispute. Whatever advice the expert gave me upon the matter, it would have to be my judgment, and the responsibility of that judgment is a considerable one in a question of this character, and I do not think that, even if advised by an expert, I should consider it right, in view of a strongly controverted question of scientific anticipation, to decide that in a way which would put a stop to the patent now asked for. I think such a question, if it is to be discussed at all, should be discussed elsewhere, where the evidence can be more thoroughly dealt with."

The law officer will not enter into difficult and controverted questions of fact.

In the same case, it was suggested that one chemist should be called on each side, but Clarke, S.-G., refused to go into evidence of that kind, but offered to allow the opponents to make an application to cross-examine the witnesses who had made declarations. This, however, they did not press for.

In *Pitt's Patent* (*c*), Clarke, S.-G., expressed the opinion that the law officer, in dealing as it were with a preliminary stage of the matter, ought not to decide difficult questions of anticipation.

Any person may oppose the grant of a patent before the comptroller, but on appeal to the law officer only such persons as in his opinion are entitled to be heard will be granted a hearing (*d*).

Who may oppose before law officer.

"I shall hesitate very much," said Herschell, S.-G., in *Re Glossop* (*e*), "before I say that any member of the public can come in and oppose a patent, and raise an inquiry, and cause an appeal of this sort, who has no interest in it, and who simply says, 'Do not ask me what my interest is, because I have none, except that I am going to show you that this patent is the same as that.'"

In a later case (*f*), Clarke, S.-G., observed, "It seems to me

(*b*) 1889, 6 P. C. R. p. 548.
(*c*) 1888, 5 P. O. R. 343.
(*d*) Act of 1883, s. 11, sub-s. 3. The same rule holds good in applications for the amendment of specifications. See sect. 18, sub-sect. 4; and *Re Bell*, 1885, Griffin, A. P. C. 10.
(*e*) 1884, Griffin, P. C. 285.
(*f*) *Re Heath and Frost*, 1886, Griffin, P. C. 288; cp. *Re Hookham*, 1886, per Webster, A.-G., Griffin, A. P. C. 32.

perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. . . . The only class of persons who are entitled to be heard in opposition before the law officer are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."

The following persons have accordingly been held (a) entitled, and (b) not entitled, respectively:—

Persons held entitled to oppose before law officer.

(a) The licensee under a prior patent (*g*); the grantee of a prior *expired* patent (*h*); the assignee and manufacturer under a lapsed patent (*i*).

Not entitled.

(b) An agent for the real opponent (*k*); a manufacturer under one of the patents relied on (*l*); and a person who was about to work the invention for which the prior patent had been granted (*m*).

In *Re Macevoy* (*n*), the opposition was on the ground of a prior patented invention by a person having no interest in such patents, except that he had manufactured under them. The comptroller heard the case, and ordered the patent to be sealed. On appeal to the law officer, Clarke, S.-G., allowed the preliminary objection, that the opponent could not be heard before the law officer, upholding *Re Glossop* (*i*), and *Re Heath and Frost* (*o*).

When an invention is a prior patented invention.

The right of opposition on the ground of a prior *patented* invention comes into operation immediately after the acceptance of the complete specification of that invention. An accepted complete specification is, for this purpose, a patented invention (*p*). As to the meaning of "application of prior date," where an application has been ante-dated under international and colonial arrangements, see *Ererill's Patent* (*q*), and *infra*, p. 184.

L'Oiseau and Pierrard's Patent.

This point was decided in *Re L'Oiseau and Pierrard* (*r*). In that case an application for a patent was opposed by the grantee

(*g*) *Re Hill*, 1888, 5 P. O. R. 599.

(*h*) *Re Lancaster*, 1884, Griffin, P. C. 293. "It makes no difference," said Gorst, S.-G., "whether the patent has expired or not. The Act allows an application for a patent to be opposed on the ground that the invention has been previously patented, and so long as the opponent's invention has been patented —if it were 100 years ago—it would not make any difference."

(*i*) *Re Glossop*, *ubi supra*.

(*k*) *Re Heath and Frost*, *ubi supra*. In this case leave to amend by inserting in the notice of opposition the name of the real opponent was refused.

(*l*) *Re Macevoy*, 1888, 5 P. O. R. 285.

(*m*) *Re Bairstow*, 1888, 5 P. O. R. 286.

(*n*) 1888, 5 P. O. R. 285.

(*o*) *Ubi supra*.

(*p*) Act of 1883, s. 15.

(*q*) 1868, Griffin, A. P. C. p. 28.

(*r*) 1887, Griffin, A. P. C. 36.

of a prior patent, which had not been sealed, but the complete specification of which had been accepted. Webster, A.-G., affirming the decision of the comptroller, held that the opponent had *locus standi*.

"I am satisfied," he said, "that in order to give effect to sect. 15, where a person has had a complete specification accepted, he is entitled to be in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose. In fact, the proviso preventing him from taking proceedings for infringement accentuates and makes clear that position, because a limit has been put upon his rights of bringing actions for infringement, which limit would only be necessary if he were in the *quasi*-position of a patentee."

No person is entitled to oppose on the ground that an applicant's invention is comprised in a prior provisional specification published by the Patent Office before the Act of 1883 (*s*).

The mere description of an applicant's invention in a prior specification is not enough (*t*): it must be claimed.

"Section 11," said Clarke, S.-G., in *Re Von Buch* (*u*), "sets out the grounds, and the only grounds, upon which an opposition to the grant can be made. One of those grounds . . . is 'that the invention has been patented in this country upon an application of prior date.' Now, it is a rule long established, and of obvious justice and importance, that only that is patented which the inventor claims." *Von Buch's Patent.*

Again, it is no answer to *a bonâ fide* applicant for a patent to allege that experiments, or even drawings, were being made by another person. If he is the true inventor, the circumstance of something having taken place somewhere else, which was not disclosed to the world, and as to which no prior application was made, will be no answer to him, even if it were shown that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time (*x*).

(*s*) *Re Bailey*, 1884, Griffin, P. C. 269. *Semble*, however, that if the law officer should find that there was a distinct reference in a provisional specification to an invention, or a device, which was within the specification of an opponent properly construed, he would hold the opponent entitled to a disclaimer on the face of the specification: per Webster, A.-G., in *Hookham's Patent*, 1886, Griffin, A. P. C. 33.

(*t*) In order to ascertain what an opponent's invention is, it is extremely material to know the state of knowledge upon the subject-matter prior to and at the date of his patent. For this purpose prior specifications may be admitted in evidence. *Jones's Patent*, 1885, per Davey, S.-G., Griffin, A. P. C. 34.

(*u*) 1886, Griffin, A. P. C. 41.

(*x*) *In re Henry's Patent*, 1872, per Lord Selborne, L. C., L. R. 8 Ch. 167.

In *Brownhill's Patent* (*y*), which was an opposition on the ground of a prior patent, it was objected before the law officer that the opponents to the grant only appealed from the comptroller's decision so far as it refused to require a reference to their patent. Clarke, S.-G., held that he could entertain the appeal.

Costs before law officer.

In opposition appeals the law officer generally makes costs follow the event (*z*), and it appears that this rule will be followed, even if the law officer vary the comptroller's decision, as, *e.g.*, by altering the insertion in a specification, which the comptroller had permitted to pass, of a small verbal alteration not going to the substance of the claim (*a*).

In *Re Ainsworth* (*b*) the respondent failed to appear on appeal. The law officer's clerk duly issued and posted the notices of hearing required by rr. 6 and 7. Webster, A.-G., heard the appellant's case and reserved his decision. Prior to any decision being given, the respondent applied *ex parte* to the Attorney-General for leave to be heard, and satisfactorily accounted for his previous non-attendance. The Attorney-General ordered the respondent to pay the appellant's costs of the adjournment, and on this being done, another day was fixed for the hearing.

Where, however, notice of appeal, duly given, was withdrawn two days before the hearing, and no sufficient reason for the step could be assigned, the law officer ordered the appellant to pay costs (*c*).

In *Re Dietz* (*d*) the opponent, who was appellant, failed to appear at the hearing. The agent for the opponent had written to the applicant asking his consent to an adjournment, but this had been refused. Clarke, S.-G., dismissed the appeal with costs.

The several grounds of opposition must now be considered in detail.

First ground of opposition.

1. "That the applicant obtained the invention from the person

(*y*) 1889, 6 P. O. R. p. 136.

(*z*) Per Webster, A.-G., *In re Anderton*, 1886, Griffin, A. P. C. 25; and see *In re Stubbs*, 1884, Griffin, P. C. 293, per Webster, A.-G.: "I regard these appeals as re-hearings. . . . In cases before me, where there is no fresh evidence, or where, on the merits, either the opponent succeeds, or the applicant succeeds, I shall, as a general rule, allow costs to follow the event, because I think it only right that, apart from special circumstances, costs should follow the event; but I wish it to be understood that that will not apply to cases where there may be further evidence brought forward, or special matter which ought to influence the judgment of the law officer."

(*a*) *Re Fletcher*, 1888, Griffin, A. P. C. 31.

(*b*) 1885, Griffin, P. C. 269.

(*c*) *Re Knight*, 1886, Griffin, A. P. C. 35.

(*d*) 1889, 6 P. O. R. 297.

giving notice of opposition, or from a person of whom he is the legal representative."

Not available in case of imported inventions.

Sect. 11 was intended to apply to communications between persons in the United Kingdom and the Isle of Man, and not to communications made abroad.

Where, therefore, an invention is in whole (*e*), or in part (*f*), a communication, the first ground of opposition is not available to the person from whom it has been obtained.

"Prior to the passing of the Act of 1883," said Webster, A.-G., in *Re Edmunds* (*f*), "the law was well settled that a person importing into the realm an invention, was the true and first inventor within the meaning of the statute of James, and it mattered not under what circumstances he had obtained the invention abroad. In my judgment, the Act of 1883 has made no alteration of the law in this respect. In the case of an imported invention, the merit of the invention is the importation—the communication to the public in the United Kingdom and the Isle of Man, and I think, therefore, the comptroller has no jurisdiction to inquire as to the circumstances under which the invention was obtained by the importer. Of course, there may be cases in which the relations between the parties are such that the person who has first imported the invention may be guilty of some breach of contract, or breach of duty, towards the person from whom he has obtained the invention abroad, and the importer may be liable to proceedings in respect of the breach of any such contract or duty, but in my opinion those are matters which the comptroller-general and the law officer cannot inquire into, but must form the subject of independent proceedings between the parties either in this country or abroad, as the case may be."

Importer is inventor.

A person availing himself of information from abroad, is an inventor within the meaning of 21 Jac. I. c. 3, s. 6, and is therefore entitled to a patent, and it is not for the comptroller to inquire into the source of his information (*g*).

This principle does not, however, apply to a case where an applicant based his right to a patent upon the ground that he had been instructed to obtain letters patent on behalf of the original inventor,

(*e*) *Re Lake*, 1888, 5 P. O. R. 415.
(*f*) *Re Edmunds*, 1886, Griffin, P. C. 281.
(*g*) Cp. *Abel's Application*, 1876, John. Pat. Man. p. 178; *Adolph Spiel's Patent*, 1888, 5 P. O. R. at p. 282; *Bairstow's Patent*, 1888, 5 P. O. R. at p. 287; and *Re Edmunds, supra*.

resident abroad, and where it was clear from the declarations filed that there was no foundation for the applicant's allegation (*h*).

In re Marshall (*i*) is a case in which the comptroller refused to seal a patent on the ground that the applicant M. had obtained his invention from S., and on appeal to law officer the decision was upheld.

In *Griffin's Applications* (*k*), the comptroller refused to stop a patent on the ground that the applicant had obtained the invention from the opponent; but on appeal Clarke, S.-G., said, that if he had any doubt about the facts he should not interfere, but that as with the evidence before him he had no doubt, he must decide that the patents should not be sealed.

Again, in *Re Homan* (*l*), an application by H. for a patent for "improvements in the construction of fireproof floors," was opposed by A., on the ground that the invention had been obtained from him. It appeared that nearly two months before the date of H.'s application, A. had registered *as a design* a brick of the same form as that of H. The comptroller decided that either a patent should be granted to the applicant and opponent jointly, or that a patent should be sealed on condition that the applicant disclaimed the form of brick registered by A. On appeal, Clarke, S.-G., held that Homan was entitled to claim originality in the matter, and directed the patent to be sealed unconditionally.

Practice in case of overlapping inventions.

Usually, however, the cases which arise under this head are complicated by the fact that the applicant's and the opponent's inventions overlap each other, or by the existence of some contract or relation between the parties (*m*).

In *Re Russell* (*n*), it appeared that the applicant *Russell*, and the opponent *Muntz*, had either contributed to the invention, or had arrived independently at the same result.

(*h*) *Re Fiechter*, 1882, Griffin, P. C. 284, per James, A.-G.; and see the comments of Webster, A.-G., upon this case in *Re Edmunds*, *ibid.* 283.

(*i*) 1888, 5 P. O. R. 661; cp. *Hadden's Application*, 1853, Johns. Pat. Man. 177.

(*k*) 1889, 6 P. O. R. p. 296.

(*l*) 1889, Goodeve, P. C. 33; 6 P. O. R. 104.

(*m*) In such cases the comptroller sometimes decides to seal the patent in order that an appeal may be taken, when the witnesses can be cross-examined. Cp. *Re Luke*, 1885, Griffin, P. C. 294; *Re Hatfield*, 1884, Griffin, P. C. 288. The old practice was different. It was the duty of the law officer to hear and determine which of two rival applicants for letters patent had the better title, and not to remit the question to the Lord Chancellor by directing warrants for both patents. *Ex parte Henry*, 1872, L. R. 9 Ch. 167; *Re Evans and Otway*, 1884, L. R. 9 Ch. 279. "It is exceedingly important, especially before the comptroller, who cannot cross-examine witnesses, that there should be the fullest good faith in the statements made": per Webster, A.-G., in *Re Anderton*, 1885, Griffin, A. P. C. 25.

(*n*) 1857, 2 De G. & J. 130.

When applicant and opponent are practically joint inventors.

Lord Cranworth, L. C., said: "There have been many cases of the sort before me, and the principle on which I have generally acted has been that where a matter is much in doubt, it is better to run the risk of putting the party opposing the grant to the cost of making out his case in some ulterior proceedings than to withhold the Great Seal from the letters patent in the first instance, for the obvious reason, that the one course would create a remediable, the other an irremediable, injury. The question here, is whether there is sufficient doubt in the present case as to who was the inventor of this improvement to render it right to take the course to which I have adverted. Having regard to the affidavits, there appears enough to satisfy my mind of this, not that Mr. *Russell* was the inventor, not that Mr. *Muntz* was the inventor, but that they were both the inventors" (*o*).

Terms on which patent sealed.

The patent was sealed on the following terms:—

"That the letters patent should be granted to two trustees, one to be named by each party. Each party to have a free license to himself and partners (if any). All costs of both sides properly incurred in the matter of the patent to be borne and paid equally by both, and the costs also of Mr. *Muntz's* application for the patent. A deed to be prepared accordingly, and to be settled, if the parties differed, by the conveyancing counsel of the Court."

Russell's Patent followed by Gorst, S.-G.

The precedent set by Lord Cranworth in *Russell's Patent* was followed with modifications by Gorst, S.-G., in *Re Luke* (*p*). This was a case of opposition by *Tatham* to an application by *Luke* for a patent for "improvements in or applicable to machines for slubbing, roving, spinning, doubling or winding fibrous materials."

"It has not been proved to my satisfaction," said the Solicitor-General, "that *Luke* obtained the whole of the invention which he seeks to patent from *Tatham*, but I am at the same time convinced that the applicant is not the sole inventor, but that part at least of the merit of the invention is due to *Tatham*.

"I think that *Luke* and *Tatham* should enter into an agreement by which the former should undertake to do all such acts as may be necessary for leaving to the latter the full rights of a joint

(*o*) Cp. *Re Fox*, 1812, 1 Web. P. C. 431; *Re Cutler*, 1839, 1 Web. P. C. 426; *Tolson's Patent*, 1856, 6 De G. M. & G. 422; *Russell's Patent*, 1857, 2 De G. & J. 130; *Spence's Patent*, 1859, 3 De G. & J. 523; *Tolhausen's Patent*, 1866, 14 W. R. 551; *Vincent's Patent*, 1867, L. R. 2 Ch. 341; *Manceaux's Patent*, 1870, L. R. 2 Ch. 272. See the cases on opposition at the Great Seal dealt with at pp. 650, 651.

(*p*) 1885, Griffin, P. C. 294; *Re Eadie*, 1885, Griffin, P. C. 279. Here a *material* part only of the applicant's invention had been obtained from the opponents.

Terms on which patent sealed.

patentee in the invention in question, and the latter should undertake to take no proceedings for revocation of the patent when granted. On the filing of such agreement at the patent office I determine that the grant shall be made and that each party shall pay his own costs of the appeal" (*q*).

In *Re Garthwaite* (*r*), an application for a patent for "fish biscuits for dogs and food for poultry and game" was opposed by *King*. It was proved that *King* had made a prior application for a patent which appeared to be identical with that described by *Garthwaite*, and that an examiner had reported interference. The comptroller held that the parties were joint inventors, and were therefore entitled to equal shares of any benefit which might accrue from the invention. On their declining to accept a joint patent the comptroller granted separate patents upon their respective applications, subject, however, to the following conditions: that each party agreed to assign to the other one half share of and in the respective patents, and to pay one half the necessary fees for maintaining the same in force; and in default of either party paying his half share of the fees, the other party to be at liberty to pay the whole of such fees, in which event the whole interest of the patent was to become the property of the party so paying the whole of the fees.

In *Re Evans and Otway* (*s*) an application for a patent for "improvements in steam engines" by E. and O. was opposed by C. on the ground that the applicants had obtained the invention from him. It appeared that C. had already obtained a patent for an invention which was substantially the same as that of E. and O., and that E. and C. had known each other for some time, and had been jointly experimenting on the subject-matter of the invention. Webster, A.-G., directed the patent to be sealed on terms that E. and O. assigned one half share of the patent to C., and that C. assigned one half share of his patent to E. and O. It subsequently transpired that O., whose name was included in E.'s application, and who was therefore a necessary party to any assignment, could not be found. Thereupon Webster, A.-G., cancelled his previous order, and now directed that a patent be *not* sealed to the

(*q*) If the applicant refused these terms the patent was not to be granted, and he was to pay the costs of both parties in the appeal. If the opponent refused them the grant was to be made, and the costs of both parties in the appeal were to be paid by him.

(*r*) 1886, Griffin, P. C. 284.

(*s*) 1884, Griffin, P. C. 270.

applicants E. and O., on the condition that C. executed an assignment to E. of one half the interest in his patent (*t*).

Where confidential relation subsists between applicant and opponent.

The mere existence of the relation of master and servant does not prevent the servant from patenting an invention of his own, or, *ipso jure*, give the master a right to the servant's inventions.

Thus, in *Re Russell* (*u*), where a master applied for letters patent for an invention upon which both he and his foreman had made improvements, a grant was only made on condition that the master and foreman should be joint grantees (*x*).

But if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in details which are adopted in the machine or model as completed: those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them (*y*).

The same principle applies where an applicant's invention probably resulted from investigations or experiments made by an employé and directed or paid for by the employer (*z*).

Where a man is trying experiments for the purpose of himself taking out a patent for an invention, all that he and his do together is confidential, and if, when he has made his invention complete, he goes and takes out a patent, all that he has done confidentially in that way does not affect him in the slightest degree (*a*).

The confidence of the servants, however, is a confidence only as regards the secrets of the master, not as regards the secrets of the fellow servants (*b*).

Thus, in *Saxby* v. *The Gloucester Waggon Co.* (*b*), it appeared that *Edwards*, a superintendent in the signalling department of the London and North Western Railway Company, had invented, but had not patented, a new signalling apparatus, working drawings of which were openly prepared, under his directions, in the company's offices, and were submitted to, and inspected by, their mechanical engineer and locomotive committee. The plaintiffs, who had subsequently taken out a patent for the same invention, maintained, as a matter of law, that the circumstances above set forth did not

(*t*) The order contained a direction as to the payment of the renewal fees similar to that in *Re Garthwaite*, cited above.

(*u*) 1857, 2 De G. & J. 130.

(*x*) The order in this case is set out above, at p. 181.

(*y*) Per Davey, S.-G., in *Re David and Woodley*, 1886, Griffin, A. P. C. 26.

(*z*) *Healey's Application*, 1872, Johns. Pat. Man. 174; *Conniff's Application*, 1872, *Ibid.*; *Macfarlane's Patent*, 1883, *Ibid.*; *Kurtz* v. *Spence*, 1888, per Kekewich, J., 5 P. O. R. at p. 181.

(*a*) *Saxby* v. *Gloucester Waggon Co.*, 1883, per Lord Blackburn, Griffin, A. P. C. 57.

(*b*) *Ubi supra.*

constitute a publication of the invention, on the ground of the confidentiality existing among the officers and servants of the London and North Western Railway Company.

"There is nothing," said Jessel, M. R., whose judgment was affirmed by the House of Lords, "in the point of law. There is no question that the right of *Edwards* to the invention was his own personal right, the mere fact of his being the superintendent of the signalling department did not prevent him inventing and patenting a new signalling apparatus. If he obtained a patent, it would not belong to the company, but to himself, and if he chose to publish it to all the other 10,000 employés of the London and North Western Railway Company, of course that would have been a complete publication. He did publish it, in fact, to twenty-two or twenty-three of them, and in my opinion there is no pretence for saying that the publication of a secret which was his own to his fellow-servants was less than a publication to the same individuals if they had not been his fellow-servants . . . I should be of opinion that it was not only discovered, but sufficiently published, by *Edwards* before the date of the patent" (*c*).

Meaning of "legal representative."

The words "legal representative" in sect. 11 must be construed in their ordinary sense, as meaning an executor or administrator of a deceased person. They do not include a person holding a power of attorney (*d*), nor a person who claimed to be entitled under an assignment of prior patents and improvements thereon to the particular improvement which the applicant was seeking to patent (*e*).

Second ground of opposition.

2. "That the invention has been patented (*f*) in this country on an application of prior date."

Who may oppose before law officer.

As to who is entitled to be heard before the law officer in opposition to a grant, see *supra*, pp. 175 *et seq.*

Application ante-dated under Act of 1883, s. 103.

E. applied on 20th August, 1886, for a patent for "automatic apparatus for subjecting the person to the action of electric currents." Notice of opposition was given by L. and P., two foreigners *in France*, on the ground that the invention had been patented by them on an application of prior date, under sect. 103 of the Patents Act, 1883, and the International Convention.

(*c*) The question whether a confidential relation existed between the parties, must be decided by reference to all the circumstances of the case: *Humpherson* v. *Syer*, 1887, per Bowen, L. J., 4 P. O. R. at p. 313.

(*d*) *Re Edmunds*, 1886, per Webster, A.-G., Griffin, P. C. 281.

(*e*) *Adolph Spiel's Patent*, 1888, 5 P. O. R. 281.

(*f*) As to the meaning of "patented" in this connection, see *ante*, pp. 176 *et seq.*, where the cases bearing upon the subject are fully considered.

It was held that this foreign application was not "an application of prior date" to E.'s (*g*), within the meaning of the Act of 1883, s. 11, sub-s. 1.

Classification of cases under this heading.

The cases relating to this ground of opposition may be classified according to the result of the opposition. Sometimes the application is refused; sometimes it is granted. At other times conditions are imposed.

Application, when refused.

An application for a patent will be refused when the invention to which it refers is absolutely or substantially identical with some other invention previously patented (*h*).

Thus, in *Re Webster* (*i*), a claim for making "wire ropes *compound*," by laying some of the wires in a strand in one direction, and some in the other direction, was ordered to be excised on proof that, in a prior patent, there was a claim for making wire ropes with ordinary strands laid to the right and left hand alternately.

Again, in *Re Heath and Frost* (*k*), it was held that there was no difference between charging a case with an explosive, and then surrounding such charged case with water, and dispensing with the case, and surrounding the explosive itself with water.

In a later case (*l*), an application by the A. and C. Co. for a patent for "an improved screw stopper," was opposed by B. It appeared that both stoppers contemplated the use of a screw thread, which was to be screwed into a bottle, and of an indiarubber ring which was to be fixed into a groove: the only point of difference between them was the position of a washer in the groove in the stopper. The application was refused.

In *Re Bailey* (*m*), the two interfering inventions had the same object, viz.: expressing milk from a mass of butter and forming the butter into measured pats without any handling. The only differences in the construction and operation of the two contrivances were, that the vessel containing the butter was cylindrical in one case and rectangular in the other, and that the screw com-

(*g*) *Re Ererill*, 1886, Griffin, A. P. C. 28.

(*h*) "Stopping a patent," said Webster, A.-G., in *Re Stubbs*, 1884, Griffin, P. C. 298, "is a very serious step, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent, unless I am satisfied that the inventions are identical." Cp. *Cumming's Patent*, 1884, per James, A.-G., Griffin, P. C. 277; *Jones's Patent*, 1885, Griffin, A. P. C. 34; *Newman's Patent*, 1888, 5 P. O. R. 271. Substantial identity will, however, be sufficient.

(*i*) 1889, 6 P. O. R. 163; *Re Hall and Hall*, 1888, 5 P. O. R. 283.

(*k*) 1885, Griffin, P. C. 310.

(*l*) *Re Aire and Calder Glass Bottle Works, and Walker's Application*, 1888, 5 P. O. R. 345; *Re Wallis and Ratcliff*, 1888, 5 P. O. R. 347; *Re Daniel*, 1888, 5 P. O. R. 413.

(*m*) 1887, Goodeve, P. P. 57.

pressing the butter was worked, in one case, directly by hand, and in the other, by the intervention of a pinion and wheel giving increased power. The comptroller refused to seal a patent.

Application, when granted.

When an opposition to an application for a patent merely raises a question of infringement (*n*), where the differences between the interfering inventions are such that they cannot be considered as substantially identical (*o*), or where there is nothing in the later specification, which on the face of it might be held to have a wider scope, or include a wider kind of invention than that to which the patentee is on the evidence entitled (*p*), the application will be granted.

When an opposition has been before the comptroller, and the comptroller has allowed the grant, the law officer will not interfere with his decision unless it is clearly wrong (*q*).

Application granted on terms.

Where an applicant's invention covers to some extent the ground embraced in a prior patented invention, the application may be granted subject to the insertion by the patentee in his specification of a general disclaiming clause referring to the existing state of knowledge.

A patent will not be stopped where there is a strongly controverted question of anticipation involving difficult questions of fact (*r*).

Claims may be struck out.

In *Hall and Hall's Patent* (*s*), which was opposed upon the ground that the invention had been previously patented, the comptroller ordered a claim to be struck out; and on appeal by the opponent to the law officer a second claim was struck out.

Form of general disclaiming clause.

Reference to existing knowledge.

Thus in *Re Guest and Barrow* (*t*), an application for a patent for "an improvement in velocipedes or cycles," the following disclaiming clause was required to be inserted: "We are aware that various arrangements of cycles have been heretofore proposed, having either a jointed backbone or the frame divided into portions joined together with one or more joints. . . .

(*n*) *Jones's Patent*, 1885, Griffin, A. P. C. 34; *Sielaff's Application*, 1886, 5 P. O. R. at p. 487.

(*o*) *Re Cumming*, 1884, per James, A.-G., Griffin, P. C. 277: *Re Stubbs*, 1884, per Webster, A.-G., Griffin, P. C. 298; *Anderson and McKinnell's Patent*, 1886, Griffin, A. P. C. 23.

(*p*) *Re Lorrain*, 1883, 5 P. O. R. 142. The patentee of the later patent frames his specification at his peril, *Ibid.*; *Re Brownhill*, 1889, 6 P. O. R. 135.

(*q*) Per Herschell, S.-G., in *Re Glossop*, 1884, Griffin, P. C. at p. 286; *Re Cumming*, *ubi supra*; *Re Pitt*, 1888, per Clarke, S.-G., 5 P. O. R. 343; *Re Brownhill*, *ubi supra*.

(*r*) *Lake's Patent*, 1889, 6 P. O. R. p. 548.

(*s*) 1888, 5 P. O. R. 283.

(*t*) 1888, 5 P. O. R. 313; *Re Cooper and Ford*, 1885, Griffin, P. C. 275; *Re Hill*, 1888, 5 P. O. R. 599.

"Such arrangements have been defective, owing to the nature of the joint or joints used, and its or their position in relation to the various portions of the cycle (*u*); but we wish it to be understood that we make no general claim to the principle of preventing vibration in cycles by the introduction of joints or springs into the backbone."

General allegation of defect.

General disclaimer.

The insertion of these disclaimers do not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interest, in order that his specification may not be considered as being too wide, and in the interests of the public, who are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (*v*).

Purpose of general disclaimer.

In *Atherton's Patent* (*x*), Webster, A.-G., ordered a claim to be struck out, considering it unnecessary, and practically the same as another claim.

In the same case it was held that a patentee may insert in his specification his own statement of the prior knowledge, and refer to any number of specifications in support of his statement, but he must not put on the public what he believes to be the construction of a written document.

The law officers have always recognized that where there is an existing patent and they can see fair ground for supposing that the construction of the later specification would interfere with the rights of the existing patent, the existing patentee is entitled to be protected (*y*). This protection may take the form of the insertion in the later specification, whereby the applicant disclaims, referring by number, date, and name of patentee to the prior patented invention everything that is described and claimed therein (*z*).

Special disclaiming clause.

Thus in *Re Hoskins* (*a*), an application by H. for a patent for

Forms of special

(*u*) With reference to the general allegation of defect in this case, Webster, A.-G., said: "As the specification only contains a statement of general knowledge, there cannot be said to be anything in the patent law to prevent a patentee, on the face of his specification, referring to the general defects which rightly or wrongly he alleges to exist. The earlier patentees are not bound by this description."

(*v*) 1888, 5 P. O. R. 313; *Re Cooper and Ford*, 1885, Griffin, P. C. 275; *Re Hill*, 1888, 5 P. O. R. 599.

(*x*) 1889, 6 P. O. R. p. 547.

(*y*) *Re Newman*, 1888, per Webster, A.-G., 5 P. O R. 271.

(*z*) In *Re Teague*, 1884, Griffin, P. C. 298, where the applicant had for the purpose of explanation described and illustrated, but had not claimed, certain parts of a rock drill which were protected by an opponent's patent, an order was made *either* for a special disclaimer *or* for the omission of those parts from the specification.

(*a*) 1884, Griffin, P. C. 291.

disclaiming clauses.

"improvements in folding cots and hammock frames," opposed by N., the following order was made:—

"This invention refers to improvements (*b*) in the description of cots invented by N., for which invention a patent, No.——, of 1883, has been granted to him, and it consists, &c."

In *Re Newman* (*c*), an application by N., opposed by A., for a patent for "improvements in springs for self-closing doors and in checks for preventing slamming, and in the methods of adjusting the same," the following special disclaimer was ordered:—

"I am aware of the prior patent granted to A., dated March 30th, 1886, No. , and I do not claim anything described and *claimed* (*d*) in the specification of that patent, and in particular I do not claim the apparatus as shown and described with reference to fig. 35."

In *Lynde's Patent* (*e*), Clarke, S.-G., ordered the following clause to be inserted in the applicant's specification: "That I am aware of Everitt's patent (No. 16,433 of 1884), and that I do not claim anything claimed and described therein."

Opponent with broad claim.

It is not because a particular patentee or a prior inventor has made a broad claim that he is entitled to have limiting words inserted unless he can show, upon the fair view of the evidence, that such words are really necessary to protect him (*f*).

Third ground of opposition.

3. "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."

(*b*) A patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention during the existence of the former patent without licence, would be an infringement: per Campbell, C. J., in *Lister* v. *Leather*, 1858, 8 E. & B. 1017; cp. *Crane* v. *Price*, 1840-42, 4 M. & G. 580; *Fox* v. *Dellestable*, 1866, 15 W. R. 195; *Ex parte Fox*, 1 Web. P. C. 431.

(*c*) 1888, 5 P. O. R. 279.

(*d*) What a disclaiming clause is intended to guard against is the claiming in a new patent of something included in the claim of the old patent, not of something mentioned in the old patent, but of something which has not only been described in the old patent, but has been *claimed* as a part of the previous invention: per Clarke, S.-G., in *Re Gozney*, 1888, 5 P. O. R. 597. In *Re Welch*, 1881, Griffin, P. C. 300, the word "claimed" was omitted. See, however, *Re Newman*, *ubi supra*; *Re Airey*, 1888, 5 P. O. R. 348; *Re Lynde*, 1888, *Ibid.* 661; *Re Wallace*, 1889, 6 P. O. R. 134.

(*e*) 1888, 5 P. O. R. 663, also see *Re Wallace*, 1889, 6 P. O. R. p. 135; *Re Hoffman*, 1890, 7 P. O. R. 92.

(*f*) *Re Guest and Barrow*, 1888, 5 P. O. R. 312. In this case, Webster, A.-G., said: "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned."

Disconformity in itself was not, under the Act of 1883 (*g*), and is not now under the Act of 1888,—by sect. 4, sub-sect. 1, of which this third ground of opposition was introduced,—an objection which will justify the law officer in stopping a patent at the instigation of an opponent. The condition specified in the latter part of the sub-section must concur with the fact of disconformity in order to make it a valid ground of opposition.

General rule of *law officer.*

It is to be observed that the law officers and the comptroller prefer to allow the patent rather than refuse it, because their decision is final, and the applicant has no further remedy; whereas it is open to the opponent to petition for revocation, or to bring an action for infringement, when the validity of the patent will come in question before the Courts.

(*g*) *Neuman's Patent*, 1888, per Webster, A.-G., 5 P. O. R. at p. 277.

CHAPTER X.

THE GRANT AND ITS EFFECT.

SECT. 1. THE GRANT.
SECT. 2. THE EFFECT OF THE GRANT.

SECT. 1.—THE GRANT.

Sealing of patent.

IF there is no opposition to the grant of a patent, or, in case of opposition, if the determination is in favour of the patentee, the comptroller causes the patent to be sealed (*a*).

Before 1878, all letters patent for inventions as well as for other matters (*b*), were issued under the Great Seal. The Crown Office Act, 1877, sect. 5 (*c*), however, empowered a committee of the Privy Council, consisting of the Lord Chancellor, the Lord Privy Seal, and one of the principal Secretaries of State, to direct a *wafer* Great Seal, instead of the Great Seal, to be attached to or embossed upon certain documents prescribed by them; and by rules made in pursuance of this section (*d*), the *wafer* Great Seal was directed to be attached to, among other documents, letters patent for inventions, which was accordingly the practice between the 1st March, 1878, and the 31st December, 1883. Under the present Act, letters patent are sealed with the seal of the Patent Office, and every patent so sealed has the same effect as if it were sealed with the Great Seal of the United Kingdom (*e*).

Time within which patent must be sealed.

A patent is sealed as soon as may be, and not after the expiration of fifteen months (*f*) from the date of application, except where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent; or the applicant dies

(*a*) Act of 1883, s. 12, sub-s. 1.
(*b*) As to these "other matters," see note, pp. 1 & 2.
(*c*) 40 & 41 Vict. c. 41.
(*d*) These rules came into operation on March 1, 1878, and are published in the "London Gazette" for March 5, 1878.
(*e*) Act of 1883, s. 12, sub-ss. 1 and 2.
(*f*) The Act of 1885, s. 3, empowers the comptroller to grant an extension of four months.

before the expiration of the fifteen months aforesaid. In the former case the patent may be sealed at such time as the law officer may direct. In the latter, a patent may be granted to his legal representative, and sealed at any time within twelve months after the applicant's death (*g*).

Term of patent.

The grant is for fourteen years, subject to the payment of the renewal fees (*h*).

How term reckoned.

Letters patent dated the 26th February, 1855, were, under the Act of 1852, to cease at the expiration of three years from the date thereof, unless there were paid before the expiration of the three years an additional stamp duty of 50*l*. The stamp duty was paid on the 26th of February, 1858:—held, that the payment had been made within the time, and that the patent was subsisting (*i*).

Forms of patent.

The form of letters patent for inventions has varied from time to time.

The Statute of Monopolies, the Act of 1852, and the Act of 1883, each made certain alterations in the form in use at the date of its enactment (*j*); and, moreover, other alterations took place in the provisoes and other parts of the patent from time to time. The Board of Trade has power to alter or amend the present form given in the schedule to the Act of 1883, by rules made as provided by sect. 101 of that Act.

Variations in form under Act of 1883.

The form prescribed by the Act of 1883 (*k*) undergoes slight modifications when the patentee is a communicator or a woman, or the legal representative of a deceased person, or where two or more persons are the applicants, and according as all or only some of them are inventors (*l*). In the case of new letters patent granted after prolongation, the form is considerably varied (*ll*). The Channel Islands are still included in such a grant, although the Act of 1883 does not extend to them. This is a consequence of the decision in *Brandon's Patent* (*m*) as to the saving effect of sect. 113 of rights existing before the Act of 1883.

(*g*) Act of 1883, s. 12, sub-s. 3.

(*h*) Act of 1883, s. 17.

(*i*) *Williams* v. *Nash*, 1859, 28 L. J. Ch. 886. See also Act, 1883, s. 98.

(*j*) The following forms of grant are to be found in this work:—

(1.) Form of grant, A.D. 1617, before the Statute of Monopolies. Appendix, p. 848.

(2.) Form of grant, about 1846. Appendix, p. 850.

(3) Form of grant under Patent Law Amendment Act, 1852. Appendix, pp. 667 *et seq.*

(4.) Form of grant now in use, with variations according to applicant or applicants, at pp. 539 *et seq.*

(5.) Form of new letters patent issued on Order in Council, for prolongation. Appendix, p. 839.

(*k*) Pages 528 *et seq.*

(*l*) See forms of such patents at pp. 533 *et seq.*

(*ll*) See p. 839.

(*m*) 1884, 1 P. O. R. p. 154. See also Chap. XV. pp. 378, 379.

Effect of various parts of grant.

The form in the schedule to the Act of 1883 is annotated at considerable length at pp. 533—549, where the effect of the various parts of the grant is fully considered.

The variations which may occur are chiefly in the recitals; the alteration in the operative part and in the provisoes consists purely in the formal changes of masculine into feminine, or singular into plural.

Sect. 2.—The Effect of the Grant.

Privilege has existence only by force of grant.

The privilege which a patent confers upon an inventor has existence merely by force of the patent, which in fact creates the right as well as grants it to the patentee. Patent right may be defined as an incorporeal chattel which the patent impresses with all the characters of personal estate by limiting it to the grantee, his executors, administrators, and assigns (*n*).

Must look to patent to discover rights of patentees.

If we wish, therefore, to determine what the patentee's rights are, it is in his patent that we must look for them. The patent fixes the date, the term, and the extent of the privilege. It confers upon the patentee the sole and exclusive right of manufacturing, using, and selling his invention, and by the clause of limitation provides at once for the assignment of the privilege and its devolution on death, or by operation of law. The construction of the various clauses in the grant of a patent will be fully considered hereafter (*o*).

The position of co-grantees of a patent requires some consideration (*p*).

Co-owners of patents.

The law as to the rights of co-owners of a patent which does not provide otherwise, is laid down in Lindley on the Law of Partnership (*q*). It is pointed out that the chattel interest in letters patent for an invention is such that each co-owner can, in fact, enjoy his rights to the full extent without the concurrence of the other owners. Also that—

(*n*) Hindmarch, 233.

(*o*) See pp. 533—549.

(*p*) "When a partnership is formed for working some secret and unpatented invention, the articles should specify to whom exclusively the right of working such invention shall belong in the event of dissolution. For if there be no agreement on the subject, all the parties will have a right to work it in opposition to each other, there being no ground upon which any of them can be prevented from so doing. If, however, it can be proved by the inventor that his secret was to be kept from his co-partners, or that they, if they discovered it, were not to make use of their discovery, they will not be allowed to violate their agreement or the trust reposed in them, and the circumstance that the invention has not been patented will not be material": Lindley on Partnership, p. 416.

(*q*) 5th ed., p. 62.

"In the case of a patent belonging to several persons in common, each co-owner can assign his share and sue for an infringement (*r*), and can also work the patent himself and give licenses to work it, and sue for royalties payable to him for its use (*s*); and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, though it is still perhaps open to question whether he is not liable to account for what he receives in respect of the licenses" (*t*).

Legal position of co-owners.

In *Kenny's Button-holing Co.* v. *Somerville* (*u*), it was held that where a partnership was formed for the purpose of working an invention patented by one of the partners, the patent became part of the assets of the partnership, and that neither party could assign without the concurrence of the other; but that each partner acquired a licence to work the invention, and could work it accordingly on his own account on dissolution of partnership.

Where a patentee has assigned a share of the profits the assignee is entitled to an account from any licensee of the assignor, but must make patentee and other interested persons parties; and must place himself in the position of the assignor, by offering to pay any moneys which may be due from the assignor to the accounting licensee (*v*).

The inability of one of several joint patentees profitably to use the invention without the consent of his co-patentees as owners of a prior patent, does not entitle him to share with his co-patentees in the profits made by them from the use of the patent; there being no principle of law, in the absence of contract, to prevent any

(*r*) *Dunnicliff* v. *Mallett*, 1859, 29 L. J. C. P. 70; 7 C. B. N. S. 209; *Walter* v. *Lavater*, 1860, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

(*s*) *Sheehan* v. *G. E. Rail. Co.*, 1880, 16 Ch. D. 59.

(*t*) *Mathers* v. *Green*, 1865, L. R. 1 Ch. 29, reversing S. C. 34 Beav. 170; 34 L. J. Ch. 298; *Re Russell's Patent*, 1857, 2 De G. & J. 130: cp. *Hancock* v. *Bewley*, 1860, 1 Johns. 601; *Re Horsley and Knighton*, 1869, L. R. 8 Eq. 475; *Lovell* v. *Hicks*, 1836, 1837, 6 L. J. (N. S.) Ex. Eq. 85; 5 *id.* 101. In *Mathers* v. *Green*, it was held by Lord Cranworth, C., that where a patent is granted in the usual form, each one of three co-grantees might, without the concurrence of the others, use the invention and not be obliged to account for the profits made thereby, and might also grant licences under the patent. This decision turned on the words of the grant, which was to the grantees, their executors, administrators, and assigns, "that they and every one of them, by themselves, their servants and agents, *and such others as they may agree with*, and no others, may use the invention." It should be observed that the clause in italics does not occur in the present form. The question as to the liability of a co-patentee to account for any royalties received by him under licences granted by him, was not considered in the House of Lords, as Lord Cranworth held that there was no evidence that such royalties had become due. In the Court below, however, Lord Romilly, M. R., whose judgment on this point has never been overruled, had decided that the co-patentee was so liable.

(*u*) 1878, 26 W. R. 787.

(*v*) *Bergmann* v. *Macmillan*, 1881, L. R. 17 Ch. D. 427.

person, not prohibited by statute, from using any invention whatever, and no implied contract where several persons jointly obtain letters patent, that no one of them shall use the invention without the consent of the others, or that he shall use it for their joint benefit (*x*).

Agreement advisable.

It seems that in all cases where the application is made by several persons jointly, an agreement should be entered into between the applicants to define their mutual positions clearly. Such agreement should provide for the payment of renewal fees, the expenses of applying for disclaimers of oppositions to similar grants, of litigation on petitions to revoke, proceedings against infringers, &c. Also for the granting of licences, and the working of the invention by the patentees themselves (*y*).

(*x*) *Mathers* v. *Green*, *supra*.

(*y*) See Trans. Inst. P. A. vol. viii., a paper "on certain features of joint *proprietorship in patents*." C. M. Owen.

CHAPTER XI.

ASSIGNMENTS, LICENCES, ETC.

SECT. 1. SALES AND ASSIGNMENTS.
SECT. 2. LICENCES.

Scope of chapter.

IT is not here proposed to deal with the position of assignees and licensees in legal proceedings affecting letters patent, or with the application of the doctrine of estoppel in such cases, both of which matters are fully considered elsewhere (*a*).

Compulsory licences.

The question of Compulsory Licences is treated of at pp. 461—463.

Registration.

The registration of documents affecting the proprietorship of patents is dealt with in the next chapter.

Inspection of register.

The Register of Patents should be inspected before any agreement, assignment or licence is entered into, in order to see in whom the registered title is.

Registration.

All deeds affecting the ownership of patents should be registered at once at the Patent Office. No document will, however, be registered until the patent is sealed (*b*).

SECT. 1.—SALES AND ASSIGNMENTS.

Power to assign.

The privilege granted by a patent cannot be assigned unless it is made assignable by the patent itself. And it seems that the same rule is applicable to a licence granted under the authority of the patent. For a licence merely grants a power, or dispenses with a right or remedy, and therefore confers a mere personal right upon the licensee which cannot be transferred to any other person, unless the grantor in the instrument itself makes the privilege which he grants assignable.

Licences to licensees, their executors, &c., assignable.

Licences *are*, however, frequently granted to licensees, their executors, administrators, and assigns, and then they become of

(*a*) See "Parties to an Action of Infringement," *pp.* 254 *et seq.*

(*b*) See Chapter XII.

course assignable and transmissible in the same way as a patent privilege. And it would seem that the assignment of a licence, like the assignment of a patent, ought to be made by deed under hand and seal.

No restriction as to the consideration for a licence.

There does not appear to be any restriction with respect to the consideration for which a licence to use a patent privilege may be granted. A deed in itself imports a consideration (*c*), and as a licence must be granted by deed, it seems that no consideration is necessary to render it valid (*d*).

Origin of power to assign.

An inventor has by law no property in his invention, and no interest in it recognizable by law, except under a patent (*e*); the right or privilege granted by a patent is of a personal nature, and, but for an express provision in the patent by which it is granted, would be inalienable (*f*).

Assignment for particular places under Act of 1883.

By the Act of 1883, s. 36, however, it is 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.

Words of grant under Act of 1852;

Under the Act of 1852 the grant was "unto the said ———, his executors, administrators, and assigns, our especial licence, full power, sole privilege and authority that he the said ———, his executors, &c., and every of them, *by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said* ———, *his executors, &c., shall at any time agree with, and no others*," &c.

under Act of 1883.

Under the Act of 1883, the grant is "unto the said patentee our especial licence, &c., that the said *patentee by himself, his agents or licensees, and no others*," &c.; "the patentee" by a recital in the patent, meaning the patentee, his executors, administrators, and assigns.

It appears that the power of assignment of interests in patents under the Act of 1883 is strictly limited by the words of the grant and the provisions of sect. 36.

As to the position of co-owners of patents, see *ante*, pp. 192 *et seq.*

Extent of assignment.

The assignment may be either absolute or by way of mortgage, and may extend to any part or share of the invention (*g*), or to the

(*c*) See Plowd. 308.

(*d*) The proviso in a patent declares that nothing in the patent contained shall prevent the granting of licences in such manner, *and for such considerations* as they may by law be granted.

(*e*) Hindmarch, 233. An inventor may, however, maintain an action for breach of an agreement respecting an invention which he proposes to patent: *Smith* v. *Dickenson*, 1804, 3 B. & P. 630.

(*f*) Hindmarch, 234; and cp. Littledale, J., in *Duvergier* v. *Fellows*, 1828, 10 B. & C. 829; and Dompier, J., in *Power* v. *Walker* (a copyright case), 1814, 3 M. & S. 9.

(*g*) *Walton* v. *Lavater*, 1860, 8 C. B. N. S. 162; *Dunnicliff* v. *Mallet*, 1859, 7 C. B. N. S. 209.

entirety of the patent so far as it relates to a separate and distinct part of the invention (*h*). One of several co-owners can assign his share, and can also work the patent and give licences, though he is probably liable to account for any profits received in respect of licences (*i*).

Deed necessary.

The assignment of a patent must be by deed.

Reasons.

Two explanations of this rule have been offered. The patent, it is said, requires that licences granted by the patentee shall be under his hand and seal, and "if the licence, which is the lesser thing, must be in writing, *à fortiori*, the assignment, which is the greater thing, must also be "(*j*).

Again, the privilege of a patent cannot be granted without deed (*k*); and the rule of law is that things which can only be granted or created by deed can only be assigned by deed (*l*). Also an assignment of a patent is a grant of an incorporeal right (*m*).

An instrument not under seal, purporting to be an assignment of a patent, may be treated merely as an agreement to assign, and is enforceable in equity (*n*).

Form of assignment.

No particular form is necessary to a valid assignment, and the ordinary rule of law respecting the construction of deeds will be applied, viz.: "that the construction be favourable, and as near to the minds and apparent intents of the parties as possible it may be and law will permit "(*o*).

Thus, a covenant to assign a patent upon the happening of a given event, will, as soon as the event happens, amount to an actual assignment of the patent (*p*).

Executors.

The executors of a patentee having obtained probate of their testator's will, assigned his patent to another person, but the probate was not registered till after the assignment (*q*).

Bankrupt.

The interest of a bankrupt in a patent passes to his trustee (*r*).

By a private Act of Parliament the sole making of a newly

(*h*) *Dunnicliff* v. *Mallet*, 1859, 7 C. B. N. S. 209.

(*i*) See p. 193, and cases there quoted.

(*j*) *Power* v. *Walker*, *ubi supra*, per Lord Ellenborough, C. J. But see *Chanter* v. *Deuchurst*, 1844, 13 L. J. Ex. 198; 12 M. & W. 823.

(*k*) Co. Litt. 9 b, 172 a; Shep. Touch. 229—231.

(*l*) 3 Co. Rep. 63 a, *Lincoln College case*.

(*m*) Co. Lit. 9 C.

(*n*) *Parker* v. *Taswell*, 1858, 2 De G. & J. 559; *Bond* v. *Rosling*, 1861, 1 B. & S. 371; *Tidey* v. *Mollett*, 1864, 33 L. J. C. P. 235. For the conditions on which specific performance of such a contract would be granted, see Morris, p. 42.

(*o*) Shep. Touch. 83, 86. For forms of assignment, see Appendix, pp. 778 *et seq.*

(*p*) *Cartwright* v. *Amatt*, 1799, 2 B. & P. 43.

(*q*) *Ellwood* v. *Christy*, 1864, 1865, 34 L. J. C. P. 130; 17 C. B. N. S. 754.

(*r*) *Hesse* v. *Stevenson*, 1868, 3 B. & P. 565.

invented machine was vested in certain persons, with a proviso that it should be forfeited in case it should become "vested in, or in trust for, more than five persons or their representatives otherwise than by devise or succession (reckoning executors and administrators only as the single persons they represent"): it was held, that one of the persons becoming bankrupt the right passed to his assignees; although there were more than five creditors, yet the assignees did not hold it in trust for "more than five persons, otherwise than by devise or succession," within the meaning of the Act (*p*).

Proviso, before 1852, avoiding patent if more than twelve persons partners therein.

Prior to the Act of 1852 a patent for an invention contained a proviso to the effect that the patent should be void if more than twelve persons became interested in it as partners. But there is now no limit upon the number of persons who may be interested in a patented invention. A considerable number of private Acts were obtained to enable companies or corporations to have patents for inventions assigned to them without their being rendered void. The form of patent given in the schedule to the Act of 1852 contained no such proviso (*q*); and, moreover, that Act provided that notwithstanding any proviso which might exist in former letters patent, it shall be lawful for a larger number than twelve persons hereafter to have a legal and beneficial interest in such letters patent (*r*).

An agreement by the vendor of a patent to assign to the purchaser all future patent rights which the vendor may hereafter acquire of a like nature to the patent sold, is not contrary to public policy (*s*).

One of two joint patentees cannot assign the whole interest in the patent without the consent of the other joint patentee. He can only assign his interest (*t*).

In *Hall* v. *Conder* (*u*), it was held to be no answer to an action on an agreement for the purchase of a patent, to plead that the invention was wholly worthless and of no public utility, and not new, and that the plaintiff was not the true and first inventor.

(*p*) *Bloxam* v. *Elsee*, 1827, 1 C. & P. 558. See also Yate-Lee and Wace's Bankruptcy; *McAlpine* v. *Mangnall*, 1846, 15 L. J. C. P. 298; *Hesse* v. *Stevenson*, 1803, 3 B. & P. 565.

(*q*) See pp. 667 *et seq.*

(*r*) Act, 1852, s. 36, and see note thereto.

(*s*) *Printing and Numerical Registering Co.* v. *Sampson*, 1875, L. R. 19 Eq. 462.

(*t*) *Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

(*u*) 1857, 26 L. J. C. P. 138, 288; 2 C. B. N. S. 22. See also *Smith* v. *Scott*, 1859, 28 L. J. C. P. 325; 6 C. B. N. S. 771.

British patents do not now fall with the expiration of a foreign patent granted before the date of the British patent, so that it is not necessary for the assignee to have a covenant providing that the foreign patents shall be kept in force. But in taking an assignment of a patent granted under the Act of 1852, it is still advisable to inquire if any foreign patents had expired before the Act of 1883 came into force.

British patents do not now fall with foreign patents.

Contents of an ordinary Deed of Assignment:

The Recitals.—There are ordinarily three recitals, one of the origin of the invention, another of the patent grant, a third of the devolution of title (if any). A recital that the assignor, or the person through whom he claims, was true and first inventor, while not amounting to an implied warranty of title (*r*), will estop the assignor, and also, if he execute the deed (*s*), the assignee, from afterwards disputing the validity of the grant (*y*).

Recitals.

The Testatum.—This is the operative part of the deed. It contains an assignment not only of the patent, but usually, although not, it would seem, necessarily (*z*), of the invention, and of the rights and powers of the patentee in respect thereof.

Testatum.

The Covenants.—The usual and proper covenants are:—A covenant for title, which will now be implied if the assignor is expressed to assign as "beneficial owner" or "trustee" (*a*); a qualified covenant for the validity of the patent so far as the acts and omissions of the assignor are concerned; an express covenant as to improvements or extensions of the patent; a covenant binding the assignor not to seek leave to amend the specification or drawings without the written consent of the assignee.

Covenants.

An assignment of a patent for a district should, in addition to the above, contain a covenant by the assignor to pay the renewal fees well within the prescribed times, and give due notice to his

Assignment for district.

(*r*) *Hall* v. *Conder*, 1857, 26 L. J. C. P. 138, 288; 2 C. B. N. S. 22; affirmed on appeal, 2 C. B. N. S. 53; *Smith* v. *Neale*, 1857, 26 L. J. C. P. 143; 2 C. B. N. S. 67; *Liardet* v. *Hammond Electric Light and Power Co.*, 1883, 31 W. R. 710.

(*s*) Cp. *Doe and Shelton* v. *Shelton*, 1835, 4 L. J. (N. S.) K. B. 167; 3 Ad. & El. 265. According to Morris, it is advisable to insert in the deed as parties "every person who shall become an assignee of a share in the trust property and execute the deed, or otherwise assent to be bound by it": see Patents Conveyancing, p. 125.

(*y*) *Oldham* v. *Longmead*, 1789, 3 T. R. 439, 441.

(*z*) Morris, 113.

(*a*) Conveyancing Act, 1881, s. 7. This covenant relates simply to the ownership and devolution of the title.

co-owner or co-owners of every such payment when made, or permit him or them to pay the same, and to repay the sums so paid on demand, and until repayment to charge them, together with interest, on his interest in the patent (*b*).

Assignment of unequal shares.

An assignment of a part share in a patent ought, in order to meet the decision in *Mathers* v. *Green* (*c*), to contain a special provision binding not only the parties themselves, but all future owners to account to each other for the profits made by them respectively, and to grant, or concur with the others in granting, licences in a manner which should be prescribed (*d*).

An assignment of a share in a patent usually contains a covenant by the assignee to perform and observe the stipulations, if any, which bind the assignor, and to indemnify him from future breaches thereof (*e*).

Where it is intended that a patent shall be divided into shares, and that each owner shall work his share separately, without the intervention of trustees, the deed of assignment should contain the following covenants, viz., that each owner shall pay his proper proportion of the renewal fees, that licences shall be granted only by all the owners jointly, and that each owner shall pay a royalty on articles manufactured by him (*f*).

Sub-assignee with notice.

In *Werderman* v. *Société Générale d'Electricité* (*g*), the plaintiff assigned to D. and M. his patent in consideration of a share in the profits, &c., and it was part of the agreement that the patent should be worked and the profits disposed of in a particular way. It was held that the assignee of D. and M., taking with notice of the agreement, was bound by the covenants in the agreement.

Assignment where partnership not intended.

Where it is not intended that co-owners of a patent should be partners, the patent should be assigned to trustees for the owners, the trustees being authorized to grant licences to the owners or to strangers, or to sell the patent at the request of the owners, and being bound to provide for the current costs and expenses in respect of the trusts, and to take or defend proceedings in relation to the patent. Provisions are also inserted securing the remuneration of the trustees, and for the appointment of new trustees if necessary (*h*).

Covenant to

A covenant to assign future patents is not against public policy.

(*b*) Morris, at p. 116.
(*c*) 1865, L. R. 1 Ch. 29; see this case discussed at p. 193.
(*d*) Morris, p. 120.
(*e*) Morris, p. 121.
(*f*) Morris, pp. 122, 123.
(*g*) 1881, L. R. 19 C. D. 246.
(*h*) Morris, p. 126.

"A man who is a needy and struggling inventor may well agree, either for a present payment in money down, or for an annual payment, to put his intellectual gifts at the service of a purchaser. I see, therefore, not only no rule of public policy against it, but a rule of public policy for it, because it may enable such a man in comparative ease and affluence to devote his attention to scientific research, whereas, if such a contract were prohibited, he would be compelled to apply himself to some menial, or mechanical, or lower calling, in order to gain a livelihood" (*i*).

assign future patents legal.

As to the construction of a covenant for purchase of all patent rights of a like nature, see *Printing and Numerical Registering Co.* v. *Sampson* (*k*).

A patentee frequently covenants with his assignees to communicate and render available for the benefit of the assignees all further improvements in the patented inventions assigned by him.

Covenant to communicate improvements.

In the case of *London and Leicester Hosiery Co.* v. *Griswold* (*l*), G. took out two patents for improvements in the manufacture of stockings, to the benefit of which the H. Company became entitled. G. and the H. Company by deed assigned the patents to the L. Company. The deed contained a covenant by G. and the H. Company to communicate to the L. Company and render available for their benefit all further improvements of the patented inventions invented by them or either of them. The L. Company brought an action against G., claiming an injunction to restrain him from selling, disposing, and communicating to any person other than the plaintiffs any invention for or relating to improvements in the manufacture of stockings, and from assisting as a scientific witness or otherwise the defendants in two actions which the L. Company had commenced. On a motion for an interlocutory injunction until trial or further order, it was held, that G. was not entitled to infringe the patents, but that there was no evidence that he had done so; that he could not be restrained from giving evidence in the actions if subpœnaed; and that he could not be restrained from disclosing any information in his possession which might tend to show that the patents were invalid; and that specific performance of the covenant could not be ordered on an interlocutory application.

A body corporate may be registered as the proprietor of a patent in its corporate name (*m*), and may therefore take an assignment.

Assignment to body corporate.

(*i*) *Printing and Registering Co.* v. *Sampson*, 1875, L. R. 19 Eq. 462.

(*k*) 1875, L. R. 19 Eq. 462; and see also *Bewley* v. *Hancock*, 1856, 6 De G. M. & G. 391.

(*l*) 1886, 3 P. O. R. 251.

(*m*) P. R. 1883, r. 70. *Railway and Electrical Appliances Co., In re*, 1888, L. R. 38 Ch. D. 597.

The position of assignees, &c., in actions of infringement, will be considered hereafter, in Chapter XIV.

Sect. 2.—Licences.

Definition of licence.

A licence to use an invention is, in fact, a grant of a right by the patentee to the licensee; and during the time it is in force it exempts the licensee either from the whole or some portion of the prohibition contained in the patent, and enables him to exercise the whole or some particular part of the privilege granted by the patent (*n*).

A licence does not, like an assignment, pass the whole interest.

Kinds of licences.

Licences are of various kinds. Where the patentee, either by express covenant, or by a grant of "the full sole exclusive licence," to use an invention, excludes himself and his assigns from the use of it during the stipulated term, either generally or for a district, the licence is said to be *exclusive*, or the licence may be *general*, in which case the licensee can merely use the invention in common with other licensees of the patentee.

Exclusive or general licence.

Again, a licence may extend over all parts of the realm comprised in the patent, or may be restricted to some particular district or districts; or the purpose for which the licensee is permitted to use the invention may be limited; or the licence may amount to a grant of all the rights covered by the patent, in which case it will be construed as an assignment.

District.

Purpose.

A licence to A. to manufacture a patent article is an authority to his vendees to sell it without the consent of the licensor (*o*).

Origin of right to grant licence.

It is doubted by Hindmarch (*p*) whether a patentee has any implied right under his privilege to grant licences any more than to assign.

Proviso for power to licence.

Letters patent, however, do invariably contain a clause expressly conferring such a right.

The origin of this clause is as follows:—"Under the old form (*q*) of condition against an assignment to more than five persons, it was considered doubtful whether a grant of a licence to more than five persons was not such an assignment within the meaning of the condition as would avoid the patent (*r*). In order

(*n*) Hindmarch, 239.
(*o*) *Thomas* v. *Hunt*, 1864, 17 C. B. N. S. 183.
(*p*) P. 238.
(*q*) See p. 198.
(*r*) 6 Jarm. & Byth. Conv. 188, n. (*a*).

to obviate this doubt, a clause is now inserted in all patents, whereby it is provided that nothing therein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted" (*s*).

A licence merely confers a personal right upon the licensee, which cannot be transferred to any other person, unless the grantor, in the instrument itself, makes the privilege assignable (*t*).

In *Bower* v. *Hodges* (*u*), Jervis, C. J., said that a licence is not really assignable, but the assignment acts only as an estoppel between the parties.

Licensing a person and his assigns is, unless the context clearly forbid such an interpretation, licensing him and all whom he shall licence (*x*).

Is deed necessary?

Formerly, a licence without covenants was not required to be under seal (*y*), nor did it require a stamp, if it did not purport to be sealed and delivered as a deed (*z*).

The present form of letters patent requires a licence to be in writing under the hand and seal of the patentee. The words of the prohibition being a command not to "practise the said invention, &c., without the consent, licence, or agreement of the said patentee *in writing under his hand and seal.*"

Agreement for a licence.

As between a licensor and his licensee, however, a verbal agreement for a licence may be good if acted on by the parties for a time, and especially where royalties have been paid on the patent articles manufactured by the licensee in accordance with the licence (*a*).

An agreement for a licence is equivalent to a formal deed of licence (*b*).

Failure of consideration.

The consideration for the grant of a licence is usually either an immediate money payment, or a periodical payment of an amount fixed or dependent on the extent to which the licensee uses the invention.

An agreement upon the basis last mentioned will not, of itself, create a partnership between the licensor and his licensee (*c*).

(*s*) Hindmarch, 239.
(*t*) Hindmarch, 242.
(*u*) 1853, 22 L. J. C. P. 194.
(*x*) *S.C.*, per Maule, J.
(*y*) *Chanter* v. *Dechurst*, 1844, 13 L. J. Ex. 198; 12 M. & W. 823.
(*z*) *Chanter* v. *Johnson*, 1845, 14 L. J. Ex. 289; 14 M. & W. 411.
(*a*) *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293; Morris, 184.
(*b*) *Postcard Automatic Supply Co.* v. *Samuel*, 1889, 6 P. O. R. 560; and see cases, *ante*, p. 197.
(*c*) *Ridgway* v. *Philip*, 1834, 1 C. M. & R. 415; *Elgie* v. *Webster*, 1839, 5 M. & W. 518.

A licensee cannot be compelled to give inspection in an action against his licensor (*d*).

Where the consideration for a licence totally fails, the licensee may recover any money paid by him (*e*).

Where the failure is only partial, and the consideration is not apportionable; thus, if the patent turns out to be invalid after the licensee has worked the invention to some extent according to the licence, the licensee cannot recover the royalties or annuities paid to patentee (*f*), except in the case of fraud (*g*).

In *Betts* v. *Willmott* (*h*), it was held, that where the owner of a patent manufactures and sells the patented article in a foreign country as well as in England, the sale of the article in one country implies a licence to use it in the other. But if he has assigned his patent in either country, the article cannot be sold so as to defeat the rights of the assignee.

In *Clark* v. *Adie* (*i*), it was held, that a patentee granting a licence cannot, without derogating from his grant, publish advertisements and circulars which have the effect of deterring usual customers or the public from dealing with his licensee.

In *Mathers* v. *Green* (*j*), it was held, by Romilly, M. R., and this part of the judgment was not reversed on appeal, that where one of several joint patentees grants a licence he is bound to account for the profits to his co-patentees.

Determination of licence on breach of conditions.

In *Ward* v. *Liresey* (*k*), the owners of a patent granted a licence under seal for the use and manufacture of their invention upon certain terms and conditions, no express power of revocation being reserved by the deed. Some of the terms and conditions were not complied with. The plaintiffs thereupon gave notice to the licensees by letter that the licence was determined: this was, however, not assented to by the defendants, and the plaintiffs brought an action claiming a declaration that the licence had been

(*d*) *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. p. 14.

(*e*) *Knowles* v. *Bovill*, 1870, 22 L. T. N. S. 70; *Beseman* v. *Wright*, 1858, 6 W. R. 719. See also *Chanter* v. *Leese*, 1839, 4 M. & W. 295; and on appeal, 9 L. J. Ex. 327; 5 M. & W. 698; and *Smith* v. *Neale*, 1857, 26 L. J. C. P. 143; 2 C. B. N. S. 67. "This rule, however, equally applies where the consideration is apportionable, so that on the total failure of any apportioned part of the consideration the moneys paid for such part will be returnable": Morris, 191.

(*f*) *Taylor* v. *Hare*, 1805, 1 Bos. & P. N. R. 260; and see *Lawes* v. *Purser*, 1856, 26 L. J. Q. B. 25; 6 El. & Bl. 930; and *Begbie* v. *Phosphate Sewage Co.*, 1875, L. R. 10 Q. B. 491. Affirmed L. R. 1 Q. B. D. 679.

(*g*) *Lovell* v. *Hicks*, 1836, 5 L. J. (N. S.) Ex. 101; and see *Hall* v. *Jarris*, 1822, 1 Web. P. C. 103.

(*h*) 1871, L. R. 6 Ch. 239.

(*i*) 1873, 21 W. R. 456.

(*j*) 1865, L. R. 1 Ch. 29.

(*k*) 1888, 5 P. O. R. 102.

determined and an injunction and accounts, and alleging fraudulent dealing on the part of the defendants. The defendants denied that they had wilfully or in fact broken any of the terms and conditions of the deed, and alleged in the alternative knowledge of and acquiescence in the breaches, if any, on the part of the plaintiffs, and also denied that the licence had been determined. Bristowe, V.-C., held (1) That the licence was one coupled with an interest, and, therefore, not revocable at will, but that it was liable to forfeiture in the event of the terms and conditions contained in the deed being broken. (2) That there had, in fact, been breaches of the terms and conditions of the licence, and that the plaintiffs thereupon became entitled to treat the licence as forfeited, and to determine it. (3) That the plaintiffs had not by their conduct or otherwise deprived themselves of their right to treat the licence as forfeited and determined. (4) That the letter sufficiently indicated the plaintiffs' intention to treat the licence as determined, and that an instrument under seal was not necessary for this purpose.

Consideration for licence.

The consideration for the grant of a licence may consist of one or any of the following:—a sum down on execution of the licence; a fixed periodical payment; a royalty dependent on the use made of the invention; a royalty on the profits.

Licensee's covenants.

A licence usually contains stipulations for the payment of the royalty or other consideration which the licensee covenants to do, and if desirable a condition should be inserted empowering the licensor to have full inspection of all books, stock, &c., and full accounts rendered from time to time. The licensee is generally to have the benefit of any subsequent improvements, which are to be communicated to him.

Power to revoke.

It is also advisable that the licensor should be empowered to revoke the licence on nonpayment of the royalties, &c., or breach of any of the covenants.

Licensor's covenants.

The licensor will enter into the usual qualified covenant that the patent is valid, and that he has power to grant the licence.

Power to assign.

A licence is not assignable without express power given by the licence, so that power should be given to assign if it be desired to do so (*l*).

As to the estoppel created by the recitals and covenants, see Chapter XIV.

(*l*) *Bower* v. *Hodges*, 1853, 22 L. J. C. P. 194.

Construction of licence.

In *Born* v. *Humber* (*l*), a licence to persons carrying on a particular business to use an invention, was held to authorize the use of the invention at all places of business of the defendants who were carrying on the original business.

Covenant by licensee not to dispute validity of patent.

As recitals in a licence merely act as estoppels up to the date of execution of the deed, it may be advisable for the licensor to make the licensee covenant not to dispute the validity of the patent or the sufficiency of the specification. On the other hand, it may frequently be advisable for the licensee to have a clause inserted in the licence specially reserving to him the right to dispute the validity of the patent.

Stamp duty on licences.

When a licence is, or purports to be, by deed, it must bear a 10*s*. deed stamp.

When a premium or fixed sum is paid for a licence, whether by deed or otherwise, an *ad valorem* stamp for the amount is necessary.

Where a licence contains a covenant for the payment of a minimum royalty, the Stamp Office insists upon payment of an *ad valorem* duty upon the gross minimum royalty reserved, and this although the licence contains power for licensor or licensee to determine the licence (*m*).

(*l*) 1889, 6 P. O. R. 9. Cp. *Henderson* v. *Mostyn Copper Co.*, 1868, L. R. 3 C. P. 202; *Otto* v. *Singer*, 1890, 7 P. O. R. 7.

(*m*) Johnson, 233, 234.

CHAPTER XII.

THE REGISTER OF PATENTS(*a*).

SECT. 1. GENERAL.

SECT. 2. THE REGISTERS OF PATENTS AND PROPRIETORS UNDER THE ACT OF 1852.

SECT. 3. THE REGISTER OF PATENTS UNDER THE ACT OF 1883.

SECT. 1.—GENERAL.

Registration.

SINCE the Patent Law Amendment Act, 1852, every patent is, upon sealing, registered, and all subsequent dealings with the patent, or other matters which affect its proprietorship, ought also to be registered.

By searching the subject-matter indexes of patented inventions, the patents granted in any particular manufacture or industry will be found, with the names of patentees and the number and dates of the patents. On looking in the name index, the patents, with their date and number, and the subject-matter thereof, granted to any person, can be seen. Upon inspection of the Registers of Patents, when the year and number of a patent are known, assignments, licences, prolongations, amendments of specification, payment of renewal fees, and other matters affecting the proprietorship or validity of the patent, will be found, and copies of the documents seen. There is always a registered owner or owners of a patent, in the same way as there are registered holders of shares in a company registered under the Companies Acts.

Registered owners.

Between the Act of 1852 and Act of 1883, the Register of Patents and the Register of Proprietors were separate series of volumes. The Register of Patents contained a series of entries, of which an

(*a*) The author desires to acknowledge his indebtedness to Mr. E. Towers, for information in connection with this Chapter.

example is given in the foot-note (*b*), and also a notification of assignments, licences, &c. But the actual assignments, licences, &c., were entered in full, in the order in which they happened to be presented at the Great Seal Patent Office, in a series of volumes, called the Register of Proprietors. Thus, to see the assignments, licences, &c., relating to any given patent, it was often necessary to look at several volumes.

Register of patents under Act of 1883.

The reference to these volumes was obtained from the Register of Patents. Under the Act of 1883 the Register of Patents is very much the same as it was before, except that all the stages of progress up to sealing are not now entered, and, moreover, these stages have been much altered. The Register of Proprietors, now non-existent in name, for entries subsequent to 1st January, 1884, is

The file.

replaced by *a file* or bundle, which is kept separate for each patent. The original specifications and other papers connected therewith, as also copies of all subsequent documents registered, and formerly entered on the Register of Proprietors, are kept together in this bundle or *file*, so that, on seeing the page of the Register of Patents

(*b*) *An Extract from the Register of Patents under the Act of* 1852.

10th September, 1874.	Petition, declaration, and provisional specification of —— of —— in the county of —— for grant of letters patent for an invention for improvements in ——
3103 (Stamp 1*s.* 8*d.*)	Sealed with the commissioners' seal and referred to Attorney-General.
14th September.....	Petition, declaration, and provisional specification left with Attorney-General for allowances.
15th September.....	Certificate of Attorney-General allowing provisional protection received and filed, and certificate thereof given.
18th September.....	Provisional protection advertised in gazette.
2nd October	Notice to proceed received and filed, and certificate thereof given.
6th October	Notice to proceed advertised in gazette.
29th October.....	Petition, declaration, and provisional protection again referred to Attorney-General.
30th October.....	Fiat for warrant received.
24th February, 1875.	Warrant left with Attorney-General for signature.
26th February.....	Warrant received, sealed and filed.
2nd March	Letters patent prepared, sealed and dated the 10th September, 1874.
9th March.....	Specification filed in pursuance of letters patent.
6th September, 1877.	Letters patent stamped with 50*l.* stamp produced at Office of Commissioners of Patents, and certificate thereof endorsed thereon.
3rd September, 1881.	Letters patent stamped with 100*l.* stamp produced at Office of Commissioners of Patents, and certificate thereof endorsed thereon.

When a complete specification was filed in the first instance, the entry commenced, "Petition, declaration, and complete specification of ——" and the reception of the "notice to proceed" was the next entry on the register. The subsequent entries were substantially the same as those above set forth. This extract given here does not contain anything beyond the formal entries, but notifications of assignments, licences, &c., were also entered in the Register of Patents.

on which a patent is registered, and referring to the file, all the information is at once before the inquirer. It should be mentioned that with the file are kept a certain number of private documents, such as the reports of the examiners, &c., but these are not open to public inspection, and are removed before the file is inspected.

By the Act of 1883 the former Register of Patents and the Register of Proprietors are to be deemed part of the Register of Patents kept under that Act (*c*).

SECT. 2.—THE REGISTERS OF PATENTS AND PROPRIETORS UNDER THE ACT OF 1852.

The Patent Law Amendment Act, 1852, provided for the registration of patents, and the proprietorship therein, as follows:— 15 & 16 Vict. c. 83, s. 35.

Register of patents.

By sect. 34 (*d*), there was to be kept at the office appointed for filing specifications, a book or books to be called "The Register of Patents," wherein were to be entered and recorded in chronological order all letters patent granted under the Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the *validity* of such letters patent as the commissioners should direct, and such register, or a copy thereof, was to be open at all convenient times to the inspection of the public, subject to such regulations made by the commissioners.

Register of proprietors.

And by sect. 35 (*e*), there was also to be kept at the office for filing specifications, a "Register of Proprietors," wherein were to be entered, in such manner as the commissioners might direct, the assignment of any letters patent, or of any share or interest therein, any licence under letters patent, and the district to which such licence relates, with the name or names of any person or persons having any share or interest in such letters patent or licence, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the *proprietor-*

(*c*) Sect. 114.
(*d*) Appendix, p. 658.
(*e*) Appendix, pp. 658, 659.

ship in such letters patent or licence; and a copy of any entry in such book properly certified was to be received in evidence in all Courts and proceedings, and was to be *primâ facie* proof of the assignment of such letters patent, or share, or interest therein, or of the licence or proprietorship as therein expressed; and until such entry, the grantee was to be deemed the sole and exclusive proprietor of the letters patent, and of all the licences and privileges thereby given and granted.

Falsification or forgery of entries on register.

The falsification or forgery of any entry on the Register of Proprietors was a misdemeanour and punishable by fine and imprisonment (*e*).

Rectification of the register.

Any person deeming himself aggrieved by any entry made under colour of the Act in the Register of Proprietors, might apply by motion to the Master of the Rolls, or to any of the Courts of Common Law at Westminster, in term time, or by summons to a judge of any of the said courts in vacation for an order to have such entry expunged, vacated, or waived; and on production of any such order, the officer having the care and custody of such register was bound to comply with its requisitions (*f*).

Cases under Act of 1852.

The following cases were decided under the Act of 1852.

In 1853, one G., the grantee of a patent, assigned the same to W. and H., who omitted to register it. Afterwards, in 1855, G. assigned it to another person, who registered the assignment on the same day. The first assignees registered their assignment a week afterwards. On the motion of the first assignees, W. and H., Romilly, M. R., in 1857, ordered the entry of the second assignment to be expunged from the register, and with costs, on the ground that it had been executed for a fraudulent and improper purpose (*g*).

An assignee cannot bring an action for an infringement of his patent *against third parties* until his assignment had been registered (*h*).

Action before registration.

But the assignee of a patent may maintain a suit against the assignor, and subsequent licensees from the assignor *with notice* of the assignment, to restrain them from using the patent, although at the time of the institution of the suit the assignment had not been registered. It is to be observed, that in this case the omission to register the first deed arose out of the negligence of the

(*e*) Act of 1852, sect. 37, Appendix, p. 659.

(*f*) Act of 1852, sect. 38. Appendix p. 660.

(*g*) *Re Green's Patent*, 1857, 24 Beav. 145.

(*h*) *Chollett* v. *Hoffman*, 1857, 26 L. J. Q. B. 249; 7 E. & B. 686.

assignor's solicitor. Also the subsequent licence was not registered (*i*).

Relation back of registration to date of assignment.

Apparently the registration of an assignment of a patent relates back to the date of the assignment, so as to entitle the assignee to maintain a suit to restrain an infringement instituted between the dates of the assignment and the registration (*i*).

Fraudulent entries.

The Court could, on motion, expunge an entry fraudulently made in the Register of Proprietors: it could direct any facts relating to the proprietorship to be inserted, but not the legal inferences to be drawn from them (*k*): it could also correct any entry which purported to affect the rights of persons not parties to the document registered (*l*).

Where the executors of a patentee having obtained probate of their testator's will, had assigned his patent to another person, but the probate was not registered till after the assignment, it was held that the assignment was valid (*m*).

In *Speckhart* v. *Campbell*, it was held by the Court of Appeal that a person (who, in this case, was a foreigner) may bring an action in his own name for an infringement, when the patent is registered in the name of another person, if that other person is a trustee for the plaintiff (*n*).

No appeal from Master of the Rolls.

There was no right of appeal against an order made by the Master of the Rolls to expunge an entry in the register (*o*).

Sect. 3.—The Register of Patents under the Act of 1883 (*p*).

Register of patents under the Act of 1883.

Under the Act of 1883, there is kept at the Patent Office a book called the Register of Patents (*q*), wherein are entered the names and addresses of grantees, notifications of assignments, and of transmissions of patents, of licences under patents, and of amend-

(*i*) *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 509; 40 L. J. Ch. 146.

(*k*) *Re Morey's Patent*, 1858, 25 Beav. 581.

(*l*) *Re Horsley and Knighton's Patent*, 1869, L. R. 8 Eq. 475.

(*m*) *Ellwood* v. *Christy*, 1864, 34 L. J. C. P. 130; 10 Jur. N. S. 1079.

(*n*) 1884, Johns. Pat. Man. 239.

(*o*) *In re Horsley and Knighton's Patent*, *supra*; L. R. 4 Ch. 784; *In re Morgan's Patent*, 24 W. R. 245; *Re Myers*, 1882, W. N. 53, 66.

(*p*) The sections relating to the Register of Patents are: sect. 23, providing for the keeping of the register; sect. 85, forbidding the entry of trusts on the register; sect. 87, providing for registration of assignments on request and proof of title to his satisfaction; sects. 88 and 89, providing for inspection of register and extracts therefrom; sect. 90, providing for the rectification of register by the Court; sect. 91, providing for correction of clerical errors by comptroller; sect. 93 makes it a misdemeanour to falsify entries in the register. There are also the Patents Rules, 1890, rr. 67—79.

(*q*) Sect. 23.

ments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be from time to time prescribed (*r*). The Register of Patents is to be *primâ facie* evidence of any matters directed to be inserted therein.

Matters recorded in register.

Amongst "the other matters affecting the validity or proprietorship of patents," notifications of which are recorded in the register, are certificates of enlargement of time for payment of renewal fees, requests, applications for amendments, advertisements of these applications, notices of opposition, notices of abandonment of applications to amend, decisions of the comptroller on hearing notices of appeal, judgments of the law officer, requests for entry of assignments, &c., requests for entry of orders in council, orders in council extending the term of letters patent, and new letters patent granted thereunder. An entry of "patent expired" is also put against all patents which have ceased by non-payment of renewal fees.

How it differs from the old registers.

The modern register of patents differs from its predecessors in the following points:—There is now no distinct register of proprietors. Assignments and other deeds are no longer set forth *in extenso*, as in the volumes of the Register of Proprietors, but copies are filed. No notice of any trust will now be entered (*s*), although it appears that any deed of assignment, &c. which also contains trusts is not refused; and, indeed, it would give rise to endless trouble if any attempt were made to do so. All the documents relating to each patent are now kept together in separate bundles or files, instead of merely forming part of a chronological series as before.

With these exceptions, and due allowance being made for the changes in procedure which have taken place, the Register of Patents under the Act of 1883 continues to be kept on the same lines as the Registers prescribed by the Act of 1852.

When documents will be registered.

Documents dated before the grant of letters patent will not be entered on the register until the patent is actually issued (*t*).

The patent is not registered until after sealing, and until that time no property is recognized by the comptroller in an invention.

It is not the practice of the Patent Office to register, even after sealing, dealings with inventions prior to the application; the reason

(*r*) Sect. 23, sub-sect. 1; P. R. 1890, rr. 68—80, deal with the register of patents; cp. sect. 87. There is nothing in sect. 23 to make registration notice of the documents registered: *Heap* v. *Hartley*, 1888, 5 P. O. R. 603.

(*s*) Sect. 85. As to the former practice, see Johns. Pat. Man., 4th ed., p. 221.

(*t*) *Parnell's Patent*, 1888, per North, J., 5 P. O. R. 126.

apparently being the difficulty of identifying the application with the invention dealt with.

Parnell's patent.

In *Parnell's Patent* (*u*), an agreement was entered into on 9th July, 1883, by A. with B. for the purpose of certain dealings with an invention. Previous to this date applications had been made for patent rights in Victoria and Queensland. On the 16th March, 1886, application was made for a patent in England, which was subsequently granted and dated, as usual, the 16th March, 1886, the date of application. In September, 1887, B. requested the comptroller to register this agreement. The comptroller refused to comply with the request, on the ground that the document was dated before the date of application. B. then moved the Court, under sect. 90, to rectify the register and order the registration of the agreement. North, J., while refusing the motion, declined to lay down as an absolute rule that no document executed before the date of the grant (*i.e.*, date of application) can be entered on the register, though there might be very forcible objections to the registration of such documents, which might often be insuperable. There were documents to which the objections might not apply. There might be a document executed immediately before the date of the grant, so clear and precise as to leave no doubt whatever as to the proposed patent referred to in it.

How long volumes of register preserved.

Under rules made in pursuance of the Public Record Act, 1877, sect. 1, the volumes of the Register of Patents are kept for twenty-one years from the date of the earliest patent recorded in each. Any volume in which there is an entry of a patent of which extension is granted, is specially retained for seven years after the expiry of the period of prolongation.

A large number of the pages in the Register of Patents contain no entry except a memorandum of the grant. Many patents lapse at the end of the fourth year through non-payment of the renewal fee, and there are frequently no dealings with a patent during its continuance which require to be registered.

Practice under the Act of 1883.

It may be convenient to give here a summary of the practice under the Act of 1883, and the Rules made thereunder (*v*), in relation to the entry of various matters on the register.

Entry of grant.

Upon the sealing of a patent the comptroller causes to be entered on the Register of Patents the name, address, and description of

(*u*) 1888, per North, J., 5 F. O. R. 126.

(*v*) P. R. 1890, rr. 67—79.

the grantee, and the title of the invention (*y*). A patent granted under the international and colonial arrangements is entered in the register as of the date of the first foreign application (*z*).

Entry of subsequent proprietorship.

A request for the entry of subsequent matters requiring registration must be addressed to the comptroller and left at the Patent Office (*a*).

Every such request must state the name, address, and description of the person claiming to be entitled to the patent, and the particulars of the assignment, transmission, or other operation of law in virtue of which proprietorship of the patent is alleged (*b*).

A body corporate may be registered as proprietor in its corporate name (*c*).

The applicant must produce to the comptroller, together with the request above mentioned, his documents of title, not being matters of record (*d*), and such other proof of title as may be required, and also an official, certified, or attested copy of the documents aforesaid (*e*).

Entry of license.

Substantially the same procedure is necessary in order to obtain the registration of a license (*f*).

Entry of orders.

Where an order has been made for the extension or revocation of a patent, or for the rectification of the register, the register will be altered accordingly upon an office copy of such order being left at the Patent Office (*g*).

Entry of payment of renewal fees.

Upon the issue of a certificate of payment under rule 48, the comptroller causes to be entered in the Register of Patents, a record of the amount and date of payment of the fee on such certificate (*h*).

Entry of failure to pay renewal fees.

The failure of a patentee to make any prescribed payment is duly entered in the register (*i*).

Restrictions on registration.

There will not be entered on the Register of Patents any notice of any trust, express, implied, or constructive (*k*).

Inspection of and extracts from the register.

The Register of Patents is open to the inspection of the public on every week day from ten a.m. to four p.m., with certain exceptions (*l*).

Certified copies.

Certified copies of every entry in the register may be furnished by the comptroller on payment of the prescribed fee (*m*).

(*y*) P. R. 1890, r. 67.
(*z*) *Ibid.* r. 29.
(*a*) See sect. 87; P. R. 1890, r. 68. Forms L or M, p. 746.
(*b*) P. R. 1890, r. 70.
(*c*) *Ibid.*, r. 73.
(*d*) An official or certified copy of such documents is sufficient: r. 71.
(*e*) Rules 71, 72.
(*f*) Rule 77.
(*g*) Rule 74.
(*h*) Rule 75.
(*i*) Rule 76.
(*k*) Sect. 85.
(*l*) See Rule 78.
(*m*) P. R. 1890, r. 79; sects. 88 and 89. For the fee, see No. 33, p. 687.

The comptroller may, on request in writing accompanied by the prescribed fee, correct any clerical error in, or in connection with, an application for a patent, or in the name, style, or address of the registered proprietor of a patent (*n*). Rectification of clerical error in register by comptroller.

The Court (*o*), also, may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars (*p*), from the register of patents, or by any entry made without sufficient cause in such register, order the register to be rectified, and may make such order as may seem fit with respect to costs. Rectification of register by the Court.

The Court may in any such proceeding itself decide or direct an issue to be tried for the decision of any question of fact, and may award damages to the person aggrieved (*q*). Issue of fact. Damages.

An order of the Court rectifying a register, directs due notice of the rectification to be given to the comptroller (*r*). Notice of rectification to comptroller.

(*n*) Act of 1883, s. 91.
(*o*) Sect. 90, sub-sect. 1.
(*p*) Act of 1888, s. 23.
(*q*) Act of 1883, s. 90, sub-s. 2.
(*r*) *Ibid.*, sub-s. 3. These provisions are based on the Act of 1852, the cases on which are noticed at pp. 210, 211.

CHAPTER XIII.

THE INFRINGEMENT OF LETTERS PATENT.

SECT. 1. GENERAL.
SECT. 2. PRINCIPLES IN PRACTICAL OPERATION.
SECT. 3. COMBINATIONS.
SECT. 4. CHEMICAL PROCESSES AND PRODUCTS.

SECT. 1.—GENERAL.

Scope of this chapter.

IT is proposed to give in this chapter a general account of the way in which the inventor's privilege under his patent may be infringed without entering upon the consideration of the means which the patentee may make use of to secure his rights. The *action of infringement*, and the various questions which may be raised therein, will be treated of in Chapter XIV. (*a*).

Prohibitory clause in letters patent.

The form of letters patent now in use (*b*), which does not, in this respect, differ materially from those which have preceded it, contains the following clause:—"And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents, for us our heirs and successors, strictly command all our subjects whatsoever within the United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, *either directly or indirectly, make use of, or put in practice, the said invention, or any part of the same, nor in any wise imitate the name, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof*, without the consent, licence, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal Com-

(*a*) Pages 245 *et seq.*

(*b*) See Form of Patent, pp. 630 *et seq.*

mand, and of being answerable to the patentee according to law for his damages thereby occasioned."

The grant is of exclusive privilege to patentee.

Moreover, the grant is to the "patentee, &c., of our especial licence, full power, sole privilege and authority that the said patentee by himself, his agents and licensees, and *no others*, may, &c., make, use, exercise, and vend the said invention."

Infringement a breach of the prohibition.

A breach of the monopoly granted and of the prohibitory clause is an infringement of the patentee's privilege for which an action may be brought, and an injunction and damages obtained (*c*).

Ways of infringing.

The ways in which a patent may be infringed are very clearly anticipated by the prohibitory words of the grant, printed in italics, and a consideration of them raises the questions which arise in the infringement of patents.

Definition of infringement.

An infringement may be defined as any act, not by the patentee or with his consent, which comes within the terms of the prohibition.

The patentee, by his specification and claims, allots to himself a certain field of invention, and the letters patent grant him certain rights in connection with that field. Provided his patent be valid, and with that question we are not in this chapter concerned, any act which trespasses upon the patentee's field of invention is an infringement.

Modes of infringing.

A patent privilege may be infringed:—

(1) By manufacturing articles by means of the invention or any imitation thereof, or by using or putting the invention or any imitation thereof in practice in any other way, and whether the same be by way of actual use of the invention or by an imitation thereof;

(2) By using or selling, or otherwise dealing in articles made in violation of the patent privilege;

(3) By making for use or sale, or vending articles which counterfeit, imitate, or resemble articles made in pursuance of the invention, or by counterfeiting or imitating the invention in any other way (*d*).

Difficult questions of fact often arise.

The issue of infringement leads to very difficult questions of fact in many cases. In the various classes of inventions, more or less definite general propositions of law have been, however, laid down, which assist in determining what is an infringement in questions of infringement arising out of the overlapping of patented inventions or other manufactures.

Overlapping manufactures.

(*c*) See next Chapter.

(*d*) See also Hindmarch, p. 487.

There are, however, several questions connected with infringement in which this overlapping is not in issue.

Infringement mixed question of law and fact.

The question of infringement is a mixed question of law and fact. Where everything is admitted on either side, and the decision depends merely on the construction of the specification, it is for the Court to determine whether or not an infringement has taken place (*d*).

What are questions of fact and what of law.

Again, "there may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool" (*e*). But when the decision will depend on disputed questions of fact such as the degree of difference or similitude between two machines, or the operation of two or more chemical substances placed together, infringement becomes a question of fact mixed with law, which the judge is bound to submit to the jury. What the jurymen find to have been done is the matter of fact, but the judge must apply that fact according to the rules of law, and is entitled and bound to say whether what has been done amounts to an infringement (*f*).

General considerations.

Before proceeding to the cases on infringement in detail, there are some general points to be considered.

Must clearly ascertain subject-matter.

It is always necessary to ascertain precisely what the subject-matter of a patent is, in order to determine whether or not there has been an infringement of the privilege, and it must be shown that the act complained of constitutes an interference, to the prejudice of the patentee, with the subject-matter, or some new and essential part of the subject-matter, of the letters patent.

Cases.

This point, of which the importance can hardly be over-estimated, will be best explained by a reference to a few decided cases.

(a) The complainers being patentees of an invention for "improvements in the manufacture of knitted fabrics and in machinery therefor," brought an action against the respondent for infringing their patent. The respondents denied infringement. The machines of both parties produced radial knitting with

(*d*) *Seed* v. *Higgins*, 1860, 30 L. J., Q. B. 314; 8 H. L. C. 550; *Curtis* v. *Platt*, 1866, 35 L. J. Ch. 852.

(*e*) *De la Rue* v. *Dickinson*, 1857, per Campbell, C. J., 7 E. & B. at p. 765; *Westinghouse* v. *The L. & Y. Rail. Co.*, 1884, per Grove, J., 1 P. O. R. 237, 238.

(*f*) *Seed* v. *Higgins*, *ubi supra*; cp. *Walton* v. *Potter*, 1841, 1 Web. P. C. 586; *Macnamara* v. *Hulse*, 1842, Car. & M. 471; *Newton* v. *Grand Junction Rail. Co.*, 1846, 20 L. J. Ex. 427, n.; 5 Exch. 331; *Stevens* v. *Keating*, 1847, 2 Web. P. C. 191; *Sellers* v. *Dickinson*, 1850, 20 L. J. Ex. 417; 5 Exch. 323.

courses of unequal lengths. In the complainers' machine, the needles were latched needles and were securable by means of a raising bar, while in the respondents they were barbed and stationary. It was held that as the specification did not claim the process of radial knitting apart from the mechanism described, and as the respondents' machine was substantially different from the complainers', although producing the same results, there had been no infringement (*g*).

Same result obtained by different means.

(b) The owner of a patent for improvements in stretchers for trousers brought an action for alleged infringement. The defendants denied the infringement. It was held that the defendants' stretchers, although obtaining the same result, obtained it by different means, and were a development beyond what was to be found in the plaintiff's specification (*h*).

(c) A patentee in his specification claimed as his invention "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair." Any combination by which that principle is applied to the same subject, and nothing short of that, is an infringement of the patent (*i*).

Intention of infringer immaterial.

In the case of *Heath* v. *Unwin* (*k*), Parke, B., held that a defendant could not be considered guilty, at least, of an indirect infringement, unless he had intended to commit it.

This doctrine was, however, disapproved of in *Stead* v. *Anderson* (*l*), where Wilde, C. J., said, "We think it clear that the action is maintainable in respect of what the defendant (the infringer) does, not of what he intends," as well as in the subsequent stages of *Heath* v. *Unwin* (*m*), and is now clearly overruled (*n*). In a later stage of *Heath* v. *Unwin* (*o*), Parke, B., said, "In delivering the judgment of the Court of Exchequer, in a former stage of this case, I stated the opinion of the Court to be that there

(*g*) *Mackie* v. *Berry*, 1885, 2 P. O. R. 146.

(*h*) *Gosnell* v. *Bishop*, 1888, 5 P. O. R. 41.

(*i*) *Minter* v. *Wells*, 1834, 1 Web. P. C. 134; cp. *Couchman* v. *Greener*, 1884, 1 P. O. R. 197; *Nordenfelt* v. *Gardner*, 1884, *ibid.* 61; *Walker* v. *Hydro-Carbon Syndicate*, 1885, 2 P. O. R. 8; *Sugg* v. *Bray*, 1885, *ibid.* 233—239; *Richardson* v. *Castrey*, 1887, 4 P. O. R. 265; *Ellington* v. *Clark*, 1888, 5 P. O. R. 319; *Garrard* v. *Edge*, 1889, 6 P. O. R. 563; *Boyd* v. *Horrocks*, 1889, *ibid.* 152; *Automatic Weighing Co.* v. *Combined Co.*, 1889, 6 P. O. R. 367.

(*k*) 1845, 2 Web. P. C. 227.

(*l*) 1847, 16 L. J. C. P. 250; 2 Web. P. C. 156.

(*m*) 1847-55, 15 Sim. 552, 553; 25 L. J. C. P. 19.

(*n*) *Stevens* v. *Keating*, 1848, 1 Mac. & G. 659; *Walton* v. *Lavator*, 1860, 29 L. J. C. P. 279; *McCormick* v. *Gray*, 1861, 7 H. & N. 25; *Newall* v. *Elliott*, 1864, 10 Jur. N. S. 954; *Curtis* v. *Platt*, 1864, 11 L. T. N. S. 245.

(*o*) 1850, 2 Webs. R. 228.

would be no indirect infringement if the defendant did not mean to imitate at all. No doubt we were in error in that respect. There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself" (*k*).

Ignorance of existence of patent immaterial.

Knowledge immaterial.

In *Nobel's Explosives Co.* v. *Jones* (*l*), Lord Blackburn said, "I do not think it would be material, in order to support an action for infringement of their (the plaintiffs') property, to show that it was knowingly infringed; whether it was done knowingly or not it would be equally an infringement of their property."

Intention no part of infringement.

In *Young* v. *Rosenthal* (*m*), Grove, J., said, "Intention is not part of an infringement. A man may infringe a patent although he does not know he has infringed it, as a patentee may claim as a novelty that which is not a novelty. But then if it is not a novelty he must suffer, and if a man infringes he must suffer, whether he intentionally infringes or whether he does not intentionally infringe."

"Evidence of intention to imitate may be material for the attention of the jury, but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, the infringement is just the same" (*n*).

Mere intention cannot make any act done an infringement, which, without that intention, would not be an infringement (*o*).

By servants or agents.

As to the responsibility of employers for the acts of infringement of their servants or agents, see next Chapter (*p*).

Importation

The *importation* into this country and sale here (*q*), or to a foreign customer (*r*), of goods manufactured abroad by a process patented in this country, is an infringement of the patent.

The rationale of this rule is very clearly explained by James, L. J., in *Von Heyden* v. *Neustadt* (*s*):—

(*k*) See also *Curtis* v. *Platt*, *supra*.

(*l*) 1880-82, L. R. 17 Ch. D. 721.

(*m*) 1884, 1 P. O. R. at p. 39.

(*n*) 1845, 2 Web. P. C. 227, n. (*d*).

(*o*) *Newall* v. *Elliott*, 1864, 10 Jur. N. S. 954.

(*p*) Pages 258 *et seq.*

(*q*) *Walton* v. *Lavater*, 1860, 29 L. J. C. P. 279, 280; *Elmslie* v. *Boursier*, 1869, L. R. 9 Eq. 217; *Wright* v. *Hitchcock*, 1870, 39 L. J. Ch. 103, 101, 106; *Cartsburn Sugar Refining Co.* v. *Sharp*, 1884, per Lord Kinnear, 1 P. O. R. at p. 186. Though the manufacture in this country of the several parts of a patented machine, and the exportation of those parts, may not be an infringement of a patent for a new combination of machinery, when the parts exported are old, it is otherwise where the part exported is itself the patented invention: *Goucher* v. *Clayton*, 1865, 34 L. J. Ch. 239; 11 Jur. N. S. 462.

(*r*) *United Telephone Co.* v. *Sharples*, 1885, per Kay, J., 2 P. O. R. at p. 31.

(*s*) 1880, L. R. 14 Ch. D. at p. 233.

"We see no reason to doubt the conclusion arrived at in *Elmslie* v. *Boursier* (*t*), that the sole right granted by the Crown 'to make, use, exercise, and vend the invention within the United Kingdom,' and the right to 'have and enjoy the whole profit, benefit, commodity and advantage accruing and arising by reason of the said invention,' includes a monopoly of the sale in this country of products made according to the patented process, whether made in the realm or elsewhere. It may be added that the patent in another part expressly forbids any person directly or indirectly to make, use or put in practice the invention. A person who makes, or procures to be made, abroad for sale in this country, and sells the product here, is surely indirectly making, using, and putting in practice the patented invention. Any other construction would, in fact, in the case of any really valuable invention of a process, render the whole privilege granted by the Crown futile." Importation.

In *Neilson* v. *Betts* (*u*), B. held an English patent for the manufacture of a combined metal to be (among other purposes) applied as capsules to put on bottles. T. (who resided and carried on the business of a brewer in *Scotland*) purchased capsules made according to the process described in B.'s patent from a foreign manufacturer, and in *Scotland* put these capsules upon his beer bottles, which he then sent to his agents in *England* for transhipment and exportation. There was no evidence that the beer was sold in England for consumption here. It was held that though the capsules were put on in Scotland, their user, while the beer remained here, was a continued user of them, which amounted to an infringement of the patent.

In *Vavasseur* v. *Krupp* (*x*), a foreign sovereign bought in Germany shells made there, but said to be an infringement of an English patent. They were brought to this country in order to be put on board a ship of war belonging to a foreign sovereign, and the patentee obtained an injunction against the agents of the foreign sovereign, and the persons in whose custody the shells were, restraining them from moving the shells. The sovereign then applied to be added as a defendant to the suit. An order was then made by the Master of the Rolls, and affirmed on appeal, that notwithstanding the injunction he should be at liberty to remove the shells. Transhipment. Rights of foreign sovereigns.

In *Nobel's Explosives Co.* v. *Jones* (*y*), a patent having been

(*t*) 1869, L. R. 9 Eq. 217.
(*u*) 1870, L. R. 5 H. L. 1.
(*x*) 1870, L. R. 9 Ch. D. 351.
(*y*) 1880-82, L. R. 17 C. D. 721.

granted in this country for making the handling of nitro-glycerine less dangerous, by causing it to be absorbed in porous unexplosive substances, a material manufactured abroad by the patent process was imported into British waters. It was held, that such importation, though for the purpose only of transhipment for exportation, and not for the purpose of having the material landed and stored in this country, was a continuing user in this country of the invention, and therefore an infringement.

Custom House agents.

In the same case it was held, that the acting as Custom House agents for an importing firm was not an infringement of an English patent, although the importation might have been an infringement.

Foreign vessels in British waters.

The Act of 1883 (*a*) declares that a patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the British territorial waters; nor the use of such an invention on board the ship, where it is not used for, or in connection with, any intended importation into, or exportation from, the United Kingdom or Isle of Man. This provision, however, is not to apply to the vessels of any foreign state where similar privileges are not accorded to British vessels.

Rights of the Crown.

Prior to the Act of 1883 the Crown and its servants or agents had the right to use a patented invention without any payment of compensation to the patentee (*b*). It was decided, in *Feather* v. *Regina* (*c*), that a grant of letters patent to a subject for an invention does not exclude the Crown from using the invention without a licence of the patentee.

This right of the Crown is not because the Crown is impliedly excepted from the effect of letters patent, but because the privilege thereby granted is granted against the subjects only, and not against the Crown (*d*).

Crown contractors.

In *Dixon* v. *London Small Arms Co.* (*e*), persons who had *contracted* with the government for the supply of a patented article were held liable in damages. As the defendants were contractors and not servants or agents, they could not shelter themselves

(*a*) Sect. 43. This is a re-enactment of Act of 1852, s. 26, and was necessitated by the decision in *Caldwell* v. *Vanvlissigen*, 1851, 21 L. J. (N. S.) Ch. 97. In that case an injunction was granted against subjects of the King of Holland to restrain them from using on board their ships within the dominions of England, without the licence of the plaintiffs, an invention to the benefit of which the plaintiffs were exclusively entitled under the Queen's patent.

(*b*) *Dixon* v. *London Small Arms Co.*, 1875, R. 1 App. Cas. 632; *Feather* v. *Regina*, 1865, 35 L. J. Q. B. 200; 12 L. T. N. S. 184.

(*c*) *Supra*.

(*d*) *Dixon* v. *London Small Arms Co.*, 1875, L. R. 1 App. Cas. 632.

(*e*) *Supra*.

behind the rights of the Crown, even though manufacturing for the Crown (*f*).

Patent to bind Crown.

The above cases still apply to patents granted prior to the Act of 1883, but now it is provided by that Act, s. 27, that a patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject. But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Experimental user.

In *Frearson* v. *Loe* (*g*), Jessel, M. R., said, "No doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made, for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition."

In the case of *Jones* v. *Pearce* (*h*), an action for the infringement of a patent for an improved method of making carriage wheels on the principle of suspension, Mr. Justice Patteson, in summing up the case to the jury, intimated that there would be no infringement of the patent if the defendant merely made the patented articles for his own amusement or as a model.

In a later case, *Muntz* v. *Foster* (*i*)—an action for the infringe-

(*f*) As to the insertion of conditions in favour of the Crown and its contractors on grant of new letters patent on prolongation, see *Napier's Patent*, L. R. 6 App. Cas. 174; *Lancaster's Patent*, 1864, 2 Moo. P. C. N.S. 189; and *Hughes' Patent*, L. R. 4 App. Cas. 174; also *Petit Smith's Patent*, 7 Moo. P. C. 133. See also Prolongation, Chapter XVII.

(*g*) 1878, L. R. 9 C. D. at p. 67. See also *Higgs* v. *Goodwin*, 1858, 27 L. J. Q. B. 145; affirmed, p. 411; *Brereton* v. *Richardson*, 1883-84, Griffin, P. C. 54; 1 P. O. R. 165; *Guilbert-Martin* v. *Kerr*, 1887, 4 P. O. R. 18.

(*h*) 1832, 1 Web. P. C. 124.

(*i*) 1844, 2 Web. P. C. 101.

Experimental user.

ment of a patent for "an improved manufacture of metal plates for sheathing the bottom of ships"—the patentee's invention consisted in making the said plates of an "alloy of foreign zinc" and of "best selected copper," the metals being melted together in certain stated proportions. Chief Justice Tindal told the jury that if the defendant had "actually made any small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent."

User for instruction.

But user of a pirated article for the purpose of experiment and instruction, is user for advantage, and an infringement of the patent (*l*).

In that case, a company, being the proprietors of two patents for improvements, brought two actions against S., one for the infringement of each patent; S. denied infringement, and the actions were consolidated. It was admitted at the trial that S. had imported from abroad certain magnets, telephones, and transmitters, which were substantially identical with the articles made under the patent. S.'s story was that he did not really buy the instruments for exportation, but for use by his pupils, so as to avoid the use by them of the patent articles which were much more expensive.

"Imagine," said Mr. Justice Kay, "that I am to believe all this extraordinary story, and that these were not bought (for exportation). . . . . what is the alternative story? The alternative story is this: The witness S. says, "We used them for the purpose of experiment; the cost of them was so small that we could afford to allow our pupils to pull them to pieces, or experiment with them." Now they had, as he says, a number of the so-called royalty paid instruments; they were more costly, and he says, again and again: "We could not afford to let our pupils use those: we could not afford to allow them to be pulled to pieces or experimented with, and therefore it was that we bought those which were very much cheaper, in order that our pupils might experiment with and use those instead of using the more expensive instruments." And I am asked to say that that was not a user in this country. What does a pupil mean. They say that the pupils are persons who do not pay anything for being taught, but, on the contrary, that after they have been a certain while in the business, they, or certain classes of them, receive some payment; but the very word pupil—and this evidence which is given shows me plainly that they are young persons who are ad-

(*l*) *United Telephone Co.* v. *Sharples*, 1885, L. R. 29 C. D. 164; 54 L. J. Ch. 633.

mitted into this business for the purpose of learning the business—and whether they pay or not, it is obvious enough that they are paid very much less than an ordinary assistant would be paid who did not want to learn the business. They are admitted upon the terms that part of the remuneration they shall get for their services shall be instruction in the business . . . . To say that to buy a telephone, which is an infringement of the patent in this country, for the purpose of instructing your pupils, is not a user in their country, is a thing which I cannot accede to. . . . I asked (whether) there could be no user of a patent unless it produced a direct pecuniary advantage to the person who used it. . . . I put the very obvious case of a man buying what he knew to be a pirated Singer Sewing Machine; for example, suppose, the real thing being protected by a patent, that he buys a cheaper instrument which he knows is made in infringement of the patent, and buys it for some member of his household, who uses it in the household—let us say for amusement simply—would that be a user or not? Of course it could not be denied, because, although it did not produce to him one farthing, or save him the expense of one farthing, there would be no doubt whatever it would be a user in this country.

Direct pecuniary advantage not condition precedent to liability.

It appears, therefore, that direct pecuniary advantage to the infringer of patented articles is not a condition precedent to his liability, and that it is sufficient if the act complained of is, or may reasonably become, prejudicial to the patentee.

In the case of *Higgs* v. *Goodwin* (*m*), the use by the defendant of a patented process for "treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes," not with the object of making a saleable mercantile article, but merely to purify the water, was not an infringement of the plaintiff's patent.

In *Proctor* v. *Bayley* (*n*), the plaintiff, the owner of a patent, the validity of which had been established in a previous action, brought an action in the Palatine Court against the defendant, claiming an injunction and damages in respect of a previous user by the defendant of certain infringing machines in his works.

(*m*) 1858, 27 L. J. Q. B. 145; affirmed at p. 411.

(*n*) *Proctor* v. *Bayley*, 1889, 6 P. O. R. 106, 538. It was also held by the Court of Appeal, that as the Palatine Court had, under Lord Cairns' Act, only jurisdiction to grant damages in a case where it was proper to grant an injunction, there was no jurisdiction in the present case, and the action must be dismissed. The Court refused to give any opinion as to whether the dismissal of this action would be prejudicial to a subsequent action at law for damages.

The machines had been put up on trial, and proving unsuccessful, had been taken down five years, and removed from the defendant's premises three years before the commencement of the action. The defendant denied purchase or user of infringing machines, and, in the alternative, pleaded that his user of them was experimental, that it had long been discontinued, and that no threat or intention on his part to use infringing machines had been alleged or proved. It was held, by Bristowe, V.-C., that the defendant had used machines which were an infringement of the plaintiff's invention and to an extent amounting to more than an experimental user; and that though the act was discontinued, and there was no threat to continue it, the plaintiff was entitled to an injunction in aid of his legal right. The defendants appealed. It was held, on appeal, that in order to invoke the extraordinary jurisdiction to grant an injunction there must be some probability of the act being continued, and that assuming the defendants had infringed, as they were only users and not manufacturers, and the only infringement was put an end to in 1883, there was no evidence of any intention on their part to continue the wrongful act, and, therefore, an injunction ought not to be granted.

What is user?

In the case of *Minter* v. *Williams* (*o*), it was held by the Court of King's Bench that the mere exposing for sale an article manufactured by a patent process is not an infringement of the letters patent, because the word "vend" which occurs in the granting, is not used in the prohibitory part of the patent; and because, even if it ought to be imported into the prohibitory clause of a patent, to "vend" does not mean to "expose for sale"; also because a mere exposure to sale is not necessarily prejudicial to the patentee.

Exposure for sale.

In *Oxley* v. *Holden* (*p*), however, an action for the infringement of a patent for "improvements in the doors and sashes of carriages," it appeared that the defendant had made about half-a-dozen of the patented articles, and that his traveller had offered them for sale to divers persons, but had not sold any. Justice Byles directed the jury that this was, in point of law, as much a user of the patent as if there had been an actual sale of the articles.

Where certain patented articles were given to a tradesman for the purpose of being repaired, and were lent by his wife to a third

(*o*) 1835, 5 L. J. K. B. 60; 1 Web. P. C. 135.

(*p*) 1860, 8 C. B. N. S. 666.

party, without any intention to sell them or to evade the patent, it was held that there had been no infringement (*q*).

It is sufficient to constitute user of a patented article that the same sort of benefit, however temporary and indirect, has been in fact derived from it in its ordinary use. It is immaterial whether the use of the article is active or passive (*r*).

The user in this country of a patented article made abroad is an infringement of the patent (*s*). Possession.

Possession of a patented article may amount to an infringement if it be shown that it was intended to be used, although there may have been no actual user.

In *Adair* v. *Young* (*t*) an action was brought against the master of a ship to restrain him from using pumps, which were an infringement of the plaintiff's patent. It was shown that the ship was fitted up exclusively with infringing pumps, but had been so fitted up before the defendant, who was not a part-owner, had taken possession of her. He had nothing to do with putting them on board, and they had never been worked in British waters.

On appeal from an injunction granted by Bacon, V.-C., it was held that the injunction was rightly granted, on the ground that the defendant, being in command of a ship exclusively fitted up with pumps, which were an infringement of letters patent, was intending to use the patented invention.

In *The United Telephone Co.* v. *London and Globe Telephone Co.* (*u*), the plaintiffs brought their action on the ground that certain instruments were infringements of their Patent B. These instruments had been manufactured for the defendants under a contract dated before the 27th of July, 1882, and were in their possession, but they had never used or sold any of them. The defendants contended that no injunction could be awarded against them, as they had not used or sold the instruments complained of. It was held that an injunction must be granted on the terms asked for by the plaintiffs, because possession without actual use of infringing articles is a sufficient ground for an injunction to restrain actual use.

The user of an invention after the patent has expired, and before new letters patent are granted on prolongation, is not an infringement (*x*).

(*q*) *United Telephone Co.* v. *Henry & Co.*, 1885, 2 P. O. R. 11.
(*r*) *Betts* v. *Neilson*, 1868-71, 34 L. J. Ch. 537.
(*s*) *Ibid.*
(*t*) 1879, L. R. 10 Ch. D. 13.
(*u*) 1884, 1 P. O. R. 117.
(*x*) *Russell* v. *Ledsam*, 1845, 14 M. & W. 574; 14 L. J. Ex. 353; affirmed, 16 L. J. Ex. 145; 16 M. & W. 641.

The user of an invention for a different purpose from that of the patent is an infringement (*t*).

Infringement by sale.

In *Townsend* v. *Haworth* (*u*), it was laid down by Jessel, M. R., that the sale of articles which, to the knowledge of the vendor, would be used by the purchaser in infringing a patent, was not an infringement of the patent so far as the vendor was concerned; and this principle was approved of by Fry, L. J., in *Sykes* v. *Howarth* (*x*). It is a necessary deduction from the proposition, which is clearly good law, that in cases of what are called combination patents, it is only the combination claimed that may not be used. The mere making, using, or vending of the elements is not prohibited by the patent.

A sale, however small, of infringing articles, however trivial in value, is sufficient to ground an action, if the plaintiff's right is distinctly challenged thereby (*y*).

When an article is sold without any restriction on the buyer, whether it is manufactured under an English or a foreign patent, that, as against the vendor, gives the purchaser an absolute right to deal with what he so buys in any way he thinks fit; and, of course, that includes selling in any country where there is a patent in the possession of and owned by the vendor (*z*).

But the mere fact that the grantors of a licence to use an invention in Belgium had a monopoly of the same invention in England, would not import, as a matter of construction, into the Belgian licence, the grant of a right to interfere with that monopoly when there was no express grant of a right to sell in England.

Infringement by manufacture.

A licence to manufacture an article is an authority to purchasers to sell again without the consent of the patentee (*a*).

Procuring manufacture of infringing articles is infringement.

If it can be shown that a defendant in an action of infringement procured the making of articles according to the patentee's invention, that will be sufficient to entitle the plaintiff to a verdict against him upon that breach (*b*).

Offers to execute orders for articles which

In the case of *Gwynne* v. *Drysdale* (*c*) a curious point was raised. The pursuer, being patentee of an invention of "improve-

(*t*) *Edison and Swan Co.* v. *Holland*, 1888, 5 P. O. R. pp. 482–3.

(*u*) 1875, L. R. 12 Ch. D. 831, n.

(*x*) 1878, L. R. 12 Ch. D. at p. 832; cp. *Brigge* v. *Lardour*, 1884, 2 P. O. R. 126.

(*y*) *Cole* v. *Saqui*, 1888, 5 P. O. R., per Kekewich, J., at p. 493.

(*z*) *Société Anonyme de Glaces* v. *Tilghman's Sand Blast Co.*, 1883, 25 Ch. D. 7, per Cotton, L. J., cp. *Betts* v. *Willmott*, 1870, L. R. 6 Ch. 239.

(*a*) *Thomas* v. *Hunt*, 1864, 17 C. B. N. S. 183.

(*b*) *Gibson* v. *Brand*, 1842, 1 Web. P. C. 631, per Tindal, C. J., and see note (*d*).

(*c*) 1885, 2 P. O. R. 160.

ments in pumping machines," which consisted in arranging the suction and discharge pipes to swivel, by making the pump case rotate, brought an action against the defenders for infringing this patent. The alleged infringements consisted of the sale of certain pumps, and offers to execute orders for swivelling pumps in response to applications by persons who applied at the instance of the pursuer. The defenders denied infringement. It was held by the Lord Ordinary (Maclaren), whose judgment was affirmed on appeal by the First Division of the Inner House of the Court of Session (*d*), that the defenders had not infringed, because the pumps which they had sold were not swivelling pumps at all, and as to their offers to execute orders for swivelling pumps, the patent did not claim every kind of swivelling pump, and the presumption must be that their offers related to such as would not be an infringement of the patent.

might or might not be infringements.

The following extract from the judgment of Lord Maclaren shows how far such offers will be treated as evidence of infringement:—

"In the first place, these cases are open to the observation that they were both offers obtained from the defender by persons who were seeking for evidence of a contravention of the patent, and it is quite certain he has never supplied swivelling pumps to any previous customer. Further, the offer is a very general one. He does not say that these swivelling pumps which he was to supply were to be according to the description in the pursuer's specification. . . . The patent does not claim every mode of swivelling a pump; indeed, I do not think a legal specification could be drawn such as would embrace every arrangement of swivelling; at all events, it is not so done here, and I cannot assume that the intention was to infringe the patent. On the contrary, the presumption is always in favour of innocence, and I must assume he meant to supply something which was not a contravention." If the arrangement had gone on, and a swivelling pump had been ordered, "we would then have seen what it was like, and possibly a case of infringement might have been made out; but at present the mere fact that an offer was made to supply a swivelling pump, if desired, unaccompanied by any evidence of positive infringement, is not such evidence as, in my opinion, would justify the Court in granting an injunction or interdict against contravention."

(*d*) 1886, 3 P. O. R. 65.

Making or working material part of invention is infringement.

The making or working any material part of an invention patented without the consent or licence of the patentee, is an infringement of his rights.

The cases in support of this statement will be considered when we come to deal with the infringement of combinations (*infra*, pp. 236 *et seq.*).

One or two general illustrations may, however, be given here with advantage.

In *Cornish* v. *Keene* (*d*), the patent comprised an invention which was composed of three distinct parts, and the plaintiffs proved that the defendants had used so much only of the invention as related to one of the three parts, yet the evidence was held to be sufficient to entitle the plaintiffs to a verdict upon the issue of infringement.

In *Newton* v. *Grand Junction Railway Co.* (*e*), Pollock, C. B., said, "It was argued that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But, in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part, for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement."

In *Sellers* v. *Dickinson* (*f*), the same learned judge said, "There may be an infringement by using so much of a combination as is material, and it would be a question for the jury whether that used was not substantially the same thing" (*f*). And again, "I think it may be laid down as a general proposition (if a general proposition can be laid down on a subject applicable to such a variety of matters

(*d*) 1835, 6 L. J. C. P. 225; 1 Web. P. C. 501; cp. *Hill* v. *Thompson*, 1818, 1 Web. P. C. 242; *Gillett* v. *Wilby*, 1839, 1 Web. P. C. 270; 9 C. & P. 336; *Newton* v. *Grand Junction Rail. Co.*, 1846, 20 L. J. Ex. 427, n.; 5 Exch. 334; *Sellers* v. *Dickinson*, 1850, 20 L. J. Ex. 417; 5 Exch. 324, 326; *Electric Telegraph Co.* v. *Brett*, 1851, 20 L. J. C. P. 123; 10 C. B. 838; *Smith* v. *L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69, 76; *Bovill* v. *Keyworth*, 1857, 29 L. T. 194; 7 E. & B. 725, 737; *De la Rue* v. *Dickinson*, 1857, 29 L. T. 194; 7 E. & B. 738; *Lister* v. *Leather*, 1858, 27 L. J. Q. B. 295; 8 E. & B. 1004, 1031, 1033; *Patent Bottle Envelope Co.* v. *Seymer*, 1858, 28 L. J. C. P. 22; 5 C. B. N. S. 172; *Thomas* v. *Foxwell*, 1858, 5 Jur. N. S. 39; *White* v. *Fenn*, 1867, 15 L. T. N. S. 505; 15 W. R. 348; *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358, 366, 368; *Wright* v. *Hitchcock*, 1870, L. R. 5 Ex. 37; *Hinde* v. *Osborne*, 1885, 2 P. O. R. 68; *United Horsenail Co.* v. *Stewart*, *ibid.* 122.

(*e*) 1846, 5 Exch. 334.

(*f*) 5 Exch. 324; *Hills* v. *Liverpool Gas Co.*, 1863, 32 L. J. Ch. 28.

as patent law—matters, indeed, incommensurable with each other, for the same doctrine which would apply to a medicine would scarcely apply to a new material or a new metal), that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent" (*g*).

Law as to improvements in patented articles.

It is no answer for the defendant in an action of infringement to show that he has improved upon the plaintiff's invention, if, without the use of that invention, the improvement cannot be made available (*h*).

A patent can be taken out for an improvement upon the subject-matter of the patent which is still running or in force, but cannot be exercised without the license or consent of the prior patentee during the currency of his grant, if it is so dependent upon the original invention as to be incapable of being used without it. At the end of that time the public has a right to choose between the two inventions (*i*). On the other hand the improvement cannot be used by the original patentee without the licence of the second patentee, but since 1883 either patentee can obtain a compulsory licence.

Sect. 2.—Principles in Practical Operation.

Infringement of a principle in practical operation.

Although there cannot be a patent for an idea or a principle apart from its physical embodiment in adequate apparatus, yet if the specification discloses the idea, shows a method by which it can be carried out, and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea, is an infringement of the patent, though the method used, and even the purpose *to* which the principle or idea is applied, be different from those embodied in the specification (*k*). Thus, in

(*g*) *Ibid.* 326.

(*h*) *Neilson* v. *Harford*, 1841, 1 Web. P. C. 310, 323.

(*i*) *Ex parte Fox*, 1812, 1 Web. P. C. 413; *Harmar* v. *Playne*, 1807, 14 Ves. 130; *Lewis* v. *Davis*, 1820, 1 Web. P. C. 489; *Crane* v. *Price*, 1842, 1 Web. P. C. 413, per Tindal, C. J. A manufacturer who professes to sell to the public a machine under his own name as one with all the newest improvements, will not be restrained from selling it on an allegation that it is an infringement of the plaintiff's patent for an old machine which had not the modern improvements: *Willcox Sewing Machine Co.* v. *Wood*, 1869, 20 L. T. N. S. 10.

(*k*) *Easterbrook* v. *The G. W. Rail. Co.*, 1885, per Wills, J., 2 P. O. R. at p. 207; cp. also *Crossley* v. *Beverley*, 1829, 1 Web. P. C. 106; *Jupe* v. *Pratt*, 1837, per Alderson, B., 1 Web. P. C. 146; *Houchill Co.* v. *Neilson*, 1843, per Lord Justice Clerk-Hope, 1 Web. P. C. at p. 683; *Otto* v. *Linford*, 1881-82, 46 L. T. N. S. 35; *Badische Anilin Fabrik* v. *Levinstein*, 1883, L. R. 24 Ch. D. 156, 171—173.

Minter v. *Williams* (*l*), the invention claimed being the application of a self-adjusting leverage to the back and seat of a chair, it was laid down that any application of that principle to the same subject would be an infringement of the patent.

Process for arriving at known result.

Where a patent is taken out for a process for arriving at a known result, any other person may take out a patent for another process, or may use another process without obtaining a patent, without any infringement of the process first patented (*m*).

Cases.

Bovill v. *Pinnm*.

In *Bovill* v. *Pinnm* (*n*), the facts were these:—

In 1844, G. obtained a patent for "improvements in grinding wheat and other grains." He described as his invention "the forcing and distributing of atmospheric air from the eye or centre of mill-stones, for the purpose of cooling the grain during the process of grinding." This was effected by an air-box placed below the mill-stones, into which air was forced by the rapid rotation of a fan or blower, which caused a current of air perpendicular to the axis of the fan; and the air was conducted by a pipe through the eye of the lower stone to the centre of the two stones, and there distributed between them by an apparatus provided with fans or arms. In 1846, the plaintiff obtained a patent for "improvements in manufacturing wheat and other grain into meal and flour." His invention consisted in the application of ventilating vanes or screws at the centre of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current of air parallel to the axis of the vane, was attached externally to the eye of the upper mill-stone; the screw vane being set in rapid motion, the air was compelled to pass through the eye into the centre of the two stones, and so find its way out between them. In 1851, the defendant obtained a patent for "improvements in grinding wheat," and his plan was to remove from the centre of both stones a large circular portion of each, and in this space, opposite to the separation of the two stones, to place a fan or blower, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones:—It was held, that the defendant's invention was no infringement of the plaintiff's, but that each was a new method of accomplishing a well-known object, viz., the cooling grinding substances by the common principle of obtaining a current of air by a rotating vane.

(*l*) 1835, 5 L. J. K. B. 60; 1 Web. P. C. 134.

(*m*) *Badische Anilin Fabrik* v. *Levinstein*, 1883, per Pearson, J., 24 Ch. D. p. 170.

(*n*) 1856, 11 Exch. 718—739.

Pollock, C. B., in delivering the judgment of the court, said: "Where a subject is not new, as this certainly was not, viz., 'the cooling of substances undergoing the process of grinding' (which had been long known to be a desideratum in grinding, and to effect which various contrivances had been adopted, and several, if not many, patents taken out), any patent taken out for *a method of performing the operation* is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase (*o*).

Seed v. *Higgins*.

Again, in *Seed* v. *Higgins* (*p*), the plaintiff claimed by his specification and disclaimer the application of centrifugal force in the particular manner described in the specification. The particular manner described was by the use of "a weight." The defendant employed a machine similar in many respects, but, though using weight, or pressure occasioned by weight, as a force, did not use "*a* weight:"—It was held, that this did not amount to an infringement of the plaintiff's patent.

Wilson v. *Barbour*.

In *Wilson* v. *Barbour* (*q*), the plaintiff and one of the defendants were patentees of an improvement in machines for spinning rope yarns, which they called an "Interceptor," and which consisted of rack-like clamps with intersecting teeth, forming an irregular elastic tube through which the fibre passed to the flyer, so that the twist imparted by the flyer was intercepted and prevented from passing to the smooth portion of the yarn or "sliver." An agreement was entered into between the plaintiff and the defendants, who were a firm of machine makers. The defendants undertook to make and sell the patented machines, and to use their best endeavours to develop the sale, the plaintiff to receive part of the profits, and "all future improvements of the patent, whether invented by plaintiff or defendants, were to belong to the patent." The defendants having found the plaintiff's "Interceptor" defective for spinning certain classes of yarn, made,

(*o*) Cp. *Bovill* v. *Keyworth*, 1857, 7 E. & B. 725.

(*p*) 1860, 8 H. L. C. 550; cp. *Palmer* v. *Wagstaffe*, 1854, 23 L. J. Ex. 217; 9 Ex. 494.

(*q*) 1883, 5 P. O. R. 246; cp. *Bovill* v. *Pimm*, 1856, per Pollock, C. B., 11 Ex. at p. 739; *Needham* v. *Oxley*, 1865, 21 Newt. Lon. Jour. N. S. 300; *Curtis* v. *Platt*, 1866, 35 L. J. Ch. 852; 11 L. T. N. S. 249; *Walker* v. *Hydro-Carbon Syndicate*, 1885, 2 P. O. R. 8; *Mackie* v. *Berry*, 1885, *ibid.* p. 146; *Sugg* v. *Bray*, 1885, *ibid.* pp. 233, 234, 236, 238, 239; *Lawrence* v. *Perry*, 1885, *ibid.* pp. 179, 188; *Proctor* v. *Bennis*, 1887, 4 P. O. R. 354; *Gosnell* v. *Bishop*, 1888, 5 P. O. R. 41.

without informing the plaintiff, various experiments for the purpose of improving it, but ultimately abandoned the principle of rack-like clamps, and adopted an interceptor consisting of two opposing surfaces, forming a continuous tube instead of an irregular one, as in the plaintiff's invention, the same results, viz., "nipping" and "rubbing" the yarn, being accomplished in both. The defendants sold a number of machines fitted with their own new interceptor without paying the plaintiff any royalty or share of profits on such sales.

While the judgment of the Court (*q*) was in favour of the plaintiff on the grounds—which are not material to the point now under consideration—that the defendants' interceptor, being an "improvement" within the meaning of the agreement, therefore belonged to the patent; and that the defendants, not having used their best endeavours to develop the sale of the plaintiff's invention, were liable in damages, it was held that the object aimed at by both interceptors not being new, and the means adopted for accomplishing it being different, the defendants' interceptor was not an infringement of the patent.

Curtis v. *Platt.*

Curtis v. *Platt* (*r*) is an authority for the same proposition. The plaintiff was the owner of a patent for improvements in spinning mules, which were well-known machines, working and acting long before that patent was taken out. For the efficient agency of these machines, it was found necessary that there should be a shaft with cams on it, and some means of arresting the shaft, staying it once, twice, or even four times during a single rotation, and thereby producing breaks or pauses for spaces of time in its rotatory motion. These pauses or breaks had been at various times attempted to be produced in various ways. One method of producing them was by the operation of a clutch-box, and it was patented by L. and R. The plaintiff's patent was for an improvement on this process, and its only merit consisted in a new arrangement of original elements, all of which were to be found in the patent of L. and R. The defendant used the same common elements for the same object, but in a different combination, with a different effect on the clutch-box, and with a different result. It was held by Wood, V.-C., and by the House

(*q*) Chancery Division of the High Court of Justice (Ireland), per Porter, M. R.

(*r*) 1863, 3 Ch. D. 136, n.; 11 L. T. 247: explained by Cotton, L. J., in *Proctor* v. *Bennis*, 1887, 36 Ch. D. pp. 750—758.

of Lords on appeal, that there had been no infringement of the plaintiff's patent.

The effect of this decision is that "where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims, and the mode which he points out of effecting the improvement."

The opinions expressed by the judges in *Curtis* v. *Platt* do not apply to a case where there is not only novelty in the machine, but novelty in the result to be produced by that machine.

New result by a process.

Obtaining same result by another process is an infringement.

When a patent is taken out for a new result, not known before, and there is one process described in the patent which is effectual for the purpose of arriving at that new result at the time when the patent is taken out, the patentee is entitled to protection against all other processes for the same result, and no person can, without infringing upon his patent, adopt simply a different process for arriving at the same result (*s*).

Or machine.

Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been done before (*t*).

In *Proctor* v. *Bennis* (*u*), the patent in question had for its object "improved and self-acting mechanism for supplying to and dis-

(*s*) *Badische Anilin Fabrik* v. *Levinstein*, 1883, per Pearson, J., 24 Ch. D. at p. 171.

(*t*) *Curtis* v. *Platt*, 1863, 3 Ch. D. 136, n., per Wood, V.-C.; *Bovill* v. *Moore*, 1816, Dav. P. C. 405; *Hill* v. *Thompson*, 1818, 1 Web. P. C. 242; *Forsyth* v. *Riviere*, 1819, 1 Web. P. C. 97; *Webster* v. *Utter*, 1824, Godson's Patent Law, 232; *R.* v. *Lister*, 1826, Webst. Letts. Pat. 80; *Cochrane* v. *Braithwaite*, 1830, 3 Lond. Jour. N. S. 42; *Russell* v. *Cowley*, 1834, 1 Web. P. C. 463; *Morgan* v. *Seaward*, 1836, 1 Web. P. C. 171; *Walton* v. *Potter*, 1841, 11 L. J. C. P. 138; 1 Web. P. C. 586; *Neilson* v. *Harford*, 1841, 1 Web. P. C. 319; *Walton* v. *Bateman*, 1842, 1 Web. P. C. 616; *Muntz* v. *Foster*, 1844, 2 Web. P. C. 101; *Gamble* v. *Kurtz*, 1846, 3 C. B. 425; *Trotman* v. *Wood*, 1864, 16 C. B. N. S. 479; *Hayward* v. *Hamilton*, 1861, Johnson's Pat. Man. 245; *Stead* v. *Anderson*, 1847, 16 L. J. C. P. 250; 2 Web. P. C. 156; *Barker* v. *Grace*, 1847, 17 L. J. Ex. 122; 1 Exch. 339; *Stevens* v. *Keating*, 1847, 19 L. J. Ex. 57; 2 Web. P. C. 181; *Electric Telegraph Co.* v. *Brett*, 1851, 20 L. J. C. P. 123; 10 C. B. 838; *Hancock* v. *Moulton*, 1852, Johnson's Pat. Man. 208; *Bateman* v. *Gray*, 1853, 22 L. J. Ex. 290; Macr. P. C. 102; *Smith* v. *London and North Western Railway Co.*, 1853, 2 E. & B. 69, 76; *Morewood* v. *Tupper*, 1855, 3 C. L. R. 718; *Simpson* v. *Holliday*, 1864, 20 Newt. Lon. Jour. N. S. 111; *Needham* v. *Oxley*, 1865, 21 Newt. Lon. Jour. N. S. 300; *Curtis* v. *Platt*, 1866, 35 L. J. Ch. 582; *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 585.

(*u*) 1887, 36 Ch. D. 740.

tributing fuel at intervals over the fire surface." The essence of the invention consisted in throwing coal on to the furnace by the intermittent radial action of a flap or door. Nothing of the kind had been done before. There had previously been imperfect machines for feeding furnaces automatically, but that had not previously been done by any intermittent radial action of a flap or door as in the case of the plaintiff's patent.

It was held by the Court of Appeal that the plaintiff's patent was infringed by a machine producing the same result by a combination of mechanical equivalents of the above contrivances, with some alterations and omissions which did not prevent the new machine from being one which took the substance and essence of the patented invention.

Sect. 3.—Combinations.

Test of infringement of combination.

The test of whether or not a combination has been infringed was thus stated by Cotton, L. J., in *Proctor* v. *Bennis* (*x*): "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variations or by mechanical equivalents the substance of it so as to produce the same result by practically the same means?"

(*x*) 1887, 36 Ch. D. at p. 754; cp. *Needham* v. *Johnson*, 1884, 1 P. O. R. 45. It was held, in *Proctor* v. *Bennis*, at p. 752, that a patent for a new combination of four elements is infringed by a machine containing some of such elements with mechanical equivalents for others; and it is immaterial to the defendant's liability that he has made improvements upon the plaintiff's invention, unless it can be shown that the improvements are of such a character as to prevent the two machines being in substance the same: *Ehrlich* v. *Ihlee*, 1888, 5 P. O. R. at p. 454, per Cotton, L. J.; cp. *Russell* v. *Ledsam*, 1845, 14 L. J. Ex. 145; 14 M. & W. 580; *Davis* v. *Feldman*, 1884, Griffin, P. C. 75; 1 P. O. R. 13, 193; *Tatham* v. *Dania*, 1869, Griffin, P. C. 213; *United Telephone Co.* v. *Nelson*, 1887, W.N. 1887, 193. A clumsy imitation of a patented machine, or a patented article, may be an infringement, although it is not such as would have been an anticipation defeating an inventor's right to a patent: *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 585; *Daw* v. *Eley*, 1867, L. R. 3 Eq. 496: cp. *Hinde* v. *Osborne*, 1884, 1 P. O. R. 221; *Hayward* v. *Pavement Light Co.*, *ibid.* p. 207, affirmed, 1885, 2 P. O. R. 64; *Useful Patents Co.* v. *Rylands*, *ibid.* 255; *Osmond* v. *Hirst*, *ibid.* 265; *Fairburn* v. *Household*, 1886, 3 P. O. R. 267; *Hocking* v. *Fraser*, *ibid.* 3; *United Telephone Co.* v. *St. George*, *ibid.* 321; *Edison* v. *Woodhouse*, *ibid.* pp. 173, 174; *United Telephone Co.* v. *Bassano*, *ibid.* 295. It is not for the Court to say how far a defendant's instrument will be an infringement if certain parts are altered or varied: *S. C.* at p. 318; *Downes* v. *Falcon Iron Works*, 1886, 3 P. O. R. 70; *Musgrave* v. *Hicks*, *ibid.* 49; *Kaye* v. *Chubb*, 1887, 4 P. O. R. 23; *Hocking* v. *Hocking*, *ibid.* 255, 434; *Wenham Co.* v. *May & Co.*, *ibid.* 303; *Moseley* v. *Victoria Rubber Co.*, *ibid.* 253; *Harvie* v. *Ross*, *ibid.* 234; *Fletcher* v. *Glasgow Gas Commissioners*, 1887, 4 P. O. R. 356. In this case the defendants admitted certain infringements, which they had discontinued, and offered to pay royalties in respect of, and successfully disproved other alleged infringements: *ibid.* 389; *Ellington* v. *Clark*, 1888, 5 P. O. R. 135; *Haslam Co.* v. *Hall*, *ibid.* 21; *Boyd* v. *Horrocks*, *ibid.* 579; *Crampton* v. *Patents Investment Co.*, *ibid.* 382; *Gosnell* v. *Bishop*, *ibid.* 166.

Cases of infringement of combinations.

The law as to the infringement of combinations may best be illustrated by a somewhat detailed examination of the cases bearing upon the subject.

Patent for entire combination not infringed by different combination for same object.

A patent for an entire combination is not infringed by a different combination for the same object of the same elements, though important, or of equivalents for them, if not a mere colourable evasion or imitation (*z*). Thus, in *Clark* v. *Adie* (*a*), the plaintiff, who was assignee of a patent for a machine for clipping horses, made a new machine for the same purpose, for which he did not take out a patent. The plaintiff's machine was very unlike the patented machine, the general combination of the parts of the latter machine not being copied, but a subordinate combination (*a*) of some of the parts (not expressly or impliedly claimed as a distinct invention in the specification of the patentee) being embodied in the plaintiff's machine. The defendant made and sold clipping machines in exact imitation of the plaintiff's machine. It was held that the defendant's patent did not protect the subordinate combination.

Again, in *Parkes* v. *Stevens* (*b*), where by the specification of a patent for improvements in spherical gas lamps at railway stations and public places, protection was claimed for "the arrangement and combination of parts hereinbefore described and represented in the drawing annexed," it was held by James, V.-C., that the use by the defendant of a sliding spherical door, which, although its advantages were altogether collateral to the objects of the invention, was a feature in the plaintiff's lamps, and described in his specification, was no infringement of the plaintiff's patent.

Patent for entire combination protects every essential part.

His Lordship, however, added: "The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—Is it really and substantially a part of the invention?" (*c*).

(*z*) *Curtis* v. *Platt*, 1866, 35 L. J. Ch. 852. In considering the question of colourable evasion, the Court will look at the novelty of the object of the combination, and of the parts combined, *ibid.*; *Lister* v. *Leather*, 1858, 27 L. J. Q. B. 295; 8 E. & B. 1004, 1031. See a consideration of this case, *supra*, at p. 143; cp. *Dudgeon* v. *Thomson*, 1877, L. R. 3 A. C. 34; *Clark* v. *Adie* (No. 1), 1875, L. R. 10 Ch. 667; *Townsend* v. *Haworth*, 1875, 12 Ch. D. 831, n.; *Harrison* v. *Anderston Foundry Co.*, 1876, L. R. 1 A. C. 574.

(*a*) *Supra*.

(*b*) 1869, L. R. 8 Eq. 358; *Saxby* v. *Clunes*, 1869-74, 43 L. J. Ex. 228.

(*c*) Cp. *Walton* v. *Potter*, 1841, 1 Web.

Question is, Has essence of combination been adopted?

In *Flower* v. *Lloyd* (*d*), it was held by the Court of Appeal that in order to constitute an infringement of a patent for a combination, there must be an infringement of the whole combination, not in the sense that every step of the combination must be adopted, but that there must be an adoption of that which constitutes the essence of the combination.

In *United Telephone Co.* v. *Harrison* (*e*), the plaintiffs were the owners of a patent for improvements in electric telephones. In the instruments which they manufactured and sold, the plaintiffs used a diaphragm or tympan of mica to receive the air vibrations produced by the voice, under which was placed a piece of cork, and below the cork was a piece of platina foil. At the date of the plaintiffs' patent it was not known that the instrument would work without the independent mica diaphragm, but this was subsequently discovered. The defendants made and sold instruments similar to those manufactured under the patent, except that they dispensed with the mica diaphragm and the cork. It was held that they had infringed the plaintiffs' patent.

The cases just cited illustrate the law as to the infringement of a patent for a combination by the adoption and reproduction of its essential parts.

Colourable imitation or substitution of equivalents.

To take the substance of a combination will be not the less an infringement because it has been coloured or disguised by immaterial variations, or by the substitution for some parts of the combination, of mechanical equivalents (*f*).

Cases.

In *Hayward* v. *Pavement Light Co.* (*g*), the plaintiffs were owners of a patent for "Improvements in Pavement Lights," having for its object lights so constructed as to divert the rays of light in an inclined direction into the rooms which it is desired to light, by using glass moulded so as to consist of an angle or series of angles. The defendants used lights of glass moulded so as to

P. C. 586, 587; *Thorn* v. *Worthing Skating Rink Co.*, 1876, L. R. 6 Ch. D. 415, n.

(*d*) 1877, W. N. 132, and see *S. C. ibid.* 71; *Burnett* v. *Tate*, 1883, Johns. Pat. Man. 260; *Mason* v. *Goodwin*, 1889, 6 P. O. R. 235.

(*e*) 1882, 21 Ch. D. 720.

(*f*) *Dudgeon* v. *Thomson*, 1877, per Lord Cairns, C., 3 A. C. 43; cp. *Morgan* v. *Seaward*, 1836, per Alderson, B., 1 Web. P. C. 171; *Walton* v. *Potter*, 1841, 1 Web. P. C. 536; *Walton* v. *Bateman*, 1842, per Cresswell, J., 1 Web. P. C. 616; *Barrett* v. *Vernon*, 1877, 25 W. R. 343; *Heath* v. *Unwin*, 1845, 2 Web. P. C. 227; *Adair* v. *Young*, 1879; L. R. 12 Ch. at p. 21. In *Webster* v. *Utter*, 1824, Higgins, Dig., p. 385, an action for the infringement of a patent for an improvement on the patent percussion gun-lock, by the addition of a bolt, sliding or moving in a groove, by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer; the defendant's lock had a spring in the bolt, and the jury, upon the evidence of mechanics that a spring in a bolt was the same thing as a bolt sliding in a groove, found that there had been an infringement.

(*g*) 1884, 1 P. O. R. 207; *Hinde* v. *Osborne*, *ibid.* 221; 2 P. O. R. 64.

consist of a curve. It was held that the defendants had infringed the plaintiffs' patent.

In *United Telephone Co.* v. *St. George* (*h*), the plaintiffs were the owners of a patent claiming a combination for telephonic purposes of a diaphragm or tympan with electric tension regulators operating in a closed circuit. The defendant's instrument, which was alleged to be an infringement, consisted of a disc of carbonised leather behind a mouth-piece and a ball of carbonised wood, suspended by means of a flexible metallic conductor so as to rest lightly by gravity against the disc. The defendant denied the alleged infringement, and contended that his instrument did not contain either of the elements of the plaintiff's combination, and did not operate in a closed circuit. It was held that the defendant's disc was a diaphragm within the meaning of the specification; that the defendant's disc and ball were tension regulators covered by the specification; that the defendant's instrument did operate in a closed circuit; and that the plaintiffs were entitled to an injunction in the usual form.

In *Wenham Co.* v. *May* (*i*), the owner of a patent for improvements in gas lamps brought an action against M. & Co., alleging infringement and asking for the usual relief. The defendants denied infringement. The only material difference between their combination and that of the plaintiffs' was, that whereas in the plaintiffs' lamp there were gauze coverings placed in two distinct positions, and serving the purpose of moderating and equalising the currents of air, in the defendants' lamp there was only one gauze covering, which did not occupy precisely the same position as either of the two in the plaintiffs' lamp, but which, according to the evidence, answered the same purpose, although less effectively. It was held, that having regard to the evidence and to the fact that upon the specification the equalising of the currents by the gauze, rather than the exact position of the gauze, appeared to be the aim of the invention, the defendants' combination was an infringement of the plaintiffs'.

In *Ehrlich* v. *Ihlee* (*j*), the grantee of a patent for improvements in mechanical musical instruments brought an action for alleged infringement. The defendants denied infringement. It was held at the trial, that the plaintiff's combination was new; and that the

(*h*) 1886, 3 P. O. R. 321.
(*i*) 1887, 4 P. O. R. 303.
(*j*) 1888, 5 P. O. R. 437; *Winby* v. *Manchester, &c. Steam Tramways Co.*, 1889, 1890, 6 P. O. R. 365; 7 P. O. R. 30; *Shaw* v. *Jones*, *ibid.* 328; *Automatic Co.* v. *Combined Co.*, *ibid.* 120.

defendants had taken the same parts to perform the same functions, with the colourable variation of a rotating wind-chest and fixed music sheet, instead of the plaintiff's fixed wind-chest and rotating music sheet, and had therefore infringed. This decision was confirmed on appeal.

Mechanical equivalents.

Mechanical equivalents may not be an infringement where a patent is only for an improved method of attaining an old object.

Thus, in *Gosnell* v. *Bishop* (*i*), the owners of a patent for improvements in stretchers for trousers brought an action for alleged infringement. The defendants denied infringement. It was held that the defendants' stretchers, although obtaining the same result, obtained it by different means, and were a development beyond what was to be found in the plaintiffs' specification.

But a combination of known mechanical appliances and principles to attain a combination of results long sought for, but not previously obtained, in a machine in common use, is a new result, and the doctrine of mechanical equivalents applies in such a case.

This point was decided in *Thomson* v. *Moore* (*k*). The plaintiff, in 1876, patented improvements in the mariners' compass, the chief features of which were an exceedingly light compass card consisting of a narrow rim of thin paper, the central portion being cut away, and the outer circumference composed of a thin rim of aluminium, it and the card being kept in shape and connected with the central boss by fine silken radial threads in tension: the needles short and light, arranged in a horizontal plane a little beneath the card, and attached to it by light silk threads; the objects attained being—(1) diminution of friction, resulting in increased sensitiveness and accuracy; (2) small magnetic moment and consequent amenability to Airy's system of correctors; (3) long vibrational period, the magnetic moment being small, and a comparatively large proportion of the weight of the card being thrown to the periphery, securing steadiness in stormy weather. In 1885, the defendant, who had previously patented certain "improvements in the adjustments of the mariners' compass," one of the features of which was a new arrangement of correctors, constructed and sold a compass card, admittedly an infringement of plaintiff's patent, and proceedings having been instituted, he consented to a perpetual injunction. In 1888 the

(*i*) 1883, 5 P. O. R. 156.

(*k*) 1889, 6 P. O. R. 426.

Mechanical equivalents.

defendant constructed another card, resembling that of the plaintiff in—(1) extreme lightness; (2) smallness of needles and magnetic moment; and (3) length of vibrational period and consequent steadiness, the greater part of the weight being thrown to the periphery, as in the patented compass card; but differing from the card described in the plaintiff's specification in the following respects—(a) the circumference consisted of an L-shaped ring of aluminium, instead of a thin flat rim; (b) the centre portion in both cards was cut away, but defendant, instead of connecting it with the boss by silken spokes in tension, used flat parallel strips of aluminium; (c) the needles in both were short and light, but in defendant's card they were arranged in two vertical rows some distance below the card, and attached by aluminium wires, instead of silk threads. The same combination of results, viz., diminution of frictional error, steadiness, and amenability to correction, were obtained in both cards though not in the same degree. Defendant alleged that he disposed the needles in vertical rows, placed some distance below the card, in order to adapt the instrument to his own patented system of correctors, which he claimed was an improvement on plaintiff's patented arrangement. The plaintiff charged defendant's new card as a fresh infringement of his patent and a breach of the injunction, and moved for an attachment. It was held by the Master of the Rolls that the patent being for a new means of attaining an old and well-known object, viz., to produce a compass which would be steady and true under all circumstances, it was the case of a combination of known mechanical means for effecting a known improvement in an old machine, and that the doctrine of mechanical equivalents did not apply. The plaintiff having appealed, the Court of Appeal, reversing the order of the Master of the Rolls, held that the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration and small needles, so as to obtain a combination of results not previously obtained, viz., diminution of frictional error, steadiness and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied; that the question was whether there was a pith and substance of invention underlying the combination; and if so, has the defendant taken that pith and substance; that the defendant's card having obtained the same results by substantially the same means, agreeing in essentials with the plaintiff's patented card, and

differing only in non-essentials, it constituted a fresh infringement, and there must be an attachment (*l*).

In *Automatic Weighing Machine Co.* v. *Knight* (*m*), a new kind of weighing machine, wherein the introduction of a coin into the apparatus allowed the weight of the body to be weighed to be shown on the indicator, the machine acting automatically, was held not to be infringed by a weighing machine, in which the introduced coin raised an arm, and so enabled the person to operate a handle which set the machine in motion.

Sect. 4.—Chemical Processes and Products.

Chemical equivalents.

In those cases where a patentee has made some discovery in chemistry, any person may afterwards use for the same purpose chemical equivalents which were not known to be such at the time the patent was taken out (*n*).

Thus in *Heath* v. *Unwin* (*o*)—an action for the infringement of a patent for certain improvements in the manufacture of iron and steel—the specification described the invention as consisting in "the use of carburet of manganese in any process whereby iron is converted into cast steel." B. manufactured cast steel by placing oxide of manganese and carbonaceous matter into the pot at the same moment as the steel. Evidence was given that carburet of manganese would be formed by the combination of these substances before the steel was melted. They produced the same effect upon the steel as the carburet of manganese at a cheaper rate. This method of producing the effect was not known at the time of taking out the patent. It was held that this was a new invention and not an infringement of the patent.

Colourable evasions.

A servile imitation or a colourable evasion of a chemical process or product will, however, be treated as an infringement.

Thus, in *Stevens* v. *Keating* (*p*), an action for the infringement of a patent for the manufacture of cements, the specification

(*l*) Cp. *Automatic Weighing Co.* v. *International Hygienic Society*, 1889, 6 P. O. R. 475.

(*m*) 1889, 6 P. O. R. 113. Cp. *United Horse Nail Co.* v. *Swedish Horse Nail Co.*, *ibid.* 7; *Boyd* v. *Horrocks*, *ibid.* 152.

(*n*) *Badische Anilin Fabrik* v. *Levinstein*, 1883, per Pearson, J., 24 Ch. D. at p. 170; 1885, 2 P. O. R. 80, 92, 93.

(*o*) 1850, 5 H. L. C. 545; *Morewood* v. *Tupper*, 1855, 3 C. L. R. 717.

(*p*) 1847, 2 Web. P. C. 181. His lordship, however, said: If it had turned out that the defendants had, by the use of borax, produced a substance very superior indeed, I think it would have been a fair question for the jury to consider, whether that was a colourable imitation or evasion, or whether it was a person travelling in his own direction, and making discoveries in the field that was not closed against him. Cp. *Talbot* v. *La Roche*, 1854, 15 C. B. 310.

Colourable evasions.

stated the invention to consist in producing certain hard cements of the combination of the powder of gypsum, powder of limestone and chalk, with other materials, such combinations being (subsequent to the mixing) submitted to heat. The specification then described the method of making cement from gypsum, in the course of which alkali was to be used, and was to be neutralised with an acid, the result was to be subjected to heat. The patentee claimed "the processes of mixing the powdered materials, alkalies, and acids, as hereinabove described," &c. The defendant manufactured cement by combining gypsum with borax, and subjecting the whole to heat. It was in evidence that borax is composed of an acid and an alkali. It was held by Pollock, C. B., that there was sufficient evidence of infringement.

Again, in *Hancock* v. *Moulton* (*q*), on an application to the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanized or cured caoutchouc, alleged to be an infringement of the plaintiffs' patent, it appeared that this patent was for obtaining a certain useful product by subjecting a mixture of sulphur and caoutchouc to heat. The mixture was first made mechanically, and then by the operation of heat the character of the caoutchouc was changed, so that it ceased to be liable to stiffen from cold; it was not decomposed by heat, and it was improved in elasticity. The patent extended to the incorporation of sulphur, and of sulphur only, with the caoutchouc, by means of heat. The defendant subsequently obtained a patent for the combination of hyposulphate of lead with caoutchouc. That combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiffs' invention. Turner, V.-C.: "Assuming the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confine their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. But it was alleged by the plaintiffs that the materials were not in truth different, or at least that the materials which produce the result are the same. It was said that the hyposulphate and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that

(*q*) 1852, Johns. Pat. Man. 260.

those parts being decomposed by *heat*, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent."

Again, in *Muntz* v. *Foster* (*r*), an action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottom of ships," Lord Lyndhurst, C., said: "The analysis proves that that compound (the metal manufactured by the defendants) consists, not of ordinary copper and zinc, but of those minerals in their greatest purity, and in the proportions recommended in the plaintiff's specification. If they were originally combined in this state the evasion is plain and direct. If they were purified in the course of this process, this, I think, would constitute a colourable evasion of the plaintiff's invention."

A person who takes out a patent for an invention which consists in the use of certain proportions is not bound to limit his claim to those precise proportions, and a colourable variation in those proportions will be an infringement of his patent (*s*).

The use of chemical equivalents known to be such at the date of the patent, is an infringement even though it lead to improvements in the process (*t*).

(*r*) 1844, 2 Web. P. C. 95.
(*s*) *Patent Type Founding Co.* v. *Richards*, 1859, 1 Johns. 381.
(*t*) *Badische Anilin* v. *Levinstein*, 1885, 2 P. O. R. 92, 93.

CHAPTER XIV.

ACTION OF INFRINGEMENT.

SECT. 1. ORIGIN AND DEVELOPMENT OF ACTION OF INFRINGEMENT.

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SECT. 16. STAY OF EXECUTION.

SECT. 17. APPEALS.

SECT. 1.—ORIGIN AND DEVELOPMENT OF ACTION OF INFRINGEMENT.

Patent privileges worthless without legal remedies.

IT is evident that a privilege, such as that granted by a patent for an invention, would be worthless if the law did not provide some remedy for the patentee against those who may invade it. The right to any species of corporeal property may to a great extent be vindicated by the physical means at the command of the owner; but with respect to an incorporeal chattel right, such as a patent privilege, which is a mere creature of the law, the proprietor must

Vindication of patent privilege entirely dependent upon the law.

depend almost entirely upon the law itself for vindication and support (*a*).

The infringement of patent rights was a wrong for which neither the common nor the early statute law of England provided any remedy (*b*).

Star Chamber.

It was, however, cognizable by the Court of Star Chamber, either as a contempt of the royal authority (*c*), or under its general jurisdiction for the repression of "cozenage," which is defined as "an offence whereby anything is done guilefully in or out of contracts which cannot fitly bee termed by any speciall name," and was punished summarily and with severity. Thus, "apprentices or servants of the patentee attempting to reap the fruits of his ingenuity . . . . were to be treated as 'first rogues, and then whipped'" (*d*).

Its jurisdiction objectionable.

The jurisdiction of the Star Chamber over the infringers of patent rights was objectionable, not only on account of its severity, but because it supported any grant which the Crown thought fit to make, and considered every infringement of letters patent as a contempt.

Monopolies to be tried at common law.

The second section of the Statute of Monopolies provided that all questions affecting the force or validity of letters patent, should be heard, tried, and determined in the Courts of common law, according to the common laws of the realm, and not otherwise. An action at law was then declared and recognized to be the proper remedy for the infringement of patent rights.

Public feeling against monopolies formerly extended to patents.

"In former times slight defects were held sufficient to avoid patents, and our Courts seemed always to look upon patent rights with the utmost jealousy. This feeling against patentees was doubtless produced by the widely spread and deeply rooted aversion to all monopolies, which was engendered by the monstrous oppression practised by means of patent grants previous to the passing of the Statute of Monopolies. That statute completely suppressed all unlawful grants, and most effectually guarded the rights of the public against illegal monopolies; but notwithstanding the securities which the statute provided for the public against illegal monopolies, it is singular enough that a period of two centuries should have elapsed before the public prejudices against grants of patent privileges to inventors disappeared, and before the judges began to

Statute of Monopolies suppressed illegal grants.

Two centuries required to extinguish public feeling against patent privileges.

(*a*) Hindmarch, p. 248.
(*b*) Coryton, 262.
(*c*) Webster, Letts. Pat. p. 42, n. (*y*).
(*d*) Coryton, *ubi supra*, and authorities there cited.

determine questions respecting patent rights fairly between the patentees and the public (*g*).

Patents formerly failed chiefly by reason of insufficient specifications.

"If the reported patent cases which have been decided in our Courts of law are examined, it will be found that in a great majority of those which were formerly determined against patentees, the parties failed to support their patents on the ground of the insufficiency of their specifications. And, indeed, if we look at the vague and meagre descriptions of their inventions which patentees were formerly in the practice of inserting in their specifications, we cannot be surprised that our Courts should have held that those instruments did not sufficiently comply with the conditions or provisoes contained in patents by which they are required to be enrolled (*h*).

Specifications formerly very imperfect.

Specifications now much more perfect.

"But the decisions of our Courts avoiding patents on the ground of insufficient specifications, have been productive of great benefit to the public, and, indeed, to patentees themselves. For specifications are now drawn in a manner much more perfect than they were formerly, (although there is still room for very considerable improvement,) and consequently not only are the public now more frequently put in possession of the information they are entitled to receive, but patentees much less frequently fail to support their patents on the ground of the insufficiency of their specifications" (*h*).

Questions between patentee and public now fairly determined.

In the case of *Cartwright* v. *Eamer* (*i*), Lord Eldon said:—"The patent is to be considered as a bargain with the public, and the specification, therefore, is to be construed on the same principle of good faith as that which regulates all other contracts. If, therefore, the disclosure be such that the invention can be communicated to the public, the statute is satisfied."

"Our Courts," wrote Hindmarch (*g*), in 1846, "now universally adopt the principle laid down by Lord Eldon . . . . and accordingly any question which may now arise respecting the validity of a patent for an invention, will be determined fairly and impartially between the parties in litigation, and without any strained or strict construction being put upon the law, or patent, in favour of or against either party."

Damages at common law

In addition to an action at law, which was in form an action on the case for damages, the owner of an invaded patent was entitled

(*g*) Hindmarch, p. 249.
(*h*) *Ibid.* p. 250.
(*i*) 1800, cited 14 Ves. 131, 136.

to bring a suit in equity against the infringers of his privilege. A Court of law could only give the patentee damages for any actual injury he had sustained by the violation of his rights, and had neither power to prevent future infringements, nor any adequate machinery by which the full extent of the particular infringement complained of could be ascertained.

Action against infringers.

Fuller remedy in equity Courts.

But the Court of Chancery, by means of its process of injunction, *could protect the patentee against the future invasion of his privilege.* It could command a person who had once violated a patent right to refrain from committing any repetition of the offence, on pain of rendering himself liable to be punished by attachment, and imprisonment for contempt at the discretion of the Court (*k*).

Injunction in Chancery.

Again—and here the language of Hindmarch (*l*) may once more be quoted—"the infringement of a patent is generally committed in secret, or, at all events, under such circumstances as to preclude the possibility of procuring sufficient legal evidence of the extent of the infringement. There is in consequence very much difficulty in the way of procuring evidence of a violation of the patent by a suspected person, and it would be almost impossible in any case to show by legal evidence in a Court of law, the full extent of the injury which the patentee has sustained by the infringement of his patent. But a Court of Equity has the power, not possessed by a Court of law, of compelling a defendant to answer on oath the complaint made against him by the plaintiff's bill, and to make a full discovery of everything which is necessary to enable the Court to do justice between the parties."

Discovery in equity.

The history of this equitable jurisdiction is curious and instructive. The privilege conferred by a patent was a legal right, of which the force and validity might, under the second section of the Statute of Monopolies, be determined in the Courts of Common Law alone. Equity followed the law, and, according to the strict theory of this maxim, could claim no independent jurisdiction in respect of the privilege, or the infringement of the privilege created by letters patent (*m*). But the Court of Chancery could, and did, interfere on principles similar to those which determined its action in cases of nuisance, breach of contract, waste, the invasion of copyright, or the property in trade secrets or trade marks, to protect

How Court of Chancery obtained jurisdiction.

(*k*) Hindmarch, p. 306.
(*l*) *Ibid.*
(*m*) *Calcraft* v. *West*, 1845, 2 Jones & Lat. 128.

the property of the patentee until his legal right could be ascertained by the jurisdiction to which it properly belonged (*n*).

Previous trial at law was at first necessary.

The Court of Chancery at first exercised its jurisdiction in aid only of a patentee whose legal right was clear and undoubted, and refused to enforce a claim under letters patent, or a charter from the Crown, until it had been tested by an action at law (*o*). This principle of action itself became in turn a maxim of equity, "and in process of time a fictitious inability was the cause on which it founded its refusal to decide questions involving the validity of the grant, the claim of the plaintiff to the property it conferred, and the fact of infringement" (*p*).

Development of jurisdiction.

Gradually, however, the Court of Chancery abandoned this position, and assumed the attitude which it maintained till the fusion of law and equity by the Judicature Acts deprived the question of its practical importance. In *Hicks* v. *Raincock* (*q*), a demurrer to a bill for an injunction to stay the infringement of a patent right on the ground that the plaintiff had not established his title at law, was overruled: and in *Newman* v. *Milner* (*r*), it was said by the Lord Chancellor never to be the right of a defendant to have a case transmitted for trial at law, but that where the title of the party was clear a Court of Equity would act without a reference; and in *Wilson* v. *Tindal* (*s*), Lord Langdale, M. R., said that he had no doubt whatever as to the competency of the Court of Chancery to grant an injunction simpliciter.

But the early reluctance of the Court of Chancery to interfere in cases of disputed patent right had its justification in reason as well as in the maxim of equity.

"Before a patent privilege," says Hindmarch (*t*), "has been established by a verdict, the title of the patentee depends entirely upon his patent, *which he has obtained by means of his own ex parte and unsupported representations to the Crown*, and that circumstance

(*n*) *Harman* v. *Jones*, 1841, per Cottenham, L. C., 1 Cr. & Ph. 299; *Sparrow* v. *Oxford, Worcester and Wolverhampton Rail. Co.*, 1851, 9 Hare, 441.

(*o*) *Blanchard* v. *Hill*, 1742, 2 Atk. 484. "If one who has letters patent for an invention files a bill for an injunction to restrain another from pirating his invention, he must state in his bill that he has brought his action at law and so established his right by a good verdict, or a demurrer to his bill for want of equity shall be sustained": Old MSS., cited 2 Coop. C. C. 61, n.

(*p*) Coryton, p. 320. See Fonb. Eq. 43.

(*q*) 1715, 2 Dick. 647; cp. *Sollau* v. *De Held*, 1851, 2 Sim. N. S. 133, and cases there cited.

(*r*) 1794, 2 Ves. jun. 486.

(*s*) 1841, 1 Web. P. C. 730, n. (*a*); cp. *Universities of Oxford and Cambridge* v. *Richardson*, 1802, 6 Ves. 689.

(*t*) Page 307.

alone would induce a Court of Equity to give a defendant a proper opportunity of testing the validity of the patent in a Court of law."

We find accordingly that, while asserting its right to act independently of references to law, the Court of Chancery still continued to display its original caution in granting injunctions.

Principles upon which Court of Chancery granted injunctions.

The considerations which guided its decisions cannot be better stated than in the language of Lord Eldon: "Where the Crown on behalf of the public grants letters patent, the grantee entering into a contract with the Crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under colour of the patent, the Court has held that, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard that the grant of the Crown may in the result prove to have been valid" (*u*). "But where the patent is but of yesterday, and upon an application being made for an injunction *it is endeavoured to be shown* in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not from its own notions respecting the matter in dispute act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law and oblige him to establish the validity of his patent in a Court of Law, before it will grant him the benefit of an injunction" (*x*).

Long possession of patent right.

Validity of recent patent must first be established at law.

Act of 1852.

The Patent Law Amendment Act, 1852, made the first advance towards the fusion of law and equity.

Injunction, inspection and account at common law under Act of 1852.

Sect. 42 of that statute provided, that "in any action in any of her Majesty's Superior Courts of Record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not sitting then for a judge of such Court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such injunction, inspection, and account, and the proceedings therein respectively, as to such Court or judge may seem fit."

But limited

Although it was held in the judicial construction of this

(*u*) *Harmer* v. *Playne*, 1807, 14 Ves. 130; cp. *Bridson* v. *McAlpine*, per Lord Langdale, M. R., 1846, 8 Beav. 229.

(*x*) *Hill* v. *Thompson*, 1817, 3 Mer. 622.

view of these powers taken.

statute (*y*), that "the intention of the legislature was to vest in the Courts of common law the power to order an injunction, inspection and account (theretofore) exclusively possessed by Courts of equity," a plaintiff does not seem to have been enabled to obtain such full relief from the Courts of law as he might have in equity (*z*). Thus it was decided in *Gittins* v. *Symes* (*a*), that the injunction which a Court of law might grant under 15 & 16 Vict. c. 83, s. 42, was, like the injunction under the 82nd section of the Common Law Procedure Act, 1854, a rule to show cause only, in the first instance: and in *Vidi* v. *Smith* (*b*), that "inspection" meant an inspection of the instrument or machinery manufactured or used by the parties with a view to evidence of infringement, and did not refer to an inspection of books.

The fusion of Law and Equity under Judicature Act, 1873.

Under the Judicature Act, 1873, the jurisdiction formerly exercised by the Courts of common law and equity is transferred to the High Court of Justice (sect. 16); and it is provided generally that in all matters "in which there is any conflict or variance between the rules of equity and the rules of the common law with reference to the same matter, the rules of equity shall prevail" (sect. 25, sub-sect. 11).

Act of 1883, s. 30.

The Patents Act, 1883, s. 30, provides that "in an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit."

Without entering for the present into a minute examination of this section, it may be stated generally that each division of the High Court has now the fullest powers of making orders for injunction, inspection, or account whenever it shall think proper so to do; and this jurisdiction may be exercised by any judge of the High Court (*c*), either on application in Court or on summons at Chambers (*d*).

(*y*) *Patent Type Founding Co.* v. *Lloyd*, 1860, per Martin, B., 5 H. & N. 198; cp. *Holland* v. *Fox*, 1854, 23 L. J. Q. B. 357; 3 E. & B. 977.

(*z*) Lawson, p. 189.

(*a*) 1854, 24 L. J. C. P. 48; 15 C. B. 362.

(*b*) 1854, 23 L. J. Q. B. 342; 3 E. & B. 969; cp. *Patent Type Founding Co.* v. *Lloyd*, and *Patent Type Founding Co.* v. *Walter*, *ubi supra*.

(*c*) *Beddow* v. *Beddow*, 1878, L. R. 9 Ch. D. 89; *Thomas* v. *Williams*, 1880, L. R. 14 Ch. D. 864; *Quartz Consolidated, &c. Co.* v. *Beall*, 1878, L. R. 20 Ch. D. 501.

(*d*) *Frearson* v. *Loe*, 1878, 26 W. R. 138.

Sect. 2.—Commencement of Action.

(1.) *General.*

Provisions of Act of 1883, sects. 13, 15.

Under the Patents Act, 1883 (*e*), a patentee cannot take proceedings in respect of infringements committed before the publication of his complete specification, *and* until letters patent have actually been granted to him; and "if any proceeding shall be taken in respect of an infringement of the patent, committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement" (*f*).

Several infringers.

Besides the question as to whether any of these statutory limitations apply to his case, a patentee has frequently to consider how he ought to act when his patent is being infringed by several persons at the same time. Under these circumstances, the patentee has several difficulties to face and to choose between. He may take proceedings against one infringer successfully, but the others are not bound by the issue of such an action, and the consequence is that the patentee may have to establish his case from the beginning against any fresh person who chooses to impugn the patent and to contest its validity upon the same or different grounds (*g*), besides laying himself open to a charge of laches (*h*). Upon the other hand, even if he proceed by separate action, against the several infringers at the same time, he may still have to defend the validity of his patent in a number of distinct proceedings, in each of which it is impeached upon different grounds; and he will also render himself liable to a charge of vexatious and oppressive litigation.

In the case of *Bovill* v. *Crate* (*i*), Wood, V.-C., suggested a way out of these difficulties:—

Best manner to proceed where several infringers.

"After getting information of case after case of infringement (the patentee) might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write, at the same time, to all the others who were *in simili casu*, and say to them: 'Are you willing to take this as a notice to you that the present case is to

(*e*) Sects. 13 and 15.
(*f*) Sect. 17, sub-sect. 4 (b).
(*g*) *Bovill* v. *Goodier*, 1865–67, per Romilly, M. R., L. R. 2 Eq. p. 199.
(*h*) *Bridson* v. *Benecke*, 1849, 12 Beav. 1; *Bovill* v. *Crate*, 1865, L. R. 1 Eq. 388.
(*i*) 1865, L. R. 1 Eq. at p. 391.

determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once.'"

No notice of action necessary.

A plaintiff is entitled to apply for an injunction, and to have his costs as soon as his legal right is invaded, although unintentionally; and he is under no obligation to give the defendant any notice before commencing an action (*k*), or to discontinue proceedings upon the defendant admitting and promising not to repeat the infringement (*l*).

In the case of *Nunn* v. *D'Albuquerque* (*m*), the defendant had, in ignorance, infringed the plaintiff's patent, but submitted and offered before suit to pay the amount of profits made, which were very trifling. At the hearing, although a perpetual injunction was granted, no costs were given, and an account was granted only upon the plaintiff's request, and at his peril.

(2.) *Parties.*

(a) *Plaintiffs.*

Legal and equitable titles.

There was formerly a difference between the rules of law and equity with respect to the parties to proceedings for the infringement of patent rights. In an action at law no one could be plaintiff unless he was either a patentee, or could show a legal title of assignment to the whole or a part of the patent privilege; while, in the Court of Chancery, a person might be made a plaintiff, or co-plaintiff, when he had any equitable interest in the patent privilege, although such interest did not amount to a legal title (*n*).

Equity rules now prevail.

The rules of equity, however, now prevail, and all parties claiming any interest, legal or equitable, in the patent, if they do not join as co-plaintiffs, may, and ought to, be made defendants to the action, so that the infringing defendants may not be called upon to account twice, first to the plaintiff, and then to the persons who claim an interest in the patent (*o*).

(*k*) *Cooper* v. *Whittingham*, 1880, L. R. 15 Ch. D. 501; *Upmann* v. *Forester*, 1883, 24 Ch. D. 231; *Goodhart* v. *Hyett*, 1883, 25 Ch. D. 182; *United Telephone Co.* v. *London, &c. Telephone Co.*, 32 W. R. 870; *Nicols* v. *Pitman*, 1884, 26 Ch. D. 374; *Wittman* v. *Oppenheim*, 1884, 27 Ch. D. 260; 28 S. J. 499; *Upmann* v. *Elkan*, 1871, L. R. 12 Eq. 146; *Burgess* v. *Hills*, 1859, 26 Beav. 244, 247; *Burgess* v. *Hately*, 1859, 26 Beav. 249; *Edelsten* v. *Edelsten*, 1863, 1 D. J. S. 203; *Davenport* v. *Rylands*, 1866, L. R. 1 Eq. 305.

(*l*) *Losh* v. *Hague*, 1837, 1 Web. P. C. 200; *Geary* v. *Norton*, 1846, 1 De G. & S. 9; *Proctor* v. *Bayley*, 1889, 6 P. O. R. 106.

(*m*) 1865, 34 Beav. 395.

(*n*) Hindmarch, 308.

(*o*) *Westhead* v. *Keene*, 1838, 8 L. J. Ch. 89; 2 Web. P. C. 36, n.; 1 Beav. 287; *Bergmann* v. *MacMillan*, 1881, 17

Assignees.

An action for infringement may be brought by the assignees of the patent infringed (*p*).

Assignee of bankrupt.

The assignees of a bankrupt patentee may bring it (*q*).

Assignee of part of a patent.

It is competent to the assignee of a separate and distinct portion of a patent to sue for an infringement of that part without joining one who has an interest in another part—the damages to be recovered in the action accruing to the former alone. In delivering judgment in the case in which this principle was laid down (*r*), Erle, C. J., said: "It is every day practice, for the sake of economy, to include in one patent several things which are in their nature perfectly severable and distinct. It is also every day practice to get rid of, by disclaimer, part of a patent which turns out to be old. Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part, which is the subject of infringement, may not maintain an action. Then, are the assignees bringing an action for an injury done solely to them by an infringement of that part of the patent which is thus vested in them alone, liable to be defeated because they have not joined the assignees of other parts of the patent, who have no manner of interest in the damages sought to be recovered in such action? I see no reason why the action should be defeated on any such ground. I see no reason why the plaintiffs should be put to the trouble and expense of applying for leave to use the names of the other parties, or of compelling them, by means of a judge's order, to permit their names to be used upon an indemnity, where no practical advantage whatever is to be gained by it, the injury being to the assignees of part only, and the damages to be recovered being theirs only."

Survival of action to survivor of tenants in common.

Where one of two persons, who are tenants in common of a patent assigned to them, dies, actions for infringements committed during his lifetime survive to the other, who is entitled at law to recover the whole damages (*s*).

Assignee may

The assignee of a patent may maintain an action for an infringe-

Ch. D. 423, per Fry, J.: "I do not for one moment say that a person who has obtained an assignment of a share of profits is not entitled to an account of profits from the person by whom they are payable. But in my judgment, in order to avoid multiplicity of actions, the account must be taken once for all in the presence of all the parties interested." See also *Van Gelder* v. *Sowerby Bridge Flower Society*, 1890, 7 P. O. R. 41.

(*p*) *Electric Telegraph Co.* v. *Brett*, 1851, 20 L. J. C. P. 123; 10 C. B. 838.

(*q*) *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169.

(*r*) *Dunnicliff* v. *Mallett*, 1839, 7 C. B. N. S. 209, 227.

(*s*) *Smith* v. *L. & N. W. Rail. Co.*, 1863, 2 E. & B. 69.

sue original grantee.

ment, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee; and the action is maintainable although there has been no infringement since the defendant has received notice that the entire interest in the patent has become vested in the assignee (*u*).

In *Walton* v. *Lavater* (*u*), from which the last proposition is taken, the facts were these: The defendant assigned one moiety of his patent to the plaintiff, and the remaining moiety to other parties, D. and G., who subsequently assigned their share to the plaintiff. It was contended that the assignee of two separate moieties of a patent was not entitled to sue for an infringement in the same manner as he would have been if he had taken the whole interest in the patent under one assignment; but the Court of Common Pleas overruled this contention. "We are of opinion," said Erle, C. J., "that the assignment to the plaintiff of that partial interest . . . . made the plaintiff in effect tenant in common with the defendant of the interest of the patent, and that the defendant, having afterwards assigned the remaining moiety to D. and G., when D. and G. assigned to the plaintiff . . . . the plaintiff became assignee of the whole patent, as if the original assignment to him from the defendant had comprised the whole."

It must be noted that the decision in *Walton* v. *Lavater* applies only to the case of letters patent which are separable into parts, and the balance of authority is against the right of an assignee of a share in the profits of a patent for an invention which is one and indivisible to sue alone for the infringement of the privilege (*x*).

Mortgages by way of assignment.

In the case of *Van Gelder* v. *Sowerby Bridge Flower Society* (*y*), the owners by assignment of a patent mortgaged it to various persons by way of assignment, and subsequently brought an action against S. for infringement without joining as parties their mortgagees, whose mortgages were all entered on the Register of Patents. At the trial S. took the preliminary objection (duly raised by his defence) that the plaintiffs were not the proprietors of the patent, and were not entitled to sue alone. Kekewich, J., held that the objection was good, and on the plaintiffs asking for leave to amend, ordered that they should pay the costs thrown away in any event, and should have leave to make an

(*u*) *Walton* v. *Lavater*, 1860, 8 C. B. N. S. 162. See *Anderson* v. *Patent Oxonite Co.*, 1886, 3 P. O. R. 279. As to the position of the general agent of foreign owners of an English patent, see *Adams* v. *N. B. Rail. Co.*, 1873, 29 L. T. N. S. 367.

(*x*) *Smith* v. *L. & N. W. Rail. Co.*, 1853, 2 E. & B. 69; *Bergmann* v. *McMillan*, 1881, 17 Ch. D. 423; *contra*, *Sheehan* v. *G. E. Rail. Co.*, 1880, per Malins, V.-C., 16 Ch. D. at p. 62.

(*y*) 1890, 7 P. O. R. 41.

application by a given date to amend, by addition of parties, subject to such terms as the Court should think fit to impose (*z*).

How far licensee entitled to sue for infringement.

There is still considerable difficulty in determining the question, how far the mere licensee of a patent privilege is entitled to sue for infringement. In the case of *George* v. *Beaumont* (*a*), Lord Eldon said: "If the patents should be determined good, damages might be recovered not only by the patentees, but by the persons who have obtained licences from them." This dictum is cited by Mr. Webster (*b*) as an authority for the proposition that "a licensee would be able to recover for any *special* damages which he may have sustained," and if this be the correct interpretation, it is not inconsistent with the law laid down in *Derosne* v. *Fairie* (*c*) and *Newby* v. *Harrison* (*d*), that a mere licensee can maintain no action alone for an infringement of the patent of which he has a licence. The principle of these decisions is this: The only right which a mere licensee can acquire under letters patent is a right of user. The patentee may grant licences to other persons, and consequently an infringement is an injury to himself and not to the licensee.

Exclusive licensee.

In *Renard* v. *Levinstein*, there is some authority for the statement that an exclusive licensee can sue for infringement of the patent, of which he has an exclusive licence, alone; but in that case the owner of the patent was made a defendant in the action (*e*). In *Plimpton* v. *Malcolmson* (*f*), Jessel, M. R., held that the patentee had better be added as co-plaintiff; and this course has been adopted in subsequent cases (*g*). In *Heap* v. *Hartley* (*h*), the patentee of a machine granted an exclusive licence to the plaintiff to use and exercise his invention within a certain district for four years. Before the expiration of the four years certain machines bought by the defendants outside this district, from persons who had purchased them from the patentee, also outside the district, subsequently to the date of the licence, were taken by them into the district, and used there. The licensee brought an action to restrain such user. It was held, at the trial, that the defendants, as purchasers without notice, were not affected by the prior grant

(*z*) The consent of the mortgagees to be joined as plaintiffs having been withheld, the action was dismissed, with costs on the higher scale: *ubi supra*, at p. 46.

(*a*) 1815, 27 Rep. Art. 2nd Ser. 252.

(*b*) Letts. Pat. p. 24, and n. (*o*).

(*c*) 1835, 1 Web. P. C. 155.

(*d*) Before Lord Campbell, cited 2 H. & M. 628.

(*e*) *Renard* v. *Levinstein*, 1864-65, 2 H. & M. 628, 631.

(*f*) 1875, 3 Ch. D. 531.

(*g*) *Plimpton* v. *Spiller*, 1876-77, Goodeve, P. C. 380; *Barnett* v. *Screw Stopper Bottling Co.*, 1884, 1 P. O. R. 9.

(*h*) *Heap* v. *Hartley*, 1888, 5 P. O. R. 603; 1889, 6 P. O. R. 495; 42 Ch. D. 461.

of the licence, and that the action must be dismissed with costs. Whether an action by an exclusive licensee in his own name, and without joinder of the patentee, to restrain an infringement of his rights under the licence, can be maintained, was held doubtful. The plaintiff appealed. The Court of Appeal held that the licence in this case being a simple licence and not a grant, the licensee was not entitled to sue in his own name without joinder of the patentee. "An exclusive licence," said Fry, L. J. (*i*), "is only a licence in one sense. . . . It is a leave to do a thing, and a contract not to allow anybody else to do a thing. But it confers, no more than any other licence, any interest or property in the thing. A licence may be, and often is, coupled with a grant, and that grant then may convey an interest in property, but the licence pure and simple, and by itself, never conveys an interest in property. It only enables a person to do lawfully what he could not otherwise do, except unlawfully. I think, therefore, that an exclusive licensee has no title whatever to sue."

Upon the other hand, there appears to be no doubt that a patentee who has granted an exclusive licence merely of his patent, and not an absolute assignment can bring an action of infringement in his own name without joining his licensee as co-plaintiff.

Trustee.

A person in whom letters patents are vested as trustee may bring an action for infringement without joining any of the beneficiaries; but the Court or a judge may at any stage of the proceedings order any of such persons to be made parties, either in addition to or in lieu of the previously existing parties (*k*).

(b) *Defendants.*

The defendants.

The actual infringer of a patent is, of course, a necessary defendant to an action for infringement.

In *Denley* v. *Blore* (*l*), it was held that the person physically using a patented invention, and not the person giving instructions and plans, which include its use, is the proper party to be sued for infringement; the contractor, for instance, and not the architect, in the case of a contrivance employed in house-building.

This decision, however, in no way affects the common law liability of a master for the acts of his servants.

(*i*) *Ubi supra*, at p. 501; 42 Ch. D. at p. 470.

(*k*) R. S. C. 1883, Ord. XVI. r. 8.

(*l*) 1851, 38 Lond. Jour. 224.

Master liable for infringements of his servants.

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding that such infringement may be in contravention of their general orders (*m*).

In an action to restrain the infringement of a patent for "improvements in fancy rollers of machines for carding wool," it appeared that a contract to clothe the rollers of a carding machine, in the execution of which the infringement complained of was committed, was carried out by a workman, selected by a manufacturer, but paid by the defendants. It was held, that the workman, although carrying on a distinct and separate trade, was *ad hoc* the agent of the defendant, and that the latter was properly sued for the infringement (*n*).

Although the ordinary form of injunction against a master or principal restrains his servants or agents also, every one of such servants or agents infringing a patent may be made a defendant to the action, and personally and individually may be made to pay the costs of it, and it is no justification for him to say that his master ordered him to do it (*o*).

A fortiori, the master of a ship, who is not a mere agent, but has a possession and control of a particular nature, may be sued as principal if he uses a patented invention on board the ship to the prejudice of the patentee (*p*).

Custom House agents.

In the case of *Nobel's Explosives Co.* v. *Jones* (*q*), the plaintiff charged that the defendants had imported and delivered, or had consigned to them, or had received or dealt with as owners, or as agents for the owners, large quantities of lithofracteur, and had transhipped the same, or caused the same to be transhipped and stored in the port of London. Defendants pleaded that their only intervention in relation to lithofracteur since the assignment of the patent to the plaintiffs had been in acting as custom-house agents to Messrs. Krebs & Co., the real owners of such lithofracteur. The defendants had merely obtained papers necessary for its transhipment, and never exercised over it any ownership or control. It was held by the Court of Appeal and the House of Lords—reversing the decision of Vice-Chancellor Bacon—that the agency of the defendants did not infringe the patent. "This

(*m*) *Betts* v. *De Vitré*, 1868, L. R. 3 Ch. 441. Where a company is formed for working a patented machine, it is *ultra vires* to purchase the patent. *Re British and Foreign Cork Co.*, 1865, L. R. 1 Eq. 231.

(*n*) *Sykes* v. *Howarth*, 1878, 12 Ch. D. 826.

(*o*) *Betts* v. *De Vitre*, 1868, per Wood, V.-C., 11 Jur. 11; *Betts* v. *Neilson*, 1868–71, 6 N. R. 221; *Barker* v. *Shaw*, 1823, Holr. Pat. 60.

(*p*) *Adair* v. *Young*, 1879, per Cotton, L. J., 12 Ch. D. at p. 18.

(*q*) 1880–82, L. R. 17 Ch. D. 721; 8 App. Cas. 5.

agency," said Lord Selborne, L. C. (*r*), "was simply to remove certain legal difficulties in the way of the passage of the goods for the ship in which they were—for the account and at the risk of the true importers, Krebs & Co.—into a lighter of theirs supplied by them, and nothing whatever was done by the defendants except to comply with certain provisions of the law for that purpose." "Jones & Co.," added Lord Blackburn (*s*), . . . "never used the article itself; they did nothing whatever except take steps to remove two obstacles which were imposed by the Legislature, not for the benefit of the patentee, but in one case against a breach or infringement of the revenue laws, and in the other case that the article would explode and do mischief. How, in any sense, taking those steps to remove these two obstacles can be said to be a user of the patent has never been made clear to my mind. I am quite clear that it is not."

Purchasers of infringing articles.

An account directed against the manufacturer of a patented article does not license the use of that article in the hands of all the purchasers. The patent is a continuing patent, and the article may be followed into every man's hand, until the infringement is got rid of. So long as the article is used there is continuing damage (*t*). A manufacturer, and purchasers from him, may be made defendants in one action (*u*), and the patentee may have an account of profits against the manufacturer, and damages against the purchaser (*x*).

Third parties.

In the case of *Edison and Swan Co.* v. *Holland* (*y*) an interesting point was raised as to the construction of the third party rule (*z*).

The E. Company brought an action against H. and the J Company for infringing their patent by using certain incandescent lamps. The lamps were manufactured by the B. Company. *After the commencement of the action*, the defendants obtained an indemnity from the B. Company, and then took out a summons asking for leave to issue a notice to the B. Company to bring them into the action under the third party rule. It was contended that the third party rule did not enable the defendant in an action to go and make a contract of indemnity with reference to that particular action, and then bring the indemnifying parties in,

(*r*) *S. C.*, 8 App. Cas. at p. 8.
(*s*) *S. C.*, 8 App. Cas. at p. 13.
(*t*) *Penn* v. *Bibby*, 1866, L. R. 3 Eq. 308, per Wood, V.-C.
(*u*) *Proctor* v. *Bennis*, 1887, 36 Ch. D. 740.
(*x*) *Penn* v. *Bibby*, *ubi supra*.
(*y*) 1886, 3 P. O. R. 396-7; *United Telephone Co.* v. *Fleming*, 1885, 2 P. O. R. 263.
(*z*) R. S. C. 1883, Ord. XVI. r. 46.

but that the rule only contemplated an indemnity existing at the time of the commencement of the action. Vice-Chancellor Bacon, however, repelled this objection. "The policy of the law expressed in the rule," said his lordship, "is plainly this: that if A. is suing B., and B. denies his right to sue, B. says 'Even if he is entitled to sue, C. has indemnified me. Let him come here and fight his own battle, or help me to fight mine!' The object of the procedure is that there may be a discussion and a decision once for all of the real substance of the dispute. It is clearly right to issue the summons; there is no doubt about it. To go into the nature of the indemnity would be a most idle and absurd thing for me to do. The rule is enough; the rule is plain. . . . To say that it cannot be resorted to because the indemnity is in truth subsequent to the date of the issuing of the writ, can be no sort of objection to it. Whatever change takes place in the rights of the parties may be set right either by amendment or by adding parties. That is the constant and uninterrupted course of the Court."

In the case under consideration, Kay, J., ultimately made the following order, directing the costs of the proceedings to be costs in the action:—

"The B. Company, by their counsel, admitting their liability to indemnify the defendants against all claims of the plaintiffs in this action, the Court doth direct that the B. Company be at liberty to appear at the trial of this action, and take such part therein as the judge shall direct. And the B. Company shall be bound by the decision of the Court in this action in any question as to the above indemnity which may arise between them and the defendants, but not further or otherwise."

At the trial, the Court gave judgment partly in favour of plaintiffs and partly in favour of the defendants, but made no special order as to B., the third parties. The plaintiffs appealed, and their appeal was allowed with costs against the defendants. The plaintiffs then asked for an injunction and costs against the third parties, the B. Company (who had appeared on the appeal), and, if necessary, for an order to amend, so as to make them defendants. The Court disagreed as to the question of amendment, but held that under Ord. XVI. r. 54, the Court had jurisdiction to order the third parties to pay the costs both of the appeal and below, and that, as the third parties had in reality fought the plaintiffs and

failed, an order for the payment of such costs must be made against them as well as against the defendants (*a*).

Infringement by foreigners.

Foreign sovereigns.

Foreigners coming into this country are subject to actions for injuries done by their infringing on the sole and exclusive right granted by the Crown to patentees of inventions (*b*); but no Court in this country can deprive a foreign sovereign of his property because it has become tainted by the infringement of somebody's patent (*c*).

Caldwell v. Van Vlissingen.

P. and others, who were subjects of the King of Holland, were using on board their ships, within the dominions of England, a screw propeller made according to an English patent assigned to C. It was held by Turner, V.-C., that the infringement might be restrained by injunction, and that the defendants were liable to an action for damages. "I take the law to be universal," said his lordship, "that foreigners are in all cases subject to the laws of the country in which they may happen to be. . . . It was said that the prohibitory words of the patent were addressed only to the subjects of the Crown; but these prohibitory words are in aid of the grant, and not in derogation from it, and they were probably introduced at a time when the prohibition of the Crown could be enforced personally against parties who ventured to disobey it. The language of this part of the patent does not, therefore, appear to me to alter the case" (*b*).

But for the existing provisions as to *foreign vessels*, see pp. 220 and 496.

Varasseur v. Krupp.

In *Varasseur* v. *Krupp*, it appeared that certain shells, alleged to have been made in accordance with the plaintiff's patented invention, had been purchased at *Essen*, in Germany, and had been brought to England, in order to complete the armament of three ships of war, which were being constructed for the Government of Japan. An injunction, restraining the defendants and the owners of the wharf where the shells were deposited from delivering them up to the Japanese Government, was dissolved, upon a motion on the part of the Mikado; and an order was made by Jessel, M. R., whose decision was affirmed by the Court of Appeal, that his Imperial Majesty should be allowed to remove the

(*a*) *Edison and Swan Co.* v. *Holland*, 1889, L. R. 41 Ch. D. 28; 6 P. O. R. 286. Rule 54 of Ord. XVI. is as follows:—'The Court or a Judge may decide all questions of costs as between a third party and the other parties to the action, and may order any one or more to pay the costs of any other or others, or give any direction as to costs as the justice of the case may require.

(*b*) *Caldwell* v. *Van Vlissingen*, 1851, 21 L. J. (N. S.) Ch. 97; 9 Hare, 415.

(*c*) *Varasseur* v. *Krupp*, 1878, L. R. 9 Ch. D. 352.

shells, which were his property, out of the jurisdiction of the Court. "It is argued," said Brett, L. J., "that if the Mikado were a private individual, then, although he has purchased these shells and paid for them, yet, inasmuch as there has been an infringement of the patent, the property is not in him, because the Court may order the shells to be destroyed. Is that argument good or not? To my mind it is utterly fallacious. The patent ram has nothing to do with the property. I am clearly of opinion that the patent law did not prevent the property from passing. The Mikado has a perfect right to have these goods. No Court in this country can prevent him from having goods which are the public property of his own country."

No jurisdiction to restrain dealing with goods of a foreign sovereign.

(3.) *The Writ.*

Service of a writ of summons at an agency in London where goods are received and sent out, but which is not really the defendant's place of business, is not sufficient (*d*).

Service of writ.

An action was instituted against G. & Co. for infringement of a patent; the writ was served on the clerk of M. at his office in London. G. & Co. had no place of business in England, but M. was their agent in London; their name was put up outside, and their letter paper bore the address of M.'s office. G. & Co. moved to set aside the service of the writ, but the notice of motion did not state the objections intended to be insisted upon. It was held that G. & Co. did not carry on business at this office, that even if they did M.'s clerk was probably not the person having the control or management of their business there; and that the service must be set aside, though without costs, because the notice of motion was defective, and because the defendants' conduct contributed to the plaintiff's mistake (*e*).

Forms of indorsement of the writ in actions of infringement will be found in the Appendix (*f*).

Indorsement of writ.

It is usual to indorse the writ for an injunction to restrain the infringement, for damages or an account of profits, and for delivery up or destruction of infringing articles.

In *Washburn and Moen Co.* v. *Cunard Co.* (*g*), the owners of a patent commenced an action to restrain infringement of their patent against a steamship company, who had brought certain

Service out of the jurisdiction.

(*d*) *Baillie* v. *Goodwin*, 1886, 3 P. O. R. 285.
(*e*) *Ibid.* p. 283.
(*f*) P. 781.
(*g*) 1889, 6 P. O. R. 398.

goods, alleged to be an infringement, from America to Liverpool. Under the bill of lading the goods were to be delivered at Liverpool to the agent of the consignees, who themselves resided at Dublin. The validity of the patent had been established in a previous action. The plaintiffs having moved for and obtained an injunction against the company and another company to whom part of the goods had already been delivered for transhipment to Dublin, then obtained leave to add the consignees as parties to the action, and to serve the writ on them out of the jurisdiction. The plaintiffs moved for an injunction against the consignees, and the consignees moved to discharge the order for service and to set aside the service. It was held that the action was properly brought against the steamship company, that the consignees would, if within the jurisdiction, have been proper parties to the action, and that, following *Massey* v. *Heynes* (*e*), they were rightly made parties though out of the jurisdiction; and that in exercise of the discretion given by R. S. C. Ord. XI. r. 2, in the case of a defendant living in Ireland, and of the general discretion possessed by the court, in reference to service out of the jurisdiction, this was a proper case for ordering such service without any special terms.

Sect. 3.—Interlocutory Injunction.

What is interlocutory injunction.

An interlocutory injunction in a patent action is one granted before the hearing, by which the defendant is commanded to refrain from infringing the plaintiff's patent until the hearing or the further order of the Court (*f*).

Principles on which granted.

The principle on which the Court acts in granting or refusing interlocutory injunctions in cases of this description, was stated by Sir George Jessel, M. R., in *Dudgeon* v. *Thomson* (*g*) :—

"The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it; or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result; or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

The whole case law of the subject may be considered under the heads above set forth.

(*e*) 1888, L. R. 21 Q. B. D. 330.
(*f*) Cp. Hindmarch, p. 312. See forms, Seton's Decrees, pp. 343, 344.
(*g*) 1877, 30 L. T. N. S. at p. 244.

I. "Where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it" (*h*). *First ground.*

The grounds on which an interlocutory injunction is granted in such cases may be shortly stated thus:—

Primâ facie evidence of a patentee's title is necessary before the Court can act upon the presumed validity of a patent without the right having been ascertained by a previous trial. Long and uninterrupted possession is *primâ facie* evidence of title which ought to be respected (*i*). *Primâ facie* evidence of title necessary.

An interdict by the Court of Session in Scotland offers *primâ facie* evidence of validity on which an English Court may grant an interlocutory injunction (*j*). Effect of Scotch interdict.

In a case where there has been long enjoyment under the patent (the enjoyment, of course, including use), the public have had the opportunity of contesting the patent, and the fact of their not having done so successfully, affords at least *primâ facie* evidence that the title of the patentee is good (*k*). Policy also is in favour of the Court's intervention in such cases. "If the case turned," said Turner, L. J., in *Davenport* v. *Jepson* (*k*), "on the question of comparative injury, see what the position of the plaintiff would be if an injunction were refused. Supposing his patent is valid, a number of persons are infringing it. If the Court refused an injunction in this case, it must refuse it in the case of each of the other infringers. Supposing the plaintiff to succeed at the hearing, the market will, in the meantime, have been flooded with articles wrongfully manufactured according to his patent." Upon the other hand, "it becomes the Court to be extremely cautious in administering its equitable jurisdiction by way of injunction; and such caution is requisite for two reasons, first, because if the legal right ultimately fail, or if the acts complained of turn out to be no violation of the legal right, the Court then has interfered without any authority whatever, the authority being merely derivative from the legal right, and in aid and protection of it; secondly, and Effect of long enjoyment.

(*h*) Cp. also *Universities of Oxford and Cambridge* v. *Richardson*, 1802, 6 Ves. 706; *Harmer* v. *Playne*, 1807, 14 Ves. 130; *Hill* v. *Thompson*, 1817, 3 Mer. 622; *Bickford* v. *Skewes*, 1838, 1 Web. P. C. 213; *Curtis* v. *Cutts*, 1839, 8 L. J. Ch. 184; 2 Coop. C. C. 60, n.; *Electric Telegraph Co.* v. *Nott*, 1847, 2 Coop. 41; *Stevens* v. *Keating*, 1847, 19 L. J. Ex. 57; 2 Web. P. C. 176, 177; *Hancock* v. *Moulton*, 1852, Higgins's Dig. 1175; *Betts* v. *Menzies*, 1857, 3 Jur. N. S. 358; *Davenport* v. *Jepson*, 1862, 1 N. R. 173; *Renard* v. *Levinstein*, 1864, 10 L. T. N. S. 94; *Plympton* v. *Malcolmson*, 1875, L. R. 20 Eq. 37.

(*i*) *Stevens* v. *Keating*, *ubi supra*, per Lord Cottenham, C.

(*j*) Cp. Hindmarch, p. 312. See forms, Seton's Decrees, pp. 343, 344.

(*k*) *Caldwell* v. *Vanvlissengen*, 1851, per Turner, V.-C., 9 Hare, at p. 424; cp. *Electric Telegraph Co.* v. *Nott*, 1847, 2 Coop. 41; *Davenport* v. *Jepson*, 1862, per Turner, L. J., 4 De G. F. & J. 446.

principally, because . . . . there is no comparison between the evil of an error in refusing an injunction, and the evil of an error in granting an injunction" (*l*).

Characteristic of long enjoyment.

The enjoyment, referred to by Sir George Jessel in *Dudgeon* v. *Thomson* (*m*), must, before the Court can recognize it, be shown to

Duration of enjoyment.

have been long, uninterrupted, and active. The periods of enjoyment which have been held sufficient range from thirteen (*n*) to three (*o*) years.

Undertaking to keep account.

In *The British Tanning Co.* v. *Groth* (*p*), the owners of a patent for an "improved process and apparatus for tanning by aid of electricity" commenced an action of infringement against the owner of a subsequent patent, with a similar title, and moved for an interim injunction. The plaintiffs alleged that the defendant's process was equivalent to theirs. It appeared that the patentees of the plaintiffs' process had entered into an agreement with the defendant not to oppose any company formed for the purpose of purchasing his invention. Stirling, J., held that as the patent was of recent date, and the evidence was not strong enough to show that the two processes were identical, and considering the agreement aforesaid, although the defendant would give no undertaking to keep an account, no order should be made except that the motion stand to the trial.

The Court abstains from interfering by injunction in the case of a recently dated patent, where there is really a substantial question to be tried. The defendant in such a case is usually required to give an undertaking to keep an account until the hearing of the action (*q*).

Where, however, the only substantial defence to an action of infringement was that the patent was void on the ground that the complete specification did not disclose all that the plaintiff knew at the date thereof to be necessary for the purpose of working the invention, but where it was proved that a competent workman

(*l*) Per Lord Cottenham, C., *Electric Telegraph Co.* v. *Nott*, *ubi supra*, at p. 47.

(*m*) 1877, 30 L. T. N. S. at p. 244.

(*n*) *Harmer* v. *Playne*, 1807, 14 Ves. 130. See the cases enumerated in Lawson, p. 194.

(*o*) *Wheatstone* v. *Wilde*, 1861, Griffin, P. C. 247. Here Wood, V.-C., held that the exclusive enjoyment for three years of a patent for improvements in electro-magnetic telegraphs—a subject-matter as to which it was shown by the patentee that inventors had been and were very much on the alert—would justify an interlocutory injunction. See, however, *Hill* v. *Thompson*, 1817, 3 Mer. 622; *Plimpton* v. *Malcolmson*, L. R. 20 Eq. 37; *Renard* v. *Levinstein*, 1864, 10 L. T. N. S. 94.

(*p*) 1890, 7 P. O. R. 1.

(*q*) *Jackson* v. *Needle* (a case under the Patent Law Amendment Act, 1852), 1884, 1 P. O. R. 174.

could carry out the invention with no other assistance than that derived from the specification, it was held that the plaintiffs were entitled to the injunction they moved for (*r*).

Enjoyment must be exclusive.

There must be not merely possession and enjoyment, but uninterrupted and exclusive possession and enjoyment, under letters patent, in order to warrant the Court in granting an interlocutory injunction. When, therefore, it was shown that since the patent in dispute was granted, persons not claiming under the patent had manufactured machines upon the principle sought to be protected by it, adversely to and without the license of the plaintiffs, it was held by Lord Cottenham, C., that there was an end to the case of exclusive possession and enjoyment, though the patent had been in force for nearly fourteen years, and that an injunction must be refused (*s*).

Prior substratum patent.

In *Heugh* v. *Magill* (*t*), on a motion to restrain the infringement of a patent for certain improvements in a machine which was the subject of a prior substratum patent, the Master of the Rolls held that the undisturbed possession of the new patent did not commence till the substratum patent had expired.

Actual user necessary.

An injunction to restrain an alleged infringement will not be granted on an interlocutory application, unless it has been shown that there has been actual user of the invention, even where the patent has been in force for a number of years (*u*).

Question of validity, how far entered into.

The Court will not enter into the question of the validity of a patent on an interlocutory motion for an injunction, unless it appears to be on the face of it so irretrievably and hopelessly bad that it could not possibly be supported (*x*). The law is that where a patentee has had long enjoyment then he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful (*y*). Upon the other hand, it is not a mere matter of course, because a patent is recent, to call on the patentee to establish his rights at law before he can obtain relief by injunction (*z*).

(*r*) *Coles* v. *Baylis*, 1886, 3 P. O. R. 178.

(*s*) *Curtis* v. *Cutts*, 1839, 8 L. J. Ch. 184; 2 Coop. 60. It is not necessary for the plaintiff to allege that his patent has never been disputed: *Read* v. *Andrew*, 1885, per Bacon, V.-C., 2 P. O. R. 119, 122.

(*t*) 1877, W. N. 62.

(*u*) *Plimpton* v. *Malcolmson*, 1875, 44 L. J. Ch. 257.

(*x*) *Briggs* v. *Lardeur*, 1884, per Pearson, J., 1 P. O. R. 129; *Shillito* v. *Larmuth*, 1885, 2 P. O. R. 2.

(*y*) *Betts* v. *Menzies*, 1857-62, 3 Jur. N. S. 357; cp. also, *Universities of Oxford and Cambridge* v. *Richardson*, 1802, 6 Ves. 706; *Losh* v. *Hague*, 1837, 1 Web. P. C. 201; *Beeston* v. *Ford*, 1830, per Lord Lyndhurst, C., 2 Coop. Ch. Ca. 58; *Bickford* v. *Skewes*, 1837, 4 M. & C. 498; *Muntz* v. *Foster*, 1843, 2 Web. P. C. 93, 95.

(*z*) *Clark* v. *Ferguson*, 1869, per Stuart, V.-C., 1 Giff. 184; cp. *Gardner* v. *Broad-*

Second ground. II. Where the validity of the patent has been established elsewhere, and the Court sees no reason to doubt the propriety of the result.

Earlier rule. It was at one time (*a*) held that though a patentee had enjoyed his patent for a considerable period, and had succeeded in several actions for an infringement thereof in upholding his patent, and had obtained injunctions restraining the parties so infringing, yet if there were a new infringement by a different party, an injunction to restrain him would not be granted till after a trial at law, however palpable the infringement might be.

Later rule. In the later cases, however, a different doctrine has been asserted, the most terse statement of which will be found in the language of Lord Romilly, M. R., in *Borill* v. *Goodier* (*b*).

The Court will protect a patentee who has established the validity of his patent in one action, against a different defendant in another action, until that defendant proves its invalidity. The defendant in the first action may, notwithstanding, dispute the patent in the second.

Effect of fresh facts impeaching novelty. An interlocutory injunction may be granted to a patentee in the cases to which the rule above stated applies, although a fresh fact is brought forward tending to impeach the novelty of the invention (*c*).

Award of arbitrator. Where a patentee had brought an action for damages, and at the trial an arbitration had been agreed to, upon which the arbitrator by his award had established the validity of the patent, and the patent had been again invaded, the Court, upon a bill filed for an injunction to restrain the infringement, held that the award of the arbitrator must be considered as equivalent to a verdict establishing the validity of the patent, against which there had been no motion for a new trial (*d*).

Effect of action at law to test validity. Where a patentee had been directed to proceed at law in order to try the validity of his patent, and had obtained judgment, then the Court of Chancery, both before and under Sir John Rolt's and Lord Cairns' Acts, granted him an injunction as a matter of course (*e*).

bent, 1856, 4 W. R. 767; 2 Jur. N. S. 1041.

(*a*) *Croskill* v. *Ivory*, 1848, 10 L. T. 459; cp. also, *Croskill* v. *Turford*, 1845, 5 L. T. 342.

(*b*) 1866, 35 L. J. Ch. 174; 35 Beav. 427; cp. *Davenport* v. *Jepson*, 1862, 4 De G. F. & J. 440; *Davenport* v. *Goldberg*, 1865, 2 H. & M. 282; *Borill* v. *Smith*, 1867, W. N. 1867, 240; *Dudgeon* v. *Thomson*, 1874, 30 L. T. N. S. 244; *Thorn* v. *Worthing Skating Rink Co.*, 1876, 6 Ch. D. 416, n.; *Hayward* v. *Pavement Light Co.*, 1884, 1 P. O. R. 207.

(*c*) *Newall* v. *Wilson*, 1852, 19 L. T. 161; 2 De G. M. & G. 472.

(*d*) *Lister* v. *Eastwood*, 1855, 26 L. T. 4.

(*e*) *Russell* v. *Cowley*, 1834, 2 Coop.

In *Boulton* v. *Bull* (*f*), where the patentee had been in possession for twenty-seven years, an injunction had been granted in order that the question as to the validity of the patent might be tried. There was a verdict for the plaintiff, subject to the opinion of the Court upon a case stated. The Court was equally divided in opinion as to the validity of the patent. Lord Rosslyn, C., refused to dissolve the injunction previously granted, but directed the plaintiff to bring another action to test the validity of his patent.

Where, however, after a verdict in favour of the plaintiff in an action for infringement, the defendant took steps to question its propriety, where, for example, he stated his intention of moving (*g*), or obtained a rule *nisi* for (*h*), a new trial, or tendered a bill of exceptions (*i*), the Court usually, but not necessarily (*k*), ordered the matter to stand over till the result of such application or proceeding was known.

Third ground.

III. Where the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent.

It will be found that the cases under this head turn upon a more or less direct application of the doctrine of estoppel.

We will first consider the position of a licensee.

Position of licensee.

A licensee may be estopped from disputing the validity of a patent where (1) the license, being by deed, contains a recital necessarily involving an assertion of the validity of the patent (*l*); (2) the license not being by deed (*m*), or being merely verbal (*n*), is still in force, and the licensee is using the invention under it (*o*).

Estoppel.

The fact of a patent having been found invalid at law upon proceedings between the patentee and third parties, is no answer to a suit based upon the same patent for an injunction and consequent relief against a licensee who has covenanted to pay royalties, and is selling the invention contrary to his covenant without payment of the royalties (*p*).

C. C. 59, n.; *Neilson* v. *Harford*, 1841, 1 Web. P. C. 373.

(*f*) 1796, 3 Ves. 140.

(*g*) *Hill* v. *Thompson*, 1817, 3 Mer. 631; 1 Web. P. C. 235, 238.

(*h*) *Collard* v. *Allison*, 1839, 4 My. & Cr. 487.

(*i*) *Bridson* v. *McAlpine*, 1845, 8 Beav. 229.

(*k*) *Bridson* v. *Benecke*, 1849, 12 Beav. 1.

(*l*) *Bowman* v. *Taylor*, 1834, 2 Ad. & E. 278; 1 Web. P. C. 292; *Smith* v. *Scott*, 1859, 28 L. J. C. P. 325; *Cutler* v. *Bower*, 1848, 17 L. J. Q. B. 217; 11 Q. B. 973.

(*m*) *Lawes* v. *Purser*, 1856, 26 L. J. Q. B. 25; 6 E. & B. 930.

(*n*) *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293, 308, 310.

(*o*) *Norton* v. *Brooks*, 1861, 7 H. & N. 499.

(*p*) *Grover and Baker Sewing Machine Co.* v. *Milliard*, 1862, 8 Jur. N. S. 714;

Apparent exceptions.

There are certain apparent exceptions to the proposition just stated which require notice.

In *Hayne* v. *Maltby* (*q*), the facts were these: "A. fraudulently asserting that he had a right to a patent machine, covenanted with B. that he should use it in a particular manner, in consideration of which B. covenanted that he would not use any other; in an action by A. on the covenant, "held that B. was not estopped by his covenant from pleading in bar to the action that the invention was not new or that the patentee was not the inventor."

In this case, however, "the recital contained no assertion of right in the plaintiffs, except as assignees . . . . the case was not properly one of estoppel" (*r*).

"The case of *Hayne* v. *Maltby*," said Lord Cottenham, C., in *Neilson* v. *Fothergill* (*s*), appears to me to come to this: that although a party has dealt with the patentee, and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party the opportunity of disputing his right; and that if the defendant successfully dispute his right, that, notwithstanding he has been dealing under a contract, it is competent for the defendant so to do."

In *Taylor* v. *Hare* (*t*), "A. having obtained a patent for an invention, of which he supposed himself the inventor, agreed to let B. use it upon payment of a certain annual sum, secured by bond: this sum was paid for several years, when B. discovering that A. was not the inventor, but that it was in public use before A. obtained his patent, brought an action for money had and received, to recover back the amount of the annuity paid." It was held that he could not recover.

Here, again, there had been distinct enjoyment under the patent, and this case is therefore distinguishable from *Chanter* v. *Leese* (*u*), in which it did not appear that there had been any enjoyment by the defendants (*x*).

After the determination of a license, the licensee may, on an

cp. *Taylor* v. *Hare*, 1805, 1 N. R. 260; 1 Web. P. C. 292; *Collinge* v. *Bowman*, 1834, 1 Web. P. C. 292; *Baird* v. *Neilson*, 1842, 8 Cl. & F. 726; *Hills* v. *Laming*, 1853, 23 L. J. Ex. 60.

(*q*) 1789, 3 T. R. 438.

(*r*) Per Patteson, J., in *Bowman* v. *Taylor*, 1834, 1 Web. P. C. 294.

(*s*) 1841, 1 Web. P. C. 290.

(*t*) 1805, 1 N. R. 260.

(*u*) 1839, 4 M. & W. 295; affirmed on appeal, 5 M. & W. 698; *Besseman* v. *Wright*, 1858, per Crompton, J., 6 W. R. 719.

(*x*) *S. C.*, 1 Web. P. C. 295.

application for an injunction, dispute the validity of the patent as against the licensor (*y*).

In *Pidding* v. *Franks* (*z*) the plaintiff had granted by deed to one S., a defendant in the suit, an exclusive license to use a patent for the manufacture of coffee. S. made an equitable assignment of his whole interest under the patent to F. Knight-Bruce, V.-C., directed an action at law instead of granting an injunction in respect of an alleged infringement, whereupon the plaintiffs sought to have the defendants, other than S., put on terms not to dispute the validity of the patent. The application was refused. "Are the defendants," said Lord Cottenham, C., "not to be at liberty to say we *have bought the patent and paid for it, but we do not intend to* use it? They are mere equitable assignees, and why should they be deprived of the right which every stranger has of disputing the validity of the patent."

Estoppel by conduct.

The conduct of a defendant may have been such as to estop him from disputing, upon an application for an interlocutory injunction, the validity of the plaintiff's patent.

Co-partners.

Thus, in *Muntz* v. *Grenfell* (*a*), where the patent had been worked by the plaintiff and defendant as partners, under circumstances affording a presumption that the defendant did not, during the existence of the partnership, dispute that the patent was valid, Knight-Bruce, V.-C., held, upon an interlocutory application for an injunction, after the determination of the partnership, that the Court must assume the patent to be valid as against the defendant. *Axmann* v. *Lund* (*b*), although apparently contradictory of, is in reality distinguishable from, this case. In the latter, the plaintiff and the defendant had, during the subsistence of the partnership, taken and prosecuted legal proceedings against infringers. In the former, such proceedings had been taken, but were abandoned by the co-partners on advice that the specification was bad.

The rules above stated apply only to co-partners whose conduct or acts amount to an estoppel. There is nothing to prevent a co-partner who has not been privy to such acts from disputing the validity of a patent (*c*).

Effect of defendant

The fact that in a previous action at law for the infringement of

(*y*) *Dangerfield* v. *Jones*, 1865, 13 L. T. N. S. 142.

(*z*) 1849, 18 L. J. Ch. 295; 1 Mac. & G. 66.

(*a*) 1842, 2 Coop. 61, n.

(*b*) 1874, L. R. 18 Eq. 330.

(*c*) *Goucher* v. *Clayton*, 1864-6; 34 L. J. Ch. 239; *Heugh* v. *Chamberlain*, 1877, 25 W. R. 742.

having submitted to judgment in previous action.

letters patent, a defendant had submitted to judgment, and had taken a licence for five years to work under the patent, would debar him from questioning its validity on an application for an *interlocutory* injunction till the hearing of a subsequent action (*d*).

Patentee may not derogate from his own grant.

A patentee may not derogate from his own grant (*e*). This proposition requires some explanation and qualification. It holds good in such cases as *Oldham* v. *Langmead* (*f*). Here the patentee had conveyed his interest in the patent to the plaintiff, and yet, in violation of his contract, he afterwards infringed the plaintiff's right, and then attempted to deny his having any title to convey. It was held by Lord Kenyon that he was estopped by his own deed from making that defence.

A defendant is not, however, estopped from disputing the validity of his patent as against purchasers of the said patent from his trustee in liquidation (*g*).

In the case of *Cropper* v. *Smith* (*h*), where this point arose incidentally, Bowen, L. J., said, "There is no estoppel of record, and there is no estoppel by deed, because the people who claim against (the defendant H.) are not parties or privies to the deed or to the record; nor is there estoppel *in pais*, or by matter of conduct. It is perfectly true that in his petition to the Crown (the defendant) did say that his invention was new, and on that the patent was granted to him: but what sensible being in this world, who buys a patent, buys it on the strength of the assertion made by the patentee in the petition that the patent is new? We know that everybody who buys it, as a rule, takes it for what it is worth; and there is absolutely no evidence in this case that the plaintiff, who bought from the assignee in bankruptcy, and who gave a very small sum for the patent, was in the least relying in his purchase on the allegations made in the petition to the Crown by the patentee that the patent was a valid one."

When a patent has been upheld in one action for infringement, the defendant in a second action, who was not a party to the first, is not bound by the decision (*i*).

(*d*) *Goucher* v. *Clayton*, *ubi supra*, per Wood, V.-C. Here, however, the application was for a perpetual injunction. Cp. *Newall* v. *Elliot*, 1863-64, 1 H. & C. 797; *Dudgeon* v. *Thomson*, 1877, 30 L. T. N. S. 244.

(*e*) *Chambers* v. *Crichley*, 1864, 33 Beav. 374.

(*f*) 1789, 3 T. R. 439, 441.

(*g*) *Cropper* v. *Smith*, 1884, 1 P. O. R. per Bowen, L. J., at p. 94. Confirmed on this point by the House of Lords, 1885, 2 P. O. R. at p. 25.

(*h*) *Otto* v. *Steel*, 1886, 3 P. O. R. at p. 114.

Refusal of interlocutory injunction.

An interlocutory injunction will be refused:

1. If there is any substantial doubt whether the acts complained of constitute an infringement of the plaintiff's patent (*i*).

2. If the application for it is made only after unnecessary and unexplained delay (*k*).

3. If there has been, on the part of the plaintiff, acquiescence in the wrong of which he complains (*l*).

4. If the balance of convenience is against granting it (*m*).

These points may be illustrated very briefly.

Infringement doubtful.

1. An interlocutory injunction may be refused if there is a conflict of scientific opinion, leaving doubt in the mind of the judge, as to the fact of infringement (*n*); or if the alteration made by the defendant on the plaintiff's patent is "not merely colourable, but *primâ facie* a decided improvement" (*o*); or when it appeared that there was a material difference between the process of the defendant and that of the plaintiff (*p*).

On an application for an interlocutory injunction the plaintiff's affidavit should state particularly in what the alleged infringement of the patent consisted (*q*).

A patentee may, however, succeed in obtaining an injunction without proving actual infringement where the defendant alleges an intention to infringe, and claims the right to infringe, and it is plain that what is threatened to be done would constitute an infringement (*r*).

Where there is one question whether a patent is valid and another question whether it has been infringed (*s*), it depends on the degree of doubt which exists on those questions whether the Court will grant the interim injunction. In such cases it will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction (*t*).

Application to be made without delay.

2. An application for an interlocutory injunction, if *ex parte*, must be made at the earliest possible period, and if on notice, must be without any unnecessary or unexplained delay (*u*).

(*i*) *Electric Telegraph Co.* v. *Nott*, 1846-7, 16 L. J. C. P. 174; 2 Coop. 41.

(*k*) *Bridson* v. *Benecke*, 1849, 12 Beav. 1.

(*l*) *Neilson* v. *Thompson*, 1840, 1 Web. P. C. 275, 285.

(*m*) *Electric Telegraph Co.* v. *Nott.*

(*n*) *Electric Telegraph Co.* v. *Nott*, *ubi supra*, per Lord Cottenham, C.

(*o*) *Morgan* v. *Seaward*, 1835, per Shadwell, V.-C., 1 Web. P. C. at p. 168.

(*p*) *Muntz* v. *Virian*, 1840, 2 Web. P. C. at p. 88.

(*q*) *Hill* v. *Thompson*, 1817, per Lord Eldon, L. C., 1 Web. P. C. 230.

(*r*) *Frearson* v. *Loe*, 1878, per Jessel, M. R., 9 Ch. D. at p. 95.

(*s*) *Wood* v. *Cockerell*, 1819, per Lord Eldon, C., 2 Coop. 58 (n.).

(*t*) *Bridson* v. *M'Alpine*, 1845, 8 Beav. 229.

(*u*) *Bridson* v. *Benecke*, 1849, per Lord Langdale, M. R., 12 Beav. 3; *Greer* v.

Such delay is a ground for refusing an injunction notwithstanding the plaintiff's long enjoyment under the patent, and the establishment of its validity in an action against another party (*x*).

Meaning of "laches."

A patentee is not bound to bring actions in respect of every infringement, but in order to support an injunction against an infringer who has been permitted to go on for some time, and against whom no action has been brought, distinct notice ought to be given to him that the patentees would seek to enforce their right (*y*), and failure to give such notice may be fatal (*z*).

A patentee is entitled to spend some time in making inquiries as to whether a defendant is a man of substance (*a*), or is really infringing (*b*).

In the case of *Osmond* v. *Hirst* (*c*), it was contended that the plaintiff had been guilty of *laches*, because, the defendant's patent having been in existence since 1882, he had not brought an action till 1885, and it was said that that must be proof of the fact that the plaintiff knew of the infringement. Bacon, V.-C., however, repelled that contention.

A patentee does not acquiesce in the infringement of his patent by omitting to take proceedings for the repeal of a subsequent patent extending to part of his invention, unless such subsequent patent is put in practice (*d*).

Although a motion for an injunction is refused on the ground of delay, an account may be ordered (*e*).

"Where there is an independent case against a motion, it is better to order the motion to stand till the trial if the defendant asks for it, because although, where the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action, yet, where there is an independent case against a motion, so that the defendant may say: 'If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me in any

Bristol Tanning Co., 1885, 2 P. O. R. 268; *Thomson* v. *Batty*, 1889, 4 Times Rep. 36.

(*x*) *S. C.*, cp. *Bacon* v. *Jones*, 1839, 4 My. & Cr. 433; *Baxter* v. *Combe*, 1850, 1 Ir. Ch. R. 284; *Bovill* v. *Crate*, 1865, L. R. 1 Eq. 388.

(*y*) *Hancock* v. *Moulton*, 1852, M. Dig. 506; Higgins's Dig. 1201; cp. *Bovill* v. *Smith*, 1867, W. N. 1867, 240.

(*z*) *Smith* v. *L. & S. W. Rail. Co.*, 1854, 23 L. J. Ch. 562, Kay, 408.

(*a*) *United Telephone Co.* v. *Equitable Telephone Association*, 1888, 5 P. O. R. 233.

(*b*) *S. C.*, and *Losh* v. *Hague*, 1837, 1 Web. P. C. 201.

(*c*) 1885, 2 P. O. R. 267.

(*d*) *Newall* v. *Wilson*, 1852, 2 De G. M. & G. 282.

(*e*) *Bovill* v. *Crate*, *ubi supra*.

view to unnecessary expense,' it is better, then, to order the motion to stand to the trial without prejudice to any question " (*f*).

Acquiescence in infringement.

3. The leading case on the doctrine of acquiescence in the infringement of a patent is *Neilson* v. *Thompson* (*g*).

There the subject-matter of the invention was an improvement in the application of air to produce heat in fires, forges, and furnaces. The patentee made his profit, not by selling the article, but by granting licences to ironmasters to use his patent on paying one shilling per ton on all the iron made. The plaintiff was aware that the defendants were at considerable expense erecting apparatus for the purpose of using his invention, and he permitted them to go on under the expectation that they would pay him a shilling a ton after a certain time. It was held by Lord Cottenham, L. C., that an interlocutory injunction must be refused on the defendant undertaking to keep an account and to deal with it as the Court might direct.

Delay or acquiescence, which would be fatal to an application for an interlocutory injunction, may not debar a plaintiff from obtaining a perpetual injunction at the trial (*h*).

"Mere delay to enforce a legal right is no bar to an action, unless the delay is such as to cause a statutory bar" (*i*).

"But acquiescence may be a ground for refusing an account of profits (*k*), or for limiting it to the date of commencing the action (*l*), or for granting damages instead of an injunction" (*m*).

In *Proctor* v. *Bennis* (*n*), an action by P., the patentee of a stoking machine, for infringement against persons who had purchased stoking machines made by B., it was proved that before the purchase P., knowing that they were going to set up stoking machines, went to them and asked them to try his machine, saying that they would find it a better machine than B.'s, without giving any intimation that he considered B.'s machine to be an infringement of his patent, though he admitted that he did at that time consider it to be so, and intended to take legal proceedings when he was in funds.

(*f*) *Lister* v. *Norton*, 1884, per Chitty, J., 1 P. O. R. at p. 116.

(*g*) 1841, 1 Web. P. C. 278; *Thomson* v. *Hughes*, 1890, 7 P. O. R. 71.

(*h*) *Johnson* v. *Wyatt*, 1863, 2 De G. & S. 18, 25; *Fullwood* v. *Fullwood*, 1878, 9 Ch. D. 176; *Proctor* v. *Bennis*, 1887, 36 Ch. D. per Cotton, L. J., at p. 758.

(*i*) *Three Towns Banking Co.* v. *Maddever*, 1884, 27 Ch. D. 530.

(*k*) *Crossley* v. *Beverley*, 1829, 1 Web. Pc. 120; *Harrison* v. *Taylor*, 1865, 11 Jur. N. S. 408.

(*l*) *Sayers* v. *Collyer*, 1884, 28 Ch. D. 103, per Fry, L. J.

(*m*) *Beard* v. *Turner*, 1866, 13 L. T. N. S. 746; *Ford* v. *Foster*, 1872, L. R. 7 Ch. 627.

(*n*) 1887, 36 Ch. D. 740.

The Court of Appeal, reversing the decision of the Vice-Chancellor of the county palatine, held that as the purchasers did not depose that when they bought B.'s machines they were ignorant of P.'s patent, nor was there any reason to believe that they were ignorant of it, or that P. supposed them to be so, P. had not, on the ground of acquiescence or estoppel, lost his right to sue them for an infringement in using B.'s machines, it not being the duty of a patentee to warn persons that what they are doing is an infringement, and P.'s conduct not amounting to a representation that it was not an infringement.

Object of Court in granting injunction.

4. The object of the Court in granting an injunction is to preserve to each party the benefit he is entitled to, until the question of right is tried (*o*).

In *Neilson* v. *Thompson* (*o*), the facts of which are set forth above at p. 275, an injunction was refused, because, to stop the defendants' works by injunction would have done an injury to them out of all proportion to the indirect benefit which it might have conferred upon the plaintiff by putting pressure upon the defendants, and inducing them thereby to take a licence of the plaintiff's patent.

Where the trade of the defendant is a new trade, and he is a seller of goods to a vast number of people, it is less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account; thus forcing the plaintiff to commence a multitude of actions against the purchasers (*p*).

In two cases (*q*), the Court left rival patentees to try their legal rights by proceedings for revocation, and declined to interfere between them by interlocutory injunction.

Where infringement long discontinued.

An injunction will not be granted when the only infringement has been long discontinued, and no probability is shown of its being continued. In *Proctor* v. *Bayley* (*r*), the plaintiff, the owner

(*o*) *Neilson* v. *Thompson*, 1840, per Lord Cottenham, L.C., 1 Web. P.C. 286.

(*p*) *Plimpton* v. *Spiller*, 1876-77, per Brett, J. A., 4 Ch. D. 291.

(*q*) *Copeland* v. *Webb*, 1862, 11 W. R. 134; cp. *Boskett* v. *Cunningham*, 1762, 2 Eden, 137.

(*r*) 1889, 6 P. O. R. 633. In this case it was also held that as the Palatine Court had, under Lord Cairns' Act, only jurisdiction to grant damages in a case where it was proper to grant an injunction, there was no jurisdiction in the present case, and the action must be dismissed, but, owing to the defendants' conduct of their case, without costs, although the defendants must have the costs of their successful appeal. The Court refused to give any opinion as to whether the dismissal of this action would be prejudicial to a subsequent action at law for damages: cp. *Millington* v. *Fox*, 1846, 3 My. & Cr. 338; and *Geary* v. *Norton*, 1846, 1 De Gex & Sm. 9.

of a patent, the validity of which had been established in a previous action, brought an action against the defendants claiming an injunction and damages in respect of a previous user by the defendants of certain infringing machines in their works. The machines had been put up on trial, and proving unsuccessful, had been taken down five years, and removed from the defendants' premises three years before the commencement of the action. The defendants denied purchase or user of infringing machines, and, in the alternative, pleaded that their user of them was experimental, that it had long been discontinued, and that no threat or intention on their part to use infringing machines had been alleged or proved. It was held, at the trial, that the defendants had used machines which were an infringement of the plaintiff's invention, and to an extent amounting to more than an experimental user; and that though the act was discontinued and there was no threat to continue it, the plaintiff was entitled to an injunction in aid of his legal right. The defendants appealed. The Court of Appeal held, that in order to invoke the extraordinary jurisdiction to grant an injunction there must be some probability of the act being continued; and that assuming the defendants had infringed, as they were only users and not manufacturers, and the only infringement was put an end to in 1883, there was no evidence of any intention on their part to continue the wrongful act, and, therefore, an injunction ought not to be granted.

Application *ex parte*.

A plaintiff making application, whether *ex parte* (*s*) or after notice (*t*), for an interlocutory injunction must swear at the time of making it that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect (*s*).

Injunctions are not now generally granted *ex parte*. An interim order, restraining the defendant till after a day named, is made, liberty being given to the plaintiff to serve notice for an injunction

(*s*) *Hill* v. *Thompson*, 1817-18, per Lord Eldon, L. C., 3 Mer. at p. 124.

(*t*) *Sturtz* v. *De la Rue*, 1828, per Lord Lyndhurst, L. C., 5 Russ. at p. 329; *Whitton* v. *Jennings*, 1860, 1 Dr. & S. 110; *Mayer* v. *Spence*, 1860, 1 J. & H. 87.

for the day before such day. An undertaking to abide by the decision of the Court as to damages and other terms may be imposed upon the defendant (*f*).

Sect. 4.—The Consolidation of Actions.

Consolidation of actions.

Order XLIX. r. 8, of the R. S. C. 1883, provides that causes or matters pending in the Chancery Division may be consolidated by order of the Court or a judge in the manner in use before the commencement of the Judicature Act in the superior Courts of common law.

Practice at common law.

According to the practice at common law actions could only be consolidated at the instance of the defendant; and the consolidation order could be made as soon as the defendants had appeared, and before declaration (*g*). How far have these rules been modified?

Existing practice.

1. Where a number of plaintiffs have commenced several actions against the same defendants, the Court may under its general jurisdiction, on the application of the plaintiffs, enlarge the time for taking the next step in the rest of the actions until one of them has been tried as a test action; but where the action so selected fails to be a real trial of the issue, another of the actions may be substituted as the test action (*h*). The plaintiff was not, without his consent, bound by the result of the one action tried, but might, after a verdict against him in one action, proceed with any of the others.

2. In *Foxwell* v. *Webster* (*i*)—where the plaintiff, who was the assignee of the patent alleged to be infringed, had filed 134 bills against separate defendants—four motions were made by four groups of defendants, amounting in the whole to seventy-seven, that the suits should be consolidated, and that either one suit selected by the plaintiff should be prosecuted, and proceedings in the remainder stayed, or else that the validity of the patent should be tried once for all, and the time for answering be enlarged, each defendant reserving his own defence on the ground of non-infringement.

Kindersley, V.-C., dismissed the motions without prejudice to

(*f*) Daniell's Chanc. Prac. 1611.
(*g*) Lush's Practice, 3rd edit. 965.
(*h*) *Amos* v. *Chadwick*, 1877, 4 Ch. D. 869; 9 Ch. D. 459; *Bennett* v. *Lord Bury*, 1880, 5 C. P. D. 339.
(*i*) 1863, 9 L. T. N. S. 362, 528. This was a suit to restrain the infringement of a patent for improvements in machinery or apparatus for sewing or stitching.

any application after answer, with a view to regulating the future course of the proceedings. "Now this," said his Lordship, "is the position of the patentee; if he were to bring together in any one suit any number, even more than one defendant, and any one defendant were to object that he ought not to be mixed up with the others, the objection would be successful, for a patentee has no right to join as defendants any number of persons infringing, not even two (*k*). Now here the plaintiff has filed 134 bills against 134 different persons, who, he alleges, are infringing; and it is said, 'How can it be necessary to file so many bills?' . . . It is a settled rule of this Court, that if a person wishes to obtain an injunction, he must not sleep upon his right; he must come to the Court speedily; and if in this case the plaintiff had proceeded against one or more of the persons alleged to be infringing and had abstained from filing bills against the others, his remedy by injunction against them would have been prejudiced. It would be in vain for him to say that he was waiting the result of a trial against some others.

"The fact that there are 134 suits does not affect the duty of each defendant to answer the interrogatories addressed to him, and which will or may give the plaintiff the benefit of a decree. . . . . The defendants have come too soon."

On appeal, Lord Westbury suggested, that the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every machine made, used or sold by them, and whence obtained, and when used, and full discovery of the profits derived therefrom, undertaking also to pay a royalty in respect of each machine, if the validity of the patent and its infringement should be established. This course was agreed to on condition that the defendants would furnish verified models of every machine so made, used or sold by them respectively. Lord Westbury then made the order for consolidation cited above.

3. In the same case (*l*), Lord Westbury, L. C., made an order directing an issue as to the validity of the patent, certain defendants being selected as representatives, the result to be binding on the plaintiff and all the defendants. It appears, however,

(*k*) Cp. *Dilly* v. *Doig*, 1794, 2 Ves. Jun. 487, per Lord Loughborough, L.C.: "I do not remember any case upon patent rights, in which a number of people have been brought before the Court as parties, acting all separately upon distinct grounds: it has always been against a particular defendant. In a case here, not long ago, upon *Boulton and Watts' Patent* there were several bills."

(*l*) 1863, 4 De G. J. & S. at p. 81.

that this order was made with the plaintiff's consent, and therefore it constitutes no exception to the rule of common law which is still in force.

Sect. 5.—Statement of Claim.

Statement of claim.

The form of statement of claim in an action of infringement, given in the Appendix to the Rules of the Supreme Court, 1883 (*c*), contains the following material allegations, viz., the number, term, date, and subject-matter of the plaintiff's patent, the plaintiff's interest therein, the fact of infringement by the defendant, and a claim for injunction and damages.

More complete forms of statement of claim will be found in the Appendix (*d*).

Unnecessary allegations.

It is not necessary to allege the novelty of the invention (*e*), or that the patentee has duly paid the instalments of stamp duties necessary to keep the patent alive (*f*), nor is any reference to the specification required, as formerly (*g*).

The statement of claim must state such a case, however, as will justify the Court in granting the injunction asked for (*h*).

In *Edison and Swan Electric Light Co.* v. *Holland* (*i*), an inquiry as to damages and delivery up of infringing articles were asked for by the statement of claim, but by an oversight were omitted to be claimed at the trial. Kay, J., on a motion by special leave on behalf of the plaintiffs, who were successful in the action, ordered the minutes of the decree to be varied so as to include the relief asked for in the statement of claim.

A separate cause of action from that endorsed on the writ must not be set out in the statement of claim. A recent action (*j*) for infringement of a patent was commenced by a writ claiming the usual relief. In their statement of claim the plaintiffs introduced a statement that they had discontinued, and paid the costs of a previous action brought by them against the same defendants for infringement, in consequence of evidence given by the defendants,

(*c*) Appendix C. Sect. VI. No. 6; and see p. 782.

(*d*) Pages 792 *et seq.*

(*e*) *Amory* v. *Brown*, 1869, L. R. 8 Eq. 663-64, per Sir W. M. James, V.-C.: "The allegation of the grant, and the production of the letters patent, throw upon the defendant the *onus* of disputing the novelty."

(*f*) *Sarazin* v. *Hamel*, 1863, 32 Beav. 145.

(*g*) *Kay* v. *Marshall*, 1836, 2 Web. P. C. 39; *Westhead* v. *Keene*, 1838, 1 Beav. 289; 2 Web. P. C. 36, n., per Lord Langdale, M. R.

(*h*) *Curtis* v. *Cutts*, 1839, 8 L. J. Ch. 184.

(*i*) 1888, 6 P. O. R. at p. 483.

(*j*) *United Telephone Co.* v. *Tasker* (No. 2), 1889, 6 P. O. R. 38.

which evidence the plaintiffs had since ascertained to be false, and they claimed that the present action might be treated as supplemental to the previous action, and that the defendants might be ordered to repay the costs paid to them and to pay the plaintiffs' costs, charges, and expenses of that action as between solicitor and client. The defendants moved, under Ord. XIX. r. 27, to strike out such statement and claim as embarrassing. It was held, that it was irregular under such a writ to introduce a separate cause of action in the statement of claim; that it would be inconvenient to try such separate causes in this action; that the Court had power to strike out such pleadings, either under Ord. XVIII. r. 1, or Ord. XIX. r. 27; and that the proper order to make was to strike out those claims and leave the plaintiffs at liberty, if they pleased, to bring a separate action, the judge expressing an opinion that such action ought to be brought in the Queen's Bench Division. The motion was therefore allowed with costs.

Sect. 6.—Particulars of Breaches (*k*).

Particulars of breaches with the claim.

In an action for the infringement of a patent, the plaintiff must deliver with his statement of claim, or by order of the Court or a judge at any subsequent time, particulars of the breaches complained of (*l*); and at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement of which particulars are not so delivered (*m*).

History of particulars in patent actions.

The history of these provisions is as follows:—

At common law the Courts had, under their general jurisdiction, and irrespective of any statute to that effect, power to order particulars of an alleged infringement, and so prevent a defendant from being taken by surprise (*n*). The two cases in which this doctrine was laid down illustrate the principles on which the Courts acted in dealing with applications of this nature.

Perry v. *Mitchell* (*n*) was an action for the infringement of two letters patent for improvements in pens, and the specification set forth and described thirteen different pens, containing an indefinite number of slits and adjustments. The declaration assigned as breaches the making, &c. pens and nibs, in imitation of parts

(*k*) For forms, see pp. 784 *et seq.*
(*l*) Patents Act, 1883, s. 29, sub-s. 1.
(*m*) *Ibid.* sub-s. 4.

(*n*) *Perry* v. *Mitchell*, 1840, 1 Web. P. C. 269; *Electric Telegraph Co.* v. *Nott*, 1847, 16 L. J. C. P. 174; 4 C. B. at p. 471, per Wilde, C. J.

of the said invention, with divers additions thereto and subtractions therefrom. It was pointed out, on behalf of the defendant, that inasmuch as neither the parts, nor the additions or subtractions, were mentioned, it would be impossible to prepare the notice of objections to be delivered with the pleas, or to know what evidence to adduce. The Court of Exchequer ordered the plaintiff to give particulars by the number of the pens on which infringements were alleged, and the following notice was given accordingly: "The pens to which the declaration in this cause refers, and the number of such pens in the specification, referred to in the declaration, are as follows" (setting forth the number and figures of the diagrams).

In *Electric Telegraph Co.* v. *Nott* (*k*), the specification claimed a combination of numerous improvements in electric telegraphs. The defendant obtained a rule nisi for particulars in writing of the alleged infringements, but it was discharged by the Court of Common Pleas on the grounds that the plaintiff would be greatly embarrassed thereby, and that, as the matter had already (*l*) been the subject of a motion for an injunction in Chancery, there was little probability of surprise on the defendant for want of the information required.

Particulars of objections under Lord Brougham's Act.

5 & 6 Will 4, c. 83, s. 5, provided, that in actions for infringement notice of objections should be given by the defendant, but this statute left the position of the plaintiff as to giving particulars in such actions unaltered.

Particulars of breaches under Act of 1852.

The Patent Law Amendment Act, 1852, s. 41, required the plaintiff "in any action in any of her Majesty's Superior Courts of Record at Westminster, or in Dublin, for the infringement of letters patent," to deliver with his declaration particulars of the breaches complained of; and provided that at the trial of such action no evidence should be allowed to be given in support of any alleged infringement which was not contained in the particulars so delivered.

This section applied only to actions in the Courts of law; but the practice which it made compulsory was so obviously convenient that it was soon adopted by the Court of Chancery. When Lord Cairns' Act (*m*), and Sir John Rolt's Act (*n*), enabled that Court to try by itself, or with a jury, questions of fact, and required it to try all questions of law arising in a cause, particulars of breaches

(*k*) See note (*n*), *ante*, p. 281.
(*l*) 2 Coop. 47.
(*m*) 21 & 22 Vict. c. 27.
(*n*) 25 & 26 Vict. c. 42.

as well as notices of objections were ordered when issues were directed (*o*).

And in *Finnegan* v. *James* (*p*), Jessel, M.R., said that he saw no reason why the practice as to furnishing particulars should be confined to such cases, and that in all suits in equity the practice at law ought to be followed as closely as circumstances would admit.

When particulars sufficient.

Neither the Patent Law Amendment Act, 1852, nor the Patents Act, 1883, describes the nature of the particulars of breaches which it requires a plaintiff to furnish; and it was, and still is, the law that particulars of breaches are sufficient if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him (*q*).

Cases.

The cases bearing upon this point are not very numerous, and the principles on which the Courts act in determining the sufficiency of a plaintiff's particulars will be best discovered by a consideration of them.

Talbot v. *La Roche* (*r*) was an action for the infringement of a patent for "improvements in obtaining pictures or representations of objects." The particulars of breaches charged infringement generally by selling pictures, and further stated, "that one of such pictures was made and sold by defendant to one A. H. C. on 27th April, 1854; but plaintiff states this by way of example only, and not so as to preclude him at the trial from insisting on other infringements." A rule for the delivery of further and better particulars was refused by the Court of Common Pleas.

Sufficiency of general allegation of infringement.

In this case two points were raised (a) as to the sufficiency of the general allegation of infringement, and (b) as to whether the plaintiff should be allowed to give instances by way of example. Under (a) the Court refused to compel the plaintiff to specify persons and occasions, or the particular parts of the specification alleged to have been infringed. "Under a plea of want of novelty," said Jervis, C. J., "the Court requires the particulars of objections to condescend upon particular instances. But that is very different from this case; the matter there is not in the knowledge of the patentee. But the defendant must know whether, and in what respects, he has been guilty of an infringement. If the two pro-

(*o*) *Curtis* v. *Platt*, 1863, 35 L. J. (N. S.) Ch. 853. In *Borill* v. *Goodier*, 1867, 36 L. J. Ch. 360, it was laid down that the object of directing issues to be tried at law is to ascertain the real facts of the case, and therefore that the Court, in an action for infringement, would allow further particulars of prior user of the invention to be brought forward upon proper notice.

(*p*) 1874, L. R. 19 Eq. 72.

(*q*) *Needham* v. *Oxley*, 1863, 1 H. & M. 248.

(*r*) 1854, 15 C. B. 310, 320. Cp. *Russell* v. *Hatfield*, 1885, 2 P. O. R. 144.

cesses described in the specification are wholly distinct from each other, and the defendant's process might be an infringement of the one and not of the other, he ought to have better particulars. But if the whole is substantially one process he is not entitled to them. We must not make the particulars more complicated than the specification." Under (b) the plaintiff was allowed to give one exhibit, and to add the general words above referred to, stating that they did not mean to confine themselves to that. The ground of the decision on this point seems to have been that, as the plaintiff's specification disclosed substantially one process, one instance of infringement would be representative, and there was no probability of surprise (s).

Whether instances should be specified.

In *Jones* v. *Lee* (t), an action by a patentee against his licensee on a covenant to pay for roving machines made with the plaintiff's invention, and to make none without, the breaches alleged were, first, not paying for roving machines made with the invention, and secondly, making machines without it. The defendant, in answer to interrogatories, admitted the making of many hundreds of roving machines, but not with the plaintiff's invention, and declared that he could not state to whom they were sold, nor give any further information about them, without disclosing his own evidence. The plaintiff claimed in respect of all the machines the defendant had made under one or other of the covenants, and asserted that he had seen some of them which had his invention applied. It was held that the defendant was entitled to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, so as to enable the defendant to understand, as far as possible, the nature of the machines as to which he was to be charged under either of the covenants; and that it was no answer to the application for such particulars that the defendant's answer to the interrogatories was insufficient to enable the plaintiff to furnish the particulars, for if the answers were insufficient they should have been objected to (u).

Instances by way of example.

The Patent Type Founding Co. v. *Richards* (x) was an action for the infringement of a patent for "improvements in the manufacture of type." Upon an order for the delivery of further parti-

(s) Cp. *Tilghman's Patent Sand Blast Co.* v. *Wright*, 1884, 1 P. O. R. 103.

(t) 1856, 25 L. J. Exch. 241; Higgins, p. 407.

(u) Cp. *Elsey* v. *Butler*, 1884, 1 P. O. R. at p. 189.

(x) 1860, 2 L. T. N. S. 359. See this case distinguished from *Tilghman's Patent*, 1884, 1 P. O. R. 104, per Pearson, J.

culars of breaches, the plaintiffs enumerated certain instances, and added—"and the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches." Keating, J., ordered this clause to be struck out.

This case is distinguishable from *Talbot* v. *La Roche*, where a reference to a specific instance, "by way of example," was allowed. In that case, the infringing articles—sun pictures—could only be made by one process. But type might be manufactured in various ways, so that the general words left room for surprise on the defendant at the trial of the action.

Needham v. *Oxley* (*y*) was a suit to restrain from infringing a patent for machinery for expressing liquids or moisture from substance. The plaintiffs stated in their bill that a machine supplied by the defendant to Messrs. T. was substantially identical with their invention, and pointed out the only difference between them. The particulars of breaches specified three machines belonging to the defendant which they alleged in general terms to be infringements of their patent. Vice-Chancellor Wood refused to make an order upon a summons for better particulars. "The object," said his lordship, "in having these particulars delivered is to give the defendant fair notice of what is the complaint against him, not to tie the plaintiff down to the precise terms of any verbal definitions, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to; but I should be very sorry to introduce anything like special pleading into the practice of this Court, or to allow verbal criticism to interfere with a determination of the merits of the contest."

Infringing article made exhibit.

Batley v. *Kynock* (*z*).—Here the plaintiff delivered particulars of breaches, charging infringement by the making and selling of cartridges (whereof one was made an exhibit), having cases and metal heads, together with cups or chambers, formed or described in the specification. The defendant moved for further and better particulars. Vice-Chancellor Bacon, in refusing the motion, said: "Here the very thing in dispute, which is no bigger than one's

(*y*) 1863, 1 H. & M. 248, 251. Cp. the language of Mr. Justice Grove in the *Walter C. Church Engineering Co.* v. *Wilson*, 1886, 3 P. O. R. at p. 127: "No one can ever try patent cases by looking at particulars. Sometimes you may by looking at the specifications and the drawings, but it is, in practice, very seldom limited to that. I cannot call to mind a case, except some very simple cases, where there have not been illustrative models of the parts in dispute, which are as well known to both parties as can be."

(*z*) 1874–75, L. R. 19 Eq. 232.

thumb, and is not a complicated machine, is made an exhibit. What ground, therefore, is there for the objection as to insufficiency of the particulars when a plaintiff produces the exhibit, and says, 'I hold in my hand the very article by which you infringe?' It would be only hampering the plaintiff to compel him to specify minutely the particular portions of his specification alleged to have been infringed."

In *Petman* v. *Bull* (*a*), a patentee brought an action in India for the infringement of three patents, all of which related to one article—a kiln for burning bricks—and the second and third in date were for improvements upon the invention specified in the first. The Indian Patent Act XV. of 1859 provided that "in an action for the infringement of (an) exclusive privilege, the plaintiff shall deliver with his plaint particulars of the breaches complained of in the said action, and . . . . no evidence shall be allowed to be given in support of any alleged infringements . . . . which shall not be contained in the particulars delivered as aforesaid." (Sect. 34.) The plaintiff did not deliver any particulars of breaches, but his plaint pointed out a particular kiln constructed and used by the defendant, and not only referred to his patents, but indicated in the case of each of them the distinctive features of his invention alleged to have been appropriated by the defendant. It was held by the Privy Council that the plaint in itself was a sufficient compliance with the requirement of sect. 34 of the Indian Patent Act. Putting upon that section the same construction which, as we have seen, was put upon the corresponding section of the Patent Law Amendment Act, 1852, s. 41, Lord Watson said: "The sole object of these enactments is to give the defendant fair notice of the case which he has to meet; and it is quite immaterial whether the requisite information be given in the plaint itself or in a separate paper."

Instances by way of illustration.

In *Walter C. Church Engineering Co.* v. *Wilson* (*b*), the C. Co. brought an action for infringement of a patent against the W. Co., and delivered particulars of breaches, alleging infringement of the second, third, and fourth claims of the patent, but not referring to any pages or lines of the specification, and complaining "in particular, by way of illustration," of certain specified machines. The defendants took out a summons for further and better particulars, which was dismissed by A. L. Smith, J. Grove, J., and

(*a*) 1886, 3 P. O. R. 390; *S. C.*, reported as *Ledgard* v. *Bull*, 11 App. Cas. 649.

(*b*) 1886, 3 P. O. R. 123.

Stephen, J., on appeal, held that the words "in particular, by way of illustration," were too wide, and ought to be omitted (*c*). "Complaining of a thing in particular," said Mr. Justice Grove, "and by way of illustration, might leave the plaintiffs open to complain of other things, and saying these are illustrations of others will lead to controversy." Subject to that limitation, their lordships held that the particulars were sufficient, inasmuch as the plaintiffs gave the machines that he complained of, and the heads of the invention in respect of which infringement was alleged.

Haslam & Co. v. *Hall* (*d*).—In this case, which was an action for the alleged infringement of a patent for refrigerative processes and apparatus for preserving meat, the plaintiffs, by their particulars of breaches, complained of the manufacture, &c., by the defendants of certain refrigerating machines containing an arrangement of machinery described and claimed in the plaintiffs' patent; and also . . . . "by way of example, and not of limitation," of the machines fitted by the defendants on board the *Selembria*. The defendants applied for further and better particulars, and obtained an order from a master in chambers that the plaintiffs, *so far as concerned machines fitted to ships* might be confined to the *Selembria* unless further names were given. Part of the defendants' application asked for a direction that the plaintiffs should state whether they claimed in respect of all, or only of some, and which, of the claims in the specification. And it was held by Wills and Day, JJ., reversing the decisions of the master and Huddleston, B., that the defendants were entitled to the direction asked for.

Summary of law.

We are now in a position to attempt a generalisation upon the law of this subject.

Particulars of breaches are not intended to be so full as to enable an action of infringement to be tried by a reference to them alone. Their object is not so much to put the judge in possession of the facts, as to give the defendant fair and full notice of the case to be made against him, and they are sufficient if they do this, either independently of, or taken together with, the pleadings, models and exhibits. In considering the sufficiency of the particulars of breaches delivered in an action of infringement, the Court will apply such tests as these:—Is the matter, as to which further

(*c*) Cp. *Ehrlich* v. *Ihlee*, 1888, 5 P. O. R. at p. 40, where the words "by way of illustration" were struck out by consent.

(*d*) 1887, 4 P. O. R. 203. Cp. *Elsey* v. *Butler*, 1884, 1 P. O. R. 189; *Cheetham* v. *Oldham* (No. 3), 1883, 5 P. O. R. 624; *Lamb* v. *Nottingham Manufacturers Co.*, Seton, 349.

particulars are required, one peculiarly within the knowledge of the defendant? Is he likely to be surprised at the trial if the information asked for is withheld? Will the embarrassment to the plaintiff of furnishing better particulars be greater than the convenience to the defendant?

Subject to these general considerations, it may be laid down that a plaintiff must specify, by a reference to page and line, the parts of his specification in respect of which the alleged breaches have been committed (*e*), unless the case is a simple one, and either the plaintiff's is clearly identified with the defendant's process (*f*); or there is a general allegation of infringement with a reference to the claiming clauses (*g*); or the thing alleged to be an infringement has been made an exhibit in the cause (*h*).

A plaintiff will not, in general, be compelled to specify the persons with respect to whom, and the occasions on which, the alleged infringement occurred, such facts being peculiarly within the knowledge of the defendant (*i*).

Particulars of breaches which specify particular instances of infringement "by way of example," or "illustration," and not "by way of limitation," will not be allowed unless the infringing article can be made in one way only, so that a simple instance is representative, and there is little probability of the defendant being taken by surprise.

Sect. 7.—Defence.

(1.) *General.*

General character of defence.

The general consideration of the questions of subject-matter, novelty, and utility, and the sufficiency of the specifications, have already been dealt with, as also has the general question of infringement. We shall, therefore, confine ourselves now to the way in which these matters may be formally raised by way of defence to an action of infringement.

The statement of defence to an action of infringement must raise the case which the defendant intends to make at the trial.

Thus, in *Borill* v. *Goodier* (*k*), it was held that an objection to

(*e*) *Lamb* v. *The Nottingham Manufacturers Co.*, Seton, 349; *Haslam & Co.* v. *Hall*, 1887, 4 P. O. R. 203.

(*f*) *Elsey* v. *Butler*, 1884, 1 P. O. R. 189; *Walter C. Church Engineering Co.* v. *Wilson*, 1886, 3 P. O. R. 123.

(*g*) *Cheetham* v. *Oldham* (No. 3), 1888, 5 P. O. R. 624.

(*h*) *Batley* v. *Kynoch* (No. 2), 1874-75, L. R. 19 Eq. 229.

(*i*) *Talbot* v. *La Roche*, 1854, 15 C. B. 310.

(*k*) 1866, L. R. 2 Eq. 195.

the validity of a patent on the ground that it was included in an expired foreign patent for the same invention, and was therefore void under 15 & 16 Vict. c. 83, s. 25, could not be taken at the hearing of a suit to restrain the infringement of the patent unless it had been raised at the trial; and in *Morgan* v. *Fuller* (*l*), a defendant was not allowed to add a totally new issue of fact not in any way suggested by his answer to the issues which had been already directed for trial, and it was held that in order to raise such new issue the defendant must file a supplemental answer.

Amendment of defence.

In *The United Telephone Company* v. *Bassano* (*m*), the plaintiffs, as the owners of two patents, brought two actions of infringement against the defendants, who delivered defences denying infringement, but not impeaching the validity of the patents. The plaintiffs having joined issue on these defences, and set the actions down for trial, the defendants applied some time afterwards for leave to amend their defences by raising issues as to the validity of the patents. Mr. Justice Pearson held that the leave asked for must be granted, but he declined to postpone in any way whatever the hearing of the action, ordered the defendants to pay all costs, and required the amended defences to be delivered within three days. The ground on which liberty to amend was granted in this action was the public importance of the issue which the defendants proposed to raise.

Two main lines of defence to action of infringement.

A defendant in a patent action is at liberty to avail himself of two different kinds of defence to the action; *firstly*, he may deny that he has committed any infringement of the plaintiff's patent right (*n*). And every defendant may avail himself of both or either of these different lines of defence to a patent action; and, *secondly*, he may deny that the plaintiff has any title to the privilege stated in the claim, either on the ground that there is no such patent in existence as the plaintiff alleges, or that the patent is defective and void, and therefore the same as if there were no patent at all (*o*).

Particular pleas.

In the form of defence to an action for infringement, given in

(*l*) 1866, L. R. 2 Eq. 296.

(*m*) 1885, 2 P. O. R. 70. Cp. *Otto* v. *Steel*, 1884, 1 P. O. R. 139; *Otto* v. *Sterne*, 1885, 2 P. O. R. 139.

(*n*) In an action for infringement, the defendant denied infringement, and in the alternative alleged that the article, the sale of which was complained of, was purchased from one L., with whom the plaintiffs had some agreement not to take proceedings. It was held, that the plaintiffs had made a *primâ facie* case of infringement by showing that the defendant had sold the patented article, and that the defendant had not discharged the *onus* which lay on him of proving his alternative defence, there being no evidence of the agreement. *Badische Anilin* v. *Dawson*, 1889, 6 P. O. R. 387.

(*o*) See Hindmarch, p. 262.

the Appendix to the Rules of the Supreme Court 1883 (*p*), the following pleas are inserted: 1. The defendant did not infringe the patent. 2. The invention was not new. 3. The plaintiff was not the first or true inventor. 4. The invention was not useful. 5. [*Denial of any other matter of fact affecting the validity of the patent.*] 6. The patent was not assigned to the plaintiff. It will be apparent that these pleas enable a defendant to resist an action for infringement substantially upon two lines—of no infringement and no title. It may be convenient to consider these points in turn.

Two main defences to action of infringement.

(2.) *Denial of Infringement.*

As to what is an infringement, see Chapter XIII. on Infringement.

Denial of infringement.

Before the pleading rules, made in pursuance of the statute 3 & 4 Will. 4, c. 42, s. 1, the only plea used in patent actions was the comprehensive plea of "not guilty," under which the defendant might take any objection he pleased to the validity of the patent. The Rules of 1834 (*q*), however, restricted the operation of this defence to a mere denial of the wrongful acts imputed to the defendant by the plaintiff, and it neither put in issue nor denied the novelty or utility of the invention, the sufficiency of the specification, or anything alleged in the declaration, except the breaches. In the case of *Stead* v. *Anderson* (*r*), it was held that upon an issue of "not guilty" the question of whether there had been a fraudulent evasion of the patent did arise.

Under the Rules of the Supreme Court, 1883 (*s*), the general issue cannot now be pleaded, except in the cases where a plea of "not guilty by statute" is competent; but the specific denial of infringement has the same scope as "not guilty" under the pleading rules of 1834.

Ignorance no defence.

A defendant is not entitled under this, or any other plea, to set up as an answer to an action for infringement his *ignorance* of the existence of the patent (*t*); or that the article complained of was an infringement (*u*); or of an infringement having been committed, when the infringers were employed by him, and were

(*p*) App. D. Sect. VI., and see Appendix, p. 786.
(*q*) Reg. Gen. H. T. 4 Will. 4, 1834.
(*r*) 1847, 16 L. J. C. P. 250.
(*s*) Ord. XIX. rr. 13—17; and Ord. XXI. r. 19.

(*t*) *Davenport* v. *Rylands*, 1865, L. R. 1 Eq. 303; *Wright* v. *Hitchcock*, 1870, 39 L. J. Ex. 103; *Wittman* v. *Oppenheim*, 27 Ch. D. 260.
(*u*) *Geary* v. *Norton*, 1846, 1 De G. & S. 9; *Walton* v. *Lavater*, 1860, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

acting within the scope of their apparent authority (*x*). See also Chapter XIII. on Infringement (*y*).

The intention of the defendant, as already stated, is immaterial(*z*); nor is a plaintiff's right of action barred by a discontinuance of, and a promise not to repeat, the infringement of a patent.

But the Court will look into all the circumstances of the case, and particularly into the conduct of the defendant in considering whether or not an injunction ought to be granted.

Injunction not always granted where infringement.

Thus, in *Betts* v. *Willmott* (*a*), a suit to restrain from infringing a patent for the manufacture of capsules, it appeared that the defendant had unwittingly sold a bottle of Rimmel's toilet vinegar, having a capsule similar to those manufactured under the patent, but had given the plaintiff full information as to the persons from whom he obtained the infringing article, and had promised not to sell any more. James, V.-C., whose decision was confirmed by the House of Lords (*b*), dismissed the bill, leaving the plaintiff to recover damages, if he could, in an action at law.

An objection to the subject-matter of a patent cannot be competently raised under a plea denying infringement (*c*).

In an action by the assignee against the assignor of a patent the defences were a denial of infringement, and an allegation that if what the defendant had done was covered by the patent, the patent was void for want of novelty, as having been anticipated by certain other specifications mentioned. The plaintiff took out a summons under Ord. XIX. r. 27, to strike out the second plea, as tending to prejudice, embarrass, or delay the fair trial of the action. North, J., in chambers, refused to do so; and it was held, on appeal, that the second plea, so far as admissible by way of defence, was included in the first, and therefore was unnecessary; but that, as it did not tend to prejudice, embarrass, or delay the fair trial, it need not necessarily be struck out; and that as the judge, in the

(*x*) *Betts* v. *De Vitre*, 1865-73, per Wood, V.-C., 11 Jur. N. S. 11; and per Lord Chelmsford, L. C., 3 Ch. at p. 429.

(*y*) Pages 216—244.

(*z*) See authorities *ante*, pp. 219-20; *Young* v. *Rosenthal*, 1884, 1 P. O. R. 29, per Grove, J., at p. 39: "Intention is not a part of infringement. A man may infringe a patent, although he does not know he has infringed it, as a patentee may claim as a novelty that which is not a novelty. But then, if it is not a novelty, he must suffer; and if a man infringes he must suffer, whether he intentionally infringes, or whether he does not intentionally infringe." Cp. *Plimpton* v. *Spiller*, 1876–77, L. R. 4 Ch. D. 286.

(*a*) 1870, 18 W. R. 946.

(*b*) 19 W. R. 369. Cp. *United Telephone Co.* v. *Henry*, 1885, 2 P. O. R. 11; *Fletcher* v. *Glasgow Gas Commissioners*, 1887, 4 P. O. R. 386.

(*c*) *Russell* v. *Crichton*, 1837, 1 Web. P. C. 677, n. (*e*); *Houschill Co.* v. *Neilson*, 1843, *ibid.*

exercise of his discretion, had thought fit not to strike it out, his discretion ought not to be interfered with (*d*).

(3.) *Denial of Plaintiff's Title.*

Denial of title.

The plaintiff's title to the patent privilege may be impeached on various grounds:—

Not new.

(a.) *Want of novelty.*—There was formerly some doubt as to the exact scope of this plea in one direction. In the case of *Walton* v. *Potter* (*e*), the Court of Common Pleas held, that an issue raising the question whether an invention was a new manufacture known in England at the time the patent was granted, admitted the invention to be a manufacture within the meaning of the Statute of Monopolies, and merely put in issue the novelty.

In *Bush* v. *Fox* (*f*), however, substantially the same plea was held to put in issue both the novelty of the invention and the question of its being a manufacture.

The case of *Spencer* v. *Jack* (*g*) may be said to have settled the difficulty. In this suit—instituted to restrain an infringement—"an issue was directed as to the novelty of the plaintiff's invention. On the defendant's motion for their issue was substituted one as to the novelty of the plaintiff's 'invention or manufacture.' On appeal, it was directed that the question of novelty should be tried on two separate and distinct issues—one as to whether the plaintiff's improvement constituted a new invention; the other, whether it constituted a new manufacture."

Under a plea of want of novelty, the following issues cannot be raised: Want of utility (*h*), no subject-matter (*i*), insufficiency of specification (*k*), or a denial that the patentee is the true and first inventor (*l*).

As to novelty in general, see Chapter IV. Sect. 3 (*m*).

Not true and first inventor.

(b.) *A denial that the plaintiff was the true and first inventor.*—This plea is, as has already been pointed out (*n*), distinct from the issue as to the novelty of the invention.

The two objections are perfectly distinct and different from

(*d*) *Hocking & Co.* v. *Hocking*, 1886, 3 P. O. R. 291.

(*e*) 1841, 1 Web. P. C., per Tindal, C. J., at p. 601; per Maule, J., at p. 611. See also *ibid.* n. (*g*), p. 598.

(*f*) 1852-56, Macr. P. C. 166, 179.

(*g*) 1862, 3 De G. J. & S. 346; Higgins's Digest, 1246.

(*h*) *Walton* v. *Bateman*, 1842, 1 Web. P. C., per Cresswell, J., at p. 623.

(*i*) *Walton* v. *Potter*, 1841, 1 Web. P. C. 598, n. (*g*).

(*k*) *Bateman* v. *Gray*, 1853, 22 L. J. Ex. 290; 8 Ex. R. at p. 911.

(*l*) *Household Co.* v. *Neilson*, 1843, 1 Web. P. C. at p. 689.

(*m*) Page 32.

(*n*) *Supra.*

each other. The one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant; and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege (*o*).

It is true that if it be shown that the invention comprised in a patent was known to the public before the date of the patent, although the patentee may, in fact, have invented it, yet he cannot have been the *first* inventor, for some one must have invented and given the invention to the public before the date of his patent. But an invention may be perfectly new to the public, and yet the patentee may not be the true and first inventor, for he may have purloined it from another, or it may have been communicated to him by one of his fellow-subjects, in either of which cases he could not be the *true* inventor. The objection that the patentee was not the true and first inventor is, in fact, something more than the objection that the invention is not new, for it shows that the patentee did not make the invention (*p*).

Objection "not true and first inventor" wider than objection "not new."

In the case of an invention communicated from abroad, this plea would enable a defendant to deny that the plaintiff was the first importer. The words "true and first inventor" mean within the scope and construction of the Statute of Monopolies (*p*).

Importer.

(c.) *Want of utility.*—The objection to a patent because the invention is not useful seems originally to have rested not on the failure of the consideration bargained for by the Crown, as the representative of the public, but on the ground that the patent was, in the words of the Statute of Monopolies, "contrary to law," as "mischievous to the State," or "to the hurt of trade," and "generally inconvenient" (*q*). In the case of *Morgan* v. *Seaward* (*r*), it was doubted by the Court of Exchequer whether the proper form of plea ought not to follow the language of the statute; and in *Jupe* v. *Pratt* (*s*) Mr. Baron Alderson expressed an opinion that it was not sufficient for such a plea to say that the invention was not useful, but that it ought to allege the invention to be prejudicial. In spite, however, of these authorities, it was the almost invariable practice, both at common law and in equity (*t*), merely to deny the utility of the invention in general terms; and the form of stating

Not useful.

(*o*) Hindmarch, p. 268.
(*p*) *Ibid.*
(*q*) See also Chap. IV. p. 48.
(*r*) 1836, 1 Web. P. C. 187—197.
(*s*) 1837, 1 Web. P. C. 146.
(*t*) Seton, 347; *Plimpton* v. *Malcolmson*, 1876, 3 Ch. D. 531, 536.

this defence prescribed in the Appendix to the Rules of the Supreme Court, 1883, has left no room for further difficulty upon the subject.

In the case of *Losh* v. *Hague* (*x*)—a suit for the infringement of letters patent for improvements in the construction of railway carriage wheels—the defendant pleaded that the said supposed improvements were only trifling and insignificant alterations in the mode of making wheels before then known and in public use, and were not legal subjects for the grant of letters patent. The plaintiff, however, joined issue on this plea, and therefore no decision was necessary upon the question of its sufficiency.

In *Morgan* v. *Seward* (*y*), and *Bedells* v. *Massey* (*z*), it was held that a plea denying the utility of an invention was quite different from a plea alleging that the plaintiff had falsely alleged his invention to be improvements. The plea of want of utility cannot, as already stated (*a*), be raised under a plea of want of novelty.

Specification insufficient.

(d.) *Insufficiency of the specification.*—In the old form of letters patent there was a proviso or condition requiring the patentee particularly to describe and ascertain the nature of his invention, and the manner in which it was to be performed by an instrument, called a specification, and to cause it to be enrolled in Chancery within a certain time after the date of the patent. Under this condition two objections might formerly be taken to a patent—one on the ground that a specification had not been enrolled at all, or in due time; the other, upon the ground that the specification did not particularly describe and ascertain the nature of the patented invention. The form of letters patent prescribed in the first schedule to the present Act, contains no condition for avoiding the grant on the ground that the specification is insufficient (*b*); but this objection, having been at the commencement of the new Act a ground for *scire facias* (*c*), is, in the case of patents granted thereunder, available by way of defence to an action for the infringement. The form of letters patent now in use is not compulsory, but may be altered at the discretion of the Crown (*d*), or by rules made by the Board of Trade.

Variance; insufficiency.

Under the plea of insufficiency the following issues may be raised—that there is a fatal variance between the complete and the

(*x*) 1838, 1 Web. P. C. at p. 202.
(*y*) 1836, 2 M. & W. 544.
(*z*) 1844, 2 Dowl. & Low. 322.
(*a*) *Supra*, p. 292.
(*b*) See *infra*, pp. 530–33.
(*c*) Webst. Lett. Pat. 42, (n); *infra*, sect. 26, sub-sect. 3, p. 474.
(*d*) Cp. sects. 33 and 116.

provisional specifications (*e*); or that the whole of the complete specification and the statement of claim taken together are so indefinite that it cannot be discovered either what the invention claimed is, or how it is to be carried into effect (*f*); or in the case of an amended specification, that the amendment is not valid.

It is not, however, competent for a defendant to set up under this plea the defences of "no subject-matter" (*g*), or that the patent is for an abstract principle only, and therefore invalid (*h*).

No subject-matter.

(c.) *No subject-matter.*—"The assertion that the invention is not the subject-matter of letters patent means that if ever so new and useful, it is for some other reason, as being too simple, or too abstract, or from its peculiar character and nature, not the class or kind of thing intended to be protected by the Statute of James (*i*).

As to this, however, see Chapter IV. on the subject-matter of patents.

Sect. 8.—Particulars of Objections.

(1.) *General.*

Objections to be delivered with defence.

In an action for the infringement of a patent, the defendant must deliver with his statement of defence, or by order of the Court or a judge at any subsequent time, particulars of any objections on which he relies in support thereof. If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him; and at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged objection of which particulars are not so delivered (*k*).

Former effect of plea "not guilty."

The defendant in an action of infringement was originally permitted to raise, under a plea of "not guilty," every possible objection to the patent which he was alleged to have infringed, and in such actions, therefore, the plaintiff was frequently surprised at the trial by some new and entirely unexpected ground of defence being stated.

The pleading rules, which came into operation in Hilary Term, Rules, 1834.

(*e*) *Penn* v. *Bibby*, 1866, per Lord Chelmsford, L. C., L. R. 2 Ch. at p. 130.

(*f*) *Siddell* v. *Vickers*, 1888, per Cotton, L. J., 39 Ch. D. at p. 106.

(*g*) *Walton* v. *Potter*, 1841, 1 Web. P. C. 598; *Household Co.* v. *Neilson*, 1843, 1 Web. P. C. 677.

(*h*) *Jupe* v. *Pratt*, 1837, 1 Web. P. C. 145.

(*i*) 1 Web. P. C. 598, n. (*g*).

(*k*) Patents Act, 1883, s. 29, subss. 2, 4.

1834, limited the scope of the plea of "not guilty" to a bare denial of the alleged infringement, and required the defendant to raise by his pleas every objection which he intended to press against the patent.

(2.) *Under Act of* 1835.

Lord Brougham's Act requiring particulars.

Before the beneficial operation of these rules had been fully appreciated, the statute 5 & 6 Will. 4, c. 83, s. 5, enacted that the defendant should give to the plaintiff at the time of pleading notice of any objections on which he meant to rely, and that no objection should, without the leave of a judge at chambers, be allowed to be made on behalf of such defendant, unless he proved the objection stated in his notice.

This enactment having been passed after the new pleading rules had come into operation, was, of course, deemed to have been made for the purpose of giving the plaintiff in a patent action some benefit other than that which he enjoyed under the existing law.

Decisions under this Act.

It was accordingly held that, while the notice of objections should not disclose the evidence on which the defendant relied (*l*), it was not a sufficient compliance with the statute merely to specify every objection in general terms, as in a plea (*m*). "In some cases, indeed," observes Hindmarch, writing in 1846 (*n*), "a plea states an objection with as much particularity as can be required in a notice. Thus, the objection that the patentee was not the true and first inventor, is stated with as much particularity in a plea as can possibly be required in a notice of objections; for the nature of the subject does not admit of anything more being stated, unless the defendant was to mention the evidence by which he would establish his objection; and it is clear that the statute was not intended to compel a defendant to state his evidence in the notice. But whenever a plea will enable a defendant at the trial to raise several different and distinct objections to the patent, the patentee is entitled under the statute to notice of the objection upon which the defendant intends to rely, in a form more specific and particular than the plea."

(*l*) *Russell* v. *Ledsam*, 1843, per Alderson, B., 11 M. & W. 649; *Leaf* v. *Topham*, 1845, per Parke, B., 14 M. & W. 146; 14 L. J. Ex. 231.

(*m*) *Neilson* v. *Harford*, 1841, 8 M. & W. 806; *Heath* v. *Unwin*, 1842, 10 M. & W. 684; *Russell* v. *Ledsam*, *ubi supra*; *Jones* v. *Berger*, 1843, 5 M. & G. 215; *Reg.* v. *Mill*, *sci. fac.*, 1850, 1 L. M. & P. 696; *Betts* v. *Walker*, 1850, 14 Q. B. 363. On the other hand, the defendant was not entitled to go beyond his pleas: *Macnamara* v. *Hulse*, 1842, 2 Web. P. C. 128, n., per Lord Abinger, C. B.

(*n*) Page 295.

Decisions on precision in objections.

The degree of precision required in a notice of objections under the Act of 1835 was the subject of considerable judicial discussion.

In one case (*o*), it was said that the extent of the information to be afforded should be that to which a plaintiff would be entitled on a bill in equity for discovery.

In another case (*p*), it was observed that the detail in a notice of objections ought not, perhaps, to exceed what the knowledge of the party objecting might be presumed to enable him to give.

Perhaps, the only general proposition that can be laid down upon this subject is that stated by Hindmarch (*q*), in terms based upon the language of Tindal, C. J., in *Fisher* v. *Dewick* (*r*) :—

"Although plaintiffs always profess to apply for further and better particulars of objections, on the ground that the notice does not furnish them with sufficient information, the real motive generally is to get rid of some of the objections, or to restrict the defence as much as possible. The object of the statute, however, was not to limit the defence, but to diminish the expense at the trial, and prevent the patentee from being taken by surprise."

Object of Act of 1835.

Cases on objections under Act of 1835.

The following points were decided as to the degree of particularity required in a notice of objections under the Act of 1835 :—

1. The notice of objections should (*semble*) specify the pleas to which the several objections were intended to apply (*s*).

2. In an objection for want of novelty, the defendant would not be compelled to state who was the first inventor, or under what circumstances the invention was used before the date of the patent. "To require the defendant to afford this information would be throwing the burden of proof on the wrong party" (*t*).

3. The following objections were held sufficient :—

Objections held sufficient.

That the plaintiff did not state the best mode with which he was acquainted (*u*); that the invention was not properly set forth in the specification (*v*); that the plaintiff's specification did not suffi-

(*o*) *Att.-Gen.* v. *Corporation of London*, 1849, 2 M. & G. 247.

(*p*) *Bentley* v. *Keighley*, 1844, per Maule, J., 7 M. & G. 652; 13 L. J. C. P. 167.

(*q*) Page 291.

(*r*) 1838, 1 Web. P. C. at p. 267.

(*s*) *Walton* v. *Bateman*, 1842, per Creswell, J., 1 Web. P. C. 268, n. (*d*). Cp. *Gillett* v. *Wilby*, 1839, 1 Web. P. C. 270, in which it was held not to be sufficient to state an objection in the notice, unless there was a plea to which it could be applied: *Walton* v. *Bateman*, 1842, *ibid.* 616.

(*t*) *Russell* v. *Ledsam*, 1843, 11 M. & W. 647, following *Heath* v. *Unwin*, 1842, 10 M. & W. 684; *Bulnois* v. *Mackenzie*, 1837, 1 Web. P. C. 260; 4 Bing. N. C. 132; *Reg.* v. *Walton*, *sci. fac.*, 1842, 2 Q. B. 969; *Bentley* v. *Keighley*, 1844, 1 Dowl. & Low. 946, and dissenting from *Jones* v. *Berger*, 1843, 1 Web. P. C. 549. Cp., also, *Fisher* v. *Dewick*, 1838, 1 Web. P. C. 551, n.; *Galloway* v. *Bleaden*, 1839, *ibid.* 268, n.; *Carpenter* v. *Walker*, *ibid.*

(*u*) *Jones* v. *Berger*, 1843, 1 Web. P. C. 546.

(*v*) *Heath* v. *Unwin*, 1842, 10 M. & W.

ciently distinguish between what was old and what was new (*x*); that the specification was calculated to deceive (*y*).

4. The following objections were held insufficient:—

Objections held insufficient.

That the invention was more extensive than, and did not correspond with, that described in the specification (*z*); that there was a discrepancy between the drawings and the specification (*a*); that an extension of the patent term had been obtained by fraud, covin, and misrepresentation (*b*); that the plaintiff had not caused *any specification* sufficiently describing the nature of the supposed invention to be duly enrolled in Chancery (*c*).

In (a) and (b) it would be necessary that the attention of the plaintiff should have been called to the particular part or parts. In (c) it was held that the notice of objections ought to state the species of misrepresentation by which the defendant meant to allege that an extension of the patent term had been obtained from the Privy Council. In (d) the Court ordered an amendment, which was made by inserting the word "other" before "specification."

In this last case Baron Parke observed (*d*):—

"I think the meaning of the last objection is too obscure. It may either mean that there is no specification existing among the rolls of the Court, or that that which has been enrolled is defective in not sufficiently describing the invention. It is not necessary that the notice of objections should set out the evidence on which the defendant relies, but it ought to be more specific than this is. The Act of Parliament which requires the notice of objections was passed at a time when the general issue was the usual plea in cases of this kind, and it was, no doubt, intended to pass in the place of special pleas."

Jurisdiction over notices of objection at common law.

It was decided (*e*) that the Courts of Common Law had jurisdiction over the notices of objections given in pursuance of the Act of 1835, and whenever such a notice was not sufficient the defendant

687, per Lord Abinger, C. B.: "The legislature never intended that the defendant should argue his case in the statement of objections which he delivers in compliance with the Act."

(*x*) *Jones* v. *Berger*, 1843, 1 Web. P. C. 546.

(*y*) *Neilson* v. *Harford*, 1841, 1 Web. P. C. 324, n., 332. It was held that this statement was sufficient to let in evidence as to any particular passage being false: and that where the objection simply states the specification to be insufficient, and the plaintiff is contented to take that as notice, any objection to the sufficiency of the specification may be taken at the trial.

(*z*) *Fisher* v. *Dewick*, 1838, 1 Web. P. C. 551, n.

(*a*) *Ibid.*

(*b*) *Russell* v. *Ledsam*, 1843, 11 M. & W. 647.

(*c*) *Leaf* v. *Topham*, 1845, 14 M. & W. 146.

(*d*) *Ibid.* at p. 148.

(*e*) *Bulnois* v. *Mackenzie*, 1837, 4 Bing. N. C. 127; *Losh* v. *Hague*, 1837-39, 1 Web. P. C. 200.

might be ordered to amend it. This power was derived from the general jurisdiction of the Courts over all proceedings in actions before them, precisely as they derived their power over particulars pleaded by a defendant in pursuance of the statute of set-off (*f*).

(3.) *Under Act of* 1852.

Act of 1852. Additional particulars.

The Patent Law Amendment Act, 1852, s. 41, repeated in substance the provisions of 5 & 6 Will. 4, c. 83, s. 5, and added that the particulars of objections delivered in pursuance of the statute should state "the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent."

Construction of Act of 1852, s. 41.

The requirements of this statute, it should be observed, are confined to notices of objections affecting the validity of the patent, and it was therefore held that a defendant might object to the want of registration of an assignment of the patent to the plaintiff, although it was not specially mentioned in his notice of objections (*g*). It is thought that the following propositions give an accurate statement of the judicial construction placed on the section in question:—

Order for further particulars to follow section 41.

1. An order for further and better particulars of objection, made under the Patent Law Amendment Act, 1852, s. 41, was required to be, in form, confined to the words of the section; but this did not relieve the defendant from the obligation to furnish full and sufficient particulars (*h*).

Cases on these points are:—

Order in *Flower* v. *Lloyd*.

Flower v. *Lloyd* (*h*).—This was an action of infringement, in which the defendant relied, *inter alia*, upon prior user and publication of the plaintiff's invention. Bacon, V.-C., required the defendants to state "the names and addresses of the persons by whom, and the places where, and the dates at and the manner in which," the alleged prior user and publication had taken place. The Court of Appeal held that this order must be varied so as not to go beyond the words of the statute; but when the defendants, in pursuance of the amended order, delivered particulars alleging prior user by three persons, and whose names and ad-

(*f*) Hindmarch, p. 286.
(*g*) *Chollet* v. *Hoffman*, 1857, 26 L. J. Q. B. 249; 7 E. & B. 686.
(*h*) *Flower* v. *Lloyd*, 1876, 45 L. J. N. S. Ch. 746.

dresses were given, and "by other persons in Birmingham and London respectively," these words were held by Field, J., to be too indefinite, and the defendants were ordered either to give better particulars or to submit to their being struck out.

Birch v. *Mather* (*i*).—In this case the particulars of objections alleged prior user of the invention at certain works, which they specified, but gave no further information. It was held by Chitty, J., that to satisfy an order in the form settled in *Flower* v. *Lloyd* the defendant *must* give the names and addresses of prior users, and that the defendants must answer interrogatories, not only as to the particulars which they were required to furnish, but also as to whether the machines in question were in existence.

Plimpton v. *Spiller* (*j*).—Here the defence was, "that a prior American patent had been surrendered, and that the invention had been published in certain journals of specified dates, and in sketches and drawings deposited at a specified time in the Patent Office Library." It was held that "the defendant must state the date of the American patent, the name of the patentee, and the date of the alleged surrender, and specify also the pages, but not the lines, of the journals referred to, and that the drawings must be referred to in writing, whether contained in books or not, the rest of the order to be in terms" of *Flower* v. *Lloyd*.

Present residence of prior users.

2. When it was necessary to give the names and addresses of parties alleged to have been prior users of an invention, the present residence was required to be stated, "as otherwise the plaintiff would not know where to go for his evidence" (*k*).

General user at a place.

3. Where in an action for infringement the defendant relied not upon a specified user by certain persons named, but on a general user at a particular place, it was a sufficient compliance with sect. 41 to state that the invention was used by manufacturers generally at a particular place, without naming any person or specifying any manufactory.

Objections held sufficient.

The justification of this rule was thus expressed by Mr. Baron Alderson in *Palmer* v. *Wagstaffe* (*l*): "If a defendant rests his case on a general user, proof of user by one person will not do. . . . . The plaintiff has no reason to complain of the generality of the

(*i*) 1883, L. R. 22 Ch. D. 630; *Finnegan* v. *James*, 1874, L. R. 19 Eq. 72; *Crossley* v. *Tomey*, 1876, L. R. 2 Ch. D. 533.

(*j*) 1877, 20 S. J. 860.

(*k*) *Palmer* v. *Cooper*, 1853, per Alderson, B., 9 Exch. at p. 236; 23 L. J. Ex. 82.

(*l*) 1853, 22 L. J. Ex. 295; 8 Exch. 840, 842.

statement, for the more general it is the more the defendant must prove under it." It was accordingly held that the following allegations of general user were sufficient: "By candle makers generally in London, and the vicinity thereof" (*m*), "by persons engaged in finishing lace at Nottingham" (*n*). On the other hand, it was necessary that the defendant's particulars of general user should give the plaintiff such information as would enable him to make inquiries at the places named (*o*).

Thus, in a suit to restrain the infringement of a patent for improvements in the construction of carriages (*p*), particulars of objections alleging prior user "by carriage builders generally throughout Great Britain," and "by various carriage builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain," were held insufficient (*p*).

The Court, however, expressed its opinion in this case—that when an objection pointed to the public use of a particular preparation, such words as "by various makers in or near London" might be sufficient; and that if the defendant could not give the names of the carriage builders "in or near London," he would be required to specify the class or classes of carriages with respect to which the alleged prior user had taken place.

General rule as to sufficiency of objections.

4. Subject to the special requirements of the Act of 1852, s. 41, in the case of notices affecting the validity of letters patent, particulars of objection, like particulars of breaches, were generally sufficient if precise enough to prevent surprise at the trial of an action of infringement. Where the evidence relied on by a defendant was prior publication he was generally obliged to state the particular work or document, the volume of the work (*q*), and, in the case of a specification (*r*), the particular pages and lines where the alleged prior publication was to be found.

Particulars of prior publication.

(*m*) 1853, 8 Exch. 840, 842.

(*n*) *Jones* v. *Berger*, 1843, 5 M. & G. 208. Cp. per Tindal, C. J., at p. 216: "The notice of objection does limit the alleged user to a particular class of persons, viz., those engaged in the trade of lacemaking in a particular place, *Nottingham*; and it is quite as open to the plaintiff as it is to the defendant to make inquiries in that place among that class of persons." In the original notice of objections in this case, the words "and elsewhere" were inserted; but the Court held that they were too general, might mislead the plaintiffs, and should be struck out.

(*o*) *Palmer* v. *Cooper*, 1853, per Parke, B., 9 Exch. at p. 236.

(*p*) *Morgan* v. *Fuller*, 1866, L. R. 2 Eq. 297; cp. *Holland* v. *Fox*, 1853, 1 C. L. R. 440.

(*q*) *Curtis* v. *Platt*, 1863, 8 L. T. N. S. at p. 657.

(*r*) *Grover and Baker Sewing Machine Co.* v. *Wilson*, W. N. 1870, p. 78; cp. *Fisher* v. *Deicke*, 1838, 1 Web. P. C. 264; *Plimpton* v. *Spiller*, 1877, L. R. 6 Ch. D. 412; Higgins's Supplement, p. 79.

The same test was applied in other matters. "It is incumbent," said Coltman, J., in *Fisher* v. *Deuick* (*s*), "on the Court to see that the objections are stated in a definite and intelligible form before the parties go down to trial, that the patentee may not be taken by surprise. The defendant is not precluded from bringing forward any number of objections, but he must state with precision what they are" (*t*).

(4.) *Under Act of* 1883.

Changes in law.

Sect. 29 of the Act of 1883 differs from sect. 41 of the Act of 1852 in two points only. The words "time and place" are substituted for "place" and "manner" which appear in the earlier Act; and the provision against the admission of evidence in support of any objection of which particulars have not been delivered is no longer absolutely peremptory, but may be relaxed by leave of the Court or a judge (*u*).

Except in these particulars, and, perhaps, it should be added (*v*), in the recognition of the practice by which the validity of a patent is now simply denied in the defence, "on the grounds stated in the particulars of objection delivered" therewith, the present Act and the Act of 1852 do not materially differ, so far as notice of objections are concerned.

Cases under this Act are:—

Cases under Act of 1883.

If a defendant disputes the validity of a patent on the ground of want of novelty he must state reasonably on what grounds, in respect of want of novelty, he relies; and must also state the time and place of the alleged prior publication or user (*x*).

Pages, lines, &c. to be given of prior publication.

Where anticipation in (a) a prior specification, or (b) publication, is alleged, the defendant must, as was necessary under the Act of 1852, in the case of (a), refer to pages, lines, and claiming clauses (*y*), and in the case of (b) to the part or parts of the work where the alleged prior publication is to be found (*z*).

Details of variance of provisional

In the *Anglo-American Brush Electric Corporation* v. *Crompton* (*a*), the defendant, who alleged, *inter alia*, variance between the pro-

(*s*) 1833, 1 Web. P. C. at p. 268.

(*t*) See *supra*, p. 297.

(*u*) *Britain* v. *Hirsch*, 1888, 5 P. O. R. 226.

(*v*) Cp. *Kurtz* v. *Spence*, 1887, 36 Ch. D. 776.

(*x*) *Fowler* v. *Gaul*, 1886, 3 P. O. R. per Denman, J., at p. 250. Cp. *Boyd* v. *Horrocks*, 1886, 3 P. O. R. per Bristowe, V.-C., at p. 287.

(*y*) *Harris* v. *Rothwell*, 1886, 3 P. O. R. 243; *Fowler* v. *Gaul*, *ibid.* 247; *Boyd* v. *Horrocks*, *ibid.* 285; *Boyd* v. *Farrar*, 1888, 5 P. O. R. 33, 36.

(*z*) *Harris* v. *Rothwell*, *ubi supra*, at p. 246.

(*a*) 1887, 4 P. O. R. 27.

visional and the complete specifications of the plaintiffs' invention, was compelled to point out in his particulars the alleged nonconformity.

and complete specifications necessary.

In the subsequent case of *Crompton* v. *Anglo-American Brush Electric Corporation* (*b*)—an action for the infringement of a patent for improvements in dynamo-electric machines—the defendants denied the validity of the patent, and alleged as one of their particulars of objection insufficiency of the specification. The notice of objection upon this point originally ran: "The specification does not sufficiently describe the nature of the said invention, and in what manner the same is to be performed." The plaintiffs having obtained an order for further and better particulars of this objection, the defendants so amended it as, in effect, to allege that the specification was insufficient to enable a competent workman to construct a machine which would answer the purpose of the alleged invention. It was held by the Court of Appeal, affirming the decision of Kay, J., in chambers, that the objection, even in its amended form, was insufficient, and that if the defendants knew exactly where the defect was they were bound to point it out.

Insufficiency of specification.

Their lordships, however, expressly guarded themselves from affirming that a defendant must show a plaintiff how to amend his specification; and the decision seems to have turned upon *the admission by the defendants* that they knew something more than they had disclosed in the objections.

This case differs from that of the *Anglo-American Brush Electric Corporation* v. *Crompton* (*c*), because there the question was whether the complete specification agreed with the provisional specification; and it was obvious that if the particular point in which that difference was said to exist was not stated, the plaintiffs would not be able to bring the evidence which might have entirely

(*b*) *Ibid.* 197. In *Blakey* v. *Latham* (1889, 6 P. O. R. 36), the particulars of objections stated that an alleged anticipation was exhibited by a person travelling for orders. At the trial evidence was given that hundreds of these alleged anticipations were made. The plaintiffs asked for and obtained leave to bring rebutting evidence to disprove the making of these hundreds, on the ground that the particulars only described an experiment. In their rebutting evidence the plaintiffs attempted to prove that the article was never made at all. The defendants were allowed to bring further evidence on this point.

An example of the class of machines in question in an action may, in order to explain counsel's argument, be handed up and looked at, and cannot be objected to on the ground that it is not in evidence: *Boyd* v. *Horrocks*, 1889, 6 P. O. R. 154.

In an action on a licensing agreement, evidence as to the state of public knowledge at the date of the patent is inadmissible, except in cases where the licensor's specification is ambiguous and requires explanation: *Crossthwaite* v. *Steel*, 1889, 6 P. O. R. 192.

(*c*) 1887, 4 P. O. R. 27.

displaced the apparent objection from merely looking at the two documents (*c*).

Evidence of general knowledge.

There is no enactment that particulars of objections should be given of general public knowledge, though the defendant, in order to rely on general public knowledge, must take that objection. General public knowledge must be proved by ordinary evidence, with reference to well-known books if necessary (*d*).

Evidence of anticipation.

In framing particulars of objections, care should be taken not to put forward a long list of anticipations of which only two or three are relied on at the trial (*e*).

Where a large number of specifications and books were relied upon as anticipations, defendants were required to specify where in particular the anticipation was to be found without giving pages and lines (*f*).

Sect. 9.—Amendment of Particulars.

By summons or motion.

An order for further and better particulars may be made on summons, by a judge in chambers (*g*), or on motion in Court (*h*).

Where the particulars of breaches or objections, originally delivered, are too general, it is the business of the parties who mean to object to them to bring the case before a judge in chambers, and procure an order, otherwise evidence which is within the literal meaning of the particulars, however general the statement, may be received at the trial (*i*).

Full particulars should be obtained before trial.

"In my opinion," said Mellish, L. J., dealing with this point in *Sugg* v. *Silber* (*j*), "there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. If, wherever the Court would order further particulars because the objection had

(*c*) 1887, 4 P. O. R., per Cotton, L. J. at p. 200.

(*d*) *Holliday* v. *Heppenstall*, 1889, 6 P. O. R. 326. Cp. *Automatic Co.* v. *Knight*, 1889, 6 P. O. R. 302; *Phillips* v. *Ivel Cycle Co.*, 1890, 7 P. O. R. 77.

(*e*) *Thomson* v. *Batty*, 1889, 6 P. O. R. 84.

(*f*) *Holliday* v. *Heppenstall*, *ubi supra*, 320.

(*g*) R. S. C. 1883, Ord. XIX. r. 7.

(*h*) J. A. 1873, s. 39; Patents Act, 1883, s. 29; R. S. C. 1883, Ord. LII. r. 1. In *Blakey* v. *Latham*, 1889, 6 P. O. R. 29, particulars were allowed to be amended in the course of the trial. In *Darrah* v. *Purser*, 1889, 6 P. O. R. 365, an objection of alleged common user for analogous purposes was allowed to be added by amendment, but particulars of time and place were ordered to be given. See form of order for amendment in *Baird* v. *Moule's, &c. Co.*, 1876, L. R. 17 Ch. D. 139.

(*i*) *Hull* v. *Bollard*, 1856, per Pollock, C. B., 1 H. & N. at p. 137; 25 L. J. Ex. 304.

(*j*) 1874–77, L. R. 2 Q. B. D. 493, 495.

not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars."

In *Hull* v. *Bollard* (*k*)—an action for the infringement of a patent for a mill-stone—the particulars of objections delivered under the Act of 1852, s. 41, stated that the alleged invention had been "*publicly used in corn-mills* for many years previously." At the trial the defendant tendered evidence of prior user at certain mills in Cheshire. It was held that the evidence was admissible. "It is true," said Pollock, C. B., "that the statute contains a proviso that the *place* or *places* at which the invention is alleged to have been used shall be stated, but that proviso does not prevent particulars not containing such statement from being available if not objected to on that ground before the trial."

Failure to comply with order for better particulars.

If a defendant fail to comply with an order for better particulars, it would seem that the proper course is to apply to have the insufficiently-stated objection struck out (*l*); and if the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (*m*).

Time for pleading after delivery of particulars.

By the Rules of 1883 (*n*), the party at whose instance particulars have been delivered under a judge's order shall, unless the order otherwise provides, have the same length of time for pleading after the delivery of the particulars that he had at the return of the summons. Save as in this rule provided, an order for particulars shall not, unless the order otherwise provides, operate as a stay of proceedings, or give any extension of time (*o*).

Sect. 10.—Inspection and Discovery.

(1.) *Inspection.*

Former practice as to.

"There is no use in this Court," said Lord Eldon in 1815 (*p*), "directing an action to be brought, if it does not possess the power to have the action properly tried."

The right to order an inspection is here treated as inherent in the jurisdiction of the Courts, at least of Equity.

Such orders were, in fact, chiefly made by these Courts till 1852.

(*k*) *Hull* v. *Bollard*, 1856, per Pollock, C. B., 1 H. & N. at p. 137.

(*l*) *Flower* v. *Lloyd*, 20 S. J. 860.

(*m*) *Penn* v. *Bibby*, 1866, L. R. 1 Eq. 548; *Grover and Baker Sewing Machine Co.* v. *Wilson*, W. N. 1870, p. 78.

(*n*) R. S. C. 1883, Ord. XIX. r. 8.

(*o*) *Boyd* v. *Farrar*, 1888, 5 P. O. R. 33, 36.

(*p*) *Bovill* v. *Moore*, 1815, 1816, 2 Coop. C. C. 56, n.; reported as *Brown* v. *Moore*, 3 Bligh, 178. See Lawson, 219.

In that year the Patent Law Amendment Act extended this equitable jurisdiction to the Courts of Common Law (s. 42). The power to order inspection conferred by that Act was, however, limited as regards its subject-matter to machinery and did not extend to books (*q*).

The production and inspection of documents might be obtained under the provisions of the Common Law Procedure Acts, 1852 and 1854; but such inspection was not ordered where the applicant's affidavits disclosed *a mere possibility* of advantage accruing to him thereby (*r*).

Practice under R. S. C. 1883.

Under the Rules of the Supreme Court, 1883, Ord. L., the widest powers of ordering an inspection are conferred on the various divisions of the High Court. The only practical limit to the discretion of the Court is the necessity of the information claimed for the purposes of the trial (*s*).

Samples, &c.

Samples may now be taken, observations made, and experiments conducted (*t*).

Application for, how made.

An application for inspection may be made and in exceptional cases will be granted (*u*) *ex parte* (*s*); it may be made at any time during the progress of an action, even before the delivery of claim (*x*), and the express terms of Ord. L. r. 6 leave no doubt that an adverse order for inspection may be made upon the plaintiff in an action for infringement (*y*).

Under Ord. L. r. 3, the Court may now authorize any person for the purpose of inspection to enter any land or building in the possession of any party. Obedience to an order for inspection may, therefore, be asserted forcibly, and not simply as before by process of contempt (*z*).

The application in the Chancery Division should be made by motion to the Court, and notice of motion should be given (*a*).

(*q*) *Vidi* v. *Smith*, 1854, 23 L. T. 231; *Saxby* v. *Easterbrook*, 1872, L. R. 7 Ex. 207; *Amies* v. *Kelsey*, 1852, 22 L. J. Q. B. 81.

(*r*) *Smith* v. *G. W. Rail. Co.*, 1854, 3 W. R.; 69 Macr. P. C. 221.

(*s*) Where the right to inspection appears to depend on the determination of any issue or question in the cause, the Court may if it thinks fit order that such issue shall be determined first, and reserve the question as to the inspection. Ord. XXXI. r. 20.

(*t*) Ord. XXX. r. 3; cp. *Badische Anilin, &c.* v. *Levinstein*, 24 Ch. D. 156; *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. 11.

(*u*) *Hennessy* v. *Bohmann*, W. N. 1877, 14.

(*x*) Dan. Prec. Ch. 1451.

(*y*) *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. 11; *Cheetham* v. *Oldham*, 1888, 5 P. O. R. at p. 623; and see earlier cases, *Russell* v. *Cowley*, 1832, 1 Web. P. C. 459, by consent; *Russell* v. *Crichton*, 1837, 1 Web. P. C. 677 n., 15 Dec. Court of Sess. 1270; *Patent Type Founding Co.* v. *Walter*, 1860, 29 L. J. Ex. 207; *Davenport* v. *Jepson*, 1862, 1 N. R. 307.

(*z*) *East India Co.* v. *Kynaston*, 1821, 3 Bligh, 153, 163, 166.

(*a*) *Habershon* v. *Gill*, W. N. 1875, 231.

In the Queen's Bench Division the application is to a judge in Chambers (*b*).

Laches sufficient to defeat the plaintiff's right to an interlocutory injunction is no bar to an order on the same motion for inspection and samples (*c*). Laches.

In order to succeed on an application for inspection, the applicant must show by affidavit:

Evidence to support motion for inspection.

1. That he is the patentee of an invention, and what it is (*d*).
2. That the defendant has infringed.

The Court will not grant an order for the inspection of a machine upon an affidavit "that the machine used by the defendants is the same for which the plaintiff has obtained a patent." The affidavit ought, at least, to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement (*e*), and should set forth the grounds of such belief (*f*).

Primâ facie evidence of infringement will be sufficient (*g*).

3. That the inspection sought for is material to his case (*h*). Inspection is not "material" in this sense, when the plaintiff has already had, in a discontinued action against the defendant, inspection of the machinery complained of (*i*).

If the *primâ facie* evidence above referred to is satisfactory, an order for inspection will be made, almost of course (*k*).

Refusal to order inspection.

Inspection will, however, be refused where, in the opinion of the Court—

(1.) There is no case to try at the hearing (*l*);

(2.) The effect of an order would be to oppress the defendant, or make him disclose more than was necessary for the purposes of the cause (*m*).

Objection that in-

An objection that an order for inspection would lead to the

(*b*) Ord. XXXIV. r. 12; Ord. XXXV. r. 6.

(*c*) *Patent Type Founding Co.* v. *Walter*, 1860, Johns. 727.

(*d*) *Meadows* v. *Kirkman*, 1860, 29 L. J. Exch. 205.

(*e*) *Shaw* v. *Bank of England*, 1852, 22 L. J. Ex. 26.

(*f*) *Germ Milling Co.* v. *Robinson*, 1884, 1 P. O. R. 217.

(*g*) *Shaw* v. *The Bank of England*, *ubi supra*; *Singer Manufacturing Co.* v. *Wilson*, 1865, 13 W. R. 560; *Batley* v. *Kynock*, 1874-75, L. R. 19 Eq. 90, 92.

(*h*) *Piggott* v. *Anglo-American Telegraph Co.*, 1868, 19 L. T. N. S. 46.

(*i*) *Shaw* v. *Bank of England*, *ubi supra*.

(*k*) *Singer Manufacturing Co.* v. *Wilson*, 1865, 13 W. R. 560.

(*l*) *Piggott* v. *Anglo-American Telegraph Co.*, *ubi supra*. The question of disconformity between the complete and the provisional specification will not be considered on an application for inspection. *Cheetham* v. *Oldham*, 1888, 5 P. O. R. at p. 618.

(*m*) *Singer Manufacturing Co.* v. *Wilson*, *supra*; *Cheetham* v. *Oldham*, 1888, 5 P. O. R. 617.

spection will lead to disclosure of trade secrets.

disclosure of trade secrets will not generally prevail if the case for inspection is otherwise satisfactory (*n*).

If this were not the law, any patent might be infringed with impunity (*o*).

The Court will, at the proper time, protect the defendant from an improper disclosure of his secret (*n*).

Form of order.

The order for inspection (*p*) usually specifies the number of inspections allowed (*q*), the names of the inspectors, and the notice to which the person against whom the order is made shall be entitled (*r*).

(2.) *Discovery.*

Existing law.

The existing law as to discovery is contained in Ord. XXXI. of the Rules of the Supreme Court, 1883. Its chief provisions, so far as relate to actions of infringement, are as follows :—

Application for interrogatories.

The plaintiff or defendant in a patent action may (the statutory right to particulars notwithstanding (*s*)), by leave of the Court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties (*t*). The Court or a judge has the same power to prevent premature discovery as it has to prevent premature inspection (*u*).

The costs of discovery, by interrogatories or otherwise, must be secured in the first instance by the applicant (*x*).

An application for interrogatories is formally sufficient if it state their general object and scope, and the judge will not, in such a case, decide upon the relevancy of particular interrogatories (*y*).

Interrogatories must be answered categorically and completely.

A defendant against whom an order for discovery is made must answer, technically and categorically, every question which can assist the plaintiff in making out his title to relief (*z*).

The following illustrations will show at once the application and the limits of this rule:—

Cases.

A defendant denying infringement must answer everything tending to show the fact of infringement, but not questions which

(*n*) *Renard* v. *Levinstein*, 1864-65, per Wood, V.-C., 10 L. T. N. S. 95; *Cheetham* v. *Oldham*, 1888, 5 P. O. R. 617.

(*o*) *Russell* v. *Crichton*, 1837, 15th Dec., Court of Sess. 1st Ser. 1270.

(*p*) See Seton, 350.

(*q*) *Heathfield* v. *Braby*, Seton, 1661. But see *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. 11.

(*r*) Pemberton, p. 236.

(*s*) *Birch* v. *Mather*, 1883, 22 Ch. D. 629; *Haddan's Patent*, 1884-85, 54 L. J. Ch. 126; *Germ Milling Co.* v. *Robinson*, 1884, 1 P. O. R. 218; *Moseley* v. *Victoria Rubber Co.*, 1886, 3 P. O. R. 351, 356. The law is the same as to administering interrogatories to a plaintiff. *Hoffmann* v. *Postill*, 1869, L. R. 4 Ch. 673, 679; *Ehrlich* v. *Ihle*, 1888, 5 P. O. R. 37.

(*t*) Rule 1.

(*u*) Rule 20.

(*x*) Rule 25.

(*y*) *Hall* v. *Liardet*, W. N. 1883, 165, 175, 194.

(*z*) *Swinborne* v. *Nelson*, 1852-53, per Romilly, M. R., 16 Beav. 416, 417; 22 L. J. Ch. 331; *Elmer* v. *Creasy*, 1873, L. R. 9 Ch. 69; *Saull* v. *Browne*, 1874, *ib.* 364; *Bourn* v. *Samson*, 1888, 5 P. O. R. 510.

assume that infringement has taken place, and answers to which will be obtained at the hearing, provided that infringement be then established (*a*).

Under this proposition, the following matters have been held (a) to show the fact of infringement; (b) to assume the infringement, and to be more properly reserved for the trial:—

(a) Whether the defendant used the materials mentioned in the plaintiff's specification.

Whether he added anything else.

Whether the additions made any difference in the process (*b*).

Whether the defendant's process was the same as that used by A. B., against whom the plaintiff had already instituted and prosecuted a successful suit (*c*).

(b) Whether machines of which the defendant was required to set out an account were purchased or hired, and, if purchased, what was the consideration for the purchase.

An account of envelopes manufactured by any machine used by the defendants, and discovery of the persons to whom such envelopes had been sold.

Accounts of the sales of such envelopes, the profits made by defendants, the stock in hand of such envelopes, and an account of moneys received by and due to the defendants in respect thereof (*d*).

Defendant not denying infringement.

When a defendant does not deny infringement, he is bound, in answer to interrogatories, to furnish the names and addresses of the persons to whom the infringing machines were sold, although his answers may expose such persons to legal proceedings (*e*).

When, however, in such a case the defendant admits sales which will give to the plaintiff at once, in the event of his establishing the validity of his patent, a right to damages, or to an account, he need not answer interrogatories as to sales to particular customers (*f*).

Principles on which Court acts in allowing inspection.

Although, when discovery is a matter of indifference to the defendant, the Court does not weigh in golden scales the question of materiality or immateriality, still, when the nature of the dis-

(*a*) *De la Rue* v. *Dickinson*, 1857, per Wood, V.-C., 3 K. & J. 391; *Lister* v. *Norton*, 1885, 2 P. O. R. 68; *Lea* v. *Saxby*, 32 L. T. N. S. 731.

(*b*) *Renard* v. *Levinstein*, 1864, 10 L. T. N. S. 94; *Rolls* v. *Isaacs*, 1878, W. N. 1878, 37.

(*c*) *Bovill* v. *Smith*, 1866, L. R. 2 Eq. 459.

(*d*) *De la Rue* v. *Dickinson*, 1857, 3 K. & J. 388.

(*e*) *Tetley* v. *Easton*, 1856, 18 C. B. 643; *Jourdain* v. *Palmer*, 1866, L. R. 1 Ex. 102.

(*f*) *Lister* v. *Norton*, 1885, 2 P. O. R. 68; cp. *Crossley* v. *Toney*, 2 Ch. D. 533.

covery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs (*g*).

A plaintiff has no right to inquire by interrogatories into the defendant's case, or to ask for the names of the witnesses whom he intends to produce, or the names of persons to whom he has sold articles similar to the machine alleged to be infringed, or to require a description of all machines similar to the plaintiff's made or used by him prior to the patent (*h*).

In *Garrard* v. *Edge* (*i*), an action for infringement, the defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars. The plaintiff applied before the trial for an order for the production by the defendants of the articles to be proved by the specified persons at the trial. Kay, J., refused the application. The plaintiff appealed. It was held, on appeal, that there was no precedent for such an order, and that, on principle, it ought not to be made.

Disclosure of trade secrets by inspection.

The law above stated (*j*) as to the disclosure of trade secrets by inspection applies to discovery (*k*).

In *Badische Anilin, &c.* v. *Levinstein* (*l*), Pearson, J., allowed the defendant's secret process to be disclosed *in camerâ*, and ordered the shorthand notes to be impounded in Court.

Communications to patent agent not privileged.

Communications made to a solicitor in his capacity of patent agent are not privileged from disclosure (*m*).

Disclosure of documents.

Reports and letters obtained from their officers by a company which had been warned, but not threatened, with actual litigation in respect of an alleged infringement of a patent, were held not to be privileged (*n*).

Interroga-

In answering interrogatories filed by a defendant for the exa-

(*g*) *Moore* v. *Craven*, L. R. 7 Ch. 94, 96, n.; *Daw* v. *Eley*, 1865, 2 H. & M. 725; *Simpson* v. *Charlesworth*, W. N. 1866, 255; *Rolls* v. *Isaacs*, 1878, W. N. 1878, 37. As to administering interrogatories to a plaintiff, see *Hoffmann* v. *Postill*, 1869, L. R. 4 Ch. 673; *Edison, &c. Co.* v. *Holland*, 1888, 5 P. O. R. 216; *Hall* v. *Truman, Hanbury & Co.*, 1885, 29 Ch. D. 347.

(*h*) *Daw* v *Eley*, *ubi supra*.

(*i*) 1889, 6 P. O. R. 372.

(*j*) *Supra*, p. 307.

(*k*) *Renard* v. *Levinstein*, 1864, 10 L. T. N. S. 94.

(*l*) 1883, 24 Ch. D. 156, 158.

(*m*) *Moseley* v. *The Victoria Rubber Co.*, 1886, 3 P. O. R. at p. 354.

(*n*) *Westinghouse* v. *Midland Rail. Co.*, 1883, 48 L. T. N. S. 98, 462; and cp. *Haslam Co.* v. *Hall*, 1888, 5 P. O. R. 1.

mination of the plaintiff, the general rule applies, that he who is bound to answer must answer fully. Discovery by defendant.

There is, however, this difference: A plaintiff is not entitled to discovery of the defendant's case, whereas a defendant may ask any question tending to destroy the plaintiff's claim (*o*).

Sect. 11.—Mode of Trial.

(1.) *Former Practice and Objections thereto. Issues.*

Actions for infringement were originally tried before a judge and a special jury, taken from the same class of persons as those who were engaged in the trial of ordinary causes (*p*). Judge and jury.

The unfitness of the constitutional tribunal for the trial of patent actions gradually came, however, to be recognised, and was strongly insisted upon by the most eminent legal and scientific witnesses before the Parliamentary Committees of 1851, 1865, 1871, and 1872.

"Where there are long and difficult specifications to be read through, and to be construed and understood, and drawings and models to be looked at, it is quite impossible for twelve men in a jury-box to understand either the specifications, the drawings, or the models. They have no opportunity of inspecting the models, which require to be seen from different points of view, and thoroughly explained and examined. Yet the jurymen have to decide upon those very models, and upon the minute differences which may happen to exist in complicated machinery. The consequence is that trials now frequently become abortive. There was one case before Vice-Chancellor Wood occupying nine days, where the jury were unable to give a verdict; and in the same week there was a case before Lord Chief Justice Erle, which took six trying days, in which the jury were again discharged without coming to a decision" (*q*). Objections to trial of patent actions by jury.

"In consequence of their being unable to understand the merits they look out for some topic of prejudice upon which they can hang their verdict. If they can be induced to think that a man has had advantages for looking at a machine, or if they think that he has obtained information from a servant, they are very apt to be led away by that which they do understand—namely, that there

(*o*) *Hoffmann* v. *Postill*, 1869, L. R. 4 Ch. 673.

(*p*) Report, &c., 1865, Ans. 1274.

(*q*) Report, 1865; Evidence of Montague E. Smith, Esq., Q.C., M.P., Ans. 1272.

has been some attempt made, at all events, to get at the means of imitation, and they are very apt to jump at the conclusion that the thing has been imitated" (*r*).

"In the case of *Betts* v. *Menzies*—which was tried before Mr. Justice Erle, then a judge of the Court of Queen's Bench—after a trial of six days, the jury brought in a verdict, but some of them accompanied it with the remark that it was very unsatisfactory, for that they believed that they did not understand it; and Mr. Justice Erle said upon that: 'Well, then, gentlemen, I am afraid that that remark of yours has rendered our week's work of no value!'" (*s*).

The general consensus of opinion at these inquiries upon the subject of the mode of trial of patent actions, may be summed up as follows:—

(1) That in actions of infringement the advantages (*t*) of trial by jury might safely be surrendered;

(2) That in any arrangement which might be made the ultimate power to decide such actions must rest with the judge; and

(3) That the least objectionable change would be to give the judge trying an action for infringement the option of calling in the aid of a specially qualified assessor, selected *pro re nâta*.

Lord Cairns on trial by jury at common law.

"If," said Lord Cairns in *Borill* v. *Hitchcock* (*u*), "the Court thinks it best that a question should be tried before a jury, a jury can be had, but if in the opinion of the Court a trial without a jury is preferable, neither party can claim a jury as a matter of right. It is a fallacy to say that under the old practice the Court required a legal question to be tried by jury. What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment, but these cases were sent to law not that they might be tried by a jury, but because this Court had not jurisdiction to decide upon a legal right."

The general objections to a jury as a tribunal for the trial of

(*r*) Report, &c., 1865, Ans. 1273.

(*s*) *Ibid.* 1279.

(*t*) Cp. Evidence of Mr. Grove, Report, 1865, Ans. 1077. "I have always had a very strong feeling in favour of trial by jury, but I think that it hardly suits patent cases upon the whole. The advantages of a jury are very great; it prevents the fixity of character of mind which exists in a single judge, or in a judicial tribunal; however anxious to do right, they probably will have certain views of their own. The dual advantage of a jury, to my mind, is that it is a constantly fluctuating tribunal, consisting of a number of men, each of whom is devoting his individual mind to the particular question."

(*u*) 1868, L. R. 3 Ch. 117.

patent cases were forcibly stated by Lord Selborne in the *Patent Marine Inventions Co.* v. *Chadburn* (*x*) :—

Lord Selborne on objections to trial of patent cases by jury.

"It is to be observed that such cases almost always involved questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence, in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge."

Issues granted by Court of Chancery under old practice.

The following issues were granted by the Court of Chancery under the old practice :—

1. Is the invention a new manufacture?
2. Was the patentee the true and first inventor?
3. Is the specification sufficient?
4. Has the defendant infringed?
5. Is the invention one of public utility?
6. Is the invention described in the specification the same as that for which the patent is granted?

Issues.

Of these issues, 1, 2, 3, 4, were those directed in *Davenport* v. *Jepson* (*y*); 5, was added in *Renard* v. *Levinstein* (*z*), and 6, was allowed in *Needham* v. *Oxley* (*a*). In *Plimpton* v. *Malcolmson* (*b*), upon an issue as to the sufficiency of the specification, the defendant was permitted to dispute the utility of parts of the alleged invention; and in *Penn* v. *Bibby* (*c*), the objection of material variance between the provisional and complete specifications was allowed to be taken under the same issue.

The first and second of the issues above mentioned, were

(*x*) 1873, L. R. 16 Eq. 447.
(*y*) 1862, 1 N. R. 173.
(*z*) 1864, 1865, 11 L. T. N. S. 766; cp. *Spencer* v. *Jack*, 1862, 1864, 11 L. T. N. S. 242; *Penn* v. *Jack*, 1866, 14 L. T. N. S. 496.
(*a*) 1863, 8 L. T. N. S. 532.
(*b*) 1875, 3 Ch. D. 531, 336.
(*c*) 1866, L. R. 2 Ch. 127, 130.

treated as distinct; and in *Spencer* v. *Jack* (*c*), where on a motion for injunction, Lord Romilly, M.R., had directed an issue—Is it a new invention or manufacture? the Lords Justices on appeal severed the question of newness of invention from that of newness of manufacture. An objection that "the invention is not the subject of letters patent" is not a proper issue (*d*).

An issue as to infringement was not directed by the Court of Chancery unless the infringement was denied by the defendants (*e*). A defendant was not allowed to add a totally new issue of fact not in any way suggested by his answer to issues already directed for trial: but in order to raise such a new issue was required to file a supplemental answer (*f*).

Old rule as to sending case to jury, and issues.

Neither party could insist, *ex debito justitiæ*, upon having a patent case referred to a jury, and a reference was, in general, refused where either the case was clear or the issues had been already determined. But if there was a really doubtful question at issue, the Court would not decide it for itself if either party desired a jury (*g*).

In the case of *Davenport* v. *Goldberg* (*g*), in which these rules were laid down, it appeared that the patent in question had been the subject of three previous proceedings. In the first (*h*), there had been a trial before a jury: the plaintiffs had been non-suited on the ground that the specification was insufficient; but the non-suit was afterwards set aside by the Court of Queen's Bench, and the plaintiffs signed judgment and obtained a decree. In the second proceeding (*i*), the plaintiffs had filed a bill against one Jepson, when a decree was made for a perpetual injunction. In a subsequent action against Jepson he did not appear and a verdict was taken for the plaintiffs. The defendant in *Davenport* v. *Goldberg* put in issue every point which had been raised in *Davenport* v. *Jepson*, and moved for a reference to a special jury (*k*) of the disputed questions of fact. Wood, V.-C., refused to grant issues on the questions of novelty and invention, but put the plaintiffs to prove the alleged infringement before a jury.

Issue of infringement alone sent to jury.

(*c*) See note (*z*), *ante*, p. 313.

(*d*) *Penn* v. *Jack*, 1866, 14 W. R. 760.

(*e*) *Davenport* v. *Phillips*, 1865, 5 N. R. 485.

(*f*) *Morgan* v. *Fuller*, 1866, L. R. 2 Eq. 296.

(*g*) *Davenport* v. *Goldberg*, 1865, 2 H. & M. 282.

(*h*) *Davenport* v. *Richards*, 1860, 3 L. T. N. S. 503.

(*i*) *Davenport* v. *Jepson*, 1862, 1 N. R. 173, 307.

(*k*) When questions of fact were determined by a special jury before the Court of Chancery itself, it was not necessary to certify, under 21 & 22 Vict. c. 27, for the special jury. *Needham* v. *Oxley*, 2 N. R. 388.

"No person," said his lordship (*l*), "is entitled to come here and say, 'I raise such and such a question, and ask for a jury *ex debito justitiæ*,' although there are certain classes of cases in which the course of the Court is, if the matter be new, not to decide important disputed questions of fact without the assistance of a verdict. . . . . On the question of infringement, it appears that the matter is so doubtful that the plaintiffs did not venture to prove their motion for an interlocutory injunction, and I must therefore take it that there is such a *bonâ fide* contest of fact on that point that I ought to send that question to a jury if the defendant desire it."

When the plaintiff's counsel, in his opening statement, made charges which were not raised by the pleadings, and the defendant's counsel thereupon asked for a jury, the application was acceded to, and the cause ordered to stand over (*m*).

The usual issues might be granted in a patent suit *before* the hearing of the cause, although the defendant denied the validity of the patent (*n*).

In *Roskell* v. *Whitworth* (*o*), Giffard, L. J., held, that while there was no inflexible rule as to the stage of a cause at which issues would, on the application of the defendant, be directed to be tried by a jury, the Court would require strong proof that the case was one which it could not satisfactorily try, if the defendant made the application not on the occasion of a motion for injunction or a motion to dissolve an injunction, but by an independent motion at any other time, and especially if it was after the disclosure of the plaintiff's evidence.

In *Hoffmann* v. *Postill* (*p*), Giffard, V.-C., intimated that in future he should treat the hearing of issues in patent cases as the hearing of the cause, and would not advance them before the cases in the paper except upon a special case made.

In *Henderson* v. *Runcorn Soap and Alkali Co.* (*q*) the same learned judge stated that he would never grant a trial of issues at the request of the defendant, when opposed by the plaintiff.

Effect of Judicature Act and Rules on trial by jury.

Under the Rules made in pursuance of the Judicature Act, 1875, an adverse order for the trial of a patent action without a

(*l*) 2 H. & M. at p. 285; Cp. *Bovill* v. *Goodier*, 1865-67, L. R. 2 Eq. 195; *Bovill* v. *Hitchcock*, 1868, L. R. 3 Ch. 417.

(*m*) *Tangye* v. *Stott*, 1865, 14 W. R. 128.

(*n*) *Arnold* v. *Bradbury*, 1871, L. R. 6 Ch. 706, reversing the decision of the V.-C., 24 L. T. N. S. 613.

(*o*) 1870, L. R. 5 Ch. 459.

(*p*) 1868, 19 L. T. N. S. 276.

(*q*) 1868, 19 L. T. N. S. 377.

jury might be made, such an action having been, before the passing of the Judicature Acts, one which "without any consent of parties could be tried without a jury" (*r*).

On the other hand, there was no power given by the Judicature Rules to a Court of law to take away from a defendant his right under Ord. XXXVI. r. 26, of those rules to insist upon trial by jury (*s*).

When the Court was sitting without a jury, it did not require the same strictness in matters of pleading as was necessary in a trial before a jury, but followed that course of procedure which it deemed best to diminish expense, and to hasten the determination of the suit.

Thus in *Renard* v. *Levinstein* (*t*), where the defendant had given no notice of objection to the plaintiff's patent, on the ground of prior publication up to the time of hearing, and only gave notice of such objection after the plaintiff's case was closed and his own had been opened, a motion by him to amend his particulars of objection by adding an allegation of prior publication in a given document was allowed.

In order to bring a case within the proviso contained in sect. 2 of Sir John Rolt's Act (25 & 26 Vict. c. 42), authorizing the Court of Chancery, notwithstanding the Act, whenever it appeared that a question of fact might be more conveniently tried by a jury at the assizes, to direct such trial, it was held in *Young* v. *Fernie* (*u*) that the Court of Chancery must be satisfied that the administration of justice would be more conveniently exercised and promoted by directing such issues, than by completing the hearing and inquiry before itself.

The practice introduced into Chancery of having separate issues was not peremptory, and was merely a convenient mode of arranging the questions to be decided by the Court (*x*).

(2.) *Existing Practice.*

The Patents Act, 1883 (*y*), provides that actions for infringement shall be tried *without* a jury, unless the Court shall otherwise direct.

(*r*) See R. S. C. 1883, Ord. XXXVI. r. 4, re-enacting r. 26 of the Order of 1875; *Patent Marine Inventions Co.* v. *Chadburn*, 1873, L. R. 16 Eq. 447; cp. also, *Swindell* v. *Birmingham Syndicate*, 1876, L. R. 3 Ch. D. 127; *Back* v. *Hay*, 1877, L. R. 5 Ch. D. 235; *Bordier* v. *Burrell*, 1877, L. R. 5 Ch. D. 515.

(*s*) *Sugg* v. *Silber*, 1874-77, 1 Q. B. D. 362.

(*t*) 1864-65, 11 L. T. N. S. 505; Agnew, 320.

(*u*) 1863, 1 De G. J. & S. 353.

(*x*) *Curtis* v. *Platt*, 1864, 11 L. T. N. S. 250.

(*y*) Sect. 28, sub-sect. 1.

Rules of Supreme Court as to trial of patent actions.

The Judicature Acts, and the Rules of the Supreme Court, 1883, contain a number of provisions applicable to the trial of patent actions.

The Court or a judge may, in any cause or matter requiring any scientific investigation, which cannot, in the opinion of the Court or a judge, conveniently be made before a jury, or conducted by the Court through its ordinary officers, order any question or issue to be tried before an official referee (*z*); and an action for infringement has been held to be an action requiring "scientific investigation" within the meaning of this rule (*a*).

The Court or a judge may direct the trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts, or any scientific or local investigation which cannot, in their or his opinion, conveniently be made with a jury (*b*).

The Court or a judge may at any time order any cause, matter, or issue, to be tried by a judge with a jury (*c*), or by a judge sitting with assessors, or by an official referee or special referee with or without assessors (*d*).

The report of any such referee may be wholly or partially adopted by the Court (*e*).

Power to direct issues.

Where, in any cause or matter, it appears to the Court or a judge that the issues of fact in dispute are not sufficiently defined, the parties may be directed to prepare issues, and such issues shall, if the parties differ, be settled by the Court or a judge (*f*).

Trial without pleadings.

When the parties to a cause or matter are agreed as to the questions of fact to be decided between them, they may, after writ issued, and before judgment, by consent and order of the Court or a judge, proceed to the trial of any such question of fact without formal pleadings (*g*).

Determination of question of law before issues of fact gone into.

If it appear to the Court or a judge that there is, in any cause or matter, a question of law which it would be convenient to have decided before any evidence is given or any question or issue of fact is tried, or before any reference is made to a referee or an

(*z*) Jud. Act, 1873, r. 57.

(*a*) *Saxby* v. *Gloucester Waggon Co.*, 1880-81, W. N. 1880, p. 28; L. R. 7 Q. B. D. 305.

(*b*) R. S. C. 1883, Ord. XXXVI. r. 5.

(*c*) Trial by jury cannot be had before a judge of the Chancery Division. *Warner* v. *Murdoch*, 1877, 4 Ch. D. 750.

(*d*) R. S. C. 1883, Ord. XXXVI. r. 7.

(*e*) R. S. C. 1883, Ord. XXXVI. r. 55; Cp. *Badische Anilin und Soda Fabrik* v. *Levinstein*, per Pearson, J., 24 Ch. D. 156; *Moore* v. *Bennett*, 1881, 1 P. O. R. C. A. pp. 129, 133; *Edison Co.* v. *Holland*, 1888, 5 P. O. R. 459, 480.

(*f*) R. S. C. 1883, Ord. XXXIII. r. 1.

(*g*) *Ibid.*, Ord. XXXIV. r. 9.

arbitrator, the Court or judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the Court, either by special case, or in such other manner as the Court or judge may deem expedient, and all such further proceedings as the decision of such questions of law may render unnecessary may thereupon be stayed (*h*).

Questions of fact may be tried differently or one before the other.

The Court or a judge may, in any cause or matter, at any time or from time to time, order that different questions of fact arising therein be tried by different modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials, and in all cases may order that one or more issues of fact be tried before any other or others (*i*).

There have been several decisions under this rule.

Cases.

In *United Telephone Co.* v. *Mottishead* (*k*), where the defendants denied both the validity of the patent, and the alleged infringement, it was held by Mr. Justice Kay that an order for the trial of the latter question by itself could not be made unless the defendants admitted the validity of the patent for the purposes of the action, and his lordship declined to take a qualified admission.

Prior user.

In *Richardson* v. *Castrey* (*l*), where the defendants denied infringement, put in issue the validity of the patent, and alleged prior user of the invention by several persons, North, J., at the trial, decided to dispose of the alleged evidence of one user before going into the others.

In *Badham* v. *Bird* (*m*), at the close of the examination of the plaintiff, who was called as first witness, the defendant's counsel undertook to prove prior user of articles admitted to be similar in all essential points to the patented article. A witness was accordingly examined on behalf of the defendant who had superintended the manufacture of such articles for some years prior to the date of the patent, and the action was thereupon dismissed.

Setting down motion for judgment where issues have been directed and tried.

Where issues have been tried, the plaintiff may at once set down a motion for judgment as soon as the issues have been determined; and where some only of the issues have been tried or determined, any party who considers that the result renders the trial or determination of the others unnecessary, or renders it desirable that such trial or determination should be postponed, may

(*h*) R. S. C. 1883, Ord. XXXIV. r. 2. Only such questions of law can properly be raised under this rule as must necessarily arise in the action. *Republic of Bolivia* v. *National Bolivian Navigation Co.*, 1876, 24 W. R. 361.

(*i*) R. S. C. 1883, Ord. XXXVI. r. 8.

(*k*) 1886, 3 P. O. R. 213.

(*l*) 1887, 4 P. O. R. 265.

(*m*) 1888, 5 P. O. R. 233.

apply to the Court for leave to set down the action or motion for judgment without waiting for such trial or determination. And the Court may give such leave upon such terms, if any, as shall appear just (*n*).

Costs of issues.

In *Blakey* v. *Latham* (*o*), where the judge was of opinion that if the patent was valid the defendants had infringed, held that the patent being invalid, the defendants were entitled to the whole costs of the action, including the costs of the issue of infringement.

In *Automatic Weighing Co.* v. *Knight* (*p*), an action for infringement, a successful defendant was ordered to pay the costs of issues on the validity of the patent unsuccessfully raised by him.

In *Boyd* v. *Horrocks* (*q*), the judge at the trial found numerous issues in favour of the plaintiffs, including infringement; the Appeal Court heard the question of infringement first, and on that dismissed the action reversing the decision of the judge. It was held, that the only order that could be made was to reverse the judgment and dismiss the action with costs without any apportionment (*r*).

(3.) *Scientific Assessors.*

Before the Act of 1852 the law officers had for some time been occasionally in the habit of summoning scientific experts to their assistance, in dealing with applications for letters patent.

Reference of provisional specification to expert.

The Act of 1852, s. 8, gave legislative sanction to this practice, providing that "the provisional specification shall be referred to the law officer, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint."

This power was, however, rarely made use of, as numerous practical difficulties arose.

Power to call in assessor.

The Patents Act, 1883, invested the Courts with the power conferred on the law officer by the Act of 1852. It is provided that—

In an action or proceeding for infringement or revocation of a

(*n*) R. S. C. 1883, Ord. XL. rr. 7, 8.
(*o*) 1889, 6 P. O. R. 29.
(*p*) 1889, 6 P. O. R. 366.
(*q*) 1889, *ibid.* 162.
(*r*) In an action to restrain threats by a patentee the plaintiff alleged the patent was invalid and that he had not infringed. At the trial he gave up the issue of validity, but a jury found there was no infringement. The plaintiff was given the general costs of the action, except the costs of the issue of validity, which were given to the defendant: *Ungar* v. *Sugg*, 1889, 6 P. O. R. 337.

patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance (*a*).

Also, that the Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor (*b*).

And that the remuneration, if any, to be paid to an assessor shall be determined by the Court, or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of the Act (*c*).

This power of trying with an assessor has been practically in abeyance, and there seems little likelihood of its coming into common practice.

Position of assessors.

The rule laid down by Lord Esher in the case of *The Beryl* (*d*), that the judgment was that of the judge alone, who was not bound to follow the opinion of the nautical assessors to the Admiralty Division, would, no doubt, be applied in actions of infringement also should a necessity for deciding this point arise.

Sect. 12.—Perpetual Injunction.

When granted.

After a patentee has conclusively (*e*) established the validity of his patent, he may obtain a perpetual injunction, extending to the whole duration of the patent privilege, and applying not merely to the particular mode of infringement proved against the defendant, but to all other modes in which the patent privilege may be violated (*f*).

How validity of patent may be established.

The validity of a patent may, of course, be established by decree after trial; or the patentee may move for judgment on admissions in the pleadings (*g*); or the defendant may, as to the whole or any

(*a*) Sect. 28, sub-sect. (1).
(*b*) *Ibid.* sub-sect. (2).
(*c*) *Ibid.* sub-sect. (3).
(*d*) 1884, 9 P. D. 137, 141.
(*e*) *Hills* v. *Evans*, 1862, 31 L. J. Ch. 457; 4 De G. F. & J. 289.
(*f*) Hindmarch, p. 361.
(*g*) R. S. C. 1883, Ord. XXXII. r. 6. Where in an action for infringement of a patent, the defendant in the defence admitted certain instances of infringement, but denied that he had committed any others, and the plaintiff thereupon moved for judgment upon the admissions in the pleadings, it was held that the plaintiff was entitled to an inquiry as to damages arising from the admitted infringements only. *United Telephone Co.* v. *Donohoe*, 1886, 31 Ch. D. 399.

part (*h*) of the plaintiff's case, submit to a perpetual injunction, on terms of paying the costs of the action (*i*).

Withdrawal of consent to perpetual injunction.

Where a defendant has consented to a perpetual injunction against him, the Court will allow such consent to be withdrawn when it has been given by surprise, error, or mistake; but the subsequent discovery by the defendant of certain facts on which he conceives he can found a defence, is not a sufficient ground for such withdrawal (*k*).

As to stay of proceedings or execution, see *infra*, p. 343. For forms of orders for perpetual injunctions, see Appendix, pp. 797 *et seq.*

Breach of injunction.

If a defendant continues the infringement after an order granting an injunction has been (a) served upon him (*l*), or (b) brought to his knowledge with notice that the plaintiff intended to enforce it (*m*), a motion for his committal may be made.

The continuance of an infringement after injunction is a contempt, even although the defendant thought he was not infringing (*n*).

Motion to commit for.

Motions to commit when only an apology and costs are asked for, and no serious case for committal is made out, are discouraged by the Courts (*o*).

It is not a breach of an injunction for the person against whom it has been ordered to publish advertisements asking for subscriptions towards the expense of an appeal, or documentary evidence of anticipation (*p*).

The mere making, using, or vending of the elements which afterwards enter into a patent consisting of a combination, is not prohibited by and is not an infringement of the letters patent (*q*).

If, however, there was a patent for a knife of a particular construction, and an injunction was granted restraining a defendant from selling knives made according to the patent, and he was to

(*h*) *Curtis* v. *Pape*, 1888, 5 P. O. R. 150.

(*i*) *Hume* v. *Beale*, Seton, p. 295.

(*k*) *Elsas* v. *Williams*, 1884, 1 Times R. 145.

(*l*) *Clayton* v. *Percy*, 1854, Higgins' Dig. 1044.

(*m*) *United Telephone Co.* v. *Dale*, 1883-84, 25 Ch. D. 778.

(*n*) *Plimpton* v. *Spiller*, 1876-77, 4 Ch. D. 287.

(*o*) *Plating Co.* v. *Farquharson*, 1881, 17 Ch. D. 49. The defendant in an action for infringement of a patent had consented to an injunction. The plaintiff in the action, in consequence of a subsequent infringement by the defendants, the infringement not being identical with the first, moved in the action to attach the defendant for breach of the injunction. It was held by the Court of Appeal in Ireland, that this was the right form of proceeding: *Thomson* v. *Moore*, 1889, 6 P. O. R., at p. 445.

(*p*) *Plating Co.* v. *Farquharson*, *supra*.

(*q*) *Townsend* v. *Haworth*, 1875, per Jessel, M. R. 12 Ch. D. 831, n.; cp. *McCormick* v. *Gray*, 1861, 7 H. & N. 25; *Sykes* v. *Howarth*, 1878, 12 Ch. D. 826.

sell the component parts so that any schoolboy could put them together and construct the knife, that sale would be a breach of the injunction (*r*).

Determination of patent a defence to motion to commit.

Upon a motion to commit a defendant for breach of an injunction, it is open to the defendant to show that the patent having been determined, there was no longer any order of the Court in existence which he could be said to have infringed (*s*).

Technical breach of injunction, when lawful.

A technical breach of injunction may in some cases be lawful.

For example: a master who comes on board a vessel ought not to be answerable on the ground that when he takes the command there is on board a pump which infringes a patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of a ship, he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. . . . Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated—it is the master's bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. A master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer (*t*).

Solicitor and client costs.

On a motion to commit, costs as between solicitor and client may be given to a successful plaintiff (*u*), but not to a successful respondent (*x*).

In *Spencer* v. *The Ancoats Vale Rubber Co.* (*y*), where it appeared that the acts complained of had not been done vexatiously, but in the probable belief—an erroneous one—that the company were entitled to do what they did, solicitor and client costs were refused, but costs on the higher scale were given.

Sect. 13.—Account and Damages.

(1.) *Account.*

Differences between former and modern practice.

There are two points in which the modern differs from the earlier practice of the Courts as to ordering an account of profits.

(*r*) *United Telephone Co.* v. *Dale*, 1883-84, per Pearson, J., 25 Ch. D. 782.

(*s*) *Daw* v. *Eley*, 1867, L. R. 3 Eq. 496.

(*t*) *Adair* v. *Young*, 1879, per James, L. J., 12 Ch. D. 20.

(*u*) *Plating Co.* v. *Farquharson*, 1879-83, 17 Ch. D. 48, 57; *Steele* v. *Hutchings*, 1879, W. N. 18.

(*x*) *Plating Co.* v. *Farquharson*, *ubi supra*.

(*y*) 1889, 6 P. O. R. 46, 68.

I. The account was formerly an adjective remedy to an injunction.

"Whenever the plaintiff," says Mr. Hindmarch (*z*), "has made out a title to the interposition of the Court by injunction in his favour, ... the Court gives him an account, in order that his remedy may be complete. But if the plaintiff fails to make out his claim to an injunction, he cannot have a decree for an account."

Thus, where the patent alleged to be infringed expired before (*a*) or during (*b*) an action, so that an injunction could not be granted, an account of profits was generally refused.

A party would not, however, be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy, thus reaping the reward of his improbous labour in making it (*c*).

This rule was modified after Lord Cairns's Act had empowered the Court of Chancery to award damages.

Where the plaintiff's bill was filed shortly before the expiration of his patent, and made (but *aliter* if it did not make (*d*)) application for an interim injunction, the Court, although refusing an account of profits, would direct an inquiry as to what damages the plaintiff had sustained (*e*).

Any Division of the High Court may now order an account, or grant damages for infringement, whether an action is commenced before or after the expiration of the patent alleged to be infringed (*f*).

II. A plaintiff might formerly obtain both an account and an inquiry as to damages against the same defendant (*g*).

The case of *Neilson* v. *Betts* (*h*), however, most undoubtedly decided the general principle that upon a decree against a party for the infringement of a patent, the patentee is not entitled both

(*z*) P. 361; and cp. *Bailey* v. *Taylor*, 1825, 1 R. & M. 73; *Smith* v. *L. & S. W. Rail. Co.*, 1854, Kay, 408; *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, 1858, 4 K. & J. 727; *Hocking* v. *Fraser*, 1886, 3 P. O. R. 7.

(*a*) *Smith* v. *L. & S. W. Rail. Co.*, *ubi supra*.

(*b*) *Price's Patent Candle Co.* v. *Bauwen's Patent Candle Co.*, *ubi supra*; *contra*, however, in *Fox* v. *Dellestable*, 1866, 15 W. R. 149.

(*c*) *Crossley* v. *Derby Gas Co.*, 1834, 1838, per Lord Brougham, L. C., 4 L. J. Ch. at p. 26.

(*d*) *Betts* v. *Gallais*, 1870, L. R. 10 Eq. 392, per James, V.-C.

(*e*) *Davenport* v. *Rylands*, 1865, L. R. 1 Eq. 302, per Wood, V.-C.

(*f*) R. S. C. 1883, Ord. XV. r. 1. *York* v. *Stowers*, 1883, W. N. 1883, 174.

(*g*) *Elmslie* v. *Boursier*, 1869, L. R. 9 Eq. 217; cp. *Hills* v. *Evans*, 1862, 4 De G. F. & J. 288, 309; L. R. 6 H. L. 321, n. (2).

(*h*) 1871, L. R. 5 H. L. 1.

to an account of profits and an inquiry into damages. That principle applies generally, and without any distinction at all. It applies to every case of infringement, and therefore it must be taken to have settled conclusively that point that the patentee must, in all these cases where he has a decree, elect whether he will have an account of profits or an inquiry into damages (*i*).

"It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, 'and the article may' be followed in every man's hand until the infringement is got rid of. So long as the article is used, there is continuing damage" (*k*).

Where, however, a patentee is in the habit of granting licences of the patented articles, and a manufacturer who has infringed the patent right pays, not by way of agreed damages (*l*), a sum equal to the ordinary royalty which the patentee demands from his licensees, he cannot recover any further sum from the manufacturer (*m*), and every article in respect of which such payment is made becomes a free instrument in the market, so far as purchasers without notice or warning from the patentee are concerned (*n*).

A patentee who takes separate proceedings against the manufacturer and the user of the patented articles cannot be compelled to accept the same royalty from a litigant as he receives from others (*o*).

To what profits account extends.

An account extends to all the direct or collateral profit which the defendant has made (*p*), and to any saving he has effected (*q*) by infringing the plaintiff's patent privilege.

It did not, however, under the Patent Law Amendment Act, 1852, and does not now, include the loss which the plaintiff sustained by reason of the infringement (*r*). The only question is,

(*i*) *De Vitre* v. *Betts*, 1873, L. R. 6 H. L. 321.

(*k*) *Penn* v. *Bibby*, 1866, per Wood, V.-C., L. R. 3 Eq. 308; *Penn* v. *Fernie*, *ibid*; *Penn* v. *Jack*, *ibid*.

(*l*) *United Telephone Co.* v. *Walker*, 1887, 4 P. O. R. 63, 67.

(*m*) *Penn* v. *Jack*, 1867, L. R. 5 Eq. 81.

(*n*) *Cropper* v. *Smith*, 1882, 24 Ch. D. 305, 312.

(*o*) *Penn* v. *Bibby*, *ubi supra*.

(*p*) *Crossley* v. *Derby Gaslight Co.*, 1834, 3 M. & Cr. 428.

(*q*) *Household Co.* v. *Neilson*, 1843, 1 Web. P. C. 697, n. (*r*). In *Bacon* v. *Spottiswoode*, 1839, 1 Beav. 387, it was held that in such a case as *Household Co.* v. *Neilson*, the plaintiff must allege in his bill and prove at the trial that such a saving had been effected.

(*r*) *Ellwood* v. *Christy*, 1865, 18 C. B. N. S. 494; overruling *Walton* v. *Lavater*, 1860, per Byles, J., 8 C. B. N. S. 190. For other decisions under the Act of 1852, see *Holland* v. *Fox*, 1854, 3 E. & B. 977; *Vidi* v. *Smith*, 1854, 3 E. & B. 969. In *Ellwood* v. *Christy*, where the plaintiff was assignee, an account was ordered only from the date of the registration of the assignment. But see *United Horseshoe and Nail Co.* v. *Stewart*, 1888, 13 A. C. 401, 417.

what advantage the infringer has derived from the use of the patent over and above what he would have got from the use of processes open to the public (*s*).

An order for an account is a debt provable in the infringer's liquidation.

An account will not be ordered when the evidence shows either that no profits have been made at all (*t*), or that the sales have been insufficient to make it worth while (*u*).

A plaintiff's right to an account, as well as to an injunction, may be barred by delay or acquiescence (*v*).

In taking an account against a defendant who has infringed a patent, it is proper to take into account for the purpose of comparison the profits made by him prior to the date of infringement. In *Siddell* v. *Vickers* (*x*), the patentee of an invention for an appliance for operating on large forgings commenced an action for infringement of his patent against Messrs. V. & Co. At the trial the judge granted an injunction, and an account of profits. The defendants appealed, and the Court of Appeal affirmed the judgment, and directed an account of all iron or steel forgings manufactured by the defendants by the use of the plaintiff's invention, and also of the profits made by the defendants by reason of such use. On the taking of the account the defendants refused to give any account of the profits made by them prior to the date at which they commenced to use the plaintiff's invention. The plaintiff took out a summons for directions as to taking the account, and that the defendants should bring in a further and better affidavit. It was held that the plaintiff was entitled to an account of the profits made by the defendants prior to the date at which they commenced their use of his invention.

(2.) *Damages.*

Nature of inquiry.

The inquiry is in the form "what damage," and not as in the case of a trade-mark "what damage, if any, the plaintiff has

(*s*) *United Horseshoe and Nail Co.* v. *Stewart*, 1886, 3 P. O. R. 143, per Lord Kinnear, and American case, *Mowry* v. *Whiteley*, cited by him *ubi supra*; and 14 Wall. N. S. 620.

(*t*) *Bergmann* v. *Macmillan*, 1881, L. R. 17 Ch. D. 427.

(*u*) *Sanitas Co.* v. *Condy* (a trade-mark case), 1887, 4 P. O. R. 533; *Watson* v. *Holliday*, 1882, 30 W. R. 747; 31 W. R. 536.

(*v*) *Crossley* v. *Derby Gas Light Co.*, 1834, 1 Web. P. C. 120; and see *ante*, p. 275.

(*x*) 1889, 6 P. O. R. 464.

sustained." There is this difference between the case of a trade-mark and that of a patent, as regards an inquiry into damages. In the former case, the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say "don't sell any goods under my mark." He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee (*y*).

In *Davenport* v. *Rylands* (*y*), accordingly, although the defendant had purchased in open market the article complained of, in ignorance of the process of its manufacture, and of the fact of infringement, the inquiry was ordered to extend to the sale within six years of the filing of the bill.

Form of inquiry

Where damages are granted in lieu of an injunction, the Court may assess the damages accrued after, as well as before, the issue of the writ (*z*).

When damages are to be assessed in respect of any continuing cause of action, they shall be assessed down to the time of the assessment (*a*).

Damages, how ascertained.

The ascertainment of damages, where it is substantially a matter of calculation, may be referred to an officer of the Court (*b*). In the Chancery Division, the question of damages cannot after judgment be tried by a jury, but must be referred to a chief clerk or referee (*c*).

Under the Chancery Acts, 1852 and 1858, the question of damages was left to be decided by a jury where there was extreme difficulty in their assessment by the Court itself (*d*).

In the order for an account or for damages, there is usually, but not always, inserted a clause requiring the defendant to pay to the plaintiff the sum found due by way of profit or damages within a limited time after the filing of the certificate of the finding (*e*).

(*y*) *Davenport* v. *Rylands*, 1865, Ver Wood, V.-C., L. R. 1 Eq. 308; *United Horseshoe and Nail Co.* v. *Stewart*, *ubi supra*.

(*z*) *Fritz* v. *Hobson*, 1880, 14 Ch. D. 543, a case under Lord Cairns's Act, now repealed.

(*a*) Ord. XXXVI. r. 58.

(*b*) *Ibid.* r. 57.

(*c*) *American Braided Wire Co.* v. *Thomson*, 1888, 4 Times Rep. 755; cp. *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 253.

(*d*) *Betts* v. *De Vitre*, 1864, 11 Jur. N. S. 9.

(*e*) *Plimpton* v. *Malcolmson*, 1876, Seton, 354; *Cunningham* v. *Gilling*, 1864, *ibid.* 355; *Betts* v. *Neel*, *ibid.*

An inquiry as to damages will not be granted where no damage or only nominal damage has been proved (*f*).

Damages may be awarded although not specifically claimed in the pleadings (*g*).

In *Proctor* v. *Bayley* (*h*) the Court of Appeal, in dismissing an action for an injunction, there being no jurisdiction to grant damages without the injunction, refused to give any opinion as to whether the dismissal of the action would be prejudicial to a subsequent action at law for damages.

When a case is tried by a jury, and damages are desired, the plaintiff ought to lay his claim before the jury for assessment (*i*).

In a recent case (*k*), however, where it appeared that damages, although claimed in the pleadings, were by an oversight not asked for at the trial, Kay, J., gave special leave, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages.

Measure of damages.

Under an order of inquiry, a plaintiff is entitled to compensation for the actual loss he has sustained by the sale of the infringing articles (*l*).

This definition of the measure of damages enables us at once to put aside as irrelevant, the vexation and annoyance of a lawsuit, for which a plaintiff must find relief in his costs (*m*), profit by the infringer not arising from the use of the patentee's invention, and not materially injuring the patentee's sales, and loss incurred by the plaintiff having, in consequence of the defendant's competition, reduced the price of his patented article.

The loss must be the natural and direct consequence of the defendant's acts (*n*).

The following are the chief rules which have been laid down as to the measure of damages.

Where judgment for damages has been recovered for the infringement of a patent, and the plaintiffs were not in the habit of selling, but more usually of letting out, the patented article at a rent or royalty, the measure of damages is the profit rent of the

(*f*) *Dicks* v. *Brooks*, 1880, L. R. 15 Ch. D. 39, per James, L. J.; *United Telephone Co.* v. *Sharples*, 1885, 2 P. O. R. 28; *Cole* v. *Saqui*, 1888, 5 P. O. R. 489, 496.

(*g*) *Betts* v. *Neilson*, 1868, 18 L. T. N. S. 159.

(*h*) 1889, 6 P. O. R. 538.

(*i*) *Needham* v. *Oxley*, 1863, 8 L. T. N. S. 604.

(*k*) *Edison and Swan Electric Light Co.* v. *Holland*, 1888, 5 P. O. R. at p. 483.

(*l*) *United Horseshoe and Nail Co.* v. *Stewart*, 1888, 13 A. C. at p. 408; *Ledgard* v. *Bull*, 1886, 11 A. C. 648, 654.

(*m*) *Penn* v. *Jack*, 1867, L. R. 5 Eq. 81.

(*n*) *United Horseshoe, &c. Co.* v. *Stewart*, *ubi supra*, at p. 413; followed in *American Braided Wire Co.* v. *Thompson & Co.*, 1890, 7 P. O. R. 47.

article during the entire period from the time when it came into the possession of the infringer until the asse.. ment of damage, or the date of its delivery up. It is immaterial for the purposes of that assessment, whether the article has or has not been in actual use during any portion of that period. A defendant is not entitled to set-off against such damages the value of any infringing article delivered up under the judgment of the Court, nor any portion of any agreed sum for damages for infringement recovered by the plaintiff in a previous action against the manufacturer from whom the defendant had bought the article, although the period in respect of the rent payable as damages commenced at a date antecedent to the commencement of the action against the manufacturer (*o*).

If, however, the damages recovered by the plaintiff from the manufacturer had not been an agreed sum, but a sum representing the full rent or royalty, the defendant would have been entitled to a set-off (*p*).

In *Arkwright* v. *Nightingale* (*q*), Lord Loughborough said—though he was not called upon to decide the point—that he would allow an unsuccessful defendant in an action for infringement to show, by way of mitigating damages, that the verdict in a previous action had been adverse to the patent and parties had acted on the faith of it.

Sect. 14.—Delivery up of Infringing Articles.

Delivery up of infringing articles.

Besides an injunction, an account of profits or damages, a successful patentee may obtain an order that, within a time limited thereby (*r*), the infringing articles shall be ascertained and (a) destroyed (*s*), or (b) delivered up to the plaintiff (*t*), or (c) marked (where the patentee's invention is composite, and the various parts may be innocently used for other purposes) so as to prevent a continuation of the infringement (*u*).

(*o*) *United Telephone Co.* v. *Walker*, 1887, 4 P. O. R. 64.

(*p*) *S. C.*; and see *Penn* v. *Jack*, and *Penn* v. *Bibby*, *ubi supra*.

(*q*) 1785, 1 Web. P. C. 61.

(*r*) *Washburn and Moen Manufacturing Co.* v. *Patterson*, 1884, 1 P. O. R. 191; *Otto* v. *Steel*, 1886, 3 P. O. R. 109, 120.

(*s*) *Betts* v. *De Vitre*, 1864, 34 L. J. Ch. 289, 291; *Emperor of Austria* v. *Day*, 1861, 3 De G. F. & J. 217.

(*t*) *Tangye* v. *Stott*, 1865, 14 W. R. 386; *Young* v. *Fernie*, Pemberton, 236; *Washburn, &c.*, *ubi supra*, 158, 162, 191.

(*u*) *Needham* v. *Oxley*, 1863, 8 L. T. N. S. 532; *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 253; *Plimpton* v. *Malcolmson*, Seton, 354; *Badische Anilin, &c.*, 1884, 24 Ch. D. 176.

SECT. 15.—COSTS.

(1.) *General.*

Costs before 1840.

Prior to 1840, a plaintiff in an action of infringement who obtained even nominal damages, was entitled to recover his full costs against the defendant, unless the judge before whom the action was tried certified under 43 Eliz. c. 6, s. 2, that no costs should be allowed.

Costs where less than forty shillings recovered.

The statute 3 & 4 Vict. c. 24, s. 1, repealed so much of that enactment as related to costs in actions of trespass on the case (which included patent actions), and provided that if the plaintiff recovered less than 40*s.* damages he should not be entitled to any costs at all unless the presiding judge should, immediately after verdict, certify that "the action was really brought to try a right besides the mere right to recover damages . . . . or that the trespass or grievance in respect of which the action was brought was wilful and malicious."

Certificate had to be obtained immediately after trial.

A certificate could only be granted under 3 & 4 Vict. c. 24, immediately after the trial. The lapse of several months between a verdict for nominal damages (*x*) and an application for a certificate by the successful plaintiff was held to be a fatal obstacle to the exercise by the judge of his statutory discretion; and the Court even doubted whether a certificate could be granted after another cause had been called on (*y*).

(2.) *Certificate of Validity.*

(a) *Under Act of* 1835.

Certificate of validity under Act of 1835.

The statute 5 & 6 Will. IV. c. 83, enacted that in any action at law, or any suit in equity, in respect of any alleged infringement of letters patent, the judge might certify that the validity of the patent came in question before him, and that on this certificate being given in evidence in any other suit in which the patentee obtained a verdict, the patentee should be entitled to receive treble costs, unless the judge certified to the contrary (sect. 3), *to be taxed*

(*x*) The damages awarded under this Act were usually nominal, the plaintiff's object being to establish his right at law before seeking pecuniary reimbursement for his losses from a suit in equity. Sometimes, however, they were exemplary. Thus, in *Lewis* v. *Marling*, 1829, 1 Carp. 476, the jury gave 200*l.* damages; and in *Newton* v. *Grand Junction Rail. Co.*, 1845, 5 Exch. 331, they were assessed at 1,000*l.* Coryton, p. 307.

(*y*) *Gillett* v. *Green*, 1841, 10 L. J. Ex. 124; 7 M. & W. 347.

Treble costs.

at three times the taxed costs (*z*). The policy of this enactment is very clearly explained by Hindmarch.

Policy of this rule.

"Before a patentee has established his claim to a patent privilege by legal proceedings, he has no proof of his title except his patent, and that has been obtained upon his own unsupported representation. But when a patentee's title to a patent privilege has been once fairly established in a Court of law or equity, he stands in a very different position, and he may very fairly claim to be better protected by the law than a patentee who has no verdict, judgment, or decree evidencing his title to such a privilege. It would not be fair to extend the protection to a patentee who has established his patent right in an action at law so far as to prevent any person from afterwards contesting the validity of the patent, for the defendant in an action might, through ignorance or collusion with the plaintiff, suffer him to obtain a verdict, and other persons may afterwards be able to show that the patent is void. But when the patentee has the evidence of a verdict or judgment in his favour, it is only proper that he should be so far protected that if he is again compelled to try the validity of his patent, he should be enabled to recover the full amount of his costs, if he again succeeds in establishing his title. The object of 5 & 6 Will. IV. c. 83, s. 3, was to indemnify patentees against their costs in actions which they may be compelled to bring after they have established their patent, and also to deter persons from committing vexatious infringements of such patents by the penalty of treble costs" (*a*).

Improved position of a patent which has been contested.

Penal costs.

Conditions necessary to obtain treble costs.

There were two conditions precedent to the enjoyment by a patentee of the protection of this enactment: (1) he must have obtained a verdict or decree in the subsequent action; and (2) the judge before whom the first action was tried must have granted his certificate that the validity of the patent had come in question

(*z*) The costs which this statute enabled a patentee to recover on a second or subsequent verdict passing for him were "treble costs, *to be taxed at three times the taxed costs.*" The words in italics prevented the application of the ordinary rule as to double or treble costs, viz., that "double or treble costs are not to be understood to mean, according to their literal import, twice or thrice the amount of single costs." Without any such clause of interpretation, the amount of treble costs would have been calculated in the following manner. To the sum allowed to the party for costs taxed in the ordinary way, was added one half of that sum, and also one fourth of the same sum, and these three sums being added together, formed what was technically termed treble costs, *i. e.*, common costs, and three-fourths of the common costs, or one fourth less than twice the common costs. Hindmarch, p. 303; Webster State. p. 37, n. (*o*).

(*a*) Hindmarch, pp. 301, 302.

before him. The judge could deprive a successful plaintiff of costs if he thought fit.

The second condition was necessary because the pleadings in a cause might, upon the face of them, appear to raise almost every possible question respecting the validity of the patent; and yet the defendant might not at the trial or hearing raise any such question (*b*).

No certificate of validity where patent not really contested.

Thus in *Shocker* v. *Rodgers* (*c*), the pleas were "not guilty," that the invention was not new, and that the specification was not sufficient. At the trial, however, no defence was offered, and the defendant consented to a verdict for 40*s*. damages. Erskine, J., before whom the cause was tried, refused to give the plaintiff a certificate under 5 & 6 Will. IV. c. 83, s. 3, although the defendant's pleas had put in issue the validity of the patent. "I think," said his lordship, "that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties, and it would be possible in a case like the present for two parties by collusion to consent to a verdict in favour of a patent; and if they could obtain a certificate under the third section of the statute to use it afterwards to the injury of a third party who was really contesting the validity of the patent."

Aliter.

In *Gillett* v. *Wilby* (*d*), however, the validity of the patent did partly come in question under a plea of want of novelty, and a certificate was granted although the defendant did not call any witnesses.

Abuse of rule as to treble costs.

The privilege conferred on patentees by this statute was, however, abused. An instance is recorded by Godson, in which a successful patentee commenced no less than forty actions. Accordingly, the Act 5 & 6 Vict. c. 97, s. 1, repealed that portion of 5 & 6 Will. IV. c. 83, s. 3, which gave treble costs, and provided that the costs should be taxed in such a way as to be a "*full* and reasonable indemnity as to all costs, charges, and expenses incurred in and about" the action.

(b) *Under Act of* 1852.

Discretion of judge.

The right of a patentee to have full costs under 5 & 6 Will. IV. c. 83, s. 3, amended by 5 & 6 Vict. c. 97, s. 1, was dependent

(*b*) *Ibid.* p. 302.
(*c*) 1843, 1 C. & K. 99.
(*d*) 1839, 9 C. & P. 334; *Newall* v. *Wilkins*, 1851, 17 L. T. 20; *Stocker* v. *Rogers*, 1843, 1 Car. & K. 99.

on the discretion of the judge before whom the second action was tried, and who might deprive him of such costs by certifying to that effect at the trial. This discretion was liable to be exercised when the certificate of validity had been obtained by the patentee in an action tried by collusion for the purpose of obtaining it (*e*), or where the second action appeared to be a harsh or unnecessary proceeding, or ended in a compromise (*f*), or when the defendant in that action did not question the validity of the patent, but wished *bonâ fide* to try a doubtful question of infringement (*g*).

Collusion.
Unnecessary action.
Compromise.
Validity not questioned.

Effect of Act of 1852.

Any doubt (*h*) as to the meaning of the term "full costs" in 5 & 6 Vict. c. 97, s. 1, was removed by sect. 43 of the Patent Law Amendment Act, 1852, which defined it as "full costs, charges, and expenses, taxed as between attorney and client," and repeated in substance the provisions of the earlier statutes, and enacted that it should be lawful for the judge before whom an action for infringing letters patent was tried, to certify on the record that the validity of the patent came in question, and that the record with such certificate being given in evidence in any suit or action for infringing the said letters patent should entitle the plaintiff, on obtaining a decree, decretal order, or final judgment, to full costs as above defined, unless the judge should certify that he ought not to have them.

Certificate of validity.

The practice under this section was as follows:—

(1.) The provisions applied only to a patentee; and no certificate could be given to the defendant in an action for infringement (*i*).

This is still the law under sect. 31 of the Patents Act, 1883.

(2.) It was necessary that the certificate of validity should be given in evidence at the subsequent trial.

There is no provision to this effect in the new statute. But it seems that proper evidence of the certificate should be given.

Costs of motion for new trial not included in rule.

(3.) The words "decree, decretal order, or final judgment," did not include a motion for a new trial of a subsequent action, and the costs of an unsuccessful motion of that description were given only as between party and party (*k*).

(*e*) *Davenport* v. *Rylands*, 1865, L. R. 1 Eq. 309.

(*f*) *Betts* v. *De Vitre*, 1864, 11 Jur. N. S. 9.

(*g*) Cp. *United Telephone Co.* v. *Patterson*, 1889, 6 P. O. R. 140.

(*h*) Cp. Hindmarch, p. 304. "It is difficult to say what construction will be put upon this statute, but there can be little doubt that it will be construed liberally, and that a plaintiff will under these statutes be allowed the amount of his costs, taxed as between attorney and client."

(*i*) *Badische Anilin, &c.* v. *Levinstein*, 1886, 29 Ch. D. 366, per Bowen, L. J., at p. 419.

(*k*) *Bovill* v. *Goodier*, Griffin, A. P. C. 49.

(4.) Under sect. 43 of the Act of 1852, it was necessary that the certificate of validity should be given by "the judge before whom the trial was heard" (*l*).

In the case of *Cropper* v. *Smith* (*m*), the plaintiffs, in an action for the infringement of their patent, had obtained a decree from Pearson, J., at the trial. On appeal, the Court of Appeal and the House of Lords overruled this decision. The defendants applied to Pearson, J., for a certificate that they had proved their particulars of objections. Counsel differing as to the certificate to be granted, his lordship desired that the matter might be mentioned to the Court of Appeal. On its being so mentioned, the Court of Appeal communicated with Mr. Justice Pearson, who then gave a certificate as required.

(5.) Notwithstanding that the 43rd section of the Act of 1852 provided that a certificate of validity should entitle a plaintiff to full costs as between solicitor and client, unless the judge deprived him of them, it was necessary that the decree or order should contain an express direction to the taxing master that the costs be so taxed (*n*).

(c) *Under Act of* 1883.

Act of 1883.

Under the 31st section of the present Act, a certificate of validity may be granted by the Court (*i. e.*, by the High Court of Justice (*o*) or the Court of Appeal (*p*)) or a judge, *i. e.*, may be given in chambers (*q*).

Vice-Chancellor of Lancaster not within rule.

Neither the Vice-Chancellor of the County Palatine of Lancaster nor the Court of Appeal sitting on appeal from him, is within the meaning of the words "Court or a judge" in this section (*r*).

Provisions of Act of 1883.

Sect. 31 of the present Act provides that, in an action for infringement of a patent, the Court or a judge may certify (*s*) that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment

(*l*) And see *Otto* v. *Linford*, 1880, 46 L. T. N. S. 35.

(*m*) 1885, 1 P. O. R. 61.

(*n*) *Lister* v. *Leather*, 1858, 4 K. & J. 425.

(*o*) Cp. sect. 117, sub-s. (1).

(*p*) R. S. C. 1883, Ord. LVIII. r. 4; *Cole* v. *Saqui*, 1889, 6 P. O. R. 41.

(*q*) Jud. Act, 1873, s. 69.

(*r*) *Proctor* v. *Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. per Day, J., at p. 185.

(*s*) A certificate under this section is not a judgment, decree, or order, within the meaning of the Jud. Act, 1873, s. 19, and is not therefore appealable; *Haslam Co.* v. *Hall*, 1888, 5 P. O. R. 144.

in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

Cases.

The decisions under this section may be very briefly summarized.

Solicitor and client costs.

In *United Telephone Co.* v. *Patterson* (*t*), an action for infringement of two patents, the plaintiffs claimed the usual injunction and damages. In his defence the defendant did not question the validity of the patents, and denied the infringement, but paid 75*l.* into Court in the alternative. At the hearing the application for granting an injunction was not resisted by the defendant, and the enquiry as to damages was referred to Chambers. The plaintiffs having proved the certificate of validity of the patents being questioned in previous actions, under sect. 43 of Patent Act, 1852, and sect. 31 of Patent Act, 1883, the defendant applied to the judge to certify that the plaintiffs ought not to have costs as between solicitor and client, on the ground that the plaintiffs' patent had not been disputed, and their claim to relief not seriously contested by the defendant. It was held that the plaintiffs were entitled to costs of the action as between solicitor and client, those of the reference as to damages being reserved, and that the fact that the defendant had not disputed the validity of the patent, and had, by paying money into Court, so far admitted his liability, afforded no ground for granting defendant a certificate depriving plaintiffs of costs as between solicitor and client.

An action commenced before a certificate is given that the validity of a patent has come in question, is not a subsequent action so as to entitle a successful plaintiff to solicitor and client costs (*u*).

Uncontested action.

It is doubtful whether a certificate of validity can be granted in an uncontested action. Kay, J., refused to certify in *Peroni* v. *Hudson* (*x*), where the defendant did not appear at the trial; but in a similar case, *Haydock* v. *Bradbury* (*y*), Kekewich, J., granted

(*t*) 1889, 6 P. O. R. 140.

(*u*) *Automatic Weighing Co.* v. *International Hygienic Society*, 1889, 6 P. O. R. 480. *Semble*, solicitor and client costs will not be given in a subsequent action for infringement, if the only question raised in that action is infringement: *Automatic Machine Co.* v. *The International Hygienic Society*, *ubi supra*. Solicitor and client costs were not given on a breach of an injunction where what was done by the defendants was not done vexatiously or improperly, but in the probable though erroneous belief that they were entitled so to do: *Spencer* v. *Ancoats Vale Rubber Co.*, 1889, 6 P. O. R. 46.

(*x*) 1884, 1 P. O. R. at p. 263.

(*y*) 1887, 4 P. O. R. at p. 75.

the usual certificate, notwithstanding the defendant's absence. "If a defendant," said his lordship, "by non-appearance at the trial, could deprive a successful plaintiff of the right which you are now claiming for him, he might be put to the trouble of proving it all over again."

Where a certificate of validity has been granted in a previous action, it need not be again granted. To do so would be to throw doubt on the sufficiency of the former certificate (*z*).

Action for threats.

Equal doubt exists upon the point whether an action for threats is "an action for infringement of a patent" within the meaning of sect. 31. In *Kurtz* v. *Spence* (*a*), Mr. Justice Kekewich held that it was not. In *Crampton* v. *The Patents Investment Co.* (*b*), Mr. Justice Field granted a certificate without prejudice to its validity if it came into operation. His lordship expressed great doubt, however, whether he had jurisdiction to grant it.

This section, like sect. 43 of the Act of 1852 (*c*), applies only to a second action for infringement.

Only applies to second action.

In *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.* (*d*), where the second action was in the paper for trial at the same time as the first action, it was held that a certificate given in the first action did not make the defendant in the second action, although he raised the question of the validity of the patent, liable to solicitor and client costs.

Validity impeached on new grounds.

When the validity of a patent is impeached in a second action on grounds different from the grounds of its impeachment in the first action, the costs as between solicitor and client will not be allowed. A second certificate of validity may be granted with reference to the extent to which the validity of the patent came in question in the second action (*e*).

In *Haslam Co.* v. *Hall* (*f*), where the patent was held to be invalid, Stephen, J., granted a certificate that the validity had come in question, but refused to certify anything further.

A certificate of validity may probably be granted, although the plaintiff fail on the issue of infringement (*g*).

(*z*) *Edison Co.* v. *Holland*, 1889, 6 P. O. R. 287.
(*a*) 1888, 5 P. O. R. at p. 164.
(*b*) 1888, *Ibid.* at p. 404.
(*c*) *Penn* v. *Bibby*, 1866, L. R. 3 Eq. 308.
(*d*) 1889, 6 P. O. R. 120. And see *Bovill* v. *Hadley*, 1864, 10 L. T. N. S. 650; 17 C. B. N. S. 435.
(*e*) *Otto* v. *Steel*, 1886, 3 P. O. R. at p. 120.
(*f*) 1888, 5 P. O. R. at p. 27.
(*g*) *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 P. O. R. 113, 120, 126.

Discretion of judge in refusing full costs same as before Act of 1883.

The law as to the discretion of the judge in refusing full costs where there has been a certificate of validity, has not been altered by the Act of 1883.

Action vexatious.

Where defendants did not question the validity of the plaintiff's patent, admitted that they had used it many years ago, but explained that they had not since used, and did not intend to use it, and where the damage, if any, had been very trifling, the Court considered the action very vexatious, and deprived the plaintiff of full costs (*h*).

Full costs where validity not disputed a second time.

In *United Telephone Co.* v. *St. George* (*i*), where the issue of infringement had been seriously contested, costs as between solicitor and client were allowed against an unsuccessful defendant although he had not disputed the validity of the plaintiff's patent.

(3.) *Certificate as to Particulars.*

(a) *Under Act of* 1835.

Costs of separate issues.

The General Rules of Hilary Term (2 Will. IV.) provided, by sect. 74, that no costs should be allowed on taxation to a plaintiff upon any counts or issues upon which he had not succeeded; and the costs of all issues found for the defendant were to be deducted from the plaintiff's costs.

Under Act of 1835, costs on objections and counts.

The statute 5 & 6 Will. IV. c. 83, s. 6, provided that in taxing costs regard should be had to the part of the case proved and certified by the judge, and that "the costs of each part of the case should be given according as either party had succeeded or failed therein, regard being had to the notice of objections as well as the counts in the declaration, and *without regard to the general result of the trial.*"

In the case of *Losh* v. *Hague* (*k*), the effect of the two provisions last cited upon each other was considered. In that case, four issues were raised by the pleadings, and the defendant gave notice of seven objections to the patent. At the trial the defendant succeeded in establishing one of his objections which fell under the third issue, but the plaintiff had a verdict upon the other three issues. The issue upon which the defendant succeeded was a bar

(*h*) *Proctor* v. *Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. 184.

(*i*) 1886, 3 P. O. R. at p. 339.

(*k*) 1839, 5 M. & W. 387.

to the whole action. In taxing costs the master allowed the defendant *the general costs* of the cause, as well as those on the third issue from which he deducted the plaintiff's costs of the three issues upon which he had succeeded. It was contended by the plaintiff that sect. 74 of the General Rules was repealed by 5 & 6 Will. IV. c. 83, s. 6, and that therefore he was entitled to three-fourths of the general costs of the cause. But the Court of Exchequer held that the statute had not the operation contended for, and that the master's ruling was right.

(b) *Under Act of* 1852.

By the Act of 1852, s. 43, it was (*inter alia*) provided that, in taxing the costs in any action, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause.

Under this section it was decided that—

The certificate of the judge who tried the cause that the defendant had proved his particulars of objections, was a condition precedent to his right on taxation to any costs in respect of such particulars, even in the case of a nonsuit (*l*).

"With respect to the costs of the issues," said Pollock, C. B., in *Honiball* v. *Bloomer*, the case from which the above statement is taken, "there is no doubt that where the plaintiff is non-suited, the defendant is entitled to all the costs of the issues, that is to say, of the pleadings and evidence necessary to support them. But as the particulars are the creatures of this statute, and the costs of this particular class of proceedings are declared by the legislature to be no part of the general costs of the cause, and that, in the absence of a certificate, they shall not be recoverable, they are not recoverable."

Honiball v. *Bloomer* was considered in *Batley* v. *Kynock* (*m*), where, after the trial of issues had been fixed, the plaintiff obtained the common order at the Rolls, dismissing his own bill with costs. Among the items in the defendant's bill of costs were charges for drawing particulars of objections, and having the same settled by

(*l*) *Honiball* v. *Bloomer*, 1854, 24 L. J. Ex. 11; 10 Exch. 538; *Parnell* v. *Mort*, 1884-85, L. R. 29 Ch. D. 325; 1 P. O. R. 4; 2 P. O. R. 139.

(*m*) 1874-75, 20 Eq. 635.

counsel, the expenses of scientific witnesses and the price of a model, all of which the taxing master had substantially allowed. Bacon, V.-C., in confirming this decision, said: "Here the state of circumstances contemplated by the statute never did and never could arise. The case referred to at common law (*Honiball* v. *Bloomer*, 10 Ex. 538) has no application to the present."

Sect. 43, however, applied only to cases where there had been a trial; where there had been no trial the law stood as it did before. Thus, in *Greaves* v. *Eastern Counties Rail. Co.* (*n*), an action for the infringement of a patent, notice of trial was given and countermanded, whereupon the defendants signed judgment. It was held by the Court of Queen's Bench that the defendants were clearly entitled, under the Statute of Gloucester, to the costs of preparing, and the evidence in support of their particulars. This case is distinguishable from *Curtis* v. *Platt* (*o*). There the defendant had obtained further time to plead on the terms that the cause should be put down for trial before issue joined, and that short notice of trial should be taken. The pleas were delivered, and the plaintiff had a special jury nominated but not struck. The action was then discontinued before issue was joined or notice of trial was given. It was held that the circumstances of the case did not authorize a departure from the general rule that costs incurred before notice of trial should not be allowed.

(c) *Under the Act of* 1883.

Sect. 29, sub-sect. 6 of the Patents Act, 1883, provides that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and that they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven, *or to have been reasonable and proper*, without regard to the general costs of the case.

This section differs in effect from the Act of 1852, s. 43, in the addition of the words "or to have been reasonable and proper."

It has already been pointed out that "Court or a judge" means a judge of the High Court, whether sitting in Court or chambers, and includes the Court of Appeal; and that it does not include the Vice-Chancellor of the County Palatine of Lancaster (*p*).

(*n*) 1859, 28 L. J. Q. B. 290; 1 E. & E. 961.

(*o*) 1864, 10 Jur. N. S. 823.

(*p*) See p. 333 and notes.

In *Griffin* v. *Feaver* (*q*), G. brought an action for infringement of a patent for improvements in metallic boxes or receptacles for holding alimentary and other substances. By his defence, the defendant alleged that the patent was invalid on a number of different grounds, including anticipation. At the trial the plaintiff's first witness, in cross-examination, was unable to distinguish the alleged invention from a previous specification, and the action was dismissed on the ground of that prior publication. The defendant was allowed the costs of all particulars of objections involved in that decision.

Costs of particulars when defendant not called on.

In *Germ Milling Co.* v. *Robinson* (*r*), the plaintiffs, in an action for infringement, failing on the ground of the invalidity of their patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence. The defendants applied for a certificate that their particulars of objections were reasonable and proper, and the plaintiffs applied for a certificate that they had proved their particulars of breaches. It was held, that the judge must decide which of the particulars of breaches were reasonable and proper in regard to the case so far as it had gone, that a certificate would be granted in respect of those particulars only which the judge specifically mentioned; and also, that as the plaintiffs were not entitled to any costs they were not entitled to any certificate.

Practice of Court of Appeal.

The Court of Appeal will give a certificate of particulars of objections, where it reverses the judgment of the Court below by which the patent was found valid (*s*).

Where the Court of Appeal is able to dispose of an action on one point, viz., that there is no infringement, it will not hear the case further to decide if the objections were reasonable (*t*).

It still remains to consider very briefly two points of practice under the present law.

(4.) *Apportionment of Costs of Issues.*

Costs of issues.

Where issues of fact and law are raised upon a claim or counter-claim, the costs of the several issues, both in law and fact, shall,

(*q*) 1889, 6 P. O. R. 396; cp. *Slazenger* v. *Feltham*, *ibid.* 130.

(*r*) 1886, 3 P. O. R. 254; cp. *Rothwell* v. *King*, 1887, 4 P. O. R. 397; *Albo-Carbon Light Co.* v. *Kidd*, *ib.* 530; *Longbottom* v. *Shaw*, 1888, 5 P. O. R. 497, and 1889, 6 P. O. R. 147; L. R. 43 Ch. D. 46; *Oddy* v. *Smith*, 1888, 5 P. O. R. 503; *Cole* v. *Saqui*, 1888, 5 P. O. R. 489; *Boyd* v. *Horrocks*, 1889, 6 P. O. R. 152, 162.

(*s*) *Cole* v. *Saqui*, 1889, 6 P. O. R. 41.

(*t*) *Boyd* v. *Horrocks*, 1889, 6 P. O. R. 162; *Longbottom* v. *Shaw*, 1889, *ib.* 143.

unless otherwise ordered, follow the event (*n*). The general principle on which the Court acts in applying this rule to the costs occasioned by issues raised in actions of infringement, was thus stated by Bowen, L. J., in *Badische Anilin, &c.* v. *Levinstein* (*o*):

General principles, Bowen, L. J.

"It seems to me that, without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense."

The principle of apportionment, thus defined, has accordingly been applied not only where a plaintiff had established the validity of his patent without proving infringement (*p*), but also where a defendant, while failing on the issue of infringement, had succeeded on that of validity (*q*).

The Court has, however, refused to allow the costs of an issue which were trifling and were not materially different from the costs of the cause (*r*).

In *Sugg* v. *Bray* (*s*), where it appeared that if the costs were apportioned the defendant would have to pay, in respect of issues on which he had failed, at least as much as he would be entitled to receive from the general costs of the cause, the Court, to avoid a very troublesome and difficult apportionment of costs on taxation, cut the knot by giving no costs to either party.

In *Moore* v. *Bennett* (*t*), the Court of Appeal had held the plaintiff's patent bad on account of insufficiency in the specification, and also that there had been no infringement. The House of Lords

(*n*) R. S. C. 1883, Ord. LXV. r. 2.

(*o*) 1885, 29 Ch. D. at p. 419.

(*p*) *Simmonds* v. *Hitchman*, 1881, Lawson, 174; 29 Ch. D. 417, n. (4); *Needham* v. *Johnson*, 1884, 1 P. O. R. 49, 59; *Nordenfelt* v. *Gardner*, 1884, *Ibid.* 61; *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, *Ibid.* 229, 253.

(*q*) *Wegmann* v. *Corcoran*, 1878-79, 27 W. R. 357, 362; *United Telephone Co.* v. *Harrison*, 1882-83, 21 Ch. D. 747; *Hocking* v. *Fraser*, 1886, 3 P. O. R. 7; *Edison, &c. Co.* v. *Woodhouse*, 1886, *Ibid.* 167; *Young* v. *Rosenthal*, 1884, 1 P. O. R. 29, 41; Cp. *Pooley* v. *Pointon*, 1885, 2 P. O. R. 167; *Laurie* v. *Baker*, 1885, *Ibid.* 213; *Lawrence* v. *Perry*, 1885, 2 P. O. R. 179; *Lister* v. *Norton*, 1886, 3 P. O. R. 199, 211; *Badham* v. *Bird*, 1888, 5 P. O. R. 238.

(*r*) *Kaye* v. *Chubb*, 1887, 4 P. O. R. 300, 302; Cp. *Edison, &c. Co.* v. *Holland*, 1888, 5 P. O. R. 483; *Blakey* v. *Latham*, 1889, 6 P. O. R. 38, 186, 190.

(*s*) 1885, 2 P. O. R. at p. 248, *per* North, J.

(*t*) 1884, 1 P. O. R. at p. 148.

adjudged the patent to be valid, but confirmed the decision of the Court below on the question of infringement. The appeal was therefore dismissed, but, as it had resulted in a material and important advantage to the plaintiff, without costs.

In *Boyd* v. *Horrocks* (*u*), an action in the Palatine Court for the infringement of a patent, the defendants unsuccessfully raised numerous issues, including that of infringement. Judgment was given for the plaintiff with costs, and a certificate was granted that his particulars of breaches had been proved, and were reasonable. The plaintiff's taxed costs were, by consent, paid into Court by the defendants pending an appeal to the Court of Appeal. On the hearing of the appeal, the Court, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the action with costs. The defendants applied for repayment of the costs paid by them into Court. It was held that the plaintiff was not entitled to an apportioned part of these costs, attributable to the points other than infringement, on which he had succeeded at the trial, and that the costs must be paid out of Court without waiting for the result of an appeal to the House of Lords. Though it is right for the Court, if, after hearing the evidence it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues, nevertheless the Court will not apportion the costs of issues which have never been heard owing to the Court deciding that the patent is bad at the outset of the case (*x*).

(5.) *Costs on the Higher Scale.*

Costs may be allowed on the higher scale on special grounds.

It is provided by the Supreme Court Rules that costs on the "higher scale" may be allowed, either generally in any cause or matter, or as to the costs of any particular application made, or business done, in any cause or matter, if, on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or a judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or matter shall or shall not be brought to trial, or hearing, or to further consideration (as

(*u*) 1889, 6 P. O. R. 528.

(*x*) *Blakey* v. *Latham*, 1889, 6 P. O. R. 190. In this case a motion to adduce further evidence was ultimately not heard, as the patent was held not to be good subject-matter. The Court will not hear it either for the purpose of costs or of vindicating character. The motion, standing over at the risk of the persons who made it, was therefore dismissed with costs.

the case may be), so order; or if the taxing officer, under directions given to him for that purpose by the Court or a judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid (*u*).

Where the action was of a complicated nature, the Court considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing master to allow all or any part of the plaintiff's costs on the higher scale, if he thought fit, on the ground of the "nature" or "difficulty" of the case (*x*).

Costs of *action for injunction not* allowed on higher scale on ground that defendant submitted to an injunction (*y*); nor merely on the ground that important questions were raised (*z*).

Costs on the higher scale should be allowed in patent cases where scientific witnesses are necessarily called (*a*).

In considering whether the costs of a cause shall be on the higher scale, the Court will have regard to the importance of the questions in issue in the action, and also to the manner in which the case has been prepared and conducted at the trial (*b*).

It seems that, although a case, as presented to the Court, may not be of a special "difficulty" within the meaning of this rule, leave may be given to the taxing master to tax all or any part of the costs on the higher scale, if it appears on such taxation that the difficulty was removed by the expenditure of time, money, and learned industry (*c*).

Where the action was one requiring special knowledge on the part of those concerned in it, costs on the higher scale were allowed (*d*).

In *Automatic Weighing Co.* v. *Knight* (*e*), an appeal was dismissed with costs, and the defendants *subsequently* applied for costs on the higher scale. Held, that the application should be granted, but without costs, as it should have been made at the hearing of the appeal.

This rule applies to patent actions (*f*). In cases involving long

(*u*) R. S. C. Ord. LXV. r. 9.

(*x*) *Fraser* v. *Brescia Steam Tramways Co.*, 1887, 56 L. T. 771; 3 Times Rep. 687.

(*y*) *Hudson* v. *Osgerby*, 1884, W. N. 83; 32 W. R. 566.

(*z*) *Grafton* v. *Watson*, 1884, 51 L. T. 141. See also *Cardiff Steamship Co.* v. *Barwick*, 1885, 53 L. T. 56.

(*a*) *Ellington* v. *Clark*, 1889, 58 L. T. 818.

(*b*) *Davies* v. *Davies*, 1887, 56 L. J. Ch. 481.

(*c*) *Fraser* v. *Brescia Tramways Co.*, 1887, 56 L. T. 771.

(*d*) *Moseley* v. *Victoria Rubber Co.*, 1887, 57 L. T. 142, 148; 4 P. O. R. 241. See, too, *Farrar* v. *Farrar*, 59 L. T. 619.

(*e*) 1889, 6 P. O. R. 310, 372.

(*f*) *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 103; *Easterbrook* v. *G. W. Rail. Co.*, 1885, 2 P. O. R. 212; *Watling* v. *Stevens*,

examinations, preparation of models, and the calling of expert evidence, costs on the higher scale have been allowed against the unsuccessful litigants (*g*). The fact, however, that a defendant submits to an injunction is not a "special ground" within the meaning of Ord. LXV. r. 9 (*h*).

In *Peroni* v. *Hudson* (*h*), where the defendant did not appear at the trial, costs on the higher scale were refused to the plaintiff.

SECT. 16.—STAY OF EXECUTION.

Under the Rules of the Supreme Court, 1883. Ord. LVIII. r. 16, proceedings will not be stayed pending an appeal, except in so far as the Court appealed from, or any judge thereof, or the Court of Appeal, may order.

Rules as to stay of execution.

No general rules can be laid down as to the circumstances under which the Court will exercise its discretion.

Each case will be judged on its own merits.

The following points have, however, been decided, and it may be useful to note them.

Where judgment is given for a defendant with costs, execution will not be stayed, upon the defendant's solicitors giving their personal undertaking to repay any costs received by them, if the judgment should ultimately be reversed with costs (*i*).

An order for the delivery up of infringing machines has been suspended on the defendant undertaking that neither they nor any articles made by them should be removed out of or used in this country pending an appeal (*k*).

Where a defendant moved for a stay of proceedings pending an appeal to the House of Lords, and it appeared that, as the defendant

1886, 3 P. O. R. 43; *Otto* v. *Steel*, 1886, *Ibid.* 120; *Moseley* v. *Victoria Rubber Co.*, 1887, 4 P. O. R. 251; *Kaye* v. *Chubb*, 1887, *Ibid.* 289; *Kurtz* v. *Spence*, 1888, 5 P. O. R. 161—an action under sect. 32. In *Grafton* v. *Watson* (51 L. T. N. S. 143) costs on appeal against an interlocutory injunction were allowed only on the lower scale, although an important question was raised.

(*g*) *Wenham* v. *May*, 1888, 5 P. O. R. 310; *Ellington* v. *Clark*, 1888, 5 P. O. R. 161. Here costs on the higher scale were allowed by the Court of Appeal, although refused by the judge in the Court below. In *Crampton* v. *The Patents Investment Co.*, 1888, 5 P. O. R. 404, the judge at the trial refused to allow the costs on the higher scale at that stage, but reserved the question until after taxation, and gave liberty to apply thereafter if the defendants could show that they had suffered any injustice by the costs being taxed on the lower scale.

(*h*) *Peroni* v. *Hudson*, 1884, 1 P. O. R. 261.

(*i*) *Easterbrook* v. *G. W. Rail. Co.*, 1886, 2 P. O. R. 212; *Merry* v. *Nickalls*, 1873, 8 Ch. 205; *Morgan* v. *Elgood*, 1876, 4 Ch. D. 287.

(*k*) *Washburn and Moen Manufacturing Co.* v. *Patterson*, 1884, 1 P. O. R. 191.

was no longer making the infringing machines, the sole object was to prevent persons from being deterred by the judgment from buying them, the motion was refused (*l*).

The operation of an injunction (*m*) and [or (*n*)] of an order for an account (*o*) has been suspended on the defendant undertaking to keep an account, and to appeal promptly, the plaintiff having liberty to apply if the appeal was not promptly prosecuted (*p*).

Sect. 17.—Appeals.

Appeals, how brought.

The old law as to appeals in patent actions is of such moderate proportions that it can most clearly be stated in treating, as we now propose very briefly to treat, of the present practice. All appeals to the Court of Appeal are to be by way of rehearing, and are to be brought by notice of motion in a summary way (*q*).

It is not, under any circumstances, necessary for a respondent to give notice of motion for a cross appeal, unless he proposes to contend, on the hearing of the appeal, that the decision of the Court below should be varied, in which case he should give notice to any parties affected by such contention (*r*).

Bankrupt appellants.

A novel point, as to the position of bankrupt appellants, was raised and decided in *United Telephone Co.* v. *Bassano* (*s*). Judgment had been given restraining the defendants from the manufacture or sale of articles of a certain construction as being an infringement of the plaintiff's patent, and ordering delivery up of all instruments so constructed. The defendants appealed, but before the appeal was ready for hearing became bankrupt. It was held that the defendants, though bankrupt, had still such an interest in being relieved from the injunction as entitled them to proceed with the appeal on giving security for costs. An order was accordingly made dismissing the appeal, unless within a certain time the bankrupts gave security for costs, or the trustee in bankruptcy made himself a party to the proceedings.

(*l*) *Proctor* v. *Bennis*, 1887, 4 P. O. R. 363; cp. *Adair* v. *Young*, 1879, 11 Ch. D. 136; *Nordenfelt* v. *Gardner*, 1884, 1 P. O. R. 63; *Otto* v. *Steel*, 1886, 3 P. O. R. 109, 121.

(*m*) *Hocking* v. *Fraser*, 1886, 3 P. O. R. 7.

(*n*) *Woodward* v. *Sansum*, 1886, 3 P. O. R. 366; *Humpherson* v. *Syer*, 1887, 4 P. O. R. 184.

(*o*) *Kaye* v. *Chubb*, 1887, 4 P. O. R. 23.

(*p*) *S. C.*

(*q*) In *Siddell* v. *Vickers*, 1888, 5 P. O. R. 416, 436, Cotton, L.J., intimated that cases before the law officers should not be cited before the High Court or the Court of Appeal. R. S. C. 1883, Ord. LVIII. r. 1. For some of the grounds of motion for a new trial, see *King* v. *Oliver*, 1884, 1 P. O. R. 32, 44.

(*r*) *Ibid.* r. 6.

(*s*) 1886, 31 Ch. D. 630.

Some years ago the practice was to dismiss an appeal at once where a reasonable time for giving security, allowed under Ord. LVIII. r. 15, had been exceeded without security being given. The more recent practice was to allow the appellant a further limited time within which to give security, and to order that if he did not give it within that time the appeal should be dismissed without further application to the Court. It was found, however, that the latter rule encouraged appellants to wait until an application to dismiss the appeal was made. Accordingly, in the case of *Washburn and Manufacturing Co.* v. *Patterson* (*t*), the Court of Appeal reverted to the old practice of making an immediate order for the dismissal of an appeal when security had not been found within a reasonable time and there were no extenuating circumstances. Their lordships intimated that an unexplained delay of three months would be sufficient.

"If upon the hearing of an appeal it shall appear to the Court of Appeal that a new trial ought to be had, it shall be lawful for the Court of Appeal, if it shall think fit, to order that the verdict and judgment shall be set aside and that a new trial shall be had" (*u*).

The Court is also invested with the widest powers of varying, in whole or in part, any judgment appealed against, and of making any order that the case may require (*x*).

Further evidence on appeal.

The Court of Appeal has full discretionary power to receive further evidence upon questions of fact; but upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence, save as to matters subsequent as aforesaid, shall be admitted on special grounds only, and not without special leave of the Court (*y*). The term "special grounds" was judicially considered in *Hinde* v. *Osborne* (*z*). "I cannot," said Lindley, L. J., in that case, "understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence simply because a man has failed at the trial and he thinks he can get more evidence which, if he had got it before, would have enabled him to succeed on the trial . . . . . There must be some ground shown to satisfy the Court that there is some evidence now forthcoming which with due diligence he could not have got, and it must, moreover, in accordance with the usual

(*t*) 1885, 29 Ch. D. 48. Cp. *Parker* v. *Maignen's Filtre Rapide Co.*, 5 P. O. R. 207; *Edison Telephone Co.* v. *India Rubber Co.*, 1881, L. R. 17 Ch. D. 137.

(*u*) R. S. C. 1883, Ord. LVIII. r. 6.

(*x*) *Ibid.* r. 4.

(*y*) *Ibid.* Cp. *Edison Co.* v. *Shippey*, 1887, 4 P. O. R. 471.

(*z*) 1885, 2 P. O. R. 47.

Further evidence.

practice, be evidence—not merely swearing by affidavits, or anything of that kind, but something in the nature of the production of a lost document or something of that sort—which will not expose the parties to a mere flood of affidavits made up to meet the blots and the defects which have been disclosed upon the first trial."

Illustrations.—(1.) The defendant in an action for infringement went to trial on a defence of non-infringement simply: he had previously pleaded want of novelty in the patent, but withdrew the plea. The plaintiff obtained an injunction, and the defendant appealed. The defendant subsequently moved for leave to adduce fresh evidence on the hearing of the appeal as to some anticipation of the plaintiff's patent, which he alleged that he had discovered since the trial. The motion was refused on the ground that it did not appear that the defendant was unable to get sufficient information to support the plea of want of novelty which he had abandoned at the trial (*e*).

(2.) W., a petitioner for revocation of letters patent, applied for leave to adduce further evidence of anticipation on the hearing of an appeal. It appeared that the plaintiff had been examined *de bene esse* before the trial, and that the alleged anticipation had been put to him in cross-examination. The motion was therefore refused (*f*).

In *Nordenfelt* v. *Gardner* (*g*), Lindley, L. J., intimated that the Court of Appeal would allow a merely formal defect of title, such as the non-production of a link in a chain of assignments, to be cured under their general powers to amend and admit further evidence (*h*).

In *Blakey* v. *Latham* (*i*), an appellant moved for leave to adduce further evidence on the appeal, on the ground that two of the witnesses who had given evidence at the trial as to an alleged anticipation had subsequently made statements, some on oath and others not, which tended to show that their evidence in the Court below was untrue in material respects, and on the further ground that the plaintiff had, since the trial, discovered further evidence with regard to such alleged anticipation which he could not with due

(*e*) *Hinde* v. *Osborne*, 1885, 2 P. O. R. 47.

(*f*) *Walker* v. *Hydro-Carbon Syndicate*, 1886, 3 P. O. R. 253.

(*g*) 1884, 1 P. O. R. at p. 73.

(*h*) R. S. C. 1883, Ord. LVIII. r. 4.

(*i*) 1889, 6 P. O. R. 186. A motion for sequestration and attachment for breach of an injunction contained in a consent judgment in an action for infringement of a patent is an interlocutory application within rule 4 of R. S. C. 1883, Ord. LVIII., and further evidence can be admitted on appeal: *Spencer* v. *Ancoats Vale Rubber Co.*, 1889, 6 P. O. R. 46.

diligence have discovered before. The Court of Appeal gave liberty to the plaintiff to subpœna such witnesses with reference to the alleged anticipation, as he should name to the respondent ten days before the appeal was first in the paper for hearing, with liberty to the respondent to subpœna such witnesses as he might desire, and give the names to the plaintiff within five days before the appeal, and the Court ordered the rest of the motion to stand over until the hearing of the appeal.

Effect of previous judgment.

In *Slazenger* v. *Feltham* (*k*), an action for infringement of a patent, it was held that where a judge of co-ordinate jurisdiction had decided two years before the present action that the patent was useful, novel, and good subject-matter, and had not been anticipated, the only question that could then be raised was the question of anticipation by fresh instances.

In *Edison Co.* v. *Holland* (*l*), it was held that a previous decision of the Court of Appeal on the same patent must be followed so far as it construed the patent, but that whether the claim was too wide or proper subject-matter, and whether the invention was novel and useful, were questions depending partly on fact and must be decided *de novo*.

Where a patent was held valid in a previous action, the same judge in a subsequent action would not allow the same objections of anticipation and want of subject-matter to be again raised, and refused to admit evidence on those points (*m*).

(*k*) 1889, 6 P. O. R. 130.
(*l*) 1889, 6 P. O. R. 243. Cp. *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, *ibid.* 367.
(*m*) *S. C.* p. 120, *ubi supra*.

CHAPTER XV.

ACTION TO RESTRAIN THREATS.

SECT. 1. PRIOR TO ACT OF 1883.
SECT. 2. UNDER ACT OF 1883.

SECT. 1.—PRIOR TO ACT OF 1883.

Origin of action to restrain threats.

AT least as early as the year 1869 (*a*), it had been recognized that damages might be recovered, and an injunction granted, against a person who issued threatening notices of legal proceedings in order to deter others from purchasing alleged infringements of his patent, and the existence of this remedy had never subsequently been questioned.

Judicial opinion, however, had been divided as to one of the *facta probanda* in such proceedings.

Want of *bona fides* material.

In *Wren* v. *Weild* (*a*), it was held by the Court of Queen's Bench that an action would not lie unless the plaintiff affirmatively proved that the defendant's claim was not a *bonâ fide* claim in support of a right which, with or without cause, he fancied he had, but a *mala fide* and malicious attempt to injure the plaintiff by asserting a claim of right, against his own knowledge, that it was without any foundation. Want of *bona fides* or the presence of *mala fides* was therefore a material fact to be alleged and proved. This view of the law had the subsequent assent, first of Jessel, M. R., and then of the Court of Appeal, in the case of *Halsey* v. *Brotherhood* (*b*). So far the Courts were unanimous.

Patentee, whether bound to

In the cases of *Rollins* v. *Hinks* (*c*) and *Axmann* v. *Lund* (*d*), however, Malins, V.-C., held that a patentee is not entitled to publish

(*a*) *Wren* v. *Weild*, L. R. 4 Q. B. 730, 737.

(*b*) 1880, 1881, L. R. 15 Ch. D. 514; 19 Ch. D. 386. Cp. *Sugg* v. *Bray*, an action brought before but tried under the Patents Acts, 1883—1885, 1 P. O. R. 45; 2 P. O. R. 224.

(*c*) 1872, L. R. 13 Eq. 355.

(*d*) 1874, L. R. 18 Eq. 330.

statements of his intention to institute legal proceedings, if he has no *bonâ fide* intention to follow up his threats by taking such proceedings, and that the Court will in such case restrain him from making such publication. follow up threats.

In *Halsey* v. *Brotherhood* (*e*), Jessel, M. R., rejected this statement of the law. "A man," said his lordship, "merely giving notice that his rights are being infringed, believing that they are infringed, is not to be subjected to an action for giving that notice . . . . even although he does not follow up that notice by bringing an action at law for the infringement."

In the same case it was held that if the plaintiff wanted an injunction he must make out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement by the plaintiff was untrue. Evidence necessary if injunction claimed.

Prior to the Act of 1883, it appears, therefore, that the law as to threatening notices may be stated thus. Two remedies—damages and an injunction—were competent to any person injuriously affected by the threat of legal proceedings. To secure the former, the plaintiff was required to prove that the statements complained of were injurious to him, untrue, and made *malâ fide*. Failure on the part of a defendant to follow up his threats by raising an action for infringement did not make him liable to an action for damages. To entitle him to an injunction the plaintiff was required to prove not only that the representations complained of were untrue, but that the defendant intended continuing to make them. Summary of law prior to 1883.

Sect. 2.—Under Act of 1883.

Sect. 32 of the Act of 1883, provides that—"Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this Patents Act, 1883, s. 32.

(*e*) *Ubi supra.*

section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

Alterations introduced by Act of 1883.

This section has altered the earlier law in several respects, which may be briefly noted before we consider its provisions in detail.

1. The *bona fides* of the patentee threatening legal proceedings or liability is immaterial if (a) the acts of the plaintiff are not in fact an infringement of his patent right; and (b) he fails with due diligence to commence and prosecute an action for infringement.

2. The doctrine laid down in *Rollins* v. *Hinks* (*f*), and *Axmann* v. *Lund* (*g*), but dissented from in *Halsey* v. *Brotherhood* (*h*), that a person giving notice that his rights are being infringed is liable to an action for damages if he does not follow up that notice by bringing an action for infringement, has now received legislative sanction.

The section may be logically considered under the following heads:—

The threat of legal proceedings.

(1) *The threat of legal proceedings*, "which is the subject-matter of the action, must not be merely a warning about something which is going to be done, but must be a threat about an act done. It must be a threat of legal proceedings or liability in respect of an alleged manufacture, use, sale, or purchase of the invention." Threats do not fall within this definition if they are mere threats or warnings as to something which may be done in the future. "Everybody has still a right to issue a general warning to pirates not to pirate, and to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled and under which he claims is one that he intends to enforce. . . . It does not follow that because a threat is so worded as in mere language apparently and grammatically to apply only to the future that therefore it may not be in any particular case in substance and in fact applicable to what has been done. Supposing for a moment that a manufacturer is making and issuing machines which the patentee considers to be an infringement of his patent; if with reference to that act done, or to those machines made, the patentee endeavours to guard himself against this section by merely issuing a threat in the air . . . . he would not escape if the

(*f*) 1872, L. R. 13 Eq. 355.
(*g*) 1874, L. R. 18 Eq. 330.
(*h*) 1879, L. R. 15 Ch. D. 514; 19 Ch. D. 386.

true gist of what he has done is to apply that threat to a particular person and to a particular act" (*i*).

How threat may be conveyed.

A threat so defined may be conveyed in a circular, an advertisement, or a private letter (*j*), or may be made at an interview, or in the course of a correspondence, even when conducted mainly without prejudice (*k*).

Threats made by a solicitor's letter are sufficient ground for an action (*l*).

Where a defendant complains not of the plaintiff's invention *simpliciter*, but that the plaintiff's invention is being so used by third parties as to infringe his patent, this is not a threat within the meaning of sect. 32 if the notice is so framed as to make this clear (*m*).

A threat of legal proceedings contained in a letter which has never been qualified or withdrawn, is held to be continued (*n*).

The point that there has not been such a threat as the section contemplates should not be raised as a "preliminary objection" at the trial (*o*).

Remedies, to whom competent.

(2) The remedies prescribed by the statute are competent *either* to the person threatened, *or to* any person aggrieved by the threats (*p*).

Remedies.

(3) *The remedies* allowed by this section are—

(a) An action to recover such damage, if any, as the plaintiff may have sustained by the defendant's threats; and

(b) An injunction against the continuance of such threats.

Action.

Although these remedies are concurrent, it will be convenient to treat them to some extent separately.

On whom *onus probandi* rests.

In an action for damages for threatening notices, the burden of proving that the patentee's statements are false rests on the plaintiff (*q*).

In *Wren* v. *Weild* (*r*), an action brought by the plaintiffs in

(*i*) *Challender* v. *Royle*, 1887, per Bowen, L. J., 4 P. O. R. at pp. 374, 375.

(*j*) *Driffield, &c. Co.* v. *Waterloo, &c. Co.*, 1886, 31 Ch. D. 638; *Walker* v. *Clarke*, 1887, 4 P. O. R. 113; *Kurtz* v. *Spence*, 1888, 5 P. O. R. 161; *Crampton* v. *Patent Investment Co.*, 1888, 5 P. O. R. 393.

(*k*) *Kurtz* v. *Spence*, *ubi supra*, 172, 173.

(*l*) *Combined Weighing Co.* v. *Automatic Weighing Co.*, 1889, 6 P. O. R. 502; 42 Ch. D. 665.

(*m*) *Burt* v. *Morgan*, 1887, 4 P. O. R. 280, 281.

(*n*) *Driffield, &c. Co.* v. *Waterloo, &c. Co.*, *ubi supra*, per Bacon, V.-C., at p. 643.

(*o*) *Kurtz* v. *Spence*, 1888, *ubi supra*, per Kekewich, J., at p. 170.

(*p*) Cp. Stirling, J., in *Burt* v. *Morgan*, *ubi supra*, at p. 280.

(*q*) *Burnett* v. *Tak*, 1882, 45 L. T. N. S. 743; *Anderson* v. *Liebig's Extract of Meat Co.*, 1881, 45 L. T. N. S. 757, 759.

(*r*) 1869, L. R. 4 Q. B. 213.

respect of injury caused by letters and statements of the defendant alleging that certain machines sold by them were infringements of his patent, the Court ordered the defendant to deliver particulars to the plaintiff, showing in what part or parts the said machines were an infringement of his patent, and pointing out, by reference to line and page of his specifications, what part of the inventions therein described he alleged to have been infringed. This case was decided in 1869, but it is presumed that a similar order might still be made.

Damages, when awarded.

Damages will be awarded only where substantial injury has been sustained.

Thus, in *Driffield, &c. Co.* v. *Waterloo, &c. Co.* (*s*), where the plaintiffs had merely been compelled by the threats complained of to look over their machinery, and to suspend certain building operations, Bacon, V.-C., held that the notion of damages was out of the question.

Threats without prejudice.

In *Kurtz* v. *Spence* (*t*)—a leading case under this section—where (a) the threats were conveyed in the course of a correspondence conducted mainly "without prejudice," and with a view to the amicable adjustment of the legal rights of the parties; and (b) the plaintiffs had not yet erected plant and machinery for the manufacture of the articles alleged to infringe the defendants' patent, Kekewich, J., refused to direct a reference as to damages, and awarded the plaintiffs 40*s*., with costs on the higher scale.

Validity may be questioned.

The plaintiff may now, it seems, question the validity of the defendant's patent in an action under sect. 32 (*u*), but the Court may order that the defendant shall have the same notice of objections, and the same right of beginning and replying, as he would have had if he had brought an action against the plaintiff to restrain the infringement of his patent (*x*).

Defendant must support patent as in action for infringement.

In an action for damages under this section, the question who is the true and first inventor is an issue of fact, which is not concluded by the defendant merely producing the original letters patent duly sealed. He is bound to support them as if he were plaintiff in an action for infringement (*y*).

(*s*) 1886, 3 P. O. R. at p. 48.
(*t*) 1888, 5 P. O. R. at p. 177.
(*u*) *Challender* v. *Royle*, 36 Ch. D. 425; disapp. of *Kurtz* v. *Spence*, 33 Ch. D. 579, upon this point. Cp. *Law* v. *Ashworth*, 1890, 7 P. O. R. 86.
(*x*) *Kurtz* v. *Spence*, 1887, 36 Ch. D. at p. 774, per Cotton and Bowen, L.JJ., Fry, L. J., *diss.*; *Union Electrical Power and Light Co.* v. *Electrical Power Storage Co.*, 1888, 38 Ch. D. 325.
(*y*) *Kurtz* v. *Spence*, 1888, 5 P. O. R. at p. 177, per Kekewich, J.

Injunction. Balance of convenience looked to.

In considering a motion (which should not be made *ex parte* (*z*)) for an interlocutory injunction under sect. 32, the Court looks to the balance of convenience and inconvenience, and in particular requires the applicant to make out at least a *primâ facie* case (*a*) that the act complained of is not an infringement.

Material points.

The following points are also material: Is there evidence of the violation of any contract or undertaking entered into between the plaintiff and the defendant? (*b*). Has the defendant with "due diligence" commenced an action for infringement against the plaintiff?

Due diligence.

The law upon this latter point may be very shortly summarised. An action is commenced with due diligence if commenced (a) within a reasonable time, *e.g.*, within an interval of three months *after the threats complained of;* (b) with the *bonâ fide* intention of testing the validity of the patent or the fact of infringement, whichever may be in question; and (c) against the person or any of the persons to whom the threats have been made (*c*).

The fact that a person making threats refrains from bringing an action to assert his rights, is very material on a motion for an interlocutory injunction (*d*).

The proviso of sect. 32 may be satisfied although the patentee does not apply for an interlocutory injunction in his action (*e*).

An action for infringement to come within the proviso must be to restrain an infringement similar to that which is threatened; and the proviso is not satisfied by an action to restrain a different infringement (*f*).

The right of action for threats given by sect. 32 of the Act of 1883 is taken away by the commencement of an action for infringement commenced and prosecuted with due diligence (*f*).

The fact that the defendant in an action under sect. 32 contends

(*z*) *Wilson* v. *Walter E. Church Engineering Co.*, 1885, per Bacon, V.-C., 2 P. O. R. 175.

(*a*) *Colley* v. *Hart*, 1889, 6 P. O. R. 17; cp. *Société Anonyme des Manufactures de Glaces* v. *Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 9; *Barney* v. *United Telephone Co.* 1885, 28 Ch. D. 94, where evidence of no infringement was held to be a condition precedent to the grant of an interlocutory injunction. *Walker* v. *Clarke*, 1888, 4 P. O. R. 114, where this extreme view was dissented from.

(*b*) *Société Anonyme, &c., ubi supra; Household* v. *Fairburn*, 1884, 1885, 1 P. O. R. 108; 2 P. O. R. 140; *Sharp* v. *Brauer*, 1886, 3 P. O. R. 193; cp. also *Clark* v. *Adie*, 1873, 21 W. R. 456, 764; *Société Anonyme, &c., ubi supra.*

(*c*) *Challender* v. *Royle*, 1887, 36 Ch. D. per Cotton, L. J., at p. 437.

(*d*) *Colley* v. *Hart*, 1889, per North, J., 6 P. O. R. at p. 21.

(*e*) *Anderson* v. *Liebig's Extract of Meat Co.*, 1881, 45 L. T. N. S. 757.

(*f*) *Combined Weighing Co.* v. *Automatic Weighing Co.*, 1889, 6 P. O. R. 502, 507; 42 Ch. D. 665.

at the trial that the threatening notices were such as he had a right to issue and to continue to issue, is no evidence of an expression of intention to persist in issuing such notices in the event of its being decided that the doing of it would be actionable (*g*).

The meaning of the proviso in sect. 32 was recently considered in *Barrett* v. *Day*, and *Day* v. *Foster* (*h*). F. was exclusive licensee of D., a patentee; he was also exclusive licensee of B., a subsequent patentee. D. sued F. for a declaration that articles made under B.'s patent were an infringement of his (D.'s) patent, and for an injunction to restrain manufacture and sale under B.'s patent without paying royalties to D. and accounts of royalties for past manufacture.

Previously to the issue of the writ, D.'s solicitor had written to F.'s solicitors that B.'s patent was within D.'s patent, and that claims would be made in the action, then intended, in respect of articles made under B.'s patent. B. sued D. under sect. 32 for an injunction to restrain threats. North, J., held that D.'s action was an action for infringement within the meaning of that section, and as it had been brought with due diligence the section did not apply, and B.'s action was stayed.

Advertisement after action brought.

After an action has been commenced, a patentee may not advertise, and will, if necessary, be restrained by injunction from advertising a positive statement that the defendant has infringed. He may, however, give notice that an action has been brought, and warning other persons against the consequence of infringement (*i*).

Cross actions.

Where an action for threats is brought, and then a cross action for infringement, some arrangement should be made in order to avoid incurring unnecessary costs by trying the same action in two different forms (*k*).

(*g*) *Sugg* v. *Bray*, 1885, per North, J., 2 P. O. R. at p. 246.

(*h*) 1890, 7 P. O. R. 54; L. R. 43 Ch. D. 435; W. N. 1890, 36.

(*i*) *Goulard* v. *Lindsay*, 1887, 4 P. O. R. per Kay, J., at p. 189; *Fusee Vesta Co.* v. *Bryant and May*, 1887, 4 P. O. R. 192.

(*k*) *Combined Weighing Co.* v. *Automatic Weighing Co.*, *ubi sup.* at p. 267.

CHAPTER XVI.

REVOCATION OF PATENTS.

SECT. 1. SCIRE FACIAS BEFORE ACT OF 1883.
SECT. 2. REVOCATION UNDER ACT OF 1883.

SECT. 1.—SCIRE FACIAS BEFORE ACT OF 1883.

Necessity of scire facias.

BEFORE the Act of 1883 the mode of revoking and cancelling patents for inventions was by an action of *scire facias*, in which a person complaining of the illegality of a patent was authorized by the fiat of the Attorney-General to proceed in the name of the Crown to obtain the judgment of the Court of Chancery for its repeal (*a*).

The action of *scire facias* was necessary as a protection to the Crown and the public. The proceedings to obtain a patent were substantially *ex parte*. The grant being entirely at the risk of the petitioner, the Attorney-General relied solely on his statement of facts. An opponent had no information to guide him except the title of the invention, which was purposely made as vague as possible, and was not permitted to hear the petitioner's statement in support of his claims. It was, therefore, essential that there should be some remedy for the Crown and the public against false suggestions and illegal grants.

The procedure for the repeal of letters patent for inventions was formerly the same as that for the repeal of other royal grants. And *scire facias* still lies to repeal such of these other grants as may be contrary to law, or have been obtained by false suggestion.

The proceeding for avoiding and cancelling a patent by *scire facias* was originally taken on the common law side of the Court

(*a*) See a full account of the practice in proceedings by *scire facias* in Hindmarch, pp. 376 *et seq.*

of Chancery, that being the Court in which the patent was made (*b*).

Crown grants always obtained by petition.

Crown grants in general are, indeed almost always, obtained by means of representations made by, or on the behalf of the grantees, and as the sovereign is so much occupied with the affairs of the state, it would be impossible always to ascertain with certainty whether the representations of a petition for a grant by patent were true or not. The law, therefore, takes especial care to protect the Crown against false petitions and representations (*c*). It is accordingly laid down that it is the duty of every one obtaining a grant from the Queen, to see that she is correctly informed respecting the grant. And if it appears that the Queen has been deceived in any material particular, by a false representation or suggestion of the grantee, the patent will be wholly void (*d*). And when facts are recited in a patent respecting the subject-matter of the grant, it will be presumed that the statements contained in the recital were represented or suggested to the Queen by the patentee (*e*).

Crown specially protected against false petitions.

If Crown deceived, patent void.

Particulars respecting the invention were stated in petition and recited in the patent.

The material particulars respecting an alleged invention for which a party formerly sought to obtain a patent, were stated in the petition for the patent. The petition stated that the petitioner was the inventor or importer of the invention, and that the invention possessed the qualities of novelty, utility, &c., so as to be the proper subject of a grant by patent. The substance of the petition for the patent was always recited in the patent itself, and therefore the patent itself showed upon what representations of the patentee it had been granted; and if the patentee had represented anything which was untrue in any material particular, or had induced the Crown to make an illegal grant, the patent was entirely void.

Remedy for the public by *scire facias*.

The various objections which can be taken to a patent for an invention, by a person against whom the patentee may institute legal proceedings, have already been considered (*f*); and the law provided a remedy for the public by action of *scire facias*, in which similar objections might be taken, and if any valid objection was sustained, the result was that the patent was repealed or annulled, and ordered to be cancelled.

Queen may proceed by *scire facias* to cancel a patent.

The Queen has by the common law an undoubted right to proceed by *scire facias* to repeal and cancel a patent respecting which she has been deceived, or by which her subjects are prejudiced.

(*b*) Hindmarch, p. 379.
(*c*) See 10 Co. R. 113, b.
(*d*) Vin. Abr. Prerog. (O. b.).
(*e*) 5 Co. R. 55, b.; 10 Co. R. 112, a.
(*f*) *Ante*, pp. 288 *et seq.*

This was laid down by the judges in the House of Lords in the case of *R.* v. *Butler* (*g*), and there are several old authorities to the same effect (*h*). In the *Magdalen College case* (*i*), it was said, that "The law has given the king a great prerogative above any of his subjects, that where by fraud or false suggestion he is deceived, that he himself in such cases shall avoid his own grant *jure regio*." And in *Legat's case* (*k*), it was said, that "When upon false insinuations or pretences the king makes any grant, as of any monopoly, &c., which, in truth, is to the prejudice of the king and commonwealth, the king *jure regio* shall avoid such grants, *and such letters patent by judgment of law shall be cancelled*" (*l*).

R. v. *Butler.*

Magdalen College case.

Legat's case.

The grounds on which an action of *scire facias* might formerly be instituted were "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent" (*m*).

Former grounds for *scire facias.*

Fraud and *false suggestion* may be considered together (*n*).

Fraud and false suggestion.

Letters patent were granted for "certain improvements in steam engines and in machinery for propelling vessels." One of the inventions as described in the specification was not an improvement. The grant was held bad for falsity of suggestion (*o*).

Cases.

Letters patent were taken out for a watch. The invention as disclosed by the specification was only of part of a watch. The patent was repealed (*p*).

The patentee of an improved machine claimed as his invention a part of it which turned out to be useless. The specification did not describe it as essential to the machine. It was held that the patent was not vitiated (*q*).

The distinction between the first two and the last of the cases just cited is clear. In each of the former there was a false statement, recited in the patent by way of suggestion, and forming a material part of the consideration for the grant. In the latter the false

(*g*) 3 Lev. 220, 221.

(*h*) See Staund. Prerog. 84, a.; Brook, Abr. Pat. 14, Petit. 11, and Sci. Fa; Rol. Abr. Prerog. (S.) p. 191; 21 Ed. III. 47 B. & 10 Co. 113, b.

(*i*) 11 Co. R. 74, b.

(*k*) 10 Co. R. 109.

(*l*) This and the third previous paragraph are adapted from Hindmarch, pp. 377-9.

(*m*) Webs. Lett. Pat. p. 32.

(*n*) See *R.* v. *Mussary*, 1738, 1 Web. P. C. 41, n. 2.

(*o*) *Morgan* v. *Seaward*, 1835-37, 2 M. & W. at p. 561.

(*p*) Before 1795; 1 Web. P. C. 42, n.; cp. *R.* v. *Wheeler*, 1819, 2 B. & Ald. 349; *Hill* v. *Thompson*, 1818, 1 Web. P. C. 239; *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 551, 552, 558; *Felton* v. *Greaves*, 1829, 3 C. & P. 611.

(*q*) *Lewis* v. *Marling*, 1829, 1 Web. P. C. 496; cp. *Morgan* v. *Seaward*, 1837, 1 Web. P. C. 197, per Alderson, B.

recital was not made by way of suggestion at all (*r*). Even if such a false recital did affect in some degree the suggestion made by the patentee to the crown, the patent will not necessarily be held void.

Utility.

Thus, in *Haworth* v. *Hardcastle* (*s*), an action for infringement, the jury found as follows: "the invention is new and useful upon the whole . . . . but they also find that the machine is not useful in some cases for taking off goods." In delivering judgment upon a motion for entering a non-suit, Tindal, C. J., said: "We think we are not warranted in drawing so strict a conclusion from this finding of the jury, as to hold that they have intended to negative, or that they have thereby negatived, that the machine was useful in the generality of the cases which occur for that purpose. After stating that the machine was useful upon the whole, the expression, that in some cases it is not useful to take up the cloths, appears to us to lead rather to the inference that in the generality of cases it is found useful. And if the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void. . . . We think that we should act with great hazard and precipitation if we were to hold that the plaintiff ought to be non-suited upon the ground that his machine was altogether useless for one of the purposes described in his specification."

Non-compliance with conditions of patent.

A specification described various parts of machinery, but no complete machine, and the defendant did not point out what parts were new. The patent was repealed (*t*).

Want of novelty and utility.

A patent was granted for "improvements in firegrates or stoves." The specification, after describing the stove, claimed as the invention the construction of stoves in such manner as that the fuel necessary to supply the fire shall be introduced from beneath, either in a perpendicular or in an oblique direction. Ellenborough, C. J., was of opinion that the evidence showed grates to have been constructed prior to the patent on a principle identical with that described in the specification; that the patentee by his claim had confined himself to that principle, and that therefore the patent could not be supported (*u*).

(*r*) See 1 Web. P. C. 42, n.; cp. *Morgan* v. *Seaward*, 1837, 1 Web. P. C. 197, per Alderson, B.; cp. *Travell* v. *Carteret*, 3 Lev. 134; *Alcock* v. *Cooke*, 1820, 5 Bing. 340, cited by Parke, B., in *Morgan* v. *Seaward*, *ubi supra*, at p. 196.

(*s*) 1834, 1 Web. P. C. 483.

(*t*) *R.* v. *Arkwright*, 1785, 1 Web. P. C. 64, and other authorities there cited; *R.* v. *Cutler*, 1816, 1 Web. P. C. 76; and Specification, *supra*, p. 83.

(*u*) *R.* v. *Cutler*, *ubi supra*.

The *defects* in the proceeding by *scire facias* were in many ways objectionable. It was cumbrous. The most superficial study of the description given by Hindmarch of the various stages in the action will satisfy any one upon this point. It was costly. The *fiat* of the Attorney-General was obtained as a matter of course by any one who could give the requisite security by bond to the chief clerk of the Petty Bag Office. No interest in the repeal was necessary. Although particulars of objection were required, and although it was provided—15 & 16 Vict. c. 83, s. 41—that no evidence should be admitted on any subject not mentioned therein, the particulars supplied were usually so vague as to give no information at all, and the patentee came into Court without any accurate knowledge of the case he had to meet. On this point the evidence taken before "the Commissioners appointed to inquire into the working of the law relating to patents for invention" is interesting and conclusive (*x*).

The action of *scire facias* was tried, in so far as issues of fact were concerned, before a jury.

The patentee, if successful in an action of *scire facias*, obtained only such costs as were covered by the petitioner's bond; the petitioner, who succeeded in setting aside a patent, got no costs at all, on account of the general rule of law which then prevailed, that the Queen received no costs in any action to which she was a party (*y*).

Sir Roundell Palmer, giving evidence before the Commissioners, said (*z*): As the inquiry is one usually more of judgment and opinion than of fact, there is always the contradiction between the witnesses ranged on each side, which is almost proverbial in questions of this description. If, then, the point to be determined is the resemblance between two machines, the difference between which cannot be observed by a common eye, or the distinction between two equivalent chemical combinations, the probability is that the last word will carry the day; and it has more than once happened that the same patent tested by an action for infringement has been held good, and has been afterwards set aside when impeached by *scire facias*, the patentee beginning his case in the action, and his opponent in the *scire facias*, and each respectively having the reply. This advantage of the first and last word in cases of this kind has

(*x*) Report of the Commissioners, &c., 1865.

(*y*) Report, &c., 1865, p. 15, Ans. 347—350.

(*z*) *Ibid.*, Appendix, p. 180, Ans. 7.

been considered of such importance that the legislature, in the Act of 1852, provided that for the benefit of a patentee at the trial of a *scire facias* to repeal letters patent, the defendant should begin, and if evidence should be adduced on the part of the prosecutor, should be entitled to reply.

Sect. 2.—Revocation Under Act of 1883.

The petition.

The proceeding by *scire facias* is now in form abolished, and revocation of a patent may be obtained by petition to the Court.

Every ground on which a patent might, before the Act of 1883, be repealed by *scire facias* is now a ground of revocation, and also available by way of defence to an action of infringement (*a*).

Letters patent for inventions assigned to the Secretary of State for War are not revocable (*b*).

The Court.

The "Court" means the High Court of Justice in England (*c*), the Court of Session in Scotland (*d*), and the High Court of Justice in Ireland (*e*).

Does not include Lancaster Palatine Court.

Petitions for revocation cannot be presented in the Court of the County Palatine of Lancaster, which is not a Court within the meaning of the Patents Act, 1883, except for the purpose expressly set forth in sect. 112 (a) (*f*).

Jurisdiction to repeal patent in England where patentee a domiciled Scotchman.

Where a petition was presented for the revocation of a patent belonging to a domiciled Scotchman who was served with the petition, but stated he did not intend to appear, the Court, on the application of the petitioner, made an order that the petition should go into the witness list, unless the patentee showed cause to the contrary, it being open to the patentee, if he appeared, to dispute the jurisdiction (*g*).

Nature of petition for revocation.

A petition for revocation is in the nature of an "action," or at any rate is a "matter," and therefore (*h*) it can be sent for trial at assizes before a judge without a jury; but such an order will not prevent the judge at the trial from acting on his own view of his jurisdiction (*i*).

(*a*) Act of 1883, s. 26, sub-ss. 1, 2, 3.
(*b*) Sect. 44, sub-ss. (3) and (9), *infra*, pp. 498, 499.
(*c*) *Ibid.* s. 117.
(*d*) *Ibid.* s. 109.
(*e*) *Ibid.* s. 111, sub-s. (1).
(*f*) *Proctor* v. *Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. at p. 185.
(*g*) *Drummond's Patent*, 1889, 6 P. O. R. 576; L. R. 43 Ch. D. 80.
(*h*) Either under R. S. C. 1883, Ord. XXXVI. r. 1; or Ord. XXX. r. 1.
(*i*) *In re Edmonds' Patent*, W. N. 1888, p. 234; 1889, 6 P. O. R. 355.

A petition for revocation may be presented by any of the following persons (*k*) :— Who may petition.

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

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

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

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

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

Proceedings in Scotland for revocation of a patent takes the form of an action of reduction at the instance of the Lord Advocate; or of a party having interest with his concurrence, which concurrence may be given on just cause shown only (*l*). Who may petition in Scotland.

It appears, therefore, that a petitioner before the Court of Session for revocation of letters patent, is required to have both an interest in the patent which he seeks to repeal and the concurrence of the Lord Advocate.

When it is desired to obtain the fiat of the Attorney-General, the following papers must be sent to the Patent Clerk, at Room No. 549, Royal Courts of Justice, London: a memorial to the Attorney-General asking for his authority, and stating all the circumstances; a statutory declaration verifying the statements in the memorial; two copies of the proposed petition and of the particulars proposed to be delivered with it; the certificate of a barrister that the petition is proper to be authorized by the Attorney-General; the certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition, if unsuccessful. Fiat of Attorney-General, how obtained.

The fiat of the Attorney-General has never been, and is not now, issued as a matter of course. Fiat not issued as of course.

(*k*) Patents Act, 1883, s. 26, sub-s. (4). (*l*) *Ibid.* s. 109, sub-s. (1).

Although it was laid down in *Butler's Case* (*e*), that "where a patent is granted to the prejudice of a subject the King, of right, is to permit him upon his petition to use his name for the repeal of it," it is also stated that "the subject had not a right *mero motu* to have a *scire facias*" (*f*), and there seems to have been no doubt that if the Attorney-General were to have accepted insufficient security, or if, after his fiat had been granted, the bail or security had failed, the Court would have ordered a stay of proceedings until further security had been given (*g*). In *Reg.* v. *Newall* (*h*), Sir F. Pollock, A.-G., on a petition for relief against certain suggestions in a writ of *scire facias*, which had regularly issued, decided that he would direct a *nolle prosequi* to be entered as to certain parts of the writ, if the prosecutor insisted on retaining them.

Fiat may or may not be granted *ex parte*.

The Attorney-General may either give or refuse his authority *ex parte*, or direct that the patentee shall have notice and liberty to be heard before him.

Principles on which Attorney-General acts.

The following cases show the principles on which the law officer acts in issuing or withholding his fiat:—

A. was the patentee of a process for the production of paraffin oil by the distillation of bituminous coal. B. applied for *scire facias*. B. was the owner of a coal field in Scotland, containing a certain mineral called the Torbane Hill mineral, the right to get which was leased to certain persons, who sold it to the patentee for the purposes of his manufacture. Under the terms of the said lease, B. had a pecuniary interest in the quantity of mineral raised. B. alleged that A.'s invention was not new, and that the patent, by restricting the sale of the Torbane Hill mineral, prejudicially affected his interests. At the date of the application, an action raised by B. in Scotland for the reduction of A.'s Scotch patent for the same invention was pending. Sir R. Bethell, A.-G., refused his fiat (a) because the writ of *scire*

(*e*) 2 Vent. 344.

(*f*) *Reg.* v. *Neilson*, 1842, 1 Web. P. C. 672; *R.* v. *Betts*, 1850, 19 L. J. Q. B. 531; 15 Q. B. 540. Sir Frederick Pollock in argument said: "I never knew a *scire facias* except in the case of a patent for an invention. The only case which I recollect of anything like two grants having been issued occurred not in this country, but in the colony of New South Wales. The Attorney-General of that colony had refused to permit a *scire facias* to issue for the very purpose of trying whether land granted by a second grant had not been granted before. Upon a case which came afterwards before my learned friend the Solicitor-General and myself, it appeared that the late law officers of the Crown had advised that the Attorney-General ought to allow the *scire facias* to issue, from which I presume it was considered that the subject had not a right *mero motu* to have a *scire facias*."

(*g*) 1 Web. P. C. 671, 672.

(*h*) *Ibid.* n. (*i*).

facias ought not to be used for purely private ends; (b) because the convenient and proper course seemed to be to allow the Scotch action to go on, and to be guided by its issue; and (c) because the patent was eleven years old, had been the subject of several legal proceedings, and ought not, therefore, to be lightly challenged (*i*).

The H. F. Co. applied for authority as regards a patent of B. and C., who had raised an action for infringement, then pending in Scotland, against the applicants. James, A.-G., directed that notice should be given to the patentees, and on their objecting that, as they were resident in Scotland, the application should have been made to the Lord Advocate, refused authority, pending the result of the action in Scotland, but gave leave to renew the application if necessary (*k*).

V. applied for authority as regards S.'s patent. Russell, A.-G., directed notice to be given to S., and at the hearing ordered the application to stand over generally, upon S. undertaking to bring an action against the applicants within a month. Costs of the application to be, by consent, costs in the cause (*l*).

B. applied for authority as to W.'s patent. B. had been a defendant in an action by W. *v.* S., and this application was made in the interval after the judgment against B. in the Court below, and before the hearing in the Court of Appeal. Russell, A.-G., directed that W. should have notice, and on his failure to appear at the hearing granted authority (*m*).

F. applied for authority as regards G.'s patent. No other proceedings were pending. Webster, A.-G., granted his fiat without directing notice to be given to G. (*n*).

K.'s trustees applied for authority as to R.'s patent. R. had sued K. in the Palatine Court for infringement, had abandoned the action after the delivery of K.'s defence, and had made an application (then pending at the Patent Office) for leave to amend. The applicants carried on K.'s business, with which it was alleged that R.'s patent interfered. Webster, A.-G., gave unconditional authority, without directing notice to be given to R. (*o*).

Meaning of "in fraud of

A patent will not be held to have been obtained in fraud of the

(*i*) *Young's Patent*, Pract. Mech. Jour. 2nd series, vol. vi. p. 98. See also vol. vii. p. 44; and Lawson, p. 105.

(*k*) *Bell and Coleman's Patent*, Griffin, P. C. 320.

(*l*) *Siddell's Patent*, Griffin, P. C. 320. In *Martin's Patent*, *ibid.*, James, A.-G., after consultation with Herschell, S.-G., held that, where an application for his authority had been eventually abandoned, he had no power, under sect. 38, to give costs.

(*m*) *Watling's Patent*, Griffin, P. C. 320.

(*n*) *Gaulard and Gibbs' Patent*, *ibid.*

(*o*) *Rothwell's Patent*, *ibid.*

the rights of another."

rights of another unless the patentee has been guilty of dishonest and culpable acts in obtaining it (*p*).

In 1885, a patent was granted to L. for improvements in the means of generating fixed gases. In 1886, A., a subject of the United States, presented a petition for revocation, on the grounds that the invention was a communication from abroad —a fact which L. had not disclosed—and that the patent had been obtained by fraud. A.'s petition contained no allegation that he was the true and first inventor. It appeared that L. had not been guilty of fraud, but had acted upon the advice of a competent patent agent in taking out the patent in his own name, and had intended to hold it for the benefit of A. It was held by Mr. Justice Stirling, that even assuming the patent to be void by reason of the non-disclosure of the fact that part of the invention was a communication from abroad, yet it was not proved to have been obtained in fraud of the petitioner's rights, and that the petition must be dismissed without prejudice to any claim which A. might make under sect. 26, sub-sect. 4 (d), as a person alleging that he was the true and first inventor of any of the inventions included in the claim of the patent (*q*).

The question still remains, said Mr. Justice Stirling in this case (*r*), Was (the patent), in the language of the statute, obtained in fraud of the petitioner's rights? The first point to be determined in answering that question is the sense of the word "fraud" as used in the statute. Here we have not to deal with a statute 300 years old, like the Statute of Monopolies, nor is there any current of decision to fix the sense in which the word therein is used, and in my judgment it would be wrong to construe the word, occurring as it does in an Act passed little more than three years ago, and in the absence of any context imperatively demanding such a construction, otherwise than in accordance with the usual construction of the English language, and consequently as involving grave moral culpability in the person obtaining the patent (*s*).

True inventor of invention

The case of *Walker* v. *Hydro-Carbon Syndicate, Limited* (*t*),

(*p*) *Avery's Patent*, 1887, per Stirling, J., 4 P. O. R. at p. 165.

(*q*) *Ibid.* at p. 152.

(*r*) At p. 165.

(*s*) The petition should be presented in the name of the person making the allegations which would destroy the grant, and not in that of his attorney, and all other persons interested in the grant must be made respondents. *S. C.*, 36 Ch. D. pp. 310, 311; *Re Haddan's Patent*, 1885, 2 P. O. R. 219.

(*t*) 1885, 2 P. O. R. p. 3. An appeal was taken against the decision in this case, but subsequently abandoned. Preliminary applications—(a) that the ap-

turned on the words "true inventor of any invention included in the claim of the patentee." In this case, W., the grantee of a patent, presented a petition under sub-sect. 2 of sect. 26 of the Patents Act, 1883, for revocation of patents granted to H. and B., alleging that he was the true and first inventor of the inventions comprised in such patents. It was held, on the construction of the specifications of the three patents, and also of a patent granted in 1865 to one Wise, that eliminating from W.'s patent matters of common knowledge, the inventions claimed by H. and B. were not similar to the invention claimed by W., and that the petition must therefore be dismissed with costs. The following extract from the judgment of Bacon, V.-C., will show the *ratio decidendi* :— included in claim of patentee.

"There was *a common universal knowledge* that petroleum, dangerous in itself, inapplicable in itself, could by means which had been resorted to long ago in Wise's patent, and long before that, namely, by being reduced into the form of spray, be usefully applied for the purposes for which alone petroleum is valuable, and avoiding all the danger which would attend the application of it in any other way. The three patents . . . . are *not for totally different purposes*, but are *totally different in their mode of application*; and now I am to be told, after a mechanical invention has been produced for a common object, that any person who makes a better combination of machinery (not by the mere introduction of mechanical equivalents, but by the exercise of mechanical genius or talent, or whatever it may be called) could not obtain a patent for it; that he has no right to say, ... 'Admitting yours was a good patent, and your contrivances are very ingenious and clever, I see a much better way of dealing with the basis of common knowledge, ... and I do it better and differently from the way in which you do it.' That is the whole case." Judgment of Bacon, V.-C.

If a petitioner can show that prior to the grant of a patent he had publicly manufactured the subject-matter by a process substantially similar to that used by the patentee, revocation will be granted (*u*). Prior user.

A petitioner qualified to present a petition in the manner Where *locus standi* patent

peal might stand over till the return from America of the plaintiff, who was an engineer, and wished to be present at the hearing for the purpose of instructing his counsel; and (b) that the plaintiff should be allowed to adduce fresh evidence on appeal, were dismissed: 1886, 3 P. O. R. 253.

(*u*) *Haddan's Patent*, 1885, 2 P. O. R. 218.

may be impeached on all grounds.

pointed out in clauses (c), (d), and (e), above, may impeach the patent on any other ground (*x*).

F. presented a petition for revocation of a patent on the ground of having publicly manufactured and sold the invention claimed by the patentee. The petition and particulars of objections alleged other grounds of invalidity besides F.'s prior manufacture and sale. On the petition coming on for hearing the preliminary point was taken by the respondents that F. not being authorized by the Attorney-General to present the petition, could not put forward or rely on any objection to the validity of the patent, except his own prior user of the patented invention; but it was held, that when the petitioner is qualified to present the petition the patent may be attacked on any other ground (*x*).

If, however, the petitioner has no *locus standi*, if he is not one of the persons entitled under the Act to present a petition to revoke the letters patent, the Court will not go into the question whether the patent is or is not good (*y*).

Particulars of objections with petition.

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

Certificate as to particulars proved, &c.

In the matter of *Goulard and Gibbs' Patent* (*a*), Mr. Justice Kekewich held (*b*), that he had no power to grant a certificate as to particulars of objections delivered (*c*) by a petitioner for revocation, but gave the petitioners leave to make a renewed application for a certificate at their own risk as to costs.

Amendment of particulars.

Particulars delivered may be from time to time amended by leave of the Court (*d*).

Contrary to the rule which prevailed in the action of *scire facias* (*e*) prior to the Act of 1852, the defendant is now, as under the Act of 1852, entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply (*f*).

(*x*) *Morgan's Patent*, 1887, 5 P. O. R. 186.

(*y*) *Avery's Patent*, 1887, 36 Ch. D. at p. 323, per Cotton, L. J.

(*z*) Sect. 26, sub-sect. (5). See form of particulars of objection, *infra*, pp. 788—790; and *Haddan's Patent*, 1885, 2 P. O. R. 219.

(*a*) 1888, 5 P. O. R. 526: affirmed 1889, 6 P. O. R. 215.

(*b*) Upon a consideration of sects. 26, 28, sub-sect. (1), and 29, sub-sects. (2), (4), and (6).

(*c*) Under sect. 26, sub-sect. (5).

(*d*) Sect. 26, sub-sect. (6).

(*e*) Hindmarch, p. 412.

(*f*) Sect. 26, sub-sect. (7).

Subject to sect. 26 ordinary practice on petition holds.

Subject to the provisions contained in the Patents Act, 1883, s. 26, the practice is governed by the ordinary practice upon a petition to the High Court. Accordingly, a petitioner on making the usual deposit will be allowed to administer interrogatories to the respondent (*g*).

Petition "an action."

A petition for revocation is in every sense of the word an "action," except that it is not commenced by writ, and involves precisely the same issues as an action to try the validity of the patent. Respondents who desire it may therefore have a petition for revocation tried on *viva voce* evidence (*h*).

Fraud of opponent's right.

Revocation on the ground of prior user by the petitioner, or a person through whom he claims (*i*), is in form apparently new; though, of course, a *scire facias* would have lain for want of novelty at the instance of any person.

Registration of order revoking patent.

The person in whose favour an order for the revocation of a patent has been made, is required to leave forthwith at the Patent Office an office copy of such order (*j*).

That a specification does not end with a distinct statement of the invention claimed is not a ground of revocation (*k*).

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

There is no provision in the Act of 1883 for the cancellation of a revoked patent, according to the practice which prevailed in proceedings by *scire facias*. But the order revoking the patent is entered upon the register, which is indeed sufficient.

A specification cannot be amended under the Act of 1883, s. 18, whilst a petition for revocation is pending, but the Court or a judge may, subject to such terms as are thought fit, give leave to apply at the Patent Office for liberty to amend the specification by way of disclaimer, and may direct a stay of proceedings in the meantime.

(*g*) *Haddan's Patent*, 1884-85, Griffin, P. C. 108.
(*h*) *Gaulard and Gibbs' Patent*, 1887, per North, J., 34 Ch. D. 396.
(*i*) Sect. 26, sub-s. 4, clause (c).
(*j*) P. R. 1890, r. 74.
(*k*) *Siddell* v. *Vickers*, 1888, per Fry, L. J., 39 Ch. D. at p. 109.
(*l*) Sect. 26, sub-s. 8.

CHAPTER XVII.

OFFENCES AND PENALTIES.

SECT. 1. PRIOR TO ACT OF 1883.
SECT. 2. UNDER ACT OF 1883.

SECT. 1.—PRIOR TO ACT OF 1883.

Remedy for imitation prior to 1835.

BEFORE the year 1835, the only remedy which a patentee had against any person for imitating his name or device was by a bill in Chancery for an injunction, or an action at law for the damages which he might have sustained (*a*).

Act of 1835, s. 7. Protection to names and marks of patentees.

The statute 5 & 6 Will. IV. c. 83, provided an additional protection to patentees in such cases. By that statute (*b*) it was enacted that any person who counterfeited or imitated the *name*, or the *stamp*, *mark*, or *device* of any patentee, should for every such offence be liable to a penalty of 50*l.*, to be recovered by action of debt in any of his Majesty's Courts of Record at Westminster, or in Ireland, or in the Court of Session in Scotland (*c*), one-half to his Majesty, his heirs, and successors, and the other to any person who shall sue for the same.

Defences under this Act.

The defendant in an action under this section was entitled to plead *nil debet*, and to give the special matter on which he relied in evidence, without any notice of objections, the 5th section of 5 & 6 Will. 4, c. 83, being inapplicable (*d*).

There is some doubt as to the defences which were competent in an action for penalties under this statute.

(*a*) Hindmarch, p. 367.
(*b*) Sect. 7.
(*c*) No penalty under this section could be recovered in a County Palatine Court, or in any inferior Court of Record.
(*d*) The right to plead the general issue was derived from the Statute of Monopolies, which enabled the defendant in a final action to plead not guilty, or that he owes nothing, and to give the special matter in evidence (sect. 4). Under the Reg. Gen. T. T. 1 Vict. 1838, the defendant was required to write in the margin of the plea, setting up the general issue, the words by statute.

In *Myers* v. *Baker* (*e*), an action for a penalty for putting on an article made according to a patent the words "K. & G. Patent Elastic," without the licence of the patentee, it was held to be no defence that "the invention was not a new manufacture."

Query whether protection only during term of patent.

It may be doubted, says Hindmarch (*f*), whether this protection given to a patentee against the use and imitation of his name, is intended only to apply to acts done during the continuance of his patent-term; or whether it is also to apply to the use and imitation of a patentee's name after the expiration of his privilege. The Act makes it an offence in every person to copy or imitate the name of "any other person who hath or shall have obtained letters patent," &c., and these words seem to be large enough to include the copying or imitating the name of a patentee whose patent has expired. But the preamble of the Act shows that the objects of the Legislature in altering the law touching letters patent were "*as well for the better protecting of patentees in the rights intended to be secured by such letters patent*, as for the more ample benefit of the public from the same;" and it will most probably be found that the intention was that the seventh section should only apply to acts done during the existence of a patent.

Limitation of proceedings.

Proceedings under 5 & 6 Will. IV. c. 83, s. 7, came within the meaning of the statute 31 Eliz. c. 3, s. 5, and were, therefore, required to be commenced within one year after the fact committed, if the action was brought by the patentee or an informer, and within two years if the Crown sued for the penalty (*g*).

Other remedies for fraudulent imitation.

The statute 5 & 6 Will. IV. c. 83, s. 7, merely gave to patentees a new and penal remedy for a kind of interference with their rights, which was already punishable both at common law and in equity.

If a person, says Hindmarch (*g*), deceitfully sells articles as of the manufacture of a patentee or of any other person, such an act is a fraud upon the patentee or other person by whom the offender pretends that the articles were manufactured. It does not signify in what manner the offender compasses his purpose—whether by counterfeiting a name, word, mark, or device upon the spurious articles themselves, or upon the envelopes in which they may be wrapped, or by using any other means so as to deceive the

(*e*) 1858, 3 H. & N. 802. In this case it was, however, held to be necessary to prove that the words "K. and G. Patent Elastic" did imitate, and were so put on by the defendant "with a view of imitating" the mark of the patentee.

(*f*) Page 368.

(*g*) Hindmarch, p. 372.

public, and induce them to purchase goods as the goods of another, when they really are not so.

Action of deceit.

Two remedies against such offenders were open to a patentee—an action of deceit at common law, and a suit in Chancery for an injunction to restrain the repetition of the fraud.

The form of action was trespass on the case, and the plaintiff was entitled to recover nominal damages upon proof of his cause of action, even if he could not show that he had been deprived of any particular amount of profit by means of the defendant's fraud, or the defendant's articles were as good as his own, or the defendant had not himself actually made any representation at all.

Cases.

Thus in an action on the case against a person for wrapping hones in envelopes resembling those of the plaintiff, no actual damage by means of the deceit was proved, and the jury found that the defendant's hones were not inferior to the plaintiff's; it was held, nevertheless, by the Court of King's Bench, that the plaintiff was entitled to recover nominal damages (*h*).

In the case of *Sykes* v. *Sykes* (*i*) it appeared that the plaintiff made and sold goods, which he was accustomed to mark with the words "Sykes' patent," and that the defendant (being of the same name as the plaintiff) made and sold to retailers goods which he also marked with the words "Sykes' patent." The declaration charged the defendant with deceitfully selling goods so marked as and for goods of the manufacture of the plaintiff. The defendant did not himself represent the goods to be of the plaintiff's manufacture, but he sold them to retailers for the express purpose of being resold as such. It was held by the Court of King's Bench, on a motion for a new trial, that the declaration had been substantially proved, and a rule *nisi* was refused.

Defects of action of deceit.

The common law action of deceit, however, was at best an imperfect remedy. The plaintiff could seldom prove the actual extent of the injury which he had sustained so as to enable a jury to award him adequate damages. Nor could he, by an action at common law, prevent the continuance of the fraudulent acts complained of.

Suit for injunction.

Under these circumstances, the Court of Chancery lent its extraordinary aid, and a plaintiff was enabled to bring a suit to restrain deceit by injunction (*k*).

(*h*) *Blofield* v. *Payne*, 1833, 4 B. & Ad. 410.

(*i*) 1824, 3 B. & C. 541. Cp. *Southerne* v. *Home*, 2 Rol. R. 26; *Singleton* v. *Bolton*, 1783, 3 Doug. 293.

(*k*) Cp. *Ransome* v. *Bentall*, 1834, 3 L. J. N. S. Ch. 161; *Knott* v. *Morgan*, 1839, 2 Keen, 213.

SECT. 2.—UNDER ACT OF 1883.

Under the Patents Act, 1883 (*l*), it is provided that any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence on summary conviction to a fine not exceeding five pounds. Patents Act, 1883, s. 105.

Also that a person shall be deemed to represent that an article is patented if he sell the 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, or impressed on or otherwise applied to the article. Use of words "patent," "patented," &c.

In *Cheavin* v. *Walker* (*m*), it was held that the use of the word "patent" along with a representation of the royal arms, as a label on an article made under an expired patent, was a representation that the patent was still subsisting, and disentitled the plaintiff from obtaining an injunction to restrain the wrongful use of the label. A plea that the word "patent" was in fact a trade-mark was overruled. "It is impossible," said Jessel, M. R., "to allow a man who has once had the protection of a patent to obtain a further protection by using the name of the patent as a trade-mark. No man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still subsisting.

The false representation of an expired patent as being still subsisting, would not, however, be an offence under the present Act.

With the question of trade-names and trade-marks we are not concerned in this work (*n*).

The sale of an article as "patented," which is merely the subject of provisional protection, is an offence against the Act (*o*).

Any person who, without the authority of her Majesty, or any of the royal family, or of any government department, assumes or uses in connexion with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable, on summary conviction, to a fine not exceeding twenty pounds (*p*). Penalty on unauthorized assumption of the royal arms.

(*l*) Sect. 105.
(*m*) 1877, 5 Ch. D. 863. Cp. *Linoleum Manufacturing Co.* v. *Nairn*, 1878, 7 Ch. D. 834.
(*n*) See Sebastian on Trade-marks.
(*o*) *Reg.* v. *Wallis*, 1886, 3 P. O. R. 1; *Reg.* v. *Crampton*, 1886, *ibid.* 367.
(*p*) Act of 1883, s. 106.

Falsification of entries in registers.

Any person who 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, shall be guilty of a misdemeanor (*p*).

Summary proceedings in Scotland.

In Scotland, any offence under the Act of 1883 may be prosecuted in the Sheriff's Court (*q*).

Isle of Man.

The punishment for a misdemeanor 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 100*l*., at the discretion of the court; and any offence 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 (*r*).

Person improperly describing himself as a patent agent.

After the 1st day of July, 1889, no person is 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; and if any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on summary conviction to a fine not exceeding 20*l*. (*s*).

(*p*) Act of 1883, s. 93.
(*q*) Sect. 108.
(*r*) Sect. 112, sub-sects. 2 and 3.
(*s*) Act of 1883, s. 1.

CHAPTER XVIII.

PROLONGATION OR EXTENSION OF PATENTS (*a*).

SECT. 1. PROLONGATION BY SPECIAL ACT OF PARLIAMENT BEFORE 1835.

SECT. 2. PROLONGATION UNDER THE ACT OF 1835, AND PATENTS ACT, 1883.

SECT. 1.—PROLONGATION BY SPECIAL ACT OF PARLIAMENT BEFORE 1835.

Before 1835 no prolongation except by special Act.

PRIOR to 1835, the term of letters patent could not be extended, except by a special Act of Parliament. The following cases illustrate the kind of circumstances under which a statutory prolongation of a patent could be obtained (*b*).

Examples of special Acts.

A patent for an engine for making stone pipes had been granted to one John Juite, in 1734. The undertaking stood still until John Elwick purchased the patent right, and at many thousand pounds' expense improved the engine beyond what it was capable of doing when first invented. An additional term of fourteen years was granted in 1743. (16 Geo. II. c. 25 (*c*).)

Israel Pownoll had obtained a patent in 1712 for an engine for raising ballast, suttege, and sand, and for removing banks, shelves, and shoals in rivers and harbours, and completed the engine before his death, but afterwards his children, being young, could not work it; and the patent being expired, it was not likely to be brought

(*a*) The Author is indebted to Mr. G. P. Wheeler, Barrister-at-Law, of the Judicial Department, Privy Council, for much information in connection with this subject.

(*b*) Cf. Report, &c., 1829, p. 171; Web. Letts. Pats. p. 19; and 1 P. C. pp. 39, 40.

(*c*) This invention did not succeed. It was revived under patents, in 1805, by Sir Geo. Wright, and again, in 1810, by a Mr. Murdock. A company was then established, and they made a large quantity of stone pipes for the water-works in Manchester and some in London, but they did not answer, and were taken up. (Report, &c., 1829, *ubi supra.*)

Special Acts.

into use without a new grant. It was, therefore, renewed for fourteen years, from 1st August, 1750. (23 Geo. II. c. 33, 1749 (*d*).)

In 1768, William Cookworthy had obtained a patent for England for using Cornish moorstone and Growan clay as materials for making porcelain. It was assigned in 1774 to Richard Campion, who incurred great trouble and expense in perfecting the invention, and could not receive an adequate compensation during the remainder of the term. An additional fourteen years was therefore added to the privilege without altering it in any other respect. A new specification of the mixture and proportion of the materials was to be enrolled, and the Act was not to hinder the use of the said materials except in such mixture and proportions as were so specified. (15 Geo. III. c. 52, 1775.)

A patent for a certain composition, or cement, for England and the colonies, was granted to John Liardet, in 1773. The cement or stucco required to be applied to buildings as soon as it was made, and could not be sent to a distance. Therefore, it could come into use only by degrees, so that the inventor could not at once be recompensed. The term of the patent was extended eighteen years upon the condition that the patentee was not to be allowed to take more than a specified price for the cement. The Act was not to hinder the use of any other cement than that invented by Liardet. Every objection to the cement's not being a new invention, sufficient to invalidate the patent, was to be a bar to any action brought under the Act. The privilege was not to be transferred to more than five persons, and a new specification of the invention was to be enrolled. (16 Geo. III. c. 29, 1766 (*e*).)

David Hartley obtained a patent for England and the colonies in 1773 for his method of applying iron plates to cover the woodwork of buildings and ships, so as to prevent the action of fire; and having expended large sums in experiments to perfect the invention, and still more money being requisite without a prospect of recompense during the term of the patent, the term was prolonged thirty-one years, upon conditions similar to those mentioned in the last case, with a further provision that the invention might be applied in any buildings used in fitting out or victualling

(*d*) Cf. another Private Act, 24 Geo. II. c. 28, 1751.

(*e*) The stucco for the walls of buildings was called "Adam's Oil Cement," because Mr. Adam, the architect, became interested in the patent. In 1778 it was set aside for insufficiency of the specification on a trial: *Liardet v. Johnson*, 1 Web. P. C. 52.

the King's ships of war without licence from the patentee. (17 Geo. III. c. 6, 1777.) Special Acts.

Dr. Edward Bancroft had a patent in 1775 for the use of certain vegetables, growing spontaneously in America, for dyeing, staining, printing, and painting certain valuable colours. Having been deprived of the benefit of his patent by the American war, he was allowed an extension of fourteen years upon the usual terms. (25 Geo. III. c. 38, 1785.)

James Turner had a patent in 1781 for a yellow colour for painting coaches and other works. Owing to secret piracies, from 1787 to 1789, his sale was almost taken from him. He brought one action to trial, and obtained two verdicts therein (a new trial having been granted), also an injunction, but he only gained nominal damages, and was not rewarded for his invention. The term of the patent was extended for eleven years from 24th June, 1792, upon the following conditions: Turner was not to sell the colour at more than 500 guineas per cwt. The Act was not to hinder any person from making any yellow colour which was publicly used before the date of the patent, but only such as was of Turner's invention, and as was described in his specification. Every objection which might have been made to the said yellow colour not being a new invention within the meaning of 21 Jac. I. sufficient to invalidate letters patent, should be a bar to any action brought by virtue of the Act (*f*). The privilege was not to be assigned to more than five persons. (32 Geo. III. c. 72, 1792.)

Standing Order, House of Lords, 1808, as to Bills for extension.

On March 29th, 1808, the House of Lords made a Standing Order, "That no Bill for the purpose (of extending the terms of letters patent) shall be read a third time in this House, unless it shall appear that the letters patent of which it is intended to extend the term by such Bill, will expire within two years from the commencement of the Session of Parliament in which the application for such Bill shall be made, and unless it shall appear that the application to Parliament for extending the term of the letters patent is made by the person, or by the representatives of the person, who himself originally discovered the invention for which such letters patent were granted by his Majesty; and that the knowledge of such invention was not acquired by such person as

(*f*) In a note to this Act in the Appendix to the Parliamentary Report of 1829, it is suggested that this clause was so drawn as to prevent any objections to the form of the specification, the form being so defective that a verdict had been given against the patentee in 1787: *Turner* v. *Winter*, 1 Web. P. C. 77; Cf. 35 Geo. III. c. 68, 1795, also 47 Geo. III. c. 131, s. 2.

aforesaid, by purchase or otherwise, from the inventor or owner of the same, or by information that such invention was known and pursued in any foreign country."

In 1829, Mr. Samuel Crosley applied to Parliament to extend the term of a patent for an improved gas apparatus assigned to him, but granted in 1815 to Mr. Samuel Clegg, the inventor. The Bill was withdrawn after the second reading, because it was found that the Standing Order of the House of Lords in 1808 would have prevented the Bill being read in that House: the prolongation not being for the benefit of the original inventor.

In the same year, however, an Act passed (10 Geo. IV. c. 135) extending for a term of twenty-one years a patent granted to John Stephen Langton for an improved method of seasoning timber and other wood. The patent having ten years of its term unexpired, the passing of the Bill through the House of Lords was contrary to their Standing Order of 1808 (*g*).

Sect. 2.—Prolongation under the Act of 1835 and Patents Act, 1883.

Lord Brougham's Act.

The frequency of such applications for statutory assistance suggested the propriety of framing some general measure providing for the extension of letters patent, and Lord Brougham's Act (5 & 6 Will. IV. c. 83, s. 3) was eventually passed. Sect. 4 of that statute declared: "That if any person who now hath or shall hereafter obtain any letters patent as aforesaid (*i.e.*, as grantee, assignee, or otherwise (*h*)), shall advertise in the *London Gazette* three times, and three times in some country paper published in the town where or near to which he carried on manufacture of anything made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a *caveat* at the Council office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be

(*g*) Report, &c., 1829; Appendix p. 180.

(*h*) See sect. 1 of this Act at p. 637, Appendix.

by him given to any person or persons who shall have entered such *caveats*, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering *caveats* shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary notwithstanding: provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

Amendments of Lord Brougham's Act.

Various changes in the procedure here described have been made by subsequent legislation. The judicial committee was empowered by the statute 7 & 8 Vict. c. 69, s. 2, to recommend an extension of the original term of letters patent for a period not exceeding fourteen years where it was shown that the patentee had been unable to obtain a due remuneration for his expense and labour in perfecting his invention, and that an additional term of seven years would not suffice for his reimbursement. Again, the clause in 5 & 6 Will. IV. c. 83, s. 4, requiring a petition for extension to be not only presented, but "prosecuted with effect," before the expiration of the original term, was, owing to the circumstances in the case of *Bodmer's Patent* (*i*), repealed by 2 & 3 Vict. c. 67.

Bodmer's Patent.

The facts in that case were as follows: An application was made in May, 1838, for an extension of the term of Bodmer's Patent for cotton spinning machinery. *Caveats* were entered in July. The case came on before the Privy Council on 17th August, when, according to the rules of practice (*k*), the opposing party was entitled to four weeks' notice of the hearing for the purpose of preparing evidence. Before the expiration of this month the Privy Council would have closed its sittings. The case was opened, and adjourned to the 29th of November. In the meantime the opposition was withdrawn, but the patent had also expired. It was held that the words "prosecuted with effect" meant that something must have been effected, some conclusion arrived at by the Council

(*i*) 15 Lond. Jour. Arts.

(*k*) J. C. R. r. 2, *infra*, p. 595.

before the expiration of the patent; and no conclusion having been arrived at, nothing effected, the law did not empower the Council to proceed with the matter further, or the Crown to grant new letters patent for an invention open to the public (*l*).

2 & 3 Vict. c. 67.

The statute 2 & 3 Vict. c. 67, s. 2—under which Bodmer's Patent was subsequently extended (*m*)—empowered the Privy Council to report in favour of an extension, in spite of failure to prosecute with effect before the expiration of the original term, where such default arose from other causes than the neglect or default of the petitioner. The same section also provided that no extension would be granted upon petitions presented after 30th November, 1839, "unless such petition be presented six calendar months, at the least, before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term." Under the Patents Act, 1883, s. 25, letters patent may be extended for seven, or in exceptional cases for fourteen years (*n*), and the petition for extension must be presented at least six months before the expiration of the original term (*o*).

Act of 1883.

The Act of 1883, sect. 25, leaves the law and procedure relating to prolongation practically unaltered. A different term is used in this Act, viz. *extension*, instead of *prolongation*. As, however, sect. 113 saves the rights of all existing patentees, and no prolongation for patents granted under the Act of 1883 can take effect until 1898, it appears that the provisions of sect. 25 are suspended, or at any rate so far suspended as rights or privileges accrued prior to 1st January, 1884, are concerned, for some years to come, notwithstanding the repeal of the statutes regulating the law and practice of prolongation at the time when the Act of 1883 was passed (*p*). This was the opinion of the Judicial Committee in *Brandon's Patent* (*q*). It seems, therefore, clearly proper to speak of *prolongation* and not extension until the provisions of sect. 25 come into full force in 1898.

In *Brandon's Patent* (*q*), a petition presented on the 24th May, 1884, for the prolongation of a patent dated the 31st October, 1870, was refused by the registrar as not being presented within six months of the expiration of the patent, as provided by the Act of

(*l*) Web. Letts. Pat. p. 58, n. (*s*); also 1 Web. P. C. 740.

(*m*) For a term of seven years. The new patent bore date 18th July, 1840. 1 Web. P. C. 740.

(*n*) Sub-sect. 5.

(*o*) Sub-sect. 1.

(*p*) See schedule to that Act.

(*q*) 1884, 1 P. O. R. 154.

1883, s. 25. The petitioner moved before the Judicial Committee of the Privy Council that the petition might be admitted. "Their lordships," said Lord Watson, in giving the decision of the Judicial Committee, "have come to the conclusion that the petition presented the 24th May, 1884, ought to be received. It is obvious that the petition would not be competently presented if the provisions of sect. 25 applied. But their lordships are of opinion that those provisions do not apply, and that the proceeding falls within the exceptions introduced by the 113th section of the statute of 1883. The provisions of sub-sect. (a) of that section must be read distributively, and so read they declare that the enactments of the new statute shall not affect any patent granted before the commencement of the Act. And they also declare in express terms that those enactments shall not affect any right or privilege which has accrued to the patentee before or at the commencement of this Act. Now the patent which was held by the present petitioner at the passing of this Act of 1883 was an exclusive right to use a certain invention for a definite period of time, but as incidental to that right he had, by virtue of the provisions of the Act 5 & 6 Will. IV., the further privilege of leave to apply for a prolongation of his patent at any time before its expiration, upon such grounds as commended themselves to this board. That right had accrued to him. He was in a position if he had chosen to make the application when the new statute came into force; and their Lordships find it impossible, looking to the precise terms of sect. 113, to hold that that privilege, which was incident to and part of his patent right, was taken away by the provisions of the new Act, or rather they find it impossible to hold that it is not a right included in the express reservation made by sect. 113. They will therefore direct that the petition be received, and the usual procedure followed."

No new rules relating to petitions for prolongation have been made by the Privy Council, and it is understood that it is not intended to alter the existing rules made under 5 & 6 Will. IV. c. 83, so that the practice appears to remain unaltered at present.

Advertisements.

Sect. 4 of 5 & 6 Will. IV. c. 83, requires the petitioner to "advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification; or near to or in which he resides, in case he carried on no such manufacture; or published in the county

where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town."

Rule II. of the Judicial Committee Rules provides that "a party intending to apply by petition, under sect. 4 of the said Act, shall, *in the advertisements* (*s*) directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall be not less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats (*t*) must be entered."

Caveats.

Where the patentee resides abroad, and the invention is carried on under licenses, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on (*u*). "The statute," said Lord Brougham (*u*), "provides for two cases, the patentee carrying on a manufactory or residing; but there would be no sense in inserting an advertisement in the *Moniteur* when the man resides in Paris; that would afford no protection to the Queen's subjects, for whose protection the rule is intended" (*u*).

To entitle an equitable assignee to appear with the legal assignee of a patent, the name of such equitable assignee must appear in the advertisements with that of his co-petitioner (*x*). "If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation" (*y*).

The petition.

The petition.—The next (*z*) step is the presentation of a petition (*a*) to the Queen in Council, praying that the petitioner's letters patent "may be extended for the further and additional term of fourteen years, or for such other term" as to her Majesty may seem fit.

Time when to be presented.

As we have already pointed out, in *Brandon's Patent* (*b*), it appears that the petition need not be presented six months before the expiration of the patent. The old rule prevails, and provided

(*s*) Before the Judicial Committee Rules were made, it seems that notice of the intention to apply for extension, and of the day on which application would be made to fix the hearing of the petition, were not necessarily included in one advertisement. See *Erard's Patent*, 1835, 1 Web. P. C. 559, n. (*c*). For a form of the present advertisement, see Appendix, p. 812.

(*t*) For form of caveat, see Appendix, p. 813. All persons entering a caveat, or *careators*, are entitled to be served with the petition, and to appear at the hearing.

(*u*) *Derosne's Patent*, 1844, 2 Web. P. C. 2.

(*x*) *In re Noble's Patent*, 1850, 7 Moo. P. C. 191.

(*y*) Per Lord Brougham, *ibid.* p. 194.

(*z*) See sect. 25, sub-s. 1, *infra*, p. 466.

(*a*) See Forms, Appendix, pp. 816 *et seq.*

(*b*) 1884, 1 P. O. R. p. 154.

a petition be "*prosecuted with effect*" (*c*) before the expiration of the term, a petition can be presented at any time before the expiration of the patent. If, however, the petition be not "*prosecuted with effect*" before the end of the term, it appears that unless the petition has been presented six months before the end of the term, the claim to prolongation is lost (*d*).

The petition should not be presented too long before the expiration of the patent, otherwise it may be ordered to stand over, as the profits accruing in the meantime might materially affect the question of extension (*e*).

Petition must set out all facts fully and fairly.

As the recommendation to the Crown for the prolongation of the term of letters patent is a matter of discretion in the Judicial Committee, it is imperative that the petition for such prolongation should state fairly and fully everything relating to the patent, and an omission to do so is *generally* (*f*) fatal to the application (*g*). Forms of petition are given in the Appendix (*h*).

Cases.

A petition was presented for the extension of a patent for a foreign invention, which had been patented in America prior to the date of the English patent. It appeared that the American patent had expired, was subsequently renewed, and would finally come to an end in August, 1876. These facts were not stated in the petition. Extension refused (*i*).

(*c*) The application for renewal is "prosecuted with effect," within the words of the statute, if the party applying obtains the report of the Judicial Committee before the expiration of the original patent: *Ledsam* v. *Russell*, 1 H. L. Ca. 687. But the Crown is not restricted as to the time within which it may not act upon such report, and renewed letters patent are not void because they are dated after the expiration of the patent.

(*d*) See 5 & 6 Will. IV. c. 83, s. 4; 2 & 3 Vict. c. 67, ss. 1, 2, and 7 & 8 Vict. c. 69, s. 2, under which it seems to have been the practice of the Privy Council to allow a petition to be presented at any time.

(*e*) See *Macintosh's Patent*, 1 Web. P. C. 739.

(*f*) In *Pitman's Patent*, 1871, L. R. 4 P. C. 84, the Judicial Committee stated that for the future they would invariably act upon the principle that failure to make a full disclosure of everything relating to the patent, the term of which it was desired to extend, *e.g.*, particulars as to foreign patents, should be fatal to a patent. In *Re Hutchinson's Patent* (14 Moo. P. C. 364), material facts showing the title of the petitioner were disclosed in evidence, which were not stated in the petition for prolongation. The hearing was postponed, and an amendment of the petition allowed. The date of this case, however, was 1861, so that it is not an exception to the rule in *Pitman's Patent*, which was laid down in 1871. But in *Reece's Patent* (Eng. Rep. January to March, 1881, XIV.), a petitioner who had, in ignorance of the Privy Council's rule, omitted in his petition to give the proper information as to his foreign patents, was allowed, on application made before the hearing, to correct the omission by adding a supplementary paper. This does not, however, contravene the decision in *Pitman's Patent*, as the petition was amended before the case came on, *vide Adair's Patent*, 1881, L. R. 6 App. Cas. 176, at p. 180.

(*g*) *In re Pitman's Patent*, 1871, *ubi sup.*; *In re Johnson's Patent*, 1871, L. R. 4 P. C. 83; cp. also *In re Clark's Patent*, 1870, L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 265; *In re Horsey's Patent*, 1884, 1 P. O. R. 225.

(*h*) At pp. 816 *et seq.*

(*i*) *In re Pitman's Patent*, 1871, *ubi sup.* "It is desirable that those who

A petition was presented nominally by one company, but really was for the benefit of another company, to which the shares of the former had been transferred. No statement of the fact appeared in the petition, and the real facts were only brought forward by the Attorney-General. Petition dismissed (*h*).

A limited company, who were the registered assignees of *Horsey's Patent* (No. 3145 of 1870), presented a petition for the prolongation of the term of such patent. The company consisted mainly of seven persons, to whom a share each was given, to enable the requirements of the Joint Stock Companies Act to be literally complied with, but the only persons really interested were the patentee and a creditor of his for money borrowed. These facts were not stated in the petition. Held, that the requisite good faith had not been observed by the petitioners, and the prayer of the petition must, therefore, be refused (*i*).

One of several joint patentees carried on the manufacture of the patented article in combination with the manufacture of other articles. No allusion to that fact was made in the petition, nor was there any intimation in the accounts that any other manufacture excepting that of the patented article was so carried on. Extension refused (*j*).

Who may be petitioner.

A petition for extension may be presented by any person *who is for the time being entitled to the benefit* of the patent, the term of which it is sought to extend. Under the clause in italics, which is the definition of "patentee" given by sect. 46 of the Patents Act, 1883, the following persons may petition for extension :—

The patentee.

1. The *original patentee*, whether inventor or merely importer of the patent. The merit of an importer, however, being less than that of an inventor (*k*), the Judicial Committee regards such applications with jealousy, and will carefully consider the merit of the invention imported (*l*).

come to oppose a patent should know the precise circumstances and the possible conditions on which a renewal was granted, and therefore it does appear to their Lordships that this was eminently a case in which the suggestions of Mr. Archibald in *Re Johnson's Patent* (1871, L. R. 4 P. C. 75), approved by their Lordships, should have been followed, and that there should have been a full disclosure of all the circumstances relating to the American patent" : per Sir J. W. Colville. Cp. *Adair's Patent*, 1881, L. R. 6 A. C. 176. The remuneration which a patentee has obtained from foreign patents, as well as from his English patent, should be stated.

(*h*) *Reece's Patent*, Eng. Rep. January to March, 1881, XIV.

(*i*) *Re Horsey's Patent*, 1884, 1 P. O. R. 225.

(*j*) *In re Yates and Kellett's Patent*, 1887, L. R. 12 App. Cas. 147.

(*k*) *Soames' Patent*, 1343, 1 Web. P. C. at p. 733; *Johnson's Patent*, 1871, L. R. 4 P. C. 75; *Pitman's Patent*, 1871, L. R. 4 P. C. 84; *Adair's Patent*, 1881, L. R. 6 A. C. 176.

(*l*) *Claridge's Patent*, 1851, 7 Moo. P. C. 394; cp. *Bell's Patent*, 1846, 2 Web. P. C. 159.

Illustrative cases.

A petition was presented for the extension of the term of a patent imported from abroad. The importers had embarked a large capital upon machinery in trying to introduce it to general use, and incurred considerable loss in so doing. Extension of letters patent for six years granted (*m*).

C. imported an invention from Paris, patented it in England, and assigned it for 8,000*l.* to a joint stock company, whose trustees petitioned for an extension on the ground that the company had expended 23,000*l.* in carrying out the invention, and that the profits made had not compensated for the losses incurred. In delivering judgment, Sir John Jervis said: "Each case must be dealt with according to its own particular circumstances, and their Lordships have looked at this case as to the merits of Claridge as the inventor according to the strict meaning of that word. He introduces, not a piece of complicated machinery, or a manufacture of difficulty or science, but something in general use at Paris. . . . . He does obtain a patent, and forms a joint stock company, and receives 8,000*l.* for the introduction of a well-known substance from a foreign land; so far as he is concerned, he has had adequate satisfaction for any merits he had in the introduction. We must take this case upon the basis of the original importer's merit, taking into consideration that those who now apply entered into a commercial speculation with a full knowledge of all the circumstances, and with the expectation of a profit, which, if they have not got, is no reason to entitle them to call upon us to grant this application" (*n*).

Executor, &c.

2. The *executor* (*o*) or *administrator* (*p*) of a deceased patentee.

Where it appears on the face of a petition presented by the equitable owner of the patent of which extension is desired, that the legal personal representative of the patentee may possibly have an interest in the patent, such legal personal representative will be added as a co-petitioner.

A petition was presented for the prolongation of a patent by C., a son of the patentee, who had acquired an interest in the patent for the benefit of his mother and sisters from L., to whom it had been assigned by the trustee in liquidation of the patentee. The patentee had, up to his death, worked the patent under a verbal agreement with L., that L., when he had been paid

(*m*) *In re Berry's Patent*, 1850, 7 Moo. P. C. 187.

(*n*) *Claridge's Patent*, 1851, 7 Moo. P. C. 394.

(*o*) Cp. *In re Bodmer's Patent*, 1849, 6 Moo. P. C. 469.

(*p*) *In re Downton's Patent*, 1839, 1 Web. P. C. 565; *In re Heath's Patent*, 1853, 2 Web. P. C. 247.

500*l.* out of profits, would settle the patent on a member of the patentee's family. The patentee had paid 300*l.* at the date of his death, and C. paid 200*l.* subsequently. The patent was handed over to C., but no assignment was executed by L. The Judicial Committee intimated that the legal personal representative of the patentee ought to be a party to the petition, which was amended accordingly (*r*).

Assignees. 3. *Assignees.*

The power of the Crown to extend letters patent is not confined to *grantees*, but extends to *assignees*; and such renewed letters patent, granted to the assignee, were good by the statute 5 & 6 Will. IV. c. 83, independently of the express provision in 7 & 8 Vict. c. 69, s. 4 (*s*).

The following extract from the judgment of Lord Romilly, M. R., in *Norton's Patent* (*t*), shows very clearly the considerations which guide the Court in dealing with applications for extension on the part of assignees:—"It must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

Another view of the principle on which applications on the part of assignees are entertained by the Judicial Committee was given by Lord Brougham in *Morgan's Patent* (*u*):—"Their Lordships have always been used to consider that by taking into their view and favourably listening to the application of the assignee, they are, though not directly, yet mediately and consequentially . . . . as it were, giving a benefit to the inventor; because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and, consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent."

(*r*) *In the matter of Willacy's Patent*, 1888, 5 P. O. R. 690.

(*s*) *Russell* v. *Ledsam*, 1845, 14 M. & W. 574; judgment affirmed in Exch. Ch. 16 M. & W. 633; and in H. of L. 1 H. L. Cas. 687.

(*t*) 1863, 1 Moo. P. C. N. S. 339; 11 W. R. 720.

(*u*) 1843, 1 Web. P. C. 737.

General principle.

It will be found that all the recorded successful applications, on the part of assignees, for the extension of letters patent, can be justified by reference to one or other of the principles stated in the extracts above quoted—the benefit of the public, and the benefit of the inventor.

Illustrative cases.

A joint stock company purchased a patent for a sum of money paid to the patentee, and the allotment to him of a number of paid-up shares, and spent a large amount of money in a *bonâ fide* endeavour to bring the invention, which was highly meritorious, into public use, without profitable result either to the patentee or to themselves. Extension granted (*x*).

The assignees of a patent for improvements in machinery petitioned for extension. The invention was of great commercial value, and the petitioners had embarked a large capital in bringing the patent into use, but the machinery was expensive, and heavy losses had been sustained. Extension granted (*y*).

Petitioners were a company who bought a patent and made a considerable sum of money by selling their shares at a premium on the Stock Exchange. Extension was refused, on the ground that the petitioners had taken over the invention as a speculative undertaking, and not for the purpose of benefiting the public (*z*).

A company bought a patent for the purpose of trading with it, and not for any purpose by means of which any benefit could come to the original inventor, who had not only parted with all interest in it, but had died since the assignment. Extension refused (*a*).

An assignee petitioning for the extension of the term of a patent was required to secure to the inventor an annuity (*b*), or a share of the profits (*c*).

(*x*) *Houghton's Patent*, 1871, L. R. 3 P. C. 461.

(*y*) *Berry's Patent*, 1850, 7 Moo. P. C. 187. Lord Brougham said in this case, "The patent law is framed in a way to include two species of public benefactors: the one, those who benefit by their ingenuity, industry, and science, and invention and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the results of foreign invention. In this case certain parties have, by their adventurous spirit and by the outlay of capital, benefited the public in proportion of the value of the foreign invention in question, which, but for that adventurous spirit and outlay of capital, would not have been available to the people of this country. That, therefore, is to be considered as a solid claim to the exercise of the *quasi* legislative power which the statute vests in this Commission."

(*z*) *Sillar's Patent*, 1882, Goodeve, P. C. 581; cp. also *Electric Telegraph Co.*, per Lord Langdale, M. R., cited in Goodeve, P. C. 554.

(*a*) *Norton's Patent*, 1863, 1 Moo. P. C. N. S. 339.

(*b*) *Whitehouse's Patent*, 1838, 1 Web. P. C. 476; *Markwick's Patent*, 1860, 13 Moo. P. C. 310; *Russell* v. *Ledsam*, 1845, 14 M. & W. 574.

(*c*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep. April to June, 1881, VII.

Assignees petitioned for the extension of a patent. The patentee had parted with his interest for a large sum of money. Extension granted to the assignees without conditions (*d*).

When petition to be presented.

Under the Act of 1883, the petition for extension must be presented at the Privy Council Office at least six months before the time limited for the expiration of the patent (*e*). The right, however, to present, under Lord Brougham's Act, a petition for the prolongation of a patent at any time before the expiration of the patent, is a right or privilege accrued under those enactments, and is, therefore, saved by sect. 113 of the present Act, in the case of patents existing at its commencement (*f*). In such cases the old law still prevails, and the petition for prolongation may be presented at any time, provided that it is prosecuted with effect during the existence of the patent.

By the Rules the petition must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette* (*g*).

Affidavit of advertisements.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of Lord Brougham's Act, sect. 4, and the 1st and 2nd of the Rules of the Judicial Committee (*h*).

There is no affidavit verifying the petition; the evidence in support of the petition is given at the hearing.

On or before the day fixed for that purpose in the advertisements (*i*), any person may enter at the Council Office a caveat (*k*) addressed to the Registrar of the Council, against the extension prayed for in the petition (*l*).

Interest of opponent.

There is no requirement of interest in an opponent to the prolongation of letters patent, such as exist in the case of opposition to the grant of patents (*m*), or the amendment of specifications (*n*).

An alien resident abroad, who was interested in an English patent by a foreign inventor, and who had also considerable dealing in this country in respect of sales of the patented machine, and in granting licences for the use of such patent, was held, under the circumstances, to have such a *locus standi* as would entitle him to

(*d*) *Bodmer's Patent*, 1849, 6 Moo. P. C. 468; *Napier's Patent*, 1861, 13 Moo. P. C. 543.
(*e*) Patents Act, 1883, s. 25, sub-s. (1).
(*f*) *Brandon's Patent*, 1884, 1 P. O. R. 154.
(*g*) J. C. Rules, Rule III., *infra*.
(*h*) J. C. Rules, Rule IV.
(*i*) J. C. Rules, Rule II.
(*k*) See Form, Appendix, p. 813.
(*l*) Patents Act, 1883, s. 25, sub-s. (2).
(*m*) *Ibid.* s. 11, sub-ss. (1), (3).
(*n*) *Ibid.*, s. 18, sub-ss. (2), (4).

oppose the extension of an English patent which would interfere with that in which he was interested (*o*).

Grounds of objections.

The caveat must be entered in the name of the opponent himself, and not in that of a patent agent (*p*). Every person entering a caveat is entitled to be served with a copy of the petition for prolongation, and no application to fix a time for hearing is allowed to be made without an affidavit of such service being produced. All parties served with petitions are required to lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections (*q*).

Under the repealed Acts, it was unnecessary for an opponent to the prolongation of letters patent to give particulars of the objections on which he proposed to rely. It was sufficient to state generally the grounds of objection (*r*). The present Act contains no provision altering this practice, and in a recent case (*s*) successful opposers were permitted to give evidence of an instance of prior user not stated in the particulars, but their costs were disallowed.

The Attorney-General, on behalf of the Crown, is entitled to give evidence of objections to the extension of a patent irrespective of the particulars (*t*).

A party applying for the extension of letters patent must give four weeks' notice of the time appointed for the hearing to any person who has entered a caveat against such extension (*u*); and, according to the usual practice of the Judicial Committee, is required to advertise the day fixed in the *London Gazette*, and in two other newspapers named in the order (*x*).

Not less than a week before the day fixed for hearing the application, the petitioner must lodge at the Council Office six printed copies of the specification, and also four copies of the balance-sheet of expenditure and receipts relating to the patent in question (*y*).

In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification will be deemed sufficient (*z*).

(*o*) *In re Schlumberger's Patent*, 1853, 9 Moo. P. C. 1.

(*p*) *Loive's Patent*, 1852, 8 Moo. P. C. 1.

(*q*) J. C. Rules, Rules V. and VI. For forms of objections, see Appendix, pp. 837, 838.

(*r*) *Ball's Patent*, 1879, L. R. 4 App. Cas. 171.

(*s*) *Stewart's Patent*, 1886, 3 P. O. R. 7.

(*t*) *Ball's Patent*, *ubi supra*; *Stewart's Patent*, 1886, 3 P. O. R. 7; *Church's Patent*, 1886, 3 P. O. R. 101.

(*u*) J. C. Rules, Rule II.

(*x*) Lawson, p. 444.

(*y*) It has of recent years been customary to lodge eight copies of the balance-sheets.

(*z*) J. C. Rules, Rule IX.

In *Re Bell's Patent* (*a*), an unintentional omission to comply with the above rule as to copies of the specification was not held to be fatal; but the Judicial Committee intimated that their leniency upon this occasion must not be used as a precedent, and their lordships may refuse to go into accounts which have not been filed within the prescribed time (*b*).

The hearing.

The Hearing.—Under 7 & 8 Vict. c. 69, s. 8, the Judicial Committee may appoint one of the clerks of the Privy Council to take any formal proofs required to be taken in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself. This section was not repealed by the Patents Act, 1883. Under the 28th section of the Patents Act, 1883, the Judicial Committee may call in the aid of an assessor specially qualified (sub-sect. 2), may try the case wholly or partially with the assistance of such assessor (sub-sect. 1), and may determine his remuneration, which is to be paid in the same manner as the other expenses of the execution of the Act. (Sub-sect. 3.)

At the hearing, the petitioner and any parties opposing may appear either by themselves or by counsel.

The Attorney-General, in accordance with a rule laid down by the Judicial Committee in *Erard's Patent* (*c*)—the first application for extension under 5 & 6 Will. IV. c. 83—always appears to watch, on behalf of the Crown and the public, the progress of extension petitions, whether opposed or not, and is entitled to set forth his views, although no caveat has been entered (*d*).

In *Pettit Smith's Patent* (*d*), an application by the Lords of the Admiralty to enter a caveat and be heard against the petitions, such caveat not having been filed within the time required by the rules, was refused, on the ground that the Attorney-General represented the interests of the Crown as well as those of the public.

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard upon either side (*e*).

Subject to two qualifications, viz., that the advertisements must be proved first in the case (*f*), and that when the accounts are *primâ facie* unsatisfactory, the petition will be dealt with

(*a*) 1846, 2 Web. P. C. 159.

(*b*) *Chatwood's Patent*, 1873, L. R. 5 P. C. 88, n.; and *Johnson and Atkinson's Patent*, 1873, L. R. 5 P. C. 87.

(*c*) 1835, 1 Web. P. C. 557, n. (*a*); and see *Whitehouse's Patent*, 1838, *ibid.* p. 474.

(*d*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133.

(*e*) *In re Woodcroft's Patent*, 1841, 3 Moo. P. C. 172, n.

(*f*) *Perkin's Patent*, 1845, 2 Web. P. C. 8.

without reference to the merits (*g*), the Judicial Committee follows as closely as possible the rules of evidence in courts of law (*h*).

Grounds of extension.

The Grounds of Extension.—It is thought that the law bearing upon the subject is accurately stated in the following propositions: —

Position of Judicial Committee.

I. *As regards the extension of letters patent, the Judicial Committee consider that they represent the legislature to a certain degree, and that they are invested with somewhat similar powers of discretion to those exercised formerly by parliament* (*i*).

The extension of letters patent has never been granted as a matter of course (*k*).

The Judicial Committee have, as a general rule, recommended an extension of the term of letters patent on grounds similar to those adopted by the legislature, and recited in the old acts of prolongation (*l*).

But it has never been their course to put themselves precisely in the situation of the legislature, and never to grant an extension in a case where an Act of Parliament would not have been obtained (*m*). Lord Brougham's Act was passed with the view of providing a remedy easier and cheaper than a petition to parliament, and better in this respect, that it took account of cases which never would have prevailed on the legislature to make a new personal law prolonging the monopoly, but meritorious enough as regards the individual, beneficial enough as regards the public, and deficient enough in remuneration, to justify interference (*n*).

Nature and merits of invention, &c.

II. *In considering their decision, their lordships 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* (*o*).

The Patents Act, 1883, sect. 25, sub-sect. (4), from which this proposition is taken, does not alter in this respect the practice of the Judicial Committee under the repealed Acts (*p*).

(*g*) *Saxby's Patent*, 1870, L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; *In re Clark's Patent*, 1870, *ibid.* 255.

(*h*) *Erard's Patent*, 1835, 1 Web. P. C. 557, n. (*a*).

(*i*) *In re Morgan's Patent*, 1843, per Lord Brougham, 1 Web. P. C. 739; *cp. Erard's Patent*, 1835, 1 Web. P. C. 557, n. (*a*); *In re Soames' Patent*, 1843, 1 Web. P. C. 733; *Perkin's Patent*, 1845, 2 Web. P. C. 18.

(*k*) *In re Jones' Patent*, 1840, 1 Web. P. C. 579; *In re Derosne's Patent*, 1844, 2 Web. P. C. 4; *In re Honiball's Patent*, 1855, 9 Moo. P. C. 393; *Cardwell's Patent*, 1856, 10 Moo. P. C. 490.

(*l*) 1 Web. P. C. 557, n. (*a*). See also above, pp. 373 *et seq.*

(*m*) *In re Morgan's Patent, ubi supra.*

(*n*) *In re Soames' Patent, ubi supra.*

(*o*) Patents Act, 1883, s. 25, subs. (4).

(*p*) *Newton's Patent*, 1884, L. R. 9 App. Cas. 592.

What petitioner must prove.

The petitioner for the prolongation of letters patent is bound to prove—(a) that the invention is meritorious; (b) that everything in the power of the parties interested has been done to bring out the invention, and to turn it to advantage; and (c) that owing to circumstances beyond his control, he has been unable to obtain an adequate remuneration (*q*).

Invention meritorious.

(a) It is, of course, impossible to define strictly the degree of merit which will induce the Judicial Committee to extend the term of a patent. A few leading principles may, however, be referred to with advantage.

The ordinary merit, which would sustain a patent in the first instance, is not sufficient to justify an extension of the term (*r*).

"The law presumes some merit in a patent by the mere granting of it," said Sir William Grove in the case of *Stoney's Patent* (*r*); "in practice very little merit will do, and I do not know that the . . . . law officers of the Crown, who advise the Crown, go into merit, in the sense in which it is used in this Board, further than seeing that the invention, or alleged invention, is not an absurd one. The theory, therefore, of patents is that they are granted *ex mero motu* by the Crown, on the recommendation of the legal advisers of the Crown, upon *primâ facie* novelty and *primâ facie* merit. But, to induce the lords of the Privy Council to extend a patent, there must be something more than that; in other words, there must be more merit than would merely support a patent in a court of law."

In the word "merit," as used in this connection, two distinct ideas seem to be involved—the exercise of invention or ingenuity on the part of the patentee, and the utility of the invention to the public.

These two elements are not, however, of equal importance. A patent for an invention which was "very small in point of discovery," but useful and of great benefit to the public, may be extended (*s*).

On the other hand, the Judicial Committee would probably refuse an extension of letters patent for a comparatively worthless or trivial invention, however ingenious (*t*). It has already been shown (*u*) that the importer of a highly meritorious invention may petition successfully for the prolongation of letters patent which he

(*q*) *Markwick's Patent*, 1860, 13 Moo. P. C. 313.

(*r*) *Stoney's Patent*, 1888, 5 P. O. R. at p. 521, per Sir William Grove; *Swaine's Patent*, 1837, 1 Web. P. C. 559.

(*s*) *Derosne's Patent*, 1844, 4 Moo. P. C. 416; *Beanland's Patent*, 1887, 4 P. O. R. at p. 491, per Lord Hobhouse.

(*t*) *Beanland's Patent*, *ubi supra*.

(*u*) See *supra*, pp. 382, 383.

has obtained for it, and that the Judicial Committee will also recognize the claims of an assignee who has incurred expense in bringing a useful patent into public use.

Upon the same principle, it is not the person who merely displays ingenuity in throwing out the idea of the possibility of doing a thing, but the person who follows out that suggestion, and after repeated experiments gives it a practical application, that is the real benefactor to the public, and possesses that description of merit which constitutes one of the grounds for extending the term of a patent (*r*).

Circumstances which do not weigh against merit.

The following considerations do not weigh against the merit of an invention:—

That only a small step was made in advance of existing knowledge—the whole history of science being a continued illustration of the slow progress by which the human mind makes its advance in discovery (*x*).

That such improvements on the original invention had been made *by the patentee* (*y*) that no person would after these ever think of using the invention as it originally stood; if such an argument were to prevail, any improvement made by the patentee upon the patent would at once take away the patentee's right to obtain an enlargement of the term (*z*).

That the patentee's invention consisted of improvements upon a former patent taken out by him in consequence of a communication from abroad—such improvements being novel and of public utility (*a*).

That the working of the invention under the original patent has been altered during the term (*b*).

Circumstances which do.

The following circumstances weigh against the merit of an invention:—

That it has not been brought into public use (*c*). The presumption arising from non-user will be considered in dealing with the duty of a patentee to employ every means of making his invention a commercial success.

(*r*) *In re Bett's Patent*, 1862, 7 L. T. N. S. 677; 1 Moo. P. C. 49, 61; cp. *Woodcroft's Patent*, 1846, per Lord Brougham, 2 Web. P. C. at p. 23.

(*x*) *Soames' Patent*, 1843, 1 Web. P. C. 735.

(*y*) *Aliter*, where the invention in its improved form was imported by persons other than the petitioner. *Woodcroft's Patent*, 1841, 1 Web. P. C. 740.

(*z*) *Galloway's Patent*, 1843, 1 Web. P. C. at p. 727. The original invention must, however, have possessed utility. *Bell's Patent*, 1846, 2 Web. P. C. 160.

(*a*) *Bovill's Patent*, 1863, 1 Moo. P. C. N. S. 348.

(*b*) *Heath's Patent*, 1853, 2 Web. P. C. 257.

(*c*) *Allan's Patent*, 1867, L. R. 1 P. C. 507; *Normand's Patent*, 1870, L. R. 3 P. C. 193.

That it would exclude the public from the use of well-known sanitary agents. This may seem a somewhat special issue to take notice of, but it has been raised in several cases, of which *Sillar's Patent* (*d*) may be taken as an instance. Here, an extension of the patent would have prevented any members of the public from using alum, clay, and charcoal in stated proportions for the purpose of deodorizing manure. The petition was dismissed. "The question," said Sir Barnes Peacock, delivering the judgment of the Judicial Committee, "is whether this patent is of such utility as to justify the renewal of the patent, excluding the public, upon this general specification, from the use of those ingredients for the purpose of deodorizing sewage, the use of two of those ingredients, viz., alum and charcoal, being well-known."

Everything done to bring invention into use.

(b) Where a patentee has *intentionally delayed* for a length of time attempting to put his invention into practice, an extension will not be recommended, unless he can show some reasonable excuse, such as want of funds, for the delay (*e*).

The fact that a patent, *in spite of the efforts of the patentee*, has not come into public and general use, raises a strong presumption against its utility (*f*). But in all cases where the utility of a patent has not been tested by actual employment, the question to be considered is whether the evidence was sufficient to rebut the presumption arising from its non-use, that the invention is one of no practical utility (*g*).

This presumption may, however, be rebutted by such evidence as the following:—

That, from the nature of the invention, it would not be likely to come into immediate use, or was only capable of being employed to a limited extent (*h*).

Illustrative cases.

An application on behalf of a patented knapsack was supported by very favourable reports from officers who had examined it. It was deposed that the fact of nine out of ten men in our infantry

(*d*) 1882, Goodeve's Patents, 581; cp. *McDougal's Patent*, 1867, L. R. 2 P. C. 1: 5 Moo. P. C. N. S. 1; *McInnes' Patent*, 1868, L. R. 2 P. C. 54; 5 Moo. P. C. N. S. 78.

(*e*) *In re Cardwell's Patent*, 1856, 10 Moo. P. C. 488; cp. *Wright's Patent*, 1839, 1 Web. P. C. 575; *Southworth's Patent*, 1837, 1 Web. P. C. 486.

(*f*) *Wright's Patent*, 1839, 1 Web. P. C. 575; *Simister's Patent*, 1842, 4 Moo. P. C. 164; *Bakewell's Patent*, 1862, 15 Moo. P. C. at p. 386; *Allan's Patent*, 1867, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Herbert's Patent*, 1867, 4 Moo. P. C. N. S. 300; *Hughes' Patent*, 1879, 4 A. C. 174.

(*g*) *Hughes' Patent*, 1879, 4 App. Ca. p. 174.

(*h*) *Jones' Patent*, 1840, 1 Web. P. C. 577.

becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by the patentee, but hitherto without return. The committee, allowing their doubt as to its utility, arising from its not having been adopted by the Government, to be slightly founded, in the absence of evidence of its failure, recommended its extension for five years (*i*).

A patentee presented a petition for prolongation of his patent "improvements in sluices and flood-gates." He satisfied the Judicial Committee that his invention was meritorious, but was, from its nature, only capable of being employed to an occasional or limited extent. Ten years' extension granted (*j*).

That, from circumstances beyond the control of the patentee, the merits of the patent had not been appreciated (*k*).

Illustrative cases.

(1) A patent for preserved meats was extended for five years on the grounds that the patentee had used every exertion in his power to introduce the invention, and had expended large sums in so doing, but by reason of the distrust with which the public viewed preparations of that nature, the inadequacy of the patentee's means, and his want of influence with public boards, he had been prevented from obtaining such a fair trial as would lead to the adoption by the public of his invention (*l*).

(2) The patentee of an invention, which had never been brought into public use during the period of fourteen years, accounted for the non-user on the ground that the invention was of such a nature that it could only be carried out by a company, which he had failed to form. It was held that the explanation was not sufficient to rebut the presumption against the practical utility of the patent, and an extension of the term was refused (*m*).

(3) The patentee of a captain's bridge, constructed as a self-launching life-raft, petitioned for prolongation on the ground that, owing to illness and other circumstances beyond his control, he had not been adequately remunerated. It was proved that for nearly eight years he had been practically incapacitated for business in consequence of a railway accident. The invention had been awarded prizes at exhibitions, but had never been brought into actual use. Extension for seven years was granted (*n*).

(*i*) *Berrington's Patent*, 1852, cited by Coryton, p. 225.

(*j*) *Stoney's Patent*, 1888, 5 P. O. R. 520.

(*k*) *Kollman's Patent*, 1839, 1 Web. P. C. 564.

(*l*) *Payne's Patent*, 1854, cited in Higgins' Digest, p. 266.

(*m*) *Bakewell's Patent*, 1862, 13 Moo. P. C. 385.

(*n*) *Roper's Patent*, 1887, 4 P. O. R. 201.

(4) The introduction of a patent for the improvement of the spinning jenny was violently resisted by the trade, so that the patentee received no adequate remuneration during the term. Extension granted for seven years (*o*).

(5) Extension has been granted when a patentee or his assignee has been prevented by necessary litigation from reaping his reward during the original term (*p*). Disputes between the co-owners of a patent will not justify the failure of a petitioner for extension to bring the invention into public use (*q*). Negligence on the part of a patentee in restraining infringement is a good ground of opposition for extension (*r*).

That he has at all times been ready to give the public the benefit of his invention (*s*).

That the circumstances have ceased which prevented the patent from being lucrative, and that it is really coming into use (*t*).

Remuneration insufficient (*u*).

(c) A petitioner for the prolongation of letters patent must satisfy the Judicial Committee that, regard being had to all the circumstances of the case, he has not received a remuneration adequate to the merit of his invention, and the time and money he had properly expended in working it (*v*).

The chief difficulty which the petitioner has to overcome is to present accounts showing, in a manner which admits of no controversy, the amount of remuneration which in every point of view the invention has brought to him (*w*).

It is not for the Judicial Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been that he has received (*x*). In

(*o*) *Robert's Patent*, 1839, 1 Web. P. C. 573; cp. *Stafford's Patent*, 1838, 1 Web. P. C. 563.

(*p*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133; *Heath's Patent*, 1853, 2 Web. P. C. 133.

(*q*) *Patterson's Patent*, 1849, 6 Moo. P. C. 469.

(*r*) *Simister's Patent*, 1841, 1 Web. P. C. 724.

(*s*) *Stewart's Patent*, 1886, 3 P. O. R. 7, 10.

(*t*) Per Lord Brougham in *Woodcroft's Patent*, 1846, 2 Web. P. C. 29. In *Foarde's Patent*, 1855, 9 Moo. P. C. 376, it was held that the fact of an Act of Parliament having passed which would compel the use of the petitioner's patent formed no objection to a renewal of the term, the merits of the invention and loss incurred in carrying it out being established.

(*u*) Forms of account in a recent case, which were considered satisfactory by the Judicial Committee, are given in the Appendix, pp. 821 *et seq.*

(*v*) *Bate's Patent*, 1836, 1 Web. P. C. 739; *Southworth's Patent*, 1837, 1 Web. P. C. 486; *Dounton's Patent*, 1839, 1 Web. P. C. 565; *Derosne's Patent*, 1844, 2 Web. P. C. 1; *Nussey and Leachman's Patent, Re*, 1890, 7 P. O. R. 22.

(*w*) *Saxby's Patent*, 1870, per Lord

one or two cases (*x*) the hearing of a petition has been adjourned to enable a petitioner to produce better evidence as to his profits, but this was merely an exceptional indulgence, and in all probability would not again be allowed (*y*).

Practice as regards imperfect accounts.

The following cases illustrate the modern practice of the Judicial Committee in dealing with imperfect accounts:—

Foreign patents.

The accounts of a petitioner were silent in reference to receipts and expenditure in respect of foreign patents for the same invention, although the attention of the petitioner had been called to the omission in a notice of objection delivered by opponents. The Judicial Committee refused an adjournment and dismissed the petition (*z*).

The statement of the remuneration received by a petitioner was, on the face of the petition and accounts filed, unsatisfactory. Petition dismissed, without reference to the merits of the invention (*a*).

Full and unreserved statement of profits.

The most unreserved and clear statement of the patentee's remuneration is an indispensable condition in an application for extension (*b*). The actual expenses and receipts must be shown; it is not sufficient to show generally that there has been no profit (*c*).

The applicant must show what profits have been derived from any foreign patents he may have for the invention (*d*), and also from sales for exportation (*e*).

Licensees.

The profits derived by licensees from the working of the patent should also appear in the accounts of a petitioner for prolongation (*f*).

Cairns, 7 Moo. P. C. N. S. at p. 85. The balance sheet should be handed over to the solicitor for the Treasury before applications for extension are heard. *Perkin's Patent*, 1845, 2 Web. P. C. at p. 14, per Lord Campbell.

(*x*) *Perkin's Patent*, 1845, 2 Web. P. C. at p. 17; *Heath's Patent*, 1853, 2 Web. P. C. at p. 256.

(*y*) *Clark's Patent*, 1870, 7 Moo. P. C. N. S. 255.

(*z*) *Newton's Patent*, 1884, 1 P. O. R. 177.

(*a*) *Clark's Patent*, *ubi supra*; *Houghton's Patent*, 1871, 7 Moo. P. C. N. S. at p. 311, per James, L. J. The statement of accounts being *primâ facie* satisfactory, the petitioners may be allowed to prove the merits of the invention before going into the accounts.

S. C., at p. 309; *Wield's Patent*, 1871, 8 Moo. P. C. N. S. 300; *Johnson's and Atkinson's Patents*, 1873, L. R. 5 P. C. 87; *Willacy's Patent*, 1888, 5 P. O. R. 590.

(*b*) *Hill's Patent*, 1863, 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; cp. *Bett's Patent*, 1861, 1 Moo. P. C. N. S. 49.

(*c*) *Quarrill's Patent*, 1840, 1 Web. P. C. 740.

(*d*) *Johnson's Patent*, 1871, L. R. 4 P. C. 75; 8 Moo. P. C. N. S. 291, dissenting from *Poole's Patent*, 1867, 4 Moo. P. C. N. S. 452; *Adair's Patent*, 1881, L. R. 6 A. C. 178; *Newton's Patent*, 1884, 1 P. O. R. 177.

(*e*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441.

(*f*) *Trotman's Patent*, 1866, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

In a petition for prolongation of a patent, where the patent rights have been transferred either in whole or in part to a company, it is essential that there should be deposited not only the patentee's account of his profits, but, in order to test them, the account also of the company (*g*).

This rule was not, however, insisted upon in the case of a patent of great merit and usefulness (*h*).

A patentee ought from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. The patentee knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original patent. It is not, therefore, too much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent (*i*).

In the matter of *Willacy's Patent* (*k*) the accounts did not show that the expenditure charged had been incurred with reference to the only part of the patent which was proved to possess utility, and an extension was therefore refused.

In *Yates and Kellett's Patent* (*l*) the grantees of a patent petitioned for prolongation on the ground of inadequate remuneration. No accounts were presented till within a week of the hearing, and the accounts then filed were insufficient. The petitioners applied for an adjournment in order that they might amend the accounts. The Judicial Committee refused the application and the petition was dismissed. "The explanation," said Lord Hobhouse, "given at the bar is that the patentee who has carried on this manufacture has destroyed his books; that the materials are not forthcoming out of which a better account might be made, and that the patentee was in difficulties and started afresh. The destruction of his books, for aught their Lordships know, may have been a perfectly honest and perfectly reasonable operation for him to perform, but he cannot escape from the consequences; and a man who is bound to show what his profits have been before he can come for the renewal of the patent, must, if he

(*g*) *Deacon's Patent*, 1887, 4 P. O. R. 119.
(*h*) *Ibid.*
(*i*) *Adair's Patent*, 1881, L. R. 6 A. C. 176; *Bell's Patent*, 1861-62, 1 Moo. P. C. N. S. 49, per Lord Chelmsford.
(*k*) 1888, 5 P. O. R. at p. 695.
(*l*) 1887, L. R. 12 App. Cas. 147; 4 P. O. R. 150; cp. *Duncan and Wilson's Patent*, 1884, 1 P. O. R. 257.

destroys his books, destroy the very case on which he must rely for a renewal of the patent."

Deductions allowed.

A petitioner for the extension of letters patent is entitled, in the petition or accounts which he submits to the Judicial Committee, to claim certain deductions from the profits made by him as patentee.

The personal expenses of the patentee for the *exclusive* devotion of his time in bringing the patent into practical operation and public notice, may be deducted (*m*).

Such an allowance will not be made where the whole of the time charged for has not been devoted to the extension and furtherance of the patent (*n*).

An allowance may be claimed by a patentee, who is also a manufacturer, for his personal superintendence of the working of his invention (*o*).

But where the petitioner did not manufacture the patented articles, but only granted licences, a charge for his personal allowance and subsistence money while visiting and overlooking the works of the licensees, was disallowed (*p*). "It was no part," said Lord Chelmsford in this case, "of the covenant with the licensees that the petitioner should superintend their operations, and if they required his assistance to instruct their workmen, they should have engaged him and paid him for his services. If they had done so, this would have constituted a fair deduction out of the profits of the licensees, and would have properly entered into the patent account."

The expenses of taking out and defending a patent, and of experiments, may be deducted (*q*).

But although law expenses incurred by the patentee in maintaining his patent rights are allowed in deduction of his profits, yet where the patentee compromised suits and gave up costs to which he had an apparent title, a deduction on that head will not be allowed (*r*).

(*m*) *Carr's Patent*, 1873, L. R. 4 P. C. 539; cp. *Bate's Patent*, 1836, 1 Web. P. C. 739; *Roberts' Patent*, 1839, *ibid.* 575; *Galloway's Patent*, 1843, *ibid.* 729; *Newton's Patent*, 1861, 11 Moo. P. C. 156. A patentee residing in America, for the purpose of getting the patented article into use in England, arranged with an agent in England, and in consideration gave him a moiety of the royalties. It was held, that in estimating the profits of the patentee derived from the patent such moiety must be deducted. *Poole's Patent*, 1867, L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452.

(*n*) *Furness' Patent*, 1885, 2 P. O. R. at p. 177.

(*o*) *Roberts' Patent*, *ubi supra*; *Perkins' Patent*, 1845, 2 Web. P. C. 8, 17.

(*p*) *Trotman's Patent*, 1866, L. R. 1 P. C. 118.

(*q*) *Bate's Patent*, *ubi supra*; *Roberts' Patent*, *ubi supra*; *Kay's Patent*, 1839, 1 Web. P. C. 572; *Galloway's Patent*, *ubi supra*; *Bett's Patent*, 1861, 1 Moo. P. C. N. S. 49.

(*r*) *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258.

The difference between the sum for which a patentee has sold his patent, and that which he has paid in buying it again, cannot be allowed in the accounts as an item of loss, but must be regarded as a mere commercial speculation (*s*).

A deduction may be allowed for profits made by the patentee as manufacturer, but not due to his monopoly (*t*).

The distinction between the manufacturing profits which a petitioner for extension may, and those which he may not, deduct, cannot better be stated than in the following language:—

"If but for the patent there would have been no manufactory, then the net profits of the manufacturer are, in that large sense, attributable to the patent. With it the manufacturer has a monopoly. . . . The patent may be said to create his trade; at least, it developed it to an extent which would be impossible without it" (*u*).

"It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer, and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer, such that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer" (*x*).

It appears, therefore, that the manufacturer's profits which the Judicial Committee will take into consideration in estimating the remuneration of a patentee, are those which could not have been made but for the preference monopoly created by the patent (*y*).

Where, however, the profits made by the patentee as manufacturer are not the profit of the monopoly, but simply the profit which any manufacturer, employed to make the patented articles, would have derived thereby, though he had no right to the patent or the monopoly, a fair deduction will be allowed (*z*).

The test above stated will be applied to profits arising from the

(*s*) *Wield's Patent*, 1871, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(*t*) *Galloway's Patent*, 1843, 1 Webst. P. C. 729; *Bell's Patent*, 1862, 1 Web. P. C. N. S. 49.

(*u*) *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 268, per Lord Chelmsford.

(*x*) *Saxby's Patent*, 1870, per Lord Cairns, L. R. 3 P. C. 292.

(*y*) *Muntz's Patent*, 1846, 2 Web. P. C. 113.

(*z*) *Galloway's Patent*, 1843, 1 Web. P. C. 729.

manufacture of the materials out of which the patented articles are made (*a*), and from the sale of the patented articles (*b*).

Any deductions from profits which it is intended to claim must be set forth in the petition or the accounts, and evidence in support of claims not specifically made will not be admitted (*c*).

Case of *primâ facie* validity must be made out.

It is not the practice of the Judicial Committee to decide upon the novelty or utility of a patent, although they will of course abstain in any case from prolonging a patent which is manifestly bad. The petitioner must make out a case of *primâ facie* validity (*d*).

Cases.

A petition was presented for the prolongation of a patent, on the ground that the patentee had been inadequately remunerated. The merit of the invention was proved, and the inadequacy of the remuneration was not seriously disputed, but objections were taken to the novelty of the invention and the sufficiency of the specification, and it was suggested that the patent, if prolonged, should be made subject to the compulsory licences clause of the new Patents Act, 1883. The objection was repelled, and the patent extended for five years without conditions (*e*).

S., being the patentee of an invention for "improvements in sugar-cane mills," petitioned for the prolongation of his patent on the ground of having sustained an actual loss in working it. M. & Co. and others opposed, and tendered evidence to show anticipation by machines made by W., and by the publication in England of the American specification of H. Extension refused (*f*).

A petition for prolongation stated that various legal proceedings had been taken and were still pending, but that the petitioner could not postpone his application until their decision, as the patents were nearly expired. The petition further stated that by reason of litigation and expenses incurred, the inventor had not been adequately remunerated. Extension for three years granted (*g*).

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

(*b*) *Bailey's Patent*, 1884, 1 P. O. R. 1.

(*c*) *Ibid.*

(*d*) Per Lord Cairns in *Saxby's Patent*, 1870, L. R. 3 P. C. 294; cp. *Erard's Patent*, 1835, 1 Web. P. C. 557, note (*a*); *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258; *Stoney's Patent*, 1888, 5 P. O. R. at p. 522; *Kay's Patent*, 1839, 1 Web. P. C. 568; *Galloway's Patent*, 1843, 1 Web. P. C. 725; *Woodcroft's Patent*, 1846, 2 Web. P. C. 30; *Pinkus's Patent* 1848, 12 Jur. 234; *Bett's Patent*, 1862, 1 Moo. P. C. N. S. 52; *McDougal's Patent*, 1867, 5 Moo. P. C. N. S. 4; *McInnes' Patent*, 1868, 5 Moo. P. C. N. S. 76.

(*e*) *Cocking's Patent*, 1885, 2 P. O. R. 153. The utility of an invention is of more importance than its novelty for the purpose of a successful petition for prolongation. *Church's Patent*, 1886, 3 P. O. R. 95.

(*f*) *Stewart's Patent*, 1886, 3 P. O. R. 7.

(*g*) *Kay's Patent*, 1839, 1 Web. P. C. 568; cp. *Heath's Patent*, 1853, 2 Web. P. C. 257.

Period of extension: generally seven years; but ten or even fourteen years under special circumstances.

The usual practice of the Judicial Committee has been not to recommend extensions for periods of more than seven years. But in exceptional cases, the seven years' limit has been exceeded, and ten or even fourteen years' extension have been granted. *Moncrieff's Patent* for gun carriages was extended fourteen years, and *Stoney's Patent* (*h*) for improvements in sluices or flood-gates was extended ten years, on the ground that from its nature it was capable only of limited and occasional use.

When an extension has been once recommended, and new letters patent granted, the power of the Judicial Committee is exhausted, and they have no jurisdiction to entertain a petition for a further prolongation of the term (*i*).

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

It is now (*l*) the practice of the Judicial Committee to prolong letters patent by ordering a new grant to be made for the extended term (*m*).

In order that the exact relations of the new to the original letters patent may be understood, the following points must be noticed:—

Renewed letters patent are not void, if dated after the expiration of the original term (*n*).

As a matter of fact, the new letters patent are ordered to be sealed by the Comptroller-General and dated the date of expiration of the original patent. The Order in Council (*o*) prolonging the patent usually fixes the time within which application may be made for the new letters patent.

It is not necessary that a new specification of the extended patent should be filed (*p*).

(*h*) 1888, 5 P. O. R. 518.

(*i*) *Goucher's Patent*, 1865, 2 Moo. P. C. N. S. 532.

(*k*) Patents Act, 1883, s. 25, sub-s. 5.

(*l*) As to extension of a patent for an invention patented abroad, see p. 422. *Bodmer's Patent*, 1853, 8 Moo. P. C. 282; *Aube's Patent*, 1854, 9 Moo. P. C. 43; *Bell's Patent*, 1861, 1 Moo. P. C. N. S. 49.

(*m*) *Cocking's Patent*, 1885, 2 P. O. R. at p. 152; *Stoney's Patent*, 1888, 5 P. O. R. at p. 524. For the form of new grant in *Stoney's Patent*, see Appendix, p. 839.

(*n*) *Russell* v. *Ledsam*, 1845, 14 M. & W. 574, decided under 5 & 6 Will. 4, c. 83, s. 4.

(*o*) Appendix, p. 838.

(*p*) *Wasteney Smith's Patent*, 1885, 2 P. O. .R 14.

The new patent will be subject to sects. 22 and 27 of the Patents Act, 1883, as to compulsory licences and patents binding the Crown (*q*).

In the case of *Bovill* v. *Finch* (*r*), separate patents had been granted to Bovill in England, Scotland, and Ireland, previous to the passing of the Patent Law Amendment Act, 1852. By that Act, and its amending Act 16 & 17 Vict. c. 115, it was provided that the letters patent granted for the prolongation of a patent should, for the future, be sealed with the Great Seal of the United Kingdom, and be of force in the whole of the United Kingdom. Letters patent were subsequently granted sealed with the Great Seal of the United Kingdom, prolonging for a term of five years from their expiration the privileges granted by the three patents above mentioned. It was held, that the effect was the same as if the three patents had been separately prolonged, and the fact of one of the original patents being void for want of novelty would not prevent the letters patent being valid as a prolongation of the other patents (*s*).

Reservations in new grant.

The following cases illustrate the nature of "the restrictions, conditions, and provisions" which the Judicial Committee may insert in a new grant of letters patent. There is nothing in the statute 5 & 6 Will. IV. c. 83, to fetter the discretion of the Crown in the renewal, except the length of term (*t*).

Cases.

Patent with several claims.

Letters patent comprised three separate subjects. Upon an application for extension, one only of the three subjects appeared to the Judicial Committee to be deserving of a renewed grant. Prolongation was granted, under 15 & 16 Vict. c. 83, s. 40, as to that part alone (*u*).

Assignees.

A petition for extension was presented by an assignee.

(a) The patentee had made nothing by his patent. The Judicial Committee required the assignee to secure an annuity or a share of the profits to the inventor or his representatives (*v*);

(*q*) *Ibid*; but see *Cocking's Patent*, *ubi supra*. Conditions allowing the Crown to use the invention patented were formerly inserted in the new grant. *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133; *Carpenter's Patent*, 1854, 2 Moo. P. C. N. S. 191 (n.); *Lancaster's Patent*, 1864, 2 Moo. P. C. N. S. 189.

(*r*) 1870, L. R. 5 C. P. 523.

(*s*) See also *In re Bovill's Patent*, 1863, 1 Moo. P. C. (N. S.) 348.

(*t*) *Ledsam* v. *Russell*, 1 H. L. Ca. 687.

(*u*) *Lee's Patent*, 1856, 10 Moo. P. C. 226; cp. *Bodmer's Patent*, 1853, 8 Moo. P. C. 282; *Church's Patent*, 1886, 3 P. O. R. at p. 102. See also *Metford's Patent*, 1879, 48 Engineer, 15.

(*v*) *Whitehouse's Patent*, 1838, 1 Web. P. C. at p. 476; *Russell* v. *Ledsam*, 1845-48, 14 M. & W. 574; *Hardy's*

(b) Valuable consideration had been given for the assignment, and the assignee had sustained considerable loss. Prolongation was granted unconditionally (*x*).

Action for infringement before patent sealed.

A patentee, having obtained an extension warrant, neglected to get the patent sealed. A subsequent petition to the Crown by a foreigner to revoke this warrant was dismissed, on condition of the payment by the patentee of the petitioner's costs, and that no action should be brought for any infringement between the date of the warrant and the subsequent petition. There was held to be jurisdiction under 3 & 4 Will. IV. c. 41 (*y*).

Licences.

A patentee, formerly in partnership with J. and W., by a deed of dissolution stipulated that J. and W. should have the exclusive right of granting, in certain cases therein provided, licenses for manufacturing the patent article. In recommending an extension of the term of the patent, the Judicial Committee imposed a condition upon the patentee to secure to J., in whom the interest in the deed of dissolution then vested, the same interest in the new letters patent in regard to the granting of licenses as was provided by the deed of dissolution; but refused to allow J. to substitute new licenses for those granted under the original letters patent, in the event of the original licensees declining to renew their licenses from him under the new grant (*z*).

Prices.

Disclaimer.

A successful petitioner for prolongation has been required (a) to grant licenses to the public upon terms similar to one already granted by him (*a*); (b) to sell the patented article at a certain fixed price (*b*); (c) to disclaim all the parts of the original patent not worked out (*c*).

In *Dixon* v. *London Small Arms Co.* (*d*), it was held that private contractors, not being servants or agents of the Crown, could not use a patented invention of another in manufacturing articles for the government service. This led in some cases to the insertion of a reservation in favour of the government and its contractors in some new grants by the Judicial Committee,

Patent, 1849, 6 Moo. P. C. 441; *Markwick's Patent*, 1860, 13 Moo. P. C. 310; *Herbert's Patent*, 1867, 4 Moo. P. C. N. S. 300; *Pitman's Patent*, 1871, L. R. 4 P. C. 87; *Morton's Patent*, 1881, Eng. Rep., April to June, 1881, VII.

(*x*) *Bodmer's Patent*, 1849, 6 Moo. P. C. 468. "Terms are only imposed upon the assignee where the inventors and patentees have made nothing by their invention." Per Lord Brougham, *ibid.* p. 469.

(*y*) *Schlumberger's Patent*, 1853, 9 Moo. P. C. 1.

(*z*) *Normandy's Patent*, 1855, 9 Moo. P. C. 452.

(*a*) *Mallet's Patent*, 1866, L. R. 1 P. C. 308; 4 Moo. P. C. N. S. 175.

(*b*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441.

(*c*) *Bodmer's Patent*, 1853, 8 Moo. P. C. 282.

(*d*) 1875, L. R. 1 App. Ca. p. 632.

where the invention was likely to be of use in the government service (*e*).

The person in whose favour an order for the extension of a patent has been made, is required to leave forthwith at the Patent Office an office copy of such order (*f*).

Costs.—In dealing with the question of costs, the Judicial Committee act upon the principle that *bonâ fide* opposition ought rather to be encouraged than discountenanced (*g*). Costs.

The costs of successful opposition are, therefore, allowed unless the Judicial Committee is dissatisfied with the manner in which the opposition has been conducted, *e. g.*, where much expense was occasioned by the opponent's relying upon patents for inventions which bore no resemblance to the patent in question, or producing discreditable witnesses, or otherwise prolonging the inquiry (*h*).

Again, costs of opposition will in general be allowed when the petitioner abandons his application for extension (*i*).

In a doubtful case, which caused the Judicial Committee great difficulty, no costs were given to the successful petitioner (*k*).

Costs will be given to a successful petitioner, where there was no ground for opposition (*l*).

Where there are several opponents representing the same kind of opposition, one set of costs, to be apportioned between them by the Registrar of the Privy Council, will be allowed (*m*). Upon the other hand, where the objection of several opponents are quite distinct, separate costs may be awarded to each (*n*). It is very usual to grant a lump sum for costs, in which case a taxation is avoided.

(*e*) See *Napier's Patent*, 1881, L. R. 6 App. Ca. p. 174, where a reservation in favour of the government and its contractors was inserted; and see also *Hughes' Patent*, L. R. 4 App. Ca. 174, where a similar condition was inserted to that in *Palliser's Patent*. This condition in *Palliser's Patent* was as follows:—"Upon condition that the officers of her Majesty's government, and all persons who may from time to time contract for the supply of ordnance and projectiles for her Majesty's service in respect of work done in the execution of such contracts, shall be at liberty to use the same invention or inventions during the continuance of the new letters patent."

(*f*) Patents Rules, 1890, r. 74, *infra*.

(*g*) *Wield's Patent*, 1871, 8 Moo. P. C. N. S. at p. 304; L. R. 4 P. C. 89; cp. *Westrupp and Gibbins' Patent*, 1836, 1 Web. P. C. 556.

(*h*) *Muntz's Patent*, 1846, 2 Web. P. C. 122; *Honiball's Patent*, 1855, 9 Moo. P. C. 394.

(*i*) *Macintosh's Patent*, 1837, 1 Web. P. C. 739; *Bridson's Patent*, 1852, 7 Moo. P. C. 499; *Hornby's Patent*, 1853, 7 Moo. P. C. 503; *Milner's Patent*, 1851, 9 Moo. P. C. 39; *Morgan Brown's Patent*, 1886, 3 P. O. R. 212. When the petition is abandoned, it is not necessary that the opposers should serve the petitioners with notice of their intended application to the Court for costs of opposition. *Bridson's Patent*, *ubi supra*.

(*k*) *Church's Patent*, 1886, 3 P. O. R. p. 95.

(*l*) *Downton's Patent*, 1839, 1 Web. P. C. 567.

(*m*) *Milner's Patent*, 1854, 9 Moo. P. C. 39; *Jones' Patent*, 1854, 9 Moo. P. C. 41; *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258; *Wield's Patent*, 1871, *ubi supra*; *Johnson's Patent*, 1871, 8 Moo. P. C. N. S. 282.

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

CHAPTER XIX.

CONFIRMATION OF PATENTS.

No confirmation except by special Act before 1835.

It has always been the law that it is necessary for the validity of a patent that the invention should be new as well as that it should be useful, and if it can be proved that the invention had been practised publicly by any person before the letters patent are granted, the patent is invalid (*a*). The hardship which this rule of law may cause in certain cases was well explained in the evidence of one of the witnesses (*b*) before the Parliamentary Committee of 1829 (*c*). "It very often happens that a person—I will say ten years ago—invents a machine which for want of just exactly the right thing does not act; he tries it; it is a complete failure; the thing is thrown by. Some eight or ten years afterwards everybody (I will say that it is an invention for the spinning of cotton) is trying who can save an hour in the spinning of cotton; it is likely a second person may invent the same thing, or may catch at the same principle; he adopts a different mode of carrying it into effect, and being a little more clever than the other, he hits on the point the other wanted, and makes his a most valuable invention: he takes out his patent for it. Away comes the other man who ten years ago invented something that involved some few of the parts this new invention does: he says 'I made such and such wheels, and put them together for the same purpose ten years ago. I did this much of it,' and that patent is upset."

Prior to 1835, there was no power in the Crown to confirm or render valid letters patent in such a case, and the only remedy was by a special Act of Parliament.

Lord Brougham's Act.

With a view to relieve patentees against this hardship, the statute 5 & 6 Will. IV. c. 83, s. 2 (*d*), passed in 1835, provided that "if in any suit or action it shall be proved or specially found that any

(*a*) *In re Card's Patent*, 1848 (per Lord Campbell), 6 Moo. P. C. 212.
(*b*) Mr. Benjamin Rotch.
(*c*) Pp. 113, 114.
(*d*) See *infra*, pp. 637 *et seq.*

person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assignees to petition His Majesty in Council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council." The section then goes on to state the *grounds* upon which this discretionary power may be exercised, viz., that the patentee believed himself to be the first and original inventor, and that the invention or part thereof had not been publicly and generally used before the date of the letters patent which it was sought to confirm.

Grounds for confirmation by Privy Council.

The following are the chief points of interest in connection with the confirmation of letters patent, which are not provided for in the new Act, and on which, therefore, it may be sufficient to dwell very lightly:—

Cases.

(1) If the defect in the patent could be cured by disclaimer or memorandum of alteration, confirmation would not be granted (*e*).

(2) The petition for confirmation was required to admit the invalidity of the patent, and the petitioner ought not to bring an action for infringement before confirmation, the two proceedings being contradictory (*f*).

(3) The petitioner had to satisfy the Judicial Committee (a) that he believed himself to be the true and first inventor (*g*); and (b) that the invention was not publicly and generally used prior to the date of his patent (*h*).

(4) The Act was meant to apply to the case of an invention abandoned, and not in use at the time of the patent; and if those conditions were absent, the Judicial Committee would not exercise its discretion, even although the person who had publicly used the invention prior to the date of the patent consented to the confirmation (*i*).

(5) Where it appeared on a petition for confirmation that part

(*e*) *In re Westrupp and Gibbins' Patent*, 1836, 1 Web. P. C. 555.

(*f*) *In re Stead's Patent*, 1846, 2 Web. P. C. 147.

(*g*) *Ibid. In re Honiball's Patent*, 1855. 2 Web. P. C. 201; *In re Card's Patent*, 1848, 2 Web. P. C. 161.

(*h*) *Ibid.*

(*i*) *In re Lamenaude's Patent*, 1850, 2 Web. P. C. 164.

of the patentee's invention formed the subject of an expired French patent, but that it had never been used or known in England otherwise than by a description in a book published in France, a copy of which was in the British Museum, notice of the day of hearing was directed to be given to the French patentee, and on an affidavit that such notice had been sent through the Post Office, directed to Paris, confirmation was recommended (*k*).

(6) The confirmation merely obviated objections arising from prior user, or publication, leaving the patent still open to all other objections to which it might be liable (*l*).

Where, however, the prior publication was that of two prior patents which had not been publicly or generally used, Lord Lyndhurst said that he did not think the Act was intended to apply to such a case. The petitioner might have gone to the office and seen the prior specifications (*m*).

Confirmation since the Act of 1883.

This Act of 5 & 6 Will. IV. c. 83, was repealed by the Patents Act, 1883, so that there can now be no confirmation except by special Act of Parliament, at least, so far as patents granted under the Act of 1883 are concerned. But it appears that confirmation may still be applied for so far as patents obtained under the Act of 1852 are concerned.

Brandon's Patent.

The decision in *Brandon's Patent* (*n*), which has already been referred to (*o*), shows that all rights or privileges of patentees under the Act of 1852 are preserved; and confirmation and prolongation in the cases contemplated by 5 & 6 Will. IV. c. 83, are equally such rights or privileges. There have been, however, no petitions for confirmation of patents granted under the Act of 1852 presented since the Act of 1883. It is clear that any such right will absolutely cease before 1898, when no patents granted before the 1st January, 1884, will be in force.

Confirmation in cases not provided for in Act of 1835.

The statute of Will. IV. only applied to cases where the patent was void by reason of prior user or invention, and there was no provision for confirming or rendering valid a patent void for any other reason. In such cases it was therefore necessary to apply to Parliament for a special Act. Two such Acts were passed prior to the Act of 1852, and patents were declared valid where the specification had been enrolled after the six months provided by the letters patent (*p*).

(*k*) *In re Heurtelaup's Patent*, 1836, 1 Web. P. C. 553.
(*l*) Hindmarch, p. 201.
(*m*) *Wells' Patent*, 1 Web. P. C. 554.
(*n*) 1 P. O. R. 1884.
(*o*) See previous chapter, pp. 378, 379.
(*p*) *Westhead's Patent*, where the specification was enrolled five days late. The

Non-payment of renewal.

After 1852 the fees on patents were paid in two instalments, of 50*l.* and 100*l.*, before the end of the third and seventh years. In order to revive a patent which had been allowed to lapse owing to non-payment of the stamp duty within the prescribed time, it was necessary to apply to Parliament, and a considerable number of special Acts were obtained with this object between 1852 and 1884 (*q*).

Select Committee, 1887.

Since the Act of 1883, sect. 17, the comptroller has power to enlarge the time for payment of the renewal fees, and in consequence it appears that very few Acts will in future be passed confirming patents void for non-payment of renewal fees. In 1887 three bills were introduced for confirming letters patent void for non-payment of renewal fees, and a Select Committee reported on the whole matter (*r*).

Recommendations of Committee.

Previous to 1887 there were three confirming Acts in 1884 (*s*), and one in 1885 (*t*); but in 1887 the Select Committee reported that, having regard to the Act of 1883, sect. 17, in future no private Act to confirm letters patent should be allowed to proceed where the excuse offered for default in payment of a renewal fee falls short of serious illness, or some other cause for which the patentee ought not to be held responsible, and which may sufficiently account for the non-payment otherwise than by neglect, inadvertence, or mistake.

The Committee further held, that a person beneficially interested in a patent should be held responsible for default in registered patentee or his agents. Also, that where any bill is entertained, clauses should be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after it has been announced as void in the Official Journal (*u*).

Potter's Patent Act, 1887.

The Committee allowed Potter's Patent Bill to proceed, being satisfied that non-payment of the renewal fees arose from serious illness of the applicant, and not from neglect, inadvertence, or mistake.

Act was passed in 1849, seven months after the forfeiture, and contained no saving clause. In *Laird's Patent* the specification was enrolled one day late, but the Act was not passed till 1851, which was seven years after the forfeiture. In this Act there was a saving clause. See Report of Select Committee H. of L. on Potter's Patent Bill, &c., in 1887, at p. 43.

(*q*) See Report, &c., *supra*, last note. A list of these Acts is there given. See also Official Journal of Patent Office of December 23, 1884.

(*r*) Report of Select Committee on Potter's Patent Bill, Skrivanow's Patent Bill, and Gilbert and Sinclair's Patent Bill, House of Lords, 1887.

(*s*) Wright's Patent Act, Boult's Patent Act, and Bradbury and Leman's Patent Act.

(*t*) Auld's Patent Act.

(*u*) The clauses suggested are set out in Potter's Patent Act, 1887, sect. 2, Appendix, p. 844.

CHAPTER XX.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International recognition of rights of inventors.

For at least ten years prior to the Act of 1883, there had been a strong opinion, both in England and in other countries, in favour of an attempt to create an international patent law, or at least some international recognition of the rights of inventors (*a*).

Select Committee, 1872.

Adopting to some extent the views expressed in 1871 by Sir H. Bessemer and Sir William Armstrong, and again in 1872 by Mr. C. W. Siemens and others, the Select Committee of 1872 recommended that there should be an assimilation in the law and practice in regard to inventions amongst the various civilized countries of the world, and that her Majesty's government be requested to inquire of foreign and colonial governments how far they are ready to concur in international arrangements in relation thereto.

Circular to British colonies.

A circular, dated August 31, 1872, was, in accordance with this recommendation, addressed to the Governors of the British colonies by the Earl of Kimberley, then Colonial Secretary, and the replies received thereto were in the main favourable (*b*).

Reports on foreign patent laws.

At the same time (*c*), her Majesty's representatives abroad were directed by Lord Granville, Secretary of State for Foreign Affairs, to prepare succinct reports upon the patent laws of the countries to which they were severally accredited, and these reports were published and laid before Parliament in 1873 (*d*).

International Convention, 1883.

The International Congress at Vienna in 1873, and the Paris Congress of 1878 (*e*), carried the movement towards an international

(*a*) As early as 1851, an association called the "Association of Patentees," sought to include in their list of reforms of the patent law "International arrangements for a mutual recognition of the rights of inventors." It was suggested, among other proposals, that (1) where any person patented an invention in one country, that person or his assignees should have the sole and exclusive title to a patent for the same invention in every other country for the space of six months after the date of his original patent; and (2) patents of importation in the name of parties other than the inventor or his assignees should be abolished in every country. The latter suggestion was supported on the ground that every *improvement or discovery made in one* part of the civilized world is, sooner or later, made known by the public journals in every other part; and it ought not, therefore, be permitted to any one (except the inventor or his assignees) to step in and deprive the public of what is likely to be communicated to them in due course.

The above shows that the ideas underlying the Convention are much older than is popularly supposed. The Convention considerably modified the position of importers.

(*b*) Correspondence respecting International Arrangements, May, 1874 (C. 999).

(*c*) By circular of August 14th, 1872.

(*d*) Reports of her Majesty's Secretaries of Embassy and Legation respecting the law and practice in foreign countries with regard to inventions, 1873 (C. 741).

(*e*) Organized during the Exhibition of 1878.

patent law considerably further; and on 20th March, 1883, an International Convention for the protection of industrial property was signed at Paris (*f*). The necessary ratifications were exchanged by the plenipotentiaries of the contracting parties on June 6, 1884, and the Convention came into effective operation a month later (*g*).

The original signatories.

The original signatories were the governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia and Switzerland. Great Britain was not included. Indeed, it was necessary that statutory power should be given to the Crown, to allow the ante-dating of the patent, which might otherwise be void by reason of anticipation.

Power for Her Majesty to make arrangements with foreign states.

By the Patents Act, 1883 (*h*), it was provided that if her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for the mutual protection of inventions (*i*), any person who has applied for protection for any invention in any such state shall be entitled to a patent for his invention in priority to other applicants, and such patent shall have the same date as the date of the application (*k*) in such foreign state.

Seven months' priority.

The application in England must be made within seven months from the date of application in the foreign state with which the arrangement is in force.

No action for infringement till complete specification accepted.

The patentee, moreover, will not be entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in this country (*l*).

Publication during the seven months.

The publication in the United Kingdom or the Isle of Man, during the seven months aforesaid, of any description of the invention, or its use therein during such period, shall not invalidate the patent which may be granted (*m*).

Application, how to be made.

The application for the grant of a patent under these provisions

(*f*) See the text of the Convention, pp. 600 *et seq.*

(*g*) The contracting parties agreed to interfere as little as possible with the particular laws of the different States. The first principle was to ask only from each country the same treatment for subjects of each of the other countries as was accorded to their own subjects. The Convention was in no way based upon the principle of strict reciprocity, and uniform regulations were only insisted upon where they were considered indispensable in order to obtain effective reciprocal protection. Not only was it agreed to permit each State to maintain its own law without modification, except on the above points; but countries, *e.g.* Holland, Switzerland, and Servia, were admitted, in which all branches of industrial property were not at the time and are not now protected.

(*h*) Sect. 103.

(*i*) The section deals also with trade marks and designs, which are foreign to the present work.

(*k*) The words *date of application* were, at the instigation of Lord Herschell, substituted, by sect. 6 of the Act of 1885, for the words *date of the protection obtained*, which appear in sect. 103. Cp. *L'Oiseau and Pierrard*, per Webster, A.-G., 1887, Griffin, A. P. C. at p. 39.

(*l*) Sect. 103, sub-s. 1.

(*m*) *Ibid.* sub-s. 2.

must be made in the same manner as the ordinary application for the British patent (*k*).

Order in Council.

These provisions are, moreover, to apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*l*).

Her Majesty's government acceded to the Convention (*m*), so far as Great Britain and Ireland are concerned, on the 17th March, 1884, and reserved power to subsequently accede on behalf of the Isle of Man (*n*), Channel Islands, or any of Her Majesty's possessions. The accession was accepted (*o*) on the 2nd April following. By an Order in Council (*p*) dated the 26th June, 1884, the provisions of the Patents Act, 1883, s. 103, were applied to the countries then signatories of the Convention, and the order took effect from the 7th July, 1884.

Subsequent withdrawals and accessions.

There have been subsequent accessions to and withdrawals from the Convention (*q*).

Colonial arrangements.

As most of the British possessions have now patent laws of their own, it was necessary to make provisions for mutual protection of inventions between the colonies and Great Britain, and accordingly

Provision for colonies and India.

the Act of 1883 (*r*) provides that where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of section 103 as to international arrangements, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Effect of 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 its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

(*k*) Sect. 103, sub-s. 3. This, however, is not quite the fact, as several other matters have to be considered, and special forms of procedure are prescribed by Patents Rules, 1890, rr. 24—29, see pp. 568—570.

(*l*) *Ibid.* sub-s. 4. Orders in Council have been issued applying the provisions of this section to the countries given in the table on opposite page.

(*m*) For text of Convention, see pp. 600 *et seq.*

(*n*) By this reservation on behalf of the Isle of Man, the patent granted to foreigners in countries which are signatories to the International Convention, is not co-extensive with the ordinary grant, which extended to the Isle of Man.

(*o*) See p. 619.

(*p*) See pp. 620, 621.

(*q*) Art. XVI. of the Convention provided for subsequent adhesions, Art. XVIII. for subsequent withdrawals.

(*r*) Sect. 104.

The position of Great Britain with regard to arrangements made under sect. 103 with foreign countries, and under sect. 104 with the British possessions, may be presented most conveniently in tabular form.

STATE.	Date of Order in Council (*s*) under sect. 103 or sect. 104 of Act of 1883.	Date from which Order in Council takes effect.	Date of accession to International Convention.	Date from which accession takes effect.	Date of Withdrawal (*t*).
Belgium	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Brazil	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
East Indian Colonies of the Netherlands	17 Nov. 1888	17 May, 1889			
Ecuador	26 June, 1884	7 July, 1884	21 Dec. 1883	6 July, 1884	26 D 1886 (*u*)
France	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Great Britain	26 June, 1884	7 July, 1884	17 Mar. 1884	7 July, 1884	
Guatemala	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Italy	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Mexico (*v*)	28 May, 1889 (*y*)	28 Dec. 1889			
Netherlands	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
New Zealand	8 Feb. 1890 (*z*)	8 Sept. 1890			
Norway	9 July, 1885	1 July, 1885			
Paraguay (*v*)	24 Sept. 1886	24 Sept. 1886			
Portugal	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Queensland	17 Sept. 1885 (*z*)	17 Sept. 1885			
Salvador	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	17 Aug. 1887 (*a*)
San Domingo	27 Jan. 1885	27 Jan. 1885	.. ..	.. ..	28 May, 1889 (*b*)
Servia	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Spain	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Sweden	9 July, 1885	1 July, 1885			
Switzerland	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Tunis	26 June, 1884	7 July, 1884	20 Mar. 1883	6 July, 1884	
Turkey					
United States	12 July, 1887	12 July, 1887			
Uruguay (*a*) (*c*)	24 Sept. 1886	24 Sept. 1886			

(*s*) Published in London Gazette.

(*t*) Under Art. XVIII. of the International Convention, the provisions of the Convention remain in force as regards any country terminating its cohesion till the expiry of one year from the date of such notice.

(*u*) See Order in Council, 16 April, 1886. Notice of withdrawal was given on Dec. 26, 1885.

(*v*) Mexico, Paraguay, and Uruguay, are not signatories to the Convention, but have, by separate treaty with Great Britain, given to British inventors, and obtained for their own countrymen, the benefits of sect. 103.

(*w*) Reciting a treaty between Great Britain and Mexico, ratified 11 Feb. 1889.

(*z*) Order in Council made under the provisions of sect. 104 of the Act of 1883.

(*a*) See Order in Council, 24 Sept. 1886.

(*b*) See Order in Council, 28 May, 1889.

(*c*) Victoria and Tasmania have embodied in their respective laws international provisions analogous to those of the Patents Act, 1883, but no Order in Council has yet been issued under sect. 104 applying the provisions of sect. 103 to those countries. The case of Natal is somewhat curious. By an enactment of the Governor in Council, dated Nov. 8, 1881, sect. 38 of Law No. 4 of 1870, which declares that letters patent granted in the United Kingdom shall not extend to Natal, was repealed, and it was decreed that from and after the date of the promulgation in that colony of the Order in Council referred to in sect. 104 of the Patents Act, 1883, all letters patent granted in the United Kingdom should be deemed and taken to be granted under the provisions of Law No. 4 of 1870, and dealt with accordingly. This law, which was limited to patents, was to come into *operation from and after the date of the promulgation in the Natal* Government Gazette of the Order in Council referred to in sect. 104 of the Act of 1883. The effect of this provision would be to extend every British patent to Natal, but no Order in Council under sect. 104 has yet been made. Cp. Trans. I. P. A. Vol. VI., pp. 130, 131. A. M. Clark on the International Convention.

Conferences under International Convention.

The International Convention provided for conferences being held successively in one of the contracting states, by delegates of the said states, with a view to improvements upon the system of the union (*d*).

The first meeting took place at Rome in April and May, 1886 (*e*), and the second at Madrid in April, 1890.

Rules for application under sects. 103 and 104.

Rules prescribing the formalities to be observed in applications for patents made under the International and Colonial Arrangements were issued by the Board of Trade and duly laid before Parliament on the 11th May, 1888; were published four days later, and came into force on 1st June, 1888. They are now Rules 24—29 of the Patents Rules, 1890.

General scope of International Convention.

The provisions of the International Convention, so far as relates to patents, may be shortly summarised as follows:—

Priority.

1. An applicant for a patent in any one of the contracting states can obtain protection in any of the other contracting states by application there within a period of six, or in the case of countries beyond the seas of seven, months from the date of his first application. The subsequent application is antedated to the date of the first application; and is, consequently, not defeated, as otherwise it would have been, by prior publication or user in the protected interval (*f*).

Importation.

2. Formerly, a patentee could not introduce into some of the States of the Union articles manufactured according to his patent in this or other countries without forfeiture of his rights. Free importation of such articles without the penalty of forfeiture is now allowed, but the patentee remains bound to "work" his patent in conformity with the laws of the country into which he introduces the patented articles (*g*).

Exhibitions.

3. Temporary protection is accorded by each of the contracting states to patented articles exhibited at official or officially recognised international exhibitions (*h*).

(*d*) Art. XIV.

(*e*) The British delegates on this occasion were the Comptroller-General (Mr. H. Reader Lack) and Mr. J. H. G. Bergne, of the Foreign Office, assisted by Mr. C. Belk, the Master Cutler of Sheffield, and Mr. H. Hughes, secretary of the Sheffield Chamber of Commerce.

The following addition to the Convention, in so far as it relates to patents, was agreed upon. To Art. V., "Each country shall decide the meaning of the word *exploiter* for itself."

The number of applications under the provisions of the International Convention amounted to 26 in 1887, and to 71 in 1888.

(*f*) Art. IV.

(*g*) Art. V.

(*h*) Art. XI. The Act of 1886 gave Her Majesty power, by Order in Council, to declare the provisions of Act, 1883, s. 39, applicable to foreign exhibitions. For the Order in Council in case of Paris Exhibition 1889, see p. 845.

International Office.

4. An International Office in connection with, and under Art. XIII. of the Convention, has been established at Berne, Switzerland. Its expenses are defrayed by the governments of all the contracting states, its functions are determined by agreement between them, and it publishes a monthly periodical entitled *La Propriété Industrielle* (*i*).

Legal effect of Orders in Council under s. 104.

The legal effect of arrangements made for the Colonies and India by Order in Council, under sect. 104, is clear, because the Order in Council may vary or add to the provisions of sect. 103; and the Order in Council is to be read with the Act as if it were contained in it. The Order in Council and sect. 103 will, therefore, be read together, and construed in the same manner as any other statutory enactment.

General relation of Convention to laws of contracting states.

But it is a matter of no little difficulty to determine the precise relation which the International Convention bears to the laws of the contracting states. The position of the Convention will probably vary, in different countries, according to the legal effect given to treaty arrangements (*k*).

Practice under sect. 103, the Convention, and the Patents Rules.

An application in the United Kingdom for a patent for any invention, in respect of which a foreign application (*l*) has been made, must contain a declaration that such foreign application has been made, and must specify all the foreign states or British possessions in which foreign applications have been made, and the date or dates thereof respectively.

(*i*) The yearly subscription (including postage) for all countries within the postal union is 5 francs 60 cents., payable to MM. Jent & Reinert, Imprimeurs, Berne.

(*k*) It is to be observed, that one of the chief difficulties, under sect. 103, is the vagueness of the word *any* in the clause beginning: "If her Majesty is pleased to make *any* arrangement with the government or governments of any foreign state, &c." But it is provided, that the section shall only apply to those foreign states with respect to which her Majesty shall from time to time, by Order in Council, declare them to be applicable. Most of the Orders in Council which have been made simply apply sect. 103 to the countries with which arrangements have been made. So that so far as the treaties are concerned, it would appear that they need not be looked at, except, perhaps, to see if the provisions of the Order in Council are all contained in the treaty. All that needs attention is the sect. 103, and to see how far the Order in Council applies its provisions. If the Order in Council applying sect. 103 to the countries under the International Convention was properly made, it would seem that her Majesty may, by Order in Council, apply some only of the provisions of sect. 103. For in this Order in Council there is a reservation of the Isle of Man. As to the general position of treaties and Orders in Council made under statutory authority, and applying the provisions thereof, see *Reg.* v. *Wilson*, 1877, L. R. 3 Q. B. D. p. 42, and *Parlement Belge*, 1880, 5 P. D. 197.

(*l*) "The term 'foreign application' means an application by any person for protection of his invention in a foreign state or British possession, to which by any Order of her Majesty in Council for the time being in force, the provisions of sect. 103 of the Patents Act, 1883, have been declared applicable." P. R. 1890, r. 24.

The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made.

If such person or any of such persons be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any (*m*).

Application on Form A2.

The application in the United Kingdom must be made in the Form A2 in the second schedule to the Patents Rules, 1890 (*n*), and in addition to the specification, provisional or complete, left with such application, as in the case of an ordinary application, must be accompanied by—

(1) A copy or copies of the specification and drawings, or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign state or British possession, in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign state or British possession as aforesaid, or otherwise verified to the satisfaction of the comptroller;

(2) A statutory declaration as to the identity of the invention in respect of which the application is made, with the invention in respect of which the said first foreign application was made, and if the specification or document corresponding to it be in a foreign language, a translation must be annexed and verified by the statutory declaration (*o*).

Variance in English and foreign specifications.

Minor matters of departure in a foreigner's English specification from his foreign specification are unimportant, if the law officer is enabled by the translation to judge of the substantial identity of the inventions described therein (*p*).

Entry by comptroller of dates.

On receipt of the application, together with the prescribed specification, and the other document or documents accompanying the same, and with such other proof, if any, as the comptroller may require of or relating to such foreign application, or of the official date thereof, the comptroller makes an entry of the applications in both countries, and of the official dates of such applications respectively (*q*).

Further proceedings same

All further proceedings in connection with the application are

(*m*) P. R. 1890, r. 25.
(*n*) *Infra*, p. 739.
(*o*) P. R. 1890, r. 26.
(*p*) *L'Oiseau and Pierrard*, 1887, per Webster, A.-G., Griffin, A. P. C. at p. 37; *Mains' Patent*, 1890, 7 P. O. R. 13.
(*q*) P. R. 1890, r. 27.

taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications (*r*). as in other cases.

The patent, when granted, is entered on the Register of Patents, as dated of the date on which the first foreign application was made, and the payment of the renewal fees, and the expiration of the patent, are reckoned from the date of the first foreign application (*s*). Renewal fees.

There have been several recent decisions under sect. 103, to which it is necessary to allude. Decisions under sect. 103.

L'Oiseau and Pierrard (*t*).—On 8th October, 1886, L. and P., two foreigners, left at the Patent Office an application in common form, with a provisional specification, for letters patent for "automatic apparatus for subjecting the person to the action of electric currents." A complete specification was deposited on 29th January, 1887, and this was accepted on the 28th March following. On 28th May, 1887, notice of opposition to the grant of a patent to L. and P. was given by E., on the ground that the invention had been patented on an application by him of prior date. E.'s application bore date 20th August, 1886, and his complete specification had been left on 3rd March, 1887, and had been accepted on the 27th of the following May. Position of applicant where previous foreign patent not disclosed.

The applicants then called attention to a patent granted to them in France for the same invention, on 18th August, 1886, and contended that, under sect. 103 and the Convention, their patent would be dated 18th August, 1886, and would therefore be prior to E.'s. No notice had been given by L. and P. at the Patent Office of the existence of this French patent; the English specification contained claims not described in the French specification, and the applicants asked leave to strike out from the former the claim applicable to so much as was not described in the latter. Webster, A.-G., allowed the excision to be made, declined to treat the hearing as an application for an amendment which would justify him in imposing any terms, and, as there was nothing to show that L. and P.'s omission to refer to the foreign application was due to bad faith, directed their patent to be sealed as of the 18th August, 1886 (*u*).

(*r*) P. R. 1890, r. 28.
(*s*) *Ibid.* r. 29.
(*t*) 1887, Griffin, A. P. C. 36.
(*u*) "I think," added the A.-G., "(and I wish to reserve this point) that if it were shown that the Patent Office had been misled, and the opponents had been misled by any positive misrepresentation, or if there were anything which would amount to want of good faith, I should like to consider on another occasion whether an applicant who claims the benefit of sect. 103 is entitled to receive it. But once given that there has been a *bonâ fide* application within the period prescribed by

In a subsequent case (*x*), however, it was held that the applicants in *L'Oiseau and Pierrard* had no right under sect. 103 to oppose the grant of letters patent to E., under sect. 11 of the Act of 1883.

Retrospective effect of Orders in Council applying sect. 103.

In *Main's Patent* (*y*), Main, who was an American, had applied for a patent on the 18th April, 1887, in the United States. On the 12th July, 1887, an Order in Council applied the provisions of sect. 103 to the United States as from the 12th July, 1887. On the 18th November, 1887, Main applied for the British patent. The application was not made under the rules relating to applications under the International Convention. The grant of the patent was opposed on the ground that the invention had been patented on an application of prior date, the 8th June, 1887. The similarity of the inventions was not denied, but the applicant for the patent claimed to ante-date his application to the 18th April, 1887, under the provisions of sect. 103. It was held, that notwithstanding the fact that the provisions of sect. 103 did not apply at the time of the United States application, that the applicant was so entitled to ante-date his application. It was also objected that the application ought to have been made as an application under the International and Colonial Arrangement Rules; but *L'Oiseau and Pierrard's Case* (*z*) was followed, and the patent ordered to be sealed as of the 18th April, 1887.

Importer has no rights under sect. 103.

A person to whom an invention has been communicated from abroad, cannot claim any rights under sect. 103. The rights under that section are personal rights, and were intended to encourage people who had invented to come to this country and make known their inventions (*a*).

A patent under the International Convention can only be granted to the person (*b*) who has made the foreign application (*c*).

statute, and no conduct which would amount to a breach of good faith, or a breach which would prevent a man from being entitled to claim his rights, I am afraid that the words of the statute are so distinct that I have no alternative in the matter." See, however, the positive requirements of rr. 25 and 26, P. R. 1890.

(*x*) *Re Everitt*, 1888, per Webster, A.-G., Griffin, A. P. C. at p. 29.

(*y*) 1890, 7 P. O. R. p. 13.

(*z*) *Supra.*

(*a*) *Re Shallenberger*, 1889, per Webster, A.-G., 6 P. O. R. at p. 550.

(*b*) *Semble*, a corporation can apply under sect. 103. *Re Carez*, 1889, per Webster, A.-G., 6 P. O. R. 552. *Re Shallenberger supra.*

(*c*) *S. C., ubi supra.* Cp. also *Re Van de Poele.*

American "renewed applications."—In *Re Van de Poele*, 1890, 7 P. O. R. 69, a most important point has recently been decided.

An American inventor applied for a patent in the United States, abandoned the application, and subsequently lodged a fresh application in respect of the same invention. Upon the latter occasion he was permitted by the Patent Office as a matter of convenience to make use of the documents filed with his first application, but the application itself was no longer operative in America after its abandonment. Webster, A.-G., held that the second application was "the first foreign application" under the circumstances.

CHAPTER XXI.

FEATURES OF FOREIGN AND COLONIAL PATENT LAWS.

Scope of chapter.

We have already considered, in the preceding chapter, the existing international and colonial arrangements for the protection of inventors.

We propose in this chapter to give an account of some of the general features of foreign and colonial patent law (*a*).

Carpmael's "Patent Laws of the World."

For the full text of the enactments relating to foreign and colonial patent rights, Carpmael's "Patent Laws of the World," with its successive supplements, should be consulted. The law and practice in regard to foreign and colonial patents are constantly changing. Fresh supplements are brought out from time to time as the more important alterations occur.

In the Appendix will be found a synopsis of the principal provisions of patent laws of various countries (*b*).

Subject-matter of foreign and colonial patents.

Subject-matter.—In regard to the subject-matter of a valid patent, the laws of most foreign countries are very much the same.

The general rules are that:—

No patent will be granted for an invention which is contrary to law or morals;

Principles.

Mere abstract principles are not patentable;

Pharmaceutical preparations.

Pharmaceutical preparations are not good subject-matter (*c*),

(*a*) Patents for the protection of inventions and discoveries are granted in the following countries, colonies, and possessions:—

The Argentine Republic, each of the eight Australian colonies—viz., Victoria, New South Wales, South Australia, Western Australia, Queensland, New Zealand, Tasmania, and Fiji—Austria-Hungary, Bahama Islands, Barbadoes, Bechuanaland, Belgium, Bolivia, Borneo (British North), Brazil, British Guiana, British Honduras, Canada, Cape of Good Hope, Ceylon, Chili, Colombia, Congo, Costa Rica, Denmark, Ecuador, Finland, France, Germany, Gibraltar, Guatemala, Hawaian Kingdom, Hong Kong, India, Italy, Jamaica, Japan, Leeward Islands, Liberia, Luxembourg, Malta (Ordinance XIII. 1889), Mauritius, Mexico, Natal, Newfoundland, Nicaragua, Norway, Orange Free State, Peru, Portugal, Russia, St. Helena, Salvador, Sierra Leone, South African Republic, Spain, Straits Settlements, Sweden, Switzerland, Trinidad, Tunis, Turkey, United States, Uruguay, Venezuela, Windward Islands.

(*b*) Pages 862 *et seq.*

(*c*) So called "patent medicines" in England are quite distinct from letters patent for inventions. Medicine stamps appropriated to a particular medicine can be obtained from the Secretary,

and an application for a patent must be limited to a single principal object;

Foods. Processes. War.

Prepared foods are frequently not subject-matter of a patent, and sometimes also chemical products. In Switzerland processes, and in Russia inventions relating to purposes of war or national defence, are not patentable.

Novelty.

Novelty is a necessary incident of every valid patent, although considerable variation is exhibited in the extent to which anticipation is considered sufficient to avoid a grant. Even in those countries where no preliminary examination upon this point is held, *e.g.*, France and Spain, want of novelty in the subject-matter of an invention is still a ground of revocation.

Improvements—additions.

Patents of improvements—Certificates of addition.—In France the patentee has one year during which he has priority of all other persons in patenting improvements in his invention, and will be granted a "certificate of addition" for any improvement which he may so make. After the end of the first year he may likewise obtain certificates of addition for improvements, but the patentee has no priority over other persons, and any one else making any improvement may obtain a "patent of improvement." Certificates of addition expire with the original patent, of which they indeed are considered to form part. No annual taxes are payable on certificates of addition. Very similar provisions exist in several other countries, such as Belgium, Germany, Spain, Italy, Argentine.

Who may be patentee.

Who may apply.—Patents are granted generally to the true and first inventor of any patentable invention, whether he be a citizen or an alien, or to his legal representative or assignee, or to his duly authorized agent. In Germany the first applicant is entitled to the patent.

Declarations.

Declarations.—In the United States, Canada and Queensland, an oath or declaration that he believes himself to be the true and first inventor is required from every applicant who applies for a patent on that ground.

In France and most of the continental countries, upon the other hand, no oath or declaration is required, but the applicant is assumed to be the true and first inventor till the contrary be proved.

Stamps and Taxes, Inland Revenue, Somerset House, W.C., to whom all communications with respect to their preparation or supply should be addressed. The use of appropriated medicine stamps does not have the effect of letters patent; but such stamps are only supplied to the person for whose use and at whose cost the plate from which they are printed was prepared, or to his authorized agent.

In Germany, whoever first applies for a patent is entitled to the grant. But the claim of a petitioner will not be allowed if the essential contents of his application have without permission been taken from the descriptions, drawings, models, implements, or contrivances of another person, or from a method of manufacture used by the latter, if such person raises opposition on that account.

Official examination.

Official examination.—A preliminary examination is held in all foreign countries, and in the principal British colonies, into the formal sufficiency of applications and other documents relating to letters patent.

As to formal sufficiency of application, &c.

In some countries, such as the United States, Germany, Sweden, Norway and Russia, there is a strict preliminary examination, at the instance of the Patent Office, into the novelty of every invention for which protection is demanded.

Official examination as to novelty, &c.

In other countries, such as France, Austria-Hungary, and Spain, there is no official examination as to novelty, but the patent expressly purports to be granted "without guarantee of the government."

As to novelty of invention.

Date of patent.

Date of grant.—In France, Luxemburg, Belgium, Sweden, Norway, and some other countries, and most of the British colonies, a patent dates from the day of filing the application.

Day of application.

In the United States, Denmark, Russia, Spain, Austria-Hungary, and many other countries, a patent dates from the day of issue.

Day of issue.

In Germany, however, the term of a patent commences with the day following the day of application.

Duration of patent.

Duration of grant.—The duration of foreign and colonial patents varies to a considerable extent in different countries, the average duration being about fourteen years.

United States.

The term of a patent in the United States of America is seventeen years. When the invention, however, has been previously patented abroad, the term of the American patent is so limited as to expire with the foreign patent, or if there be more than one, with that which has the shortest term. In no case does an American patent for such an invention remain in force for more than seventeen years. This rule has been very rigorously enforced in the United States in the past. Thus a British patent was held to expire in fourteen years from its commencement, even if the term is prolonged by the Judicial Committee. In recent decisions, however, it has been held that where a patentee, possessed of a foreign patent of prior date to the United States patent granted for a short time, has the option of extending the same as a matter of

Falling of patents with expiry of previous foreign patent.

right, then the United States patent does not expire so long as such foreign patent is maintained in force. For instance, an Italian patent granted for one year can be prolonged from year to year as a matter of right to fifteen years, and if so prolonged the United States patent would not expire until the end of the fifteen years. On the other hand, it is presumed that a United States patent would lapse if a prior foreign patent for the same invention were allowed to lapse through non-payment of tax. For instance, although the British patent is granted for fourteen years, and it were allowed to lapse at the expiration of the fourth year, through non-payment of tax, the United States patent of subsequent date would also lapse (*d*).

In nearly every country, except Great Britain, Sweden, Norway and Germany, similar provisions exist.

Duration dependent on merit of invention,

In some countries, *e.g.*, the Argentine Republic, the duration of a patent grant depends upon the merit of the invention and the wish of the inventor.

or character thereof.

In Spain, the duration of a patent depends on the character of the invention protected by it. If the subject-matter is entirely new and original, the term is twenty years. If the invention has not yet been publicly worked in Spain, or patented abroad for more than two years, the patent is granted for ten years. If an invention, though neither original nor entirely new, has not yet been worked in Spain, a patent for five years will be granted to the person who first introduces the manufacture into the Spanish dominions.

Extent of grant.

Extent of grant.—As a general rule, a foreign patent extends, or may readily be extended, to all the territories comprised within, and all the colonies and possessions of, the State which grants it (*e*). Thus, on the establishment of the dual system in Austria-Hungary, it was decided by special agreement between the Ministers of Austria and Hungary, that the Imperial Decree of August 15th, 1852, which contained the Austrian law and practice in regard to inventions,

(*d*) There was a similar provision in the United Kingdom under the Patent Law Amendment Act, 1852, s. 25.

(*e*) Before the Patent Law Amendment Act, 1852, a patent could be granted in England to include her Majesty's colonies and plantations abroad upon payment of an additional fee. An additional clause was then inserted in the patent granting the privileges, "also in our Islands of Jersey, Guernsey, Alderney, Sark and Man, and in all our colonies and plantations abroad." But after the passing of that Act it was not usual to grant patents with this clause. All the patents, however, extended to the Channel Islands and Isle of Man. Under the Act of 1883, a patent is to issue for the United Kingdom and Isle of Man only. But as the prerogative of the Crown is expressly saved by that Act, the sovereign could apparently legally still extend the grant as before. In some of the colonies, however, special statutes exist, where her Majesty may, by her assent thereto, have waived her prerogative rights.

should remain in force throughout the whole Empire. In accordance with this agreement, the respective Ministers of Commerce submit for mutual approval the inventions for which they intend granting patents, and subsequently to such approval each ministry issues patents, bearing identical dates, for its respective division of the Empire. Thus an inventor desirous of securing an exclusive right to his invention in Austria-Hungary, must provide himself with two patents. These are, however, granted on a single application addressed at the choice of the applicant to either the Austrian or the Hungarian Ministry of Commerce, and on one payment of the fees (*f*). An Austria-Hungarian patent extends also to Bosnia and Herzegovina (*g*).

In like manner, French and Spanish patents extend to the colonies of those countries respectively.

Payments.—In the United States, and in several of our colonies, when a patent has once been granted, no further payment is required to entitle the patentee to the enjoyment of his privilege during the full term prescribed in the grant. Taxes.

As a rule, however, the duration of a patent is made subject to the payment of certain taxes.

Compulsory licenses.—In India, in the chief British colonies, in Germany, and the Argentine Republic, compulsory licenses may be granted as in England. Compulsory licenses.

The patent laws of every foreign country of importance, with the exception of the United States and of most British colonies, require patented inventions to be "worked" within a prescribed period after the date of the grant, upon pain of forfeiture of the patent right. In such countries patentees are also required, under the same penalty not to discontinue the use of their inventions within the territories of such countries for more than a specified period. Compulsory working, &c.

The compulsory working clauses in foreign and colonial patent laws are not enforced with uniform strictness. In France, for instance, they appear to be directed chiefly against voluntary and calculated inactivity on the part of a patentee, and it seems to be sufficient if the essential parts of an invention are worked within the prescribed time.

Importation of patented articles.—In Canada, after the first year, France, Turkey, and Venezuela, a patentee who has imported articles Importation of patented articles.

(*f*) Parliamentary Report, 1873, C. 741, p. 3.

(*g*) Law of December 20th, 1879, s. 9.

manufactured abroad, and similar to those which are protected by his patent, forfeits all his rights (*h*).

In France, however, the Minister of Agriculture, Commerce, and Public Works, may authorize the introduction (1) of models of machines; and (2) of articles made abroad intended for public exhibitions, or for trials made with the consent of the government.

Marking.

Marking of patented articles.—In many countries, as in England, there is no obligation to mark patented articles as such. In most countries it is an offence, however, to mark articles as patented which have not been protected.

In France the patentee need not mark his articles as patented, but if he does he must add the words "*Sans garantie du Gouvernement*," or its equivalent, the letters "S. G. D. G."

In Germany, also, there is no obligation to mark the words "Deutsches Reichs Patent," or the letters "D. R. P.," which, however, it is recommended to the patentee to put on the patented articles.

In the United States all articles must be marked as patented with the date of the patent, but if the nature of the articles render this inconvenient, the wrapper, package or label, must be so marked. There is no penalty, however, for non-compliance with this provision, except that in an action for infringement the patentee must prove knowledge in the infringer that the article was patented.

Assignments and licences of patents.

Assignments, &c.—Assignments and licences of patents are recognised by all foreign and colonial laws. As a general rule no assignment is valid as regards third parties till it has been registered at the proper office, for which purpose it must be prepared in accordance with the requirements of each country.

Extension of term.

Extension of term.—Generally the maximum term of a foreign patent can only be extended by a special law. This is the case in the United States, France, Austria-Hungary, and other countries. A Spanish patent cannot, it seems, be prolonged.

In some of the British colonies, *e.g.*, Western Australia and New Zealand, similar provisions to those of our own law exists for obtaining the extension of the term of a patent.

Infringements.

Infringements.—In general, every interference with the rights of a patentee, either by the manufacture of the products or by

(*h*) But see Article V. of the International Convention, p. 606.

using the means forming the subject of his patent, constitutes an infringement.

In the United States the infringer of patent rights is liable to civil proceedings alone. These proceedings are similar to our own.

In most foreign countries, however, infringement is an offence punishable by fine, and in case of its repetition by imprisonment, as well as a wrong to be redressed by damages.

Provisions for the seizure and confiscation of the infringing articles are also found in most foreign laws.

Revocation of grant.—Most countries provide for the revocation of the grant of patent privileges if the provisions of the patent law are not complied with. Revocation.

Part II.

THE PATENTS ACTS, 1883 to 1888,

CONSOLIDATED (*a*) AND ANNOTATED.

BEING,

46 & 47 VICT. c. 57.—An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August, 1883.] — Act of 1883.

48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883 (*b*). [14th August, 1885.] — Act of 1885.

49 & 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions (*c*). [25th June, 1886.] — Act of 1886.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883 (*d*). [24th December, 1888.] — Act of 1888.

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

(*a*) The form in which these Acts have been drawn renders consolidation a simple matter, without departing from the text of the Acts. The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

(*b*) For text at length, see Appendix, p. 725.

(*c*) *Ibid.* p. 727.

(*d*) *Ibid.* p. 728.

PART I.

PRELIMINARY.

Sect. 1. Short title.

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

The principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888 (*o*).

The short titles of the amending Acts are respectively—

The Patents, Designs, and Trade Marks (Amendment) Act, 1885.

The Patents Act, 1886.

The Patents, Designs, and Trade Marks Act, 1888.

As we are concerned with patents only here, these Acts are frequently cited as the Act of 1883, Act of 1885, &c., or sometimes as the Patents Act, 1883, the Patents Act, 1885, &c.

Division of Act into parts.

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

Part I.—PRELIMINARY.
II.—PATENTS.
III.—DESIGNS.
IV.—TRADE MARKS.
V.—GENERAL.

In this work we are not concerned with Parts III. and IV., or with some sections of Part V. These portions of the Act are therefore omitted in this part of the work, though for completeness the whole of the Acts are given in the Appendix. Occasions may arise where a consideration of sections relating to trade marks or designs may be of use in considering the sections relating to patents.

Commencement of Act.

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

Act 1888, s. 28.

The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

There is no special provision as to time of commencement of the Acts of 1885 and 1886, so that they commence from the dates of those Acts, the 14th August, 1885, and the 25th June, 1886, respectively.

(*o*) Act of 1888, s. 29.

PART II.

PATENTS.

APPLICATION FOR [1] AND GRANT OF PATENT.[2]

Sect. 4.

Persons entitled to apply for patent.

4. (1.) Any person,[3] whether a British subject or not,[4] may make an application for a patent.

(2.) Two or more persons may make a joint application[5] for a patent, and a patent may be granted to them jointly.[6]

Act 1885, s. 5. Power to grant patents to several persons jointly.

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared, that it has been and is lawful under the principal Act to grant such a patent.[7]

1 *Application for patent:*

For rules as to applications, Patents Rules, 1890, p. 565.
Outline procedure on applications, Chap. VI. p. 69.
Rival applicants, sect. 7, sub-sect. 5, pp. 438—440.
Application of true inventor where patent revoked on ground of fraud, sect. 26, sub-sect. 8, p. 475.
Application in fraud of first inventor, sect. 35, p. 491.
Deceased inventors, sect. 34, p. 491.
Correction of clerical errors in application, sect. 91, p. 509.
Amendment of application, sect. 7, p. 439; sect. 91 (a), p. 509; Patents Rules, 1890, p. 566.
General form of application, Patents Rules, 1890, Form A, p. 737.
Form of application by importer, Patents Rules, 1890, Form A 1, p. 738.
Applications sent by post, sect. 97, sub-sect. 1, p. 511.
Applications under International and Colonial Arrangements, Chap. XX. p. 408; sect. 103, p. 516; and Patents Rules, 1890, p. 568.
Form of application under Patents Rules, 1890, Form A2, p. 739.

2 *Grant of patent:*

Grant and its effect, Chap. X, p. 190.
Effect of grant on Crown, sect. 27, p. 478.
Opposition to grant, sect. 11, p. 444; Chap. IX, p. 167; Patents Rules, 1890, p. 573.
Date of grant, sect. 13, p. 451.

Sect. 4.

Extent, sect. 16, p. 454.
Term, sect. 17, p. 454.
One invention only, sect. 33, p. 490.
Assignment of grant, sect. 36, p. 492, and Chapter XI. p. 195.
Variations in form of grant, under this Act, pp. 530—536.

Coverture. Infancy. Lunacy.

3 *Any person.*—It may be laid down as a general proposition that there is now no limitation arising from incapacity—such as coverture, infancy (*f*), or lunacy (*g*)—upon the right to apply for a patent, so long as all proceedings are taken in due form, there is no inquiry at the Patent Office as to age, sanity, or coverture.

Corporation.

A body corporate, which is expressly (s. 117, sub-s. 1) included in the definition of "person," may be a patentee. But only as a joint patentee, as a corporation cannot apparently be an inventor; but, *semble*, a body corporate may be an applicant under sect. 103 (*h*).

Importers.

As to communications from abroad, and the position of importers, see note to s. 5, sub-s. (2).

Persons possibly incapacited. Sovereign. Clergymen. Alien enemy.

The only persons as to whose capacity there still appears to be some doubt are the Sovereign, who cannot make a grant to herself (*i*); a beneficed clergyman, under the provisions of 1 & 2 Vict. c. 106, ss. 28—30 (*k*); and perhaps an alien enemy. This last point was raised in *Bloxam* v. *Elsee* (*l*), but not decided,—the patent being held invalid upon another ground. It has been doubted, says Webster (*m*), referring to this case, whether letters patent, taken out on a secret trust to be held for the benefit of a real inventor, who was an alien enemy, were void or not. To hold that such a trust could not exist would appear contrary to the spirit and policy of the patent law, in recognising communications from foreigners as good subject-matters for letters patent; but no action could be maintained by such alien, or by the trustee on his behalf, on any contract, on the ground that the resulting moneys might be employed against the country (*n*).

Query, whether alien enemy can be patentee.

(*f*) See s. 99, and *Cheavin* v. *Walker*, 1877, per Bacon V.-C., L. R. 5 Ch. D. 858.

(*g*) See s. 99.

(*h*) *Re Carez*, 1889, per Webster, A.-G., 6 P. O. R. 552.

(*i*) Hindmarch, p. 34. But see sect. 44, sub-s. 1, below, at p. 497, where it is provided that certain inventions may be assigned to the Secretary of State for War on behalf of her Majesty.

(*k*) *Hall* v. *Franklin*, 1838, 3 M. & W. 259. It may be doubtful whether the exercise of a patent privilege by a *beneficed clergyman* would not be a trading within the meaning of the statute, and therefore prohibited by that Act. And if that be so, it may be questionable whether the grant of a patent privilege to such a clergyman would not be void, because the Queen's intent, namely, that the patentee should derive a profit from the exercise of the privilege, cannot take effect: Hindmarch, p. 35.

(*l*) 1825-27, 6 B. & C. at p. 178; 9 D. & R. 224.

(*m*) Letters Patent for Inventions, p. 23.

(*n*) See foot-note, p. 23, *ibid.* Also 1 Web. P. C. p. 418 (note).

A member of an official commission or committee cannot take out a patent for the subject-matter of their official investigation, or for the results of such investigation, embodied in an official report to the public authorities (*o*). Such a report belongs absolutely to the State. "The consideration for every patent is the communication of useful information to the public. What consideration is there when the information is already the property of the State?" (*p*). **Sect. 4.** Member of official commission, when disqualified.

Probably no official in the Patent Office would be allowed to apply for or hold any interest in a patent. Official in Patent Office.

4 *Whether a British subject or not.*—An *alien amy* (a) resident in this country, or (b) resident abroad, may obtain a patent (*q*). Aliens.

The dictum of Lord Cairns, C., however, in *Re Wirth's Patent* (*r*), that a patent might be granted to an alien *resident abroad for an invention communicated to him* by another alien, also resident abroad, is no longer an accurate statement of the law, as Form A1, Patents Rules, 1890 (*s*), contemplates a resident applicant only in such cases.

5 *Joint application.*—For form of application, see Patents Rules, 1890, Form A, or Form A1, pp. 737, 738. Joint applicants.

This part of the sub-section is declaratory of the existing law.

6 *Joint grantees.*—As to joint grantees, see Chap. X., pp. 192 *et seq.*; form of grant, pp. 533, 534. Joint grantees.

Where a patent for inventions is granted to two or more persons in the usual form, each one may use the invention without the consent of the others, and without being liable to account to them for the profits made by such use (*t*).

The power of one of several co-grantees of letters patent to grant a valid licence without the consent of the others probably depends upon the authority conferred by the granting and prohibitory clauses. Where the grant is, as in *Mathers* v. *Green* (*t*), to A., B., and C., their executors, administrators, and assigns, "that they, by themselves . . . . . and *such others as they may agree with*, and no others, may use the invention," then, unless the effect of these words is modified by the prohibitory clause, it would seem that none of the co-grantees could grant a licence without the concurrence of all the others. In *Mathers* v. *Green* (*u*) Lord Romilly held that one of several co-grantees Powers of co-grantees.

(*o*) *Patterson* v. *Gas Light and Coke Co.*, 1876-77, L. R. 2 Ch. D. 833; L. R. 3 A. C. 239.

(*p*) *S. C.*, L. R. 2 Ch. D., per James, L. J., at p. 833.

(*q*) *Beard* v. *Egerton*, 1846, 3 C. B. 97; *Chappell* v. *Purday*, 1845, 14 M. & W. 318.

(*r*) 1879, 12 Ch. D. at p. 304.

(*s*) *Infra*, p. 738.

(*t*) *Mathers* v. *Green*, 1865-66, L. R. 1 Ch. 29, per Lord Cranworth, L. C., reversing the decision of Lord Romilly, M. R. Cp. also *Powell* v. *Head*, 1879, L. R. 12 Ch. D., per Jessel, M. R., at p. 690. See also p. 193, note (*t*).

(*u*) 34 Beav. 170.

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would be bound to account to the others for royalties received from a licensee. This point was not judicially reviewed on the appeal.

7 Patents are now frequently granted to joint applicants where some only are inventors as here provided. In this way a capitalist or other person who has assisted the inventor obtains an interest in, and control over, the invention from the date of application.

Application and specification.

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form[1] as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.[2]

Declaration.

(2.) An application must contain a declaration[3] to the effect that the applicant is in possession of an invention, whereof he or, in the case of a joint application, one or more of the applicants claims or claim to be the true and first inventor or inventors,[4] and for which he or they desires or desire to obtain a patent; and must be accompanied[5] by either a provisional or complete specification.

Specification.

Act 1885, s. 2. 5 & 6 Will. 4, c. 62.

The declaration may be either a statutory declaration, under the Statutory Declarations Act, 1835,[6] or not, as may be from time to time prescribed.

(3.) A provisional specification must describe the nature of the invention,[7] and be accompanied by drawings, if required.[8]

(4.) A complete specification, whether left on application or subsequently,[9] must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed,[10] and must be accompanied by drawings, if required.[8]

Act 1886, s. 2. The same drawings may accompany both specifications.

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification,

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(5.) A specification, whether provisional or complete, must commence with the title,[11] and in the case of a complete specification must end with a distinct statement[12] of the invention claimed.[13]

1 *Such other form.*—See Patents Rules, 1890, r. 5, &c., p. 560, and Forms A, A1, A2, *ib.* pp. 537 *et seq.*

The application must be signed by applicant. Patents Rules, 1890, r. 8, p. 561.

2 *Prescribed manner.*—See Patents Rules, 1890, *infra*, pp. 562 *et seq.*

Applications by post, sect. 97, sub-sect. (1), p. 511.

Proof of delivery through post, sect. 97, sub-sect. (2), p. 511.

3 *A declaration.*—For form of declaration, see Patents Rules, 1890, r. 6 (3), and note thereto, p. 561; also Forms *infra*, pp. 537—539.

By 47 & 48 Vict. c. 62, s. 9, a statutory declaration in connection with an application for a patent was exempted from the stamp duty of 2*s.* 6*d.*, chargeable on statutory declarations under the Stamp Act, 1870.

For declaration by representative of deceased inventor, sect. 34, p. 491.

For declaration on behalf of infant, lunatic, &c., sect. 99, p. 512.

4 *True and first inventor.*—The definition of invention under the present Act is the same as it was under the Statute of Monopolies. See sect. 46, *infra*, p. 501.

Meaning of "true and first inventor."

The best general interpretation of the words "true and first inventor," is that given by Lord Lyndhurst, C., in *The Household Co.* v. *Neilson* (*y*):—

An inventor who first communicates invention to public.

"If the invention is in use at the time the grant is granted the man cannot have a patent, although he is the original inventor: if it is not in use he cannot obtain a patent if he is not the original inventor. He is not called the inventor who has in his closet invented it but who does not communicate it (*z*); the first person who discloses that invention to the public is considered as the inventor. The party must be *an* inventor: you need not say *the* inventor, because another may have invented and concealed it; but in addition to his being an inventor others must not use the invention at the time of the patent." The cases which illustrate this point turn chiefly on confidential and experimental user, which are considered above (*a*).

First importer.

By the common law (*b*), affirmed by the Statute of Monopolies,

(*y*) 1843, 1 Web. P. C. 719.

(*z*) Cp. *Dollond's Patent*, 1776, 1 Web. P. C. 43.

(*a*) Pages 223 *et seq.*

(*b*) *Hasting's Patent*, 1567, 1 Web. P. C. 6; *Matthey's Patent*, Eliz., 1 Web. P. C. 6; *Humphrey's Patent*, 1 Web. P. C. 7; *Darcy* v. *Allin*, 1602, 1 Web. P. C. 6.

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Importers.

and a series of judicial decisions (*c*), a patent might be granted to the first importer into this realm of a foreign invention. The words "within the realm" were not, however, reproduced in sect. 5, sub-s. (2), of the Patents, &c. Act, 1883; and as the form of application originally prescribed by the Act (*d*), drew no distinction between an original and a communicated invention, it seemed as if the right of the first importer of an invention from abroad to obtain a patent in respect of it had implicitly been taken away, and that a person taking out a patent, and making a declaration as required by this sub-section, that he was a true and first inventor, when in truth he was only the importer of a communicated invention, made a false suggestion, which, according to the dictum of Wood, V.-C., in *Milligan* v. *Marsh* (*e*), would avoid the grant. The Patents Rules of 1883, however, gave a form specially applicable to communications from abroad. There is also the definition of an invention given in the present Act (*f*), which defines an invention to be any manner of new manufacture, the subject-matter, and grant of privilege within the meaning of sect. 6 of Statute of Monopolies. Many applications are now made by agents as importers, under Form A1.

Another difficulty, however, remains.

The Patents Rules, 1890, r. 6, provide that "an application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the principal Act *shall be made either in the Form A or in the Form A1 set forth in the second schedule hereto, as the case may be.*" Form A contains a declaration that the applicant is "the true and first inventor" of the subject-matter in respect of which a patent is claimed. Form A1 deals with communicated inventions. Suppose that a person in possession of a communicated invention uses Form A instead of Form A1, is the patent which he obtains liable to be avoided as containing a false suggestion? In the recent case *Re Avery's Patent* (*g*); Stirling, J., appears to have considered that such a patent would be valid; but the point has not been expressly decided.

Re Avery's Patent.

Rule as to communications not

A communication made in England by one British subject to another British subject cannot be patented by the receiver of the communi-

(*c*) *Edgeberry* v. *Stephens*, 1 Web. P. C. 35; *Walton* v. *Bateman*, 1842, 1 Web. P. C. 615; *Beard* v. *Egerton*, 1846, 3 C. B. 97; *Nickels* v. *Ross*, 1849, 8 C. B. 679; *In re Lamenaude's Patent*, 1850, 2 Web. P. C. 169; *Steedman* v. *Marsh*, 1856, 2 Jur. N. S. 391; *Marsden* v. *Saville St. &c. Co.*, 1878, per Jessel, M. R., 3 Ex. D. 203, 205.

(*d*) Form A, *infra*, p. 737.

(*e*) 1856, 2 Jur. N. S. 1083. Cp. also, *Renard* v. *Levinstein*, 1864-65, 10 L. T. N. S. 177; *Plimpton* v. *Malcolmson*, 1876, L. R. 3 Ch. D. at p. 555, per Jessel, M. R. Scotland is "within the realm" in the sense of the 6th section of the Statute of Monopolies.

(*f*) Sect. 46.

(*g*) 1887, 4 P. O. R. 163; 36 Ch. D. 307, 318, 324.

cation, so as to make the receiver the true and first inventor within the meaning of the patent laws (*h*).

As to fraud of importer, see *Edmund's Patent*, 1886, Griffin, P. C. 281, and p. 179.

applicable to communications in this country.

Fraud of importer.

5 *Must be accompanied by, &c.:—*

For origin and development of specification, see Chap. VIII. sect. 1, p. 83.

Forms of specifications, Appendix, p. 759.

As to relative advantages and disadvantages of leaving complete specification in first instance, see Chap. VI. p. 71.

Publication of specifications, sect. 13, p. 451.

Indexes of, sect. 40, p. 495; sect. 101, sub-sect. (1), p. 513.

6 *Statutory Declarations Act*, 1835.—5 & 6 Will. IV. c. 62. See this statute in Appendix, *infra*, p. 636.

Sect. 11 of this statute was repealed by sect. 113 of the Act of 1883. See pp. 522, 556.

Before the Statutory Declarations Act, 1835 (5 & 6 Will. IV. c. 62), s. 11, the application (then a *petition*) for letters patent was verified by an *affidavit* sworn before a master, or a master extraordinary, in Chancery. "The solemn declaration," introduced by the Statutory Declarations Act, was quite distinct from the *petition* (*i*), but afterwards formed *part of the application* (*k*).

There is now no *statutory* declaration in an application for a patent. It is a simple declaration. But see Patents Rules, 1890, rr. 24—29, as to applications under International and Colonial Arrangements.

7 *A provisional specification, &c.:—*

As to essentials of provisional, see Chap. VIII. sect. 3, p. 95.

Reference to examiner, sect. 6, p. 436.

Amendment of sect. 7, sub-sect. (1), p. 438. Chap. VIII. sect. 5, p. 145.

Comparison of, with complete, sect. 9, sub-sect. (1), p. 441.

Variance between provisional and complete, sect. 11, sub-sect. (1), p. 444.

Chap. VIII. sect. 4, sub-sect. (1), p. 97.

8 *Drawings.*—For the rules as to drawings, and for the existing regulations as to size, paper, quality of ink, scale, &c., see Patents Rules, 1890, rr. 30—33, pp. 571, 572.

Drawings.

The words *if required* are new, the use of drawings having formerly

(*h*) *Marsden* v. *Saville St. &c. Co.*, 1878, per Jessel, M. R., 3 Ex. D. 204.

(*i*) See also forms under Act of 1852, Appendix p. 665.

(*k*) See *infra*, p. 666. Cp. also, Patents Rules, 1890, r. 6, p. 560.

Sect. 5. been permissive, not compulsory (*l*), and mean if required by the Comptroller-General.

A specification may consist simply of a drawing, and a description of it, provided that the invention is distinctly described and claimed (*m*).

Subject to this proviso, drawings are taken to be part of the specification (*n*).

9 *Whether left on application or subsequently.*—See Chap. VI. pp. 70 *et seq.*

10 *Complete specification* :—

Reference to examiner, sect. 9, p. 441.
Time for leaving, sects. 8, 9, pp. 440, 441.
Acceptance of, sect. 9, sub-sect. 4, p. 442.
Comparison with provisional, sect. 9, sub-sect. 1, p. 441.
Protection under, sect. 15, p. 453.
Amendment of, sect. 18, p. 455; and Chap. VIII. sect. 5, p. 434.
Transmission of copies of, sect. 100, p. 512.
Board of Trade may require duplicates of, sect. 101, sub-sect. 1 (c), p. 513.
Forms of, Patents Rules, 1890, p. 740; and Forms, p. 759.

This sub-section is declaratory of the common law.

Nature of complete specification.

While an exhaustive definition of the words "must particularly describe and ascertain" falls beyond the scope of this note, it may be possible to indicate with general accuracy the *tests of sufficiency* which the Courts have from time to time applied in the construction of specifications:

They are—Does the specification contain a full and *bonâ fide* disclosure of all material facts and details within the knowledge of the patentee at the time of specifying? (*o*).

And—Is the description of the invention sufficiently accurate to enable a careful and competent workman to make the invention with-

(*l*) *Boulton* v. *Bull*, 1795, 2 H. Bl. 481; per Buller, J.; *Ex parte Fox*, 1812, 1 Web. P. C. 431, per Lord Eldon; *Bloxam* v. *Elsee*, 1825, 1 C. & P. 564, per Abbott, C. J.

(*m*) *Brunton* v. *Hawkes*, 1820, 1 Carp. P. C. 410 per Abbott, C. J.; *Foxwell* v. *Bostock*, 1864, 10 L. T. N. S. 146, per Lord Westbury, L. C.; *Poupard* v. *Fardell*, 1869, 18 W. R. 129, per Malins, V.-C., overruling *Ex parte Fox*. *Provided that, &c.*—*Macfarlane* v. *Price*, 1816, 1 Web. P. C. 74; *Fairbairn* v. *Household*, 1886, 3 P. O. R. 266. See also *supra*, p. 107.

(*n*) *Williams* v. *Brodie*, cited in *R.* v. *Arkwright*, 1785, 1 Web. P. C. 71; *Hastings* v. *Brown*, 1853, 1 E. & B. 454; *Morgan* v. *Seaward*, 1836, 1 Web. P. C. 173; *Morton* v. *Middleton*, 1863, 1 Cr. & S. 3rd Ser. 722-24; *Daw* v. *Eley*, 1867, L. R. 3 Eq. 500, n.; 14 W. R. 126.

(*o*) *Full and bonâ fide*—*Cartwright* v. *Eamer*, 1800, cited 14 Ves. 131, 136, per Lord Eldon; *R.* v. *Arkwright*, 1785, 1 Web. P. C. 66, per Buller, J.; *Bovill* v. *Moore*, 1815-16, Dav. P. C. 361, per Gibbs, C. J.; *Sturtz* v. *De la Rue*, 1828, 5 Rus. 324, per Lord Lyndhurst, L. C.; *Coles* v. *Baylis*, 1886, 3 P. O. R. 180, per Bacon, V.-C.

Within the knowledge of the patentee at the time of specifying—*Crossley* v. *Beverley*, 1829, 9 B. & C. 64, per Bayley, J.

out any further aid than that which his practical knowledge and the specification afford him? (*p*).

For a fuller discussion of this subject, see Chap. VIII. sect. 4 (2), p. 118.

11 *The title.*—As to the title generally, its nature, variance between title and specification, and amendment of, see Chap. VIII. sect. 2, p. 89.

Report of examiner upon title, sect. 7, sub-sect. 1, p. 438.

Comptroller may refuse application where title insufficient, *ibid.* p. 438.

Nature of title.

The title must express correctly and concisely the subject-matter of the invention; and ought to be neither too narrow to include the whole invention, nor so wide that it includes more than the patentee has invented.

Variance between title and specification.

The introduction of the provisional specification, and the power to require amendments, now conferred upon the comptroller-general, have made the old cases as to variance between the title and the specification of less importance; but a summary of the law will be found above, at p. 91, to which the reader is referred.

Meaning of "distinct statement."

12 *A distinct statement.*—"Distinct" means independently of and apart from the mere description of the nature of the invention, and of the way in which it is to be carried into effect (*q*).

13 *The claim.*—The important subject of claims is fully dealt with in Chap. VIII. sect. 4 (4), p. 97.

The claim.

"The object of a claim is, to restrict and cut down what might be suggested as the claim made by the previous part of the description, so as to show what it does consist of, and to prevent the patent from being defeated in consequence of words being used which might lead to the inference that something which was not intended to be claimed was claimed, and then the patent being defeated by there being included in the previous part of the specification that which was not new but old" (*r*).

Object of claim.

"It is not the function of a provisional specification to claim anything. The claim is, in point of fact, a disclaimer: it shows what parts, and what parts only, of the whole invention you mean to protect by your patent" (*s*).

(*p*) Cp. *Cartwright* v. *Eamer*, *ubi supra*; *Bloxam* v. *Elsee*, 1825-27, 1 C. & P. 558, per Abbott, C. J.; *Plimpton* v. *Malcomson*, 1875, L. R. 3 Ch. D. 568, per Jessel, M. R.; *Bray* v. *Gardner*, 1887, 4 P. O. R. 406, per Kekewich, J.; *Edison* v. *Woodhouse*, 1887, 4 P. O. R. 92, 107, 108.

(*q*) *Siddell* v. *Vickers*, 1888, 5 P. O. R. 428.

(*r*) *Jackson* v. *Wolstenholmes*, 1884, 1 P. O. R. 108, per Cotton, L. J.

(*s*) *Lucas* v. *Miller*, 1885, 2 P. O. R. 159, per Kay, J.

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"The office of the claim is to protect the patentee from the danger of being supposed to make claims beyond those which he elects to make, and it must therefore limit his patent rights to what it fairly embraces" (*t*).

Sect. 5, sub-s. 5, directory merely.

A further question arises as to the effect of nonconformity to the directions in sect. 5, sub-s. (5).

This matter is dealt with by Cotton, L. J., in *Siddell* v. *Vickers* (*u*): "There is nothing in the Act which says that if the complete specification does not contain that 'distinct statement' the patent shall be bad. There are things in sect. 5 the neglect of which it can hardly be said will make the patent bad. It may be the neglect to comply with some of these requisites will make the patent bad, not because there is any enactment to that effect, but because, according to law, the specification must so describe the invention that it can be known what it is, and that the public can know how that invention is to be carried into operation." His lordship then points out that any objection on that ground would now require to be taken under sect. 26, sub-s. (3), (*x*), and adds, "But, in my opinion, what is here required is apparent on the face of the specification, and whether the Act is complied with or not, it must be considered as a mere direction—a matter to be attended to by the comptroller or law officer when the matter comes before him; and if they are satisfied, unless independently of this provision the specification is so indefinite as to make the patent bad, the mere fact that there is not a compliance with this, or a proper compliance with other provisions here, will not of itself, because sect. 5 is not obeyed, make the patent bad, though it may be that the law officer might require it to be altered" (*y*).

Reference of application to examiner.

6. The comptroller[1] shall refer every application to an examiner,[2] who shall ascertain and report[3] to the comptroller whether the nature of the invention has been fairly described,[4] and the application, specification, and drawings (if any) have been prepared in the prescribed manner,[5] and the title[6] sufficiently indicates the subject-matter of the invention.

1 *The comptroller* :—
This is the first mention of the comptroller in the Act.

(*t*) *Easterbrook* v. *Great Western Rail. Co.*, 1885, 2 P. O. R. 208, per Wills, J.

(*u*) 1888, 5 P. O. R. at p. 428.

(*x*) See p. 474.

(*y*) Cp. Fry, L. J., *S. C.*, at p. 433.

2 *The examiners.*—As to examiners generally, see Chap. V. sect. 3, p. 60.

Appointment of, sect. 83, sub-s. (1), p. 503.

Reference of specifications to, sect. 9, sub-s. (1), p. 441.

Reports by, sects. 7—9, sub-s. 2, pp. 439—441.

3 *Reports of examiners.*—These reports are private, and are only liable to production under sect. 9, sub-s. (5), p. 442.

The examiner has to report on the following points:—

Is the nature of the invention fairly described?

Have the application and specification, or specifications and drawings, if any, been prepared in the prescribed manner?

Does the title sufficiently indicate the subject-matter of the invention?

Is more than one invention claimed?

And where there is a provisional specification left in the first instance, the examiner has to report on the second reference to him with the complete specification, whether the complete describes substantially the same invention as the provisional specification.

4 *Fairly described.*—See note *supra*, sect. 5, sub-s. (4).

5 *Prescribed manner.*—Cp. Patents Rules, 1890, pp. 737 *et seq.*

6 *The title.*—See note *supra*, sect. 5, sub-s. (5). The provisional specification "must describe the nature of the invention." It is now sufficient for the title to indicate its subject-matter.

As to what may be subject-matter of invention, see Chap. IV. p. 16.

Power for comptroller to refuse application or require amendment. Repealed. Act 1888, s. 2.

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

(2.) *Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

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

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

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

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

Act 1888, s. 2.

Power of comptroller to refuse application or require amendment.

"7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention,[1] the comptroller may refuse to accept the application,[2] or require that the application, specification, or drawings be amended before he proceeds with the application;[3] 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.

Appeal to law officer.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.[4]

Hearing by law officer.

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

Notice of acceptance.

"(4.) The comptroller shall, when an application has been accepted, give notice[5] thereof to the applicant.

Rival applications.

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed,[6] another application for a patent is made, accompanied by a specification bearing the same or similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."[7]

1 See note to sect. 6, *supra*.

2 Here the words "the comptroller may refuse to accept the application," and the last clause of the sub-section, are new.

3 *The comptroller may require that the application, &c., be amended.*—See Forms of Letters by Comptroller, *infra*, p. 750.

Grounds on which comptroller may require amendment.

The grounds on which the comptroller may require amendment are—that the nature of the invention is not fairly described; that the application, specification, &c., have not been prepared in the prescribed manner; or that the title does not sufficiently indicate the subject-matter of the invention.

He has no authority to refuse an application, or to require amendment, because the subject-matter is not useful, or not novel, or impracticable.

Scope of examiner's preliminary duty.

There has not been, as yet, any judicial construction of the words "if the examiner reports that *the nature of the invention is not fairly described;*" and the precise scope of the examiner's preliminary duty is therefore uncertain.

But it seems improbable that the Legislature intended anything more than that the examiner should ascertain and report whether the specification *on the face of it* fairly describes the invention. The most absurd invention would be passed by an examiner, provided that the inventor's meaning were intelligible. The decision of Sir Richard Webster, A.-G., in *Brown's Patent* (*p*), lends colour to this view of the character of the examiner's duty.

As to voluntary amendment by the patentee, see notes to sect. 18, p. 455.

4 *The law officer.*—This is the first mention of the law officer in the Act.

As to definition of law officer, sect. 117, sub-sect. (1), p. 525.

Appeals to, against refusal of comptroller-general to accept complete specification, sect. 9, sub-sects. (2, 3), p. 441.

Appeals to, on opposition, sect. 11, sub-sects. (2, 3), pp. 444, 445.

Appeals in regard to amendments of specifications, sect. 18, sub-sects. (3—7), p. 456.

Costs in proceeding before, sect. 38, pp. 492, 493.

Power to examine witnesses on oath, *ibid.*

Power to make rules, *ibid.*

Power to summon expert, *ibid.*

The appeal to the law officer is new.

See "Rules regulating the Practice and Procedure on Appeals to the Law Officers," and notes thereon, *infra*, Appendix, p. 589.

5. *Notice of acceptance.*—See form of such notice, *infra*, p. 758.

(*p*) 1887, Griffin, A. P. C. at p. 2.

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The application is accompanied by a provisional or a complete specification (Patents Rules, 1890, r. 21, p. 567).

The acceptance is to be advertised in the Official Journal of the Patent Office, *ibid.*

6 *Sealing.*—As to sealing, see sects. 12, 13, pp. 449—451.
Seal of Patent Office, see sect. 84, p. 503.

7 *Rival applications.*—This sub-section amends the corresponding sub-section in the Act of 1883, in the following particulars:—(1) the report of the examiner, with regard to conflicting and pending applications, is dispensed with; (2) the comptroller's power to decline to proceed with the second application is discretionary.

Time for leaving complete specification.

8. (1.) If the applicant does not leave a complete specification with his application,[1] he may leave it at any subsequent time within nine months[2] from the date of application.[3]

Act 1885, s. 3. Extension of time.

A complete specification may be left within such extended time,[4] not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.[5]

Abandonment of application.

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.[6]

1 *Complete specification with application.*—As to leaving complete specification in first instance, see sect. 5, sub-sect. (2), and Chap. VI. p. 71.

2 *Nine months.*—Month here means calendar month: 13 & 14 Vict. c. 21, s. 4.

3 *From the date of application.*—The *day* of the date is excluded (*q*). As to other "excluded days," see sect. 98, pp. 511, 512.

4 *Extension of time.*—The extension of time for one month is readily granted by the comptroller, the general reason being experiments not completed, or desire to apply for and obtain foreign patents.

5 *Prescribed fee.*—The fee is 2*l.*, see p. 588, Fee, No. 39.

6 *Abandonment of application.*—Under the Act of 1852, it was held that the abandonment of a provisional specification did not amount to

(*q*) Cp. *Russell* v. *Ledsam*, 1845, 14 M. & W. 574, per Parke, B.; *Williams* v. *Nash*, 1859, 5 Jur. N. S. 696.

a publication of it, so as to invalidate a patent upon a subsequent application for the same invention.

Cases under Act of 1852.

On the 10th April, 1858, A. obtained provisional protection for three heads of invention, one of which was comprised in a provisional specification of the 17th March previous, which latter he thereupon abandoned, and completed his patent before the provisional specification of the 17th March had been made public by the Patent Office, under the 29th section of the Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83). It was held that there had been no such publication as would invalidate the patent (*r*).

In *Lister* v. *Norton*, under substantially the same circumstances as before, it was held that the abandonment of the first provisional specification would not avoid the patent, even if actual user during the currency of the first provisional specification can be shown (*s*).

This case opens an important question as to how long an inventor can obtain protection by filing provisionals in succession. He appears to be protected from acts of user, and under the Act of 1885, s. 4, the specifications accompanying an abandoned application are never exposed to public inspection.

Comparison of provisional and complete specification.

9. (1.) Where a complete specification is left after a provisional specification,[1] the comptroller shall refer both specifications to an examiner[2] for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner,[3] and whether the invention particularly described in the complete specification is substantially the same[4] as that which is described in the provisional specification.[5]

(2.) If the examiner reports[6] that the conditions hereinbefore contained have not been complied with, the comptroller may refuse[7] to accept the complete specification unless and until the same shall have been amended to his satisfaction;[8] but any such refusal shall be subject to appeal to the law officer.[9]

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

(*r*) *Oxley* v. *Holden*, 1860, 8 C. B. N. S. p. 708, per Erle, C. J.

(*s*) *Lister* v. *Norton*, 1886, 3 P. O. R. 200.

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(4.) Unless a complete specification is accepted[10] within twelve months from the date of application,[11] then (save in the case of an appeal[12] having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.[13]

Act 1885, s. 3.

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow.[14]

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding [*other than an appeal to the law officer under this Act*], unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.[15]

Repealed. Act 1888, s. 3.

1 *Complete left after provisional.*—Cp. sect. 5, sub-s. 2, and Chap. VI. p. 71.

2 *Examiner.*—See note to sect. 6; also Chap. V. sect. 3, p. 60.

3 *Whether the complete specification has been prepared in the prescribed manner.*—Cp. Patents Rules, 1890, rr. 30—33, p. 570.

Effect of variance under present Act.

4 *Substantially the same.*—From the language of Cotton, L. J., in *Siddell* v. *Vickers* (*t*), quoted under sect. 5, sub-s. (5), it appears that variance between the complete and the provisional specifications derives no new significance from this Act, and is fatal, if at all, in virtue of the previous law.

The general effect of the cases, bearing upon the point of variance, may be stated in this way. There is no variance if the difference between the two specifications is merely in a matter of detail, or if the complete specification is the legitimate development of, and contains nothing that is not foreshadowed in, the provisional (*u*).

(*t*) 1888, 5 P. O. R. 428.

(*u*) *Lucas* v. *Miller*, 1885, 2 P. O. R. 155; *Horrocks* v. *Stubbs*, 1886, 3 P. O. R. 233, 236; *Watling* v. *Stevens*, 1886, 3 P. O. R. 37, 41, 147, 152; *Moseley* v. *Victoria Rubber Co.*, 1887, 4 P. O. R. 241, 248; *Anglo-American Brush* v. *Crompton*, 1887, 4 P. O. R. 27; and 1888, 5 P. O. R. 398; *Hutchison* v. *Patullo*, 1887-8, 4 P. O. R. 332; and 5 P. O. R. 351; *Woodward* v. *Sansum*, 1887, 4 P. O. R. 178; *Siddell* v. *Vickers*, 1888, 5 P. O. R. 81, 98.

On the whole subject of variance between the specifications, see Chap. VIII. p. 97.

5 The language of the statute seems a little at fault here; it should run "As the invention, the general nature of which is described," &c.

6 *Examiner's report.*—See note to sect. 6.

7 *Refusal of comptroller.*—See Letters from Comptroller, pp. 752, 753.

8 *Unless and until the same shall have been amended.*—There must be no variance between the amended complete specification and the provisional (*x*).

9 *Appeal to law officer :—*
For rules regulating such appeals, see *infra*, p. 589.
See also note to sect. 7, sub-s. 2.

10 *Acceptance of complete specification.*—The Act does not make the acceptance of a complete specification conclusive as to its sufficiency; and insufficiency of the specification is a ground for the revocation of a patent now as before the Act of 1883 (*y*).

Acceptance of complete specification not conclusive of sufficiency.

11 *Date of application.*—The day of the date is excluded, see note to sect. 8, sub-s. 2.

12 *Notice of appeal.*—Form T., *infra*, p. 749.

13 *Application void.*—As to abandonment of application and its effect, see note to sect. 8, sub-s. 2.
A list of abandoned applications is published weekly in the "Illustrated Official Journal."

14 *Comptroller may allow.*—See Letters from Comptroller, *infra*, p. 756.
Fee, No. 40, p. 588.

15 *Reports of examiners.*—These reports are put into the *file* when the patent is sealed and the grant entered on the register. But they are not open to public inspection.
As to *inspection* generally, see Chap. XIV. p. 305.
Unless the Court . . . . shall certify.—No such order appears to have been made.

(*x*) *Goulard and Gibbs' Patent*, 1888, 5 P. O. R. at p. 532.
(*y*) Cp. *infra*, sect. 26, sub-s. (3), and *Goulard and Gibbs' Patent*, *supra*, where a patent was revoked on this ground. See a summary of the conflicting opinions on this point in Morris's Patents Conveyancing, pp. 20-21, and p. 21, n. (*p*).

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Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance;[1] and the application and specification or specifications with the drawings (if any) shall be open to public inspection.[2]

1 *Advertisements of acceptance* of complete specifications appear weekly in the "Illustrated Official Journal," see Patents Rules, 1890, r. 21, p. 567.

2 *Inspection.*—Until the specifications are printed only the duplicate copies can be seen at the Patent Office.

It takes usually about three weeks after acceptance of complete specification before the printed specifications are published.

Cp. Patents Rules 1890, r. 22, p. 567.

Opposition to grant of patent.

11. (1.) Any person[1] may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice[2] at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him,[3] or from a person of whom he is the legal representative,[4] or on the ground that the invention has been patented in this country on an application of prior date[5] [*or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application*],

Repealed. Act 1888, s. 4.

or on the ground 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,

Act 1888, s. 4.

but on no other ground.[6]

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant,[7] and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case,[8] but subject to appeal to the law officer.[9]

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(3.) The law officer shall, if required, hear the applicant [10] and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant,[11] and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert,[12] who shall be paid such remuneration as the law officer, with the consent of the Treasury,[13] shall appoint.

Opposition under Act of 1883.

Under the present Act there may be opposition (1) to the grant of a patent, sect. 11, sub-s. (1), and Chap. IX., p. 167; (2) to the amendment of a specification, sect. 18, sub-s. (2), and Chap. VIII., p. 145; and (3) to the extension of the term of a patent, sect. 25, sub-s. (2), and Chap. XVIII., p. 386.

The law relating to each of these subjects is fully discussed in the several chapters above referred to.

For the history of oppositions to the grant of letters patent before and under the Act of 1852, see p. 650, n. (*b*).

We shall only mention here those cases which bear upon the construction of the words of the section.

1 *Any person.*—As to procedure on oppositions generally, see Patents Rules, 1890, r. 34, p. 573; and Law Officers' Rules, *infra*, p. 589.

2 *Notice of opposition.*—Form D., p. 741.

Who entitled to oppose.

Opposition to the grant of a patent, or to the amendment of a specification, can be offered by such persons only as in the law officer's opinion are "entitled to be heard" upon the subject: see sect. 11, sub-s. (3), and sect. 18, sub-s. (4); it would seem, therefore, that the twelfth section of the Patent Law Amendment Act, 1852, limiting opposition to the grant of a patent to persons "having an interest in opposing the grant of letters patent," is still substantially in force. The limitation upon opposition to the amendment of a specification is new. Cp. 5 & 6 Will. IV. c. 83, s. 1, p. 637.

See consideration of cases, at p. 175.

There is no restriction imposed by sect. 25, sub-s. (2) upon the persons who may enter a caveat against the extension of letters patent.

Grounds of opposition.

Applicant having ob-

3 *The applicant having obtained the invention from him.*—Invention here means the *entire* invention.

Where *part* of an invention only was communicated by the opponent

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tained invention from opponent.

to the applicant, the usual practice has been to seal a patent to them *jointly* (*z*).

Under sect. 11, sub-s. (1), the comptroller-general or the law officer cannot inquire into the circumstances under which an invention was *imported* into this country, thus, whether there was fraud on the part of the person making the communication from abroad (*a*).

Where fraud is imputed to an applicant, evidence in support of the charge must be filed before appeal to the law officer comes on for hearing (*b*).

Meaning of "legal representative."

4 The legal representative:

As to application by legal representative of deceased inventor, see sect. 34.

This term must probably be construed in its ordinary sense, as meaning an executor or administrator of a deceased person.

Query whether it includes a person holding a power of attorney from the alleged true and first inventor (*c*).

The *assignee* of a prior patent is not "the legal representative" of the patentee within the meaning of this sub-section (*d*).

Meaning of "patented."

5 Has been patented:

The word "patented" is construed strictly (*e*), and it appears to be necessary that the opponent should prove that a patent for *the same invention* as the applicant's has been granted.

It will not do for him to produce merely a provisional specification (*f*); but in *L'Oiseau and Pierrard* (*g*), it was held by Webster, A.-G., that for the purpose of opposition on the ground of a prior patent, it was sufficient to have complete specification accepted. That only is "patented" which the inventor has claimed.

It is immaterial that the previous patent, on which an opponent relies, has expired (*h*).

Where the applicant's invention is simply an improvement on a prior invention, the specification must state this, and a patent will be granted for the improvement only (*i*).

Where two inventions are *clearly identical*, it is no defence for an applicant to allege that his opponent has included in his complete

(*z*) *Eadie's Patent*, 1885, Griffin, P. C. 279; *Garthwaite's Patent*, 1886, Griffin, P. C. 284.

(*a*) *Edmunds' Patent*, 1886, Griffin, P. C. 281.

(*b*) *Huth's Patent*, 1884, Griffin, P. C. 292.

(*c*) *Edmunds' Patent*, 1886, Griffin, P. C. 282.

(*d*) *Adolph Spiel's Patent*, 1888, 5 P. C. R. 282.

(*e*) *Cumming's Patent*, 1884, Griffin, P. C. 277; *Stubbs' Patent*, 1884, Griffin, P. C. 298; *Welch's Patent*, 1884, Griffin, P. C. 301.

(*f*) *Bailey's Patent*, 1884, Griffin, P. C. 269.

(*g*) 1887, Griffin, A. P. C. 36; cp. *Dundon's Patent*, 1885, Griffin, P. C. 278.

(*h*) *Lancaster's Patent*, 1884, Griffin, P. C. 294.

(*i*) *Hoskins' Patent*, 1884, Griffin, P. C. 291.

specification subject-matter which was not in the provisional. This is an objection to the validity of the prior patent, and cannot be raised before the comptroller-general or the law officer (*k*).

6 *Or on the ground that the complete specification describes, &c.*—This clause, which was enacted by the Patents Act, 1888, sect. 4, meets and resolves a doubt expressed by Sir Richard Webster, A.-G., in *Newman's Patent* (*l*).

Act of 1888, s. 4.

It was enacted to prevent fraud arising from a prior applicant taking advantage of information conveyed by the specification of a later applicant.

7 *Notice of opposition to applicant.*—As to procedure, see Patents Rules, 1890, rr. 34 *et seq.*, p. 573.

8 *Decide on the case.*—Where the comptroller-general requires an amendment, but does not, in his decision, settle its terms, the time for appealing dates from the day of forwarding to the opponent a copy of the amendment approved by him (*m*).

9 *Subject to appeal.*—An appeal to the law officer is a re-hearing: but, apart from special circumstances, costs follow the event (*n*).

Practice where applicant failed to appear.

10 *Hear the applicant.*—In the matter of *Ainsworth's Patent* (*o*), where the applicant failed to appear at the appeal, Sir Richard Webster, A.-G., heard the opponent, and then reserved his decision. Prior to any decision being given, the applicant applied *ex parte* to the Attorney-General for leave to be heard, and, having satisfactorily accounted for his absence on a former occasion, was granted a fresh hearing, on condition of paying the appellant's costs of the adjournment.

Entitled to be heard.

11 *Entitled to be heard.*—See full discussion of the meaning of these words, Chap. IX., p. 175.

In the matter of *Heath and Frost's Patent* (*p*), Sir Edward Clarke, S.-G., said: "It seems to me perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. . . . It appears to me that by sect. 11 the only class of persons who are entitled to be heard in opposition before the law officer, are persons who are interested, with a real and legitimate interest, in the prior patent upon which an application is opposed; or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."

(*k*) *Green's Patent*, 1885, Griffin, P. C. 287.
(*l*) 1888, 5 P. O. R. at p. 278.
(*m*) *Chandler's Patent*, 1886, Griffin, P. C. at p. 273.
(*n*) *Stubbs' Patent*, 1884, Griffin, P. C. 298.
(*o*) 1885, Griffin, P. C. 269.
(*p*) 1886, Griffin, P. C. 290.

Sect. 11. The purchaser of a prior patent who had worked it, and had manufactured machines in accordance with it, would probably be entitled to be heard (*q*); not so a person who had merely manufactured articles under a prior patent (*r*).

In the matter of *Heath and Frost's Patent* (*s*), Sir Edward Clarke, S.-G., declined to hear a patent agent, who, acting on behalf of a client, opposed *in his own name* the grant of letters patent.

It would appear that any member of the public can oppose before the comptroller.

In *L'Oiseau and Pierrard* (*t*), however, the comptroller went into the question of interest.

Power of law officer to summon expert.

12 *Power of law officer to call in expert.*—Under the Patent Law Amendment Act, 1852, s. 8, the law officer was empowered "to call to his aid," in determining whether or not a provisional specification correctly described the nature of the invention claimed, "such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint."

As to scientific assessors in legal proceedings, see sect. 28, sub-sects. 2 and 3, p. 480; and Chap. XIV., pp. 319, 320.

13 *Treasury:*

Definition of, sect. 117, sub-sect. (1).
Direction as to fees, sect. 24.
Powers in relation to Patent Office, sect. 82, sub-sect. (1).
Powers in relation to invention used by Crown, sect. 27, sub-sect. (2).
Powers in relation to presentation of Patent Office publications, sect. 101, sub-sect 1.

Sealing of patent.

12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent[1] to be sealed with the seal of the Patent Office.[2]

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal[3] of the United Kingdom.[4]

(3.) A patent shall be sealed[5] as soon as may be, and not after the expiration of fifteen months from the date

(*q*) *Glossop's Patent*, 1884, Griffin, P. C. 286-7.
(*r*) *Bairstow's Patent*, 1888, 5 P. O. R. at p. 286.
(*s*) Griffin, *ubi sup.* at p. 288.
(*t*) 1887, Griffin, A. P. C. 36.

of application, except in the cases hereinafter mentioned, that is to say— Sect. 12.

(a) Where the sealing is delayed[6] by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.[7]

A complete specification may be left and accepted within such extended times,[8] not exceeding one month and three months respectively after the said nine and twelve months respectively, as the comptroller may on payment of the prescribed fee[9] allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Act 1885, s. 3. Extension of time for leaving and accepting complete specification and sealing.

1 *A patent.*—See Form of Patent, annotated, at pp. 533 *et seq.*

2 *Seal of Patent Office.*—See sect. 45, sub-sect. 4; seal to be judicially noticed, sect. 84.

3 *As if it were sealed with the Great Seal.*—In the case of *The East India Company* v. *Sandys* (*u*) it is laid down that "all the King's subjects are bound to take notice of the King's Great Seal." The Great Seal proves itself, and cannot be impeached (*x*).

4 *Great Seal of United Kingdom.*—By common law the Sovereign can make a gift of moveable chattels without writing. Every other grant must be by charter or letters patent under the Great Seal. Seals formerly in use.

The seal originally used for letters patent for inventions was the Great Seal of England, but after the legislative unions with Scotland and Ireland, the Great Seals of Great Britain and of the United Kingdom were respectively substituted (*y*).

For the purposes of letters patent, however, the seals of the three kingdoms were in one sense distinct (*z*).

(*u*) Skin. 225; and see sect. 84, *infra*.
(*x*) Cp. Hindmarch, 36, 37.
(*y*) Hindmarch, p. 36.
(*z*) 6 Ves. 708.

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In a petition for a patent for Ireland the words "under the Great Seal of Ireland" were inserted; in a petition for a patent in Scotland the words were "under the Seal appointed by the Treaty of Union to be kept and used in Scotland, instead of the Great Seal thereof"(*a*).

Wafer Great Seal.

The Crown Office Act, 1877, provided that a *wafer* Great Seal might be attached, instead of the Great Seal, to documents prescribed by rules made thereunder by the Lord Chancellor, the Lord Privy Seal, and one of the principal Secretaries of State, or any two of them in case of difference. Letters patent for inventions were so prescribed by rules published in the London Gazette of March 5th, 1878 (*b*).

Former practice as to time of sealing.

5 Sealing of patent:

Under the Patent Law Amendment Act, 1852, ss. 19 and 20—construed together with 16 & 17 Vict. c. 115—no letters patent were to be issued unless (a) application to seal them were made within three months from the date of the law officer's warrant, and (b) letters patent—except those issued in lieu of others lost or destroyed—were issued during the continuance of the protection conferred by the Act.

Where, however, an application to seal letters patent had been duly made, but the sealing had been delayed by a caveat, or opposition, after the expiration of the statutory protection, the Lord Chancellor might cause letters patent to be sealed at such time as he should direct.

16 & 17 Vict. c. 115, s. 6, empowered the Lord Chancellor to cause letters patent to be sealed at any time within one month after the expiry of the statutory protection, provided the delay in such sealing had arisen from accident, and not from the neglect or wilful default of the applicant.

Practice under Act of 1883.

Under the present Act letters patent must be sealed within fifteen months from the date of the application, unless:—

The sealing is delayed by an appeal to the law officer, taken at any stage—in which case the patent may be sealed at such time as the law officer may direct;

Or, the applicant dies within the fifteen months, where a patent may be granted to his legal (personal) representative at any time within twelve months from the death (*c*);

Or, the comptroller has, under the 3rd section of the Act of 1885, allowed an extended time for leaving and accepting the complete

(*a*) Webster's Letters Patent, 67, n. (*e*).

(*b*) Letters patent for the appointment of Indian judges, Colonial governors, Indian and Colonial bishops, and other matters were included in the prescribed documents, by later rules: London Gazette, Aug. 13, 1878.

(*c*) Cp. Patent Law Amendment Act, 1852, s. 21, *infra*, p. 654.

specification, in which case a further extension of four months after the said fifteen months is granted. **Sect. 12.**

6 *As to appeals in opposition cases*, see Chap. IX. p. 173.

7 *Grant to legal representatives.*—See sect. 34.

8 *A complete specification may be left and accepted, &c.*—An application for extension of time for leaving or accepting a complete specification shall be in writing, and shall state in detail in what circumstances, and upon what grounds such extension is applied for; and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary. (Patents Rules, 1890, rr. 49 and 50, pp. 576, 577.)

9 *Prescribed fee.*—These are Fees 39 and 40, see p. 588.

13. Every patent shall be[1] dated and sealed as of the day of the application: Provided that no proceedings[2] shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.[3] Date of patent.

Where an application for a patent has been abandoned, or become void,[4] the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.[4] Act 1885, s. 4. Specifications, &c. not to be published unless application accepted.

1 *Date of patent:*

The *date* of letters patent was, by 18 Hen. 6, c. 1, required, on pain of nullity, to be *the day of the delivery of the King's warrant to the Chancellor*. Former practice.

In practice, however, letters patent usually bore the date of sealing, unless the grant was opposed, in which case the Lord Chancellor might order them to be antedated (*e*).

15 & 16 Vict. c. 83, s. 23, provided that letters patent might (the Act of 18 Hen. VI. c. 1, notwithstanding), be sealed and bear date as of the day of application for the same.

Under this section the Lord Chancellor or the law officer had a limited discretion over the date of the patent, and it was sometimes

(*e*) 1 Web. P. C. 430, n. (*c*); also Webster's Letters Patent, p. 33, n.

Sect. 13. made a condition of sealing a patent that it should bear a particular date (*c*).

Act of 1883. The present Act is imperative upon this point.

As to date of patents granted under International and Colonial Arrangements, see Chap. XX. pp. 415, 416.

Restriction on proceedings. 2 *Provided that no proceedings, &c.:*

This proviso must be taken along with sect. 15.

The effect of the two sections may perhaps be accurately stated thus:

(1) No action for infringement shall be instituted unless and until a patent has been granted.

(2) Even after a patent has been granted no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

(3) Infringements committed between that date and the sealing of the patent are actionable.

3 *Rival applications:*

This proviso was inserted to meet the objectionable practice of *racing for the seal.* It was held that the Lord Chancellor could not knowingly grant two patents for the same invention. Consequently, under the Act of 1852 there were several cases in which a later applicant rushed for the seal and then opposed the grant to an earlier applicant, on the ground that a patent had already been granted to him for the same invention (*d*).

4 *Abandoned and void applications.*—The specifications are not now published. Under the Act of 1852 provisional specifications of abandoned applications were published.

PROVISIONAL PROTECTION.

Provisional protection. **14.** Where an application for a patent in respect of an invention has been accepted, the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.[1]

(*c*) Cp. *Ex parte Bates and Redgate*, 1869, L. R. 4 Ch. 580; *Ex parte Bailey*, 1872, L. R. 8 Ch. 60; *Ex parte Harrison*, 1874, L. R. 9 Ch. 632.

(*d*) Cp. *Saxby* v. *Hennett*, 1873, L. R. 8 Ex. 210; *Scott and Young, Ex parte*, 1871, L. R. 6 Ch. 274.

Sect. 14.

1 *Provisional protection:*

Provisional protection must not be confounded with the interval between the acceptance of the provisional and the filing of the complete specification.

This is a re-enactment with modifications of the 8th section of the Patent Law Amendment Act, 1852.

The provisional protection—which now extends from the date of the application to the date of sealing a patent granted thereon, instead of for six calendar months from the date of application, as formerly—merely amounts to this, that the applicant may *use* his invention during the protected period, without so *dedicating it to the public* as to avoid the patent subsequently granted to him for want of "novelty."

The words "to be granted for the same" clearly refer to the patent, and not to the application.

The last clause of the section shows conclusively that provisional protection is *merely* "protection from the consequences of use and publication."

It does not entitle the inventor to take proceedings for infringements of his invention, committed before the acceptance of the complete specification, even *after* a patent has been granted to him (*e*).

Effect of acceptance of complete specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.[1]

1 *Restrictions on proceedings.*—Infringements committed between the date of the acceptance of a complete specification and the date of sealing the patent are actionable; but proceedings cannot be taken unless and until the patent has been granted.

(*e*) Cp. *Ex parte Bates and Redgate*, 1869, L. R. 4 Ch. 577; *Ex parte Bailey*, 1872, L. R. 8 Ch. 60; *In re Henry's Patent*, 1872, L. R. 8 Ch. 167; *contra*, per Earl Cairns, L. C., *In re Dering's Patent*, 1879, L. R. 13 Ch. D. 393.

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PATENT.

Extent of patent.

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

Prior to this Act, letters patent sealed with the Great Seal of the United Kingdom extended to the Channel Islands also. Cp. 15 & 16 Vict. c. 83, s. 18.

Arrangements for the extension of the provisions of the present Act to the Channel Islands have been proposed but have not been carried into effect.

Prior to 15 & 16 Vict. c. 83, s. 18, a British patent extended to the Colonies also, if the patentee desired it.

For the old law as to the extent of letters patent, see *infra*, pp. 542, 543.

Term of patent.

17. (1.) The term limited in every patent for the duration[1] thereof shall be fourteen years[2] from its date.[3]

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee[4] fails to make the prescribed payments within the prescribed times.[5]

(3.) If, nevertheless, in any case, by accident, mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time[6] for making that payment.

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

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

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is pro-

posed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.[7] Sect. 17.

1 *Duration of patent:*

The term given by a patent commences on *the day of the date* of the letters patent.

The rule is otherwise when anything has to be done in a certain time after a given event or date. Here the time is reckoned exclusively of the day of the event or date (*f*).

2 *Fourteen years.*—Cp. 21 Jac. 1, c. 3, s. 6, *infra*, p. 628.

3 *From its date.*—The patent is dated as of the day of application; so it is really ante-dated.

As to date of patent under International and Colonial Arrangements, see Chap. XX. pp. 415, 416.

4 *The patentee* means the person who is for the time being entitled to the benefit of a patent (*g*).

5 *Prescribed payment within the prescribed times.*—For the prescribed payments and times, see the Schedule to the Act of 1883, at p. 550; and the Patents Rules, 1890, rr. 45—51, pp. 575—577.

A payment is within the prescribed time if made before midnight on the anniversary of the day of the date of the patent (*h*).

6 *Application for enlargement of time.*—For form of application, see Patents Rules, 1890, Form K., p. 745.

As to contents of application, see Patents Rules, 1890, r. 49, p. 575.

An enlargement of time is granted almost as a matter of course.

7 The patent right may be treated, in fact, as if temporarily suspended.

AMENDMENT OF SPECIFICATION.[1]

18. (1.) An applicant or a patentee[2] may, from time to time,[3] by request in writing[4] left at the Patent Office, seek leave to amend his specification,[5] including drawings forming part thereof, by way of disclaimer, correction, or explanation,[6] stating the nature of such amendment and his reasons for the same. Amendment of specification.

(*f*) *Russell* v. *Ledsam*, 1843-48, per Parke, B., 14 M. & W. at p. 582. As to computation of time for enrolment of the specification under the old law, see *Watson* v. *Pears*, 1809, 1 Web. P. C. 154, n.

(*g*) Sect. 46. For the table of renewal fees, see p. 587.

(*h*) *Williams* v. *Nash*, 1859, 28 Beav. 93.

Sect. 18.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner,[7] and at any time within one month from its first advertisement any person[8] may give notice at the Patent Office of opposition[9] to the amendment.

(3.) Where such notice is given the comptroller shall give notice[10] of the opposition to the person making the request, and shall hear and decide[11] the case subject to an appeal to the law officer.

(4.) The law officer shall, if required,[12] hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions,[13] if any, the amendment ought to be allowed.

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

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

(7.) The law officer shall, if required,[12] hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different[14] from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed,[15] except in case of fraud;[16] and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10.) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*] **Sect. 18.** Repealed. **Act 1888, s. 5.**

(10.) The foregoing provisions[17] of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending.[18] **Act 1888, s. 5.**

1 *Amendment of specifications.*—See on the whole subject, Chap. VIII. p. 145.

The true reading of sects. 18—21 was given by A. L. Smith, J., *In the matter of Hall and others*(*h*):—"Sect. 18 gives power to a patentee, when he finds out the blunder in his specification himself, to seek leave to amend his specification by way of disclaimer, correction, or explanation; and he can go *proprio motu* to the comptroller and say, 'I want to amend the blunder I have got in my specification, as regards disclaimer, correction, or explanation.' Then there are a series of sub-sections showing what the comptroller is to do, how notice is to be given, what is to be done, and how other parties may come in and object; and the last sub-section, it seems to me, is most natural . . . . that means this, that where a patentee is in litigation, he should not go behind the back of the other party and get these amendments and set himself quite right . . . . What would happen if that had remained there? After litigation has been commenced, if there had been no sect. 19, the patentee, as soon as the writ was issued, would be fixed, no matter what small technical blunder there might be in his specification. But what the Legislature says is this—and I read sect. 19 as a proviso to sect. 18—provided always, that a judge or the Court . . . . may give *liberty* to the patentee to apply at the Patent Office for leave to amend his specification by way of disclaimer." True reading of sects. 18-21.

In the same case, Cave J., said: "Nothing is said as to the proceedings which are to take place on such an application for amendment; but I think it is perfectly clear, notwithstanding the somewhat awkward language of sub-sect. 10 of sect. 18, that the procedure under sect. 18 is meant to apply to a case in which leave is given to make the application by a judge in the course of the action for the infringement of the patent (*i*).

2 *An applicant or a patentee:*

For practice under this section, see Patents Rules, 1890, r. 52, p. 577.

For definition of "patentee," see note to sect. 46; under that definition a grantee who had wholly parted with his interest in a

(*h*) 1888, 5 P. O. R. at p. 312. (*i*) *S. C.* at p. 310.

Sect. 18. patent could not, it would seem, apply, under sect. 18, sub-sect. (1), for leave to disclaim or amend any part of his specification.

3 *From time to time.*—Second disclaimers are therefore permissible, see *supra*, p. 154.

4 *By request in writing:*
Cp. sect. 97, *infra*, and Patents Rules, 1890, r. 52, p. 577.
For form of application, see Patents Rules, 1890, Form F.

5 *His specification.*—This must mean his complete specification, after acceptance, before which there is no publication from the Patent Office. Cp. sect. 10.

6 *Correction or explanation:*
The power to amend by way of correction or explanation is new.
See general note above, p. 457; also Chap. VIII. p. 154.

7 *Shall be advertised in the prescribed manner:*
Advertisement in the Official Journal of the Patent Office is required. (Patents Rules, 1890, r. 52, p. 577.)
Where an amendment is opposed, the applicant and opponent frequently agree upon modifications in the proposed amendment.
If such modifications are comparatively limited and unimportant, a second advertisement will not be required; but the Comptroller-General may order an amendment, modified to a considerable extent or in important details, to be again advertised.
Cp. *In re Van Gelder*, 1889, 6 P. O. R. 22, and *supra*, Chap. VIII. p. 152.

8 *Any person, i. e.,* "being in the opinion of the law officer entitled to be heard" (sub-sect. (4)).
This objection can only be raised *before* the law officer. Cp. note to sect. 11, sub-sect. (3), p. 445.
This limitation on the right of opposition is new.

9 *Notice of opposition, &c.:*
Cp. Patents Rules, 1890, r. 53, p. 578.
There is no limitation upon the *grounds* of opposition.

10 *The comptroller shall give notice*—For practice, see Patents Rules, 1890, r. 53, p. 578.

11 *And shall hear and decide the case.*—It has been held that the Comptroller-General may impose conditions in deciding a case under this sub-section, in spite of the curious wording of the enabling clause, which we find in sub-sect. (5) (*j*).

(*j*) *Hearson's Patent*, 1884, Griffin, 309.

The comptroller cannot, however, give costs. See *ante*, p. 156. **Sect. 18.**

12 *The law officer shall, if required, &c.*—For practice under this sub-section, see the Law Officers' Rules, *infra*, p. 589.

13 *What conditions, if any, &c.:*

Conditions of amendment being allowed.

Under 15 & 16 Vict. c. 83, s. 39, no action in respect of an infringement committed *before* a disclaimer, or memorandum of alteration, could be brought without the leave of the law officer. This proviso gave the law officer a practical power of determining the conditions on which a disclaimer should be allowed.

The law officer's leave is no longer required, but he may still effect the same object by making it a *condition* of the amendment being accepted that no action for a prior infringement shall be brought.

The considerations which guide the law officer in determining whether or not this condition shall be prescribed, are the same as those which formerly influenced him in granting or withholding leave: Had the invention been imperfect long before the disclaimer? Had there been a long prior user? Had manufacturers embarked capital in making and dealing with it? (*k*).

14 *No amendment shall be allowed, &c.:—*

The Act of 1835 struck at any disclaimer which extended *the exclusive right* originally claimed by the patentee.

The words of the present sub-section are much wider. The two inventions are now required to be merely *substantially* identical.

15 *Leave to amend, &c.:*

This is a re-enactment of a similar proviso in 15 & 16 Vict. c. 83, s. 39.

The meaning of the sub-section is this: leave to amend prevents any question being raised as to whether the person at whose instance the amendment was allowed was or was not the applicant or the patentee; it does not debar the Court from inquiring whether the amendment claims an invention substantially larger than, or different from, that claimed in the original specification.

Van Gelder's Patent, 1890, per Esher, M. R., 6 P. O. R. at p. 27. The Attorney-General cannot make a valid amendment if it is to substantially enlarge the invention, or make it a different invention. That is by virtue of sect. 18, sub-sect. (8). Sub-sect. (9) has not the effect of making that which he has done invalidly conclusive; and if

(*k*) Cp. *Harrison's Patent*, 1853, Macr. P. C. 31; *Smith's Patent*, 1855, *ibid.* 232, 234; *Tranter's Patent*, 1873, Johns. P. M. 191. For a case in which a prior infringer was compelled to compound with a patentee, see *Lucas's Patent*, 1854, Macr. P. C. 235.

Sect. 18. what he has done is invalid, by reason of sub-sect. (8), whenever anybody attempts to put in force that amendment for any purpose, the Court could say that what the Attorney-General has done has not really altered the original specification. Then the matter must be determined according to the original specification. The amendment would be held to be invalid.

16 *Except in cases of fraud.—E.g.*, where leave was given to file a disclaimer on terms refused by the patentee, and the disclaimer was subsequently filed without his consent (*l*).

17 *The foregoing provisions, &c.*—The Act of 1888, sect. 5, from which this new sub-section is taken, has settled several doubts raised by the corresponding sub-section in the Act of 1883 :—

(1) Did the words "legal proceeding in relation to a patent" apply to proceedings before the comptroller? (*m*).

(2) Did they include only actions for infringement and proceedings for revocation? (*n*).

As to the construction of sects. 18—21, see general note above, p. 457.

18 *Pending.*—This means action before judgment in the High Court of Justice. See definition of "Court," sect. 117, sub-sect. (1), and *Cropper* v. *Smith*, 28 Ch. D. per Chitty, J., at p. 151.

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

19. In an action for infringement of a patent,[1] and in a proceeding for revocation[2] of a patent, the Court or a Judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a Judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer,[3] and may direct that in the meantime the trial or hearing of the action shall be postponed.

1 *Action for infringement.*—See sect. 29, and Chap. XIV. p. 245.

2 *Procceding for revocation.*—See sect. 26, and Chap. XVI. p. 355.

3 *Disclaimer pending action.*—As to disclaimer pending action, see p. 164.

(*l*) *Re Berdan's Patent*, 1875, L. R. 20 Eq. 346.

(*m*) *Cochrane's Patent*, 1885, Griffin, P. C. 305, where the Comptroller-General answered the question in the negative.

(*n*) *Cropper* v. *Smith*, 1884, 1 P. O. R. 254; and *In re Hall and others*, 1888, 5 P. O. R. 306.

Only a power of amendment by disclaimer is given under this section. Cp. sect. 18, sub-sect. (1). **Sect. 19.**

As to the construction of the section, cp. above, at p. 457.

Where a request for leave to amend is made in pursuance of an order by the Court or a Judge, an official or verified copy of the order must be left, with the request, at the Patent Office. (Patents Rules, 1890, r. 58, p. 579.)

The judge has an absolute discretion in imposing terms under sect. 19 (*o*).

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.[1] Restriction on recovery of damages.

1 *Where an amendment by way of disclaimer, &c.*—This section, which is new, does not appear to affect the law officer's power to impose conditions under sect. 18, sub-sects. (4) (7).

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

Every amendment, &c. (sect. 21).—Cp. Patents Rules, 1890, r. 59, p. 579. The amendment is advertised in the Official Journal of the Patent Office, and in such other manner, if any, as the comptroller may direct.

COMPULSORY LICENSES.[1]

22. If on the petition of any person interested[2] it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms— Power for Board to order grant of licenses.

(a) The patent is not being worked[3] in the United Kingdom; or

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

(*o*) *Lang* v. *Whitecross Co.*, 1889, 6 P. O. R. 570.

Sect. 22. (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

P. R. 1890, rr. 60—66.

1 *Compulsory licenses.*—As to voluntary licenses and assignments, see Chap. XI., p. 195.

The provisions of this section are new.

For practice under it, see Patents Rules, 1890, rr. 60—66, inclusive.

History of the compulsory license clauses.

As to the history of the provisions in this section, see Report of the Commissioners appointed to inquire into the working of the Law relating to Letters Patent for Inventions, 1865, also the Reports of 1871 and 1872.

Committee of 1865.

The Committee of 1865 reported against compulsory licenses, apparently on two grounds: (1) that the exceptional instances in which patentees were unwilling to grant licenses did not justify a sweeping interference with rights to which law has assigned the character of property; and (2) that the value of a patent and the amount of charge that might reasonably be imposed on persons using it, varied in every instance, and it was impossible to suppose that any system of arbitration would prove satisfactory where neither precedent, nor custom, nor fixed rule of any kind could be appealed to on either side.

Committee of 1872.

The Select Committee of 1872 recommended the insertion of a compulsory license clause in the letters patent, thus investing the Crown with the same right which the Judicial Committee exercised in recommending the extension of a subsisting grant.

Results of compulsory license clause.

This section has not justified the hopes of its framers, and bears out the report of the Committee of 1865. It has been practically inoperative, and very few applications have been made under it to the Board of Trade, and no order has been made in any case for a compulsory license.

Up to the end of the year 1887 there was only one informal application for a compulsory license, which was subsequently, by leave of the Board of Trade, withdrawn. In 1888, there was one application. It may be, however, that in some cases these provisions induce patentees to grant licenses rather than be forced to appear before the Board of Trade.

This section does not apply to patents granted, or applications pending, *before* the commencement of this Act (sect. 45, sub-s. (2)); but it applies to a new patent granted after the Act by way of extension of the term of an existing patent (*m*). **Sect. 22.** Scope of section.

No appeal is given from the decision of the Board of Trade; but as the order of the Board is enforced by mandamus, which, being a prerogative writ, may be disputed before the Courts of law, the patentee has practically a right of appeal. An unsuccessful applicant, however, has no remedy.

2 *Petition.*—See Forms H, and H1, and I, *infra*, pp. 743, 744.

3 *Working of patent in the United Kingdom.*—According to English law, it has always been considered to be a user if the patented invention is in use in the United Kingdom though the actual articles were imported from abroad, and it does not appear to have been the intention of the Legislature, by section 22 of the present Act, to compel the actual manufacture of patented articles in England. If it could be shown that the patented article had been imported into this country by the patentee in sufficient quantities, so that the public can be supplied at reasonable rates, he would not be held to be in default within the meaning of sect. 22. It is thought that an applicant for a compulsory license could successfully lodge a petition according to any one of the sub-sects. (a) (b) (c), without having to bring himself in any way within the other two. Meaning of working.

REGISTER OF PATENTS.

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

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

(3.) Copies of[3] deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in

(*m*) *Wasteney Smith's Patent*, 1885, 2 P. O. R. 14.

Sect. 23. any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

1 *Register of patents.*—See Chap. XII., p. 207.
As to register of patent agents, see p. 526.
Inspection of and extracts from register, sect. 88.
Falsification of register, sect. 93.
Powers of Board of Trade over, sect. 101, sub-s. (1 a).

Under the Act of 1852 (ss. 34 and 35, see *infra*, pp. 658, 659), there were two registers—(1) a register of patents, in which were recorded all matters and things affecting the *validity* of the patents, such as grants, deposits, and filing of certificates, disclaimers, payment of renewal fees, sealing of new patents under order for extension by Privy Council, &c.; and (2) a register of proprietors, in which were recorded all assignments, licenses, and other matters relating to the *proprietorship* of the patents. The principal changes in the old practice, made under the present Act, are these :—

1. There is now *one* register of patents, of which the former registers are deemed parts (sect. 23, sub-s. (1), and sect. 114, sub-s. (1)).

2. Instead of the documents above referred to being themselves entered, as formerly was the case with the register of proprietors, the *names and addresses* only of grantees, and notifications only of assignments, &c., are now recorded (sect. 23, sub-s. (1)). Copies of the documents registered are, however, left at the Patent Office, and may be inspected there and copies obtained.

3. Formerly documents conferring merely *equitable* interests in patents might be recorded in the register of proprietors, but it is conceived that under sects. 85 and 87, the documents, notification of which may now be entered on the register, must confer a legal interest.

Documents signed or executed between the date of application and the date of actually sealing the patent, will be registered under the same conditions as if entered into after sealing; but it is not the practice at the Patent Office for the comptroller to register any document bearing date before the nominal date of sealing of the patent, that is, before the date of application, though how far this is a proper construction of this section is doubtful. It appears that there may be documents dated before the date of sealing which ought to be entered on the register. I do not think it necessary, said North, J., in *Re Parnell's Patent* (*n*), to decide, and in deciding I should feel some

(*n*) 1888, 5 P. O. R. p. 126.

little difficulty, whether the comptroller is entitled to refuse, and whether it is his duty to refuse, to enter on the register any notice of title derived through a document that bore date before the taking out of the letters patent, instead of being dated after them. I feel a difficulty in deciding that point for this reason, that it is very easy to imagine a document executed immediately before the letters patent were issued so clear and so precise as to leave no doubt whatever as to the proposed patent referred to in it, and so clear that if it had been dated immediately after the grant of the letters patent instead of immediately before, the right of the applicant to be registered in respect of it would be perfectly clear also. I decline to lay down absolutely that no document executed before the grant of the letters patent can be entered on the register, though I see that there may be very forcible objections made to the entry of such documents, and that to a great many documents those objections would be insuperable; but I see that there may be documents as to which this objection might not apply, and that is the reason why I decline to lay down a general rule of universal application. Sect. 23.

See sects. 87 and 90, *infra;* Patents Rules, 1890, rr. 67—79, and notes thereon, *infra*, pp. 581—584.

2 *Primâ facie evidence.*—The registration of a document is *primâ facie* evidence that it is a proper document to be registered, but is not, in itself, notice to all the world of everything contained therein (*n*).

3 *Copies of deeds, &c.*—As to size of documents, see Patents Rules, 1890, rr. 10, 30—33, pp. 562, 570—572. Copies of deeds, &c.

FEES.

24. (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees[1] in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade;[2] and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct. Fees in schedule.

(*n*) *Heap* v. *Hartley*, 1888, 5 P. O. R., per Bristowe, V.-C. at p. 609. This point was not considered on appeal: 1889, 6 P. O. R. 495.

Sect. 24. (2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

1 *Fees.*—See list of fees, *infra*, p. 586.

2 *The Board of Trade.*—See note to sect. 22, at p. 462.

EXTENSION OF TERM OF PATENT.[1]

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

25. (1.) A patentee[2] may, after advertising[3] in manner directed by any rules made under this section[4] his intention to do so, present a petition[5] to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months[6] before the time limited for the expiration of the patent.

(2.) Any person[7] may enter a caveat,[8] addressed to the registrar of the council at the council office, against the extension.

(3.) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same,[9] and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel[10] on the petition.

(4.) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public,[11] to the profits made by the patentee as such,[12] and to all the circumstances of the case.[13]

(5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent[14] for a further term not exceeding seven, or in exceptional cases fourteen,[15] years; or to order the grant of a new patent[16] for the term therein mentioned, and containing any restrictions,

conditions, and provisions that the Judicial Committee may think fit.[17] Sect. 25.

(6.) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.[18]

(7.) The costs[19] of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice. Costs.

1 As to prolongation or extension of patents generally, see Chap. XVIII. pp. 373—403.

This section practically re-enacts the practice and procedure which existed in the Privy Council before the Act of 1883.

It seems as if the operation of this section were suspended till the end of 1897 because of the saving effect of section 113. See also *Brandon's Patent* (*q*), and the remarks on p. 378. But the matter is of small importance, because, as above stated, this section makes very little change in the law, if any, beyond the provision as to presenting the petition for extension at least six months before the expiration of the patent.

2 *A patentee:*

This includes the person for the time being entitled to the benefit of a patent (sect. 46); a petition may therefore be presented by an assignee, executor, or administrator. Meaning of "patentee."

Where a patent is mortgaged, the mortgagee ought to be made a party to the petition. In a recent case, however (*r*), it was held that the absence of the mortgagee, though an irregularity, was not fatal, the parties having agreed to insert his name in the extended patent, so as to give him the same security as formerly.

The legal personal representative of a deceased patentee ought to be made a party to a petition for extension of a patent dealt with otherwise than by assignment (*s*).

(*q*) 1884, 1 P. O. R. 154.
(*r*) *In re Church's Patent*, 1886, 3 P. O. R. at p. 100.
(*s*) *In re Willacy's Patent*, 1888, 5 P. O. R. 690.

Sect. 25.

3 *After advertising.*—See form of advertisement, p. 812; affidavit of advertisement, p. 814.

The advertisement.

The advertisement must be proved before the application is heard (*t*).

In the matter of *Derosne's Patent* (*u*), the petitioner resided in France, but had granted licenses to persons resident and carrying on business in London and Liverpool, and caused advertisements to be inserted in the *Gazette* and newspapers published in those places. It was held that this was a sufficient compliance with 5 & 6 Will. IV. c. 83, s. 4.

Rules.

4 *Rules made under this section.*—No such rules have yet been made. Those, accordingly, which were made in pursuance of 5 & 6 Will. IV. c. 83, are still in force. See below, p. 594.

The petition.

5 *The petition.*—See forms of petition, *infra*, pp. 816, 817.

A grant of new letters patent being a matter of grace and not of right, a petitioner is bound to strict truth and to the utmost candour and frankness, to *uberrima fides*, in his statement to the Crown (*v*); and the rule has again and again been laid down that where a patentee, whether English or foreign, has obtained foreign patents, there should be a full statement of these in the petition (*w*).

Time of presentation.

Under 5 & 6 Will. IV. c. 83.

6 *At least six months:*

Under 5 & 6 Will. IV. c. 83, s. 4, the law was that any application by petition for the prolongation of letters patent *must be made and prosecuted with effect* before the expiration of the term originally granted.

Under 2 & 3 Vict. c. 67, s. 2.

2 & 3 Vict. c. 67, s. 2 (*x*), provided that where the failure to comply with the requirement of the earlier statute was shown not to have arisen from the neglect or default of the petitioner, the term of letters patent might be extended, if a petition had been presented to the Judicial Committee six calendar months at least before the expiration of the original term.

Under Act of 1852.

The Patent Law Amendment Act, 1852, s. 40, adopted the provisions of the above mentioned Acts in regard to the extension of letters patent.

In the matter of *Macintosh's Patent* (*y*), a petition was lodged 16th January, 1836, and on the usual application being made shortly afterwards for an early day to be fixed for the hearing, the Judicial Com-

(*t*) *Perkins' Patent*, 1845, 2 Web. P. C. 8.

(*u*) 1844, 2 Web. P. C. 1.

(*v*) *Clark's Patent*, 1870, L. R. 3 P. C. 421.

(*w*) *Pitman's Patent*, 1871, L. R. 4 P. C. 84; *Johnson's Patent*, 1871, L. R. 4 P. C. 82; *Adair's Patent*, 1881, L. R. 6 A. C. 176.

(*x*) This enactment was passed in consequence of the decision under 5 & 6 Will. 4, c. 83, s. 4, in *Bodmer's Patent*, 1838-40, 2 Moo. P. C. C. 471.

(*y*) 1837, 1 Web. P. C. 739, n.

mittee intimated that as the English patent did not expire till the 17th of June, 1837, the profits accruing in the meantime might materially affect the question of extension, and the application had better stand over for the present.

Saving of existing rights.

By sect. 113 (a), the right of the owner of a patent, existing at the date when the present Act came into operation, is saved. He may, therefore, apply for prolongation at any time before the expiration of the original term (z).

Who may oppose.

7 *Any person.*—There is no limitation on the right of opposition to the extension of a patent. Cp. *supra*, sect. 11, sub-ss. (1), (3); sect. 18, sub-ss. (2), (4).

The Crown.

The Crown may adduce evidence against a patent, irrespective of the objections (a), and in *Erard's Patent* (b)—the first application under 5 & 6 Will. IV. c. 83—the Judicial Committee intimated that in all cases of unopposed applications the Attorney-General should attend on the part of the Crown.

In *Re Baxter's Patent* (c), the extension of a patent was unsuccessfully opposed by two apprentices, who alleged that they expected to be able to practise the invention on the expiry of the patent, and that they had not been taught any other trade.

The caveat.

8 *Caveat.*—See form of caveat, p. 813; form of notice of objection, p. 837.

It appears that the *caveat* must be entered by the actual opponent and not by a patent agent (d).

Particulars of objection.

The present Act, like the repealed Acts, 5 & 6 Will. IV. c. 83, and 2 & 3 Vict. c. 67 (e), does not require particulars of objections in extension cases, but in the matter of *Stewart's Patent* (f), where the opposition succeeded upon the ground of an anticipation not mentioned in the objections, the opponent's costs were disallowed.

Judicial Committee.

9 *The said Committee shall proceed to consider.*—By sect. 28, sub-s. (2), the Judicial Committee may call in the aid of an assessor, and determine his remuneration.

The books of account produced by a patentee will be *minutely* examined by the Judicial Committee (g). See form of accounts, *infra*, p. 821.

(z) *In re Brandon's Patent*, 1884, 1 P. O. R. 154.

(a) *Church's Patent*, 1886, 3 P. O. R. at p. 101; citing *Re Ball's Patent*, 1879, L. R. 4 A. C. 173.

(b) 1835, 1 Web. P. C. 557.

(c) 1849, 13 Jur. 593.

(d) *Lowe's Patent*, 1852, 8 Moo. P. C. 1.

(e) *Ball's Patent*, 1879, L. R. 4 A. C. 171.

(f) 1886, 3 P. O. R. 7.

(g) *Perkins' Patent*, 1845, 2 Web. P. C. 6.

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Counsel.

10 *By counsel:*

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose (*h*).

Position of Attorney-General.

In all petitions for the extension of letters patent, whether opposed or not, the Attorney-General attends on behalf of the Crown (*i*); and he so far represents the government and the public generally, that a government department who had not entered a caveat in time were not allowed, the Attorney-General being present, to enter a caveat and be heard in opposition (*j*).

Nature and merits of invention.

11 *The nature and merits of the invention in relation to the public.*—On this subject, see Chap. XVIII. p. 389.

It is not the habit of the Judicial Committee in considering petitions for extension to determine the validity or invalidity of a patent. They leave that question to the ordinary Court of law.

What they do consider is not whether there is sufficient novelty to sustain the patent, but whether the novelty constitutes *that exceptional merit* which justifies an extension (*k*).

Of course, a patent which is clearly bad will not be prolonged (*l*).

Where only *part* of an invention was shown to possess utility, and the accounts as to that part were defective, the Judicial Committee refused an extension (*m*).

Profits of patentee.

12 *To the profits made by the patentee as such.*—The Judicial Committee is entitled to look to what has been received by way of profit on the invention in foreign countries (*n*).

Accounts.

Under the Judicial Committee Rules, r. 9, a party applying for an extension of a patent must lodge at the Council Office, at least *one week* before the day fixed for hearing the application, certain copies (*vide infra*, p. 592) of the specification, and of the balance sheet of expenditure and receipts relating to the patent in question. This rule is imperative, and all deductions which the petitioner claims to make from his profits must be set forth in the accounts submitted (*o*).

In a recent case, *Re Yates and Kellett's Patent* (*p*), the petitioner

(*h*) *In re Woodcroft's Patent*, 1841, 3 Moo. P. C. 172, n.

(*i*) *In re Erard's Patent*, 1835, 1 Web. P. C. 557.

(*j*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133.

(*k*) *In re Stewart*, 1886, 3 P. O. R. 9, 10; cp. also *In re Bailey's Patent*, 1884, 1 P. O. R. 1; *Re Cocking's Patent*, 1885, 2 P. O. R. 151, 153; also citing *Saxby's Patent*, L. R. 3 P. C. App. 294; *Beanland's Patent*, 1887, 4 P. O. R. 491.

(*l*) *Erard's Patent*, 1835, 1 Web. P. C. 557; *Woodcroft's Patent*, 1846, 2 Web. P. C. 18; *Pinkus' Patent*, 1848, 12 Jur. 233; *Saxby's Patent*, 1870, L. R. 3 P. C. 292.

(*m*) *In re Willacy's Patent*, 1888, 5 P. O. R. 690.

(*n*) *In re Newton's Patent*, 1884, 1 P. O. R. 177.

(*o*) *In re Bailey's Patent*, 1884, 1 P. O. R. 1.

(*p*) 1887, 4 P. O. R. 150; cp. *Johnson's and Atkinson's Patents*, 1873, L. R. 5 P. C. 87.

failed to file his accounts within the time fixed by the Judicial Committee Rules, r. 9. The accounts, when lodged, were insufficient. The petitioner then applied for an adjournment, in order to supplement them, but the Judicial Committee refused the application, and dismissed the petition.

Where patent rights have been transferred either in whole or in part to a company, it is essential that there should be deposited not only the patentee's account of his profits, but, in order to test them, the accounts also of the profits of the company to whom the patentee has transferred his patent (*q*).

Onus is on petitioner.

The *onus* is upon the petitioner to satisfy the Committee that when all circumstances are considered his remuneration has been less than he is equitably entitled to. No one but himself is in a condition to state the whole account, and it is important to have it distinctly understood that the most unreserved and clear statement is an indispensable condition to the success of a petition (*r*).

Duty to keep patent account.

It is the duty of a patentee to keep from the first a patent account distinct and separate from any other business in which he may be engaged (*s*).

In estimating a patentee's expenditure, the Judicial Committee may take account of (a) the *reasonable* cost of working the patent (*t*); (b) the value of the patentee's *time* properly expended upon working his invention (*u*); (c) exceptional loss by litigation (*x*); and (d) manufacturer's profits *not due to the monopoly conferred by the patent* (*y*).

On the other hand, if but for the patent there would have been no manufactory, and the patentee is also a manufacturer, then the net profits of the manufacturer are attributable to the patent, and cannot be deducted (*z*).

Considerations which guide committee.

13 *All the circumstances of the case.*—The following is a summary of the considerations which guide the committee:—

Has the petitioner been prevented by causes beyond his control

(*q*) *In the Matter of Deacon's Patent*, 1887, 4 P. O. R. 122.

(*r*) *Hills' Patent*, 1868, 1 Moo. P. C. N. S. 258; *Saxby's Patent*, 1870, L. R. 3 P. C. 292; *Adair's Patent*, 1881, L. R. 6 A. C. 176.

(*s*) *Bett's Patent*, 1862, 1 Moo. P. C. N. S. 49; *Trotman's Patent*, 1866, L. R. 1 P. C. 118.

(*t*) *Roberts's Patent*, 1839, 1 Web. P. C. 573. See, however, the limitations to the proposition in *Clark's Patent*, 1870, L. R. 3 P. C. 421, per James, L. J.

(*u*) *Roberts's Patent*, *ubi sup.*; *Trotman's Patent*, 1866, L. R. 1 P. C. 118; *Carr's Patent*, 1873, L. R. 4 P. C. 539.

(*x*) *Kay's Patent*, 1839, 1 Web. P. C. 568; *Roberts's Patent*, *ubi supra*; *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133; *Heath's Patent*, 1853, 2 Web. P. C. 247.

(*y*) *Galloway's Patent*, 1843, 1 Web. P. C. 724; *Muntz's Patent*, 1846, 2 Web. P. C. 113.

(*z*) *Saxby's Patent*, 1870, L. R. 3 P. C. 292; cp. also *Hills' Patent*, 1863, 1 Moo. P. C. N. S. 258.

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from deriving an adequate remuneration from the working of his patent? (*a*).

Does the invention possess *exceptional merit, i.e.*, such novelty or utility as will justify the committee in advising an extension?

"We are here," said Lord Brougham, in *Perkins' Patent* (*b*), "by the authority of the Legislature, given to us to advise the Queen, to protect her from rashly and inexpediently for the public granting an extension, which formerly used to require a solemn and deliberate act of all the three branches of the Legislature, involving a double inquiry, together with an opinion of the government itself."

Each case is dealt with on its own merits; and the only general rule which can be laid down is a negative one, viz., that the novelty and utility which might support an original, may be insufficient to justify an extended grant of letters patent (*c*).

Has the introduction of the patent been slow? If so, was this to be expected from its nature and the circumstances of the case (*d*), or is it in evidence of want of utility? (*e*). If not, has not the patentee been adequately remunerated?

Is the public interest opposed to an extension? (*f*).

14 *To extend the terms of the patent*—or part of it (*g*).

15 *Or in exceptional cases fourteen years.*—This is a re-enactment of 7 & 8 Vict. c. 69, s. 2. An invention may be said to fall under the description of "exceptional," when it appeals only to a small number of minds, is used only in a small number of cases, and requires a considerable outlay (*h*).

16 The practice is to order new letters patent to be sealed by the comptroller-general with the seal of the Patent Office, and the date of the new patent will be the date following the day of expiration of the old patent; in this way, without overlapping, the patent right is continuously preserved, and the patentee has the full benefit of the exten-

(*a*) Cp. *Southworth's Patent*, 1837, 1 Web. P. C. 486; *Downton's Patent*, 1839, 1 Web. P. C. 565; *Norton's Patent*, 1863, 1 Moo. P. C. N. S. 339; *Trotman's Patent*, 1866, L. R. 1 P. C. 118; *Sillar's Patent*, 1882, 1 Goodeve, P. C. 582.

(*b*) 1845, 2 Web. P. C. 6.

(*c*) *Vide supra*, p. 382.

(*d*) *Woodcroft's Patent*, 1846, 2 Web. P. C. 18; *Carr's Patent*, 1873, L. R. 4 P. C. 539.

(*e*) *Sinister's Patent*, 1842, 4 Moo. P. C. C. 164; *Pinkus' Patent*, 1848, 12 Jur. 233; *Bakewell's Patent*, 1862, 15 Moo. P. C. C. 385; *Norton's Patent*, *ubi supra*; *Allan's Patent*, 1867, L. R. 1 P. C. 507; *Herbert's Patent*, 1867, L. R. 1 P. C. 399; *Hughes' Patent*, 1879, L. R. 4 A. C. 174.

(*f*) *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488; *McInnes's Patent*, 1868, L. C. 2 P. C. 54; *Sillar's Patent*, 1882, *ubi supra*.

(*g*) *Bodmer's Patent*, 1853, 8 Moo. P. C. C. 282; *Lee's Patent*, 1856, 10 Moo. P. C. C. 226; *Napier's Patent*, 1881, L. R. 6 A. C. 174; *Church's Patent*, 1886, 3 P. O. R. 102.

(*h*) *In re Stoney's Patent*, 1888, 5 P. O. R. 523.

sion. The form of such letters patent is settled by the Order in Council prolonging the patent, and is different from the common form set out in the schedule to the Act of 1883. The recitals will be different (*i*), and as the patents, which are prolonged under the Act of 1883, will be, for some years to come, patents granted under the Act of 1852, the general form of the letters patent will follow the precedent in use under that Act. Thus, the Channel Islands, though not now included in an ordinary grant, will be properly included in new letters patent granted, or prolongation by Privy Council of patents granted under the Act of 1852. **Sect. 25.**

The Order in Council prolonging the term of the patent privilege must be registered in the Register of Patents, and a copy of the new letters patent should be filed, and a record thereof put upon the register. It would seem that a copy of the Order in Council ought also to be filed, but this does not seem to have been the practice.

A form of the Order in Council is given in Appendix, p. 838.

It is customary to mark the register in red ink where a patent is extended with words "extended for —— years." The volume of the register is ordinarily kept for twenty-one years after date of the latest patent registered therein, but when any patent in a volume of the register has been extended, the volume is kept for seven years after the expiration of the extended patent. See also p. 213.

17 *Containing any restrictions, conditions and provisions, &c.*—In the event of an extension being granted to an *assignee*, the Judicial Committee generally require some advantage to be secured to the inventor or his family (*j*).

A condition to the effect that contractors for her Majesty's service should be at liberty to manufacture and use the invention upon terms, has sometimes been imposed (*k*).

A condition requiring the patentee to grant licences to the public, was inserted in *Mallet's Patent* (*l*); but see sect. 22 of the present Act.

In *Hardy's Patent* (*m*), a condition to prevent the price of the articles patented, viz., iron axletrees for railway carriages, being raised out of proportion to the price of the raw material, was imposed.

18 *Rules of procedure and practice.*—No rules have yet been made. For the old rules still in force, see p. 594. Rules of practice.

(*i*) See Form in Appendix, p. 839.

(*j*) *Whitehouse's Patent* (quoted as *Russell's Patent*, 2 Moo. P. C. C. 496), 1838, 1 Web. P. C. 473; *Markwick's Patent*, 1860, 13 Moo. P. C. C. 310; *Poole's Patent*, 1867, L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452; *Pitman's Patent*, 1871, L. R. 4 P. C. 84.

(*k*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133; *Hughes' Patent*, 1879, L. R. 4 A. C. 174; *Napier's Patent*, 1881, L. R. 6 A. C. 174.

(*l*) 1866, L. R. 1 P. C. 308.

(*m*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441.

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19 *Costs.*—Where there was ground for opposition, and the case was doubtful and difficult, the Judicial Committee made no order as to costs (*n*).

It is unnecessary for opponents to give notice of their intention to apply for costs (*o*), and these will, in general, follow a successful opposition (*p*).

In *Wield's Patent* (*q*), Sir J. W. Colville said, "Their Lordships are inclined to adhere to the rule that has been laid down, almost from the first application under the Act giving them jurisdiction in patent cases, that in the exercise of their power to grant costs, it is certainly not desirable to refuse the costs of a fair opposition, since it is rather in the interest of this tribunal to encourage *bonâ fide* oppositions, in order that the Court may be put in possession of all that can be alleged against the continuance of the patent."

On the *abandonment* of an application for extension, the practice has been to direct that the costs of the opposition should be taxed by the registrar of the Privy Council, and paid by the petitioner (*r*). In *Milner's Patent* (*s*), an alternative was offered to the petitioner of paying a fixed sum for costs.

A *vexatious* opposition will be punished with costs (*t*).

Where the extension of a patent is opposed by several opponents, and refused, the usual order is that the costs should be distributed by the registrar among the several opponents, unless the petitioner prefer taxation (*u*).

In *Johnson's Patent* (*u*), a lump sum for costs was given to two opponents, who both represented the same kind of opposition; and this seems to be the more common rule now.

REVOCATION.

Revocation of patent.

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

Petition.

(2.) Revocation[2] of a patent[3] may be obtained on petition[4] to the Court.[5]

(3.) Every ground[6] on which a patent might, at the

(*n*) *Church's Patent*, 1886, 3 P. O. R. at p. 102.
(*o*) *Bridson's Patent*, 1852, 7 Moo. P. C. C. 499.
(*p*) *Westrupp and Gibbins' Patent*, 1836, 1 Web. P. C. 554.
(*q*) 1871, L. R. 4 P. C. 89.
(*r*) *Hornby's Patent*, 1853, 7 Moo. P. C. C. 503.
(*s*) 1854, 9 Moo. P. C. C. 39.
(*t*) *Downton's Patent*, 1839, 1 Web. P. C. 565.
(*u*) *Johnson's Patent*, 1871, L. R. 4 P. C. 75; *Wield's Patent*, 1871, L. R. 4 P. C. 89; *Jones' Patent*, 1854, 9 Moo. P. C. C. 41; *Bovill's Patent*, 1863, 1 Moo. P. C. N. S. 348.

commencement of this Act, be repealed by scire facias shall be available by way of defence to an action of infringement and shall also be a ground of revocation. Sect. 26.

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

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

(b) Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland:[7]

(c) Any person[8] alleging that the patent was obtained in fraud of his rights,[9] or of the rights of any person under or through whom he claims:

(d) Any person[8] alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

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

(5.) The plaintiff must deliver with his petition particulars of the objections[10] on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered. Particulars of objections.

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

(7.) The defendant shall be entitled to begin,[11] and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the

Sect. 26. true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

1 *Scire facias.*—See Chap. XVI., p. 355.

2 *Revocation.*—See Chap. XVI., p. 360.

For order of revocation, see p. 811.

For order dismissing petition, see p. 812.

Revocation in Scotland.

A petition for revocation becomes in Scotland "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." (Sect. 109, sub-s. (1), *infra*.)

"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." (*Ibid.*, sub-s. (2).)

Patent.

3 *Patent.*—As the term "patent" means "letters patent for inventions" (sect. 46), having "effect throughout the United Kingdom and the Isle of Man" (sect. 16), it seems that a revocation for the whole United Kingdom and the Isle of Man can be obtained in any one of the Courts—as defined below—of the three kingdoms.

Petition.

4 *On petition.*—See forms of petition, *infra*, pp. 809, 810.

A patent may also be repealed by the Sovereign on proof before any six members of the Privy Council that it is contrary to law, or prejudicial, or inconvenient to the public, or not new, or not invented by the patentee. It was probably under this power, which has always been inserted as a proviso in letters patent (*x*), that Queen Elizabeth recalled the letters patent for monopolies which provoked the remonstrance of the House of Commons repeatedly during her reign; but there is no modern instance of its exercise (*y*).

Court.

5 *The Court.*—"Court" means, in England, the High Court of Justice for England (sect. 117, sub-s. (1)); in Scotland, the Court of Session (sect. 111, sub-s. (1)); and in Ireland, the High Court of Justice for Ireland (sect. 117, sub-s. (1)).

(*x*) See Form of Patent, *infra*, p. 532.

(*y*) Hindmarch, p. 431.

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Grounds of *scire facias* still available.

6 *Grounds of scire facias.*—An action of *scire facias* lay in three cases (*z*):—

Where the King by his letters patent had granted the self-same thing to several persons, the first patentee had a *scire facias* to repeal the second grant.

When the grant had been made upon a false suggestion, the King might *jure regio* repeal his own grant.

When the King had granted anything which by law he could not grant, he *jure regio* (for the advancement of justice and right) might have a *scire facias* to repeal his own letters patent.

"The proceedings," says Mr. Webster (*a*), "may be instituted on the grounds of fraud, false suggestion, non-compliance on the part of the patentee with the condition of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent."

Attorney-General's authority, how obtained.

7 *Authorization of petition:*

When it is desired to obtain the Attorney-General's authority under this sub-section, it is necessary to send the following papers to the Patent Clerk, at Room 519, Royal Courts of Justice, London:—

Memorial to the Attorney-General, asking for his authority, and stating all the circumstances.

Statutory declaration verifying the statements in the memorial.

Two copies of the proposed petition, and of the particulars proposed to be delivered with it under sect. 26, sub-s. (5).

Certificate of a barrister that the petition is proper to be authorized by the Attorney-General.

Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition, if unsuccessful.

The Attorney-General sometimes gives or refuses his authority *ex parte*.

In some cases he directs notice to be given to the patentee, and directs the parties to be heard before him.

8 *Any person:*

A petition for revocation cannot be presented under clauses (c) and (d) of this sub-section by an attorney under a power; for the person alleging fraud upon his rights, and all persons beneficially interested in the patent, are necessary parties (*b*).

A petitioner, qualified in the manner indicated in (c), (d), (e), may impeach a patent *upon any lawful ground*. Thus, a petitioner, alleging prior manufacture, user and sale, may put forward other objections to

(*z*) 4 Inst. 88.

(*a*) Letters Patent for Invention, p. 32.

(*b*) *Re Avery's Patent*, 1887, 4 P. O. R. 158, 159; L. R. 36 Ch. D. 307.

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a patent, such as variance, or that the invention was not proper subject-matter (*a*).

Jurisdiction to repeal patent in England where patentee domiciled Scotchman.

In *Drummond's Patent* (*b*), F. & Co. presented a petition for the revocation of D.'s patent. D. was a domiciled Scotchman resident in Scotland. A copy of the petition and of the particulars of objections were delivered to him personally in Scotland. He then wrote to the petitioner's solicitors, stating that he did not intend to appear at the hearing of the petition, as he was not subject to the jurisdiction of the English Court. The petitioners applied for directions as to the hearing of the petition, and that it might be heard with witnesses and put down in the witness list. The Court made an order that that course should be adopted, unless by a certain day, of which notice was to be given to D., he should appear and show cause to the contrary, it being open to him if he appeared to dispute the jurisdiction.

Fraud of petitioner's rights.

9 *In fraud of his rights:*

An act done by an agent under an honest mistake, even though it may cause loss to the principal, is not an act done in fraud of the principal's rights.

To be in fraud of his rights it must be either done with the intention of depriving, or insisted on so as to deprive, the principal of his rights (*c*).

10 *Particulars of objections.*—See notes to sect. 29, sub-sects. (2)—(5); and see Chap. XV., p. 366.

11 *The defendant shall be entitled to begin.*—See note to sub-s. (1) of this section. This is a re-enactment of a proviso in the Patent Law Amendment Act, 1852, s. 41.

Subject to sub-sects. (5), (6) and (7), the new Act leaves the practice to be governed by the ordinary practice upon a petition to the High Court. "Plaintiff," in the R. S. C. Ord. XXXI. r. 1, means "petitioner," and that rule applies to petitions for the revocation of a patent (*d*).

CROWN.

Patent to bind Crown.

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

(*a*) *In the Matter of Morgan's Patent*, 1888, 5 P. O. R. 187.

(*b*) 1889, 6 P. O. R. 576; L. R. 43 Ch. D. 80.

(*c*) *Re Avery's Patent*, 1887, 4 P. O. R. p. 327; L. R. 36 Ch. D. 307.

(*d*) *Haddan's Patent*, 1884-5, 54 L. J. Ch. 126; Griffin, P. C. 109.

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury,[2] between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested. Sect. 27.

1 These sub-sections do not apply to patents granted before the commencement of this Act, or upon applications then pending (*e*). Such patents are, therefore, subject to the former law, which it may be interesting to trace. Effect of grant of patent on Crown.

By the theory of the law, the Crown was not bound to grant a patent to any person for a new invention, however valuable, and it was a consequence of the power to withhold a patent altogether that the Crown might make a grant subject to such qualifications as it deemed right; and those qualifications were introduced into each patent according to the discretion of the Attorney-General for the time being. The form generally used was the following proviso: "If the patentee, his executors, &c., shall not supply or cause to be supplied for our service *all such articles of the said invention* as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then the patent shall be void" (*f*). Former law.

Now this proviso had one grave defect (*g*)—

It dealt merely *with the use of patented articles*, and was assumed not to give the Crown the power of using, upon terms, *patented processes*. The result was that *patents for processes* were taken out in the most vague and general terms, not with any view to use by private individuals, but simply in the hope that some improvement, proposed by a public department, would be found to constitute an infringement of the patented process, and that then the patentee might obtain substantial damages or compensation. Defects of old proviso.

(*e*) Sect. 45, sub-s. (2).

(*f*) Cp. Report of the Patent Commissioners, 1865, p. 131; also Hindmarch, p. 71.

(*g*) *Ibid.*, Evidence of the Duke of Somerset, First Lord of the Admiralty, and Rear-Admiral R. S. Robinson, pp. 127—133.

Sect. 27. It was suggested that a clause should be inserted in the customary proviso, empowering the officers of any public department to require a patentee to grant *a licence for the use of his patent;* but the decision in *Feather* v. *Reg.* (*h*), that the Crown has, independent of any proviso, the right *to use a patented invention*, seems to have met the difficulty.

Contractors. In the form of letters patent now in use, the old proviso is retained. In *Dixon* v. *London Small Arms Co.* (*i*), it was held that the doctrine of *Feather* v. *Reg.* (*h*) did not extend to *contractors* for the public service, a decision which still holds good in the case of those patents to which sub-s. (2) of sect. 27 does not apply.

2 *With the approval of the Treasury.*—This clause is in accordance with a recommendation made by the Commission of 1865 (*k*).

LEGAL PROCEEDINGS.

Hearing with assessor.

28. (1.) In an action or proceeding for infringement[1] or revocation[2] of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified,[3] and try and hear the case[4] wholly or partially with his assistance; the action shall be tried without a jury[5] unless the Court shall otherwise direct.

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

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.[6]

1 See action of infringement, at p. 245.

2 See revocation of patents, p. 355.

Scientific assessors.

3 *An assessor specially qualified, &c.:*
This power of calling in an assessor has been very rarely exercised.

(*h*) 1865, 35 L. J. Q. B. 200; 6 B. & S. 257.

(*i*) 1875-76, L. R. 1 App. Cas. 632.

(*k*) Report, &c., 1865, IX.

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This provision is new, is a development of a similar power conferred by 15 & 16 Vict. c. 83, s. 8, upon the law officer dealing with the sufficiency of a provisional specification, and was enacted in accordance with the recommendations of successive Parliamentary Commissions (*l*).

The power to summon an expert assessor, conferred by this section, has been exercised in Scotland but not in England.

As to power of law officer to summon scientific assessors, see sect. 11, sub-sect. 4.

4 *Shall try and hear the case.*—It is thought that this clause deprives the Court of the right to remit an action of infringement, although involving a prolonged scientific examination (*m*), to an official referee.

Trial without a jury, why advisable.

5 *And the action shall be tried without a jury.*—The reasons why patent cases should be tried without a jury were well summarised by Lord Selborne, L. C., in *Patent Marine Inventions Co.* v. *Chadburn* (*n*). See p. 313.

6 *Expenses incurred in execution of Act,* see sect. 83, sub-sect. 2.

Delivery of particulars.

29. (1.) In an action for infringement of a patent[1] the plaintiff[2] must deliver with his statement of claim,[3] or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.[4]

(2.) The defendant[5] must deliver with his statement of defence,[6] or, by order of the Court or a judge, at any subsequent time, particulars of any objections[7] on which he relies in support thereof.

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

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.[8]

(*l*) See Reports of 1851 and 1865, *passim*.

(*m*) Cf. Judicature Act, 1873, s. 57.

(*n*) 1873, L. R. 16 Eq. 447.

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(5.) Particulars delivered may be from time to time amended,[9] by leave of the Court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs[10] in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.[11]

1 *Action for infringement.*—See Chap. XIV. p. 245.

2 *The plaintiff.*—As to who may or should be plaintiffs, see *supra*, p. 254.

Statement of claim.

3 *Statement of claim.*—The subject is treated of under "Action of Infringement," at p. 280.

For forms of statement of claim, see Appendix, pp. 782—784.

The form of statement of claim for the infringement of a patent, prescribed by the R. S. C. 1883, App. C. Sect. VI. No. 6, contains the following material allegations:—the number, date, and term of the patent, the subject-matter, the fact that the plaintiff is the true and first inventor, and the fact of infringement by the defendant. The claim concludes for an injunction and damages, and refers to the particulars of breaches delivered along with it.

Allegations in statement of claim.

A technical variance from the prescribed form will not be fatal to the plaintiff's claim (Ord. XIX. r. 26); but the Court has power to strike out any pleading on the ground that it is unnecessary, scandalous, or embarrassing (*ibid.* r. 27).

It was not necessary, even in the old *declaration* in an action at law (*o*), or in the *bill* in a suit at equity (*p*), and is not necessary now, to allege the novelty of the invention protected by the patent.

The allegation of the grant and the production of the letters patent were held to throw upon the defendant the *onus* of disputing the novelty.

In *Sarazin* v. *Hamel* (*q*) it was doubted whether, under a bill to restrain the infringement of a patent, it was necessary to allege that the patentee had duly paid the instalments of stamp duties necessary to keep the patent alive under 16 & 17 Vict. c. 5, s. 2, and no such allegation is required by the prescribed form.

(*o*) Hindmarch, p. 253.
(*p*) *Armory* v. *Brown*, 1862, L. R. 8 Eq. 663.
(*q*) 1863, 32 Beav. 145.

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It may be said, generally, that a statement of claim must raise a *primâ facie* case strong enough to justify an injunction (*r*), and must contain all the material allegations (with the exception of the particulars) on which the plaintiff relies (*s*).

Particulars of breaches.

4 *Particulars of breaches.*—See *supra*, p. 281.
Form of particulars, *infra*, p. 784.
As to history of this requirement, see *supra*, p. 281.

5 *The defendant.*—As to who may and ought to be defendants, see *supra*, p. 258.

6 *Statement of defence.*—See p. 288.
For forms of defence, see pp. 786 *et seq.*

Particulars of objections.

7 *Particulars of objections.*—For form of particulars, see p. 788.
For particulars of objections generally, see p. 295.

Restriction of evidence at hearing.

8 *No evidence shall, except by leave, &c.*—The words "except by leave of the Court or judge" are new. The rest of the sub-section re-enacts substantially 5 & 6 Will. IV. c. 83, s. 5, and 15 & 16 Vict. c. 83, s. 41.

Where additional evidence comes to the knowledge of a defendant after the delivery of his particulars, the proper course is to apply at once for leave to amend the particulars (*t*).

United Telephone Company v. *Bassano.*

A recent case, *United Telephone Co., Limited* v. *Bassano* (*u*), raised an interesting point of practice under this section. The plaintiffs, as owners of two patents, brought two actions for infringement against the defendants, who delivered defences denying infringement, but not impeaching the validity of the patents. The plaintiffs joined issue upon these defences, and set the case down for trial. Sometime afterwards the defendants took out a summons for leave to amend their defences by inserting therein a denial of the validity of the plaintiffs' patents, and urged that the matter should be reserved for disposal by the judge at the trial of the actions. The plaintiffs opposed this application on the ground that the validity of the patents had, to the knowledge of the defendants, been decided in former cases. Pearson, J., declined to postpone the hearing of the trial, but gave the defendants leave to put in, within three days, an amended defence, raising the new issue; and ordered them to pay the costs of the application and any costs occasioned by the amendment.

Where the words of the particulars are sufficiently wide, however, to include the new evidence tendered, it will be admitted (*x*).

(*r*) *Curtis* v. *Cutts*, 1839, 8 L. J. Ch. 184.
(*s*) R. S. C. 1883, Ord. XIX. r. 4.
(*t*) *Daw* v. *Eley*, 1865, L. R. 1 Eq. 38.
(*u*) 1885, 2 P. O. R. 70.
(*x*) *Hull* v. *Bollard*, 1856, 1 H. & N. 134, 137; *Curtis* v. *Platt*, 1866,

Sect. 29. 9 *Amendment of particulars.*—See p. 304.

Amendment of particulars.

10 *Shall not be allowed any costs, &c.*—With the exception of the words "to have been reasonable and proper," this sub-section substantially re-enacts 15 & 16 Vict. c. 83, s. 43.

11 *Without regard to the general costs of the case.*—According to Stephen, J., in *Haslam Co.* v. *Hall* (*s*), this does not mean that the certificate of the judge is to be "without regard," &c., and the sub-section should read, "and with regard to the general costs of the case, they respectively shall not be allowed any costs," &c.

Order for inspection, &c., in action.

30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction,[1] inspection[2] or account,[3] and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

1 *Injunctions.*—See Forms, *infra*, pp. 793, 794.

For a full discussion of the former and present practice of the Courts in granting injunctions, &c., see above, p. 264. As to inspection and account, see pp. 305—322.

The following may serve as a summary of the more important points:—

The present section substantially re-enacts 15 & 16 Vict. c. 83, s. 42, of which the object was to vest in the Courts of common law the power to order an injunction, inspection, or account, theretofore exclusively possessed by Courts of equity (*t*). How far this object was attained appears to be somewhat doubtful (*u*), but under the Judicature Act, 1873, and the Rules of the Supreme Court, 1883 (*x*), each division of the High Court of Justice, and any judge of such High Court (*y*), either in Court or in chambers, has the power of making orders for injunction, inspection, or account, whenever it is thought necessary.

35 L. J. Ch. 852, 868; *Sugg* v. *Silber*, 1874, 2 Q. B. D. at p. 495, per Mellish, L. J.

(*s*) 1888, 5 P. O. R. at p. 26.

(*t*) *Holland* v. *Fox*, 1854, 23 L. J. Q. B. 357; 3 E. & B. 977; *Patent Type Founding Co.* v. *Lloyd*, 1860, 29 L. J. Ex. 207; 5 H. & N. 198.

(*u*) *Ibid.*; and S. C., Johns. 727; also *Gittins* v. *Symes*, 1854, 24 L. J. C. P. 48; 15 C. B. 362.

(*x*) Ord. L.

(*y*) *Beddow* v. *Beddow*, 1878, L. R. 9 Ch. D. 89; *Thomas* v. *Williams*, 1880, 14 Ch. D. 864; *Quartz Consolidated Co.* v. *Beale*, 1882, 20 Ch. D. 501.

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Interlocutory injunction.

As to granting an *interlocutory* injunction, the rule upon which the Courts still act is that stated by Sir George Jessel, M. R., in *Dudgeon* v. *Thomson* (*z*) :—

"The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that as against the defendant himself there is no reason to doubt the validity of the patent."

A plaintiff must apply promptly after discovery of an alleged infringement, in order to obtain an interlocutory injunction to restrain it (*a*).

A person, however, who is threatened with proceedings for infringement is entitled to wait a reasonable time to see what is done in execution of the threat before applying for an interlocutory injunction under sect. 32 (*b*), (*infra*).

Perpetual injunction.

A *perpetual* injunction may be granted by the Court where the plaintiff has established the validity of his patent and the fact of infringement (*c*), or may be obtained by motion in Court (*d*), or by order in Chambers (*e*), where the defendant is willing to submit to the plaintiff's demands without bringing the action to trial.

Inspection, when ordered by.

2 *Inspection.*—See *supra*, p. 305.

Form of order for inspection, p. 794.

Before ordering *inspection* the Court must be satisfied (1) that there is a *primâ facie* case to be tried (*f*); and (2) that the inspection demanded will probably, and not merely possibly (*g*), yield something material to the case of the party demanding it (*h*), and will not be oppressive to the other party (*i*).

(*z*) 1874, 30 L. T. N. S. 244. Cp. the following modern cases:—*Lister* v. *Norton*, 1884, 1 P. O. R. 114; *Jackson* v. *Needle*, 1884, *ibid.* 174; *Briggs* v. *Lardeur*, 1884, *ibid.* 126; *Shillito* v. *Larmuth*, 1885, 2 P. O. R. 1; *Read* v. *Andrew*, 1885, *ibid.* 119; *United Telephone Co.* v. *St. George*, 1886, 3 P. O. R. 33; *Rothwell* v. *King*, 1886, *ibid.* 379; *Coles* v. *Baylis*, 1886, *ibid.* 178.

(*a*) *Thomson* v. *Batty*, 1889, 4 Times R. 36; 6 P. O. R. 84.

(*b*) *United Telephone Co.* v. *Equitable Telephone Association*, 1888, 5 P. O. R. 233.

(*c*) *Hill* v. *Evans*, 1862, 31 L. J. Ch. 457; 4 De G. F. & J. 289.

(*d*) *Morrell* v. *Pearson*, 1849, 12 Beav. 284.

(*e*) Jud. Act, 1873, s. 39; and *Frearson* v. *Loe*, 1878, L. R. 9 Ch. D. 48; 26 W. R. 138. Cp. also R. S. C. 1883, Ord. LIV. r. 12; and Ord. LV. r. 15.

(*f*) *Piggott* v. *Anglo-American Telegraph Co.*, 1868, 19 L. T. N. S. 46.

(*g*) *Smith* v. *London and Great Western Rail. Co.*, 1854, Macr. P. C. 223; *Germ Milling Co.* v. *Robinson*, 1886, 3 P. O. R. 13.

(*h*) *Piggott* v. *Anglo-American Telegraph Co.*, *ubi supra*.

(*i*) *Singer Manufacturing Co.* v. *Wilson*, 1865, 5 N. R. 505.

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Inspection of trade secrets.

That an inspection will lead to the disclosure of trade secrets is not a sufficient ground for refusing it (*k*); but the Court will take steps to prevent the inspection being used to the prejudice of the defendant (*l*), and it has been customary in such cases to order an inspection and report by some scientific man under an "obligation of confidence," and not by the plaintiff (*m*).

Inspection of examiner's report.

In ordering inspection of an examiner's report under this section, it seems that the Court must certify such inspection to be desirable, and in the interests of justice. (Cp. sect. 9, sub-s. (5).)

The Court has no power under this section to require the defendants to an action for infringement to make an *affidavit* verifying the machines and processes used by them in the manufacture which is in issue (*n*).

Account of profits.

3 *Account.*—See above, p. 322.

Any Division of the High Court of Justice may order an account of profits against a person infringing patent rights (*o*); but the plaintiff must elect between such an account and damages (*p*). The basis of the claim for profits is that the patentee condones the infringement, and does not complain of it, but seeks to recover the whole profit made by the infringer as if it had been made as trustee for him (*q*).

For the form of an order for an account of profits where an article is only partially made by the use of a patented invention, see *Siddell* v. *Vickers* (*r*).

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question;[1] and if the Court or a judge so certifies, then in any subsequent action for infringement,[2] the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

(*k*) *Renard* v. *Levinstein*, 1864-65, 10 L. T. N. S. 94.

(*l*) *Russell* v. *Crichton*, 1837, 15 Court of Sess. 1270.

(*m*) *Flower* v. *Lloyd*, 1876, W. N. 230; and *Plating Co.* v. *Farquharson*, 1879-83, Griffin, P. C. 187.

(*n*) *Drake* v. *Muntz's Metal Co.*, 1886, Griffin, P. C. 79.

(*o*) R. S. C. 1883, Ord. XV. r. 1; *York* v. *Stowers*, W. N. 1883, 174.

(*p*) *Neilson* v. *Betts*, 1871, 5 H. L. 1, per Lord Westbury.

(*q*) *Betts* v. *De Vitre*, 1873, L. R. 6 H. L. 321; *United Horse Shoe and Nail Co.* v. *Stewart*, 1886, 3 P. O. R. at p. 123, per Lord Kinnear.

(*r*) 1888, 5 P. O. R. at p. 436.

1 *Certificate of validity.*—See p. 329.

2 *Subsequent action for infringement:*

Where two actions were in the paper for hearing at the same time, the action heard second was held not to be a subsequent action within this section, so as to entitle the plaintiff to solicitor and client costs (*s*).

The Vice-Chancellor of the Palatine Court of Lancaster has no jurisdiction under this section (*t*) to grant a certificate of validity.

No appeal lies from the decision of a Court or judge as to granting or withholding a certificate under this section (*u*).

See form of certificate of validity, p. 801.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens[1] any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats. Provided that[2] this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Action of threats.

1 *Action of threats.*—See Chap. XV. p. 348; and also Appendix, p. 808.

Former law.

The law, as it existed independently of the present section (which is not retrospective (*v*)), was thus stated by the late Master of the Rolls, giving his own opinion and that of Blackburn, L. J., in *Halsey* v.

(*s*) *Automatic Weighing Co.* v. *International Hygienic Society*, 1889, 6 P. O. R. 480. See further decisions as to solicitor and client costs, *supra*, p. 334.

(*t*) *Proctor* v. *Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. at p. 184.

(*u*) *Haslam Co.* v. *Hall*, 1888, 5 P. O. R. at p. 144.

(*v*) *Sugg* v. *Bray*, 1885, 2 P. O. R. 223.

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Brotherhood (*w*):—"To support the action (for an injunction to restrain threats) the allegations must not only assert the statement to be untrue, but that it was made without reasonable and probable cause. . . . . A man merely giving notice that his rights are being infringed, believing that they are infringed, is not to be subject to an action for giving that notice, even although he does not follow up that notice by bringing an action at law for the infringement." The defendant, however, while not bound to be correct in his statement of the law, was bound to be correct in his statement of facts, and if the threats were not mere allegations of piracy, which is matter of law, but went on to allege untruly matters of fact, an action would lie, whatever the defendant might allege his state of mind to have been (*x*).

Construction of present section.

The following points have been decided as to the construction of the present section:

It contemplates final judgment. This appears from the circumstance that it speaks of damages which could not be obtained on an interlocutory application (*y*).

In order to grant relief at the trial, the Court must be satisfied that, in fact, the instrument complained of and in respect of which the threats were made is not an infringement of any legal rights of the person making the threats (*z*).

The question whether the patent of the person making the threats is a valid patent must come into consideration in the action if the plaintiff seeks it; and, in such a case, a defendant cannot protect himself by the mere production of his letters patent, but must support them as if he were plaintiff in an action for infringement. "Legal right" means "valid right," and not merely a right under an instrument which is legal only so long as it stands unchallenged (*a*).

In applications for *interlocutory* injunctions, the Court ought to consider, not merely the balance of convenience, but whether the plaintiff has a *primâ facie* case (*b*).

To come within the Act, threats need not be made by circular, or advertisement, or something *ejusdem generis*. Threats made by a solicitor's letter are within the Act (*c*); and a letter written "without prejudice" may contain threats within the present section (*d*).

(*w*) 1880-81, L. R. 15 Ch. D. 514; 19 Ch. D. 386. Cp. also *Wren* v. *Weild*, 1869, L. R. 4 Q. B. at p. 737.

(*x*) *Dick* v. *Brooks*, 1880, 15 Ch. D. pp. 39, 40, per Bramwell, L. J.

(*y*) *Challender* v. *Royle*, 1887, 4 P. O. R. at p. 371.

(*z*) *Ibid.*

(*a*) *Ibid.*; differing from Chitty, J., in *Kurtz* v. *Spence*, 1886, 33 Ch. D. at p. 582. See also *Kurtz* v. *Spence*, 1888, 5 P. O. R. at p. 177.

(*b*) *Ibid.*; reversing Bacon, V.-C., *S. C. ibid.* p. 368; *Walker* v. *Clarke*, 1887, 4 P. O. R. 111, per Kay, J., also overruled.

(*c*) *Crampton* v. *The Patents Investment Co.*, 1888, 5 P. O. R. 393.

(*d*) *Kurtz* v. *Spence*, 1888, 5 P. O. R. 173.

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Damages will not in general be allowed where no actual damage has been suggested or sustained (*e*).

Mere threats and warnings as to something which might be done in the future would not fall within the meaning of the word in the present section. "Everybody," said Bowen, L. J., in *Challender* v. *Royle* (*f*), "has still a right to issue a general warning to pirates not to pirate, and to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled, and under which he claims, is one that he intends to enforce. But my language must not be misunderstood on this point. It does not follow that because a threat is so worded as in mere language apparently and grammatically to apply only to the future that therefore it may not be in any particular case in substance and in fact applicable to what had been done. Supposing for a moment that a manufacturer is making and issuing machines which the patentee considers to be an infringement of his patent: if, with reference to that act done or to those machines made the patentee endeavours to guard himself against this section by merely issuing a threat in the air, it seems to me he would not escape if the tone gist of what he has done is to apply that threat to a particular person and a particular act." This language has been interpreted (*g*) to mean that "when a threat is given, there must be something then in respect of which the threatened party could claim a right of action, which must not be wholly with reference to something future or contingent—something proposed to be done." "I do not," adds Justice Kekewich, "understand the Lord Justice to say that if a patentee says, 'You have sold so many hundred-weights or tons of the patented article, and I tell you I shall proceed against you if you sell any more.' That is not a threat within the meaning of the section. I hardly know what the use would be of a threat if it was simply with reference to something which is past."

2 *Proviso.*—The proviso means that *the old law shall apply* if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent (*h*), it is not necessary that this action should be brought against the person aggrieved (*i*). Proviso.

(*e*) *Driffield Linseed Cake Co.* v. *Waterloo Mills Cake Co.*, 1886, 31 Ch. D. at p. 638. Cp. *Kurtz* v. *Spence*, *ubi supra*, at p. 177.

(*f*) *Ubi supra*, at p. 375.

(*g*) *Kurtz* v. *Spence*, 1888, 5 P. O. R. at p. 171, per Kekewich, J.

(*h*) *Challender* v. *Royle*, *ubi supra*, at p. 372. As to due diligence, see *Herrburgher* v. *Squire*, 1888, 5 P. O. R. at 595.

(*i*) *Ibid.* at p. 373. See the language of Cotton, L. J., as to the reason of this rule, at pp. 373, 374.

MISCELLANEOUS.

Sect. 33. Patent for one invention only.

33. Every patent may be[1] in the form in the First Schedule to this Act, and shall be granted for one invention only,[2] but may contain more than one claim;[3] but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.[4]

Form of patent.

1 *Every patent may be, &c.*—See p. 530. The word *may* is permissive. As a matter of fact the form of the grant in the schedule is adhered to, except in so far as necessary variations are requisite in cases where there are several applicants, or an applicant dies, &c. See pp. 533—536.

Rule as to one invention.

2 *One invention only.*—Cp. Patents Rules, 1890, r. 19, p. 566. Where, by mistake, inadvertence, or otherwise, more than one invention is included, the application may be amended and separate patents may be applied for. Every such application may bear the date of the original application.

Unless by implication in this section, the Act neither enables the comptroller to refuse an application on the ground that it claims more than one invention (*k*), nor allows an appeal to the law officer from such a refusal (*l*). In fact, however, the Comptroller-General does exercise this power, and appeals to the law officers have been taken from his decision.

The *test* by which the question of one invention is decided is "the general object of the invention" (*m*).

"If you have a particular general object of an invention," said Herschell, S.-G., in *Jones's Patent* (*m*), "to make rails rest more securely, and you describe one, two, or three cognate devices for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention."

(*k*) Sect. 7, sub-sect. (1), *supra*.
(*l*) Sect. 7, sub-sect. (2), *supra*.
(*m*) *Jones's Patent*, 3 Griffin, P. C. 265; *Hearson's Patent*, 1885, *ibid.* 266; *Robinson's Patent*, *ibid.* 267.

3 *One claim.*—These words appear to have been inserted in the section by mistake. The claim appears in the specification, not in the patent. **Sect. 33.** One claim.

4 No objection can be taken to a patented invention on the ground that it comprises more than one invention after the specifications have been accepted by the comptroller.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.[1] Patent on application of representative of deceased inventor.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

1 *Deceased inventors:*

This section alters the law laid down in *Marsden* v. *Saville Street Foundry and Engineering Company* (*n*).

The application must be accompanied by an official copy of, or extract from, the will of the deceased inventor, or the letters of administration granted of his estate and effects, in proof of the applicant's title. (Patents Rules, 1890, r. 20, p. 566.) Application by representative of deceased inventor.

If the applicant dies before sealing, a patent may be sealed to his executor or administrator (sect. 12 (3 b)).

Where an applicant dies after the acceptance of the provisional, but before the acceptance of the complete, specification, the practice is for the executor or administrator to produce for the inspection of the Comptroller-General probate of the will, or letters of administration of the deceased inventor, and then to carry out the subsequent stages in his own name.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection. Patent to first inventor not invalidated by application in fraud of him.

This is substantially a re-enactment of 15 & 16 Vict. c. 83, s. 10.

(*n*) 1878, 3 Ex. D. 203.

Sect. 35. In the case of *Re Vincent's Patent* (*o*), the sealing of a patent was opposed on the ground of previous public user of the invention; in reply to which the applicant made the case that such user was obtained by fraud on him, so as to bring the case within 15 & 16 Vict. c. 83, s. 10. It was held that the question ought to go before a jury, and that the patent ought to be sealed in order that such a trial might not be precluded.

Assignment for particular places.

36. A patentee may assign[1] 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.

1 *Assignment of patents.*—See Chap. XI. p. 195.
See 15 & 16 Vict. c. 83, s. 35, Appendix, p. 658.
This section applies to existing patents; and a patent granted under the old practice might, therefore, be assigned for the Channel Islands.

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

This section in substance re-enacts 15 & 16 Vict. c. 83, s. 22.
The fee is £2, Form N., *infra*, p. 747.

Proceedings and costs before law officer.

38. The law officers[1] may examine witnesses on oath[2] and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules[3] regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs[4] to be paid by either party, and any such order may be made a rule of the Court.

(*o*) 1867, L. R. 2 Ch. 341.

Sect. 38.

Law officer.

1 *The law officer* means Her Majesty's Attorney-General or Solicitor-General for England (*p*).

Examination of witnesses.

2 *May examine witnesses on oath.*—This provision is new. The Lord Chancellor had, under the old practice, power to examine witnesses *vivâ voce* at the hearing of a petition for the Great Seal to be affixed to letters patent (*q*).

Law Officers' Rules.

3 *And may from time to time make . . . . rules.*—See the Law Officers' Rules, *infra*, p. 589.

Costs.

4 *Power of law officer over costs.*—The Comptroller-General has no power over costs. See Opposition to Grant, p. 173, and Amendment of Specification, p. 156. See also Law Officers' Rules, pp. 592, 593.

When there is no opposition, and the question is only between the Comptroller-General and the applicant, the law officer will not award costs against the Comptroller-General. Under exceptional circumstances the law officer has recommended the fees payable upon appeal to be returned (*r*). In a recent case (*s*), where an applicant for a patent obtained from the law officer a protecting clause, to which he was not absolutely entitled, no costs were allowed to him though successful.

In another case (*t*), the opponent, successful on appeal to the law officer, was allowed costs to cover the stamp on the notice of appeal.

Exhibition at industrial or international exhibition not to prejudice patent rights.

39. The exhibition of an invention at an industrial or international exhibition, certified[1] as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a

(*p*) See definitions, sect. 117, subsect. (1), *infra*.

(*q*) *In re Gething*, 1874, L. R. 9 Ch. 633.

(*r*) Griffin, P. C. p. 16, n.

(*s*) *Newman's Patent*, 1888, 5 P. O. R. 279.

(*t*) *Aire and Calder Works and Walker's Application*, 1888, 5 P. O. R. at p. 347.

Sect. 39. patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice[2] of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of patents and designs exhibited at international exhibitions. Act 1886, s. 3.

It shall be lawful for Her Majesty, by Order in Council,[3] from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, 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 to Her Majesty in Council may seem fit.

1 *Exhibition certified as industrial or international.*—In order to have an exhibition certified under this section application must be made by the authorities controlling the exhibition or by some person interested, to the Board of Trade, and evidence produced to satisfy the Board that the exhibition is of sufficient importance, and, generally, a proper subject for the certificate. Upon being so satisfied a certificate is issued (*u*). The Board of Trade communicates the issue of the certificate to the Patent Office, where a list of such certified exhibitions is kept. The notice of intention to exhibit (*v*), and the description of the invention, are left at the Patent Office, and, if satisfactory, the inventor's name will be registered, and he will then be able to apply for a patent within six months of the opening of the exhibition.

The form of certificate by Board of Trade is given in Appendix, p. 845.

2 *Prescribed notice.*—An intending exhibitor of an unpatented in-

(*u*) See Form O., in Appendix, p. 747.

(*v*) Patents Rules, 1890, r. 15, p. 363, and Form O., p. 747.

vention must (1) give the comptroller seven days' notice (*w*) of his intention to exhibit, publish, or use his invention, and (2) furnish the comptroller with a brief description of the invention, accompanied with drawings, if necessary, and with such other information as the comptroller may in each case require. (Patents Rules, 1890, r. 15.) **Sect. 39.**

This section re-enacts, with modifications, 28 Vict. c. 3, and 33 & 34 Vict. c. 27.

3 The form of Order in Council granting temporary protection to inventions exhibited at the Paris Universal Exhibition, 1889, is given in Appendix, p. 845.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions,[1] as well as reports of patent cases decided by Courts of law,[2] and any other information that the comptroller may deem generally useful or important.[3] Publication of illustrated journal, indexes, &c.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all *complete specifications*[4] *of patents for the time being in force,*[5] with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.[6]

1 *An illustrated journal of inventions.*—The journal forms part of *The Illustrated Official Journal* (*Patents*), which appears every week. As to previous publications, see p. 65.

2 *Reports of Patent Cases.*—These are appended to the official journal. Formerly they were published separately. There were no official reports of patent cases until 1884.

3 *Any other information.*—See Patent Office circular.

4 *Complete specifications.*—Where an application for a patent has been abandoned or become void, the specification or specifications and drawings, if any, accompanying or left in connection with such ap- Abandoned application.

(*w*) Form O., *infra*, p. 747.

Sect. 40. plication, shall not at any time be open to public inspection, or be published by the comptroller.

5 *Specifications of patents in force.*—Printed copies of specifications of patents in force are kept on sale at the Patent Office (Sale Branch), and if the original edition has been exhausted, a further edition will be printed by the comptroller, if the specifications are required, at the public expense. Where the patent has expired, whether by non-payment of renewal fees or otherwise, the comptroller is not bound to keep printed copies on sale, and if the stock has run out any person wanting printed copies must pay the cost of reprinting and lithographing the drawings, if any.

6 *Patent Office publications.*—See list of such publications, *supra*, p. 65.

Patent Museum.

41. The control and management of the existing Patent Museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.[1]

1 *Patent Museum.*—See history of this Museum, sketched *supra*, p. 56.

Power to require models on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

No demand for models seems now ever to be made by the Patent Office. The few additions made to the Patent Museum at South Kensington, appear to be voluntary gifts.

Foreign vessels in British waters.

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything

intended to be sold in or exported from the United Kingdom or Isle of Man. **Sect. 43.**

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.[1]

1 *User by foreign vessels in British waters.*

Prior to 15 & 16 Vict. c. 83, s. 26—of which the present section is substantially a re-enactment—the exclusive rights under an English patent were enforced against foreigners while in England, in the same way and to the same extent as against British subjects.

Therefore, in a case in which the foreign owners of a ship caused to be made in their own country, and attached to their vessel, a steam screw propeller, the manufacture and user of which was unrestrained by law there, but restricted in England by a patent, and afterwards sent the vessel with a cargo for the purpose of trade to England, the use of the steam propeller was restrained by injunction while the vessel should be within the waters covered by the English patent (*x*). *Caldwell* v. *Vanvlissengen.*

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment. Assignment to Secretary for War of certain inventions.

(*x*) *Caldwell* v. *Vanvlissengen*, 1851, 21 L. J. N. S. Ch. 97; 16 Jur. 115.

Sect. 44.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the patent office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any

person authorized by writing under the hand of the Secretary of State to receive it. Sect. 44.

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

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

This section is substantially a re-enactment of 22 Vict. c. 13.

Sect. 44. For "Memorandum for Inventors," issued by the War Office with regard to applications under this section, and as to other inventions or patents, see p. 846.

There have been very few assignments to the Secretary of State for War under the provisions of this section. Applications to the War Office as to inventions, whether patented or not, are made by letter addressed to the Under Secretary of State for War, stating the nature of the invention and the reward asked for, if any, by the inventor.

EXISTING PATENTS.[1]

Provisions respecting existing patents.

45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.[2]

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses.[3]

(3.) In all other respects (including the amount and time of payment of fees)[4] this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.[5]

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the patent office.

Sub-s. 1. 1 *Existing patents.*—This section—especially sub-sect. 3 thereof—must be read to a certain extent with section 113, *infra*. In *Brandon's Patent* (*t*), this matter was discussed. See the remarks on this case at pp. 378—9 and 523.

2 *Applications.*—The applications under the Act of 1852, pending

(*t*) 1884, 1 P. O. R. 154; see also *Singer* v. *Stassen*, 1884, 1 P. O. R. 121.

at the time of the commencement of the Act of 1883, were completed under the procedure laid down in the earlier Act. **Sect. 45.**

3 The provisions as to patents binding the Crown are new in the Act of 1883. See sect. 27. The provisions of sect. 22, as to compulsory licences, are likewise new. The effect of this sub-section is to restrict the operation of these new provisions to applications made after 1st January, 1884. Sub-s. 2.

4 The payment of annual fees on patents applied for under Act of 1852, where the third year's renewal fee of 50*l.* had been paid in lieu of the payment of 100*l.* before the end of the seventh year, was regulated by an order of the Board of Trade, made under their general powers under this Act, in August, 1884.

5 *General effect of Act of* 1883.—This sub-section must be read with sect. 113, and, apparently, in subordination thereto. Sub-s. 3.

In *Singer* v. *Stassen* (*u*), Bowen, L. J., said, that old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains, but the express repeal of the old law contained in sect. 113 is not to affect them. It appears, therefore, that section 18 as to amendment, and sect. 19 as to disclaimer pending action, apply to all existing patents applied for under the Act of 1852 (*x*).

As to the effect of sect. 25 of the Act of 1852, providing for the falling of a British patent with any prior foreign patent, see the notes to that section at p. 655, also *Blake's Patent*, 1873, L. R. 4 P. C. 535; and *Winan's Patent*, 1872, L. R. 4 P. C. 93.

DEFINITIONS.

46. In and for the purposes of this Act— Definitions of patent, patentee, and invention.

"Patent"[1] means letters patent for an invention:

"Patentee"[2] means the person for the time being entitled to the benefit of a patent:

"Invention"[3] means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

1 *Patent.*—As to other grants by letters patent, see pp. 1 and 2.

(*u*) *Supra.*

(*x*) *Singer* v. *Stassen*, *supra.*

Sect. 46.

2 *Patentee.*—This definition includes an executor, administrator, or assignee; and "person" includes persons. (See 13 & 14 Vict. c. 21, s. 4, and also *Powell* v. *Head*, 1879, L. R. 12 C. D. at p. 686.)

3 *Invention.*—As to subject-matter of patents, see Chap. IV. pp. 15 *et seq.*

By the definition of "invention" here given, the law as to what inventions are valid subject-matter for a patent is retained intact as it existed prior to the Act of 1883.

Part V.

GENERAL.

PATENT OFFICE AND PROCEEDINGS THEREAT.

Patent Office.

82. (1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.[1]

(2.) Until a new patent office is provided,[2] the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks,[3] who shall act under the superintendence and direction[4] of the Board of Trade.[5]

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

1 *The Patent Office.*—For a full account of the history and present constitution of the Patent Office, and of the business transacted therein, see Chap. V. pp. 49 *et seq.*

2 *New Patent Office.*—No new Patent Office has been provided. The former "Great Seal Patent Office" is still under the name of the "Patent Office," the building in which the official patent business is carried on.

3 *The Comptroller-General.*—The comptroller has the general superintendence of the patent office under the Board of Trade.

4 *Who shall act under, &c.*—The comptroller is further enabled by sect. 95, *infra*, to apply to either of the law officers for directions in any case of doubt or difficulty.

5 *The Board of Trade.*—There is no definition of the Board of Trade in the Act. It is defined, however, in 24 & 25 Vict. c. 47, s. 65.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks,[1] and so many examiners[2] and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries[3] of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

1 *Appointment of Comptroller.*—Mr. H. Reader Lack was appointed Comptroller-General on the new Act coming into force.

2 *Examiners.*—See Chap. V. pp. 60 *et seq.*

3 As to salaries of such officers and clerks, see Comptroller-General's Report for 1889.

Seal of patent office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

Letters patent for inventions are now sealed with the seal of the Patent Office. In this respect only the seal of the Patent Office has the same effect as the Great Seal of the United Kingdom, see sect. 12, *supra*.

Trust not to

85. There shall not be entered in any register kept

Sect. 85. be entered in registers.

under this Act,[1] or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

1 *Any register kept under this Act.*—As to the Register of Patents, see sect. 23, and Chap. XII. pp. 207 *et seq.*

It was formerly the practice to enter on the Register of Proprietors deeds of trust relating to patents. And in *Re Morey's Patent* (*y*) it was held that this register might contain not only a register of documents, but any other facts relating to proprietorship of which the Court might think fit to order the insertion.

As a matter of fact, many deeds which are now filed in the Patent Office contain declarations of trust in favour of other parties. But in the notification of the deed in the register itself, no notice is taken of the trust.

Refusal to grant patent, &c., in certain cases.

86. The comptroller may refuse[1] to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

1 *Refusal of comptroller.*—As to exercise of discretionary power by comptroller, see Patents Rules, 1890, rr. 11—14, pp. 562, 563.

The refusal of the comptroller under this section cannot be appealed against to the law officer.

It is stated that under this section a patent has been refused for an apparatus for a lottery (*z*).

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment,[1] transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register[2] of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to **the provisions of this Act and**

Act 1888, s. 21.

(*y*) 1858, 6 W. R. 612; 25 Beav. 581. (*z*) Griffin, P. C. p. 30.

to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Generally.

1 *Assignment, &c.*—Although the sixth section of the Statute of Monopolies excepts grants to inventors only, the legality of a limitation of the privilege to executors, administrators, and assigns was never questioned (*a*).

It was, however, considered that, without express words of limitation in the patent, the grant would be personal merely, and the privilege would cease upon the death of the patentee during the term (*b*); and the form of letters patent contained a proviso against assignment at first to more than *five* (*c*), and afterwards (*d*) to more than *twelve* persons.

This proviso, however, applied to assignments by act of parties merely, and not by operation of law (*e*).

As to assignments and licences generally, see Chap. XI.

As to assignments to Secretary of State for War, see sect. 44, *supra*.

As to the Register of Patents, see sects. 23, 85, 87—91, 93 and 114.

See also Patents Rules, 1890, rr. 67—79, *infra*.

For form of request, see Patents Rules, 1890, Form L. at p. 746. The stamp is 10*s*., see Schedule of Fees, p. 587.

Assignment of share or for district.

Under the present Act, a right of assignment for particular districts or places is expressly given (*f*); but the right to assign the patent itself depends, as formerly, upon the terms of the letters patent.

A patentee may assign any part or share of his patent (*g*), or the entirety of the patent so far as it relates to a separate and distinct part of the invention (*h*); and the assignee, whether of a share or of

(*a*) Hindmarch, p. 58.

(*b*) *Ibid.*; and *Duvergier* v. *Fellows*, 1830, 10 B. & C. 826.

(*c*) This rule sometimes proved inconvenient, because, with only five persons an inventor might be unable to raise sufficient capital to carry his invention into effect. It was avoided by putting in names under licenses or as trustees for others: Report, 1829, p. 12.

(*d*) In 1832.

(*e*) *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169.

(*f*) Sect. 36.

(*g*) *Walton* v. *Lavater*, 1860, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

(*h*) *Dunnicliff* v. *Mallett*, 1859, 29 L. J. C. P. 70; 7 C. B. N. S. 209.

Sect. 87.

the entirety, takes the legal interest, and is not to be considered merely as a licensee (*i*).

"In the case of a patent belonging to several persons in common," says Lindley, L. J., in his work on Partnership (*k*), "each co-owner can assign his share, and sue for an infringement, and can also work the patent himself, and give licenses to work it; and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses."

It appears to be the law that while an assignee cannot sue until his assignment has been registered, registration relates back to the date of the assignment (*l*).

Under a covenant in a deed of assignment to communicate improvements to the assignees, a patentee cannot be restrained from giving evidence against the assignees as a scientific witness, under a subpœna; nor can he be prevented from disclosing any information in his possession which may tend to show that the patents assigned were invalid (*m*). During an action for infringement, the defendants assigned their business, and then obtained an order in chambers to add the assignees as third parties. On appeal to the judge in Court the order was discharged (*n*).

2 *The Register of Patents.*—See note to sect. 23, *supra*, p. 463.

Inspection of and extracts from registers. **Act 1888, s. 22.**

88. Every register[1] 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,[2] 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.[3]

1 *Every register, &c.*—See sect. 23. For the hours of inspection, see Patents Rules, 1890, r. 78.

2 *And certified copies.*—See sect. 96.

(*i*) *Walton* v. *Lavater*, *ubi supra*, at p. 184.

(*k*) Pages 68, 69.

(*l*) *Chollett* v. *Hoffman*, 1857, 26 L. J. Q. B. 249; 7 E. & B. 686; and *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 510, per Malins, V.-C.

(*m*) *London and Leicester Hosiery Co.* v. *Griswold*, 1886, 3 P. O. R. 251.

(*n*) *Briggs* v. *Lardeur*, 1885, 2 P. O. R. 13.

3 *Prescribed fee.*—The fee for a copy is 4*d.* per folio, but not less than 1*s.* in all.

If the copy is to be certified the fee is 1*s.* for certifying, plus the cost of copying.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

This section re-enacts, with alterations, 16 & 17 Vict. c. 115, s. 4. By that Act, the sealed copies were admissible in evidence in all proceedings *relating to letters patent for inventions*. See also Patents Rules, 1890, r. 79.

The register is *primâ facie* evidence of any matters by this Act directed or authorised to be inserted therein (*o*).

Rectification of registers by Court. Act 1888, s. 23.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person **or of any other particulars** from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall

(*o*) Sect. 23, sub-s. (2).

Sect. 90. direct that due notice of the rectification be given to the comptroller.[1]

1 The order when received by the comptroller is notified in the register and a copy filed.

For the general practice under this section, see Chap. XII., on the Register of Patents.

For form of motion to rectify register, see Appendix, p. 776.

For form of order thereon, see Appendix, p. 777.

Scope of section.

This section applies to all the subjects comprised in the present Act, the provisions of 15 & 16 Vict. c. 83, s. 38, by which the jurisdiction was given to the Master of the Rolls, to the Courts of common law in term time, and to any judge of the said Courts in vacation.

Appeals.

Orders made under that section could not be appealed against (*o*), but the jurisdiction of the Master of the Rolls over patents having passed under the Judicature Act, 1873, s. 16, sub-s. (1), to the High Court, orders made under the present section are subject to appeal like any other orders of Court (*p*).

The following cases will illustrate the practice under the Patent Law Amendment Act, 1852, s. 38:—

Cases under Patent Law Amendment Act.

A patentee (*q*) having assigned his patent to persons who omitted to register the assignment, afterwards *fraudulently* (*r*) assigned the patent to another person, who registered it on the same day. The Court, on the motion of the first assignees, registered their assignment a week afterwards. The Court, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs.

A patentee (*s*) assigned half his patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a license to work and use to A. B.'s assignment was first registered. It was held that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A. subsequently entered.

It was also held, in this case, that the Court could, in a motion under 15 & 16 Vict. c. 83, s. 38, direct any *facts* relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them.

(*o*) *In re Horsley and Knighton's Patent*, 1869, L. R. 4 Ch. 784.

(*p*) *Re Morgan's Patent*, 1876, 24 W. R. 246; *Re Myers' Patent*, W. N. 1882, 53, 56.

(*q*) *Re Green's Patent*, 1857, 24 Beav. 145.

(*r*) That the second assignment was fraudulent appears from *Re Morey's Patent*, 1858, 25 Beav. 581.

(*s*) *In re Morey's Patent*, 1858, 25 Beav. 581.

One of two joint patentees (*t*), by deed, assigned his interest in the patent to a third person, and released to him all the rights of action, &c., against him, of both the patentees, and the deed was set out completely in the register of proprietors. It was held that the other patentee was entitled under 15 & 16 Vict. c. 83, s. 38, to have the entry struck out.

In *Re Berdan's Patent* (*u*), it was held that the Master of the Rolls, as keeper of the records, had power to order a disclaimer filed without the consent of the patentee to be taken off the register.

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing[1] accompanied by the prescribed fee,[2]—

(a) Correct any clerical error in or in connexion with an application for a patent,[3] or for registration of a design or trade mark; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(c) [This sub-sect. relates only to trade marks.]

(d) [Same as (c).]

Act 1888, s. 24.

1 *Request in writing.*—See Form P., *infra*, p. 747.

2 *Prescribed fee.*—Fee No. 36, p. 587.

3 *Clerical errors.*—As to jurisdiction of Master of Rolls, see p. 144. As to jurisdiction of comptroller, see p. 166.

According to sect. 91 only clerical errors in connection with patent applications can be corrected, but by virtue of Rule 16, *infra*, p. 564, clerical errors in a specification after grant of patent can be corrected.

Alteration of registered mark.

92. [This section relates only to trade marks. It is given in Appendix, at p. 716.]

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced

(*t*) *In re Horsley and Knighton's Patent*, 1869, L. R. 8 Eq. 475.

(*u*) 1875, L. R. 20 Eq. 347.

Sect. 93. or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

This is an application to all the registers kept under the new Act of 15 & 16 Vict. c. 83, s. 37.

See Chap. XVII., p. 368, on Offences and Penalties.

As to punishment of misdemeanours in Isle of Man, see sect. 112, p. 522.

This offence being a misdemeanour, the punishment would be fine or imprisonment, with or without hard labour, for a period not exceeding two years.

Exercise of discretionary power by comptroller.

94. Where any discretionary power[1] is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant)[2] giving the applicant an opportunity of being heard personally or by his agent.

1 Cp. Patents Rules, 1890, r. 11, *infra*, p. 562.

This is a most important provision in favour of patentees, &c.

2 *If so required.*—Form E., *infra*, p. 741.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

By sect. 82, sub-s. (3), the comptroller acts under the superintendence of the Board of Trade. In this Act the Board of Trade replaces the Commissioners of Patents of the Act of 1852.

Applications to the law officers are not infrequently made under this section, especially in cases of legal questions arising as to the construction of provisions of the Act in the practice of the Patent Office.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized 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. Sect. 96.

Patents Rules, 1890, r. 79, Form Q., *infra*, p. 748. The comptroller generally gives his decisions on oppositions and amendments in writing.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorized or required to be left, made, or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

These very useful provisions are made much use of in practice.

In *Trotter* v. *Maclean* (*x*), a witness produced a copy of a letter which he said he had made, and swore that he should in the ordinary course of business have posted the original, and it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

See Patents Rules, 1890, r. 7, p. 561.

(*x*) 1879, L. R. 13 Ch. D. 574.

Sect. 98. As to enlargement of time, Patents Rules, 1890, r. 51, p. 577.
As to hours for inspection of register, *ibid.* r. 78, p. 584.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

So long as the necessary documents are prepared in the prescribed manner there is nothing to prevent the grant of a patent to an infant, and the age, sanity or coverture, of an applicant is in no way inquired into by the office or referred to in any of the proceedings to obtain a patent.

In the case of an inventor becoming insane before applying for his patent, it is presumed the application might be made for him under this section. Also that other steps might, under this section, be taken for him in the event of insanity after application.

See Patents Rules, 1890, r. 80, as to the power of the comptroller to dispense with evidence.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland,

and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals. Sect. 100.

See sect. 40, p. 495.
This section re-enacts, with modifications, 16 & 17 Vict. c. 115, s. 5.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

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

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

(b) For classifying goods for the purposes of designs and trade marks:

(c) For making or requiring duplicates of specifications, amendment, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:

(e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public autho-

Sect. 101.

rities, bodies and institutions at home and abroad:

(g) Generally for regulating the business of the patent office, and all things by this Act, placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.[1]

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.[2]

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.[3]

1 Alterations were made by the Patents Rules, 1883, rr. 5 and 6; and the Patents Rules, 1885, rr. 4 and 5. See now Patents Rules, 1890, rr. 5 and 6, pp. 560, 561.

2 General rules were framed after the passing of the Act and before its coming into operation, and the rules took effect from the 1st January, 1884.

3 Sub-sections (4) and (5) incorporate the usual provisions where the rules are subject to an Act to have the force of statute law.

Sect. 102.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report[1] respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade. Act 1888, s. 25.

102a. (1.) All things required or authorized 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 authorized 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.

1 This Report is made annually, and is the continuation of the Commissioners of Patents Annual Reports made under the Act of 1852. The report is usually issued in June. The first report was made on the working of the Act of 1883 for the first three months of 1884. Afterwards a report was made for the whole year, and there is now one report a year under this section.

The report of the comptroller gives information, amongst other things, upon the following matters (so far as patents are concerned):—

The number of applications and patents sealed.

A table of the sources whence the applications come, giving the number of applications from persons in the United Kingdom and in various countries and colonies.

The number of applications by way of communication.

The number of applications under the International Convention.

The number of patents remaining in force.

The publications of the Patent Office and of the grants made to various libraries, &c.

Particulars of amendments, oppositions, applications for prolonga-

Sect. 102. tion to Privy Council, applications to Board of Trade for compulsory licences, &c.
An account of the receipts and expenditure of the office.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International arrangements for protection of inventions, designs, and trade marks.

103. (1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states[1] for mutual protection of inventions, designs, and trade marks, or any of them,[2] then any person[3] who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants;[4] and such patent or registration shall have the same date as the [*date of the protection obtained*] **date of the application**[5] in such foreign state.

Act 1885, s. 6.

Provided that his application is made, in the case of a patent within seven months,[6] and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication,[7] in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the

patent which may be granted for the invention, or the registration of the design or trade mark: Sect. 103.

(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,[8] under this Act: provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council[9] declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

1 *Arrangements with foreign States.*—For a complete list of the States with which such arrangements have been made, see *ante*, p. 411.

2 *Mutual protection of inventions, designs, and trade marks.*—The International Convention seems to contemplate a wider scope, but its operation in Great Britain appears to be limited to the subjects above mentioned, except in so far as the ordinary legal remedies are equally available to foreigners and British subjects.

3 *Any person.*—*Semble* a corporation is a "person," and can claim rights under this section (*y*).

A patent under the International Convention and sect. 103 can be granted only to the person who has made the foreign application (*z*). A communicatee of an invention from abroad cannot claim any rights under this section (*a*).

"Person" includes citizen and foreigner alike (*b*).

In *Main's Patent* (*c*), Webster, A.-G., held that an applicant was entitled to have his English application ante-dated, although his foreign application was made before the country in which it was made had come under sect. 103.

(*y*) *Re Carez*, 1889, per Webster, A.-G., 6 P. O. R. at p. 552 and see sect. 117, *infra*, p. 525.
(*z*) *S. C. ubi sup.*
(*a*) *Re Shallenberger*, 1889, per Webster, A.-G., 6 P. O. R. at p. 551.
(*b*) *Re Shallenberger*, *ubi supra*.
(*c*) 1890, 7 P. O. R. 13.

Sect. 103.

4 *In priority to other applicants.*—See *L'Oiseau and Pierrard* (*b*), *supra*, p. 415.

This section does not give a foreign applicant any right of opposing, under sect. 11, the grant of a subsequent patent (*c*).

5 *Date of the application.*—These words were, at the instigation of Lord Herschell (*L'Oiseau and Pierrard, ubi sup.*), substituted for the words in italics by sect. 6 of the Act of 1885.

6 See the International Convention, Art. 4, p. 604.

7 See the International Convention, Art. 4, p. 604.

8 See the procedure to be followed under this section in the Patents Rules, 1890, rr. 24—29, pp. 568 *et seq.*

9 See complete table of these Orders in Council, *supra*, p. 411.

The general effect of this section and its relation to the International Convention are discussed at pp. 408 *et seq.*

Provision for colonies and India.

104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession[1] has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time by Order in Council[2] to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

1 *British possession.*—See sect. 117, sub-s. (1).

2 *Order in Council.*—See complete list of such Orders in Council, *supra*, p. 411.

(*b*) 1887, Griffin, A. P. C. 36.

(*c*) *Re Everitt*, 1888, Griffin, A. P. C. 28.

OFFENCES.

Sect. 105.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purpose of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

This section is based upon 5 & 6 Will. IV. c. 83, s. 7.

A person cannot mark his invention "patented," although he has (a) applied for a patent (*d*), or (b) obtained provisional protection (*e*), unless or until a complete specification has been accepted, in which case it appears that under sect. 15 the applicant is entitled to do so. But see the Patent Office Circular of Information, where the contrary is stated.

This section does not apply to a case of false representation of an expired patent as still subsisting (*f*).

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

(*d*) *Reg.* v. *Crampton*, 1886, 3 P. O. R. 367.

(*e*) *Reg.* v. *Wallis*, 1886, 3 P. O. R. 1.

(*f*) *Cheavin* v. *Walker*, 1877, L. R. 5 Ch. D. 863; *Marshall* v. *Ross*, 1869, L. R. 8 Eq. 651.

SCOTLAND, IRELAND, ETC.

Sect. 107. Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor,[1] shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

1 *An assessor.*—Sect. 28, p. 480.

United Horse Shoe & Nail Company v. *Stewart* (*g*), and *Mackie* v. *Berry* (*h*) were tried before a Lord Ordinary of the Court of Session (Lord Kinnear) and an assessor—the late Mr. Fleeming Jenkin, Professor of Engineering in Edinburgh University.

Summary proceedings in Scotland.

108. In Scotland any offence[1] under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

1 *Offence.*—As to what are offences under the Act, see Chap. XVII. p. 368.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in

(*g*) 1885, 2 P. O. R. 127. (*h*) 1885, 2 P. O. R. 146.

respect of a patent as if the same had been granted to extend to Ireland[1] only. Sect. 110.

1 *Ireland.*—Prior to the Act of 1852, an English patent did not extend to Ireland or Scotland, see *infra*, pp. 551 *et seq.*

Under the Act of 1852, Ireland, as well as Scotland, was embraced in the grant, but sect. 29 of that statute contained a saving clause similar in terms to the present section. In *Bovill* v. *Finch* (*i*), a case decided under the old law, three separate original letters patent had been granted in 1849, to an inventor for England, Scotland and Ireland respectively. The Scotch patent was void for want of novelty, and afterwards a prolongation of the terms of the three original patents was granted by one and the same letters patent under the Great Seal of the United Kingdom, pursuant to 15 & 16 Vict. c. 83. It was held, that the grant of prolongation was divisible, and operated as if there had been separate grants by separate instruments for the three countries, so that the prolongation of the English patent was not rendered void by the invalidity of the Scotch patent. In delivering judgment, however, Montague Smith, J., said, "We do not, however, deem it necessary to decide what would be the effect of the want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal."

General saving for jurisdiction of Courts.

111. (1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register[1] under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other

(*i*) 1870, L. R. 5 C. P. 523.

Sect. 111. authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

1 *Rectification of register.*—See notes to sect. 90, p. 507, and Chap. XII. pp. 207 *et seq.*

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(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.

Jurisdiction of Lancashire Palatine Court. Act 1883, s. 26.

112a. [This section relates only to Trade Marks. It is given in the Appendix, at p. 722.]

REPEAL, TRANSITIONAL PROVISIONS, SAVINGS.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enact-

ments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or **Sect. 113.**

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Construction of principal Act. Act 1888, s. 27.

See also section 45, *supra*, and the notes thereto.

The provisions of sub-section (a) must be read distributively, and if so read they declare that the enactments of the Act of 1883 shall not affect any patent granted before the commencement of the Act; and they also declare that those enactments shall not affect any *right or privilege* which had accrued to the patentee before or at the commencement of this Act. The privilege enjoyed by a patentee under the Act of 5 & 6 Will. IV., of applying for a prolongation of his patent at any time before its expiration, is a right included in the express reservation of the present section (*k*).

In *Singer* v. *Stassen* (*l*), the effect of this section upon the general body of the Act, as it affects patents applied for under the Act of 1852, was very fully considered in the Court of Appeal. In this case, an action of infringement was commenced in 1883, and in 1884 an application was made by the plaintiff for liberty to apply at the Patent

(*k*) *Brandon's Patent*, 1884, 1 P. O. R. 164.

(*l*) 1884, 50 L. T. 326. Cp. also *Hearson's Patent*, 1884, Griffin, P. C. 310.

Sect. 113. Office for leave to amend his specification by way of disclaimer. The defendants objected that sect. 19 of the Act of 1883 did not apply to actions pending at the date of its coming into operation, and that the right of the defendants not to have a disclaimer put in evidence in such an action, by virtue of the proviso of 5 & 6 Will. IV. c. 83, s. 1, was saved by sect. 113 of the Act of 1883. Bowen, L. J., summarised the effect of sect. 113 on the effect of the Act of 1883 on patents applied for under the Act of 1852, as follows:—"Old patent rights and old patent liabilities are affected by the substantial legislation which the statute contains, but the express repeal of the old law contained in sect. 113 is not to affect them. They will be still protected by the keeping in force for their benefit of any of the old enactments which are required to safeguard vested rights or interests to the extent to which sect. 113 means it to apply. There is nothing, therefore, which prevents sect. 19 applying to old patents and old patent rights."

See also the trade marks cases—*Hayward's Trade Marks* (*m*), and *Jackson* v. *Napper* (*n*), and the *Design case* (*o*).

Former registers to be deemed continued.

114. (1.) The registers of patents and of proprietors[1] kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

1 *Old registers.*—See Chap. XII. pp. 207 *et seq.*, where the relation of the Register of Patents and the Register of Proprietors under the Act of 1852, to the Register of Patents and the accompanying *file* under the Act of 1883, is explained.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they

(*m*) 54 L. J. Ch. N. S. 1003.
(*n*) L. R. 35 C. D. 162.
(*o*) *Willman* v. *Oppenheim*, L. R. 27 C. D. p. 260.

had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act. Sect. 115.

See Patents Rules, 1890, r. 81. New rules for Patents, Designs and Trade Marks were issued early in 1890, consolidating and amending previous rules made under this Act, which were repealed. For a note on the previous rules relating to Patents, see pp. 585, 586.

116. Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof. Saving for prerogative.

As to effect of patent against Crown, see sect. 27, *supra*, p. 478.

This section is very important. Apparently, under it, there is nothing to prevent the Crown granting a patent for an invention altogether outside the procedure laid down in the Patents Acts, 1883—88, provided only the grant be within the common law prerogative, as modified by the Statute of Monopolies.

GENERAL DEFINITIONS.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,— General definitions.

"Person"[1] includes a body corporate:

"The Court"[2] means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller General of Patents, Designs, and Trade Marks:

Sect. 117.

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

Register of patent agents. Act 1888, s. 1.

(1.) After the first day of July one thousand eight hundred and eighty-nine 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.[3]

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules[4] as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bona fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.[5]

(4.) If any person knowingly describes himself as a patent agent

in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds. Sect. 117.

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

1 *Person* includes a company registered under the Act of 1862. A body corporate may be registered as proprietors by its corporate name. (Patents Rules, 1890, r. 73.)

2 *The Court* does not include the Court of Chancery of the County Palatine of Lancaster (*p*). But see sect. 112a, added by the Act of 1888, as to trade marks, the registration whereof is applied for in the Manchester office.

3 *Patent agents.*—Prior to this Act, there were no means of excluding unqualified persons from acting as patent agents; and the Parliamentary Reports of 1851 and 1865 contain abundant evidence of the inconvenience and expense to which the absence of any such provision might give rise.

The profession of a patent agent has not been carried on in this country as a separate branch of business more than seventy years.

Prior to the passing of the Patent Law Amendment Act, 1852, a patent agent's business was of a comparatively limited character, as at that time only about 550 patents were taken out annually in England.

Under the Patent Law Amendment Act the number of patents annually obtained greatly increased, and patents were taken out by British subjects abroad much more frequently than formerly.

A communication with a patent agent is not privileged, though he is a solicitor (*q*).

It is hardly necessary to add that a patent agent is liable to his principal for fraud or negligence (*r*).

4 *Register of Patent Agents Rules.*—These rules were issued by the Board of Trade on the 11th June, 1889. The Institute of Patent Agents was thereby intrusted, under the Board of Trade, with the care of the Register of Patent Agents, and the control of the qualifying examinations for admission to the register, &c. For the rules at length, see Appendix, pp. 856 *et seq.*

The Institute of Patent Agents was incorporated as the "Institute of Patent Agents," as an association limited by guarantee, on the 12th August, 1882, under the Companies Acts, 1862 to 1880; and the

(*p*) *Proctor* v. *Sutton Lodge Chemical Co.*, 1868, 5 P. O. R. 184.
(*q*) *Moseley* v. *The Victoria Rubber Co.*, 1886, 3 P. O. R. 355.
(*r*) *Lee* v. *Walker*, 1872, L. R. 7 C. P. 121.

Sect. 117. use of the word "limited" was dispensed with by license of the Board of Trade, under the Companies Act, 1867, s. 23.

A royal charter of incorporation has recently been applied for, in which it is proposed that follows of the institute should be entitled to describe themselves as "chartered patent agents."

5 This sub-section preserves the rights of existing practitioners, and entitles them to be placed upon the register without examination.

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Section 5.

FORM A.

[£1 Stamp.] FORM OF APPLICATION FOR PATENT.

(*This Form is replaced by Forms A, A1, Patents Rules*, 1890, *see pp.* 737, 738.)

I, John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do solemnly and sincerely declare that I am in possession of an invention for† "Improvements in Sewing Machines;" that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.*

And I make the above solemn declaration conscientiously

believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

‡*John Smith.*

Declared at Birmingham, in the county of Warwick, this day of 18 .

Before me,

§*James Adams,*

Justice of the Peace.

NOTE.—*Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act*, 1835," *must be omitted; and the declaration must be made before a British consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.*

* *Here insert name, address and calling of inventor.*
† *Here insert title of invention.*
‡ *Signature of inventor.*
§ *Signature and title of the officer before whom the declaration is made.*

FORM B.

FORM OF PROVISIONAL SPECIFICATION.

(*This Form is replaced by Form B, Patents Rules*, 1890, *see p.* 740.)

*Improvements in Sewing Machines.**

I,† *John Smith, of* 29, *Perry Street, Birmingham, in the county of Warwick, Engineer, do hereby declare the nature of my invention for "Improvements in Sewing Machines," to be as follows:—*‡

* * * * * *

§*John Smith.*

Dated this day of 18 .

NOTE.—*No stamp is required on this document.*

* *Here insert title as in declaration.*
† *Here insert name, address, and calling of inventor as in declaration.*
‡ *Here insert short description of invention.*
§ *Signature of inventor.*

FORM C.

[£3 Stamp.] FORM OF COMPLETE SPECIFICATION.

(*This Form is replaced by Form C, Patents Rules*, 1890, *see p.* 740.)

*Improvements in Sewing Machines.**

I,† John Smith, of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, do hereby declare the nature of my invention for "Improvements in Sewing Machines," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:—‡

* * * * *

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is§

1.

2.

3. *&c.*

‖ *John Smith.*

Dated this day of 18 .

* *Here insert title as in declaration.*
† *Here insert name, address, and calling of inventor as in declaration.*
‡ *Here insert full description of invention.*
§ *Here state distinctly the features of novelty claimed.*
‖ *Signature of inventor.*

Section 33.

FORM D.

FORM OF PATENT.[1]

Style and address (*a*).

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:[2]

Recital of

Whereas *John Smith*, of 29, *Perry Street, Birmingham*,

(*a*) These side-notes do not appear in the Queen's Printers' copy.

in the county of *Warwick*, *Engineer*, hath *by his solemn declaration* (*b*) represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief: declaration and invention.

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention: Petition of inventor.

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention: Recital of specification of invention.

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:[3] Recital of motive.

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion[4] do by these presents, for us, our heirs and successors,[5] give and grant[6] unto the said patentee[7] our especial licence, full power, sole privilege, and authority,[8] that the said patentee by himself, his agents, or licensees,[9] and no others, may at all times hereafter during the term of years herein mentioned, make,[10] use, exercise, and vend[11] the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man,[12] in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention,[13] The grant, to patentee, &c. Extent of grant.

(*b*) *By his solemn declaration.*—These words are now omitted, since an applicant makes no solemn declaration, but merely an ordinary declaration without any formalities, as under the Statutory Declarations Act, 1885, which was contemplated by the original forms of this schedule. By the new forms of the Patents Rules and the Act of 1885, sect. 2 (see *supra*, p. 430), there is now no *solemn* declaration, if *solemn* means something beyond a simple declaration.

Term of grant.

during the term of fourteen years[14] from the date[15] hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We

Prohibition against infringement.

do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:[16] Provided that these

Proviso for revocation by Crown or Privy Council.

our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained:[17] Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and

Proviso avoiding patent if renewal fees not paid.

in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained:[17] Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted:[17] And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.[18] In witness whereof we have caused these our letters to be made patent this[19] one thousand eight hundred and and to be sealed as of the one thousand eight hundred and[20]

Proviso in connection with Act of 1883, s. 27, sub-s. 2.

Proviso as to licenses.

Favourable construction.

Date.

Seal of Patent Office.[21]

Seal.

1 *Form of patent.*—The form here given is only applicable to the case of a single inventor, and it is obvious that considerable alterations must be made in the recitals, and the details of the wording of the patent in the very various forms which a grant may take. If there be several joint inventors, or several joint applicants, one or more of whom only are inventors, or in the case of applications by agents as importers, or where one of the applicants dies, or where an inventor dies before application, in all these cases alterations in the recitals and text of the patent must be made.

Variations in the form of patent.

It will be observed, that by the Act of 1883, s. 33, *supra*, p. 490, a patent *may* be in this form. Nothing is said about other forms, and there

are no rules issued by the Board of Trade on the subject. It has, however, always been customary to vary the formal parts of the patent as it is required in the office; and, indeed, several forms are printed for use, and these meet all the commoner cases. To meet rarer cases, one of the printed forms is altered in red ink. The printed forms in use have been much more fully punctuated than this form in the schedule; and in all of them the words "*by solemn declaration*" are now omitted.

There are kept in the Patent Office, in stock, eight forms, marked A, B, C, D, E, EE, F and G.

Form A. Grant to single inventor.

A is the form of grant to a single inventor, and follows the form in the schedule, except that, as with all the printed forms, the words "*by his solemn declaration*" are omitted, and the punctuation is fuller.

Form B. Joint applicants.

B is the form of grant to several joint applicants, all of whom are actual inventors. Where necessary the plural is used instead of the singular.

Form C. Importers.

C is the form of grant of a patent of communication, and the recitals are different. The patent runs—

VICTORIA, &c., greeting:

Whereas hath represented unto us that he is in possession of an invention for , that the said invention has been communicated to him from abroad, by , and that the same is not in use by any other person, to the best of his knowledge and belief:

And whereas the said declarant hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent for the sole use and advantage of the said invention:

And whereas the said declarant hath by and in his complete specification particularly described the nature of the said invention:

&c., &c., &c.

and then continues as in schedule.

Form D. Several applicants some inventors.

D is the form of grant to several applicants. It is in the plural throughout, and the recitals are slightly different. It runs—

VICTORIA, &c., greeting:

Whereas have represented unto us that they are in possession of an invention for , that the true and first inventor thereof, and that the same is not in use by any other person, to the best of their knowledge and belief:

And whereas the said applicants have humbly prayed that we would be graciously pleased to grant unto them (hereinafter, together with their executors, administrators, and assigns, or any of them, referred to as the said patentees) our royal letters patent for the sole use and advantage of the said invention:

And whereas the said applicants have by and in their complete specification particularly described the nature of the said invention:

&c., &c., &c.

E applies to cases where the inventor dies after the application for the patent and before the complete specification is left. It runs— Form E. Deceased inventor.

VICTORIA, &c., greeting:

Whereas represented unto us that he was in possession of an invention for that and that the same was not in use by any other person, to the best of his knowledge and belief:

And whereas the said declarant humbly prayed that we would be graciously pleased to grant unto him our royal letters patent for the sole use and advantage of his said invention:

And whereas the said declarant departed this life on the :

And whereas the said hath by and in his complete specification particularly described the nature of the invention:

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to grant to the said (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our royal letters patent:

&c., &c., &c.

the grant being to an executor or administrator.

EE is the same except that two or more executors are supposed to have the grant conferred on them jointly after the recital And whereas the said declarant departed this life, &c.; the rest of the patent is in the plural of Form E. Form EE. Grant to executors.

F.—This applies to the case of a female applicant, and is the same as Form A, except that *he* is changed to *she*, &c., as required. Form F. Feminine.

G.—This applies to the case of several joint applicants where one of the applicants die. It runs:— Form G. An applicant deceased.

VICTORIA, &c., greeting:

Whereas represented unto us that they were in possession of an invention for that and that the same was not in use by any other person, to the best of their knowledge and belief:

And whereas the said declarants humbly prayed that we would be graciously pleased to grant unto them our royal letters patent for the sole use and advantage of their said invention:

And whereas the said declarant departed this life on the :

And whereas the said have by and in their complete specification particularly described the nature of the invention:

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to grant to the said (hereinafter, together with their executors, administrators and

assigns, or any of them, referred to as the said patentees) our royal letters patent:

It will be observed that this form is framed so as to be easily altered to suit varying circumstances.

The *style* and *address*.

2 *Victoria* . . . . *greeting*.—These words constitute what are called in the old treatises the *style* of the Sovereign, and the *address* or *direction* to her subjects in general.

Letters patent commence in the name of the Sovereign, because although issued, formerly from the Court of Chancery, and now from the Patent Office(*c*), they are made by the Sovereign as the head of the executive Government, acting with the advice of her ministers, on behalf of the whole community; and the grant is made in her name in order that the authority by which the privilege is created and granted may be thus announced to all those who reside within that part of the United Kingdom to which the patent privilege extends (*d*).

For the *styles* formerly used by the Kings of England in letters patent, see Co. Litt. 7 a, 7 b; 2 Inst. 1. See also a form of grant in 1617, by James I., before the Statute of Monopolies, in the Appendix, at p. 848.

Letters patent are directed to all persons to whom they shall come, because they are public records, and all persons are bound to take notice of the grants which they contain. It is no defence for an infringer to allege that he was ignorant of the privilege which he has infringed(*e*).

Letters patent are under seal (*f*), because the Sovereign cannot grant but by matter of record (*g*).

Prior to the time of Richard II., the direction of letters patent was as follows:—*Omnibus archiepiscopis ducibus marchionibus countibus episcopis, &c.* (*h*).

The recitals.

3 *Whereas* . . . . *request*.—These clauses form the *recitals*, which contain a short statement of the substance of the inventor's declaration and petition for the grant, of the filing of the specification, and the motive of the Sovereign in making the grant.

Before, and under, the Patent Law Amendment Act, 1852, the word "petition" (*i*) appears in the grant of letters patent, instead of "solemn declaration," which was required by sect. 5 (*j*) of the present Act. The

(*c*) Act of 1883, s. 12, sub-s. 1, *supra*, p. 448.
(*d*) Hindmarch, p. 40.
(*e*) See 1 Co. R. 45 a; 1 Skin. R. 225; 4 Co. R. 71 b; 6 Co. R. 15 b; also Hindmarch, p. 40.
(*f*) Formerly the Great Seal; now (sect. 12, sub-sect. 1, p. 448), the seal of the Patent Office.
(*g*) Com. Dig. Prerog.
(*h*) 2 Inst. 1.
(*i*) See Appendix, p. 667; and Old Forms of Letters Patent, pp. 848 and 850.
(*j*) See *supra*, p. 430.

words "by his solemn declaration" are now omitted in the form of grant, as the declaration is not now made under the Statutory Declarations Act, 1835 (*k*).

Consideration for grant.

An inventor is not entitled to a patent as of right, but only by the grace and favour of the Crown (*l*). It is necessary that he should inform the Sovereign of his invention, and also that the information should in *every material particular* be correct. The representations made by the inventor are made at his own peril; they form the *consideration* for the grant; this consideration is *entire*, and if any part of it fail, the patent as a whole will be void, and may be set aside by a petition for revocation (*m*). The allegations in the petition as to the utility and novelty of the invention were the grounds on which the action of *scire facias* was prosecuted, and they are still available by Act of 1883, s. 26, sub-s. (3) (*n*), alike by way of defence to an action for infringement and as grounds of revocation.

The present form of letters patent also contains a proviso empowering the Sovereign or any six members of the Privy Council to determine a patent privilege on the same grounds (*o*).

In the reign of John, the king was named in the singular number in his letters patent, but since that period the plural has been adopted (*p*).

Recital of invention.

Instead of the words, "that he is in possession of an invention," which appear for the first time in the form of letters patent prescribed by the Patent Law Amendment Act, 1852, the earlier recitals set forth "that he hath invented" (*q*), and if the patent was granted for an imported invention, the recital stated the representation in the petition thus: "That in consequence of a communication from a foreigner residing abroad, he is in possession of an invention . . . . which the petitioner conceives will be of great public utility, and that the same is new within this realm, and hath not been practised or used therein by any person or persons whomsoever to the best of his knowledge and belief, the petitioner therefore," &c. (*r*).

Utility.

An invention being "any manner of new manufacture, the subject of letters patent and grant of privilege" within the meaning of the

(*k*) See Act of 1885, s. 2.

(*l*) See also Act of 1883, s. 116, at p. 525.

(*m*) Cp. *Hill* v. *Thompson*, 1818, 2 B. Moo. 424, per Dallas, J.; *Brunton* v. *Hawkes*, 1821, 4 B. & A. at p. 549, per Abbott, C. J.; *Kay* v. *Marshall*, 1839, 5 Bing. N. C. 501, per Tindal, C. J.; *Morgan* v. *Seaward*, 1837, 2 M. & W. 544. An immaterial mistake does not, however, vitiate a patent, *e. g.*, a grant to a person as a knight, who in truth was no knight, where the identity of the grantee sufficiently appeared: *R.* v. *The Bishop of Chester*, 2 Salk. 560; 5 Mod. 297; Show. P. C. 212.

(*n*) See p. 474.

(*o*) See *infra*, p. 545.

(*p*) 2 Inst. 2.

(*q*) See Old Forms of Letters Patent, Appendix, p. 851.

(*r*) Hindmarch, p. 628, n. (*x*).

Statute of Monopolies, sect. 6 (*s*), it is not necessary, though it was formerly usual (*t*), to insert in the recital a clause to the effect that the petitioner believes that his invention would be of great public utility.

Nature of invention.

In letters patent granted before the time when a specification began to be required, the nature of the invention was more or less fully set forth in the recital (*u*), and a patent without such a recital would most probably have been held void (unless it contained a proviso dispensing with it) by reason of the grant being too general and not sufficiently certain (*x*). As to the proviso by which an insufficient description of the nature of an invention was prevented from invalidating the grant of letters patent, see notes to the words "of our especial grace, knowledge, and mere motion" (*y*), and to the proviso for favourable construction (*z*).

Prerogative of Crown in trade matters.

The words "our royal letters patent for the sole use and advantage of his (*a*) said invention," point to the control which the Crown has always exercised over the trade of the country and to its common law prerogative (which the Statute of Monopolies merely regulated) of granting the exclusive right to trade with a new invention for a limited period (*b*).

Where complete specification in first instance under Act of 1852.

Where an inventor filed a complete specification in the first instance, under the power in that behalf conferred by the Patent Law Amendment Act, 1852, sect. 9, instead of within six months of the grant, the following clause was formerly added to the recital: "And whereas the said A. B. hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed," &c.

Recital. Motive of Sovereign.

The words, "and whereas we being willing to encourage all inventions which may be for the public good," were introduced in substance in the earliest forms of letters patent (*c*); novelty and utility are thus by implication made essential conditions, and the encouragement of the arts is suggested as the motive of the grant. Consequently if these conditions and objects do not exist, or cannot be fulfilled, the

(*s*) See definitions, Patent Law Amendment Act, 1852, s. 55, *infra*, p. 664; and sect. 46 of the present Act, *supra*.

(*t*) See p. 851.

(*u*) Cp. *Smalt Patents*, 3 Jac. 1; 1 Web. P. C. p. 9; *Baker's Smalt Patent*, 6 Jac. 1; *ibid.* p. 11; *Mansell's Glass Patent*, 21 Jac. 1; *ibid.* p. 17.

(*x*) See Vin. Abr. Prerog. (Oc.) (F c.); see note to sect. 5, sub-sect. 5, *supra*, p. 431.

(*y*) *Infra*, p. 539.

(*z*) *Infra*, p. 540.

(*a*) Where an invention had been imported from abroad, it was formerly the practice to substitute "the said invention" for the clause which appears in the text.

(*b*) Cp. *Caldwell* v. *Vanvlissingen*, 1851, 21 L. J. N. S. Ch. 97; 9 Hare, 415, per Turner, V.-C.

(*c*) See Appendix, Forms, *infra*, p. 848.

Crown will have been deceived by false suggestions, and the letters patent will be void (*d*).

4 *Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion.*—The general rule of law that grants shall be construed most strongly against the grantor, and in favour of the grantee, was said to be reversed when the King was the grantor, unless the grant contained some special words indicative of the King's bounty (*e*). The words, "of our especial grace, certain knowledge, and mere motion," were inserted in letters patent in order that they might be construed more favourably for the grantee. "The deed of grant," says an old writer (*f*), "swells with imposing terms which are but the shadows of majesty. The 'certain knowledge and mere motion' turns out to be *clausula clericorum* (*g*), the prohibition useless to the infringer, the proviso for favourable construction useless to the patentee." This sweeping criticism, however, appears to have been unjust. It is thought that the following note accurately expresses the legal efficacy of the special words under discussion:—

Especial grace.

Certain knowledge.

Mere motion.

The words "of our especial grace," imported that the grant proceeded solely from the grace and bounty of the Crown, and not from any right or title inherent in the grantee (*h*). The words "certain knowledge" implied that the Sovereign had knowledge of the subject-matter of the grant (*i*); but their scope was limited by the clause in the recital making the grant dependent on the representations of the grantee. The words "mere motion," imported that the grant proceeded from the bounty of the Sovereign, without any suggestion or suit by the grantee (*k*). It was, however, the duty of every applicant for letters patent to see that the Sovereign was correctly informed respecting the subject-matter of the grant (*l*); and the recital in the patent showing that the grant was made upon the petition of the patentee diminished the force of the words of grace, and prevented a patent from being reduced to the same standard of construction as the grant of a subject (*m*). What, then, was the practical effect of the

(*d*) Webster's Letters Patent for Inventions, Practical Forms, p. 70, n. (*w*).

(*e*) 5 Bac. Abr. 602; 1 Web. P. R. 26; *Alton Wood's Case*, 1 Co. Rep. 27; *Priddle and Napier's Case*, 11 Co. Rep. 110; *R.* v. *Mussury*, 1738, 1 Web. P. C. 41; *Dobbs* v. *Penn*, 1849, 3 Exch. 427; *Carpenter's Screw Propeller*, Times, July 11, 1854.

(*f*) Turner, Remarks upon Patent Law, 1851, p. 19.

(*g*) See *Needler* v. *Bishop of Winchester*, Hob. 221, 222.

(*h*) *Brunton* v. *Hawkes*, 1821, 4 B. & A. 552, per Bailey, J.

(*i*) A charter in which the words *ex certâ scientiâ* occurred was said to be "assertive" and not "suggestive": 1 Co. 44 a; 10 Co. 112 b; 3 Levinz, 249; Plowd. 502 b.

(*k*) 10 Co. 112 b; Vin. Abr. Prerog.; Bac. Abr. Prerog.; Com. Dig. Grant.

(*l*) 1 Co. R. 52 a.

(*m*) *R.* v. *Capper*, 1817, 5 Price, 217; 1 Co. R. 46 a, 46 b.

words of grace and bounty? It seems they cured many defects and irregularities which would otherwise have vitiated the grant (*n*). Possibly apart from, and certainly when taken along with, the proviso for favourable construction, they provided that a patent should be valid notwithstanding it did not contain a full and certain description of the invention (*p*). They did not, however, cure a false suggestion on the part of the grantee (*q*). Nor did they authorise any construction against the plain intent and purpose of the grant (*r*).

For us, our heirs, &c.

5 *For us, our heirs and successors.*—The object of inserting the words "for us, our heirs and successors," is to show that the grant is to continue in force during the whole of the term granted, notwithstanding the demise of the Crown (*s*). It seems, however, that these words are not necessary in order to make the grant binding upon the Queen's successors (*t*).

Give and grant.

6 *Give and grant.*—The words "give and grant" are the proper operative words in a patent for an invention with regard not only to the Queen, who is grantor, but also to the nature of the grant (*u*).

Definition of patentee.

7 *Patentee.*—The definition of patentee, given by sect. 46 of the present Act, as the person for the time being entitled to the benefit of a patent, renders the insertion of the words executors, administrators, or assigns, as in the earlier forms (*x*) of letters patent, unnecessary.

Especial license.

8 The words "especial license, full power, sole privilege, and authority," give the patentee a right to exclude all others from the use or exercise of his invention during the patent term.

Agents or licensees.

9 *By himself, his agents or licensees.*—These words are important. For the variation in them where there are several patentees, see *supra*, pp. 533 *et seq.* As to the position of co-owners of a patent, see pp. 192 *et seq.*

The persons authorised to exercise the patent privilege are enume-

(*n*) Webster's Letters Patent for Inventions, Practical Forms, p. 76, n. (*d*); and 1 Web. P. C. at p. 41; *R.* v. *Museary*, 1738, *ibid.*; 1 Co. R. 53 a.

(*p*) Hindmarch, pp. 72, 73.

(*q*) *Legat's Case*, 10 Co. R. 109; *Barwick's Case*, 5 Co. R. 94; *Cholmley's Case*, 2 Co. R. 54; *Auditor Curle's Case*, 11 Co. R. 4; *Earl of Devonshire's Case*, 11 Co. R. 89; *Travell* v. *Carteret*, 3 Lev. 135; *Alcock* v. *Cooke*, 1829, 5 Bing. 340; *Morgan* v. *Seaward*, 1837, 1 Web. P. C. at p. 196.

(*r*) *Alton Wood's Case*, 1 Co. R. 49 a, 52 b, 53 a.

(*s*) Hindmarch, p. 52.

(*t*) Com. Dig. Grant (G. 3).

(*u*) Shep. Touch. 228.

(*x*) See *infra*, pp. 667, 848, 850.

rated lest any of them should be subject to punishment for creating a monopoly without sufficient authority (*y*).

10 The word *make*, which is within the exception of the Statute of Monopolies, is intended to signify the sole privilege of exercising the invention in the making of articles by manufacture. Make.

11 The word *vend* has given rise to some difficulty. By the first section of the Statute of Monopolies, patents granting "the sole buying, selling, making, working, or using of anything" are declared to be void, and the proviso in favour of inventions contained in the sixth section extends only to "grants of privilege of the sole working or making of any manner of new manufactures," leaving the sole buying or selling of anything within the prohibition of the first section of the statute. It seemed, therefore, that a grant of the sole right to *vend* an invention was contrary to the first section of the statute, and not within the meaning of the proviso. Vend.

The following considerations, however, dispose of this difficulty :—

The things produced by the exercise of a patent invention must be manufactures, or *vendible* articles, capable of being made the subject of transaction in trade and commerce. But the object of the law in permitting the grant of letters patent is to reward such inventors as shall give to the public the benefit of useful inventions; and that reward is the profit to arise from the exercise or sale of the invention during the patent term.

"Whether a patentee makes and sells those articles himself, or is merely paid by others for making them, it is quite clear that his reward must be derived from the same source; and as no one can use the invention except the patentee, none besides him can lawfully have such articles for sale.

"The sole right to vend articles made by means of a patent invention is, therefore, not only necessarily incident to the privilege granted by the patent, but is also absolutely necessary to enable the patentee to obtain the reward which the law intends for him; and although the exception contained in the 6th section of the Statute of Monopolies, does not expressly save the right of the Crown to grant the sole privilege of vending such articles, there can be no doubt that it is implied; and, indeed, all patents made since the passing of the statute have invariably granted patentees the sole privilege of vending their patent articles, and this shows the construction put upon the statute, not only at the time it was made, but ever since" (*z*).

As to infringement by "vending," see pp. 217 *et seq.*

(*y*) Bac. Abr. tit. Monop. A.

(*z*) Hindmarch, p. 55. Cp. *Minter* v. *Wells*, 1835, 4 A. & E. 251.

Extent of grant.

12 *United Kingdom of Great Britain and Ireland, and Isle of Man.*—Prior to the Patent Law Amendment Act, 1852, s. 18 (*a*), letters patent obtained in England conferred an exclusive privilege only within England, Wales, Berwick-upon-Tweed, the Channel Islands, the Isle of Man, and the Colonies and plantations abroad, if so expressed in the grant (*b*). Patents for Scotland and Ireland were required to be taken out under the Great Seals of these countries respectively (*c*). The hardship which might possibly arise from the exclusion of Scotland and Ireland from an English patent is brought out by a case—apparently hypothetical—put by a witness, a sugar refiner at Liverpool, in his evidence before the Parliamentary Commission of 1851 (*d*). Suppose that there were two rival sugar refiners, A. and B., carrying on business, one in England, the other in Ireland, and that C. invented an improved process for refining sugar. The expense of taking out a patent in Ireland was very considerable; and the sugar and molasses refining trade in that country was of very limited extent. C. therefore patented his manufacture in England alone. The result was, that A. was obliged to pay patent charges to C. for the use of his new process, while his rival on the other side of St. George's Channel was exempt from any such liability.

Colonies and plantations abroad.

Letters-patent granted under the Patent Law Amendment Act, 1852, extended to the United Kingdom of Great Britain and Ireland, the Channel Islands, the Isle of Man, *and, in case Her Majesty, by warrant under her royal sign manual so directed, to her colonies and plantations abroad* (sect. 18) (*e*). The power, hereby reserved to the Sovereign, of including the colonies in letters patent granted after the Act of 1852, was not exercised; and in January, 1853, a letter was addressed on behalf of the Secretary of State to the colonial authorities, making inquiries of the colonial governments on the subject, the result of which was the passing of the various Acts and ordinances under which patents are issued in British India and the Colonies (*e*).'

(*a*) This Act came into operation on 1st October, 1852.

(*b*) See Forms, Petition, *infra*, p. 665; and Old Form of Letters Patent, *infra*, p. 851. The usual custom was, when an invention was supposed to be applicable to the Colonies as well as to England, that the parties petitioned the Crown for letters patent in England and the Colonies; and the Crown granted a patent according to the prayer of the petition. It also granted a further privilege through the Privy Council of enabling the patentee in the Crown Colonies to deposit official or authenticated copies of the patent and the specification, so that they should be as good evidence as the production of the original documents: Report, 1851, p. 65, Ans. 390.

(*c*) 6 Ves. 708.

(*d*) Report, &c., 1851, p. 151, Ans. 975 *et seq.*

(*e*) Letters patent for England prior to 15 & 16 Vict. c. 83, frequently included, as has been said, the Colonies and plantations abroad; but such grants did not extend to the East Indies, that territory not being regarded in law as a colony or plantation, but as a dependency or possession: Report on Letters Patent, 1872, Appendix A. at p. 157.

The Channel Islands, which were introduced, on the solicitation of Mr. W. Carpmael, by Sir John Campbell (Attorney-General), and Sir R. M. Rolfe (Solicitor-General) into letters patent, granted November, 1838 (*f*), are omitted from sect. 16 of the present Act. Channel Islands.

13 In the form of letters patent which was in use before (*g*), and under (*h*), the Patent Law Amendment Act, 1852, the manner in which the patent privilege was to be exercised was left, as it substantially is in the present form, to the discretion of the patentee. Exercise of invention.

Mr. Hindmarch (*i*) expresses a doubt whether a patentee was bound under that clause to exercise his patent at all during the continuance of his right. The declaration in an action for infringement always, indeed, alleged that the plaintiff had "made, used, exercised, and vended the invention to his great advantage and profit;" but the object of this allegation was to show that the plaintiff had been injured by the invasion of his privilege, and that the patent did not confer upon him a bare right of no utility or benefit; and it was never decided that a patentee must have exercised his invention in order to enable him to prevent others from infringing his patent right.

There was, however, usually inserted in the form of letters patent a proviso requiring the patentee to supply articles of his invention for the service of the Crown, in such manner, at such times, and upon such terms as might be settled by the officers or commissioners requiring the same; and, independently of the new provisions as to compulsory licences (sect. 22, *supra*, p. 461), a grant of letters patent might probably be avoided as "prejudicial and inconvenient" to the Sovereign's "subjects in general" (*k*), if it were made to appear to the Privy Council that the patentee was not exercising his privilege. Saving of rights of Crown.

The term of a patent includes the day of its date (*l*).

14 *Fourteen years.*—Patents are now always granted for fourteen years, as provided by Act of 1883, sect. 17, sub-s. 1. But it seems the Sovereign might grant a patent for a less time (*m*).

15 *Date.*—A patent is sealed as of the day of application (*n*). This ante-dating is a curious contrivance, under which the advantages of provisional protection are obtained without further special provisions being required as to anticipation, priority, &c. It is also adopted in applications under the International and Colonial Arrangements.

After the clause defining the extent of letters patent, there was Habendum.

(*f*) Webster's Letters Patent for Inventions, p. 15, n. (*y*).
(*g*) See *infra*, p. 850.
(*h*) See *infra*, p. 667.
(*i*) Page 56.
(*k*) *Infra*, p. 545.
(*l*) *Russell* v. *Ledsam*, 1843-6, 14 M. & W. at p. 382. See sect. 17, sub-sect. (1), *supra*, p. 454.
(*m*) See Act of 1883, s. 116.
(*n*) Act of 1883, s. 13.

formerly inserted in the grant what was technically called the *Habendum* (*p*), declaring that the inventor, his executors, administrators, and assigns, should have and enjoy the privilege according to the statute in such case made and provided. From this clause it was clear that the grant was intended to be made subject to the conditions required by the Statute of Monopolies (*q*).

Prohibitory part of grant.

16 *And to the end . . . . thereby occasioned.*—This is the *prohibitory* part of the grant. It has been referred to already, under the head of infringement (*r*).

All persons are bound to take notice of the grant of the Crown, and the object of the prohibition is to warn them of its effect and what the law requires them to abstain from doing (*s*). The prohibition extends to all subjects of the Crown living within those parts of the realm to which the privilege extends, and it operates during the whole term of the patent. The granting and the prohibitory parts differ in the terms employed, those of the former being, "make, use, exercise, and vend;" those of the latter, "make use of, or put in practice." The prohibitory words, however, are in aid of the grant and not in derogation from it (*t*), and will receive from the Court the construction which will effectuate the purpose of the patent and prevent acts injurious to the patentee, with as little restraint on the public as possible (*u*). The omission of the word "vend" from the prohibition will not, therefore, diminish the effect of the preceding grant. The words "put in practice" appear from the declaration of intention at the commencement of the clause to be synonymous with "exercise."

Prior to the Statute of Monopolies, questions on patent rights were determined in the Star Chamber, and infringements were punishable as contempt of royal authority (*x*). In addition to his equitable and common law remedies of injunction and damages, a patentee was enabled by 5 & 6 Will. IV. c. 83, s. 7, to recover a penalty of 50*l.* against any person who had made an unauthorised use of his name (*y*). This statute was, however, repealed by the present Act (*z*).

See sections 105 and notes thereon (*a*).

(*p*) See Appendix, Forms, *infra*, p. 851.

(*q*) Hindmarch points out (p. 63) that this clause was in itself sufficient to dispose of the supposition, which, he says, received some countenance in *Brown* v. *Annandale*, 1841-42, 1 Web. P. C. 433, that the effect or intent of a patent was to grant a privilege on the terms merely of the conditions comprised in the patent, excluding all others.

(*r*) See p. 216.

(*s*) Hindmarch, p. 60.

(*t*) *Caldwell* v. *Vanvlissingen*, 1851, 21 L. J. N. S. Ch. 97; 9 Hare, 415, per Turner, V.-C.

(*u*) *Minter* v. *Williams*, 1835, 4 A. & E. 251, per Coleridge, J.

(*x*) 3 Inst. 182, 183. See also pp. 247 *et seq.*

(*y*) See Appendix, p. 639.

(*z*) See also pp. 368 *et seq.*

(*a*) *Supra*, p. 519.

The prohibition formerly contained a command by the Sovereign to all justices, officers, and ministers, not to molest the patentee in the lawful use and exercise of his invention at any time during the patent term (*y*). The reason for this clause being inserted is thus explained by Hindmarch (*z*). "All monopolies, except those preserved by the provisoes in the Statute of Monopolies, are contrary to law, and persons who put them in force may be punished by fine and imprisonment. The grant to a patentee of the sole use of his invention being a lawful grant, this clause seems to have been introduced into the patent as a protection to the patentee, so that if he were to be charged before any justices or officers of the Crown with putting an illegal monopoly in force, he might produce his patent to them in proof of his right, and to show by the command contained in it that they had no power to proceed against him."

Provisoes.

17 *The three provisoes.*—These provisoes constitute the *conditions of the grant* of letters patent. The first makes a grant revocable by the Sovereign, or any six members of the Privy Council, for certain causes mentioned in the proviso. A similar power of summary revocation has been inserted in all letters patent granted since the Statute of Monopolies, but no authentic (*a*) instance of its exercise is on record, and it is difficult to see how it could be exercised. In *Reg.* v. *Eastern Archipelago Co.* (*b*), the Court of Queen's Bench was equally divided as to the effect of a similar condition upon proceedings by *scire facias* to repeal a charter granted to an incorporated company. In the opinion of Campbell, C. J., the proviso gave only an additional and cumulative remedy, by enabling the Crown in a summary manner to revoke the charter or modify it.

The object of this proviso is thus explained by Hindmarch (*c*): "The grant of a patent is a matter of grace and favour, and therefore . . . . . the Crown may annex any condition it pleases to the grant; and this condition seems to have been inserted with the view of enabling the Crown to determine any illegal grant which may be unadvisedly made, without allowing the public to be put to the trouble or cost of resisting the unlawful patent."

The revocation, if by the Sovereign, must be either under the signet or the Privy Seal; if exercised by the Privy Council, it must be under the hands of six or more members thereof.

The grounds of revocation under this proviso are—(1) that the grant

(*y*) See Form, *infra*, p. 850.
(*z*) Page 61.
(*a*) Hindmarch suggests (p. 432) that it was probably under this or a similar proviso that Queen Elizabeth was enabled to recall the patents for monopolies, which were found to be so grievous to the public during her reign.
(*b*) 1853, 21 L. T. 35.
(*c*) Page 431.

is contrary to law, or prejudicial or inconvenient to the people of the kingdom in general, (2) that the invention is not new as to public use, or (3) that the patentee is not the first and true inventor thereof within the realm. Of these grounds, the first is merely an affirmance of the common law (*d*), corroborated by the Statute of Monopolies (*e*), that letters patent which are contrary to law or common justice, or prejudicial or inconvenient to her Majesty's subjects, are null and void; the second expresses the conditions of novelty and non-user, the third also is declaratory of the common law, and in accordance with the Statute of Monopolies.

Prior user.

Prior to the Patent Law Amendment Act, 1852 (*f*), the proviso, avoiding a grant of letters patent if the invention was not new, or the grantee was not the true and first inventor, ran thus: "or that the said invention is not a new invention as to the public use and exercise thereof in that part of our United Kingdom of Great Britain and Ireland called England, our Dominion of Wales, and Town of Berwick-upon-Tweed (*g*), aforesaid, or not invented and found out by the said (A. B.) as aforesaid." This form was adopted at a time when the realm only included England, Wales, and Berwick-upon-Tweed; and the alteration in the law, produced by the union with Scotland and Ireland, not being adverted to, the officers of the Crown adhered to the old form which was in use before the alteration of the law. The opinion, however, which for some time prevailed in the legal profession, that it was only necessary for an invention to be new *within the districts mentioned in the above form*, was definitely rejected by the House of Lords in *Brown* v. *Annandale* (*h*), in which a Scotch patent was held to be invalidated by prior public user in England.

Brown v. *Annandale.*

In the form prescribed by the Patent Law Amendment Act, 1852 (*f*), the condition, as in the present form, required an invention to be new within the realm.

Up to the date of the present Act, the form of letters patent contained a proviso that the patent should not affect any former grant (*i*). In some cases letters patent under the Great Seal—containing, for example, a new commission of the peace—operate so as to determine the powers or privileges conferred by previous letters patent. The proviso, under consideration, seems to have been inserted in order to except letters patent for inventions from this general rule, and to prevent the rights of different patentees from clashing with each other. This express stipulation was, however, unnecessary, for it was clearly the law, that

(*d*) Shep. Abr. Prerog. 48, ss. 6, 7; Godbolt, 254.

(*e*) 21 Jac. 1, c. 3, s. 6.

(*f*) See Forms, Appendix, p. 852.

(*g*) The Channel Islands, the Isle of Man, and the Colonies and plantations abroad, were added, if necessary.

(*h*) 1841, 1842, 1 Web. P.C. 433; *Roebuck and Garbett's Case*, 1774, 1 Web. P. C. 49. Cp. Hindmarch, pp. 63, 64.

(*i*) See Forms, Appendix, p. 852.

if the Sovereign by his letters patent granted the same thing to several persons, a *scire facias* would be for the repeal of the last patent (*k*).

Letters patent are frequently granted for an improvement on an existing patent, but where the improvement could not be used without the original invention, the subsequent patentee cannot make use of the former patent without licence, during the continuance of the term (*l*).

Proviso against assignment to more than twelve.

Prior to the Patent Law Amendment Act, 1852, a proviso was inserted in letters patent against the assignment of the patent privilege to more than *twelve*—(before 1832, to more than *five*)—persons at any one time, *entitled to divide the profits as partners* (*m*). This clause was introduced in conformity with the Statute 6 Geo. I. c. 18, against the unlimited raising of transferable shares, and its object was double—viz. to prevent the public being imposed upon by specious projects under the colour of letters patent, and to avoid the oppression which, it was thought, would be practised if powerful companies were allowed to become possessed of patent privileges (*n*). This proviso applied only to assignments by act of party, and not to assignments by operation of law (*o*) and any number of licences, exclusive or common, might be granted, in spite of it (*p*). Whenever it was desired to transfer a patent to a company of more than twelve persons, an Act of Parliament was necessary. Many such special Acts were passed before the Act of 1852.

Proviso for enrolment of specification.

As to the proviso for the enrolment of a specification under the Act of 1852, and the origin and introduction of the specification itself, see p. 83 *et seq.*

Proviso as to fees.

As to the fees payable by a patentee, see *infra*, p. 550.

"In manner for the time being by law provided."—These words are new. In previous forms of letters patent, the settlement of the terms of the supply of patented articles for the public service was left to the department requiring it; and considerable hardship was sometimes caused to the patentees thereby. In the evidence of a witness (*q*) before the Select Committee of 1851 (*r*) was mentioned the following case: A large number of vessels had been supplied with patent screws by the Admiralty. The whole amount of horse-power applied to such screws was upwards of 12,500 horse-power.

(*k*) Hindmarch, p. 65; Coryton's Law of Patents, p. 172, n. (*y*), and authorities there cited.

(*l*) *R.* v. *Lister*, 1826, Webster's Letters Patent, p. 80, n. (*f*); *R.* v. *Fussell*, *ibid.*; *Cochrane* v. *Braithwaite*, 1830, *ibid.* p. 79; *Crane* v. *Price*, 1242, 1 Web. P. C. 413. Cp. also *Harmer* v. *Playne*, 1807, 14 Ves. jun. 130; *Ex parte Fox*, 1812, 1 Ves. & B. 67; *Lewis* v. *Davis*, 1829, 3 C. & P. 502.

(*m*) Appendix, p. 853.

(*n*) Hindmarch, p. 66.

(*o*) *Bloxam* v. *Elsee*, 1825, 6 B. & C. 169.

(*p*) *Protheroe* v. *May*, 1839, 1 Web. P. C. 414.

(*q*) Mr. J. B. Westhead, M.P.

(*r*) Page 352, Ans. 2661, 2662.

The Admiralty paid at the rate of 2*l.* per horse-power for the patent-right on 2,420 horse-power, and then declined to pay upon the remainder. There were various grounds for the refusal, sometimes that the Crown was not liable, sometimes that they had no certainty that the parties who claimed under the patents were the only parties or the right parties. The whole sum received by the inventors from the Admiralty in respect of these inventions, which had cost them not less than 56,000*l.*, was about 4,840*l.*

It appears that the proper remedy of a patentee against a public department refusing to settle terms according to the patent was by petition of right, and not by mandamus (*r*); and this is still the law in the case of patents existing before the commencement of the present Act, to which the provisions of sect. 27, as to patents binding the Crown, do not apply (*s*).

Proviso as to licences.

The proviso authorising the grant of licences was, prior to the Patent Law Amendment Act, 1852, inserted in the grant of letters patent immediately after the condition against assignment to more than twelve persons as partners. The interest of a licensee under letters patent is totally of a distinct nature from that of the assignee of a part: the latter is a partner dividing or entitled to divide the profits with the other assignees, whereas the former has acquired only a right of user for some assigned or assignable consideration (*t*).

Favourable construction.

18 As to the effect of the proviso for favourable construction, see *supra*, p. 540.

Name letters patent.

19 *In witness whereof.*—The name "letters patent" is derived from this clause, which occurs in the old forms also, by which it is in effect declared that the Queen makes her grant "patent," or known to all persons, by passing it under the Great Seal, or now the seal of the Patent Office (*u*).

Conclusion.

The formal conclusion, which was in use till 1852, ran thus: "In witness whereof we have caused these our letters to be made patent. Witness ourself at Westminster, this day of , in the year of our reign."

Patents for inventions were always tested in the name of the Sovereign.

Date.

20 *Date.*—In *Lord Zouch and More's Case* (*v*) it was laid down that "the King's patent may be without date; for he may resort to the enrolment and the Privy Seal to help it." But the statute 18 Hen VI.

(*r*) *Ex parte Pering*, 1836, 4 A. & E. 949. Cp. *Walker* v. *Congreve*, 1816, Coop. 1 P. C. 356.

(*s*) See also sect. 45, sub-s. (2), *supra*, p 500.

(*t*) Webster's Letters Patent, p. 83, n. (*o*), (*p*).

(*u*) 2 Inst. 78.

(*v*) Godbolt, 416.

c. 1, s. 1, provided that letters patent should bear date the day of the delivery of the Privy Seal bill to the Chancellor, and that letters patent made to the contrary should be void. Under sect. 13 of the present Act, every patent is dated as of the day of application, and the term runs from that date inclusive.

Letters patent had formerly subscribed to them the words "By warrant," or "By writ of Privy Seal," to show that the patent had been made in pursuance of a command contained in the Queen's writ, or warrant under her Privy Seal (*x*).

At the bottom was written the name of the clerk of patents (*y*), and a heavy wax impression of the Great Seal was affixed to the document, as is still done in those letters patent for other royal grants to which the wafer Great Seal is not affixed. The Great Seal gave authority to the document; all persons were bound to take notice of it, and it was admissible in evidence without further proof.

21 *The Seal of the Patent Office* has now (sect. 12, sub-s. (2)) the same effect as the Great Seal of the United Kingdom. From the 1st October, 1852, when the Patent Law Amendment Act came into force, to the 1st March, 1878, the impression of the Great Seal was always appended to the parchment. At the latter date, under the Crown Office Act, 1877, sect. 5, and the rules made by the Privy Council (*z*) thereunder, letters patent for inventions were sealed with the wafer Great Seal. Since 1st January, 1884, the seal of the Patent Office is impressed on the letters patent.

Form E.

Section 47.

FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

See *Designs Rules*, 1890.

Form F.

Section 62.

FORM OF APPLICATION FOR REGISTRATION OF TRADE MARK.

See *Trade Marks Rules*, 1890.

(*x*) 2 Inst. 555, 556; 8 Co. R. 18 b.
(*y*) See 3 & 4 Will. IV. c. 84.
(*z*) See *London Gazette*, March 5, 1878.

Section 24. THE SECOND SCHEDULE.

Fees on Instruments for obtaining Patents, and Renewal.*

(a) *Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification	3	0	0			
				4	0	0
or,						
On filing complete specification with first application.....				4	0	0

(b) *Further before end of four years from date of patent.*

On certificate of renewal	50	0	0†

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* Should the renewal fees not be paid in due course, an enlargement of time for payment may be made, subject to the following penalties :—

	£	s.	d.
Not exceeding one month - - - - - -	3	0	0
,, ,, two months - - - - - -	7	0	0
,, ,, three months - - - - - -	10	0	0

† The provisions for the payment of this fee are retrospective, and apply to patents applied for prior to Act of 1883, so that the time for the payment was extended from the third to the fourth year, and might be effected either in one sum or by annual instalments commencing at the fourth year from the date of the patent.

(c) *Further before end of seven years, or in the case of patents granted after the commencement of this Act, before the end of eight years from date of patent.*

On certificate of renewal ..... 100 0 0‡

Or in lieu of the fees of £50 *and* £100 *the following annual fees:—*

Before the expiration of the fourth year from the date of							
					the patent	10	0 0
,,	,,	fifth	,,		,,	10	0 0
,,	,,	sixth	,,		,,	10	0 0
,,	,,	seventh	,,		,,	10	0 0
,,	,,	eighth	,,		,,	15	0 0
,,	,,	ninth	,,		,,	15	0 0
,,	,,	tenth	,,		,,	20	0 0
,,	,,	eleventh	,,		,,	20	0 0
,,	,,	twelfth	,,		,,	20	0 0
,,	,,	thirteenth	,,		,,	20	0 0

Fees on Patents under the Old Law before Act of 1852.

It may be interesting at this place to give an account of the fees payable before 1852. The old procedure is thus rendered more easy of appreciation.

The fees under the Act of 1852 appear in the schedule to that Act. See Appendix, p. 665.

Previously to the Patent Law Amendment Act of 1852, letters patent, passed under the Great Seal of England, extended only to

Former fees.

‡ In the case of patents granted before the commencement of the said Act, a patentee who has paid the prescribed fee of 50*l.* may, in lieu of the prescribed fee of 100*l.* payable before the end of seven years from the date of patent, pay the following annual fees:—

Before the end of the seventh year from the date of							
					the patent	10	0 0
,,	,,	eighth	,,		,,	10	0 0
,,	,,	ninth	,,		,,	10	0 0
,,	,,	tenth	,,		,,	15	0 0
,,	,,	eleventh	,,		,,	15	0 0
,,	,,	twelfth	,,		,,	20	0 0
,,	,,	thirteenth	,,		,,	20	0 0

This reduction was made by the Board of Trade in August, 1884.

England, Wales, and Berwick-upon-Tweed. The following (*b*) is a table of the fees which were then payable upon a

PATENT FOR ENGLAND.

	£	s.	d.		£	s.	d.	£	s.	d.
				Secretary of State's						
				Reference	2	2	6			
				Warrant	7	13	6			
				Bill	7	13	6			
								17	9	6
				Mr. Attorney-General's						
	£	s.	d.	Report	4	4	0			
Stamps..	6	0	0	Bill	15	16	0			
								20	0	0
				Signet Office,						
				*Fees	3	1	0			
				Gratuity	1	1	0			
				Office keeper	0	5	0			
								4	7	0
				Privy Seal,						
				*Fees	2	16	0			
				Gratuity	1	1	0			
				Office keeper	0	5	0			
								4	2	0
				Great Seal Office,						
				†Fees	5	17	8			
	30	2	0	Stamps	30	2	0			
				Boxes	0	9	6			
				Gratuity	2	2	0			
				Hanaper	7	13	6			
				Deputy	0	10	6			
				Recipi	1	11	6			
				Sealers	0	10	6			
				Office keeper	0	5	0			
								49	2	2
				Passing of the Patent				10	10	0
				Letters, &c.				1	1	0
	5	0	0	Specification according to its length ..						
Stamps	£41	2	0					£106	11	8

* The fees for *two* names at the Signet and Privy Seal were as follow:—

Signet Office,	£	s.	d.	Privy Seal Office,	£	s.	d.
Fees and Stamps	7	13	0	Fees and Stamps	7	8	0
Gratuity	2	2	0	Gratuity	2	2	0
Receiver and Assistant Clerk	0	10	6	Record Keeper	0	10	6
	£10	5	6		£10	0	6

† Every additional name was charged £2 13*s.* 4*d.* at the Great Seal.

The colonies and Channel Islands.

A patentee might, however, if he desired it, have his patent extended to the Colonies and the Channel Islands by a slight alteration in the prayer of the petition. The additional expense of including either or both amounted to 7*l.* 7*s.* 6*d.*: viz., 1*l.* 7*s.* 6*d.* both on the warrant and on the bill, 2*l.* 5*s.* both at the Signet and the Privy Seal, and 2*s.* 6*d.* on the Attorney-General's bill (*c*).

(*b*) Report, &c., 1829, Evidence of Mr. Moses Poole, p. 87. See also Webster's Letters Patent for Inventions, p. 123.

(*c*) Webster's Letters Patent for Inventions, p. 123.

Reasons why grant seldom extended to the colonies.

The Channel Islands do not seem to have been included in letters patent till 1838; and applications for patent privileges in the Colonies and plantations abroad were rare, partly because the inventions which would be chiefly used in the Colonies were not numerous, and partly because in those Colonies which possessed local legislatures proceedings for infringement could not be taken in a local Court of justice unless an express Act of the Colonial Legislature had been applied for at the time when the patent in this country had been obtained (*e*).

Scotch and Irish patents.

An English patentee, who desired to have his privilege protected in Scotland and Ireland, was obliged, prior to the Patent Law Amendment Act, 1852, to take out a separate patent for each of these countries. The following Table (*f*) will show the cost of the

Scotch patent.

PATENT FOR SCOTLAND.

£	s.	d		£	s.	d.	£	s.	d.
			Secretary of State's						
			Reference	2	2	6			
1	10	0	Warrant	15	7	0			
			Stamp	1	10	0			
							18	19	6
			Lord Advocate's						
			Report				4	4	0
			Director	15	0	0			
			Clerk	7	10	0			
			Translator	1	1	0			
			Director	1	1	0			
			Servant	0	2	6			
			Livery	0	3	7½			
			Extra	0	2	6			
							25	0	7½
			Great Seal,						
			Lord Keeper	6	13	4			
			Deputy	2	10	0			
			Usher	2	4	5½			
			Appendee	2	2	0			
			Deputy	1	1	0			
			Wax	0	7	6			
			Extra	0	2	6			
			Agent	4	4	0			
							19	4	9½
			Passing Patent				10	10	0
			Letters				1	11	6
5	0	0	Specification according to length						
Stamps	£6	10	0				£79	10	5

A patent for Scotland was obtained more expeditiously than a patent for England. As soon as the Lord Advocate had made his report—similar to the Attorney-General's report in England—the Sovereign

(*e*) This was done in the case of *Hague's Patent* for expelling the molasses from sugar: Report, &c. 1829, p. 18.

(*f*) Report, &c., 1829, *ubi supra*.

issued a warrant, which was in substitution for the Bill used in England. The royal signature was only required once for a Scottish patent (*g*).

Irish patent.

The mode of taking out a patent for Ireland was as follows (*h*):—The first step was an affidavit and petition to the Sovereign, as in England, but the prayer was for a patent in Ireland, instead of in England, Wales, and Berwick-upon-Tweed. Then the petition was referred to the Attorney and Solicitor-General for Ireland, after which it went before the Lord-Lieutenant, who referred it to the Attorney and Solicitor-General for report. Then it came back to England for the King's letter, which was similar to the warrant on an English patent. After this the King's letter was sent to Dublin, and the patent, having passed through several offices, was granted under the Great Seal of Ireland. An Irish, like a Scotch, patent received the royal signature only once.

The following Table (*i*) will show the cost of taking out a separate

PATENT FOR IRELAND.

	£	s.	d.		£	s.	d.	£	s.	d.
				Secretary of State's Reference	2	2	6			
				Warrant	7	13	6			
Stamp ..	1	10	0	Stamp	1	10	0			
								11	6	0
				Mr. Attorney-General's and Solicitor-General's Report				31	10	0
				Paid entering at Signet Office				3	3	0
				,, ,, ,, Seal Office				2	14	6
				Lord Lieutenant for fiat				5	5	0
				Mr. Attorney-General and Clerk for fiat				11	0	3
				Clerk of the Hanaper				8	9	2
	23	13	4	Stamp to the Grant				21	13	4
				Enrolling				1	1	8
Stamp to Specification..	1	0	6	Further Fees paid in Ireland				21	2	6
				Passing the Patent				10	10	0
				Letters				0	10	6
	£26	3	4					£128	5	11

It thus appears that the cost of taking out separate patents for

(*g*) In *Brown* v. *Annandale*, 1842, 1 Web. P. C. 433, it was held that the public use of an invention in England prior to the date of letters patent for Scotland would invalidate such letters patent. Cp. *Roebuck* v. *Stirling*, 1774, 1 Web. P. C. 48; *Re Pow*, 1845, 2 Web. P. C. 5, reported as *Robinson's Patent*, 5 Moo. P. C. 65. Neither in *Roebuck's* nor in *Brown's case*, however, was the grantee of the patent the true and first inventor in England, and the above decision did not apply to a case in which the true and first inventor in one part of the realm was the grantee of the letters patent in the other part: 1 Web. P. C. 454, n.; *Magill* v. *Ewing*, 11 Ir. Jur. N. S. 164.

(*h*) Report, &c., 1829, Evidence of Mr. Francis Abbott, at p. 50.

(*i*) Report, &c., 1829, p. 88.

England, Scotland, and Ireland amounted to about 350*l.*, a sum which attorneys' bills and other incidental expenses are said to have raised to 400*l.* or 500*l.*

Cost of patent under Patent Law Amendment Act.

Under the Patent Law Amendment Act, 1852, letters patent extended to the United Kingdom, the Isle of Man, and the Channel Islands (*k*), and the cost of taking out a patent and maintaining it for the full term amounted to 175*l.*, as contrasted with the old charge of 350*l.* This sum was made up as follows: 5*l.* at each of the following stages, the application, the notice to proceed, the warrant, the sealing, and the filing of the complete specification; 50*l.* before the expiration of the third year, and 100*l.* before the expiration of the seventh; and the patent became void on default of either the second or the third payment. In the original Act there were two schedules (*l*), and the payments were divided as fees and stamp duties, but under a subsequent statute—16 Vict. c. 5—the whole of the fees were taken in stamps (*m*).

Under the Patent Law Amendment Act, 1852, it was sufficient if the renewal fees were paid before midnight on the anniversary of the day of the date on which the letters patent were granted (*n*).

Policy of reducing fees.

The advantage of spreading the payments required from a patentee over his term was that while applications for patents were not discouraged, a cheque was given to the multiplication of frivolous and obstructive patents, by which artizans, small tradesmen, and manufacturers, who could not face the expense of litigation, however weak might be the case against them, had been seriously embarrassed. Thus it was stated in evidence before the Parliamentary Committee of 1865 (*o*) that over two-thirds of the patents sealed became void by reason of the nonpayment of the 50*l.* at the end of the third year, and nine-tenths failing the payment of the 100*l.* at the end of the seventh year. Under the Act of 1883, a very small proportion of patents are kept in force until the end of the term. It may, however, be doubted if the present renewal fees are not much too high. The total cost of a patent which runs fourteen years is now 154*l.*

Mode of payment under 15 & 16 Vict c. 83.

The mode of payment introduced by the Patent Law Amendment Act, 1852, had other advantages also. The preliminary payments of 25*l.* were not sufficiently large to discourage poor inventors, who experienced little difficulty in obtaining the necessary capital. The postponement of the heavier payments till the expiration of the third

(*k*) Not to the colonies or plantations abroad, unless pecially mentioned. See p. 667.

(*l*) *Infra*, p. 665.

(*m*) Report, &c., 1865, Evidence of Mr. Leonard Edmunds. pp. 26-9, Ans. 523, 527, 534. Report, &c., 1871, Evidence of Mr. T. Webster, Q.C., p. 93, Ans. 1077.

(*n*) *Williams* v. *Nash*, 1859, 28 L. J. Ch. 886; 28 Beav. 93.

(*o*) Edmunds' Evidence, p. 28.

and seventh years of the patent term enabled the patentee to determine whether it would pay him to keep up his patent, and acted as a more effectual deterrent from the continuance of a useless patent than the system of annual payments which was then in force upon the continent (*y*).

Present fees.

The fees comprised in the present schedule are paid by stamps impressed on the proper forms, which can be obtained at any money order office in the United Kingdom. By sect. 24, sub-s. 2, the Board of Trade may from time to time, with the consent of the Treasury, reduce any of these fees. The annual fees in lieu of the 100*l.* fee payable on patents applied for under the Act of 1852 have been reduced: see *ante*, p. 551. The comptroller-general has no power to remit them. But the time for payment may be extended for the term of three months on payment of a fee, see p. 577.

(*y*) Report, &c., 1872, Evidence of Mr. C. W. Siemens, p. 31, Ans. 581, 588; and of Mr. J. Howard, M.P., pp. 48, 49, Ans. 921, 924.

Section 113.

THE THIRD SCHEDULE.

Enactments repealed.

21 James 1, c. 3 .. [1623.]	The Statute of Monopolies (*a*). In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4, c. 62.. [1835.] In part.	The Statutory Declarations Act, 1835 (*b*). In part; namely,— Section eleven.
5 & 6 Will. 4, c. 83.. [1835.]	An Act to amend the law touching letters patent for inventions (*c*).
2 & 3 Vict. c. 67 .. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions" (*d*).
5 & 6 Vict. c. 100.. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65 .. [1843.]	An Act to amend the laws relating to the copyright of designs.

(*a*) This is given entire in the Appendix, p. 628 *et seq.*

(*b*) Appendix, p. 630.
(*c*) Ibid. p. 637 *et seq.*
(*d*) Ibid. p. 640 *et seq.*

Enactments repealed—continued.

7 & 8 Vict. c. 69 (*e*) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled "An Act for the better administration of justice in his Majesty's Privy Council, and to extend its jurisdiction and powers" (*f*). In part; namely,— Sections two to five, both included.
13 & 14 Vict. c. 104 [1850.]	An Act to extend and amend the the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83.. [1852.]	The Patent Law Amendment Act, 1852 (*g*).
16 & 17 Vict. c. 5.. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications (*h*).
16 & 17 Vict. c. 115 [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act (*i*).
21 & 22 Vict. c. 70.. [1858.]	An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13..... [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war (*j*).
24 & 25 Vict. c. 73.. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3.. [1865.]	The Industrial Exhibitions Act, 1865 (*k*).
33 & 34 Vict. c. 27.. [1870.]	The Protection of Inventions Act, 1870 (*l*).
33 & 34 Vict. c. 97.. [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the schedule the words and figures— "Certificate of the registration of a design ..... £5 0 0 And see section 65."
38 & 39 Vict. c. 91.. [1875.]	The Trade Marks Registration Act, 1875.

(*e*) Sects. 6 and 7 of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.
(*f*) Appendix, p. 641 *et seq.*
(*g*) Ibid. p. 646 *et seq.*
(*h*) Appendix, p. 670 *et seq.*
(*i*) Ibid. p. 672 *et seq.*
(*j*) Ibid. p. 674.
(*k*) Ibid. p. 676.
(*l*) Ibid. p. 677.

Enactments repealed—continued.

38 & 39 Vict. c. 93.. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33.. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37.. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10.. [1880.]	The Great Seal Act, 1880 (*n*). In part; namely,— Section five,
45 & 46 Vict. c. 72.. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882 (*o*). In part; namely,— Section sixteen.

(*n*) Appendix, p. 678.

(*o*) Appendix, p. 678.

PATENTS RULES, 1890 (*a*).

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following rules :—

Short Title.

1. These rules may be cited as the Patents Rules, 1890. Short title.

For the rules repealed by these Rules, see notes to Rule 81.

Commencement.

2. These rules shall come into operation from and immediately after the 31st day of March, 1890. Commencement.

Interpretation.

3. In the construction of these rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

For definitions of terms used in the Patent Acts, see Act of 1883, sects. 46 and 117. For definition of Board of Trade, see note (*a*) below.

(*a*) These Rules consolidate the Patents Rules, 1883, 1885, 1886, and the International and Colonial Arrangements Rules of 1888. They are made by the Board of Trade, under sect. 101 of the Patents Act, 1883, and are signed by the President of the Board. There is no authoritative definition of the term "Board of Trade," except that in 24 & 25 Vict. c. 47, s. 65, viz., "The Lords of the Committee of the Privy Council appointed for the consideration of matters relating to Trade and Foreign Plantations." Cp. also 22 Geo. III. c. 82, ss. 1, 15. It will be observed that in most instances these rules merely re-enact the provisions of the Patents Acts, 1883—88.

Fees.

Fees.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these rules.

Fees.—For schedule of fees, see p. 586.

The fees are prescribed by the Board of Trade, with the consent of the Treasury (*b*).

As regards the amount and time of payment of fees, the Act of 1883 is retrospective (*c*).

The fees are paid by stamps impressed on the forms in the schedule to these rules. These forms cannot be obtained at the Patent Office in Southampton Buildings, or at the Patent Office (Sale Branch) in Cursitor Street, but may be obtained at Room 6, Royal Courts of Justice, and there impressed with the necessary stamps in payment of the prescribed fees. Stamped or blank forms may also be obtained through any money order office on a few day's notice, or at certain post offices throughout the United Kingdom.

Forms.

Forms. Alterations.

5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the Second Schedule to these rules.

Forms in Schedule to Act of 1883.—These forms are given at p. 528 *et seq.*

Patents Rules, 1890.—These forms are given at p. 737 *et seq.*

Application.

6.—(1.) An application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the Act of 1883 and section 2 of the Act of 1885 shall be made either in the Form A or the Form A1, or the Form A2, set forth in the Second Schedule to these rules, as the case may be.

Specification.

(2.) The Form B in such schedule of provisional specification and the Form C of complete specification shall respectively be used.

(*b*) See sect. 24 of the Act of 1883; Patents Rules, 1890, rr. 45—48.

(*c*) Cp. sect. 45, p. 500.

(3.) The remaining forms other than A, A1, A2, B and C, set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules. Other forms.

Under the Patents Rules, 1883, r. 6 (1), application for a patent was made by a statutory declaration. The Patents Act, 1885, s. 2, allowed the declaration to be either statutory or not, as might be prescribed; and the present form contains merely a statement in writing, which, if false, will avoid the patent, but on which a prosecution for making a false declaration, as provided by the Statutory Declarations Act, 1835, would not lie.

General.

7. The Patent Office shall be open to the public every week day, between the hours of ten and four, except on the days and times following :— Hours of business.

Christmas Day.

Good Friday.

The day observed as her Majesty's birthday.

The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

See provision as to days for leaving documents at the Patent Office, Act of 1883, s. 98.

As to days when the Register of Patents is open to public inspection, see r. 79.

The library is open from 10 a.m. to 10 p.m. daily.

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, and, if he so require, resident in the United Kingdom. Agency.

As to patent agents, see p. 526.

For practice on applications, see, also, notes to sects. 4, 5, *supra*, pp. 427 *et seq.*, and Chapter on Applications, pp. 81 *et seq.*

As to applications under the International and Colonial Arrangements, see rr. 24—29.

When an applicant desires to change his agent, the words, "And I hereby cancel all previous authorisations," should be inserted in the authorisation of the new agent (*b*).

For a form of authorisation of agent, see p. 738.

An authorisation to an agent can be given at any time during the progress of an application for a patent.

Statement of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the Comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the Comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

The statement of address should be on a separate sheet, but may be written on the back of the application, and generally is so written.

Size, &c. of documents.

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office, or otherwise furnished to the Comptroller or to the Board of Trade, shall be written or printed in large and legible characters and unless otherwise directed in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the Comptroller.

As to the sizes and methods of preparing drawings accompanying provisional or complete specifications, see rr. 30—33.

Duplicates of specifications and drawings are required by the Comptroller.

Exercise of discretionary power by Comptroller.

11. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specifica-

(*b*) Griffin, P. C. p. 322.

tion, the Comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the Comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice. Notice of hearing.

This is practically a repetition of Act of 1883, s. 94.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter. Notice by applicant.

See form of notice by applicant, Form E, *infra*, p. 741. No fee is payable.

13. Whether the applicant desires to be heard or not, the Comptroller may at any time require him to submit a statement in writing within a time to be notified by the Comptroller, or to attend before him and make oral explanations with respect to such matters as the Comptroller may require. Comptroller may require statement, &c.

The Comptroller General does not usually require the applicant to be present, but will decide in his absence if he gives notice that he does not desire to be heard.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby. Decision to be notified to parties.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the Comptroller Industrial or international exhibitions.

notice, in writing, of his intention to exhibit, publish, or use the invention, as the case may be.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the Comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the Comptroller may in each case require.

As to industrial or international exhibitions, see Act of 1883, s. 39; and as to foreign exhibitions, see Act of 1885, s. 3.

Form of notice, *infra*, p. 747. The fee is 10*s.* (*b*).

Form of certificate by Board of Trade, *infra*, p. 845.

Power of amendment, &c.

16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the Comptroller may think fit.

This is a very important rule.

For the amending of which no special provision is made.—The following documents are therefore excepted from the operation of this rule:—

A complete specification after acceptance (*c*);

An application for a patent, so far as clerical errors are concerned (*d*);

Drawings (*e*);

The register (*f*);

as to all of which the Comptroller General has a special jurisdiction.

The Act gives no power for the amendment of *letters* patents, unless possibly in Act of 1883, s. 23 (1).

In *Re Airey* (*g*), where a notice of opposition omitted to give the date and title of a prior patent, in accordance with rule 36, *infra*, the Comptroller gave leave to amend under this rule, as it appeared that the applicant had before him the means of referring to the specification; and in *Re Lake* (*h*), where the notice of opposition had been signed by the opponent's agent, who died before the hearing, the

(*b*) Schedule of Fees, pp. 586—588.
(*c*) Act of 1883, ss. 18—21.
(*d*) *Ibid.* s. 91 (a).
(*e*) *Ibid.* ss. 7 and 9.
(*f*) *Ibid.* s. 91 (b).
(*g*) 1888, 5 P. O. R. 348.
(*h*) 1887, Griffin, A. P. C. 35.

name of the real opponent was allowed to be substituted. See other cases, *supra*, p. 170.

16A. Any application, notice, or other document authorised or required to be left, made or given at the Patent Office, or to the Comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Manner in which, and persons before whom declaration is to be taken.

17. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b) In any other part of Her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(c) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

See the Commissioners for Oaths Act, 1889 (52 Vict. c. 10).

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively

numbered, and each paragraph shall so far as possible be confined to one subject.

APPLICATION[1] WITH PROVISIONAL OR COMPLETE SPECIFICATION.[2]

Order of recording applications.

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

1 For application generally, see Chapter VI., p. 69.

As to applications for patents generally, see pp. 81, 82.

As to joint applications, see sect. 4, p. 427.

As to applications under sect. 103, see p. 516, and rules 24—29, *infra*.

The form must be signed by the applicant, and not by an agent (*i*).

In the case of an application by a company, the form should be signed by the secretary and two directors, and must have the common seal affixed to it. But unless under the International and Colonial Arrangements, a company cannot be a sole applicant, because it cannot be an inventor.

As to sending applications through the post, see Act of 1883, s. 97.

Although not required by the Acts or Rules, a list of applications is advertised weekly in the Official Journal.

2 For the relative advantage of filing a provisional or complete specification in the first instance, see pp. 71 *et seq.*

Application for separate patents by way of amendment.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the Comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire to that effect to the Comptroller, bear the date

(*i*) Rule 6.

of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

As to the provision against a patent comprising more than one invention, see note to sect. 33, *supra*, p. 490.

Application by representative of deceased inventor.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

There is no special form of application by legal representative of deceased person.

As to the right of such representative to be an applicant, see Act of 1883, ss. 34 and 12 (3b).

As to form of grant in such cases, see p. 535.

Notice and advertisement of acceptance.

21. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Notice of acceptance. See form of, at pp. 757, 758.

The advertisement is in the Illustrated Official Journal, published every Wednesday. The advertisement of the acceptance of the complete specification only is required by the Act.

As to acceptance of specifications, see Act of 1888, s. 2, and Act of 1883, s. 10.

Inspection on acceptance of complete specification.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

See Act of 1883, s. 10. The Act of 1885, s. 4, provided that publication should only take place in the event of acceptance. The fee for inspection is 1s. (*j*).

(*j*) See Schedule, p. 587.

The printed specifications are issued about three weeks after the acceptance of the complete specification. So that there is five weeks after the issue of the printed specification during which the advisability of entering an opposition may be considered, besides the three weeks during which only the written copies can be inspected.

Application on communication from Abroad.

Communication from abroad.

23. An application for a patent for an invention communicated from abroad shall be made in the Form A 1 set forth in the Second Schedule to these Rules.

The person to whom a communication from abroad is made must be resident in the United Kingdom or the Isle of Man.

The Patent Office does not recognise agents not resident in this country.

A communicator cannot apply under sect. 103. *Re Shallenberger*, 1889, 6 P. O. R. 551.

International and Colonial Arrangements(*k*).

24. The term "foreign application" shall mean an application by any person for protection of his invention in a Foreign State or British Possession to which by any Order of Her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

This and the five succeeding rules were the Patents (International and Colonial Arrangements) Rules, 1888.

British possession.—See definition of this term in sect. 117, *supra*, p. 526.

Order in Council.—See list of such Orders and the States to which they are applicable, *supra*, at p. 411.

On International and Colonial Arrangements generally, see sects. 103 and 104, *supra*, at pp. 516 *et seq.*, and also at Chapter XX.

Foreign application.—See *Re Van de Poele* (1890, 7 P. O. R. 69), and *supra*, p. 416.

25. An application[1] in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify[2] all the Foreign States or British Possessions in which foreign

(*k*) See Chapter XX.

applications have been made and the official date or dates thereof respectively. The application must be made within 7 months[3] from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

1 *Application.*—See Form A2, *infra*, p. 739.
As to who may apply, see Rule 23.

2 *Shall specify.*—See the case of *Re L'Oiseau and Pierrard* (*l*), and *supra*, at p. 415.

3 *Seven months.*—See International Convention, 1883, Art. 4, and Chap. XX.; also Act of 1883, s. 103, p. 516.

26. The application in the United Kingdom shall be made in the Form A2 in the Second Schedule to these Rules, and in addition to the specification, provisional or complete, left with such application must be accompanied by—

(1.) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the Foreign State or British Possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such Foreign State or British Possessions as aforesaid, or otherwise verified to the satisfaction of the Comptroller;

(2.) A statutory declaration[1] as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification[2] or document corresponding thereto be in a foreign language, a trans-

(*l*) 1887, Griffin, A. P. C. 36.

lation thereof shall be annexed to and verified by such statutory declaration.

1 *Statutory declaration.*—As to manner in which, and persons before whom, such declarations may be taken, see r. 17, *supra*, p. 565.

2 *Specification.*—The foreign and British specification need not be in the same terms if they are in substance identical (*m*).

27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof (if any) as the Comptroller may require of or relating to such foreign application or of the official date thereof, the Comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

28. All further proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

A "foreign applicant" cannot, however, oppose the grant of a subsequent British patent for the same invention as his own, under the Act of 1883, s. 11, sub-s. 1 (*n*).

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

Sizes and Methods of preparing Drawings accompanying Provisional or Complete Specifications.

Drawings for specifications.

30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the

(*m*) *Re L'Oiseau and Pierrard*, 1887, Griffin, A. P. C. 37.

(*n*) *Re Everitt*, 1888, Griffin, A. P. C. 28.

provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself.

Drawings are required in duplicate, see Rule 32.

31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

Requirements as to paper, &c.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality, and where possible without colour or Indian-ink washes.

Size of drawings.

They must be on sheets of one of the two following sizes (the smaller being preferable) 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be $\frac{1}{2}$ an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Quality of ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement (*o*). Reference figures and letters must be bold, distinct, not less than $\frac{1}{8}$ of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must

(*o*) This drawing is not given here, but is issued with the Patent Rules, which may be purchased at the Patent Office Sale Branch, Cursitor Street, W.C. Price 6*d*.

be shown outside the figure, and connected with the part referred to by a fine line.

Scale of drawings.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c., need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings to bear name of applicant, &c.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

No written description of the invention should appear on the drawings.

Restrictions as to wood engravings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings.

32. A *facsimile* of the original drawings but *without* colour or Indian-ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "true copy."

The office prefers that the lettering on the duplicate copy should be in pencil, preferably blue pencil.

Provisional drawings used for complete specification.

33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

As to the law in regard to drawings, see *supra*, pp. 107, 433.

Opposition to Grants of Patents (*o*).

Notice of opposition.

34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (hereinafter in Rules 37, 38, 41 and 43, called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

Notice of opposition must be *signed* by the opponent (*p*), but may, with the permission of the Comptroller General, under rule 16, be signed after delivery. Although rule 8 does not expressly apply to an opponent, the Comptroller General permits agents to act for opponents as well as for applicants.

Copy for applicant.

35. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant.

Particulars of prior patent.

36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice.

An omission *per incuriam* is curable by the Comptroller General under Rule 16, subject to costs of the day if the correction renders an adjournment of the hearing necessary.

As to disallowance of opposition, see Rule 42.

Opponent's evidence.

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

The Comptroller may extend the time under r. 51.

Statutory declarations.—See r. 17, *supra*, p. 565.

Applicant's evidence.

38. Within 14 days from the delivery of such list

(*o*) For this subject generally, see Chap. IX.

(*p*) See, however, Act of 1883, s. 99.

the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Evidence in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

The declarations in reply should be confined strictly to matters in reply, otherwise they may be ordered to be removed from the file.

Closing of evidence.

39. No further evidence shall be left on either side except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application in writing made to him for that purpose.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Such leave will not be granted unless the Comptroller-General is satisfied that the further evidence which it is desired to give was not within the knowledge of, or reasonably obtainable by, the party applying for leave, within the times allowed by rr. 35 and 36.

Notice of hearing.

41. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and shall give the parties 10 days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the Comptroller an application on Form E. The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the Comptroller shall decide the case and notify his decision to the parties.

See Fee 6, Form E, *infra*, pp. 586 and 741.
The attendance of both or either of the parties is not required.

Disallowance of opposition in certain cases.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

See also Rule 36, *supra*.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

This rule is new.

Decision to be notified to parties.

44. The decision of the comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

The decision of the Comptroller is usually given to the parties with the reasons therefor in writing.

CERTIFICATES OF PAYMENT OR RENEWAL (*q*).

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

45. If a Patentee[1] intends at the expiration of the fourth or eighth year from the date of his patent[2] to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee[3] of 50*l.* or 100*l.*, as the case may be.

1 *Patentee.*—See definition of: Act of 1883, s. 46, p. 501.

2 *Date of his patent.*—See sect. 13, *supra*, p. 451.

(*q*) As to renewal fees generally, see Act of 1883, second schedule, pp. 550 *et seq.*

Prescribed fee.—See Act of 1883, s. 24, and second schedule thereto, at p. 550. See also Schedules of Fees to these Rules, at p. 586.

As to patents granted before commencement of Act.

46. In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

The commencement, &c.—The Act of 1883 commenced on 1st January, 1884 (*r*); the Act of 1885, on 14th August, 1885; the Act of 1886, on 25th June, 1886; and the Act of 1888, on 1st January, 1889.

Payment of annual fees in lieu of 50*l.* and 100*l.*

47. If the patentee intends to pay annual fees in lieu of the above mentioned fees of 50*l.* and 100*l.*, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, pay the prescribed fee.

The Form J in the second schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.

Annual fees.—See Fees 15—25. Form J is given at p. 744. And see Act of 1883, second schedule.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

See form of certificate, *infra*, p. 745.

On issue of certificate, the amount and date of payment is entered on the Register of Patents: see Rule 76. The patentee's failure to make any prescribed payment is also recorded on the register: see Rule 77.

Enlargement of Time.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the

(*r*) See Act of 1883, s. 3.

circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Cp. Patents Rules, 1883, r. 46.
See form of such application, *infra*, p. 745.

An enlargement of time for payment may be made, subject to the following penalties:—

Not exceeding one month, 3*l.*
Not exceeding two months, 7*l.*
Not exceeding three months, 10*l.*

No enlargement is granted after three months: Act of 1883, s. 17, sub-s. 4 (a).

See prescribed payments, schedule of fees, *infra*, p. 587.

Extension of time for leaving and accepting complete specification.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary.

This rule is new.

In other cases.

51. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

See Rule 35.

This application is not granted as a matter of course. The written consent of the other side, if there be one, should, if possible, be obtained, and good cause must be shown for the extension.

This rule applies only to the times prescribed by *the rules*. See sect. 98, *supra*, p. 511, as to the days for leaving documents, &c. at the Patent Office in the case of Sunday, holidays, &c.

Amendment of Specification (*s*).

Request for leave to amend.

52. A request for leave to amend a specification must

(*s*) As to amendments of specifications generally, see pp. 145 *et seq.*

be signed by the applicant or patentee (hereinafter, in Rules 54, 55, and 58, called the applicant), and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

Advertisement.

As to amendment of specifications generally, see Act of 1883, ss. 18—21; and Act of 1885, s. 5; also Chap. VII.

For form of request, see p. 742.

Signed.—The application for leave to amend must be signed by the applicant or patentee. Subsequent proceedings may be conducted by an agent.

Advertised.—The advertisement is in the Illustrated Official Journal.

Notice of opposition.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

See Act of 1883, s. 18, sub-s. 2, p. 456. The notice must be given within one month of the first advertisement; and this time cannot, it seems, be extended, as Rule 31 applies only to the times prescribed under the rules. The notice of opposition should be on Form G (*t*), with a fee of 10*s.* (*u*). It must be signed by the opponent, who must be "a person entitled to be heard" under Act of 1883, s. 18, sub-s. 4.

Copy for the applicant.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

Opponent's evidence.

55. Within 14 days after the expiration of one month from the first advertisement of the application for

(*t*) See Appendix, p. 742.

(*u*) See Schedule of Fees, p. 586.

leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

To the applicant, *i. e.*, to the applicant or his authorised agent (*x*).
See Rule 37, *supra*, p. 573.

Further proceedings.

56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44, shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

Requirements thereon.

57. Where leave to amend is given the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31.

Leave by order of Court.

58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

An Order of the Court.—See Act of 1883, s. 19, *supra*, p. 460.

Advertisement of amendment.

59. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

See Act of 1883, s. 21, *supra*, p. 461.
The advertisement is in the Illustrated Official Journal.

Compulsory Licences (*y*).

Petition for compulsory grant of licences.

60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show clearly the nature of the petitioner's interest, and the ground or

(*x*) Rule 8.

(*y*) See Act of 1883, s. 22.

grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

For form of petition, see p. 743. For fees, see schedule, p. 587.

To be left with evidence at Patent Office.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

Directions as to further proceedings unless petition refused.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

Procedure.

63. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Petitioner's evidence.

Patentee's evidence.

64. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in reply.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

66. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition. Further proceedings.

Register of Patents (*z*).

67. Upon the sealing of a patent the comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention. Entry of grant.

There is no entry upon the Register until the patent is sealed.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the Patent Office. Request for entry of subsequent proprietorship.

Forms of request, Appendix, Form L., p. 746.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner. Signature of request.

A body corporate may be registered as proprietor by its corporate name: Rule r. 74.

(*z*) See Chap. XII., on the Register of Patents.

Particulars to be stated in request.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

See Forms L and M, p. 746.

Production of documents of title and other proof.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof, as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller.

Copies for Patent Office.

72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

Body corporate.

73. A body corporate may be registered as proprietor by its corporate name.

Entry of orders of the Privy Council

74. Where an order has been made by Her Majesty in Council for the extension of a patent for a further

term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent, or the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be. Order of Court.

As to extension of letters patent, see Act of 1883, s. 25, *supra*, p. 466; and chapter on Extension, pp. 373 *et seq.*

As to revocation of patents, see Act of 1883, s. 26, *supra*, p. 474; and chapter on Revocation, at p. 355.

As to rectification of register, see Act of 1883, s. 90, and *supra*, pp. 210 *et seq.*

Order in Council for extension, see form of, at p. 838.

Order of Court for revocation, see form of, at p. 811.

Order for rectification of register, see form of, at p. 777.

75. Upon the issue of a certificate of payment under Rule 48, the comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate. Entry of payment of fees on issue of certificate.

See form of certificate of payment, *infra*, p. 745.

As to fees, see Act of 1883, second schedule, p. 550.

76. If a patentee fails to make any prescribed payment[1] within the prescribed time[2] or any enlargement[3] thereof duly granted, such failure shall be duly entered in the register. Entry of failure to pay fees.

1 *Prescribed payment.*—See Schedule of Fees, 14—25, *infra*, p. 587.

2 *Prescribed times.*—See Act of 1883, s. 17, sub-ss. 2, 3, 4, *supra*, p. 454.

3 *Enlargement.*—See Rules 49—51.

77. An attested copy of every license granted under a patent shall be left at the Patent Office by the licensee, Entry of licences.

with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

As to licences generally, see p. 202.
See form of request, Form M, p. 746.
For fee, see p. 587.

Hours of inspection of register.

78. The Register of Patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following:—

(a) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or

(b) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office;

(c) Times when the register is required for any purpose of official use.

As to hours of business at Patent Office, see Rule 7, *supra*.

Certified copies of documents.

79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee.

The fee is No. 35 (1*s.*), *infra*, p. 587, besides the cost of copying, at fourpence a folio.

Power to Dispense with Evidence, &c.

80. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to

make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

See Act of 1883, s. 99, *supra*, p. 512, as to declarations by infants, lunatics, &c.

REPEAL (*a*).

81. All general rules heretofore made by the Board of Trade under the Patents Designs and Trade Marks Acts, Repeal.

(*a*) The Patent Rules, 1890, consolidate in one set the Patents Rules of 1883, 1885, 1886, and 1888, and make some amendments and additions. Among other alterations it is provided as regards hearings before the comptroller or the law officers, that (by rule 17a) statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject; by rule 41, on completion of the evidence, or at such other time as he may see fit, the comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E. The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the comptroller shall decide the case and notify his decision to the parties; that (by rule 43) where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Rule 47 abolishes the necessity of notice by a patentee who intends to pay annual fees in lieu of the fees of 50*l*. and 100*l*. Form J duly stamped is sufficient.

As regards the recording subsequent proprietorship of patents, it is provided (by rule 72):—

There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application then pending.

The Patents Rules made previously under the Act of 1883 were :—

The Patents Rules, 1883, which came into operation the 1st January, 1883.

The Patents Rules, 1885, which came into operation on the 15th August, 1885.

The Patents Rules, 1886, which came into operation on the 16th September, 1886.

The Patents (International and Colonial Arrangements) Rules, which came into operation on the 1st June, 1888.

Dated the 31st day of March, 1890.

M. E. HICKS-BEACH,
President of the Board of Trade.

FIRST SCHEDULE.

List of Fees payable on and in connexion with Letters Patent.

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection	1	0	0			
2. On filing complete specification	3	0	0			
				4	0	0
or						
3. On *filing* complete specification with first application	4	0	0			
4. On appeal from comptroller to law officer. By appellant	3	0	0			
5. On notice of opposition to grant of patent. By opponent	0	10	0			
6. On hearing by comptroller. By applicant and by opponent respectively	1	0	0			

		£	s.	d.
7.	On application to amend specification :—			
	Up to sealing. By applicant.....	1	10	0
8.	After sealing. By patentee	3	0	0
9.	On notice of opposition to amendment. By opponent..	0	10	0
10.	On hearing by comptroller. By applicant and by opponent respectively	1	0	0
11.	On application to amend specification during action or proceeding. By patentee	3	0	0
12.	On application to the Board of Trade for a compulsory license. By person applying.....	5	0	0
13.	On opposition to grant of compulsory license. By patentee	5	0	0
14.	On certificate of renewal :—			
	Before end of 4 years from date of patent	50	0	0
15.	Before end of 7 years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of 8 years from date of patent	100	0	0
	or in lieu of the fees of 50*l.* and 100*l.*, the following annual fees:—			
16.	Before the expiration of the 4th year from the date of the patent..	10	0	0
17.	,, ,, 5th ,, ,, ..	10	0	0
18.	,, ,, 6th ,, ,, ..	10	0	0
19.	,, ,, 7th ,, ,, ..	10	0	0
20.	,, ,, 8th ,, ,, ..	15	0	0
21.	,, ,, 9th ,, ,, ..	15	0	0
22.	,, ,, 10th ,, ,, ..	20	0	0
23.	,, ,, 11th ,, ,, ..	20	0	0
24.	,, ,, 12th ,, ,, ..	20	0	0
25.	,, ,, 13th ,, ,, ..	20	0	0
	On enlargement of time for payment of renewal fees :—			
26.	Not exceeding 1 month	3	0	0
27.	,, 2 months	7	0	0
28.	,, 3 months	10	0	0
29.	For every entry of an assignment, transmission, agreement, license, or extension of patent	0	10	0
30.	For duplicate of letters patent .... each	2	0	0
31.	On notice to comptroller of intended exhibition of a patent under section 39	0	10	0
32.	Search or inspection fee..... each	0	1	0

	£	s.	d.
33. For office copies, every 100 words (but never less than one shilling)	0	0	4
34. ,, of drawings, cost according to agreement.			
35. For certifying office copies, MSS., or printed, each ..	0	1	0
36. On request to comptroller to correct a clerical error—			
Up to sealing	0	5	0
After sealing	1	0	0
37. For certificate of comptroller under section 96	0	5	0
38. For altering address in register	0	5	0
39. For enlargement of time for filing complete specification not exceeding one month	2	0	0
40. For enlargement of time for acceptance of complete specification—			
Not exceeding one month	2	0	0
,, two months.....	4	0	0
,, three months	6	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

31st March, 1890.

Approved: R. E. WELBY,
For the Lords Commissioners of
Her Majesty's Treasury.

31st March, 1890.

SECOND SCHEDULE.

(*For these Forms, see Appendix*, pp. 737—750.)

LAW OFFICERS' RULES (*a*).

Rules regulating the Practice and Procedure on Appeals to the Law Officers (*a*).

Notice of appeal.

I. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the Acts, he shall within 14 days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

An appeal lies to the law officer from the decision of the comptroller:

(a) Requiring the amendment of an application or specification, or of drawings (*b*);

(b) Refusing an application on the ground that the invention comprised in it is the same as that comprised in a prior application (*c*);

(c) Requiring the amendment of a complete specification (*d*);

(d) Upon opposition to the grant of letters-patent (*e*);

(e) Upon opposition to the amendment of a specification (*f*);

(f) Refusing leave to amend a specification (*g*).

There is no right of appeal to the law officer from the Comptroller General, refusing—

(a) To enlarge the time prescribed by the principal Act for the payment of fees (*h*);

(b) To grant a patent for an invention of which the use would in his opinion be contrary to law or morality (*i*); or

(c) To extend the time for leaving a complete specification (*j*).

(*a*) These Rules are made under sect. 38 of the principal Act, which further empowers the law officer to examine witnesses on oath and to award costs. The comptroller has no power to award costs, and evidence before him must be given by way of statutory declaration. He has no power to administer oaths or to examine witnesses on oath.

(*b*) Act of 1883, s. 7, sub-s. 2.
(*c*) *Ibid.* s. 7, sub-s. 6.
(*d*) *Ibid.* s. 9, sub-s. 2.
(*e*) *Ibid.* s. 11, sub-s. 2.
(*f*) *Ibid.* s. 18, sub-s. 3.
(*g*) *Ibid.* s. 18, sub-s. 6.
(*h*) *Ibid.* s. 17.
(*i*) *Ibid.* s. 86.
(*j*) Act of 1885, s. 3.

Appeals have been taken to the law officer from the decision of the Comptroller General under sect. 33, that a patent contains more than one invention; but these are rather in the nature of references under Act of 1883, s. 95, by which the comptroller may apply to either of the law officers in case of doubt and difficulty.

For notice of appeal, see Form T, *infra*, p. 749. The fee is £3, *infra*, p. 586.

In cases where by his decision the comptroller requires an amendment to be made, *and does not in his decision settle the specific words of the amendment*, the time for appealing is regarded as dating from the day of forwarding to the opponent a copy of the amendment approved by him (*k*). Notice of appeal may be signed by an agent authorized by appellant (*l*).

Notice to state what part appealed against.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

The effect of Rules I. and II. is to limit the hearing before the law officers to points specifically raised by the notice of appeal; and where a notice of appeal is as to part only of the comptroller's decision, the person receiving such notice, and desiring to question other parts of the comptroller's decision, must give a counter-notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter-notice may be extended under Rule 5 (*m*). A counter-notice is necessary when the appeal is from the whole decision (*n*).

Service of notice of appeal.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at room 549, Royal Courts of Justice, London; and when there has been an opposition before the comptroller, to the opponent or opponents; and when the comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

As to how notice may be sent, see r. XIV., *infra*.

(*k*) *Re Chandler*, 1886, Griffin, P. C., at p. 273; *Re Cooper and Ford*, 1885, *ib.* 276.

(*l*) *Re Anderson and McKinnell*, 1887, Griffin, A. P. C., at p. 24.

(*m*) *Re Bairstow*, 1888, per Clarke, S.-G., 5 P. O. R., at p. 286.

(*n*) *Re Hall and Hall*, 1888, 5 P. O. R. 283.

In *Re Anderson and McKinnell* (*o*), it was held by Clarke, S.-G., that this rule applied only when the *applicant appealed*. But in *Re Hill* (*p*), Webster, A.-G., while agreeing with this construction of the terms of the rule, said that due notice should be given of the appeal to the respondent, even if he were applicant before the comptroller, either through the Patent Office or through the official clerk. (Cp. *Re Rylands*, 1888, 5 P. O. R. 668.)

Transmission of papers to law officer.

IV. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

Extension of time for appealing.

V. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer.

Time for appealing.

The time for appealing has been extended by the Comptroller General in cases in which the parties were resident abroad.

Notice of hearing of appeal.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

To whom notice of hearing to be given.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

Evidence before law officer.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the

(*o*) 1887, Griffin, A. P. C. 24. (*p*) 1888, 5 P. O. R. 601

knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

A specification which had come to the knowledge of an appellant since the hearing before the comptroller cannot be put in before the law officer on opposition to the grant of a patent. Such a specification is not evidence, but an additional ground of opposition (*p*). Herschell, S.-G., refused to allow an imputation of fraud in a notice of opposition to be gone into, on the ground that no evidence had been filed in support of it; nor would he allow time for evidence as to fraud to be put in (*q*).

Cross-examination.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

Powers of law officer.

As to the power of the law officer to examine witnesses on oath, see sect. 38, *supra*.

"When it is desired to obtain an order for the attendance of declarants for cross-examination, a list of such persons must be left with the law officers' clerk, with a request for an order for their attendance. Copies of the request and list should be sent to the other side. The law officer then requests the attendance of both parties before him, with reference to the application, and if satisfied that an order should go directs that summonses should be issued, which the law officers' clerk then issues in due course" (*r*).

Conduct money to witnesses on cross-examination.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness, whose attendance is required, a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the

(*p*) *Re Bailey*, 1884, Griffin, P. C. 269.

(*q*) *Re Huth*, 1884, Griffin, P. C. 293; cp. *Re L'Oiseau and Pierrard*, 1887, Griffin, A. P. C. 36, and *ante*.

(*r*) Griffin, P. C. p. 319.

amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

As to the law officer's power over costs, see Act of 1883, s. 38, and note thereto, *supra*, p. 492. Costs.

The law officer makes costs follow the event in appeals if he possibly can (*s*).

The law officer usually orders a lump sum to be paid on account of costs.

XII. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act. Order for payment of costs.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary. Documentary evidence.

XIV. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post. How notices may be sent.

A.-G.
S.-G.

This rule seems to be already covered by Act of 1883, s. 97, *supra*, p. 511.

(*s*) *Re Anderton*, 1886, Griffin, A. P. C. 25; *Re Fletcher*, 1887, Griffin, A. P. C. 30.

PRIVY COUNCIL RULES IN PATENT CASES BEFORE THE JUDICIAL COMMITTEE.

RULES TO BE OBSERVED IN PROCEEDINGS before the RIGHT HONOURABLE the LORDS of the JUDICIAL COMMITTEE OF THE PRIVY COUNCIL under the Act of the 5th and 6th William IV., intituled "An Act to amend the Law touching LETTERS PATENT FOR INVENTIONS," cap. 83.

No rules made under Act of 1883.

No rules having yet been made under sect. 25, sub-s. 6 of the Act of 1883, these Rules, which were made to regulate procedure under the statute 5 & 6 Will. IV. c. 83, are still in force. It is understood that the Judicial Committee have no present intention of issuing new rules. Apparently the procedure on prolongation is unaltered, as only patents granted before the Act of 1883 can be prolonged for some years to come (*a*). There is no confirmation now by petition to Privy Council, except perhaps for patents granted under the Act of 1852.

Petition for confirmation.

RULE I.—A party intending to apply by petition, under sect. 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such adver-

(*a*) See Chapter XVIII.

tisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the council office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

This Rule relates to the provision contained in 5 & 6 Will. IV. c. 83, s. 2, for the confirmation of letters patent, invalid for want of novelty. That provision has not, however, been re-enacted in the present Act.

As to confirmation generally, see Chapter XIX.

Petition for prolongation.

RULE II.—A party intending to apply by petition, under sect. 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the council office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

The *sect.* 4, here referred to, dealt with the prolongation of letters patent and required the petitioner to advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where, or near to which, he carried on any manufacture of anything made according to his specifi-

cation, or near to, or in which he resided in case he carried on no such manufacture, or published in the county where he carried on such manufacture, or where he lived, in case there should not be any paper published in such town, that he intended to apply to the Sovereign in Council for extension.

This mode of advertisement must still be followed.

"When the patentee resides abroad, and the invention is carried on under licenses, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on" (*b*).

To entitle an equitable assignee to appear with the legal assignee of a patent on a petition for extension, the name of the former must appear with that of the latter in the advertisements required by sect. 4 of 5 & 6 Will. IV. c. 83 (*c*).

The advertisements should be proved before the case is heard (*d*).

In *Macintosh's Patent* (*e*), a petition for extension, presented nearly eighteen months before the expiration of the patent, was ordered to stand over as the profits accruing in the meantime might materially affect the question as to the propriety of an extension being granted. Upon the application to fix a day for the hearing being renewed, it was questioned, but not decided, whether the old notices would be sufficient.

For forms of advertisements, see Appendix, p. 812 *et seq.*

Petitions. When petition must be presented.

RULE III.—Petitions under sects. 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

In a case where delay arose from the mistake of the petitioner's agent, this rule was waived by the Judicial Committee (*f*), and in *Recce's Patent* (*g*), a supplementary statement to correct errors in a petition was allowed to be delivered before the hearing.

For forms of petition, see Appendix, p. 816 *et seq.*

(*b*) *Derosne's Patent*, 1844, 2 Web. P. C. . "The statute," said Lord Brougham, in this case, "provides for two cases, the patentee carrying on a manufactory, or residing; but there would be no sense in inserting an advertisement in the 'Moniteur,' when the man resides in Paris; that would afford no protection to the Queen's subjects, for whose protection the rule is intended": *Ibid.*

(*c*) *In re Noble's Patent*, 1850, 7 Moo. P. C. 191.

(*d*) *In re Perkins's Patent*, 1845, 2 Web. P. C. 8; *Bell's Patent*, 1846, *ibid.* p. 160.

(*e*) 1837, 1 Web. P. C. 739, n.

(*f*) *In re Hutchinson's Patent*, 1861, 14 Moo. P. C. 364.

(*g*) Cited by Lawson, p. 259, from Eng. Rep., Jan. to Mar. 1881, xiv.

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of sect. 4 of the said Act, and the 1st and 2nd of these rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions. Affidavits of advertisements.

RULE V.—All persons entering caveats under sect. 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect. 2 of the said Act, and all persons lodging notices of opposition under the 1st of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service. Caveats.

For form of caveat, see Appendix, p. 813.

Where the Judicial Committee made an order to receive a petition which had not been presented in accordance with rule 3, *supra*, and a caveat had been entered, it was held that as the party filing the caveat was interested in sustaining the objection to the reception of the petition notice of the application must be served upon him (*h*).

RULE VI.—All parties served with petitions shall lodge at the council office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions. Grounds of objection.

Under this rule, it is sufficient to state the grounds, without the particulars, of the objections (*i*).

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense. Copies.

RULE VIII.—The registrar of the privy council, or Costs.

(*h*) *In re Hutchinson's Patent*, 1861, 14 Moo. P. C. 364.

(*i*) *Bell's Patent*, 1879, L. R. 4 App. Cas. 171.

other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Documents to be lodged at Council Office.

RULE IX.—A party applying for an extension of a patent, under sect. 4 of the said Act, must lodge at the council office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The Crown.

The Judicial Committee will hear the Attorney-General, or other Counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

Copies of specification, &c.

In *Bell's Patent* (*k*), a petition was allowed to proceed, although copies of the specification had not been lodged as required by this rule, the omission being unintentional, and due to the rule not being generally known, but the Judicial Committee intimated that their leniency in that case was not to be taken as a precedent.

The rule as to copies of the balance-sheet is imperative (*l*), and is intended to enable the Attorney-General to inspect the accounts, and to make inquiries before the hearing of the petition.

(*k*) 1846, 2 Web. P. C. 159.

(*l*) *Johnson's and Atkinson's Patents*, 1873, L. R. 5 P. C. 87; *Yates and Kellett's Patent*, 1887, 4 P. O. R. 151.

In considering a petition for the extension of a patent which has not come into use, and is not likely to be used except by the Government, the Judicial Committee rely, to a large extent, upon what is said in favour of the patent by the representatives of the Crown (*m*).

In *Ball's Patent* (*n*), it was observed by Sir Barnes Peacock that the Attorney-General might introduce evidence impeaching a patent irrespective of the notice of objections.

(*m*) *Hughes' Patent*, 1879, 4 A. C. 174.

(*n*) 1879, 4 A. C. 171.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (*a*).

Signed at Paris March 20, 1883.

[Ratifications exchanged at Paris, June 6, 1884.]

I.

International Convention (*b*).

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Recital of objects of convention.

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects

(*a*) "Industrial property" includes patents, industrial designs and models, trade marks and trade names. See, however, Clause I. of the Protocol, p. 614.

We are here concerned with the Convention only in so far as it deals with patents, although the text is given in full.

For an account of the origin of this Convention, see p. 408.

The legal relation of this Convention to the Patents Act, 1883, ss. 103 and 104, has been taken up at p. 413 *et seq.*

(*b*) The original Convention was published in French, which, under Art. 6 of the Final Protocol (*infra*, p. 617), is the official language of the International Office. The authorised English translation has been given here; but, except in the formal parts, the French version of each article has been printed immediately below the paragraph to which it refers. The terms of the Convention, both in the original and in the English translation, are often vague. In such cases a reference to the original French text is of assistance.

and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say:—

Plenipotentiaries.

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c.;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon, Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, His Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c.;

The President of the French Republic: M. Paul Challemel-Lacour, Senator, Minister for Foreign Affairs; M. Hérisson, Deputy, Minister of Commerce; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c.;

The President of the Republic of Guatemala: M. Crisanto-Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Italy: M. Constantin Ressman, Commander of His Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c.;

His Majesty the King of the Netherlands: the Baron de Zuylen de Nyevelt, Commander of His Majesty's Order of the Netherlands Lion, Grand Cross of His Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Portugal and the Algarves: M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c.;

The President of the Republic of Salvador: M. Torres-Caïcedo, corresponding Member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the King of Servia: M. Sïma M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c.;

And the Federal Council of the Swiss Confederation: M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permament Commission for the protection of Industrial Property;

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles :— Articles agreed upon.

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the protection of Industrial Property. Union for protection of industrial property.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la protection de la Propriété Industrielle.

The necessary ratifications were exchanged by the plenipotentiaries of the High Contracting Parties on June 6, 1884, and as Article XVIII. provides that the convention should come into operation one month after the exchange of ratifications, the date from which it applies to the countries named in Article I. is July 6, 1884. Date of the Convention.

The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to "industrial products," properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.). (See Final Protocol I, *infra*, p. 614). "Industrial property."

ARTICLE II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State. Legal remedies.

Les sujets ou citoyens de chacun des États Contractants jouiront,

dans tous les autres États de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque État.

"Patents." Under the word "patents" are comprised the various kinds of industrial patents, recognised by the legislation of each of the Contracting States, such as importation patents, improvements patents. (See Final Protocol, 2.)

The last paragraph of this Article does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals and the competence of those tribunals. (Final Protocol, 3.)

ARTICLE III.

Rights of subjects of States not within Union established in countries within Union.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

Sont assimilés aux sujets ou citoyens des États Contractants les sujets ou citoyens des États ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des États de l'Union.

By this Article subjects or citizens of non-contracting States who are domiciled or have establishments in contracting States are placed on a better footing than their compatriots at home. It is possible that difficult questions may arise upon the meaning of the words "*domiciled or have industrial or commercial establishments.*"

ARTICLE IV.

Right of priority.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third

parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des États Contractants, jouira, pour effectuer de dépôt dans les autres États, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres États de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

Construction of this article.

When first this Article came into operation, some doubt existed whether the six months were to be computed from the date of deposit of the application for a patent, or from the date on which the patent was actually sealed in Great Britain, or signed in the other contracting States. The Act of 1885, s. 6, substituted "*date of application*" for "*date of the protection obtained.*"

See now Patents Rules, 1890, rr. 24—29; and see Patents Act, 1885, s. 103, sub-s. 1, where seven months is the period within which application must be made.

It appears that *one of the contracting States* means the first state

where application was made, so that six months, or if beyond the sea seven months at most from the time of first making an application in any of the countries which are parties to the convention, is the extent of priority given.

Is Great Britain beyond sea?

It was also a question whether Great Britain was, as regards France, &c., a country beyond sea. The comptroller-general was instructed that it was not; on the other hand, it is held here that France and other continental countries are, as regards Great Britain, countries beyond the sea.

Article V.

Importation and forfeiture.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des États de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

Date of first conference.

The first conference of delegates of the contracting States was held at Rome in April and May, 1886, the second at Madrid in 1890.

On the former of those occasions the following addition to Article V. was recommended:—

"Exploiter."

Each country shall determine the sense in which the word *exploiter* (work) is to be interpreted by the law of that country.

Compulsory working.

The compulsory working of inventions is a source of much useless effort, and gives rise to many technical evasions of the laws. Most foreign countries, however, still exact a "working" of the invention at stated intervals within their own territories.

This is practically the principal advantage accruing to Great Britain under the Convention, as formerly the introduction of a patented article into France forfeited the French patent rights.

Article VI.

Registration of trade marks.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected

in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

ARTICLE VII.

The nature of the goods on which the trade-mark is to be used can, in no case, be an obstacle to the registration of the trade-mark.

Nature of goods to be no obstacle to registration of trade mark.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

Protection of trade names.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

ARTICLE IX.

Seizure of goods bearing illegal trade mark or name.

All goods illegally bearing a trade-mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des États de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque État.

ARTICLE X.

Goods falsely bearing name of a locality.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

ARTICLE XI.

Protection at exhibitions.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial

designs or models, and trade-marks, for articles exhibited at official or officially recognized International Exhibitions.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues.

Temporary protection.—See sect. 39 of Act of 1883, as amended by the Act of 1886, s. 3.

The form of an Order in Council granting temporary protection to inventions at the Paris Universal Exhibition of 1889 is given at page 845.

Article XII.

Each of the High Contracting Parties agree to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks. Government Office.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété Industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

In this country the Patent Office fulfils this obligation.

Article XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property). International Bureau.

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les États Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les États l'Union.

See the Final Protocol, 5 and 6, *infra*, p. 615.

An international office, &c.—This office has been established at Berne. A monthly periodical, entitled *La Propriété Industrielle*, is published under its supervision.

ARTICLE XIV.

Conferences.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by Delegates of the said States. The next meeting shall take place in 1885 at Rome.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des États Contractants, entre les Délégués des dits États.

La prochaine réunion aura lieu en 1885, à Rome.

The first meeting was held at Rome in April and May, 1886.

ARTICLE XV.

Special arrangements between contracting parties.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles,

des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

Special arrangements.—Such arrangements have been made with Paraguay, Mexico, and Uruguay, see p. 411.

Article XVI.

Adherence of other States.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

Les États qui n'ont point pris part à la présente Convention seront *admis à y adhérer sur leur demande.*

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

A list of the States belonging to this International Union, with the several dates of the Orders in Council relating thereto, and the dates at which the Convention commenced its effective operation, will be found at p. 411.

The original parties to the Convention are all bound from the same date, *July 6th, 1884.*

It is obvious that, as regards any two countries subsequently joining the Convention, the date of adhesion of the country which last joined the Convention will regulate the date of commencement of the operation of the Convention between the two countries. The provisions of section 103 of Patents Act, 1883 (p. 516), were made applicable to applications under the International Convention, by Order in Council dated 26th June, 1884.

The Order in Council is printed *infra*, at p. 620, and it is to be observed that her Majesty reserved power to hereafter accede to the

Convention on behalf of the Isle of Man and the Channel Islands. The ordinary British patent covers the Isle of Man but not the Channel Islands, so that at present a patent obtained under the provisions of the International Convention and Patents Act. 1883, s. 103, is not co-extensive with the ordinary British patent, as it does not give any rights over the Isle of Man.

ARTICLE XVII.

Convention subordinate to laws of contracting countries.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

It appears that the International Convention is valid in this country only in so far as its provisions are authorised by the Patents Acts, 1883—88, or any other law, whether statute or common law, affecting the subjects dealt with in the Convention.

ARTICLE XVIII.

Commencement of operation of Convention.

The present Convention shall come into operation one month after the exchange of ratifications,[1] and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de

recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'État qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

1 The ratifications were exchanged on June 6th, 1884, so that the date from which the Convention operates is July 6th, 1884.

Great Britain joined the Convention July 7th, 1884. For dates of other countries joining the Convention, see p. 411.

Article XIX.

The present convention shall be ratified,[1] and the ratifications exchanged in Paris, within one year at the latest. Ratification.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

1 See note to preceding Article.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

En foi de quoi les Plénipotentiaires respectifs l'ont signée et y ont apposé leurs cachets.

Fait à Paris, le 20 Mars, 1883.

(Signed)

(L.S.) Beyens.
(L.S.) Villeneuve.
(L.S.) Duc De Fernan-Nunez.
(L.S.) P. Challemel-Lacour.
(L.S.) Ch. Hérison.
(L.S.) Ch. Jagerschmidt.
(L.S.) Crisanto-Medina.
(L.S.) Ressman.
(L.S.) Baron De Zuylen de Nyevelt.
(L.S.) Jose da Silva Mendes Leal.
(L.S.) F. D'Azevedo.
(L.S.) J.-M. Torres-Caïcedo.
(L.S.) Sima M. Marinovitch.
(L.S.) Lardy.
(L.S.) J. Weibel.

II.

Final Protocol.

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows:—

"Industrial property." 1. The words "Industrial Property" are to be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

"Patents." 2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals, and the competence of those Tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organization of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

Expenses of International Office.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely :—

1st class	25 units.
2nd class.....	20 ,,
3rd class	15 ,,
4th class	10 ,,
5th class	5 ,,
6th class	3 ,,

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense :—

1st class	France, Italy.
2nd class	Spain.
3rd class	Belgium, Brazil, Portugal, Switzerland.
4th class	Holland.
5th class	Servia.
6th class	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language, dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired either by the said Administrations, or by societies or private persons will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The Administration of the country in which the next conference is to be held will make preparation for the transactions of that conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his adminis-

tration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention. Final Protocol to be read with Convention.

In witness whereof the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed) BEYENS.
VILLENEUVE.
Duc DE FERNAN-NUNEZ.
P. CHALLEMEL-LACOUR.
CH. HÉRISSON.
CH. JAGERSCHMIDT.
CRISANTO-MEDINA.
RESSMAN.
Baron DE ZUYLEN DE NYEVELT.
JOSE DA SILVA MENDES LEAL.
F. D'AZEVEDO.
J.-M. TORRES-CAÏCEDO.
SIMA M. MARINOVITCH.
LARDY.
J. WEIBEL.

III.

Accession of Her Majesty's Government to the Convention signed at Paris, March 20, 1883.

Accession of Her Britannic Majesty to the Convention.

The Undersigned, Ambassador Extraordinary and Plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that Her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and formally engages, as far as regards the President of the French Republic and the other High Contracting Parties, to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

Reservation of right to accede on behalf of the Channel Islands and Isle of Man.

The Undersigned makes this Declaration on the part of Her Britannic Majesty with the express understanding that power is reserved to Her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's Government.

In witness whereof the Undersigned, duly authorised, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris on the 17th day of March, 1884.

(L.S.) (Signed) Lyons.

IV.

Declaration of Acceptance of Accession.

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by Her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which declaration is word for word as follows:—

(Here is inserted the text of No. III. in English.)

Accession of Her Britannic Majesty, with its reservations accepted.

The President of the French Republic has authorised the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other High Contracting Parties to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorised, has drawn up the present Declaration of Acceptance and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) Jules Ferry.

ORDER IN COUNCIL applying Section 103 of the Act of 1883 to the Signatories to the International Convention (*a*).

At the Court at Windsor, the 26th day of June, 1884:
Present—The Queen's most Excellent Majesty in Council.

Whereas by the provisions of the Patents, Designs and Trade Marks Act, 1883, it is among other things provided:—

Recital of Act of 1883, s. 103.

That if her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark, in any such State, shall, subject to the conditions further provided and set forth in the said Act, be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under the said Act in priority to other applicants, and such patent or registration shall have the same date as the date of the protection obtained in such foreign State.

Recital of accession of Great Britain to International Convention.

And whereas it has pleased her Majesty to make an arrangement of the nature contemplated by the said Act, by and in virtue of a declaration signed and sealed by her Majesty's Ambassador at Paris on the 17th March, 1884, duly conveying the accession of Great Britain to the International Convention and Protocol for the protection of Industrial Property, signed by the representatives of certain powers on the 20th day of March, 1883, and duly ratified on the 6th day of June, 1884, power being reserved to her Majesty to hereafter accede to the provisions of the said Convention and Protocol on behalf

(*a*) Published in *London Gazette* of July 1, 1884. For the other Orders in Council which have been made, see Table at p. 411.

of the Isle of Man, the Channel Islands, and any of her Majesty's possessions, which declaration or accession was duly accepted by the French Government on behalf of the Signatory Powers, by and in virtue of a declaration dated the 2nd of April, 1884.

Section 103 applied.

Now, therefore, her Majesty, by and with the advice and consent of her Privy Council, and by virtue of the authority committed to her by the said Act, doth declare, and it is hereby declared, that the provisions of the said Act hereinbefore specified shall apply to the following countries, viz. :—

Belgium.
Brazil.
France.
Guatemala.
Italy.
Netherlands.
Portugal.
Salvador.
Servia.
Spain.
Switzerland.
Ecuador, and
Tunis.

Order, when order takes effect.

And it is hereby further ordered and declared that this Order shall take effect from the 7th day of July, 1884.

C. L. PEEL.

APPENDIX OF STATUTES.

18 HEN. 6, c. 1. [A.D. 1439.]

For regulating Grants by the King.

[*This statute is impliedly repealed, so far as patents for inventions are concerned, by Act of* 1883. *See also Act of* 1852, *s.* 23.] 18 Hen. 6, c. 1.

"Whereas by suit made to the King by divers persons, it hath been desired by their petitions to have offices, farms, and other things of the gift and grant of the King by his gracious letters patent thereof to them to be made, desiring by the same petitions the same letters patent of the King, to bear date at a certain day limited in the same, the which day is often long before the King's grant to them made of their said petitions, whereby the King's letters patent to them thereupon made have borne the same date, by reason whereof divers of the King's liege people having such offices, farms, and other things of the gift or grant of the King by his gracious letters patent thereof to them long time before duly made, by such subtle imagination of such ante-dates desired by such petitions of such offices, farms, and other things often have been put out, removed, and expelled, against right, good conscience, and reason." Our said Lord the King, willing to put out such imaginations, by the advice and assent of the Lords spiritual and temporal aforesaid, and at the special request of the said Commons, hath ordained, by authority of the same parliament, that of every warrant hereafter sent by the same our Lord the King, or his heirs, to the Chancellor of England for the time being, the day of the delivery of the same to the Chancellor shall be entered of record in the Chancery. And that the Chancellor do cause letters patent to be made upon the same warrant, bearing date the day of the said delivery in the Chancery, and not before in anywise. And if any letters patent be from henceforth made to the contrary, they shall be void, frustrate, and holden for none (*a*). Date of letters patent.

(*a*) This is the earliest statute bearing any relation directly to letters patent for inventions; there are several earlier statutes relating chiefly to the regulation of trade, and the grants of lands and offices. See 9 H. 3; 9, 14, 25, 27 Ed. 3; 2, 5, 11 R. 2; 1, 2, 4, 6 H. 4; Webs. Letts. Pat. p. 33, n. (*a*).

6 HEN. 8, c. 15. [A.D. 1514-1515.]

6 Hen. 8, c. 15.

An Act avoiding Second Letters Patent granted by the King.

[*This statute is superseded, so far as letters patent for inventions are concerned, by Statute of Monopolies, s.* 6.]

"The King's highness, of his goodness, calling to his remembrance, that where his grace hath granted to divers of his servants (for their service to his grace done), lands, tenements, fees, offices, and other things, to have to them during his pleasure; and after other persons, by their sundry suits, have obtained of his highness other letters patent of the same, not advertising his grace of his former grants, whereby the said former patentees have been avoided, and put from the advantage of their said former grants and patents, contrary to the intent and grant of our said sovereign lord."

What shall be expressed in the King's letters patent, in the case of duplicate grants of the same boon.

Wherefore be it ordained, established, and enacted by our said Sovereign Lord, the Lords spiritual and temporal, and the Commons in this present parliament assembled, and by authority of the same, that if any person or persons from henceforth do make suit to the King's highness for any lands, tenements, offices, or any other things so by his grace granted, or hereafter to be granted to any person or persons during his pleasure, the said first patentee then being in life; that he do express in his said bill of petition or patent, the tenor of the said former patent, and that the King then hath determined his pleasure against the first said patentee; or else the second letters patent of any of the premises to any person hereafter to be granted, to be void and of none effect (*b*).

2. This Act to commence and take effect from the fourth day of April next coming, and not before.

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27 HEN. 8, c. 11. [A.D. 1535-1536.]

27 Hen. 8, c. 11.

An Act concerning Clerks of the Signet and Privy Seal (*c*).

[*Repealed by* 47 & 48 *Vict. c.* 30, *s.* 5.]

"Whereas the King's clerks of his grace's signet and privy seal, giving their daily attendance for the passing and writing of his Majesty's great and weighty affairs, and the causes of this his realm, having for their entertainment and their clerks no fees nor wages certain for those offices, other than such fees as cometh and groweth of the said signet and privy seal; to the in-

(*b*) Letters patent for inventions are not during the King's pleasure, but only for fourteen years; and a grant of second letters patent for the same subject-matter would be void under 21 Jac. 1, c. 3, and at common law, as well as by this statute: Webs. *ubi sup.* 34, n. (*b*).

(*c*) These offices were regulated by 57 G. 3, c. 63, and abolished under 2 W. 4, c. 49; Webs. *ubi sup.* n. (*c*).

This statute regulates the course of proceedings for passing letters patent. According to the preamble of the statute, it would appear to have been passed for the purpose of insuring fees to certain clerks; but Sir E. Coke speaks of it in the following terms:—"Such was the wisdom of prudent antiquity, that whatsoever should pass the Great Seal should come through so many hands, to the end that nothing should pass the Great Seal, that is so highly esteemed and accounted of in law, that was against law or inconvenient; or that any thing should pass from the King any ways which he intended not, by undue and surreptitious means" 2 Inst. 556. Its object has also been stated to ensure that the grants should be carefully inspected by the officers of the crown; but this is obviously futile as regards letters patent for inventions, the grant being at the peril of the grantee; and now, since the practice has been introduced of enrolling a specification, the patentee is judged on his own deed.

tent that from henceforth they should not by any manner of means be defeated of any part or portion of the same their fees:" be it therefore ordained, established, and enacted, by the consent and assent of the Lords spiritual and temporal, and the Commons, in this present Parliament assembled, and by authority of the same, that all and every gift, grant, and other writing, which shall be made or given in writing by the King's highness, or any of his most noble posterity, to any person or persons, signed with his grace's sign, or the sign or signs manual of any of them, to be passed under any his grace's great seals of England, Ireland, Duchy of Lancaster, or any of his highness's counties palatines, or principality of Wales, or by other process out of the Exchequer, after the fifteenth day of April, in the twenty-seventh year of his most noble reign, and that all and every gifts, grants, and other writings, of what name or names, quality or qualities soever the same be, or hereafter shall be named, deemed, or called, which the master of the King's wards, or general surveyors of the King's lands, for the time being, or any other officer or officers that now be, or hereafter shall be made, shall, by virtue of an Act of Parliament, or any the King's grants to them or any of them made, or hereafter to be made in that behalf, give, grant, or make, after the aforesaid fifteenth day of April, to any person or persons in the King's name, to be passed under any of his Majesty's seals, be in anywise first, and before the same grant, or any of them, be passed under any the King's said seals, or other process made of the same, brought and delivered to the King's principal secretary, or to one of the King's clerks of his grace's signet for the time being, to be at the said office of the signet passed accordingly (*d*).

The King's grants shall be brought to the secretary or to a clerk of the signet.

2. And be it also ordained and enacted by the authority aforesaid, that one of the clerks of the signet, to whom any of the said writings, signed with the King's most gracious hand, or the hand of any other aforesaid, or any of them fortune to be delivered, may and shall by warrant of the same bills, and every of them, within the space of eight days next after he shall have received the same, unless he have knowledge by the said secretary, or otherwise, of the King's pleasure to the contrary, make or cause to be made in the King's name, letters of warrant, subscribed with the hand of the same clerk, and sealed with the King's signet, to the lord keeper of the King's privy seal, for the further process to be had in that behalf; and that one of the King's clerks of the said privy seal, upon due examination had by the said lord keeper of the said privy seal, of the said warrant to him addressed from the office of the said signet as afore, may and shall within the space of eight days next after he shall have received the same, unless the lord keeper of the privy seal do give them commandment to the contrary, make or cause to be made, by warrant of the aforesaid warrant to the said lord keeper of the privy seal, address from the office of the signet aforesaid, other letters of like warranty, subscribed with the name of the same clerk of the privy seal, to the lord chancellor of England, lord keeper of the great seal, chancellor of the duchy of Lancaster, chancellor of the King's land of Ireland, treasurer and chamberlains of the exchequer, and chamberlains of any of his counties palatines, or principality of Wales, or other officer, and to every of them, for the writing and ensealing with such seals, as remain in their custody, of letters patent or closed, or other process making, due and requisite to be had or made upon any the said grants, according to the tenor of the warrant to them or any of them directed from the officer of the privy seal, as is afore specified (*e*).

A warrant by the clerk of the signet to the lord keeper of the privy seal.

A warrant from the privy seal to the great seal.

(*d*) This section provides, that every grant in writing, after signature by the King, and before any seal has been affixed, which in the case of letters patent would be, the bill should be brought to be passed at the Signet Office. The Queen's Bill on being passed at the Signet Office, is termed the Signet Bill. Webs. *ubi sup.* 35, n. (*d*).

(*e*) By the first clause of this section, the clerk is directed to prepare letters of warrant under his hand and the Signet Seal, to the keeper of the Privy Seal; and by the second clause, the clerk of

The penalty for altering of the course aforesaid.

3. And also be it enacted, by the authority aforesaid, that no manner of clerk or clerks, or other person or persons, do write or make any manner of writing, warrant or warrants, upon any manner of gift or grant, made by the King's highness, or by any other his grace's officers as aforesaid, or procure the same or any of the same to be passed under the seals aforesaid, after any other sort, manner or fashion, or by any other warrant or warrants, than as before specified and delivered, upon pain to forfeit for every bill, warrant or writing, passed contrary to the order before limited and prescribed, the sum of 10*l.*; the one-half thereof to be to our Sovereign Lord the King, and the other half to him that shall first sue for the same by action of debt, writ, bill, plaint, or information in any of the King's Courts; in which action or suit, no essoin, protection, privilege, nor wager of law, shall be admitted; any manner, act, statute, provision, proclamation, or other ordinance heretofore had or made, contrary to this present Act, or any article of the same, in anywise notwithstanding.

Fees for writings which pass by immediate warrant.

4. And nevertheless be it also enacted, that every of the said clerks, or other person, which shall pass in writing, or procure to be passed in writing, any grant or grants by immediate warrant, wherefore fees be paid at the great seal, shall of the parties receive for the offices of the said signet and privy seal, as well as such fees as in this Act is taxed for writing of any such grant or other writings, as also the fees for the seal of the same; which fees, and every part and portion thereof, the same clerk or clerks, by whom any grant shall pass in writing by immediate warrant, shall upon a bill of the hand of one of the said clerks of the said signet or privy seal, deliver unto one of the same clerks of the signet or privy seal, within the space of three months next and immediately ensuing after the passing and sealing of any of the said grant or grants by immediate warrant, upon pain of 10*l.* to be by every such of the said clerks or other person as shall offend, forfeited, to be levied in form aforesaid, as often as he or they shall offend contrary to the meaning of this Act.

This Act shall not prejudice the lord treasurer for directing the warrants to the great seal.

5. Provided also, that this Act, or any thing contained in the same, be not in anywise prejudicial to the lord treasurer of England for the time being, concerning such warrants or precepts as he by virtue of his office shall and may direct immediately to the Lord Chancellor of England, or to any other person or persons for making out of the King's grants or letters patent, to any person or persons, of any offices, farms, or lands, or tenements, or of any other thing belonging to his nomination or disposition; but that as well he may direct his said warrants or precepts for the causes abovesaid, as also his clerk, or clerks, or other person, may procure the same to be sealed under any of the seals aforesaid, without any warrant to be before or after sued or obtained under the King's signet or privy seal for the same, in as large and ample a manner, and after such sort or fashion as he or they might have done at any time before the making of this Act; any thing in the same Act mentioned to the contrary notwithstanding.

6. [This clause refers to leases of the duchy lands of Lancaster, which may pass under the seal of the same duchy, see 4 Inst. 210.]

7. [This relates to the grant of a small office in the duchy.]

8. [This section treats of certain trifling fees to the clerk of the signet for writing warrants for tales or reward, gift of offices, pensions, &c.]

The Lord Chancellor may pass instruments without fees.

9. Provided also, that the Lord Chancellor of England for the time being, shall and may at all times use his discretion in passing and speeding any thing by the great seal, and delivering the same without paying any fees for the great seal, signet, and privy seal, as the case of necessity shall

the Privy Seal is directed to prepare other letters of warrant to the Lord Chancellor. The law takes notice of three seals; the Great Seal, the Privy, and the Signet. 2 Inst. 554.

The Great Seal is in the custody of the Chancellor; the Privy Seal in the custody of the clerk or Lord Keeper of the Privy Seal, and the Signet Seal in the custody of the principal secretary of the Signet. Webs. *ubi sup.* 36, n. (*e*).

require, and as hath been accustomed; and that the clerks for writing or procuring such writings and patents by his commandment shall be discharged of all penalties expressed before in this Act, for not receiving and paying fees to the signet and privy seal; any thing in this Act contained to the contrary hereof notwithstanding.

10, 11, 12. [The first of these clauses refers to the officers and clerks of the Court of augmentations. The second to the sealing of instruments in the King's private affairs, &c. The last respects grants or leases of farms under the yearly rent of 6*l.* 13*s.* 4*d.*

3 & 4 EDW. 6, C. 4. [A.D. 1549.]

An Act concerning Grants and Gifts made by Patentees out of Letters Patent (f). 3 & 4 Edw. 6, c. 4, explained by

13 ELIZ. C. 6 (g). [A.D. 1570.]

An Act that the exemplification or constat of Letters Patent shall be as good and available as the Letters Patent themselves (h). 13 Eliz. c. 6.

A supply of the statute of 3 & 4 Ed. 6, c. 4.

"For the avoiding of all such doubts, questions, and ambiguities, as heretofore have risen and been moved, and of such as hereafter might rise and be moved, in and upon the statute made in the parliament begun and holden at Westminster, the fourth day of November, in the third year of the reign of our late sovereign lord King Edward the Sixth, intituled, "An Act concerning grants and gifts made by patentees out of letters patent, and for a due and full supply of all such wants as may be thought to be therein."

An exemplification of letters patent shall be of the same force as the letters patent themselves.

2. Be it enacted and declared, by the authority of this present parliament, that all and every patentee or patentees, their heirs, successors, executors, and assigns, and all and every other person and persons having by or from them, or any of them, or under their title, any estate or interest of, in, or to any lands, tenements, or hereditaments, or any other thing whatsoever, to such patentee or patentees, heretofore granted by any letters patents, either of the most famous princes, King Henry the Eighth, King Edward the Sixth, Queen Mary, King Philip and Queen Mary, or by any of them, or by the Queen's most excellent Majesty that now is, at any time sithence the fourth day of February, in the twenty-seventy year of the reign of the said late King Henry the Eighth, or else by the Queen's Majesty that now is, her heirs or successors, at any time hereafter to be granted, shall and may, at all times hereafter, in any of the Queen's highness's Courts, her heirs and successors, or elsewhere, by the authority of this present Act, make and

(*f*) Some doubt being entertained whether this statute applied to patentees themselves, as well as to those claiming under them, it was explained and amended by 13 Eliz. c. 6. Webs. *ubi sup.* 38, n. (*f*).

(*g*) This is now obsolete so far as patents for inventions are concerned. Special provisions for duplicate copies of patents for inventions are contained in Act of 1883.

(*h*) These words, exemplification and constat, are used indifferently in the statute; and they differ only in the formal parts of their commencements and conclusions. An exemplification is the same with the *inspeximus*, so called because immediately after the King's style that word follows. It is called exemplification *a re ipsâ*, because the record is thereby exemplified, as appears by the end of it, *duximus exemplificand per præsentes*. The *constat* is so called, because of that word immediately after the King's style. Nothing is exemplified by either of them but the tenor of the record. Also a constat requires an affidavit, but an exemplification none. 5 Co. Rep. 54.

convey, or be allowed and suffered to make and convey, to and for him, them, and every of themselves, such claim or title, by way of declaration, plaint, avowry, bar, replication, or other pleading whatsoever, as well against the Queen's highness, her heirs and successors, and every of them, as against all and every other person and persons whatsoever, for or concerning the lands, tenements, hereditaments, or other things whatsoever, specified or contained in any such letters patent, or of, for, or concerning any part or parcel thereof, by showing forth an exemplification or constat, under the great seal of England, of the enrolment of the same letters patent, or of so much thereof as shall and may serve to or for such title, claim or matter, the same letters patent then being and remaining in force, not lawfully surrendered nor cancelled, for or concerning so much and such part and parcel of such lands, tenements, hereditaments, or other thing, whereunto such title or claim shall be made, as if the same letters patent self were pleaded and showed forth; any law, usage, or other thing to the contrary notwithstanding (*i*).

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31 Eliz. c. 5, s. 5. [A.D. 1589.]

31 Eliz. c. 5, s. 5. Limiting time within which penal actions may be commenced (*j*).

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21 Jac. 1, c. 3. [A.D. 1623 (*k*).]

21 Jac. 1, c. 3. *An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.*

All monopolies, &c., shall be void. "Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God one thousand six hundred and ten, publish (*l*) in print to the whole realm, and to

(*i*) At common law no grant of the King is available or pleadable, unless under the Great Seal. 2 Co. Rep. 166.

Hence the letters patent themselves, with the Great Seal, must have been produced. But by 3 & 4 Ed. VI. c. 4, explained by this statute, patentees and persons claiming under them, may make title in pleading, by showing forth an exemplification of the enrolment of the letters patent, as if the letters patent themselves were pleaded and shown forth. And now they are to be given in evidence in the same manner as if they were pleaded. *Olive* v. *Guyn*, Hardr. 119.

By these statutes, an exemplification of the part only which is material, is necessary. But such an extract as would be a surprise upon the party, or deprive him of any benefit he might derive if the whole were produced, is not sufficient. *Att.-Gen.* v. *Taylor*, Prec. in Chan. 59. Webst. Letters Patent, 40, n. (*h*).

(*j*) Repealed in part by 11 & 12 Vict. c. 43, s. 36, and 42 & 43 Vict. c. 59.

(*k*) The Statute of Monopolies was passed on 25th May, 22 Jac. I. 1624. Previous to 33 Geo. III. c. 13, every Act of Parliament was considered as passed upon, and related back to, the first day of the session, unless the terms of the Act provided to the contrary (4 Inst. 25). This must be borne in mind, otherwise *Mansell's Patent*, excepted by sect. 13, *infra*, will appear to bear date subsequent to the date of the Act (1 Web. P. C. 29, n. (*g*)). See *ante*, Chap. III., p. 9.

(*l*) This publication was entitled "A Declaration of His Majesty's Pleasure," &c. It was published, A.D. 1610, out of the King's zeal to law and justice, and

all posterity, that all grants of monopolies (*m*), and of the benefit of any penal laws (*n*), or of power to dispense with the law (*o*), or to compound for the forfeiture (*p*), are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this realm (*q*): And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid." For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the Commons, in this present parliament assembled, that it may be declared (*q*) and enacted, and be it declared and enacted, by authority of this present parliament, that all monopolies and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole (*r*) buying, selling, making, working, or using of any thing

states that monopolies are things against the laws of this realm, and therefore expressly commands that no suitor move the King to grant any of them (Co. 11 R. 88 b). The judgment in *Darcy* v. *Allin*, the case of monopolies (1 Web. P. C. 1), was the principal motive for publishing this book, and that book was a great motive of obtaining the royal assent to the statute. 3 Inst. 182.

(*m*) A monopoly is an institution or allowance by the King, by his grant, commission, or otherwise, to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of anything whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade (Co. 3 Inst. 181, c. 85; and 1 Web. P. C. 5). It is material to attend to the latter part of the definition, since upon it rest the following incidents of a monopoly: 1. That it raises the price of a commodity. 2. That it diminishes its quality. 3. That it impoverishes artificers. 11 R. 26, 86 b.; and Webs. L. P. 40, n. (*n*).

(*n*) It had been the practice to grant to particular persons all the penalties which the Crown should become entitled to under penal statutes. Webs. L. P. 41, n. (*o*).

(*o*) As to the dispensing power, see 7 Rep. 36 b. By the Bill of Rights it was declared "that from and after this present Parliament, no dispensation by *non obstante* of or to any statute or any part thereof be allowed, but that the same shall be held void and of none effect, except a dispensation be allowed in such a statute."

(*p*) The compounding for forfeitures was a relic of the same practice as the exercise of the dispensing power, and was abolished with it. Webs. L. P. 41, n. (*e*).

(*q*) The Statute of Monopolies was simply declaratory of the common law.

(*r*) The word *sole* is here applied to five several things, whereof four are special, and the fifth, *sole using*, is so general that no monopoly can be raised but will be within the reach of this statute; and yet for more caution the words "or of any other monopolies" are added; and by reason of these words,

within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures limited by any statute (*s*); or of any grant or promise (*t*) of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in ure or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licenses, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them and of every of them, ought to be and shall be for ever hereafter examined, heard, tried and determined, by and according to the common laws of this realm, and not otherwise (*u*).

All persons disabled to use monopolies, &c.

3. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which

sole using, divers provisions are made by this Act. The words, also, "of any thing," are of so large an extent as to cause some exceptions in the subsequent clauses. 3 Inst. 187.

(*s*) The great inconvenience of the practice here abrogated appeared in the proceedings of *Empson* and *Dudley* in the reign of Henry VII., who had the office of Masters of the Forfeiture, and by colour of their commission and office did most intolerably and unlawfully oppress the subjects. 3 Inst. 187.

(*t*) Not only is the grant declared void as contrary to the common law of the realm, but the promise also; for such promise maketh the more violent and undue proceedings against the subject, to the scandal of justice and offence of many. 7 Rep. 36 b.

(*u*) This Act having in the preceding section declared all monopolies, &c. to be void by the common law, has provided by this that they shall be examined, heard, tried and determined in the Courts of Common Law, according to the common law, and not at the Council Table, Star Chamber, Chancery, Exchequer Chamber, or any other Court of like nature, but only according to the common laws of the realm, and not otherwise. For such boldness the monopolists took, that often at the Council Table, Star Chamber, Chancery and Exchequer Chambers, petitions, informations and bills were preferred, pretending a contempt for not obeying the commandments and clauses of the said grant of monopolies, and of the proclamations concerning the same. (3 Inst. 182, 183.) The Court of Star Chamber punished all infringements of patents and royal grants, and on that principle supported any patent the Crown thought fit to grant. Webs. L. P. 42, n. (*y*).

now are or hereafter shall be, shall stand and be disabled and uncapable to have (*x*), use, exercise, or put in use any monopoly, or any such commission, grant, license, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power or faculty, grounded or pretended to be grounded upon them or any of them.

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

4. And be it further enacted by the authority aforesaid, that if any person or persons, at any time after the end of forty days next after the end of this present session of parliament, shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained, by occasion or pretext of any monopoly, or of any such commission, grant, license, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises; that then, and in every such case, the same person or persons shall and may have his and their remedy for the same at the common law, by any action or actions, to be grounded upon this statute; the same action or actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them, by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, or distrained, taken, carried away, or detained; wherein all and every such person and persons, which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aid-prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded

He that delayeth an action grounded upon this

(*x*) *I. e.*, take. 3 Inst. 183.

statute incurs a præmunire.

upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power or authority, save only of the Court wherein such actions as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any such order, warrant, power, or authority, save only by writ of error or attaint; that then the said person and persons so offending, shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and præmunire made in the sixteenth year of the reign of King Richard the Second (*y*).

Letters patent heretofore granted for twenty-one years for new manufactures, saved.

[*Repealed by Stat. Law Rev. Act*, 1863.]

5. Provided nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patent and grants did not use, so they be not contrary to the law nor mischievous to the state, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be if this Act had not been made, and of none other: and if the same were made for more than one-and-twenty years, that then the same, for the term of one-and-twenty years only, to be accounted from the date of the first letters patent and grants thereof made, shall be of such force as they were or should have been if the same had been made but for the term of one-and-twenty years only, and as if this Act had never been had or made, and of none other (*z*).

Letters patent hereafter to be granted for fourteen years, for new manufactures, saved.

6. Provided also, and be it declared and enacted, that any declaration before-mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grant shall not use, so as also they be not contrary to the law nor mischievous to the state

(*y*) The remedy under this section, by action on the statute, to parties grieved by pretext of monopoly, is practically superseded. Many of the terms and proceedings, as aid-prayer, order of restraint, wager of law, are either unknown in modern practice, or abolished by statute. Webs. L. P. 44, n. (*a*).

The imparlance, which meant extension of time to plead till next term, was abolished by 2 Will. IV. c. 39, s. 1.

The concluding clause of this section extends to the judges of the Courts, and is more general than the one immediately preceding, which extended to the Courts generally, but, as was resolved by a Committee of the House of Commons, did not extend to the judge. 3 Inst. 183.

(*z*) Letters patent for inventions depend on the exceptions in this and the following section. The words of the two sections are the same, except that one relates to grants in existence at the time of passing the statute, the other to grants to be made afterwards.

See an instructive commentary on these sections, by Sir E. Coke, 3 Inst. 181.

See also *supra*, at pp. 9—14.

by raising prices of commodities at home, or hurt of trade, or generally inconvenient: The said fourteen years to be accomplished from the date of the first letters patent or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other (*a*).

This Act not to extend to grants sanctioned by Parliament.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial to any grant, or privilege, power, or authority whatsoever, heretofore made, granted, allowed and confirmed by any Act of Parliament now in force, so long as the same shall continue in force.

Warrants granted to justices, saved.

8. Provided also, that this Act shall not extend to any warrant or privy seal, made or directed or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas, and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol-delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters granted to corporations, saved.

9. Provided also, and it is hereby further intended, declared, and enacted, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent, to them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandise; but that the same charters, customs, corporations, companies, fellowships and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; any thing before in this Act contained to the contrary in any wise notwithstanding.

Letters patent that concern printing, saltpetre, gun-

10. Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before-mentioned, shall not extend to any letters patent of grants of privilege hereto-

(*a*) This proviso is very fully dealt with in Chapter IV., on the Subject-Matter of Patents, p. 15.

powder, great ordnance, shot, or offices, saved.

[*Repealed by Act of* 1883, *s.* 113.]

fore made, or hereafter to be made, of, for, or concerning the digging, making, or compounding of saltpetre, or gunpowder, or the casting or making of ordnance, or shot for ordnance, nor to any grant or letters patent heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained now in being, and put in execution, other than such offices as have been decried by any his Majesty's proclamation or proclamations: but that all and every the same grants, commissions, and letters patent, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had nor made, and not otherwise (*a*).

This Act shall not extend to commissions for alum-mines.

[*Repealed by Act of* 1883, *s.* 113.]

11. Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before-mentioned, shall not extend to any commission, grant, letters patents, or privilege heretofore made, or hereafter to be made, of, for, or concerning the digging, compounding, or making of alum, or alum-mines: but that all and every the same commissions, grants, letters patents, and privileges, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if the Act had never been had nor made, and not otherwise (*a*).

Nor to the liberties of Newcastle-upon-Tyne, nor to licenses of keeping taverns.

[*Repealed by Act of* 1883, *s.* 113.]

12. Provided also, and be it enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to any use, custom, prescription, franchise, freedom, jurisdiction, immunity, liberty, or privilege, heretofore claimed, used, or enjoyed by the governors and stewards and brethren of the fellowship of the hoast-men of the town of Newcastle-upon Tyne, or by the ancient fellowship, gild, or fraternity, commonly called hoast-men, for or concerning the selling, carrying, lading, disposing, shipping, venting, or trading of or for any sea coals, stone coals, or pit coals, forth or out of the haven or river of Tyne, or to any grant made by the said governor and stewards and brethren of the fellowship of the said hoast-men to the late Queen Elizabeth, of any duty or sum of money to be paid for, or in respect of, any such coals as aforesaid; nor to any grants, letters patent, or commission, heretofore granted, or hereafter to be granted, of, for, or concerning the licensing of the keeping of any tavern or taverns; or selling, uttering, or retailing of wines to be drunk or spent in the mansion-house, or houses, or other place in the tenure or occupation of the party or parties so selling or uttering the same; or for or concerning the making of any compositions for such licences, so as the benefit of such compositions be reserved and applied to and for the use of his Majesty, his heirs or successors, and not to the private use of any person or persons (*a*).

Nor to letters patent for glass making.

13. Provided also, and be it enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to a grant or privilege, for or concerning the making of glass, by

(*a*) These sections excepted from the prohibition contained in sect. 1 of the Statute of Monopolies:—(a) letters patent concerning printing; digging for and making saltpetre or gunpowder; or casting or making of ordnance, or shot for ordnance; or grants of offices (sect. 10); (b) letters patent for digging and making alum, and for alum mines (sect. 11); (c) all privileges enjoyed by the hoast-men of the town of Newcastle-upon-Tyne for selling, carrying, and shipping any pit coals out of the river Tyne, also concerning the licensing of any taverns (sect. 12). The last two sections of the statute contained similar exceptions for letters patent for glass making, to Sir Robert Mansell, Vice-Admiral of England, for the exportation of calves' skins to James Maxewell (sect 13), for Baker's smalt patent, and Lord Dudley's patent for the making of iron ore (sect. 14). These clauses were rendered necessary by the generality of the words "of any thing" in sect. 1 of the Statute of Monopolies.

Sect. 10 was annulled, so far as exclusive privileges in the gunpowder and saltpetre trades were concerned, by an Act passed in 1640—16 Chas. I. c. 21.

his Majesty's letters patent under the Great Seal of England, bearing date the two-and-twentieth day of May, in the one-and-twentieth year of his Majesty's reign of England, made and granted to Sir Robert Mansell, Knight (*b*), Vice-Admiral of England: nor to a grant or letters patent, bearing date the twelfth of June, in the thirteenth year of his Majesty's reign of England, made to James Maxewell, Esquire, concerning the transportation of calves' skins: but that the said several letters patent, last-mentioned, shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before-mentioned, as if this Act had never been had nor made, and not otherwise.

[*Repealed by Stat. Law Rev. Act*, 1863.]

Or exportation of calves' skins.

14. Provided also, and be it declared and enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before-mentioned, shall not extend or be prejudicial to a grant or privilege for or concerning the making of smalt, by his Majesty's letters patent, under the Great Seal of England, bearing date the sixteenth day of February, in the sixteenth year of his Majesty's reign of England, made or granted to Abraham Baker (*c*); nor to a grant or privilege for or concerning the melting of iron ewer, and of making the same into cast-works or bars with sea coals or pit coals, by his Majesty's letters patent, under the Great Seal of England, bearing date the twentieth day of February, in the nineteenth year of his Majesty's reign of England, made or granted to Edward Lord Dudley (*d*); but that the same several letters patent and grants shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before-mentioned, as if this Act had never been had nor made, and not otherwise (*e*).

Nor to grants for making smalt.

[*Repealed by Stat. Law Rev. Act*, 1863.]

Or melting iron ore.

(*b*) These letters patent were not within the 5th section. The grantee, Mansell, was not the true and first inventor of the manufacture which was the subject of the grant—viz., the making of glass with coal instead of wood, the letters patent themselves showing (1 Web. P. C. 18), that Percival was the true and first inventor; also that the manufacture was not new at the time of the grant, others having practised the invention before. But for this exception the term of the letters patent would have been reduced to twenty-one years, which, as Mansell had interest at Court, would have endangered the passing of the bill. 1 Web. P. C. 32, n. (*q*).

(*c*) See the smalt patents set forth at length, 1 Web. P. C. 9—13. Baker's patent was not within sect. 5. The first smalt patent (*ubi sup.* p. 9), shows that other persons were associated with Baker in the introduction of the invention: nor was the manufacture new within the realm at the time of the grant of the excepted patent. On these grounds, therefore, the letters patent would have been void unless specially excepted. 1 Web. P. C. 32, n. (*r*).

(*d*) These letters patent (see 1 Web. P. C. 14—16, where a sketch is given of the history of the subject-matter of this grant: viz., the manufacture of iron with pit coal), for all that appears on the face of them, are within section 5, and would consequently have been preserved to the grantee without this special exception. But independently of the importance to the patentee of such an exception, as a sort of judgment of parliament in favour of a grant, at a time when, from the abuse of the royal prerogative, all patents were looked upon with the greatest suspicion and as grievances, it is very doubtful whether this patent would have been saved under that section, since it appears that Lord Dudley, the son of the grantee, was the true and first inventor. 1 Web. P. C. 33, n. (*r*).

(*e*) The conclusion of this and the preceding section, when taken in connection with the preamble of the Act, suggests the two following considerations: first, that there were certain grants which, though partaking in some measure of the character of monopolies, were not really grants of monopolies within the meaning of the use of that term in the preamble; and, secondly, that the conditions of validity under the statute and at common law are different. At common law the introducer, as well as the inventor, could be the grantee, and the term was frequently more than fourteen years; whereas by the statute the true and first inventor alone can be the grantee (1 Web. P. C. 33, n. (*s*).) The importer of an invention *from abroad* is, however, its true and first inventor. See *supra*, p. 69.

5 & 6 Will. 4, c. 62.

An Act, &c. for the Abolition of unnecessary Oaths.

[9th September, 1835.]

Declaration substituted for oaths and affidavits heretofore required on taking out a patent. [*Repealed by Act of* 1883, *s.* 113.]

11. And be it enacted, That whenever any person or persons shall seek to obtain any patent under the Great Seal for any discovery or invention, such person or persons shall, in lieu of any oath, affirmation or affidavit which heretofore has or might be required to be taken or made upon or before obtaining any such patent, make and subscribe in the presence of the person before whom he might, but for the passing of this Act, be required to take or make such oath, affirmation, or affidavit, a declaration to the same effect as such oath, affirmation, or affidavit, and such declaration, when duly made and subscribed, shall be to all intents and purposes as valid and effectual as the oath, affirmation, or affidavit, in lieu whereof it shall have been so made and subscribed (*f*).

Declaration to be in the form prescribed in the schedule.

20. And be it further enacted, That in all cases where a declaration in lieu of an oath shall have been substituted by this Act, or by virtue of any power or authority hereby given, or where a declaration is directed or authorized to be made and subscribed under the authority of this Act, or of any power hereby given, although the same be not substituted in lieu of an oath heretofore legally taken, such declaration, unless otherwise directed under the powers hereby given, shall be in the form prescribed in the schedule hereunto annexed.

Person making a false declaration guilty of a misdemeanour.

21. And be it further enacted, That in any case where a declaration is substituted for an oath under the authority of this Act, or by virtue of any power or authority hereby given, or is directed and authorized to be made and subscribed under the authority of this Act, or by virtue of any power hereby given, any person who shall wilfully and corruptly make and subscribe any such declaration, knowing the same to be untrue in any material particular, shall be deemed guilty of a misdemeanour.

Commencement of Act.

22. And be it enacted, That this Act shall commence and take effect from and after the first day of October in this present year, the year of our Lord one thousand eight hundred and thirty-five.

Schedule referred to by the foregoing Act.

Form of declaration.

"I, *A. B.*, do solemnly and sincerely declare that and I make this solemn declaration, conscientiously believing the same to be true, and by virtue of the provisions of an Act made and

(*f*) This section substituted a declaration for the oath, affirmation, or affidavit which had previously been required from the applicant for letters patent. The only other section in this statute having any reference to letters patent for inventions was the 21st, which made a false declaration a misdemeanour.

passed in the year of the reign of his present Majesty, intituled 'An Act,'" (*here insert the title of this Act*).

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

An Act to amend the Law touching Letters Patent for Inventions (*h*). 5 & 6 Will. 4, c. 83.
[10th September, 1835.]

[*Repealed by Act of* 1883, *s.* 113.]

Whereas, it is expedient to make certain additions to, and alterations in, the present law touching letters patent for inventions, as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same; 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, that any person who, as grantee, assignee, or otherwise, hath obtained, or who shall hereafter obtain, letters patent, for the sole making, exercising, vending, or using of any invention, may, if he think fit, enter with the clerk of the patents of England, Scotland, or Ireland, respectively, as the case may be, having first obtained the leave of his Majesty's Attorney-General or Solicitor-General, in case of an English patent, of the Lord Advocate or Solicitor-General of Scotland in the case of a Scotch patent, or of his Majesty's Attorney-General or Solicitor-General for Ireland in the case of an Irish patent, certified by his fiat and signature, a disclaimer of any part of either the title of the invention, or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration, being filed by the said clerk of the patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent, or such specification, in all Courts whatever: Provided always, that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat, being so entered, shall give the party entering the same a right

Any person having obtained letters patent for any invention, may enter a disclaimer of any part of his specification, or a memorandum of any alteration therein, which, when filed, to be deemed part of such specification.

Caveat may be entered as heretofore.

(*g*) The Statute of Monopolies, says Webster (Letters Patent, p. 11), which enacted no new law, but was only, both in form and substance, declaratory of the existing law, and the rigorous spirit in which patent rights were legislated on by the Courts, protected the public from unjust monopolies at the expense of the patentee. The letters patent and specification were unalterable, clerical errors only excepted, and any defect or flaw which either of these instruments contained was irremediable, and interpreted most rigorously against the patentee. The common law declared letters patent wholly void for any defect in part, and the patentee was deprived of the whole of his invention from the failure of some condition, as want of novelty in a very small part.

This Act was passed to amend this state of the law, and it provided that a patentee might, with the consent of the proper law officers of the Crown, amend his title and specification; it enabled him to obtain confirmation of a patent which would otherwise have been void for want of novelty, and to have his patent extended in certain cases on the recommendation of the Privy Council. Patent rights were also more effectually secured by giving a patentee treble costs on obtaining a second verdict, by compelling a defendant in an action to deliver notice of objections, and by a penalty for the unauthorized use of his name.

(*h*) Rules were made by the Judicial Committee for proceedings for confirmation and prolongation, which are still in force, see p. 594.

Disclaimer not to affect actions pending at the time.

to have notice of the application being heard by the Attorney-General, or Solicitor-General, or Lord Advocate respectively: Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by scire facias), pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of the invention, for which the letters patent have been, or shall have been granted: Provided also, that it shall be lawful for the Attorney-General, or Solicitor-General, or Lord Advocate, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney-General, or Solicitor-General, or Lord Advocate, shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

Attorney-General may require the party to advertise his disclaimer.

Mode of proceeding where patentee is proved not to be the real inventor, though he believed himself to be so.

2. And be it enacted, that if in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention, or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee, or his assigns, to petition his Majesty in council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the judicial committee of the privy council; and such committee, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided, that any person opposing such petition shall be entitled to be heard before the said judicial committee: Provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same.

If in any action or suit a verdict or decree shall pass for the patentee, the judge may grant a certificate, which being given in evidence in any other suit, shall entitle the patentee, upon a verdict in his favour, to receive treble costs.

3. And be it enacted, that if any action at law or any suit in equity for an account shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge before whom such action shall be tried to certify on the record, or the judge who shall make such decree or order, to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made, in favour of such patentee or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs.

Mode of proceeding in case of application for the

4. And be it further enacted, that if any person who now hath or shall hereafter obtain any letters patent as aforesaid shall advertise in the London Gazette three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or pub-

lished in the county where he carries on such manufacture, or where he lives in case there shall not be any paper published in such town, that he intends to apply to his Majesty in council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in council to that effect, it shall be lawful for any person to enter a caveat at the council office; and if his Majesty shall refer the consideration of such petition to the judicial committee of the privy council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the judicial committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding *seven years* (*i*), and his Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: *Provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent* (*k*).

prolongation of the term of a patent.

Repealed by 2 & 3 Vict. c. 67.

5. And be it enacted, that in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff, and in any *scire facias* to repeal such letters patent, the plaintiff shall file with his declaration a notice of any objections on which he means to rely at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial unless he prove the objections stated in such notice: Provided always, that it shall and may be lawful for any judge at chambers, on summons served by such defendant or plaintiff on such plaintiff or defendant respectively, to show cause why he should not be allowed to offer other objections, whereof notice shall not have been given as aforesaid, to give leave to offer such objections, on such terms as to such judge shall seem fit.

In case of action, &c. notice of objections to be given.

6. And be it enacted, that in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and without regard to the general result of the trial.

As to costs in actions for infringing letters patent.

7. And be it enacted, that if any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not or shall not have obtained letters patent, the name or any imitation of the name of any other person who hath or shall have obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the King's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner imitate or counterfeit the stamp or mark or other device of the patentee, he shall for every such offence be liable to a penalty of fifty pounds, to be recovered by action of debt, bill, plaint, process, or information in any of his Majesty's courts of

Penalty for using, unauthorized, the name of a patentee, &c.

(*i*) Fourteen. 7 & 8 Vict. c. 69, s. 2, *post*, p. 642.

(*k*) Proviso repealed by 2 & 3 Vict. c. 67, s. 1, *post*, p. 642.

record at Westminster or in Ireland, or in the court of session in Scotland, one half to his Majesty, his heirs and successors, and the other to any person who shall sue for the same: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon any thing made, for the sole making or vending of which a patent before obtained shall have expired.

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2 & 3 Vict. c. 67 (*l*).

2 & 3 Vict. c. 67. *An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching Letters Patent for Inventions."* [24th August, 1839.]

[*Repealed by Act of* 1883, *s.* 113.]

5 & 6 Will. 4, c. 83. "Whereas by an Act passed in the fifth and sixth years of the reign of his Majesty King William the Fourth, intituled 'an Act to amend the law touching letters patent for inventions,' it is amongst other things enacted [*reciting sect.* 4]: and whereas it has happened since the passing of the said Act, and may again happen, that parties desirous of obtaining an extension of the term granted in letters patent of which they are possessed, and who may have presented a petition for such purposes in manner by the said recited Act directed, before the expiration of the said term, may nevertheless be prevented by causes over which they have no control from prosecuting with effect their application before the judicial committee of the privy council; and it is expedient therefore that the said judicial committee should have power, when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited Act, notwithstanding that before the hearing of the case before them the terms of the letters patent sought to be renewed or extended may have expired": Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present parliament assembled, and by the authority of the same, that so much of the said recited Act as provides that no extension of the term of letters patent shall be granted as therein mentioned if the application by petition for such extension be not prosecuted with effect before

Repealing provision requiring the application by petition to be prosecuted with effect

(*l*) 5 & 6 Will. 4, c. 83, s. 4—dealing with the prolongation of letters patent—provided "that no such extension shall be granted if the application by petition shall not be made, and *prosecuted with effect*, before the expiration of the term originally granted in such letters patent." The import of the phrase "prosecuted with effect," came before the Privy Council in *Re Bodmer's Patent* (1 Web. P. C. 740). An application was made in May, 1838, for an extension of the term of Bodmer's patent for cotton spinning machinery. Caveats were entered in July. The case came on before the Privy Council on 17 August, when, according to the rules of practice, the opposing party was entitled to four weeks' notice of the hearing, for the purpose of preparing evidence. Before the expiration of that month, the Privy Council would have closed its sittings. The case was opened and then adjourned to 29th November. In the meantime the opposition was withdrawn, but the patent had also expired. It was held that the words "prosecuted with effect" meant that something must have been effected, and some conclusion arrived at, by the Council, before the expiration of the patent, and that no conclusion having been arrived at, the law did not empower the Council to proceed further, or the Crown to grant new letters patent for an invention open to the public. 2 & 3 Vict. c. 67 repealed the proviso in Lord Brougham's Act, and Bodmer's patent was afterwards extended under the new statute. (Webster's Lett. Pat. pp. 58, n. (*s*), and 61, n. (*x*).) See extension of patents, Chapter XVIII. p. 373, and notes to sect. 25, *supra*.

the expiration of the term originally granted in such letters patent, shall be and the same is hereby repealed.

before the expiration of the term of the patent.

2. And be it further enacted, that it shall be lawful for the judicial committee of the privy council, in all cases where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application, and to report thereon as by the said recited Act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said judicial committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years (*m*) after the expiration of the term mentioned in the said original letters patent: Provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited Act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after the thirtieth day of November, one thousand eight hundred and thirty-nine, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said judicial committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

Term of patent right may be extended in certain cases, though the application for such extension not prosecuted with effect before the expiration thereof.

3. And be it further enacted, that this Act may be altered, amended, or repealed by any Act to be passed in the present session.

Act may be amended this session.

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7 & 8 VICT. c. 69.

An Act for amending an Act passed in the Fourth Year of the Reign of his lat Majesty, intituled "An Act for the better Administration of Justice in his Majesty's Privy Council," and to extend its Jurisdiction and Powers.

[6th August, 1844.]

"Whereas the Act passed in the fourth year of the reign of his late Majesty, intituled 'An Act for the better Administration of Justice in his Majesty's Privy Council,' hath been found beneficial to the due administration of justice: And whereas another Act passed in the sixth year of the said reign, intituled 'An Act to amend the Law touching Letters Patent for Inventions' hath been also found advantageous to inventors and to the public: And whereas the Judicial Committee, acting under the authority of the said Acts, hath been found to answer well the purposes for which it was so established by Parliament, but it is found necessary to improve its proceedings in some respects for the better dispatch of business, and expedient also to extend its jurisdiction and powers: And whereas by the laws now in force in certain of her Majesty's colonies and possessions abroad, no appeals can be brought to her Majesty in Council for the reversal of the judgments, sentences, decrees and orders of any Courts of Justice within such colonies, save only of the Courts of Error or Courts of Appeal within the same, and it is expedient that her Majesty in Council should be authorized to provide for the admission of appeals from other Courts of Justice within such colonies or possessions:" Be it therefore enacted, &c.

(*m*) See 7 & 8 Vict. c. 69, s. 2, empowering Her Majesty in Council to extend the term by fourteen years in certain cases.

[*The first section does not relate to the subject of this work.*]

If extension of a patent term may be granted for fourteen years in certain cases.

[*Repealed by Act of* 1883, *s.* 113.]

2. "And whereas it is expedient for the further encouragement of inventions in the useful arts to enable the time of monopoly in patents to be extended in cases in which it can be satisfactorily shown that the expense of the invention hath been greater than the time now limited by law will suffice to reimburse:" be it enacted, That if any person having obtained a patent for any invention, shall before the expiration thereof present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said committee shall be of opinion and shall so report to her Majesty that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any time not exceeding fourteen years, in like manner, and subject to the same rules as the extension, for a term not exceeding seven years is now granted under the powers of the said Act of the sixth year of the reign of his late Majesty (*a*).

Less term than prayed may be granted.

[*Repealed by Act of* 1883, *s.* 113.]

3. Provided always, and be it enacted, That nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petition shall have prayed.

Extensions of patent terms may be granted to assignees.

[*Repealed by Act of* 1883, *s.* 113.]

4. "And whereas doubts have arisen touching the power given by the said recited Act of the sixth year of the reign of his late Majesty in cases where the patentees have wholly or in part assigned their right;" be it enacted, That it shall be lawful for her Majesty, on the report of the Judicial Committee, to grant such extension as is authorized by the said Act and by this Act, either to an assignee or assignees, or to the original patentee or patentees, or to an assignee or assignees, and original patentee or patentees conjointly.

Disclaimers and memorandums of alteration under 5 & 6 Will. 4, c. 83, s. 1, may be entered by assignees.

[*Repealed by Act of* 1883, *s.* 113.]

5. And be it enacted, That in case the original patentee or patentees hath or have departed with his or their whole, or any part of his or their interest by assignment to any other person or persons, it shall be lawful for such patentee, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a disclaimer and memorandum of alteration, under the powers of the said recited Act, and such disclaimer and memorandum of such alteration having been so entered and filed as in the said recited Act mentioned shall be valid and effectual in favour of any person or persons in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever, on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf (*a*).

Disclaimers and memorandums of alteration by assignees before passing

6. And be it enacted, That any disclaimer or memorandum of alteration before the passing of this Act, or by virtue of the said recited Act by such patentee with such assignee, or by such assignee as aforesaid, shall be valid and effectual to bind any person or persons in whom the said letters patent

(*a*) Sect. 2 of this Act enabled the Judicial Committee to extend the term of a patent for fourteen years instead of merely for seven years—the limit fixed by 3 & 4 Will. IV. c. 41, s. 4. This provision was not, however, to prevent the Judicial Committee from reporting in favour of an extension for a lesser term than that prayed for. (Sect. 3.) Extension might be granted (sect. 4), and a disclaimer and memorandum of alteration might be made (sect. 5), although a patentee had wholly or in part assigned his rights. See *supra*, pp. 195, 492.

might then be or have since become vested: and no objection shall be made in any proceeding whatsoever that the party making such disclaimer or memorandum of alteration had not authority in that behalf.

of Act to be valid. [*Repealed by Stat. Law Rev. (No. 2) Act*, 1874.]

7. And be it enacted, That any new letters patent which before the passing of this Act may have been granted, under the provisions of the above-recited Act of the sixth year of the reign of his late Majesty to an assignee or assignees, shall be as valid and effectual as if the said letters patent had been made after the passing of this Act, and the title of any party to such new letters patent shall not be invalidated by reason of the same having been granted to an assignee or assignees: Provided always, that nothing herein contained shall give any validity or effect to any letters patent heretofore granted to any assignee or assignees where any action or proceeding in sciro facias, or suit in equity, shall have been commenced at any time before the passing of this Act, wherein the validity of such letters patent shall have been or may be questioned.

New patents granted under 5 & 6 Vict. c. 83, s. 4, to assignees before passing of Act to be valid.

Not to affect existing scire facias, or suit in equity. [*Repealed by Stat. Law Rev. (No. 2) Act*, 1874.]

[*The remainder of this statute is not directly applicable to the subject of the present work.*]

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14 VICT. c. 8.

An Act to extend the Provisions of the Designs Act, 1850, *and to give Protection from Piracy to Persons exhibiting new Inventions in the Exhibition of the Works of Industry of all Nations in one thousand eight hundred and fifty-one.* [11th April, 1851.]

[*Repealed by Stat. Law Rev. Act*, 1875 (*o*).]

Whereas it is expedient that such protection as hereinafter mentioned should be afforded to persons desirous of exhibiting new inventions in the Exhibition of the Works of Industry of all Nations in one thousand eight hundred and fifty-one; Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present Parliament assembled, and by the authority of the same, as follows:—

Proprietors of new inventions to be allowed to exhibit them without prejudice to letters patent to be thereafter granted.

1. Any new invention for which letters patent might lawfully be granted may at any time during the year one thousand eight hundred and fifty-one, but not afterwards, be publicly exhibited in any place previously certified by the Lords of the Committee of Privy Council for Trade and Foreign Plantations to be a place of exhibition within the meaning of the Designs Act, 1850, without prejudice to any letters patent to be thereafter during the term of the provisional registration hereinafter mentioned, granted for such invention to the true and first inventor thereof: Provided always, that such invention have, previously to such public exhibition thereof, been provisionally registered in manner hereinafter mentioned; and provided also that the same be not otherwise publicly exhibited or used by or with the consent of the inventor prior to the granting of any such letters patent as aforesaid, except as hereinafter mentioned: Provided also, that no sale or transfer, or contract for sale or transfer, of the right to or benefit of any invention so provisionally registered, or of the rights acquired under this Act or to be acquired under any letters patent to be granted for such invention, shall be deemed a use of such invention, and the publication of any account or description of such invention in any catalogue, paper, newspaper, periodical or otherwise, shall not affect the validity of any letters patent to be during such term granted as aforesaid.

Inventions to be provisionally registered, and not to be used before granting of the letters patent.

Public trial of agricultural or horticul-

2. The public trial or exhibition of any such invention as aforesaid (being an invention for purposes of agriculture or horticulture) which shall be

(*o*) See notes to sect. 39 of the Act of 1883, *supra*.

tural implements under the direction of the Commissioners, not to prejudice letters patent.

certified by the Lords of the said Committee to have taken place under the direction of the Commissioners for the Exhibition of 1851, for purposes connected with the exhibition thereof in such place of public exhibition as aforesaid, whether such trial or exhibition take place before or after the passing of this Act, shall not prevent the provisional registration of such invention under this Act, nor prejudice or affect the validity of any letters patent to be granted for such invention during such term as aforesaid.

Certificate of invention to be granted for provisional registration.

3. Her Majesty's Attorney-General, or such person or persons as he may from time to time appoint to issue certificates under this Act, on being furnished with a description in writing, signed by or on behalf of the person claiming to be the true and first inventor within this realm of any new invention intended to be exhibited in such place of public exhibition as aforesaid, and on being satisfied that such invention is proper to be so exhibited, and that the description in writing so furnished describes the nature of the said invention so intended to be exhibited, and in what manner the same is to be performed, shall give a certificate in writing under the hand or hands of such Attorney-General, or the person or persons appointed as aforesaid for the provisional registration of such invention.

Certificate of invention to be registered.

4. The Registrar of Designs, acting under the Designs Act, 1850, upon receiving such certificate, and being furnished with the name and place of address of the person by or on whose behalf the registration is desired, shall register such certificate, name and place of address, and the invention to which any certificate so registered relates shall be deemed to be provisionally registered, and the registration thereof shall continue in force for the term of one year from the time of the same being so registered; and the registrar shall certify under his hand and seal that such invention has been provisionally registered, and the date of such registration and the name and place of address of the person by or on whose behalf the registration was effected: Provided always, that if any invention so provisionally registered be not actually exhibited in such place of public exhibition as aforesaid, or if the same invention be in use by others at the time of the said registration, or if the person by or on whose behalf the said registration has been effected be not the first and true inventor thereof, such registration shall be absolutely void.

Description to be preserved, and invention to be marked with the words "Provisionally registered."

5. The description in writing of any invention so provisionally registered shall be preserved in such manner and subject to such regulations as the Attorney-General shall direct, and any invention so provisionally registered and exhibited at such place of public exhibition as aforesaid shall have the words "Provisionally registered" marked thereon or attached thereto, with the date of the said registration.

Provisional registration to confer same benefits as under the Designs Act, 1850.

6. Such provisional registration as aforesaid shall during the term thereof confer on the inventor of such invention, with respect thereto, all the protection against piracy and other benefits which, by the Designs Act, 1850, are conferred upon the proprietors of designs provisionally registered thereunder, with respect to such designs; and so long as such provisional registration continues in force, the penalties and provisions of the Designs Act, 1842, for preventing the piracy of designs, shall extend to the acts, matters and things next hereinafter mentioned as fully and effectually as if those penalties and provisions had been re-enacted in this Act and expressly extended to such acts, matters, and things; that is to say, to the making, using, exercising, or vending the invention so provisionally registered, to the practising the same or any part thereof, to the counterfeiting, imitating, or resembling the same, to the making additions thereto or subtraction from the same, without the consent in writing of the person by or on whose behalf the said invention was so provisionally registered.

Letters patent thereafter granted to be as valid as if inventions

7. All letters patent to be during the term of any such provisional registration granted in respect of any invention so provisionally registered, shall, notwithstanding the registration thereof, and notwithstanding the exhibition thereof in such place of public exhibition or otherwise as aforesaid, be of the same validity as if such invention had not been

so registered or exhibited; and it shall be lawful for the Lord High Chancellor, if he think fit, on the grant of any letters patent to any inventor in respect of any invention provisionally registered under this Act, to cause such letters patent to be sealed as of the day of such provisional registration, and to bear date as of the day of such provisional registration, the Act of the eighteenth year of King Henry the Sixth or any other Act notwithstanding.

were not registered or exhibited.

8. Notwithstanding anything contained in the Designs Act, 1850, and the two Acts therein referred to and called the Designs Act, 1842, and the Designs Act, 1843, the protection intended to be by those Acts extended to the proprietors of new and original designs shall be extended to the proprietors of all new and original designs which shall be provisionally registered and exhibited in such place of public exhibition as aforesaid, notwithstanding that such designs may have been previously published or applied elsewhere than in the United Kingdom of Great Britain and Ireland: Provided that such design, or any article to which the same has been applied, have not been publicly sold or exposed for sale previously to such exhibition thereof as aforesaid.

Proprietors of new and original designs exhibited to be entitled to benefits of Designs Acts, although designs have been previously published elsewhere than in the U. K., if not publicly sold or used.

9. All the provisions of the Designs Act, 1850, and the provisions incorporated therewith relating or applicable to the designs to be provisionally registered thereunder, or to the proprietors of such designs, except the provision for extending the term of any such provisional registration, shall, so far as the same are not repugnant to or inconsistent with the provisions of this Act, apply to the inventions to be provisionally registered under this Act, and to the inventors thereof; and the said Designs Act and this Act, shall be construed together as one Act.

The Designs Act, 1850, and this Act, to be construed as one Act.

10. This Act may be cited as "The Protection of Inventions Act, 1851."

Short title.

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14 & 15 VICT. c 82.

An Act to simplify the Forms of Appointment to certain Offices, and the manner of passing Grants under the Great Seal. [7th August, 1851.]

[*Repealed by* 47 & 48 *Vict. c.* 30, *s.* 5.]

[Sect. **1** *repeals so much of* 27 *Hen. VIII. c.* 11, *as relates to warrants for passing grants, &c., under the Great Seal.*

Sect. **2** *dispenses with Signet and Privy Seal bills as authorities for passing grants under the Great Seal.*

Sect. **3** *abolishes the offices of clerks to the Signet and Privy Seal.*

Sect. **5** *transfers the duties of the Signet Office not superseded by this Act to the office of Secretary of State.*]

7. It shall be lawful for the Lord High Chancellor or Lord Keeper or Lords Commissioners of the Great Seal of the United Kingdom from time to time after the passing of this Act to frame and establish such further rules and regulations to be observed on the passing of letters patent under the Great Seal of the United Kingdom as shall seem to them expedient.

Lord Chancellor and Secretary of State may make rules concerning the passing of letters patent.

10. This Act shall, save where herein otherwise provided, commence from and after the thirty-first day of December, one thousand eight hundred and fifty-one.

Commencement of Act.

15 Vict. c. 6.

An Act for extending the Term of the Provisional Registration of Inventions under "The Protection of Inventions Act, 1851" (*o*). [20th April, 1852.]

[*Repealed by Stat. Law Rev. Act*, 1875.]

14 Vict. c. 8.

Whereas by "The Protection of Inventions Act, 1851," it was provided that the provisional registration of any new invention registered thereunder should continue in force for the term of one year from the time of the same being so registered: and whereas it is expedient that the same should be extended: Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Provisional registration under the recited Act to continue in force till 1st February, 1853.

1. The registration of every invention provisionally registered under the said Act shall continue until the first day of February, one thousand eight hundred and fifty-three, in like manner and with the like effect and consequences as if every such registration had been continued in force till that day by the said Act instead of for the term of one year from the time of the invention being registered as therein mentioned.

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15 & 16 Vict. c. 83 (*p*).

An Act for amending the Law for granting Patents for Inventions. [1st July, 1852.]

[*Repealed by Patents, &c., Act*, 1883, *s.* 113.]

Whereas it is expedient to amend the law concerning letters patent for inventions; Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Certain persons constituted Commissioners of Patents for Inventions, three of whom may act, the Chancellor or Master of the Rolls being one.

1. The Lord Chancellor, the Master of the Rolls, Her Majesty's Attorney-General for England, her Majesty's Solicitor-General for England, the Lord Advocate, her Majesty's Solicitor-General for Scotland, her Majesty's Attorney-General for Ireland, and her Majesty's Solicitor-General for Ireland, for the time being respectively, together with such other person or persons as may be from time to time appointed by her Majesty, as hereinafter mentioned, shall be Commissioners of Patents for inventions; and it shall be lawful for her Majesty from time to time, by warrant under her royal Sign Manual, to appoint such other person or persons as she may think fit to be a commissioner or commissioners as aforesaid; and every person so appointed shall continue such commissioner during her Majesty's pleasure; and all the powers hereby vested in the commissioners may be exercised by any three or more of them, the Lord Chancellor or Master of the Rolls being one (*q*).

(*o*) See notes to sect. 39 of the Act of 1883, *supra*, p. 494. Cp. also 28 Vict. c. 3, and 33 & 34 Vict. c. 27, *infra*, pp. 676, 677.

(*p*) The Patent Law Amendment Act, 1852, was founded upon three Bills, which were considered by a Select Committee of the House of Lords in 1851—(1) Lord Granville's Patent Law Amendment Bill; (2) Lord Brougham's Patent Law Amendment Bill; and (3) these two Bills consolidated by Mr. Thomas Webster, by request of the Select Committee.

(*q*) Under Lord Granville's Bill, the "Secretaries of State" were included in the commission, but it was suggested that the number should be as small as possible, and confined to those who had actually to deal with the granting of patents. The functions of the commis-

2. It shall be lawful for the commissioners to cause a seal * to be made for the purposes of this Act, and from time to time to vary such seal, and to cause to be sealed therewith all the warrants for letters patent under this Act, and all instruments and copies proceeding from the office of the commissioners, and all Courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the Great Seal are received in evidence, and shall also take notice of and receive in evidence, without further proof or production of the originals, all copies or extracts, certified under the seal of the said office, of or from documents deposited in such office (*r*). Seal of the Commissioners.

3. It shall be lawful for the commissioners from time to time to make such rules and regulations (not inconsistent with the provisions of this Act), respecting the business of their office, and all matters and things which under the provisions herein contained are to be under their control and direction, as may appear to them necessary and expedient for the purposes of this Act: and all such rules shall be laid before both Houses of Parliament within † fourteen days after the making thereof, if Parliament be sitting, and if Parliament be not sitting, then within fourteen days after the next meeting of Parliament; and the commissioners shall cause a report to be laid annually before Parliament of all the proceedings under and in pursuance of this Act (*s*). Power to Commissioners to make rules and regulations, which shall be laid before Parliament. Commissioners to report annually to Parliament.

4. It shall be lawful for the commissioners of her Majesty's Treasury to provide and appoint from time to time proper places or buildings for an office or offices for the purposes of this Act (*r*).‡ Treasury to provide offices.

5. It shall be lawful for the commissioners, with the consent of the Commissioners of the Treasury, from time to time to appoint for the purposes of this Act such clerks and officers as the commissioners may think proper; and it shall be lawful for the commissioners from time to time to remove any of the clerks and officers so appointed.§ Commissioners, with consent of the Treasury, to appoint clerks, &c.

6. Every petition for the grant of letters patentfor an invention, and the declaration required to accompany such petition, shall be left at the office of the commissioners, and there shall be left therewith a statement in writing,‖ Petition and declaration to

sioners under this Act were to make rules of practice, and to regulate the proceedings connected with the granting of patents.

(*r*) It was proposed in Mr. Webster's consolidated Bill that the petition, the declaration, and the provisional specification, should be left at the Great Seal Patent Office; and that all the intermediate proceedings, viz. the advertisement and the consulting of indexes and documents by the public, and everything of a public nature, should be at the Commissioners' Office. The present Act, however, follows Lord Granville's Bill in requiring the commissioners to regulate all proceedings from the commencement to the last step which was taken at the Great Seal Patent Office.

(*s*) This section is an amalgamation of the 2nd and 3rd sections as they originally stood in Lord Granville's Bill. Instructions were given to let the rules be expressed in the Act of Parliament as much as possible, and not to leave such extensive and indefinite powers to the commissioners as were given in Lord Granville's Bill: hence the enumeration of the subjects respecting which the commissioners were empowered to make rules. The provision for an annual report to Parliament appeared for the first time in Mr. Webster's consolidated Bill. This report was published annually, under the title of "The Report of the Commissioners of Patents for Inventions," the first report being made in 1854 for the period between 1st October, 1852, when the Act came into operation, and the 31st December, 1853. The last report under this Act was the report for 1883. Since the coming into operation of the Act of 1883, upon the 1st January, 1884, an annual report has been made pursuant to sect. 102, under the title of the "Report of the Comptroller-General of Patents, Designs, and Trade Marks."

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* Compare Patents Act, 1883, s. 84.
† *Ibid.* s. 102.
‡ *Ibid.* s. 82.
§ *Ibid.* s. 83.
‖ *Ibid.* s. 5, sub-s. 2.

be accompanied with a provisional specification.

hereinafter called the provisional specification, signed by or on behalf of (*u*) the applicant for letters patent, describing the nature of the said invention; and the day of the delivery of every such petition, declaration, and provisional specification shall be recorded at the said office, and indorsed on such petition, declaration, and provisional specification, and a certificate thereof given to such applicant or his agent; and all such petitions, declarations, and provisional specifications shall be preserved in such manner as the commissioners may direct, and a registry thereof and of all proceedings thereon kept at the office of the commissioners (*v*).

Every application to be referred to one of the law officers.

7. Every application for letters patent made under this Act shall be referred by the commissioners, according to such regulations as they may think fit to make, to one of the law officers.

The provi-

8. The provisional specification shall be referred to the law officer, who

(*u*) It was formerly necessary that the specification should be acknowledged by the applicant himself before inrolment.

(*v*) The defects in the early English Patent Law, which the introduction of the provisional specification was intended to remove, were these—(1) Applications were made for letters patent by persons who had only vague ideas in their minds at the time of applying. (2) The sole information given by the applicant to the law officer was a *title*, so worded as not to call the attention of rival inventors, or enable them to discover the subject-matter, and at the same time not to incur the danger that a Court of justice might afterwards rule it to be an imperfect definition of the invention described in the specification. The evils to which the procedure here described lent itself are obvious. Speculators or patent jobbers found out that a person of talent was occupied with an invention, applied for a patent, with a title sufficiently general to cover the invention; and, having thus got the start of the inventor, made his invention their own, if they could get at it before the time of specifying. Again, the public had no means of becoming acquainted with the fact that an application for letters patent for a particular invention had been made, except through the imperfect system of caveats, *i.e.*, individuals who had previously lodged caveats were entitled to notice of any applications that might be made for patents, in terms corresponding, in the opinion of the Attorney-General's clerk, to those of their caveats. In judging of the correspondence between the title and the caveat, the law officer's clerk was very liable to be mistaken; and, besides, as caveats were open to public inspection, nothing was easier than for an ingenious inventor to prepare what was called a *blind* title, evading the term of particular caveats. (3) Between the date of his application and the sealing of his patent, the applicant had no security for his invention. He was unable to mature it by experiments, because, even if disclosure to workmen did not amount to publication—a point which seems at one time to have been doubtful—he had no protection against the treacherous discovery of his invention by workmen to third parties. The result was that the patentee, not being able to pursue his experiments and construct his machine before the inrolment of his specification, often found out at the last that he was deficient in parts, and was obliged to go through the whole process of obtaining patents for the three kingdoms again. To draw a title honestly under such circumstances, was as difficult as to prepare a general index to a work of which none of the chapters were yet completely written. Another inconvenience, arising from the absence of provisional protection, was the inability of the inventor to go to a capitalist for assistance in maturing his invention. (4) The time for specifying might be extended at the discretion of the Attorney-General, and in some cases was extended to fifteen or eighteen months in all. The result was that a person applying for a patent under a vague title might preclude other persons from taking out patents for anything of the same sort till he put in his specification. A case of this description is given in the evidence of Mr. Samuel Clegg before the Committee of 1829 (pp. 92, 93): "Upon the occasion," said the witness, "of the last patent I took out for certain improvements in the construction of a steam engine, I had to wait six months, because a person had just previously taken out a patent for certain improvements in the steam engine, and I could not tell what those certain improvements were."

shall be at liberty to call to his aid such scientific * or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint; and if such law officer be satisfied that the provisional specification describes the nature of the invention, he shall allow the same, and give a certificate of his allowance, and such certificate shall be filed in the office of the commissioners, and thereupon the invention therein referred to may, during the term of six months from the date of the application for letters patent for the said invention, be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as provisional protection: Provided always, that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the law officer (*y*) to whom the same is referred to allow or require the same to be amended.

Provisional specification to be referred to the law officer who, if satisfied, may give a certificate of his allowance, which shall be filed.

9. The applicant for letters patent for an invention, instead of leaving with the petition and declaration a provisional specification as aforesaid, may, if he think fit, file with the said petition and declaration an instrument in writing under his hand and seal (hereinafter called a complete specification),† particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration, and the day of the delivery of every such petition, declaration, and complete specification shall be recorded at the office of the commissioners, and indorsed on such petition, declaration and specification, and a certificate thereof given to such applicant or his agent, and thereupon, subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this Act for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights and privileges as might have been conferred upon him by letters patent for such invention,‡ issued under this Act, and duly sealed as of the day of the date of such application; and during the continuance of such powers, rights and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascer-

Inventor may deposit, in lieu of a provisional specification, a complete specification, such deposit to confer for a limited time the like rights as letters patent.

(*y*) The object of this section was to secure, in accordance with the general recommendation of the majority of the witnesses examined before the Select Committee of 1851, some kind of preliminary investigation into the sufficiency of the provisional specification. Mr. Webster's consolidated Bill proposed a reference to some person other than the law officer, but here, as in the case of opposition, provided (sect. 8) that everything done by the referee should be subject to the approval of the law officer, and might be varied or corrected by him, according to circumstances. The present section makes the law officer himself the referee, and enables him to call in the aid, and to fix the remuneration, of a scientific assessor. It appears to have been the practice of the law officers to obtain scientific assistance, before the present Act; thus Sir Thomas Plumer and Sir A. E. Cockburn are stated to have done it; but there was some doubt as to the power of fixing remuneration, provided for by this section.

The provisional protection here conferred could not be extended beyond six months. This is a departure both from Lord Granville's Bill, which gave a power of extension for six, and from Mr. Webster's Bill, which gave a similar power for three, months.

Provisional protection is simply the ability to use and publish the invention from the date of the certificate without prejudice to letters patent subsequently granted. It seems to have been suggested by similar systems prevailing in France and the United States of America.

As to the title under the present law, see p. 89, and sect. 5, sub-s. 5.

As to the sufficiency of specification, see p. 103.

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* Compare Patents Act, 1883, s. 11, sub-s. 4.

† *Ibid.* s. 5, sub-ss. 2, 4.

‡ *Ibid.* s. 15.

tained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed; and a copy of every such complete specification shall be open to the inspection of the public, as hereinafter provided, from the time of depositing the same, subject to such regulation as the commissioners may make (*z*).*

Letters patent granted to the first inventor not to be invalidated by protection obtained in fraud of the first inventor.

10. In case of any application for letters patent for any invention, and the obtaining upon such application of provisional protection for such invention, or of protection for the same, by reason of the deposit of a complete specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application, or of such provisional or other protection as aforesaid, or of any use or publication of the invention subsequent to such application, and before the expiration of the term of such provisional or other protection.†

Commissioners to cause protections to be advertised.

11. Where any invention is provisionally protected under this Act, or protected by reason of the deposit of such complete specification as aforesaid, the commissioners shall cause such provisional protection or such other protection as aforesaid to be advertised in such manner as they may see fit (*a*).‡

Application

12. (*b*) The applicant for letters patent, so soon as he may think fit after the

(*z*) This section was introduced at the suggestion of the Master of the Rolls, Sir John Romilly, made in the evidence before the Select Committee of 1851 (pp. 378 *et seq.*), and was not contained in any of the three bills on which the Patent Law Amendment Act, 1852, was founded. It was intended to meet the case of an inventor who was ready in the first instance to make his complete and final specification, and who, it was felt, ought not to be compelled to pay all the fees, and go through the necessary proceedings, as was proposed in the bills before the committee for taking out a patent upon a provisional specification.

(*a*) These sections provide for advertisements, and notices of objections, and were contained in the consolidated bill. It was agreed at a meeting which took place at the Board of Trade between Mr. Webster and the law officers, that a system of advertisements should be substituted for the system of caveats, which was imperfect and liable to be abused. Under that system, only those individuals who had lodged caveats received notice of applications. Even their chance of notice depended on whether the Attorney-General's clerk was struck by the resemblance between a caveat and the title of a proposed patent, and it was easy to evade the terms of a caveat in preparing the title.

The notice of objections was an application to oppositions to the grant of letters patent of the procedure in applications for extension, under Lord Brougham's Act, 5 & 6 Will. IV. c. 83. As to opposition under present law, see *supra*, p. 167.

(*b*) This and the following three sections relate to the procedure on oppositions. It will be convenient here to trace shortly the history of opposition to the grant of letters patent (1) before the Patent Law Amendment Act, 1852, and (2) before the Patents, &c. Act, 1883. See an account of the early practice on obtaining letters patent, in Hindmarch, pp. 503 *et seq.*, and Webster's Letters Patent for Inventions, pp. 13 *et seq.*, and p. 69.

(1.) Opposition took the form of *entering a caveat*, general or specific, against the grant of letters patent for an invention described therein. A *general caveat* was lodged at the chambers of the Attorney and the Solicitor-General by, or on behalf of, an applicant for letters patent, and its effect was to secure that the person lodging it should receive *notice* (*R.* v. *Cutler*, 1847, 3 C. & K. 215) of any *petition* for the grant of letters patent for the same, or a similar, invention, referred for the *report* of the law officer. Having received such notice, the person entering the *caveat* was entitled to appear in support of his opposition before the law officer. A general *caveat* remained in force for a year, but might be renewed from year to year by entering a general *caveat*.

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* Compare Patents Act, 1883, s. 13.
† *Ibid.* s. 35.
‡ *Ibid.* s. 10.

invention shall have been provisionally protected under this Act, or where a complete specification has been deposited with his petition and declaration, then so soon as he may think fit after such deposit, may give notice at the office of the commissioners of his intention of proceeding with his application for letters patent for the said invention, and thereupon the said commissioners shall cause his said application to be advertised in such manner as they may see fit; and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application at such place and within such time and subject to such regulations as the commissioners may direct (*c*).

for letters patent to be advertised, and also oppositions to the same.

13. So soon as the time for the delivery of such objections shall have expired, the provisional specification or complete specification (as the case

Specification and objections

An inventor was enabled to debar any person who had, by fraud or breach of confidence, obtained a knowledge of his invention from patenting it, but could not hinder such a party from *publishing* it to the world, and thereby rendering his own petition worthless. A *specific caveat* may be defined as opposition to the grant of letters patent for a particular invention offered (a) at the Patent Bill Office to the preparation of the *Queen's Bill*, (b) at the Signet Office to the preparation of the *Signet Bill*, (c) at the Privy Seal Office to the preparation of the *Privy Seal Bill*, and (d) at the Patent Office to the *sealing* of letters patent.

(2.) The Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83, s. 12). After this statute the practice of entering caveats was discontinued unless special leave had first been obtained: *In re Heathorn's Patent*, 1864 (10 L. T. N. S. 802; 10 Jur. N. S. 810), substituted for the *caveat* against the *grant* of a patent, a new procedure, by which any person having an interest in opposing a grant might deliver *particulars of objections* within twenty-one days after the Commissioners of Patents had, as required by the statute, advertised the petitioner's *notice to proceed*. The Act reserved, however, the Lord Chancellor's former jurisdiction (15 & 16 Vict. c. 83, s. 15), and notice of opposition at Great Seal was still competent.

The Lord Chancellor's jurisdiction is now impliedly taken away, letters patent being sealed (sect. 12, sub-s. (1)) at the Patent Office. The grant of a patent can now be opposed only upon the grounds enumerated in this sub-section. Former grounds of opposition were (1) prior public user (*In re Samuda; In re Griffiths*, 1846, cited Hindmarch, p. 534); (2) want of utility (*In re Cutler*, 1839, 1 Web. P. C. 426): this is not a strong authority for the proposition, and Lord Cottenham appears to have doubted whether the sealing of a patent ought to be stopped on the ground of want of utility alone. See, however, Webster, *ubi sup.* p. 427, n. (*b*); (3) that the invention was not proper subject-matter for a patent (*Re Spence's Patent*, 1859, 7 W. R. 157; 3 De G. & J. 523).

As most of the old cases turn upon opposition at the Great Seal, which it was a matter of *discretion* with the Lord Chancellor to allow, whereas under the Patents, &c. Act, 1883, there is an express *right* of appeal from the comptroller to the law officer, it may suffice to state generally the principles by which successive Lord Chancellors were guided. These were:—Had the objection raised at the Great Seal Office been taken before the law officer? (*Ex parte Henson*, 1832, 1 Web. P. C. 432; *In re McKean*, 1859, 1 L. T. N. S. 1; 1 De G. F. & J. 2; *In re Mitchell's Patent*, 1867, L. R. 2 Ch. 343.) If not, could it have been, and ought it to have been so taken? Were there any special circumstances, such as fraud, surprise, or the discovery of new material facts, which tended to weaken the law officer's decision (if given)? (*In re Vincent's Patent*, 1867, L. R. 2 Ch. 341; *Ex parte Sheffield*, 1872, L. R. 8 Ch. 237.) Was the patent clearly bad? (*In re Tolson's Patent*, 1856, 4 W. R. 518; 6 De G. M. & G. 422; *In re Russell's Patent*, 1857, 30 L. T. 178; 2 De G. & J. 130.)

The importance of considering these questions carefully, and answering them correctly, arose from the fact that the Lord Chancellor's refusal to seal patents, if erroneous, was irremediable, whereas the sealing of a bad patent left every one at liberty to dispute it. (*In re Spence's Patent*, 1859, 3 De G. & J. 523. Cp. language of Sir Henry James, A.-G., in *Cumming's Patent*, 1884, Griffin, P. C. at p. 278; and of Sir Richard Webster, A.-G., in *Edmunds' Patent*, 1886, Griffin, P. C. at p. 282. Cp. also *Brandies Patent*, 1853, 1 Eq. R. 121; *Ashenhurst's Patent*, 1853, 2 W. R. 3; *Cobley's Patent*, 1862, 31 L. J. Ch. 333; *Daines' Patent*, 1856, 26 L. J. Ch. 298; *Marshall* v. *Ross*, 1869, L. R. 8 Eq. 651; *Hersee & Smyth, In re*, 1866, L. R. 1 Ch. 518.)

(*c*) See note (*a*), p. 650.

to be referred to law officer.

may be) and particulars of objection (if any) shall be referred to the law officer to whom the application has been referred (*b*).*

Power to law officer to order by or to whom costs shall be paid.

14. It shall be lawful for the law officer to whom any application for such letters patent is referred, if he see fit, by certificate under his hand, to order by or to whom the costs of any hearing or inquiry upon any objection, or otherwise in relation to the grant of such letters patent, or in relation to the provisional (or other) protection acquired by the applicant under this Act,† shall be paid, and in what manner and by whom such costs are to be ascertained; and if any costs so ordered to be paid be not paid be not paid within four days after the amount thereof shall be so ascertained, it shall be lawful for such law officer to make an order for the payment of the same, and every such order may be made a rule of one of her Majesty's superior Courts at Westminster or Dublin, and may be recorded in the Books of Council and Session in Scotland to the effect that execution may pass thereupon in common form (*c*).

Power to law officer to cause a warrant to be made for sealing of letters patent.

15. It shall be lawful for such law officer, after such hearing, if any, as he may think fit, to cause a warrant to be made for the sealing of letters patent for the said invention, and such warrant shall be sealed with the seal of the commissioners, and shall set forth the tenor and effect of the letters patent thereby authorized to be granted, and such law officer shall direct the insertion in such letters patent of all such restrictions, conditions and provisoes as he may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act; and the said warrant shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant: Provided always, that the Lord Chancellor shall and may have and exercise such powers, authority and discretion in respect to the said warrant, and the letters patent therein directed to be made under this Act, as he now has and might now exercise with respect to the warrant for the issue under the Great Seal of letters patent for any invention, and with respect to the making and issuing of such letters patent; and the writ of scire facias shall lie for the repeal of any letters patent issued under this Act, in the like cases as the same would lie for the repeal of letters patent, which may now be issued under the Great Seal (*d*).‡

Chancellor to have same powers in respect to warrant, &c., as he now has.

Writ of *scire facias*.

(*b*) This section is a departure from the 7th clause of the consolidated bill, which anticipated the modern system of examiners. That clause provides for the reference of the provisional specification and notice of objections, if any, to an examiner or examiners, who were to report to the law officers upon the novelty of the invention, or any other grounds, such as the sufficiency of title, which in their opinion might affect the granting of the patent; so that the functions of the law officers, instead of being partly ministerial and partly judicial, might be made as strictly judicial as possible. The notion was that the commissioners would appoint six or eight persons skilled in particular departments, including two or three engineers and two or three chemists, one or more of whom might be chosen to report on any particular subject, and that they should not sit as a Board except for convenience.

(*c*) This section corresponds to the 8th clause of the consolidated bill, which gave the law officers the power of awarding costs; the notion being that their fee in unopposed cases might be a small sum, but that in opposed cases they should be paid according to the work done, and should have the power of making the applicant or the opponent, as the case might be, pay the costs. Such fees were extra to the costs in the Schedule, which relates to unopposed cases.

(*d*) Under Lord Granville's Bill and Lord Brougham's Bill, the sign manual gave the warrant for sealing the patent. The consolidated bill substituted the law officer's warrant for the sign manual (sect. 9); and that provision is here reproduced.

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* Compare Patents Act, 1883, s. 11.
† *Ibid.* s. 38.
‡ *Ibid.* s. 26, sub-s. 1.

Nothing to affect the prerogative of the Crown in granting or withholding grant of letters patent.

16. Provided also, That nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding the grant of any letters patent; and it shall be lawful for her Majesty, by warrant under her royal Sign Manual, to direct such law officer to withhold such warrant as aforesaid, or that any letters patent for the issuing whereof he may have issued a warrant as aforesaid shall not issue, or to direct the insertion in any letters patent to be issued in manner herein provided of any restrictions, conditions or provisoes which her Majesty may think fit, in addition to or in substitution for any restrictions, conditions or provisoes which would otherwise be inserted therein under this Act;* and it shall also be lawful for her Majesty, by like warrant, to direct any complete specification which may have been filed under the provision hereinbefore contained, and in respect of the invention described, in which no letters patent may have been granted, to be cancelled, and thereupon the protection obtained by the filing of such complete specification shall cease.

Letters patent to be made subject to avoidance on non-fulfilment of certain conditions.

17. All letters patent for inventions granted under the provisions hereinbefore contained shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expiration of the said three and seven years respectively, the sum or sums of money and stamp duties in the schedule to this Act annexed; and the payment of the said sums of money and stamp duties respectively shall be indorsed on the warrant for the said letters patent; and such officer of the commissioners as may be appointed for this purpose shall issue, under the seal of the commissioners,† a certificate of such payment, and shall indorse a receipt for the same on any letters patent issued under the authority of the said warrant; and such certificate, duly stamped, shall be evidence of the payment of the several sums respectively(*e*).

Letters patent issued under the Great Seal to be valid for the whole of the United Kingdom, the Channel Islands, and the Isle of Man.

18. The commissioners, so soon after the sealing of the said warrant as required by the applicant for the letters patent, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant and it shall be lawful for the Lord Chancellor to cause such letters patent to be sealed with the Great Seal of the United Kingdom, and such letters patent so sealed shall extend to the whole of the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man; and in case such warrant so direct, such letters patent shall be made applicable to her Majesty's colonies and plantations abroad, or such of them as may be mentioned in such warrant;‡ and such letters patent shall be valid and effectual as to the whole of such United Kingdom, and the said islands and isle, and the said colonies or plantations, or such of them as aforesaid, and shall confer the like powers, rights and privileges as might, in case this Act had not been passed, have been conferred by several letters patent of the like purport and effect passed under the Great Seal of the United Kingdom, under the seal appointed to be used instead of the Great Seal of Scotland, and under the Great Seal of Ireland respectively, and made applicable to England, the dominion of Wales, the town of Berwick-upon-Tweed, the Channel Islands, and Isle of Man, and the said colonies and plantations, or such of them as aforesaid, to Scotland, and to Ireland respectively, save as herein otherwise provided: Provided always, that nothing in this Act contained shall be deemed or taken to give any effect or operation to any letters patent to be granted under the authority of this Act in any colony in which such or the like letters patent would be invalid by the law in force in the same colony

Nothing to give effect to any letters patent granted in any colony.

(*e*) These provisions as to payments were anticipated in each of the three bills before the Select Committee of 1851.

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* Compare Patents Act, 1883, ss. 27, 116.

† *Ibid.* s. 17, sub-s. 2.

‡ *Ibid.* s. 16.

for the time being: Provided always, that a transcript of such letters shall, so soon after the sealing of the same and in such manner as the commissioners shall direct, be transmitted to the Director of Chancery in Scotland, and be recorded in the records of Chancery in Scotland, upon payment of such fees as the commissioners shall appoint, in the same manner and to the same effect in all respects as letters patent passing under the Seal appointed by the Treaty of Union to be used in place of the Great Seal of Scotland have heretofore been recorded,* and extracts from the said records shall be furnished to all parties requiring the same, on payment of such fees as the commissioners shall direct, and shall be received in evidence in all courts in Scotland to the like effect as the letters patent themselves (*f*).

No letters patent to be issued after three months from date of warrant.

19. Provided always, that no letters patent, save as hereinafter mentioned in the case of letters patent destroyed or lost, shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent within three months after the date of the said warrant.

No letters patent (except in lieu of those lost, &c.) to be issued after expiration of protection given by this Act.

20. Provided also, that no letters patent (save letters patent issued in lieu of others destroyed or lost) shall be issued or be of any force or effect unless the same be granted during the continuance of the provisional protection under this Act, or,† where a complete specification has been deposited under this Act, then unless such letters patent be granted during the continuance of the protection conferred under this Act‡ by reason of such deposit, save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of a caveat or an application to the Lord Chancellor against or in relation to the sealing of such letters patent, then such letters patent may be sealed at such time as the Lord Chancellor shall direct.

Letters patent may be granted to personal representatives of the applicant during the term of protection, or within three months after applicant's decease.

21. Provided also, that where the applicant for such letters patent dies during the continuance of the provisional protection, or the protection by reason of the deposit of a complete specification (as the case may be), such letters patent may be granted to the executors or administrators of such applicant during the continuance of such provisional or other protection,§ or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such provisional or other protection, and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such provisional or other protection.

If letters patent be destroyed or

22. Provided also, that in case any such letters patent shall be destroyed or lost, other letters patent of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the commissioners

(*f*) Under Lord Granville's and Lord Brougham's Bills, there was to be but one patent, in point of form, under the Great Seal of the United Kingdom. In pursuance, however, of the instructions of Lord Granville and the law officers, Mr. Webster inserted in his Consolidated Bill a provision that while there should be but one warrant for the whole kingdom, three transcripts should be made of the letters patent in the same form in every respect, the only difference being in the name of the country; that these should be signed by the clerk of the patents, and sealed with the Great Seal, the Seal of Scotland, and of Ireland respectively; so that there would be, as far as the inventor was concerned, but one patent, because all the proceedings would be the same up to the warrant. The warrant would be the authority for the three, but there would be the convenience of three patents for the purposes of title, and for the purpose of record at Edinburgh and Dublin.

The present section is an adaptation, with modifications, of these provisions.

As to patents for the colonies, see *supra*, p. 542.

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* Compare Patents Act, 1883, s. 100.

† *Ibid.* s. 12. Cp. *Re Johnson's Patent*, *Re Somerset and Walker's Patent*, 1879, L. R. 13 Ch. D. 397, 398, n.

‡ *Ibid.* s. 37.

§ *Ibid.* s. 34.

may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

Letters patent may be issued.

23. It shall be lawful (the Act of the eighteenth year of King Henry the Sixth, chapter one, or any other Act, to the contrary notwithstanding) to cause any letters patent to be issued in pursuance of this Act to be sealed and bear date as of the day of the application for the same, and in case of such letters patent for any invention provisionally registered under the "Protection of Inventions Act, 1851," as of the day of such provisional registration, or, where the law officer to whom the application was referred, or the Lord Chancellor, thinks fit and directs, any such letters patent as aforesaid may be sealed and bear date as of the day of the sealing of such letters patent, or of any other day between the day of such application or provisional registration and the day of such sealing.*

Letters patent may be dated as of the day of the application.

24. Any letters patent issued under this Act, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date: Provided always, that save where such letters patent are granted for any invention, in respect whereof a complete specification has been deposited upon the application for the same under this Act,* no proceeding at law or in equity shall be had upon such letters patent in respect of any infringement committed before the same were actually granted.

Letters patent where antedated to be of the same validity as if sealed on the day of the date.

25. Where, upon any application made after the passing of this Act, letters patent are granted in the United Kingdom for or in respect of any invention first invented in any foreign country or by the subject of any foreign power or State, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in the United Kingdom, all rights and privileges under such letters patents shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any foreign country, and which shall be granted in the said United Kingdom after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity (*g*).

Letters patent obtained in United Kingdom for patented foreign inventions not to continue in force after the expiration of the foreign patent.

(*g*) The section seems to have been framed with a view to prevent, in some degree, manufacturers in this country paying patent dues from which their foreign competitors were exempt. The logical conclusion would be, however, that no patent should be valid in the United Kingdom, unless the invention be also patented in every other country in the world.

This section was not re-enacted in form or substance in the Act of 1883.

It exposed foreign inventors to a special disability, and also English inventors who make their invention abroad and patented it in some foreign country before taking out the British patent.

The section has been very widely adopted in substance by various other countries of the world, and consequently it was desirable to telegraph all over the world that the patents might bear the same date, by applying everywhere on the same day. This necessity has been considerably lessened by the International Convention, whereby patents may be ante-dated to the date of the country where patents first obtained, provided that country be one of the signatories to the Convention.

The general effect of the section and of the similar enactments of other countries, was to discourage English inventors from taking out foreign

* Compare Patents Act, 1883, s. 13.

Letters patent not to prevent the use of inventions in foreign ships resorting to British ports; except ships of foreign states in whose ports British ships are prevented from using foreign inventions.

26. No letters patent for any invention (granted after the passing of this Act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of her Majesty's dominions, or in any of the waters within the jurisdiction of any of Her Majesty's Courts, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from Her Majesty's dominions: Provided always, that this enactment shall not extend to the ships or vessels of any foreign State of which the laws authorize subjects of such foreign State, having patents or like privileges for the exclusive use or exercise of inventions* within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels, while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign state.

Specifications to be filed instead of being enrolled.

27. All letters patent to be granted under this Act (save only letters patent granted after the filing of a complete specification) shall require the specification thereunder to be filed in the High Court of Chancery, instead of requiring the same to be enrolled, and no enrolment shall be requisite.

Specifications, &c., to be filed in such office as Lord Chancellor shall direct.

28. Every specification to be filed in pursuance of the condition of any letters patent shall be filed in such office of the Court of Chancery as the Lord Chancellor shall from time to time appoint, and every provisional specification and complete specification left or filed at the office of the commissioners on the application for any letters patent shall forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such application, be transferred to and kept in the said office appointed for filing specifications in Chancery: [*and in case reference is made to drawings in any specification deposited or filed under this Act, an extra copy of such drawings shall be left with such specification* (*g*)].

As to filing extra copies of drawings.

Copies of specifications to be open to inspection at office of Commissioners, and at Edinburgh and Dublin.

29. The commissioners shall cause true copies of all specifications (other than provisional specifications), disclaimers and memoranda of alterations filed under or in pursuance of this Act, and of all provisional specifications after the term of the provisional protection of the invention has expired, to be open to the inspection of the public at the office of the commissioners, and at an office in Edinburgh and Dublin respectively, at all reasonable times, subject to such regulations as the commissioners may direct; and the commissioners shall cause a transcript of the said letters patent to be transmitted for enrolment in the Court of Chancery, Dublin, and shall cause the same to be enrolled therein, and the transcript or exemplification thenceforward shall have the like effect to all intents and purposes as if the original letters patent had been enrolled in the Court of Chancery in Dublin, and all parties shall have all their remedies by scire facias or otherwise, as if the letters patent had been granted to extend to Ireland only (*h*).

patents; so that the apparent wish of the Legislature to protect English manufacturers against paying patent dues from which foreign manufacturers were free, was curiously falsified.

For an interesting paper, by Mr. W. Carpmael, and discussion on this subject and the meaning of the words "expiration or sooner determination," see Trans. Inst. P. A. Vol. 1, pp. 57 *et seq.* Cp. also *Hulse* v. *Robertson*, 1876, L. R. 4 Ch. D. 9; 46 L. J. Ch. 1.

(*g*) Repealed by 16 & 17 Vict. c. 115, s. 1.

(*h*) The evil which this section was intended to remedy was the imperfect means, enjoyed by the public, of inspecting specifications. It seems that there was no legal right, enforceable by action, to obtain such inspection; and although the practice was to permit it upon payment of a fee, the public were not, prior to 1838, allowed to make copies or abstracts; a patentee was not even permitted to make an extract from his own specification. The statute 1 & 2 Vict. c. 94, s. 12, however, which

* Compare Patents Act, 1883, s. 43.

Specifications and other documents to be printed and published.

30. The commissioners shall cause to be printed,* published and sold, at such prices and in such manner as they may think fit, all specifications, disclaimers and memoranda of alterations deposited or filed under this Act, and such specifications (not being provisional specifications), disclaimers and memoranda respectively shall be so printed and published as soon as conveniently may be after the filing thereof respectively, and all such provisional specifications shall be so printed and published as soon as conveniently may be after the expiration of the provisional protection obtained in respect thereof; and it shall be lawful for the commissioners to present copies of all such publications to such public libraries and museums as they may think fit, and to allow the person depositing or filing any such specification, disclaimer or memorandum of alteration to have such number, not exceeding twenty-five, of the copies thereof so printed and published, without any payment for the same, as they may think fit (*i*).

As to presenting copies of publications to public libraries, &c.

Enrolments, &c. may be removed to the office for specifications.

31. It shall be lawful for the Lord Chancellor and the Master of the Rolls to direct the enrolment of specifications, disclaimers and memoranda of alterations heretofore or hereafter enrolled or deposited at the Rolls Chapel Office, or at the Petty Bag Office, or at the Enrolment Office of the Court of Chancery, or in the custody of the Master of the Rolls as keeper of the public records, to be transferred to and kept in the office appointed for filing specifications in Chancery under this Act (*j*).

received the royal assent on 14th August, 1838, enabled the Master of the Rolls, or Deputy Keeper of the Records, to allow copies to be made of any records in his custody, at the request and cost of any person desirous of procuring the same. Under this provision Lord Langdale, M. R., opened the Rolls Chapel and allowed the public to consult the specifications on payment of one shilling, and to take extracts in pencil. Although this was, so far as it went, a most beneficial arrangement for the public, the moment it was made parties interested in increasing the expense in requiring office copies to be made, in making drawings for those office copies, and in the extensive ratification of such interests, had such an influence with the patentees, and control over the specifications, that three-fourths of the specifications ceased to be enrolled at the Rolls Chapel, where the public would have the benefit of *consulting and copying them*, and were taken to the Enrolment Office and to the Petty Bag Office, at neither of which persons could copy them or make a single extract in writing. Another difficulty arose from the fact that at the Rolls Chapel and the Petty Bag Office, specifications were enrolled along with surrenders, deeds, and other instruments. All specifications, however, enrolled since the 1st January, 1849, were, owing to an alteration introduced by Lord Langdale, M. R., enrolled in the Enrolment Office.

(*i*) Under this section, which appeared in substance in each of the three Patent Law Amendment Bills, the commissioners were required to cause all specifications, *i. e.*, the old specifications, to be printed as soon as they were able; all subsequent specifications were to be printed forthwith; and the patentee was to have twenty-five copies of his printed specification gratis; this proviso appeared only in Mr. Webster's Bill, and the object was to give the patentee some consideration for the 5*l.* which he paid on filing his specification, the printing of which was assumed to cost about 3*l.*

(*j*) The enrolment of specifications dates no further back than about the year 1712, when it became the custom to insert a proviso into all patents, obliging the patentee to execute a complete specification of the invention for which the patent was granted, and also to enrol the same in the Court of Chancery, *within a specified time after the* date of the patent. The authority by which this clause was introduced does not appear, and was not, at least, parliamentary. Specifications afterwards came to be, and before 1st January, 1849, were, enrolled at the option of the patentee in any one of the three offices mentioned in the present section; and a person desirous of finding out a particular specification had no means of knowing to which office he ought to go.

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* Compare Patents Act, 1853, s. 40.

† *Ibid.* s. 101, sub-s. 1 (f).

Commissioners to cause indexes to be made to old specifications, &c.; such specifications, &c. may be printed and published.

32. The commissioners shall cause indexes* to all specifications, disclaimers and memoranda of alterations heretofore or to be hereafter enrolled or deposited as last aforesaid to be prepared in such form as they may think fit, and such indexes shall be open to the inspection of the public at such place or places as the commissioners shall appoint, and subject to the regulations to be made by the commissioners, and the commissioners may cause all or any of such indexes, specifications, disclaimers and memoranda of alterations to be printed, published and sold in such manner and at such prices as the commissioners may think fit (*k*).

Copies of specifications, &c. as printed by Queen's printers to be evidence.

33. [*Copies, printed by the printers to the Queen's Majesty, of specifications, disclaimers and memoranda of alterations shall be admissible in evidence, and deemed and taken to be primâ facie evidence of the existence and contents of the documents to which they purport to relate in all Courts and in all proceedings relating to letters patent* (*l*).]

Register of patents to be kept.

34. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books, to be called "The Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit or filing of specifications, disclaimers and memoranda of alterations filed in respect of such letters patent,† all amendments in such letters patents and specifications, all confirmations and extensions of such letters patent, the expiry, vacating or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the commissioners may direct, and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the commissioners may make.

A register of proprietors to be kept at the office for filing specifications.

35. There shall be kept at the office appointed for filing specifications in Chancery under this Act a book or books, entitled "the Register of Proprietors," wherein shall be entered, in such manner as the commissioners shall direct, the assignment of any letters patent, or any share or interest therein, any licence under letters patent, and the district to which such licence relates, with the name or names of any person having any share or interest in such letters patent or licence, the date of his or their acquiring such letters patent, share and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or licence; and a copy† of any entry in such book, certified under such seal as may have been ap-

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(*k*) Prior to this Act, the only indices of specifications were those published in the Repertory of Arts—the history and character of which are sketched by Mr. Wyatt, its editor and proprietor, in his evidence before the Select Committee of 1829 (p. 163)—and other journals, and in the three offices mentioned in sect. 31. The publication of specifications by private individuals was irregular and incomplete, and it was alleged that influence was sometimes brought to bear upon such persons by patentees to prevent the publication of their specifications. The official indices were incomplete and ill-arranged.

(*l*) Repealed by 16 & 17 Vict. c. 115, s. 1. The old law was that the original specification, which was returned to the patentee after enrolment, was not admissible in evidence; and as the Masters of the Rolls, after the time of Sir John Leach, refused to allow the original rolls of Court to be taken out for production, an office copy of the specification, compared with the record, was necessary, and the expense of the examined office copy was sometimes very serious. It was also necessary that the copyer, or some official from the office when the specification was enrolled, should attend as a witness to prove its authenticity. If the enrolment, however, was in the Rolls Chapel, which was a branch of the public Record Office, established by 1 & 2 Vict. c. 94, then under sect. 13 of that statute, a copy certified by the Deputy Keeper of the Records, or one of the assistant Record Keepers, and purporting to be sealed or stamped with the seal of the Record Office, was made evidence without further or other proof.

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* Compare Patents Act, 1883, s. 40.

† *Ibid.* ss. 23, 87.

pointed or as may be directed by the Lord Chancellor to be used in the said office, shall be given to any person requiring the same, on payment of the fees hereinafter provided; and such copies so certified shall be received in evidence in all Courts and in all proceedings, and shall be primâ facie proof of the assignment of such letters patent, or share or interest therein, or of the licence or proprietorship, as therein expressed: provided always, that until such entry shall have been made the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licences and privileges thereby given and granted; that certified duplicates of all entries made in the said register of proprietors shall forthwith be transmitted to the office of the commissioners in Edinburgh and Dublin, where the same shall also be open to the inspection of the public; and any writ of scire facias to repeal such letters patent may be issued to the sheriff of the county or counties in which the grantee or grantees resided at the time when the said letters patent were granted; and in case such grantee or grantees do not reside in the United Kingdom it shall be sufficient to file such writ in the Petty Bag Office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees; and such register or a copy shall be open to the inspection of the public at the office of the commissioners, subject to such regulations as the commissioners may make; provided always, that, in any proceeding in Scotland to repeal any letters patent, service of all writs and summonses shall be made according to the existing forms and practice; provided also, that the grantee or grantees of letters patent to be hereafter granted may assign the letters patent for England, Scotland or Ireland respectively as effectually as if the letters patent had been originally granted to extend to England or Scotland or Ireland only, and the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits as he or they should and would have had and been subject to upon the assignment of letters patent granted to England, Ireland or Scotland before the passing of this Act (*m*).

Power for more than twelve persons to have a legal interest in letters patent.

36. Notwithstanding any proviso that may exist in former letters patent, it shall be lawful for a larger number than twelve persons hereafter to have a legal and beneficial interest in such letters patent (*n*).

Falsification or forgery of entries a misdemeanor.

37. If any person shall wilfully make or cause to be made any false entry in the said register of proprietors, or shall wilfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause to be produced or tendered, in evidence any such writing, knowing the same to be false or forged,* he shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.

(*m*) This section corresponds to clause 19 of the Consolidated Bill. No evidence was taken before the Select Committee of 1851 upon the subject: but the difficulty of knowing in whom patents were vested in the event of proceedings by *scire facias* was felt by patentees generally.

(*n*) Soon after the Statute of Monopolies was passed, a limitation was inserted in letters patent of the number of persons who might be interested in a patent, to five; afterwards the number was increased to twelve. It was supposed that a large and powerful body would take advantage of having the monopoly of an invention to refuse to grant licences to any other manufacturer, and so obtain the whole monopoly of the manufacture in which they were engaged for the term of years during which the protection lasted. This argument, however, belonged to the notions of political economy prevalent in the reign of James I., and for some time afterwards, and was disregarded by the Legislature itself, private Acts being frequently passed to allow joint stock companies to purchase patents, notwithstanding the clause of limitation.

* Compare Patents Act, 1883, s. 93.

Entries may be expunged.

38. If any person should deem himself aggrieved by any entry made under colour of this Act in the said register of proprietors, it shall be lawful for such person to apply, by motion, to the Master of the Rolls or to any of the Courts of Common Law at Westminster in term time, or by summons to a judge of any of the said Courts in vacation, for an order that such entry may be expunged, vacated or varied; and upon any such application the Master of the Rolls, or such Court or judge respectively, may make such order for expunging, vacating or varying such entry, and as to the costs of such application, as to the said Master of the Rolls or to such Court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order for expunging, vacating or varying any such entry, shall expunge, vacate or vary the same, according to the requisitions of such order (*o*).

Provisions of 5 & 6 Will. 4, c. 83, and of 7 & 8 Vict. c. 69, as to disclaimers and memoranda of alterations to apply to patents under this Act.

39. All the provisions of the Acts of the session holden in the fifth and sixth years of King William the Fourth, chapter eighty-three, and of the session holden in the seventh and eighth years of her Majesty, chapter sixty-nine, respectively, relating to disclaimers and memoranda of alterations in letters patent and specifications, except as hereinafter provided, shall be applicable and apply to any letters patent granted, and to any specification filed under the provisions of this Act: provided always, that all applications for leave to enter a disclaimer or memorandum of alteration shall be made, and all caveats relating thereto shall be lodged at the office of the commissioners (*p*),† and shall be referred to the respective law officers in the said first-recited Act mentioned: provided also, that every such disclaimer or memorandum of alteration shall be filed in the office appointed for filing specifications in Chancery under this Act, with the specification to which the same relates, in lieu of being entered or filed and enrolled as required by the said first-recited Act, or by the Act of the session holden in the twelfth and thirteenth years of her Majesty, chapter one hundred and nine, and the said Acts shall be construed accordingly: provided also, that such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officer in the first-recited Act mentioned, certified as therein mentioned, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the said Acts and this Act; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: provided also, that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the law officer shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration.

Applications for disclaimers and caveats to be at office of Commissioners.

(*o*) These sections correspond to clauses 20 and 21 of the Consolidated Bill, and were framed on the analogy of the Copyright Acts.

(*p*) This clause corresponds to a clause in sect. 22 of the Consolidated Bill. It provides for caveats being entered at one office, instead of, as before, at six offices.

The clause goes on to provide that the filing of any disclaimer should be deemed to be an enrolling, and that the fiat of the law officer should be conclusive upon the right of the party to enter the disclaimer, except in cases of fraud. Many questions had arisen where it appeared that parties were interested in a patent all of whom had not concurred in the petition or signed the disclaimer. It was therefore deemed important that the fiat of the Attorney-General should be conclusive upon all questions of form of that kind.

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* Compare Patents Act, 1883, ss. 90, 91.

† *Ibid.* ss. 18—20.

Provisions of 5 & 6 Will. 4, c. 83, 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, as to confirmation and prolongation, to apply to patents under this Act.

40. All the provisions of the said Act of the fifth and sixth years of King William the Fourth, for the confirmation of any letters patent, and the grant of new letters patent, and all the provisions of the said Act, and of the Acts of the session holden in the second and third years of her Majesty, chapter sixty-seven, and of the session holden in the seventh and eighth years of her Majesty, chapter sixty-nine, respectively, relating to the prolongation of the term of letters patent, and to the grant of new letters patent for a further term, shall extend and apply to any letters patent granted under the provisions of this Act, and it shall be lawful for her Majesty to grant any new letters patent, as in the said Acts mentioned; and in the granting of any such new letters patent, her Majesty's Order in Council shall be a sufficient warrant and authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions and provisions in the said order mentioned; and the Lord Chancellor, on the receipt of the said Order in Council, shall cause letters patent,* according to the tenor and effect of such order, to be made and sealed in the manner herein directed for letters patent issued under the warrant of the law officer: provided always, that such new letters patent shall extend to and be available in and for such places as the original letters patent extended to and were available in: provided also, that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire (*q*).

In actions for infringement of letters patent, particulars to be delivered, and no evidence allowed not mentioned therein.

41. In any action in any of her Majesty's Superior Courts of Record at Westminster or in Dublin for the infringement of letters patent, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant, on pleading thereto, shall deliver with his pleas, and the prosecutor in any proceedings by scire facias to repeal† letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action or of the suggestions of the said declaration in the proceedings by scire facias respectively; and at the trial of such action or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid: provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit: provided also, that at the trial of any proceeding by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent, and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply (*r*).

(*q*) This section corresponds to clause 23 of the Consolidated Bill. Previously, if the Privy Council recommended the extension of a patent, all the fees had to be paid over again. It was provided, therefore, that the Order in Council for the extension of a patent should be a sufficient warrant for the sealing of a new grant, so that no fee was payable upon it, except the last fee of 5*l.* for sealing the letters patent.

(*r*) This section reproduces the 24th clause of the Consolidated Bill, and was inserted in that measure in consequence of a suggestion by Lord Cranworth. It introduced a new principle that the plaintiff should be required to give particulars of breaches. The declarations were in a general form; and it often happened that great expense was thrown on the defendants, owing to their not having some information as to the grounds of complaint.

* Compare Patents Act, 1883, s. 25.

† *Ibid.* s. 29.

Courts of common law may grant injunction in case of infringement.

42. In any action in any of her Majesty's Superior Courts of Record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not sitting then for a judge of such Court,* on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection or account, and to give such direction respecting such action, injunction, inspection and account, and the proceedings therein respectively, as to such Court or judge may seem fit.

Particulars to be regarded in taxation of costs.

43. In taxing the costs in any action in any of her Majesty's Superior Courts at Westminster or in Dublin, commenced after the passing of this Act for infringing letters patent, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particulars unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of the letters patent in the declaration mentioned came in question; and the record, with such certificate, being given in evidence in any suit or action for infringing the said letters† patent, or in any proceeding by scire facias to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by scire facias on obtaining a decree, decretal order or final judgment, to his full costs, charges and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs: provided always, that nothing herein contained shall affect the jurisdiction and forms of process of the Courts in Scotland in any action for the infringement of letters patent or in any action or proceeding respecting letters patent hitherto competent to the said Courts: provided also, that when any proceedings shall require to be taken in Scotland to repeal any letters patent, such proceedings shall be taken in the form of an action of reduction at the instance of her Majesty's Advocate, or at the instance of any other party having interest with concurrence of her Majesty's Advocate, which concurrence her Majesty's Advocate is authorized and empowered to give upon just cause shown only (*s*).

Payments and stamp duties on letters patent to be as in schedule.

44 (*t*). [*There shall be paid in respect of letters patent applied for or issued as herein mentioned, the filing of specifications and disclaimers, certificates, entries and searches, and other matters and things mentioned in the Schedule to this Act, such fees as are mentioned in the said Schedule;*‡ *and there shall be paid into and for the use of her Majesty, her heirs and successors, for or in respect of the warrants and certificates mentioned in the said Schedule, or the vellum, parchment or paper on which the same respectively are written, the stamp duties mentioned in the said Schedule; and no other stamp duties shall be levied, or fees, except as hereinafter mentioned, taken in respect of such letters patent and specifications, and the matters and things in such Schedule mentioned.*]

Duties to be under management of Commissioners of Inland Revenue.

45. [*The stamp duties hereby granted shall be under the care and management of the Commissioners of Inland Revenue; and the several rules, regulations, provisions, penalties, clauses a ers contained in any Act now or hereafter to be in force with reference to p duties shall be applicable thereto.*]

All monies received to be paid to the consolidated fund.

46. [*The fees to be paid as aforesaid shall from time to time be paid into the receipt of the Exchequer, and be carried to and made part of the consolidated fund of the United Kingdom.*§]

(*s*) This section reproduces the 25th clause of the Consolidated Bill.

(*t*) This and the two following sections were repealed by 16 & 17 Vict. c. 5.

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* Compare Patents Act, 1883, s. 30.
† *Ibid.* s. 29, sub-s. (6).
‡ *Ibid.* s. 24.
§ *Ibid.*

Not to prevent payment of fees to law officers in cases of opposition, &c.

47. Provided always, that nothing herein contained shall prevent the payment as heretofore to the law officers in cases of opposition to the granting of letters patent, and in cases of disclaimers and memoranda of alterations, of such fees as may be appointed by the Lord Chancellor and Master of the Rolls as the fee to be paid on the hearing of such oppositions, and in the case of disclaimers and memoranda of alterations respectively, or of such reasonable sums for office or other copies of documents in the office of the commissioners, as the commissioners may from time to time appoint to be paid for such copies, and the Lord Chancellor and Master of the Rolls, and the commissioners, are hereby respectively authorized and empowered to appoint the fees to be so paid in respect of such oppositions, disclaimers and memoranda of alterations respectively, and for such office or other copies.

Fees and salaries of officers.

48. It shall be lawful for the Commissioners of Her Majesty's Treasury from time to time to allow such fees to the law officers and their clerks (for duties under this Act in respect of which fees may not be payable to them under the provisions lastly hereinbefore contained) as the Lord Chancellor and Master of the Rolls may from time to time appoint,* and to allow such salaries and payments to any clerks and officers to be appointed under this Act, and such additional salaries and payments to any other clerks and officers in respect of any additional duties imposed on them by this Act, as the said commissioners of the Treasury may think fit.

Sums for defraying salaries and expenses under this Act to be paid out of monies to be provided by Parliament.

49. It shall be lawful for the Commissioners of Her Majesty's Treasury to allow *from* time to time *the necessary sums for providing offices* under this Act, and for the fees, salaries, and payments allowed by them as aforesaid, and for defraying the current and incidental expenses of such office or offices;† and the sums to be so allowed shall be paid out of such monies as may be provided by Parliament for that purpose.

Power to Treasury to grant compensation to persons affected by this Act.

50. And whereas divers persons by virtue of their offices or appointments are entitled to fees or charges payable in respect of letters patent as heretofore granted within the United Kingdom of Great Britain and Ireland, or have and derive in respect of such letters patent, or the procedure for the granting thereof, fees or other emoluments or advantages:

It shall be lawful for the said Commissioners of the Treasury to grant to any such persons who may sustain any loss of fees, emoluments or advantages by reason of the passing of this Act, such compensation as, having regard to the tenure and nature of their respective offices and appointments, such commissioners deem just and proper to be awarded; and all such compensations shall be paid out of such monies as may be provided by Parliament for that purpose: provided always, that in case any person to whom any yearly sum by way of compensation shall be awarded and paid shall, after the passing of this Act, be appointed to any office or place of emolument under the provisions of this Act, or in the public service, then and in every such case the amount of such yearly sum shall in every year be diminished by so much as the emoluments of such person for such year from such office or place shall amount to, and provision in that behalf shall be made in the award to him of such yearly sum.

Account of salaries, fees and compensation allowances to be laid before Parliament.

51. An account of all salaries, fees, allowances, sums and compensations to be appointed, allowed, or granted under this Act shall, within fourteen days next after the same shall be so appointed, allowed, or granted respectively,‡ be laid before both Houses of Parliament, if Parliament be then sitting, or if Parliament be not then sitting, then within fourteen days after the next meeting of Parliament.

Not to extend to patents applied for before commencement of Act.

52. Letters patent may be granted in respect of applications made before the commencement of this Act, in like manner and subject to the same provisions as if this Act had not been passed.

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* Compare Patents Act, 1883, s. 83, sub-s. 1.

† *Ibid.* s. 83, sub-s. 2.

‡ *Ibid.* s. 102.

As to letters patent granted before commencement of this Act in England, Scotland or Ireland.

53. [*Where letters patent for England or Scotland or Ireland have been granted before the commencement of this Act, or are in respect of any application made before the commencement of this Act hereafter granted for any invention, letters patent for England or Scotland or Ireland, may be granted for such invention in like manner as if this Act had not been passed: provided always, that in lieu of all the fees or payments and stamp duties now payable in respect of such letters patent, or in or about obtaining a grant thereof, there shall be paid in respect of such letters patent for England or Scotland or Ireland on the sealing of such respective letters patent a sum equal to one-third part of the fees and stamp duties which would be payable according to the Schedule to this Act in respect of letters patent issued for the United Kingdom under this Act, on or previously to the sealing of such letters patent; and at or before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England or Scotland or Ireland, sums equal to one-third part of the fees and stamp duties payable at the expiration of the third year and the seventh year respectively of the term granted by letters patent issued for the United Kingdom under this Act; and the condition of such letters patent for England or Scotland or Ireland shall be varied accordingly; and such fees shall be paid to such persons as the commissioners of her Majesty's Treasury shall appoint, and shall be carried to and form part of the said consolidated fund* (*u*).]

Forms in schedule may be used.

54. The several forms in the Schedule to this Act may be used for and in respect of the several matters therein mentioned, and the commissioners may, where they think fit, vary such forms as occasion may require, and cause to be printed and circulated such other forms as they may think fit to be used for the purposes of this Act.

Interpretation of terms.

55. In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context; (that is to say),

The expression "Lord Chancellor" shall mean the Lord Chancellor, or Lord Keeper of the Great Seal, or Lords Commissioners of the Great Seal:

The expression "the Commissioners" shall mean the commissioners for the time being acting in execution of this Act:

The expression "Law Officer" shall mean her Majesty's Attorney-General or Solicitor-General for the time being for England, or the Lord Advocate, or her Majesty's Solicitor-General for the time being for Scotland, or her Majesty's Attorney-General or Solicitor-General for the time being for Ireland: *

The expression "invention" shall mean any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the Act of the twenty-first year of the reign of King James the First, chapter three:

The expressions "Petition," "Declaration," "Provisional Specification," "Warrant," and "Letters patent" respectively, shall mean instruments in the form and to the effect in the Schedule hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this Act (*x*).

Short title.

56. In citing this Act in other Acts of Parliament, instruments and proceedings, it shall be sufficient to use the expression "The Patent Law Amendment Act, 1852."

Commencement of Act.

57. This Act shall commence and take effect from the first day of October, one thousand eight hundred and fifty-two.

(*u*) Repealed by 16 & 17 Vict. c. 5. This section corresponds to clause 12 of the Consolidated Bill, introduced to meet a suggestion made by Mr. John Duncan, Solicitor, in evidence before the Select Committee of 1851 (p. 131).

(*x*) This clause was inserted at the suggestion of Mr. Webster, in order that the Act might prescribe the forms of the proceedings as well as the practice.

* Compare Patents Act, 1883, s. 117.

The SCHEDULE to which this Act refers.

FEES TO BE PAID.

	£	s.	d.
On leaving petition for grant of letters patent - - - -	5	0	0
On notice of intention to proceed with the application - - -	5	0	0
On sealing of letters patent - - - - - - -	5	0	0
On filing specification - - - - - - - -	5	0	0
At or before the expiration of the third year - - - -	40	0	0
At or before the expiration of the seventh year - - - -	80	0	0
On leaving notice of objections - - - - - - -	2	0	0
Every search and inspection - - - - - -	0	1	0
Entry of assignment or licence - - - - - -	0	5	0
Certificate of assignment or licence - - - - - -	0	5	0
Filing application for disclaimer - - - - - -	5	0	0
Caveat against disclaimer - - - - - - - -	2	0	0

STAMP DUTIES TO BE PAID.

	£	s.	d.
On warrant of law officer for letters patent - - - - -	5	0	0
On certificate of payment of the fee payable at or before the expiration of the third year - - - - - - - -	10	0	0
On certificate of payment of the fee payable at or before the expiration of the seventh year - - - - - - - -	20	0	0

FORMS.

PETITION.

To the Queen's most excellent Majesty.

The humble petition of [*here insert name and address of petitioner*] for, &c.
Showeth,

That your petitioner is in possession of an invention for [*the title of the invention*] which invention he believes will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of his knowledge and belief.

Your petitioner therefore humbly prays, that your Majesty will be pleased to grant unto him, his executors, administrators, and assigns, your royal letters patent for the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [*colonies to be mentioned, if any*], for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray, &c.

No. DECLARATION.

I of in the county of do solemnly and sincerely declare, that I am in possession of an invention for, &c. [*the title as in petition*], which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief [*where a complete specification is to be filed with the petition and declaration, insert these words*:—"and

that the instrument in writing under my hand and seal, hereunto annexed, particularly describes and ascertains the nature of the said invention and the manner in which the same is to be performed"]; and I make this declaration conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the session of Parliament held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An Act to repeal an Act of the present session of Parliament, intituled 'An Act for the more effectual abolition of oaths and affirmations taken and made in various departments of the State, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits,' and to make other provisions for the abolition of unnecessary oaths."

A. B.

Declared at this day of A.D. before me,
A Master in Chancery,
or
Justice of the Peace.

No. PROVISIONAL SPECIFICATION.

I do hereby declare the nature of the said invention for [*insert title as in petition*] to be as follows: [*here insert description*].

Dated this day of A.D.

(*To be signed by applicant or his agent.*)

REFERENCE.

(*To be endorsed on the Petition.*)

Her Majesty is pleased to refer this petition to to consider what may be properly done therein.

——— Clerk of the Commissioners.

WARRANT.

In humble obedience to her Majesty's command referring to me the petition of of , to consider what may be properly done therein, I do hereby certify as follows: that the said petition sets forth that the petitioner [*allegations of the petition*].

And the petitioner most humbly prays [*prayer of the petition*].

That in support of the allegations contained in the said petition the declaration of the petitioner has been laid before me, whereby he solemnly declares, that [*allegations of the declaration*].

That there has also been laid before me [a provisional specification signed , and also a certificate ,] *or* [a complete specification, and a certificate of the filing thereof], whereby it appears that the said invention was provisionally protected [*or* protected] from the day of A.D. in pursuance of the statute:

That it appears that the said application was duly advertised:

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new or will have the desired success, and as it may be reasonable for her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion, that her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns, for his said invention within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [*colonies to be mentioned, if any*], for the term of fourteen years,

according to the statute in that case made and provided, if her Majesty shall be graciously pleased so to do, to the tenor and effect following [*see next Form*].

Given under my hand, this day of A.D.

(SEAL.)

LETTERS PATENT.

VICTORIA, by the Grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith; to all to whom these presents shall come, greeting: — Queen's title.

Whereas hath by his petition humbly represented unto us that he is in possession of an invention for which the petitioner conceives will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of his knowledge and belief: the petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent for the sole use, benefit, and advantage of his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [*colonies to be mentioned, if any*], for the term of fourteen years, pursuant to the statutes in that case made and provided: — Recital of petition.

[And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in :]

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: know ye, therefore, that we of our especial grace, certain knowledge, and mere motion have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, our especial licence, full power, sole privilege, and authority, that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he, the said , his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, in such manner as to him, the said , his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet; and that he, the said , his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned: to have, hold, exercise, and enjoy the said licences, powers, privileges, and advantages hereinbefore granted or mentioned to be granted unto the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of , A.D. , next and immediately ensuing, according to the statute in such case made and provided; and to the end that he, the said , his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our

Concession of prayer.

Words of grant.

Extent of grant.

Form of grant.

Prohibitory words.

United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [*colonies to be mentioned, if any*], that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the consent, licence, or agreement of the said , his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said , his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned: And moreover we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, headboroughs, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being, that they or any of them do not nor shall at any time during the said term hereby granted, in anywise molest, trouble, or hinder the said , his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use

Proviso for revocation.

or exercise of the aforesaid invention, or anything relating thereto: provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be made appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the true and first inventor thereof within this realm as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding; provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said , his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof: it being our will and pleasure that the said , his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions by them invented and found out, according to the true intent and meaning of the said respective letters patent and of these presents: provided likewise nevertheless, and these our letters

Condition as to specification.

patent are upon this express condition [that if the said shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed in within calendar months next and immediately after the date of these our letters patent]; [and also if the said instrument in writing filed as aforesaid does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed]; and also if the said , his exe-

On non-payment of stamp duty.

cutors, administrators, or assigns, shall not pay or cause to be paid at the office of our commissioners of patents for inventions the sums following, that is to say, the sum of pounds, on or before the day of , A.D. , and the stamp duty payable in respect of the certificate of such payment, and the sum of pounds on or before the day of , A.D. , and the stamp duty payable in respect of the certificate of such payment; and also if the said , his executors, administrators, or assigns,

shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same; that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted; And lastly we do by these presents, for us, our heirs and successors, grant unto the said , his executors, administrators, and assigns, that these our letters patent, or the filing thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the said , his executors, administrators, and assigns, as well in all our Courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [*colonies to be mentioned, if any*], and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent, this day of , A.D. , and to be sealed and bear date as of the said day of , A.D. , in the year of our reign.

Condition as to supplying articles for Her Majesty's service.

Power to grant licenses.

Specification.

To all to whom these presents shall come:

I, , of , send greeting:

Whereas her most excellent Majesty Queen Victoria, by her letters patent bearing date the day of , A.D. , in the year of her reign, did for herself, her heirs and successors, give and grant unto me, the said , her special licence that I, the said , my executors, administrators, and assigns, or such others as I, the said , my executors, administrators, and assigns, should at any time agree with, and no others, from time to time and at all times thereafter during the term therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [*colonies to be mentioned, if any*], an invention for [*insert title as in letters patent*] upon the condition (amongst others) that I, the said , by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in , within calendar months next and immediately after the date of the said letters patent: Now know ye that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; (that is to say) [*describe the invention*].

In witness whereof I, the said A. B., have hereto set my hand and seal this day of , A.D. .

A. B.

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16 Vict. c. 5 (*y*).

An Act to substitute Stamp Duties for Fees on passing Letters Patent for Inventions, and to provide for the Purchase for the public Use for certain Indexes of Specifications. [21st February, 1853.]

[*Repealed by Patents Act*, 1883, *s.* 113.]

15 & 16 Vict. c. 83.

Whereas it is expedient that the fees payable in respect of letters patent for inventions under the Patent Law Amendment Act, 1852, and mentioned in the schedule to such Act, be converted into stamp duties: be it enacted, therefore, by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Sects. 17, 44, 45, 46 and 53, and part of schedule of recited Act repealed.

1. Sections seventeen, forty-four, forty-five, forty-six and fifty-three of the said Patent Law Amendment Act, 1852, and so much of the schedule to the said Act as relates to fees and stamp duties to be paid under the said Act, shall be repealed.

Letters patent to be made subject to avoidance on non-payment of stamp duties expressed in schedule to this Act annexed.

2. All letters patent for inventions to be granted under the provisions of the said Patent Law Amendment Act, 1852 (except in the cases provided for in the fourth section of this Act), shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expiration of the said three years and seven years respectively, the stamp duties in the schedule to this Act annexed expressed to be payable before the expiration of the third year and of the seventh year respectively, and such letters patent, or a duplicate thereof, shall be stamped with proper stamps showing the payment of such respective stamp duties, and shall, when stamped, be produced before the expiration of such three years and seven years respectively at the office of the commissioners; and a certificate of the production of such letters patent or duplicate so stamped, specifying the date of such production, shall be indorsed by the clerk of the commissioners on the letters patent or duplicate, and a like certificate shall be indorsed upon the warrant for such letters patent filed in the said office.

Stamp duties mentioned in the schedule to this Act to be payable.

3. There shall be paid unto and for the use of her Majesty, her heirs and successors, for or in respect of letters patent applied for or issued under the provisions of the said Patent Law Amendment Act, 1852, warrants, specifications, disclaimers, certificates and entries, and other matters and things mentioned in the schedule to this Act, or the vellum, parchment or paper on which the same respectively are written, the stamp duties mentioned in the said schedule; and no other stamp duties shall be levied in respect of such letters patent, warrants, specifications, disclaimers, certificates, entries, matters and things; and the stamp duty mentioned in the said schedule on office copies of documents shall be in lieu of such sums as by the said Patent Law Amendment Act, 1852, are authorized to be appointed to be paid for such office copies.

As to payment of stamp duties on letters patent for England, Scotland or Ireland respectively.

4. Where letters patent for England or Scotland or Ireland have been granted before the commencement of the said Patent Law Amendment Act, 1852, or have been, since the commencement of the said Act, or hereafter may be granted for any invention, in respect of any application made before the commencement of the said Act, letters patent for England or Scotland or Ireland may be granted for such invention in like manner as if the said Act had not been passed: provided always, that in lieu of all fees or payments and stamp duties which were at the time of the passing of the said Act payable in respect of such letters patent as last aforesaid, or in or about

(*y*) This Act substituted stamp duties for fees on passing letters patent for inventions (sects. 1—7), and enabled the commissioners to purchase the indices of specifications prepared by Mr. Bennett Woodcroft. (Sect. 8.) See his evidence before the Select Committee of 1851, p. 220.

obtaining a grant thereof, and in lieu of all other stamp duties whatsoever, there shall be paid in respect of such letters patent as last aforesaid on the sealing thereof stamp duties equal to one third part of the stamp duties which would be payable under this Act in respect of letters patent issued for the United Kingdom under the said Patent Law Amendment Act, 1852, on or previously to the sealing of such letters patent as last aforesaid, and before the expiration of the third year and the seventh year respectively of the term granted by such letters patent for England, Scotland or Ireland, stamp duties equal to one third part of the stamp duties payable under this Act before the expiration of the third year and the seventh year respectively of the term granted by letters patent issued for the United Kingdom under the said Patent Law Amendment Act, 1852, and the condition of such letters patent for England or Scotland or Ireland shall be varied accordingly.

Duties to be under the management of the Commissioners of Inland Revenue;

5. The stamp duties hereby granted shall be under the care and management of the Commissioners of Inland Revenue; and the several rules, regulations, provisions, penalties, clauses and matters contained in any Act now or hereafter to be in force with reference to stamp duties shall be applicable thereto.

who are to provide the proper stamps for the purpose.

6. The said Commissioners of Inland Revenue shall prepare stamps impressed upon adhesive paper, of the amounts following, that is to say, two-pence, four-pence, eight-pence and one shilling, to be used only in respect of the stamp duties on the office copies of documents and on the certificates of searches and inspections mentioned in the schedule to this Act; such adhesive stamps of proper amounts to be affixed by the clerk of the Commissioners of Patents for inventions to such office copies of documents and certificates of searches and inspections as aforesaid; and immediately after such affixing he shall obliterate or deface such stamps by impressing thereon a seal to be provided for that purpose, but so as not to prevent the amount of the stamp from being ascertained; and no such office copy or certificate shall be delivered out until the stamps thereon shall be obliterated or defaced as aforesaid.

Conditions of letters patent already granted under recited Act to be satisfied by payment of stamp duties, &c., under this Act.

7. The condition contained in any letters patent granted under the said Patent Law Amendment Act, 1852, and before the passing of this Act, for making such letters patent void at the expiration of three years and seven years respectively from the date thereof, unless there be paid, before the expiration of the said three years and seven years respectively, the sums of money and stamp duties by the said Patent Law Amendment Act, 1852, required in this behalf, shall be deemed to be satisfied and complied with by payment of the like stamp duties as would have been required if such letters patent had been granted after the passing of this Act, and had been made subject to the condition required by this Act in lieu of the said condition therein contained; and the provision hereinbefore contained concerning the endorsement on the letters patent or duplicate, and on the warrant for the same letters patent, of a certificate of the production of the letters patent or duplicate properly stamped, shall be applicable in the case of such letters patent granted before the passing of this Act.

Power to commissioners to purchase the indexes of existing specifications prepared by Mr. Woodcroft.

8. And whereas by the said Patent Law Amendment Act, 1852, the commissioners are directed to cause indexes to all specifications heretofore or hereafter to be enrolled or deposited to be prepared in such form as they may think fit, which indexes are to be open to the inspection of the public: and whereas the existing specifications so directed to be indexed as aforesaid are in number fifteen thousand and upwards, and it would require some years to make indexes thereof on a proper arrangement and classification: and whereas Mr. Bennett Woodcroft has already made complete indexes of such specifications, which the commissioners have examined and approved of, and it is expedient that such indexes be purchased for the use of the public:

It shall be lawful for the commissioners, with the consent of the commissioners of her Majesty's Treasury, to purchase the said indexes of the said Bennett Woodcroft for a sum not exceeding one thousand pounds, and to pay the purchase-money for the same out of the monies in their hands which

have arisen from fees received in respect of letters patent under the said Patent Law Amendment Act, 1852, and directed by the said Act to be paid into the receipt of the Exchequer; and after the purchase of such indexes the provisions of the said Act shall be applicable thereto as if such indexes had been prepared under the said recited enactment.

As to the word "duplicate."

9. The word "duplicate" shall be construed to mean in this Act such letters patent as may be issued under the twenty-second section of the Patent Law Amendment Act, 1852, in case of any letters patent being destroyed or lost.

This Act, and 15 & 16 Vict. c. 83, to be construed together.

10. This Act and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

The SCHEDULE of Stamp Duties to be paid to which this Act refers.

	£	s.	d.
On petition for grant of letters patent - - - - -	5	0	0
On certificate of record of notice to proceed - - - -	5	0	0
On warrant of law officer for letters patent - - - -	5	0	0
On the sealing of letters patent - - - - - - -	5	0	0
On specification - - - - - - - - -	5	0	0
On the letters patent, or a duplicate thereof, before the expiration of the third year - - - - - - - - -	50	0	0
On the letters patent, or a duplicate thereof, before the expiration of the seventh year - - - - - - - -	100	0	0
On certificate of record of notice of objections - - - -	2	0	0
On certificate of every search and inspection - - - -	0	1	0
On certificate of entry of assignment or licence - - - -	0	5	0
On certificate of assignment or licence - - - - -	0	5	0
On application for disclaimer - - - - - - -	5	0	0
On caveat against disclaimer - - - - - - -	2	0	0
On office copies of documents, for every ninety words - -	0	0	2

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16 & 17 Vict. c. 115 (z).

An Act to amend certain Provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified Copies of Letters Patent and Specifications to certain Offices in Edinburgh and Dublin, and otherwise to amend the said Act. [20th August, 1853.]

[*Repealed by Patents Act*, 1883, s. 113.]

15 & 16 Vict. c. 83.

Whereas it is expedient to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of

(z) The provisions of this Act were:—(1) copies of provisional specifications were to be open to inspection at the commissioners' office (sect. 2); (2) a copy of every specification, provisional or complete, under the hand of the patentee or applicant, was to be left at the commissioners' office (sect. 3); (3) copies or extracts of letters patent, &c., certified, sealed, and filed at the commissioners' office, were to be receivable in evidence in the Courts of every country to which the patent right extended (sect. 4); (4) certified printed copies of specifications, &c., under the seal of the commissioners, were to be transmitted to the Director of Chancery in Scotland, and to the Enrolment Office of the Court of Chancery in Ireland (sect. 5); (5, in cases of accidental delay, the Lord Chancellor might extend (by a period not exceeding one month) the time for filing the provisional specification. This section affirmed a power previously existing, and exercised by Cranworth, L. C., in *Re Simpson and Isaac's Patent*, 1853, 21 L. T. 81; (6) sect. 40 of 15 & 16 Vict. c. 83, was declared to apply to the making and sealing of new letters patent for a further term (sect. 7). See now Act of 1883, s. 100.

letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act: Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Sect. 33 and part of sect. 28 of recited Act repealed.

1. Section thirty-three of the said Act, and such part of section twenty-eight of the said Act as directs that in case reference is made to drawings in any specification deposited or filed under the said Act an extra copy of such drawings should be left with such specification, shall be repealed.

Copies of provisional specifications to be open to inspection at the commissioners' office.

2. The commissioners shall cause true copies of all provisional specifications left at the office of the commissioners to be open to the inspection of the public, at such times, after the date of the record thereof respectively, as the commissioners shall by their order from time to time direct.

A copy of every specification, &c., under the hand of the patentee or applicant, to be left at commissioners' office.

3. A true copy, under the hand of the patentee or applicant, or agent of the patentee or applicant, of every specification and of every complete specification, with the drawings accompanying the same, if any, shall be left at the office of the commissioners on filing such specification or complete specification.

Copies or extracts of letters patent, &c., certified and sealed, filed at commissioners' office, to be received in evidence.

4. Printed or manuscript copies or extracts, certified and sealed with the seal of the commissioners, of letters patent, specifications, disclaimers, memoranda of alterations, and all other documents recorded and filed in the Commissioners' Office, or in the office of the Court of Chancery appointed for the filing of specifications, shall be received in evidence in all proceedings relating to letters patent for inventions in all Courts whatsoever within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and her Majesty's colonies and plantations abroad, without further proof or production of the originals.

Certified printed copies of specifications, &c., under seal of commissioners, to be transmitted to the Director of Chancery in Scotland, and to the Court of Chancery in Ireland, which shall be evidence, without production of originals.

5. Certified printed copies, under the seal of the commissioners, of all specifications and complete specifications, and fac-simile printed copies of the drawings accompanying the same, if any, disclaimers and memoranda of alterations filed or hereafter to be filed under the said Patent Law Amendment Act, shall be transmitted to the Office of the Director of Chancery in Scotland and to the Enrolment Office of the Court of Chancery in Ireland within twenty-one days after the filing thereof respectively, and the same shall be filed in the Office of Chancery in Scotland and Ireland respectively, and certified copies or extracts from such documents shall be furnished to all persons requiring the same, on payment of such fees as the commissioners shall direct; and such copies or extracts shall be received in evidence in all Courts in Scotland and in Ireland respectively in all proceedings relating to letters patent for inventions, without further proof or production of the originals.

Lord Chancellor, in certain cases, may seal letters patent after the expiration of provisional protection.

6. Where letters patent have not been sealed during the continuance of the provisional protection on which the same is granted, provided the delay in such sealing has arisen from accident, and not from the neglect or wilful default of the applicant, it shall be lawful for the Lord Chancellor, if he shall think fit, to seal such letters patent at any time after the expiration of such provisional protection, whether such expiration has happened before or shall happen after the passing of this Act, and to date the sealing thereof as of any day before the expiration of such provisional protection, and also to extend the time for the filing of the specification thereon; and where the specification, in pursuance of the condition of any letters patent, has not been filed within the time limited by such letters patent, provided the delay in such filing has arisen from accident, and not from the neglect or wilful default of the patentee, it shall be lawful for the Lord Chancellor, if he shall think fit, to extend the time for the filing of such specification, whether the default in such filing has happened before or shall happen after the passing of this Act: Provided always, that, except in any case that may have arisen before the passing of this Act, it shall not be lawful for the Lord Chancellor to extend the time for the sealing of any letters patent, or for the filing of any specification, beyond the period of one month.

Removing doubts as to provisions of 15 & 16 Vict. c. 83, respecting the making and sealing of new letters patent for a further term.

7. And whereas doubts have arisen whether the provision of the Patent Law Amendment Act, 1852, for the making and sealing new letters patent for a further term, in pursuance of her Majesty's Order in Council, in the cases mentioned in section forty of the said Act, extends to the making and sealing of new letters patent in the manner by such Act directed, where such new letters patent are granted by way of prolongation of the term of letters patent issued before the commencement of the said Act: And whereas it is expedient that such new letters patent granted by way of prolongation shall be granted according to the provisions of the said Patent Law Amendment Act: Be it declared and enacted, that where her Majesty's Order of Council for the sealing of new letters patent shall have been made after the commencement of the said Act, the said provision of the said Act for making and sealing in manner aforesaid of new letters patent shall extend, and shall as from the commencement of the said Act be deemed to have extended, to the making and sealing in manner aforesaid of new letters patent for a further term, as well where the original letters patent were made before as where such original letters patent have been issued since the commencement of the said Act.

15 & 16 Vict. c. 83, and this Act, to be construed as one Act.

8. This Act and the Patent Law Amendment Act, 1852, shall be construed together as one Act.

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22 Vict. c. 13 (*a*).

An Act to amend the Law concerning Patents for Inventions with respect to Inventions for improvements in Instruments and Munitions of War.

[8th of April, 1859.]

[*Repealed by Patents Act*, 1883, *sect.* 113.]

Whereas in some cases of inventions for improvements in instruments or munitions of war it may be important to the public service that the nature of the invention should not be published, and it is therefore expedient to amend the law concerning letters patent for inventions: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Improvements in instruments or munitions of war may be assigned by inventors to Secretary of State for War.

1. Any inventor of any improvement in instruments or munitions of war, or the executors, administrators, or assigns of such inventor, may, for valuable consideration or without, assign to her Majesty's principal Secretary of State for the War Department, on behalf of her Majesty, all the benefits of the invention, and of all letters patent obtained or to be obtained for the same, and such Secretary of State may be a party to the assignment, and such assignment shall be effectual to vest the benefit of such invention and of such letters patent in the said Secretary of State for the time being on behalf of her Majesty at law and in equity; and the benefit of such invention and of such letters patent shall be deemed property acquired by the said Secretary of State on behalf of her Majesty; and all covenants and agreements contained in such assignment for giving full effect thereto, and for keeping the invention secret, and otherwise in relation thereto, shall be valid and effectual (notwithstanding any want of valuable consideration), and may

(*a*) Under this statute, improvements in instruments or munitions of war might be assigned by the inventor to the Secretary of State for War, who might certify to the commissioners of patents that the invention should be kept secret. The petition for letters patent, and the specification, and all documents relating to the invention were left with the clerk of patents under the seal of the Secretary of State, to whom, at the end of the term, the letters patent were to be delivered up. See Act of 1883, s. 44, *supra*.

be enforced and proceeded upon by the said Secretary of State for the time being accordingly, and all actions, suits, and proceedings in relation thereto may be instituted and conducted by such Secretary of State for the time being, who shall have all such rights, privileges, and prerogatives in relation thereto as by law provided in the case of actions, suits, and proceedings concerning property under his care, control, and disposition.

Foregoing enactment to extend to assignments already made.

2. The foregoing enactment shall extend to render valid and effectual, and be otherwise applicable to and in respect of, any such assignment as aforesaid made before the passing of this Act, and the covenants and agreements contained in such assignment, as well as any such assignment to be made thereafter, and the covenants and agreements therein contained.

Secretary of State for War may certify to Commissioners of Patents that the invention should be kept secret.

3. Where any such assignment as aforesaid has been made to the said Secretary of State, he may at any time before the filing of the petition for the grant of letters patent for the invention, or after the filing of such petition and before publication of the provisional specification (if any), if he think it fit for the benefit of the public service that the particulars of the invention, and of the manner in which the same is performed, should be kept secret, certify the fact of such assignment having been so made, and his opinion to the effect aforesaid in writing under his hand to the commissioners of patents for inventions.

Where the Secretary of State for War has so certified, petition for letters patent, &c. to be left with the clerk of the patents in a packet under the seal of Secretary of State.

4. Where the said Secretary of State certifies as aforesaid, the petition for letters patent for the invention, the declaration accompanying such petition, and the provisional specification or complete specification (as the case may be), filed or left therewith, and any specification to be filed in pursuance of the condition of any letters patent for such invention, and all disclaimers and memoranda of alterations to be filed in relation to such letters patent, and any drawings accompanying any of the documents aforesaid, and any copies of any such documents or drawings, or where the said Secretary of State so certifies after the said petition has been filed, such of the said documents and drawings as may be filed after his so certifying, and the copies thereof, shall, in lieu of being filed or left in the ordinary manner in the office of the commissioners, or in the office appointed for that purpose under "the Patent Law Amendment Act, 1854," be delivered to the clerk of the patents in a packet sealed with the seal of the said Secretary of State.

Such packet to be kept so sealed or under the seal of the commissioners.

Such sealed packet to be delivered on demand to Secretary of State or by order of the Lord Chancellor.

5. Such packet shall at all times after the delivery thereof to the clerk of the patents until the expiration of the term or any extended term for which letters patent for the invention may be granted, be kept by him sealed up as aforesaid, or under the seal of the commissioners, save when it may be necessary to have access to the documents therein contained, or any of them, for the purpose of recording and endorsing the day of the filing thereof, or for the purpose of any reference to one of the law officers, either in relation to the same or any other invention, but in any such case as aforesaid the clerk of the patents shall not part with the care or custody of the said packet, or any of the said documents, save as may be required by one of the law officers for the purposes of any such reference, and shall use such precautions as may be necessary to prevent the contents or particulars of such documents being improperly disclosed.

6. Such sealed packet shall be delivered at any time during the continuance of any such letters patent to the said Secretary of State, or to any person having authority to receive the same on his behalf, on demand in writing under the hand of the said Secretary of State, or to such person as the Lord Chancellor may order, and shall if and when the same is returned to the commissioners be again sealed up, and kept under seal as aforesaid.

At the expiration of letters patent, sealed packet to be delivered to Secretary of State.

7. Such sealed packet as aforesaid shall at the end of the term or extended term for which any letters patent for the invention to which the documents in such packet relate, be delivered up to the said Secretary of State, or to any person having authority to receive the same on his behalf.

Where Secretary of State

8. Where the said Secretary of State certifies as aforesaid after the filing of the petition, and before the publication of the provisional specification (if any), such petition and the declaration accompanying such petition and the

certifies after filing of petition, documents already filed to be put into a sealed packet.

provisional specification and drawings relating to the invention which may have been filed or left in any such office as aforesaid, and all copies thereof in any such office, shall be forthwith placed in a packet, sealed with the seal of the commissioners, and every such packet shall be subject to all the provisions of this Act concerning any sealed packet delivered to the clerk of the patents.

Copy of specification, &c., not to be sent to Scotland or Ireland, or published; but, otherwise, provisions of Patent Acts to apply.

9. No copy of any specification or other document or drawing by this Act required to be kept under seal, shall be transmitted to Scotland or Ireland, or be printed, published, or sold, or be open to the inspection of the public; but save as in this Act otherwise directed, the provisions of the "Patent Law Amendment Act, 1852," and any Act amending the same, shall extend and be applicable to and in respect of every such specification and other document and drawing as aforesaid, and the letters patent and invention to which the same relates, and this Act and the "Patent Law Amendment Act, 1852," shall be construed together as one Act.

No scire facias to be brought.

10. It shall not be lawful for any person to take proceedings, by scire facias or otherwise, to repeal any letters patent for an invention in relation to which the said Secretary of State has certified as aforesaid.

Secretary of State may waive the benefit of this Act as respects any invention.

11. The Secretary of State may at any time by writing under his hand waive the benefit of this Act with respect to any particular invention, and the document and matters relating thereto shall be thenceforth kept and dealt with in the ordinary way.

Communications of invention to Secretary of State, &c., not to prejudice letters patent.

12. The communication of any invention for any improvement in instruments or munitions of war to the said Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation be deemed use or publication of such invention so as to prejudice the grant or validity of any letters patent for the same.

Construction of "Secretary of State."

13. In the construction of this Act, "Her Majesty's Principal Secretary of State for War Department" shall mean her Majesty's principal Secretary of State for the time being, to whom her Majesty shall think fit to entrust the seals of the War Department.

INDUSTRIAL EXHIBITIONS ACT, 1865.

28 VICT. c. 3 (*b*).

An Act for the Protection of Inventions and Designs exhibited at certain Industrial Exhibitions in the United Kingdom. [27th March, 1865.]

Whereas exhibitions of objects of art and industry manufactured or contributed wholly or in part by members of the industrious classes of Her Majesty's subjects have lately been held, and may be from time to time hereafter held, in divers parts of the United Kingdom; and it is expedient to encourage such exhibitions by granting to persons desirous of exhibiting at the same new inventions or new designs such protection as is hereinafter mentioned: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Short title.

1. This Act may be cited as the "Industrial Exhibitions Act, 1865."

(*b*) By this statute it was provided that the Board of Trade might certify that certain *Industrial* Exhibitions should be entitled to the benefit of the Act (sect. 2), and that the exhibition of new inventions at exhibitions so certified should not prejudice patent rights (sect. 3). See Act of 1883, ss. 39 and 40, and Act of 1886, s. 3.

2. It shall be lawful for the lords of the committee of Her Majesty's Privy Council for trade and foreign plantations, upon the application of any persons desirous of holding any such exhibition as aforesaid in any part of the United Kingdom, to certify, if they shall think fit, that the exhibition so proposed to be held is in their judgment calculated to promote British art and industry, and to prove beneficial to the industrious classes of Her Majesty's subjects, either generally or in or near the place where such exhibition is proposed to be held; and every such certificate shall mention the place at which and the time during which such exhibition is proposed to be held; and the time mentioned in any such certificate may afterwards, if the lords of the said committee shall so think fit, be enlarged and extended by a further certificate, but so that the whole time allowed and certified for the holding of the same exhibition shall in no case exceed the total period of six months; and every such exhibition so certified, if and so long as the same shall be held at the place and within the time mentioned in any such certificate, shall be deemed to be an industrial exhibition entitled to the benefit of this Act. Power to Board of Trade to certify that certain Industrial Exhibitions are entitled to the benefit of this Act.

3. The exhibition of any new invention at any industrial exhibition entitled to the benefit of this Act shall not, nor shall the publication during the period of the holding of such exhibition of any description of such invention, nor shall the user of such invention for the purposes of such exhibition, and within the place where the same may be held, or elsewhere by any person using the same during the period of such exhibition, without the privity and consent of the true and first inventor thereof, prejudice the right of any person to register provisionally such invention, or invalidate any letters patent which may be granted for such invention. Exhibition of new inventions not to prejudice patent rights.

4. The exhibition at any industrial exhibition entitled to the benefit of this Act of any new design capable of being registered provisionally under the "Designs Act, 1850," or of any article to which such design is applied, shall not, nor shall the publication during the period of the holding of such exhibition of any description of such design, prejudice the right of any person to register, provisionally or otherwise, such design, or invalidate any provisional or other registration which may be granted for such design. Exhibition of designs not to prejudice right to registration.

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33 & 34 VICT. C. 27(*c*).

An Act for the Protection of Inventions exhibited at International Exhibitions in the United Kingdom. [14th of July, 1870.]

[*Repealed by Patents Act*, 1883, s. 113.]

Whereas it is expedient that such protection as is hereinafter mentioned should be afforded to persons desirous of exhibiting new inventions at exhibitions to be held in the United Kingdom.

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows (that is to say):

1. This Act may be cited as "The Protection of Inventions Act, 1870." Short title.

2. The exhibition of any new invention at any international exhibition shall not, nor shall the publication during the period of the holding of such exhibition of any description of such invention, nor shall the user of such invention for the purposes of such exhibition, and within the place where the same may be held, nor shall the user of such invention elsewhere by any Exhibition of new inventions not to prejudice patent rights.

(*c*) This statute applied to *International* Exhibitions the provisions of 28 & 29 Vict. c. 3.

other person without the privity and consent of the true and first inventor thereof, prejudice the right of the exhibitor thereof, he being the true and first inventor, within six months from the time of the opening of such exhibition to leave at the office of the Commissioners of Patents a petition for the grant of letters patent for such invention, and the declaration accompanying the same, and a provisional specification or a complete specification thereof, under the Patent Law Amendment Act, 1852, and the Acts amending the same, or to obtain provisional protection or letters patent for such invention, in pursuance of those Acts, nor invalidate any letters patent which may be granted for such invention upon any such petition as aforesaid.

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43 & 44 Vict. c. 10.

An Act to amend the Law respecting the Manner of passing Grants under the Great Seal, and respecting Officers connected therewith.

[2nd August, 1880.]

[*Repealed, Patents Act*, 1883, *s.* 113.]

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

1. This Act may be cited as "The Great Seal Act, 1880."

2. This Act shall come into operation on the first day of November, one thousand eight hundred and eighty, which day is in this Act referred to as the commencement of this Act.

5. In the case of letters patent for inventions granted before or after the passing of this Act, all instruments required to be filed in the office of the Great Seal Patent Office shall be deemed so filed if filed in the office of the Commissioners of Patents for Inventions (*d*).

REVENUE, FRIENDLY SOCIETIES AND NATIONAL DEBT ACT, 1882.

45 & 46 Vict. c. 72 (*e*).

An Act for amending the Laws relating to Customs and Inland Revenue, and Postage and other Stamps, and for making further Provision respecting the National Debt, and Charges payable out of the Public Revenue, or by the Commissioners for the Reduction of the National Debt; and for other purposes.

[16th August, 1882.]

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

Short title. **1.** This Act may be cited as "The Revenue, Friendly Societies, and National Debt Act, 1882."

(*d*) This section provided that instruments relating to letters patent for inventions formerly required to be filed in the Great Seal Patent Office, should be deemed to be sufficiently filed if filed in the commissioners' office.

(*e*) Sect. 16 provided that the stamp duties granted in respect of letters patent for inventions should be deemed public office fees, and not stamp duties.

16. From and after the passing of this Act, the Public Offices Fees Act, 1879, shall, notwithstanding anything to the contrary therein contained, apply and be deemed to have been applicable as from the first day of April one thousand eight hundred and eighty-two, to the stamp duties granted to her Majesty, her heirs and successors, by an Act passed in the session holden in the sixteenth and seventeenth years of the reign of her Majesty, intituled, "An Act to substitute Stamp Duties for Fees on passing Letters Patent for Inventions, and to provide for the Purchase for the Public Use of certain Indexes of Specifications," and also to the stamp duty of five pounds on the "certificate of registration of a design" granted to her Majesty, her heirs and successors, by the Stamp Act, 1870, and the said duties shall be deemed to be, and to have been as from the said first day of April, fees payable in a public office, and not stamp duties.

The stamp duties granted in respect of letters patent for inventions and on the certificate of registration of a design, to be deemed public office fees and not stamp duties.

16 & 17 Vict. c. 58.

THE PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888, CONSOLIDATED (*f*),

BEING,

46 & 47 VICT. c. 57.—An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. [25th August, 1883.]

48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]

49 & 50 Vict. c. 37.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [25th June, 1886.]

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]

NOTE.—The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

BE it enacted by the Queen's most excellent Majesty, by and with

(*f*) The complete text of the Act is given here, with the exception of the schedules, which, so far as patents are concerned, have been already given, and as regards Trade Marks and Designs, have been replaced by the forms of the Trade Marks and the Designs Rules of 1890.

The text of the amending Acts, 1885, 1886, and 1888, are given at length below. The text of the Act of 1883 sufficiently appears by omitting the heavier type and reading in the italics.

the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

Preliminary.

Short title.

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

Note.—By Act 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

Division of Act into parts.

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

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

Commencement of Act.

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

Act, 1888, s. 28.

The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Note.—There is no special provision as to time of commencement of the Acts of 1885 and 1886, so that they commence from the dates of those Acts, the 14th August, 1885, and the 25th June, 1886.

PART II.

Patents.

Application for and Grant of Patent.

Persons entitled to apply for patent.

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

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

Act, 1885, s. 5.

Power to grant patents to several persons jointly.

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

Application and specification.

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

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

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

Act 1885, s. 2.
5 & 6 Will. 4, c. 62.

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

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

The same drawings may accompany both specifications.

Act 1886, s. 2.

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

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

Reference of application to examiner.

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

Power for comptroller to refuse application or require amendment.

[**7.** (1.) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention,*

Repealed. Act 1888, s. 2.

the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.

(2.) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.

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

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

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

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

Act 1888, s. 2. Power of comptroller to refuse application or require amendment.

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

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

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

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

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the

second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

Time for leaving complete specification.

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

Act 1885, s. 3.

A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.

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

Comparison of provisional and complete specification.

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

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

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

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

Act 1885, s. 3.

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow.

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

Repealed. **Act 1888, s. 3.**

production or inspection is desirable in the interests of justice, and ought to be allowed.

Advertisement on acceptance of complete specification.

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

Opposition to grant of patent.

11. (1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date [*or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application*], or on the ground 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, but on no other ground.

Repealed. Act 1888, s. 4.

Act 1888, s. 4.

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

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

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

Sealing of patent.

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

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

(3.) A patent shall be sealed as soon as may be, and not after

the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

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

(*b*) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

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

Act 1885, s. 3.

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

Date of patent.

Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

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

Act, 1885, s. 4.

Provisional Protection.

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

Provisional protection.

Protection by Complete Specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of

Effect of acceptance of complete specification.

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

Patent.

Extent of patent.

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

Term of patent.

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

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

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

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

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

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

Amendment of Specification.

Amendment of specification.

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

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time

within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

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

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

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

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

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

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

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

(10.) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*] Repealed. Act. 1888, s. 5.

(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending. Act. 1888, s. 5.

19. In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by Power to disclaim part of invention during action, &c.

way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

Restriction on recovery of damages.

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

Advertisement of amendment.

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

Compulsory Licenses.

Power for Board to order grant of licenses.

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

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

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

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

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Register of Patents.

Register of patents.

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

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

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

Fees.

Fees in schedule.

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

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

Extension of Term of Patent.

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

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

(2.) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

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

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

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

(6.) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings

shall be regulated according to the existing procedure and practice in patent matters of the judicial committee.

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

Revocation.

Revocation of patent.

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

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

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by scire facias shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

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

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

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

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

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

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

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

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

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence im-

peaching the validity of the patent, the defendant shall be entitled to reply.

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

Crown.

Patent to bind Crown.

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

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

Legal Proceedings.

Hearing with assessor.

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

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

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

Delivery of particulars.

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

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

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

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

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

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Order for inspection, &c., in action.

30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any

legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Miscellaneous.

Patent for one invention only.

33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

Patent on application of representative of deceased inventor.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

Exhibition at industrial or international exhibition not

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period

to prejudice patent rights.

of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

(*a*) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(*b*) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of patents and designs exhibited at international exhibitions. Act, 1886, s. 3.

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, 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 to Her Majesty in Council may seem fit.

Publication of illustrated journal, indexes, &c.

40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

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

Patent Museum.

41. The control and management of the existing Patent

Museum, and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in council may see fit to give.

Power to require models on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.

Assignment to Secretary for War of certain inventions.

44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the patent office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it.

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

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this

part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Existing Patents.

Provisions respecting existing patents.

45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of application made after the commencement of this Act.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses.

(3.) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the patent office.

Definitions.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An

Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

PART III.

DESIGNS.

Registration of Designs.

Application for registration of designs.

47. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the patent office in the prescribed manner.

(3.) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7.) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Drawings, &c., to be furnished on application.

48. (1.) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs, or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2.) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

Certificate of registration.

49. (1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

Copyright in Registered Designs.

Copyright on registration.

50. (1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

Marking registered designs.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so, the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Inspection of registered designs.

52. (1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorized in writing by the proprietor, or a person authorized by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on 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.

Act, 1883, s. 6.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information as to existence of copyright.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of copyright in certain events.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

Register of Designs.

Register of designs.

55. (1.) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2.) The Register of Designs shall be primâ facie evidence of any matters by this Act directed or authorized to be entered therein.

Fees.

Fees on registration, &c.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's exchequer in such manner as the Treasury shall from time to time direct.

Industrial and International Exhibitions.

Exhibition at industrial or international exhibition not to prevent or invalidate registration.

57. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely,—

(*a*) The exhibitor must, before exhibiting the design or article,

or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

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

Protection of patents and designs exhibited at international exhibitions. Act, 1886, s. 3.

And whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, 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 to her Majesty in Council may seem fit.

Legal Proceedings.

Penalty on piracy of registered design. Act, 1888, s. 7.

58. During the existence of copyright in any design—

(*a*) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply or **cause to be applied** such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

(*b*) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any Court of competent jurisdiction: **Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.** Act, 1888, s. 7.

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Definitions.

Definition of "design," "copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of "proprietor."

61. The author of any new and original design shall be considered the "proprietor" thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application for registration.

62. (1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to [*the Patent Office in the prescribed manner*] **such place and in such manner as may be prescribed.**

Act, 1888, s. 8.

(3.) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connexion with which the applicant desires the trade mark to be registered.

(4.) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal and may make such order as aforesaid.

Act, 1888, s. 8.

(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.

Limit of time for proceeding with application.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant [*the application shall be deemed to be abandoned*], **the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the comptroller may in special cases permit, the**

Act, 1888, s. 9.

registration is not completed, the application shall be deemed to be abandoned.

Conditions of registration of trade mark.

Repealed.

Act, 1888, s. 10.

64. [(1.) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:*

(*a*) *A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or*

(*b*) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or*

(*c*) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2.) *There may be added to any one or more of these particulars any letters words or figures, or combination of letters words or figures, or of any of them.*

(3.) *Provided that any special and distinctive word or words letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five may be registered as a trade mark under this part of this Act.*]

Conditions of registration of trade mark.

Act, 1888, s. 10.

64. (1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

(*a*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

(*b*) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

(*d*) An invented word or invented words; or

(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

(3.) Provided as follows:

(i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no

entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.

Connection of trade mark with goods.

65. A trade mark must be registered for particular goods or classes of goods.

Registration of a series of marks.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (*a*) the statement of the goods for which they are respectively used or proposed to be used, or (*b*) statements of numbers, or (*c*) statements of price, or (*d*) statements of quality, or (*e*) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Trade marks may be registered in any colour. Act, 1888, s. 11.

67. A trade mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours.

Advertisement of application. Act, 1888, s. 12.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller, unless the comptroller refuse to entertain the application.

Opposition to registration. Act, 1888, s. 13, subss. 1, 2.

69. (1.) Any person may within [*two months*] one month or such further time, not exceeding three months, as the comptroller may allow, of the [*first*] advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

Act, 1888, s. 13, sub-s. 3.

(2.) Within [*two months*] one month after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Repealed.

[(3.) *If the applicant sends such counter statement, the comptroller*

Act, 1888, s. 13, sub-s. 4.

shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4.) *If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*]

Act, 1888, s. 13, sub-s. 4.

(3.) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

(5.) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

(6.) Where the opponent is out of the United Kingdom, he shall give the comptroller an address for service in the United Kingdom.

Assignment and transmission of trade mark.

70. A trade mark, when registered, shall be assigned and transmitted only in connexion with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court.

Restrictions on registration.

72. (1.) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the

same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

(2.) **Except as aforesaid** the comptroller shall not register with respect to the same goods or description of goods a trade mark [*so nearly resembling*] **having such resemblance to** a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive. Act, 1888, s. 14.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the [*exclusive*] use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design. Further restriction on registration. Act, 1888, s. 15.

74. (1.) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark— Saving for power to provide for entry on register of common marks as additions to trade marks.

(*a*) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(*b*) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

[(2.) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*] Act, 1888, s. 16.

(2.) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register. Act, 1888, s. 16.

Provided that a person need not under this section disclaim his

own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

(3.) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of Registration.

Registration equivalent to public use.

75. [*Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*]

Act, 1888, s. 17.

Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be primâ facie evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

Certificate as to exclusive use and costs thereon.

Act, 1888, s. 18.

77a. In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor

and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same.

Register of Trade Marks.

Register of trade marks.

78. There shall be kept at the patent office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Removal of trade mark after fourteen years unless fee paid.

79. (1.) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee: and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2.) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3.) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4.) Where after the said three months a trade mark has been removed from the register for non-payment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5.) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during [*the five years*] **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 comptroller that the non-pay-**

Act, 1888, s. 19, sub-s. 1.

Act, 1888, s. 19, sub-s. 2.

ment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.

Fees.

Fees for registration, &c.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

Sheffield Marks.

Registration by Cutlers' Company of Sheffield marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of that company, the following provisions shall have effect:

(1.) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

Act, 1888, s. 20, sub-s. 1.

[(2.) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel and such goods in the register established under the Trade Marks Registration Act*, 1875, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act*, 1875:]

Act, 1888, s. 20, sub-s 1.

(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the

Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, 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 either of the said other registers: 38 & 39 Vict. c. 91.

(3.) An application for registration of a trade mark used [*on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*] **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: **Act, 1888, s. 20, sub-s. 2.**

(4.) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5.) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6.) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day:

[(7.) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register; and notice of every entry made in the Sheffield register must be given to the comp-* **Act, 1888, s. 20, sub-s. 3.**

troller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :]

Act, 1888, s. 20, sub-s. 3.

(7.) **The provisions of this Act and of any general 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, 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 general 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 comptroller, 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 comptroller by the Cutlers' Company : provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register :**

Act, 1888, s. 20, sub-s. 2.

(8.) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used [*on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge*] **on metal goods,** he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company :

(9.) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :

(10.) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :

(11.) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers'

Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks:

(12.) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm reverse or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court:

(13.) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register:

(14.) **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.** Act, 1888, s. 20, sub-s. 4.

(15.) **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 comptroller.**

PART V.

GENERAL.

Patent Office and Proceedings thereat.

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

(2.) Until a new patent office is provided, the offices of the commissioners of patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comp-

troller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and clerks.

83. (1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by parliament.

Seal of patent office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

Refusal to grant patent, &c., in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Act, 1888, s. 21.

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed;

Act, 1888, s. 22.

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.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents, specifications, disclaimers, and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

Act, 1888, s. 23.

90. (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person or **of any other particulars** from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee,—

(*a*) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or

(*b*) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark;

(*c*) Cancel the entry or part of the entry of a trade mark on the register: provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

Act, 1888, s. 24.

(*d*) **Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or**

classes of goods in connexion with which he has desired the design or trade mark to be registered.

Alteration of registered mark.

92. (1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized 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.

Applications and notices by post.

97. (1.) Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying

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

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

goods and regulating business of Patent Office.

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

(*c*) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:

(*e*) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f*) For regulating (with the approval of the treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies and institutions at home and abroad:

(*g*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this

Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of Board of Trade. Act, 1888, s. 25.

102a. (1.) **All things required or authorized 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 authorized 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.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks. [Act, 1885, s. 6.

103. (1.) If her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the [*date of the protection obtained*] **date of the application** in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of

the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: provided that, in the case of trade marks, any trade mark, the registration of which has been duly applied for in the country of origin, may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for colonies and India.

104. (1.) Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade

mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of her Majesty, or any of the royal family, or of any government department, assumes or uses in connexion with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland, Ireland, &c.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for

111. (1.) The provisions of this Act conferring a special juris-

jurisdiction of Courts.

diction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to 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.

Jurisdiction of Lancashire Palatine Court.

Act, 1883, s. 28.

112a. 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 Office, have the like jurisdiction under this Act as Her 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.

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a*) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(*c*) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Construction of principal Act. Act, 1888, s. 27.

The principal Act shall, as from the commencement of this Act [i.e., Act of 1888], take effect subject to the additions, omissions, and substitutions required by this Act; but nothing in this Act shall affect the validity of any act done, right acquired or liability incurred before the commencement of this Act.

Former registers to be deemed continued.

114. (1.) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent, or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1.) In and for the purposes of this Act, unless the context otherwise requires,—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her Majesty's High Court of Justice in England:

"Law officer" means her Majesty's Attorney-General or Solicitor-General for England.

"The Treasury" means the Commissioners of her Majesty's Treasury:

"Comptroller" means the Comptroller General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District, the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

Register of patent agents. Act, 1888, s. 1.

(1.) After the first day of July one thousand eight hundred and eighty-nine 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.

(2.) The Board of Trade shall, as soon as may be after the passing

of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bona fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

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

[*For the Schedules to Act of* 1883, *so far as they relate to Patents,* *see* pp. 528—558. *The amending Acts have no Schedules.*]

PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

(48 & 49 Vict. c. 63.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14th August, 1885.]

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

Construction and short title.

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

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

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

2. Whereas sub-section two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen

as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that:

The declaration mentioned in sub-section two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

5 & 6 Will. 4, c. 62.

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

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

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

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

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

Power to grant patents to several persons jointly.

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

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

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

PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, *so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.* [25th June, 1886.]

WHEREAS by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts: 46 & 47 Vict. c. 57.

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

Short title and construction.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886. 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

The same drawings may accompany both specifications.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

Protection of patents and designs exhibited at international exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the controller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

51 & 52 Vict. c. 50.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24th December, 1888.]

46 & 47 Vict. c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

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

Register of patent agents.

1.—(1.) After the first day of July, one thousand eight hundred and eighty-nine, 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.

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are, in the opinion of the Board, required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act 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.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable, on summary conviction, to a fine not exceeding twenty pounds.

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

Amendments of 46 & 47 Vict. c. 57.

2. For section seven of the principal Act the following section shall be substituted, namely:—

Sect. 7, as to applications.

"**7.**—(1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may 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.

"(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

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

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

"(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

Sect. 9, as to disclosure of reports of examiners.

3. In sub-section five of section nine of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

Sect. 11, as to opposition to grant of patent.

4. In sub-section one of section eleven of the principal Act the words from "or on the ground of an examiner" to "a previous application," both inclusive, shall be omitted, and there shall be

added in lieu thereof the following words, namely, "or on the ground 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."

Sect. 18, as to amended specifications.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely:—

"(10.) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending."

Sect. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act the following words shall be added; namely,

"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."

Sect. 58, as to piracy of registered designs.

7.—(1.) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

Sect. 62, as to application for registration.

8.—(1.) In sub-section two of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2.) To the same section of the principal Act the following sub-section shall be added:—

"(6.) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.

Sect. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the

comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

Sect. 64, as to fancy words.

10.—(1.) For section sixty-four of the principal Act the following section shall be substituted, namely—

"**64.**—(1.) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

"(*a*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(*b*) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

"(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

"(*d*) An invented word or invented words; or

"(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2.) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"(3.) Provided as follows:

"(i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

"(ii.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act."

Sect. 67, as to colours of trade marks.

11. In section sixty-seven of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

Sect. 68, as to advertisement

12. In section sixty-eight of the principal Act after the word

of applications.

comptroller shall be added the words "unless the comptroller refuse to entertain the application."

Sect. 69, as to opposition to registration.

13.—(1.) In sub-section one of section sixty-nine of the principal Act for the words "two months" shall be substituted the words "one month or such further time, not exceeding three months, as the comptroller may allow."

(2.) In the same sub-section the word "first" shall be omitted.

(3.) In sub-section two of the same section for the words "two months" shall be substituted the words "one month."

(4.) For sub-sections three and four of the same section the following sub-sections shall be substituted; namely,

"(3.) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4.) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5.) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

"(6.) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

Sect. 72, as to restrictions on registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section, namely, "except as aforesaid," and for the words "so nearly resembling" shall be substituted the words "having such resemblance to."

Sect. 73, as to restriction on registration.

15. In section seventy-three of the principal Act the word "exclusive" shall be omitted.

Sect. 74, as to additions to trade marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted; namely,

"(2.) The applicant for registration of any such addition must,

however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

Sect. 75, as to effect of registration.

17. For section seventy-five of the principal Act the following section shall be substituted; namely,

"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

Certificate as to exclusive use and costs thereon.

18. After section seventy-seven of the principal Act the following section shall be added and numbered 77A; namely,

"In an action for infringement of a registered trade mark the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same."

Amendments of 46 & 47 Vict. c. 57.

Sect. 79, as to removal of trade mark from the register.

19.—(1.) In sub-section five of section seventy-nine of the principal Act, for the words "the five years" shall be substituted the words "one year."

(2.) To the same sub-section the following words shall be added; namely, "unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

Sect. 81, as to Sheffield marks.

20.—(1.) For sub-section two of section eighty-one of the principal Act the following sub-section shall be substituted:

"(2.) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the

38 & 39 Vict. c. 91.

register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, 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 either of the said other registers."

(2.) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3.) For sub-section seven of the same section the following sub-section shall be substituted:

(7.) The provisions of this Act and of any general 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, 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 general 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 Comptroller, 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 Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield Register.

(4.) To the same section the following sub-sections shall be added; namely,—

(14.) 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.

(15.) 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 comptroller.

Sect. 87, as to entry of

21. In section eighty-seven of the principal Act, after the words

"subject to," shall be added the words "the provisions of this Act and to." assignments, &c.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to." Sect. 88, as to inspection.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars." Sect. 90, as to rectification of register.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely, Sect. 91, as to correction of errors.

"(*d*) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely, Proceedings of Board of Trade.

"(1) All things required or authorized 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 authorized 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."

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,— 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 Office, have the like jurisdiction under this Act as Her 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."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

APPENDIX OF FORMS.

I.—Patents Rules, 1890. Forms (*a*).

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form A.

To be accompanied by two copies of Form B or of Form C.

PATENT.

APPLICATION FOR PATENT.

*—— do hereby declare that —— in possession of an invention, the title of which is †—— that ‡—— the true and first inventor— thereof; and that the same is not in use by any other person or persons to the best of —— knowledge and belief; and —— humbly pray that a patent may be granted to —— for the said invention.

Dated —— day of —— 18—

——§

NOTE.—Where application is made through an agent (Rule 8), the authorization on the back (if used) should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert name and full address and calling of applicant or applicants.
† Here insert title of invention.
‡ In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.
§ To be signed by applicant or applicants.
In the case of a firm, each member of the firm must sign.

(*a*) These forms are contained in the Second Schedule to the Rules.

For the convenience of applicants, suggested forms of authorization to an agent and statement of address respectively are printed below.

(1.) *Where Application is made through an Agent* (*Rule* 8).

—— hereby appoint —— of —— to act as —— agent in respect of the within application for a patent, and request that all notices, requisitions and communications relating thereto may be sent to such agent at the above address.

—— day of —— 18—

——*

* To be signed by applicant or applicants.

(2.) *Where Application is made without an Agent* (*Rule* 9).

—— hereby request that all notices, requisitions, and communications in respect of the within application may be sent to —— at ——

—— day of —— 18—

——†

† To be signed by applicant or applicants.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form A1.

(*To be accompanied by two copies of Form B. or of Form C.*)

APPLICATION FOR PATENT FOR INVENTION COMMUNICATED FROM ABROAD.

I, *—— of —— in the county of —— do hereby declare that I am in possession of an invention, the title of which is †—— which invention has been communicated to me by ‡—— that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

Dated —— day of —— 18—

——§

NOTE.—Where application is made through an agent (Rule 8), the authorization on the back (if used) should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25, *Southampton Buildings,*
Chancery Lane, London, W.C.

* Here insert name, and full address, and calling of applicant.
† Here insert title of invention.
‡ Here insert name, address, and calling of communicant.
§ To be signed by applicant or applicants.

For the convenience of applicants suggested forms of authorization to an agent and statement of address respectively are printed below.

(1.) *Where application is made through an Agent* (*Rule* 8).

—— hereby appoint —— of —— to act as —— agent in respect of the within application for a patent, and request that all notices, requisitions, and communications relating thereto may be sent to such agent at the above address.

—— day of ——, 18— ——*

* To be signed by applicant or applicants.

(2.) *Where application is made without an Agent* (*Rule* 9).

—— hereby request that all notices, requisitions, and communications in respect of the within application may be sent to —— at ——

—— day of ——, 18— ——†

† To be signed by applicant or applicants.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form A2.

PATENT.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

*—— do hereby declare that I (*or* we) have made foreign applications for protection of my (*or* our) invention of † —— in the following foreign states and on the following official dates, viz.: ‡ —— and in the following British possessions and on the following official dates, viz.: § ——

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the ‖ —— to the best of —— knowledge, information and belief, and —— humbly pray that a patent may be granted to —— for the said invention in priority to other applicants, and that such patent shall have the date ‖ ——

——¶

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert name and full address and calling of applicant, or of each of the applicants.
† Here insert title of invention.
‡ Here insert the names of each foreign state followed by the official date of the application in each respectively.
§ Here insert the names of each British possession followed by the official date of the application in each respectively.
‖ Here insert the official date of the earliest foreign application.
¶ Signature of applicant or of each of applicants.

[To be issued with Form A, A1 or A2.]

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form B.

PROVISIONAL SPECIFICATION.

(*To be furnished in duplicate.*)

*——

†—— do hereby declare the nature of this invention to be as follows:— ‡

NOTE.—No stamp is required on this document, which must form the commencement of the provisional specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The provisional specification and the "duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:—

"Dated this —— day of —— 18—."

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert title as in declaration.
† Here insert name, and full address and calling of applicant or applicants as in declaration.
‡ Here insert short description of invention.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Where provisional specification has been left, quote No. and date.
No.——
Date ——

Form C.

COMPLETE SPECIFICATION.

(*To be furnished in Duplicate—one unstamped.*)

*——

† —— do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

‡

NOTE.—This document must form the commencement of the complete specification; the continuation to be upon wide-ruled foolscap

paper (but on one side only) with a margin of two inches on left hand of paper. The complete specification and the "duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:—

"Dated this —— day of —— 18—."

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert title as in declaration.

† Here insert name, and full address and calling of applicant or applicants as in declaration.

‡ Here insert full description of invention, *which must end with a distinct statement of claim or claims, in the following form:—*

"Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is

Here state distinctly the features of novelty claimed.

1.
2.
3.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

(*To be accompanied by an unstamped copy.*)

PATENT.

*I —— hereby give notice of my intention to oppose the grant of letters patent upon application No. —— of —— applied for by —— upon the ground † ——

(Signed) —— ‡

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address.

† Here state upon which of the grounds of opposition permitted by sect. 11 of the Act the grant is opposed.

‡ Here insert signature of opponent.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

In Cases of Refusal to Accept, Opposition, or Applications for Amendment, &c.

PATENT.

SIR,

—— of * —— hereby apply to be heard in reference to —— and request that I may receive due notice of the day fixed for the hearing.

——, Sir, your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert address.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form F.

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

*—— seek leave to amend the specification of letters patent No.—— of 18— as shown in red ink in the copy of the original specification hereunto annexed :—

My reasons for making this amendment are as follows † :—

(Signed) —— ‡

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant or patentee.
† Here state reasons for seeking amendment ; and where the applicant is not the patentee, state what interest he possesses in the letters patent.
‡ To be signed by applicant.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form G.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

[*To be accompanied by an unstamped copy.*]

*—— hereby give notice of objection to the proposed amendment of the specification or drawings of letters patent No. —— of 188— for the following reason :— †

(Signed) ——

To the Comptroller
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of opponent.
† Here state reason of opposition.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form H.

Form of Application for Compulsory Grant of Licence.

[*To be accompanied by an unstamped copy.*]

* —— hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a licence to me by † ——

(Signed) ——

Note.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* form below.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant.
† Here state name and address of patentee, and number and date of his patent.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form H1.

Form of Petition for Compulsory Grant of Licences.

To the Lords of the Committee of Privy Council for Trade.

The petition of * —— of —— in the county of ——, being a person interested in the matter of this petition as herein-after described:—

Sheweth as follows:—

1. A patent dated —— No. —— was duly granted to —— for an invention of †

2. The nature of my interest in the matter of this petition is as follows:—‡

———

———

3. §

———

———

Having regard to the circumstances above stated, the petitioner

alleges that by reason of the aforesaid default of the patentee to grant licences on reasonable terms ‖

Your petitioner therefore prays that an order may be made by the Board of Trade ¶ —— or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

* Here insert name, full address, and description.
† Here insert title of invention.
‡ Here state fully the nature of petitioner's interest.
§ Here state in detail the circumstances of the case under sect. 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licences on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.
‖ Here state the ground or grounds on which relief is claimed in the language of sect. 22, sub-sects. (*a*), (*b*), or (*c*), as the case may be.
¶ Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form I.

Form of Opposition to Compulsory Grant of Licence.

*—— hereby give notice of objection to the application of —— for the compulsory grant of a licence under Patent No. —— of 188—.

(Signed) ——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form J.

Application for Certificate of Payment or Renewal.

——

——— hereby transmit the fee prescribed for the continuation in force of *—— Patent No.—— of 18— for a further period of ——

Name † ——
Address ——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert name of patentee.
† Here insert name and full address.

(*This part of the Form to be filled in at the Patent Office.*)

CERTIFICATE OF PAYMENT OR RENEWAL.

PATENT.

Letters Patent No.—— of 18—.

—— 18—

This is to certify that —— did this —— day of —— 18—, make the prescribed payment of £—— in respect of a period of —— from —— and that by virtue of such payment the rights of the patentee remain in force.*

(SEAL.)

Patent Office, London.

* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form K.

PATENT.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

SIR,

I hereby apply for an enlargement of time for —— month—in which to make the —— payment of £ —— upon my Patent No.—— of 18—

The circumstances in which the payment was omitted are as follows *:—

I am, Sir, your obedient Servant,

† ——

——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* See Rule 49, p. 576.
† Here insert full address to which receipt is to be sent.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form L.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

I *—— hereby request that you will enter † —— name— ‡ in the Register of Patents:—

§ —— claim to be entitled ‖ —— of the Patent No.—— of 18—, granted to ¶ —— for ** —— by virtue of †† ——

And in proof whereof I transmit the accompanying ‡‡ —— with an attested copy thereof.§§

I am, Sir, your obedient Servant,

——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* *Or* We.
Here insert name, full address, and description.
† My *or* our.
‡ *Or* names.
§ I *or* We.
‖ Here insert the nature of the claim.
¶ Here give name and address, &c. of patentee or patentees.
** Here insert title of the invention.
†† Here specify the particulars of such document, giving its date and the parties to the same, and showing how the claim here made is substantiated.
‡‡ Here insert the nature of the document.
§§ Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an attested copy must be left.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form M.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE IN THE REGISTER OF PATENTS.

SIR,

I hereby transmit an attested copy of a licence granted to me by —— under Patent No.—— of 18— as well as the original licence for verification, and I have to request that a notification thereof may be entered in the register.

I am, Sir, your obedient Servant,

* ——

——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert full address.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form N.

APPLICATION FOR DUPLICATE OF PATENT.

Date ——

SIR,

I regret to have to inform you that the letters patent dated * —— No. —— *granted to* —— *for an invention of* † —— *have been* ‡ ——

I beg therefore to apply for the issue of a duplicate of such letters patent. § ——

[Signature of Applicant.]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here insert date, number, name, and full address of patentee.
† Here insert title of invention.
‡ Here insert the word "destroyed" or "lost," as the case may be.
§ Here state interest possessed by applicant in the letters patent.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

* —— hereby give notice of my intention to exhibit a —— of —— at the —— Exhibition, which † —— of —— 18— under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

‡ —— herewith enclose ——

(Signed) ——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant.
† State "opened," or "is to open."
‡ Insert brief description of invention, with drawings if necessary.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form P.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,

I hereby request that the following clerical error * —— in the † —— No. —— of 18— may be corrected in the manner shown in red ink in the certified copy of the original † —— hereunto annexed.

Signature ——
Full Address ——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Or errors.
† Here state whether in application, specification, or register.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form Q.*

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office, London,
18—

I, ——, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To † ——

* *Caveats.*—Any person who may be interested in knowing the date when the complete specification in respect of any particular application shall have been accepted by the Comptroller and advertised in the Official Journal, or the date when an application for leave to amend any particular specification shall have been filed at the Patent Office and advertised, may be informed of such dates upon his forwarding to the Comptroller a request, in writing (upon foolscap paper), to that effect, together with a Patents' Form Q., bearing a 5*s.* stamp.

† Here insert name and full address of person requiring the information.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form R.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,

*—— hereby request that —— address now upon the register may be altered as follows:—

†——————————

—— Sir, your obedient Servant,

——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name or names and full address of applicant or applicants.
† Here insert full address.

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

*—— hereby transmit an office copy of an Order in Council with reference to †——

—— Sir, your obedient Servant,

——

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* Here state name and full address of applicant.
† Here state the purport of the order.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form T.

Form of Appeal to Law Officer.

I, * —— of * —— hereby give notice of my intention to appeal to the Law Officer from † —— of the Comptroller of the —— day of —— 18— whereby he ‡ ——

No. § —— of the year 18— §

Signature ——

Date ——

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

* Here insert name and full address of appellant.

† Here insert "the decision" or "that part of the decision," as the case may be.

‡ Here insert "refused [or allowed] application for patent," or "refused [or allowed] application for leave to amend patent," or otherwise, as the case may be.

§ Insert number and year.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

PATENT.

Form U.

Form of Application for Extension of Time for leaving a Complete Specification.

Sir,

—— hereby apply for extension of time for one month in which to leave a complete specification upon application.

—— dated ——

The circumstances in and grounds upon which this extension is applied for are as follows:— *

——, Sir, your obedient Servant,

——†

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* See Rule 50, p. 577.

† To be signed by applicant or applicants, or his or their agent.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883—1888.

Form V.

PATENT.

Form of Application for Extension of Time for Acceptance of a Complete Specification.

Sir,

—— hereby apply for extension of time for —— month— for the acceptance of the complete specification upon application No. —— dated ——

The circumstances in and grounds upon which this extension is applied for are as follows :— *

——

——, Sir, your obedient Servant,

—— †

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

* See rule 50, p. 577.
† To be signed by applicant or applicants, or his or their agent.

M. E. Hicks-Beach,
President of the Board of Trade.

31st March, 1890.

II.—Formal Letters of the Comptroller.

Title of Application insufficient.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 18—

With reference to your application for a patent numbered as above, I have to inform you that the title does not sufficiently indicate the subject-matter of the invention, which, from the description in the specification, would appear to be for ——

I have therefore to request—in accordance with section 7, sub-section 1, of the Patents, &c., Act, 1883—that you will be good enough to amend the title so that it may sufficiently indicate the subject-matter of the invention, for which purpose the specification is returned herewith.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

NOTE (*a*).

I. Alterations must be made in ink and initialled.
II. The margin must in no case be written upon.
III. Amendments must not be made on slips of paper pasted over portions of the original specification.
IV. Portions of the specification may be re-written on fresh sheets of foolscap paper, but in such cases the original pages must be cancelled and *returned to this office*.
V. In the case of a complete specification the stamped form must always be used as the first sheet of the amended specification.

AUTHORIZATION OF AGENT REQUIRED.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 18—

——

With reference to your application for a patent, numbered as above, I have to state that in every case where the applicant appoints an agent to act on his behalf, it is necessary that a statement of such authorization be furnished.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE (*a*), p. 751.]

SPECIFICATION COMPRISING MORE THAN ONE INVENTION.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 18—

——

With reference to your application for a patent, numbered as above, I beg to state that the specification appears to comprise more than one invention, viz. :—

I have therefore to request that, in order that section 33 of the Patents, &c., Act, 1883, may be complied with, you will amend the specification so that it shall comprise one invention only.

The invention— withdrawn may be made the subject of —— separate application— If you desire to obtain for such further application— the date of the original, you should, in forwarding ——, make a request to that effect.

(*a*) This memorandum appears on most of the printed forms of letter from the Comptroller. It is not reprinted, but merely referred to hereafter.

The title in this specification will require to be amended, so as to indicate the subject-matter of the invention which you decide to retain.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

FULL ADDRESS, &c. IN APPLICATION FORM.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 18--

——

With reference to your application for a patent, numbered as above, I have to request that you will be good enough to insert your full address and calling in the application form and the specification, in accordance with the directions contained in the marginal notes * and † on Forms A and —— respectively.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

SIGNATURE AND DATE TO SPECIFICATION.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 18-

——

With reference to your application for a patent, numbered as above, I have to request that you will be good enough to sign and date the specification, in accordance with the directions contained in the foot-note on Form ——

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

AMENDMENT OF PROVISIONAL SPECIFICATION REQUIRED.

The Patent Office,
25, Southampton Buildings, London, W.C., ——18—

——

With reference to your application for a patent, numbered as above, I beg to inform you that the provisional specification does not fairly describe the nature of the invention as required by section 6 of the Patents, &c., Act, 1883. I have, therefore, to request that you will

be good enough to amend that document by furnishing therein a —— description of the nature of your invention.

Your attention is directed especially to those parts of the specification indicated by pencil marks in the margin.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

SAME LETTER REQUIRING EXPLANATION UNDER ACT OF 1888, S. 2.

The Patent Office,
25, Southampton Buildings, London, W.C., ——18--

With reference to your application for a patent, numbered as above, I beg to inform you that the provisional specification does not fairly describe the nature of the invention as required by section 6 of the Patents, &c., Act, 1883. I have, therefore, to request that you will be good enough to amend that document by furnishing therein a —— description of the nature of your invention.

You should furnish with the amended specification an explanation of the circumstances under which the specification was filed without containing a fair description of the nature of the invention, as under section 2 of the Patents, &c., Act, 1888, I am empowered to direct that in such cases the application shall bear date as from the time when the requirement as to description is complied with.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

AMENDMENT OF COMPLETE SPECIFICATION.

The Patent Office,
25, Southampton Buildings, London, W.C., ——18—

With reference to your application for a patent, numbered as above, I have to request—under section 7, sub-section 1. of the Patents, &c., Act, 1883—that you will be good enough to amend the specification, which is returned herewith, so that it may "*particularly describe and ascertain the nature of the invention and in what manner it is to be performed.*"

Your attention is called especially to those parts of the specification indicated by pencil marks in the margin.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

AMENDMENT OF TITLE (*in Complete Specification*).

The Patent Office,
25, Southampton Buildings, London, W.C., —— 18—

With reference to your application for a patent, numbered as above, I have to request that you will be good enough to amend the title in the complete specification so as to correspond with that given in the provisional specification, viz. :—

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

AMENDMENT OF TITLE (*in other cases*).

The Patent Office,
25, Southampton Buildings, London, W.C., —— 188—

With reference to your application for a patent, numbered as above, I have to request that you will be good enough to amend the title in the —— so as to correspond with that given in the —— viz. :—

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

TITLES NOT THE SAME.

Patent Office,
25, Southampton Buildings, London, W.C., —— 188—

With reference to your application, numbered as above, I beg to point out that the titles on Forms A and —— do not agree. Either title would be accepted, but the two should be made to exactly correspond.

I am, Sir, your obedient servant,
——Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

TITLE TO BE CORRECTLY INSERTED.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 188—

——.

With reference to your application for a patent, numbered as above, I have to request that you will be good enough to insert the title at the head of the specification, in accordance with the directions contained in the marginal note (*) on Form ——

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

AMENDMENT OF DRAWINGS.

Patent Office,
25, Southampton Buildings, London, W.C., —— 188—

——

With reference to your application, numbered as above, I beg to inform you that the lines on the drawing—are not sufficiently black to admit of their satisfactory reproduction by photo-lithography; and I have to request that in this respect you will be good enough to amend the drawing—returned herewith.

A circular of instructions with a specimen drawing is enclosed herewith.

I am, Sir, your obedient servant,
—— Comptroller-General.

To ——

DRAWINGS REQUIRED.

The Patent Office,
25, Southampton Buildings, London, W.C., —— 188—

——

With reference to your application for a patent, numbered as above, I have to request that, in order to aid the written description, you will be good enough to file drawings of your invention, prepared in accordance with the revised rules.

On the drawings the various parts of the invention shown should be indicated by letters or numerals, and be referred to in the specification (enclosed) by means of such letters or numerals.

A circular of instructions, with a specimen drawing, is also enclosed herewith.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

[*For note accompanying this Form, see* NOTE, p. 751.]

EXTENSION OF TIME FOR ACCEPTANCE OF COMPLETE SPECIFICATION.

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C., ——18—

The desired extension of time for —— month— for the acceptance of the complete specification in respect of application for a patent, numbered and dated as above, has been allowed.

—— Comptroller-General.

NUMBER AND YEAR OF APPLICATION.

The Patent Office, 25, Southampton Buildings,
Chancery Lane, W.C., ——18—

I beg to acknowledge the receipt of your letter of the —— and to request that you will be good enough to furnish me with the number and year of the application referred to.

I am, —— your obedient servant,
—— Comptroller-General.

To ——

GENERAL FORM OF REQUEST.

Patent Office,
25, Southampton Buildings, London, W.C., ——18—

With reference to your application, numbered as above, I have to request that you will be good enough to ——

NOTE.—Alterations, erasures, &c., in the specification or drawings should be initialled by the applicant or his agent.

LETTER REMINDING APPLICANT THAT PATENT LOST IF STEP NOT TAKEN.

Patent Office,
25, Southampton Buildings, London, W.C., ——18—

I beg to call your attention to my letter of the —— relative to your application numbered as below; and with a view of preventing you from losing, through accident or oversight, the patent you sought, I should be glad to learn from you that my letter has not miscarried.

Please, therefore, be good enough to sign following statement, and return the form to this Office.

I am, —— your obedient servant,
—— Comptroller-General.

No. ——

SIR,

I beg to state that your letter was duly received, **and that I propose to proceed with my application in due course.*

I am, Sir, your obedient servant,

——

To the Comptroller,
Patent Office.

* If you do not propose to proceed with your application, strike out these words.

APPLICATION AND PROVISIONAL SPECIFICATION ACCEPTED.

25, Southampton Buildings,
Chancery Lane, London, W.C., ——18—

In conformity with the provisions of the Patents, &c., Act, 1883, I hereby give you notice of the acceptance of your application with a provisional specification for a patent for ——

No. —— dated —— 18—

I am, —— your obedient servant,
—— Comptroller-General.

N.B.—A complete specification must be left at the Patent Office within 9 months of the date of application, if a patent is desired.

This complete specification must be prepared upon Form C, stamped £3, must bear the number and date of the application, and must end with a distinct statement of the invention claimed.

If the complete specification is not left at the Patent Office within the prescribed 9 months, an extension of time for 1 month more may be applied for upon Form U, stamped £2.

At the end of 10 months, if no complete specification has been filed, the application will be regarded as abandoned.

Forms C and U may be purchased in London at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), or may be obtained at a few days' notice through any money order office in the United Kingdom, upon prepayment of the value of the stamp.

COMPLETE SPECIFICATION ACCEPTED.

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C., ——18—

In conformity with the provisions of the Patents, &c., Act, 1883, I hereby give you notice of the acceptance of the complete specification of your application for a patent for ——

No. —— dated —— 18—

I am, —— your obedient servant,
—— Comptroller-General.

Note.—When a complete specification has been accepted it is open to public inspection, and notice of acceptance will be advertised forthwith in the Official Journal of the Patent Office. Any person may, at any time within two months from the date of such advertisement, give notice of opposition to the grant of a patent on the grounds stated in section 11 of the Patents, &c., Act, 1883. The subsequent procedure is set forth in sections 12, 13, and in Nos. 34—43, of the "Rules" under the Act.

APPLICATION WITH COMPLETE SPECIFICATION ACCEPTED.

The Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C., —— 18—

In conformity with the provisions of the Patents, &c., Act, 1883, I hereby give you notice of the acceptance of your application with a complete specification for a patent for ——

No.—— dated —— 18—

I am —— your obedient servant,
—— Comptroller-General.

NOTE.—When a complete specification has been accepted it is open to public inspection, and notice of acceptance will be advertised forthwith in the Official Journal of the Patent Office. Any person may, at any time within two months from the date of such advertisement, give notice of opposition to the grant of a patent on the grounds stated in sect. 11 of the Patents, &c., Act, 1883. The subsequent procedure is set forth in sects. 12, 13, and in Nos. 34—43 of the "Rules" under the Act. The nature of the protection consequent upon the acceptance of a complete specification is stated in sect. 15 of the Act.

EXTENSION OF TIME FOR LEAVING COMPLETE SPECIFICATION.

Patent Office,
25, Southampton Buildings, London, W.C., —— 18—

With reference to your application, numbered as above, I beg to call your attention to sub-sect. 4 of sect. 9 of the Patents Act, 1883, which enacts that, "unless a complete specification is accepted within

twelve months from the date of application (*i.e., the date when the provisional specification, if any, or the complete, was lodged at this office*), then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void."

Power has, however, been given to the comptroller under sect. 3 of the Patents Amendment Act, 1885, to extend, by three months, this period of twelve months, upon payment of the following fees:—

For one month's extension	£2
For two months' extension	£4
For three months' extension	£6

Application for such extension must be made upon a stamped copy of Form V., which may be obtained at a few days' notice through any Postal Money Order Office.

Having regard to the above-mentioned sections, I should be glad if you would return the papers relating to your application.

I am, —— your obedient servant,
—— Comptroller-General.

III.—Forms of Specifications.

A simple form of Specification (complete in first instance) for an Apparatus.

No. . A.D. 1887.

Date of application, 22nd Dec., 1887—Accepted, 27th Jan., 1888.

COMPLETE SPECIFICATION.

An Improvement in Axle Boxes for Railway Rolling Stock.

I, A. B., of No. ——, —— Street, in the county of Middlesex, engineer, do hereby declare the nature of this invention, and in what manner the same is to be performed to be particularly described and ascertained in and by the following statement:—

My invention relates to means of preventing access of dust or grit to the axle boxes of railway rolling stock, and so preventing to a large extent much of the friction and wear which result from the entrance of gritty particles, mostly at that side of the box which is next to the wheel.

For this purpose I form, in the side of the box next to the wheel, a circular groove concentric with the axle, and in this groove I insert a ring of soft metal or alloy with springs arranged in the groove behind it so as to press it outwards against the boss of the wheel.

The accompanying drawing is a longitudinal section of an axle box

of ordinary construction modified according to my invention. A is the axle, B the bush, W is part of the boss of one of the running wheels, against which the ring R is pressed by several springs S arranged behind it in the circular groove G.

The ring R, thus pressed against the boss W of the revolving wheel, and being capable of moving to and fro with it in the transverse oscillations of the axle, forms a joint practically tight which prevents access of dust or grit on the inner side of the axle box, the outer side of which is closed by a cover and lid L in the usual way.

Having now particularly described and ascertained the nature of this invention and in what manner the same is to be performed, I declare that what I claim is:—

Claim. In combination with an axle box for railway rolling stock, a packing ring fitted in a groove formed in the inner side of the box and pressed by springs against the boss of the running wheel, substantially as and for the purpose herein set forth.

Dated this —— day of December, 1887.

X. & Y.
Agents for the Applicants.

NOTE.—The drawing cannot be conveniently reproduced here.

Provisional and Complete Specifications of Chemical and Mechanical Process for Waterproofing, &c.

No. . A.D. 1889.

Date of application, 8th May, 1889.

Complete specification left, 15th Nov., 1889—Accepted, 28th Dec., 1889.

PROVISIONAL SPECIFICATION.

A Process for Waterproofing and preserving Textures and other Materials.

We, A. B., of —— in the county of London, waterproofer, and C D., of —— in the county of Essex, analytical chemist, do hereby declare the nature of this invention to be as follows:—

Textures and other materials have been waterproofed and preserved against decay or ravages of insects by treating them with cupr-ammonia, but this treatment is in many cases objectionable on account of its affecting the colours and dyes of the materials treated. Our invention relates to means of waterproofing and preserving without materially affecting the colours or dyes of the materials treated. For

this purpose, we dissolve cotton or other substances containing cellulose in a strong solution of cupr-ammonia; from this we precipitate the copper by adding scrap zinc to the solution, and we thus convert the liquid into a colourless mucilaginous solution of ammonia-zinc and cellulose. In a bath of this mucilaginous liquid we soak the texture or other material so that it is thoroughly impregnated; we then squeeze out the superfluous liquid and dry the material, calendering it if necessary.

Dated this —— day of ——, 1889.

X. & Y.
Agents for the Applicants.

COMPLETE SPECIFICATION.

A Process for Waterproofing and Preserving Textures and other Materials.

We, A. B., of —— in the county of London, waterproofer, and C. D., of —— in the county of Essex, analytical chemist, do hereby declare the nature of this invention and in what manner the same is to be performed to be particularly described and ascertained in and by the following statement:—

Textures and other materials have been waterproofed and preserved against decay or ravages of insects by treating them with cupr-ammonia, but this treatment is in many cases objectionable on account of its affecting the colours and dyes of the materials treated. Our invention relates to means of waterproofing and preserving without materially affecting the colours or dyes of the materials treated. For this purpose, we dissolve cotton or other substance containing cellulose in a strong solution of cupr-ammonia containing at least 4 per cent. by weight of copper, the quantity of cellulose being about 3 per cent. by weight of the solution, from this solution we precipitate the copper by adding scrap zinc to the solution, and we thus convert the liquid into a colourless mucilaginous solution of ammonia-zinc and cellulose. In a bath of this mucilaginous liquid we soak the texture or other material so that it is thoroughly impregnated, we then squeeze out the superfluous liquid and dry the material, calendering it if necessary.

Having now particularly described and ascertained the nature of the said invention and in what manner the same is to be performed, we declare that what we claim is:—

Claim. The herein described process for waterproofing and preserving textures and other materials by treating them with a solution of cellulose and ammonia zinc prepared by adding zinc to a solution of cupr-ammonia and cellulose.

Dated this —— day of November, 1889.

X. & Y.
Agents for the Applicants.

Process of Manufacturing Dynamite and Method of Firing same (*a*).

EXPLOSIVE COMPOUNDS.

A.D. 1867, May. No.

LETTERS PATENT to A. B., of the —— Chancery Lane, in the county of Middlesex, civil engineer, for the invention of "Improvements in Explosive Compounds and in the means of Igniting the same."—A communication from abroad by C. D., of Rue St. Sebastien, Paris, in the Empire of France.

Sealed the 15th October, 1867, and dated the 7th May, 1867.

Provisional specification left by the said A. B. at the office of the Commissioners of Patents, with his petition, on the 7th May, 1867.

I, A. B., of the —— in the County of Middlesex, civil engineer, do hereby declare the nature of the said invention for "Improvements in Explosive Compounds and in the means of Igniting the same," to be as follows:—

This invention relates to a method of modifying the nature of nitro-glycerine in a manner which renders it much safer for use than heretofore. Nitro-glycerine if mixed with porous inexplosive substances, such, for instance, as charcoal or silica, becomes very much altered in its properties; thus, for instance, nitro-glycerine alone is not inflammable by a spark, but may be got to explode by submitting it to a very rapid shower of sparks. Nitro-glycerine absorbed in porous substances, on the other hand, easily catches fire from a spark, but burns away slowly and without explosion, except under very close and resisting confinement, when a violent explosion ensues; against shocks or blows the above mixture is also far less sensitive than nitro-glycerine alone. Owing to the aforesaid properties of the mixture described its use for blasting metal or very sound rock requires no other firing than an ordinary safety fuse. In shattered rock or coal, on the other hand, it will cause no real explosion at all, the gas will leak out through the crevices and prevent a great accumulation of pressure from the explosive medium, which alone can determine the detonation of nitro-glycerine when absorbed in porous substances, such, as for instance, charcoal or silica; for this reason a special igniter is used to explode the above mixture in fissured or slinky rocks, or wherever it is to be used without close confinement; that special igniter consists of a kind of percussion cap wherein the fulminate is caused to develop a very high gaseous pressure before it bursts, which may be attained either by increasing the charge of fulminate or diminishing the leakage of gas before the cap bursts; this cap is adapted to the end of a safety fuse whereby it is ignited.

(*a*) It will be seen that this was a case under the Act of 1852. The *usual* form of specifications has not been materially altered by the Act of 1883. Claims are now compulsory, but they were formerly usual.

Specification in pursuance of the conditions of the Letters Patent, filed by the said A. B. in the Great Seal Patent Office on the 6th November, 1867.

To all to whom these presents shall come, I, A. B., of the —— in the county of Middlesex, civil engineer, send greeting.

Whereas her most Excellent Majesty Queen Victoria, by her letters patent, bearing date the seventh day of May, in the year of our lord one thousand eight hundred and sixty-seven, in the thirtieth year of her reign, did, for herself, her heirs and successors, give and grant unto me, the said A. B., her special licence, that I, the said A. B., my executors, administrators, and assigns, or such others as I, the said A. B., my executors, administrators, and assigns, should at any time agree with, and no others, from time to time and at all times thereafter during the term therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, an invention for "Improvements in Explosive Compounds and in the means of Igniting the same," being a communication to me from C. D., of Paris, in the Empire of France, upon the condition (amongst others) that I, the said A. B., my executors or administrators, by an instrument in writing under my, or their, or one of their hands and seals, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in the Great Seal Patent Office, within six calendar months next and immediately after the date of the said letters patent.

Now know ye, that I, the said A. B., do hereby declare the nature of the said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement thereof (that is to say):—

This invention relates to the use of nitro-glycerine in an altered condition which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into a powder, which I call dynamite or D.'s safety powder. By this absorption of the nitro-glycerine in some porous substance it acquires the property of being in a high degree insensible to shocks, and it can also be burned over fire without exploding.

The aforesaid safety powder or dynamite is exploded, first, when under very close and resisting confinement by means of a spark or any mode of ignition used for firing ordinary gunpowder; second, without or during confinement by means of a special fulminating cap containing a strong charge of fulminate, which is adapted to the end of a fuse, and is strongly squeezed to the latter for the purpose of more effectually confining the charge, so as thereby to heighten the effect of the detonation; third, by means of an additional charge of ordinary gunpowder the explosion of the latter will cause the dynamite to go off even when it is only partially confined.

From the aforesaid it will be understood that a strong fulminating cap, if adapted to the fuse by being squeezed thereon, will cause dynamite to explode under all conditions of confinement or non-confinement, and that an additional charge of gunpowder or analogous substance will cause dynamite to explode only when confined or partially confined; and that any ordinary mode of ignition as used for

gunpowder, for instance, a fuse will determine the explosion of dynamite only under very close and resisting confinement. It is evident that the above-described fulminating cap may be greatly varied in form, but the principle for its action lies in the sudden development of a very intense pressure or shock. In order to ensure a perfect stability in the nitro-glycerine contained in the dynamite the porous substance before it is saturated with nitro-glycerine is to be rendered alkaline by washing it with a solution of carbonate of soda or lime water or analogous substance in order to neutralize the acid and prevent any decomposition of nitro-glycerine from taking place. I would here remark that the above-described safety powder or dynamite (being nitro-glycerine absorbed in porous non-explosive substances) possesses very distinct properties from and very great practical advantages over liquid nitro-glycerine, and its explosion except under very close and resisting confinement requires a special ignition, as described above.

Claim. Having now described the invention of "Improvements in Explosive Compounds and in the means of Igniting the same," and having explained the manner of carrying the same into effect, as communicated to me by my foreign correspondent, I claim as the invention secured to me by letters patent as aforesaid, the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the modes of firing the same by special ignition (*a*), as herein set forth.

In witness whereof I, the said A. B., have hereunto set my hand and seal, the fifth day of November, in the year of our Lord one thousand eight hundred and sixty-seven.

Witness, A. B. (L.S.)

Form of Provisional and Complete Specifications for a process of a series of Operations (1st, 2nd, and 3rd Claims) and also for an Apparatus (4th Claim) (*b*).

A.D. 1876, MAY. No. .

Gas-motor Engines (*c*).

Letters patent to A. B., of No. —— Southampton Buildings, Chancery Lane in the county of Middlesex, for the invention of "Improvements in Gas-motor Engines" Communicated to him from abroad by C. D. of the —— at Deutz in the German Empire.

Provisional specification left by the said A. B. at the Office of the Commissioners of Patents on the 17th May, 1876.

A. B. of No. —— Southampton Buildings, Chancery Lane, in the County of Middlesex. "Improvements in Gas-motor Engines." [A

(*a*) The latter part of this claim was held by the Court of Appeal to be invalid, because the special ignition here claimed was in no way different from the ordinary ignition, but the House of Lords, supporting the Court of first instance, held it to be valid, on the ground that the inventor of a new explosive is entitled to claim the mode of firing the same, although it be the mode in common use of firing explosives. See *British Dynamite Co. v. Krebs*, Goodeve's P. C. p. 88.

(*b*) See note, p. 762.

(*c*) This patent was twice upheld in the Court of Appeal. In *Otto v. Linford*, Bacon, V.-C., held the patent to be invalid, but the Court of Appeal reversed his decision. In *Otto v. Steel*, Pearson, J., held the patent to be valid, and the Court of Appeal upheld his decision.

communication to him from abroad by C. D. of the —— at Deutz in the German Empire.]

In gas-motor engines, as at present constructed an explosive mixture of combustible gas and air is introduced into the engine cylinder where it is ignited, resulting in a sudden expansion of the gases and development of heat, a great portion of which is lost by absorption unless special provisions are made for allowing the gases to expand very rapidly.

According to the present invention, combustible gas or vapour is introduced into the cylinder together with air or other gas that may or may not support combustion in such a manner that the particles of the combustible gas are more or less dispersed in an isolated condition in the air or other gas, so that on ignition, instead of an explosion ensuing, the flame will be communicated gradually from one combustible particle to another, thereby effecting a gradual development of heat and a corresponding gradual expansion of the gases, which will enable the motive power so produced to be utilised in the most effective manner. The mode of using the gases and the arrangement of the engine may be variously modified in carrying out this invention. Thus according to one arrangement the gases are introduced into the engine cylinder at atmospheric pressure. The cylinder is for this purpose provided with a slide having suitable ports for the admission of air and of an intimate mixture of combustible gas and air, and the movement of the slide is so regulated by means of a cam or eccentric on the engine shaft that during the first part of the stroke of the piston, air alone enters the cylinder, while during a succeeding portion of the stroke the mixture of gas and air is introduced behind the air. This mixture in entering the cylinder will become more or less dispersed in the air previously introduced, the particles of the mixture being situated nearest together at the point where they enter the cylinder and becoming gradually more dispersed as they mix with the air in front. A communication being now established by the slide between a small external gas flame and the contents of the cylinder at the point where the combustible mixture is most dense, this ignites, and the combustion of the whole charge takes place gradually, the mixture burning with gradually decreasing rapidity as the flame extends to those particles that are more diffused among the air. The gradual expansion of the gases thus produced causes the piston to complete its stroke, and on the return stroke, which may be effected either by the momentum of the fly wheel or by the introduction of a similar charge at the other end of the cylinder, the products of combustion are expelled through a valve, after which the above described operation is repeated for the next stroke.

According to another arrangement the combustible gas and air or other gas are employed in a compressed state in the engine. For this purpose the engine may operate either as above described, the gas and air being simply compressed to the requisite degree before being introduced into the cylinder, or by preference, the compression is effected in the cylinder itself in the following manner. The cylinder is constructed of greater length than the stroke of the piston, so that there is a space beyond the latter when it is at end stroke. Assuming this space to be filled with a portion of the gaseous products of combustion resulting fom the last stroke, at atmospheric pressure, the piston in performing one part of its stroke draws in atmospheric air, after which it will draw

in the combustible mixture during the remainder of its stroke. The cylinder will then be filled with three strata of different gases, more or less intermingled at their junction, namely, a stratum of products of combustion next the piston, then a stratum of air, and lastly the combustible mixture. The piston then performs its return stroke, whereby the gaseous charge is compressed into the before-mentioned space at the end of the cylinder. The gases will in this condition still retain their stratified position, the particles of combustible mixture being diffused to a certain extent through the other strata. The charge is now ignited and burns gradually and with the same effect as described with reference to the first arrangement. On the return stroke the products of combustion are expelled with the exception of the quantity contained in the space at the end of the cylinder. The regulation of the power of the engines operating according to the above described invention is effected simply by admitting more or less of the combustible gas for each charge, this being done by regulating the time of opening and closing of an admission valve on the gas supply pipe. The motion of the slide is regulated by a rotating cam capable of being adjusted on its shaft relatively to a lever connected to the slide, which adjustment may be effected by any suitable known arrangement of governor.

Specification in pursuance of the conditions of the Letters Patent filed by the said A. B. in the Great Seal Patent Office on the 3rd November, 1876.

A. B., of No. —— Southampton Buildings, Chancery Lane, in the County of Middlesex, "Improvements in Gas-motor Engines." A communication to me from abroad by C. D. of the —— at Deutz in the German Empire.

In gas-motor engines as at present constructed an explosive mixture of combustible gas and air is introduced into the engine cylinder where it is ignited, resulting in a sudden expansion of the gases and development of heat, a great portion of which is lost by absorption unless special provisions are made for allowing the gases to expand very rapidly. According to the present invention, combustible mixture of gas or vapour and air is introduced into the cylinder together with air or other gas that may or may not support combustion in such a manner that the particles of the combustible mixture are more or less dispersed in an isolated condition in the air or other gas, so that on ignition, instead of an explosion ensuing, the flame will be communicated gradually from one combustible particle to another, thereby effecting a gradual development of heat and a corresponding gradual expansion of the gases, which will enable the motive power so produced to be utilised in the most effective manner. The mode of using the gases and the arrangement of the engine may be variously modified in carrying out this invention. Thus, according to one arrangement, the gases are introduced into the engine cylinder at atmospheric pressure. The cylinder is for this purpose provided with a slide having suitable ports for the admission of air and of an intimate mixture of combustible gas or vapour and air, and the movement of the slide is so regulated by means of a cam or eccentric on the engine

shaft that during the first part of the stroke of the piston, air alone enters the cylinder, while during a succeeding portion of the stroke the mixture of gas or petroleum vapour and air is introduced behind the air. This mixture in entering the cylinder will become more or less dispersed in the air previously introduced, the particles of the mixture being situated nearest together at the point where they enter the cylinder, and becoming gradually more dispersed as they mix with the air in front. A communication being now established by the slide between a small external gas flame and the contents of the cylinder at the point where the combustible mixture is most dense, this ignites and the combustion of the whole charge takes place gradually, the mixture burning with gradually decreasing rapidity as the flame extends to those particles that are more dispersed among the air. The gradual expansion of the gases thus produced causes the piston to complete its stroke, and on the return stroke, which may be effected either by the momentum of the fly-wheel or by the introduction of a similar charge at the other end of the cylinder, the products of combustion are expelled through a valve, after which the above described operation is repeated for the next stroke.

According to another arrangement, the combustible gas and air or other gas are employed in a compressed state in the engine. For this purpose, the engine may operate either as above described, the gas and air being simply compressed to the requisite degree before being introduced into the cylinder, or by preference the compression is effected in the cylinder itself in the following manner. The cylinder is constructed of greater length than the stroke of the piston, so that there is a space beyond the latter when it is at end stroke. Assuming this space to be filled with a portion of the gaseous products of combustion resulting from the last stroke, at atmospheric pressure, the piston in performing one part of its stroke draws in atmospheric air, after which it will draw in the combustible mixture during the remainder of its stroke. The cylinder will then be filled with three strata of different gases, more or less intermingled at their junction, namely, a stratum of products of combustion next the piston, then a stratum of air, and lastly the combustible mixture. The piston then performs its return stroke, whereby the gaseous charge is compressed into the before-mentioned space at the end of the cylinder. The gases will in this condition still retain their stratified position, the particles of combustible mixture being diffused to a certain extent through the other strata. The charge is now ignited and burns gradually and with the same effect as described with reference to the first arrangement. On the return stroke, the products of combustion are expelled with the exception of the quantity contained in the space at the end of the cylinder. The regulation of the power of the engines operating according to the above-described invention is effected simply by admitting more or less of the combustible gas for each charge, this being done by regulating the time of opening and closing of an admission valve on the gas supply pipe. The motion of this valve is regulated by a rotating cam capable of being adjusted longitudinally on its shaft by any suitable known arrangement of governor.

Description of the Drawings.

[*As we are unable to give the drawings here, the detailed description is omitted.*]

Claims.

Having thus described the nature of the said invention and in what manner the same is to be performed as communicated to me by my foreign correspondent it is claimed in respect of gas motor engines :—

First. Admitting to the cylinder a mixture of combustible gas or vapour with air separate from a charge of air or incombustible gas so that the development of heat and the expansion or increase of pressure produced by the combustion are rendered gradual, substantially as and for the purposes herein set forth.

Second. Compressing by one instroke of the piston a charge of combustible and incombustible fluid drawn into the cylinder by its previous outstroke, so that the compressed charge, when ignited, propels the piston during the next outstroke, and the products of combustion are expelled by the next instroke of the piston, substantially as herein described.

Third. Regulating the admission of the combustible gas or vapour to the cylinder by means of a separate slide controlled by a governor, so that when the speed of the engine increases, the combustible charge is reduced, substantially as herein described.

Fourth. The construction substantially as herein described in reference to Figs. 2 to 13 of the drawings of a gas-motor engine wherein by one outstroke of the piston separate charges of combustible fluid and air are drawn into the cylinder, which charges are compressed by the instroke and then ignited so as to propel the piston which by its return stroke expels the products of combustion.

In witness whereof I, the said A. B., have hereunto set my hand and seal, this first day of November, in the year of our Lord, one thousand eight hundred and seventy-six.

A. B. (L.S.)

Provisional and Complete Specifications for process and Apparatus for producing Electric Currents. Also for an Electric Arc.

PRODUCING AND REGULATING ELECTRIC CURRENTS (*a*).

A.D. 1873, *5th June*. No. 2006.

LETTERS PATENT to A. B. of No. —, —— Street, Westminster, in the county of Middlesex, for the invention of "Improvements in apparatus for producing and regulating electric currents, such apparatus being particularly applicable for electric lighting." A communication from abroad by C. D. and E. F., both of Berlin, in the German Empire.
Dated the 5th June, 1873.

Provisional Specification left by the said A. B. at the Office of the Commissioners of Patents on the 5th June, 1873.

A. B. of No. —, —— Street, Westminster, in the county of Middlesex. "Improvements in apparatus for producing and regu-

(*a*) This was the first patent for machines of the drum armature type, as distinguished from the Pacinotti or Gramme ring type.

lating electric currents, such apparatus being particularly applicable for electric lighting." [A communication from abroad by C. D. and E. F., both of Berlin, in the German Empire.]

This invention relates to apparatus for producing by mechanical power currents of electricity applicable more particularly to the production of electric lights, and for regulating automatically the currents applied to produce such lights.

The improved apparatus for producing the electric currents is of the following description. Between the poles or polar extensions of one or more magnets or electro-magnets is fixed an iron cylinder, leaving a space between its periphery and the faces of the magnetic poles, which are hollowed out to a cylindrical form concentric with the said cylinder. In this annular space a cylindrical shell of light metal or other material is caused by mechanical power to revolve round the axis of the cylinder. On this shell is wound insulated wire in a direction parallel to the axis, such wire crossing the ends of the shell from the outer periphery thereof on the one side to the outer periphery on the other side. There may be several such wire coils, each covering an arc of the periphery on each side of the shell. The ends of the wires constituting each such coil are connected respectively to pieces of metal, rollers, springs or brushes of conducting material which are insulated from one another, but which in their rotation with the shell and coils bear successively against two stationary conductors insulated from each other, which constitute the poles of the machine. On causing the shell with its coils to rotate by mechanical force, currents of electricity are generated in the coils as they successively pass the fixed magnetic poles, and by properly arranging the conductors from these several coils in relation to the poles of the magnet and to the conductors on which they bear in their rotation, these electric currents are transmitted through any conductor connecting the poles of the machine. The currents thus transmitted may be made either continuous or intermittent in one direction, or they may be made alternately reversed by suitably arranging the conductors from the several coils in relation to commutators connecting them successively during their rotation with the poles of the machine. The inner iron cylinder may itself be rendered magnetic by coiling on it longitudinally an insulated electric wire in the manner of what is known as Siemens' rotating armature, and in this case the outer magnets might be dispensed with.

Further, the inner iron cylinder, instead of being fixed, might be made to rotate, and in this case the separate shell for receiving the wire coils might be dispensed with, the wire being coiled longitudinally on the rotating iron cylinder itself. The wire may be coiled on the shell in two layers over an even number of divisions of the periphery of the shell, the two opposite divisions in each case having the same wires, but the ends of those wires being connected successively to insulated conductors in number equal to that of the divisions of the shell, which conductors revolve with the shell and come successively to bear against two fixed springs, rollers, or conducting brushes forming the poles of the machine. The connections of the several wires to these several conductors may be so arranged that a continuous current is produced by the rotation of the shell.

The apparatus described above may be modified in the following

manner. Two magnetic poles hollowed out to a cylindrical form are arranged opposite to each other, and in the centre between them is fixed a cylinder of iron with a wire coiled in longitudinal slots thereon in the manner of a Siemens' armature, so that when a current of electricity is passed through the coil the cylinder becomes magnetic, having its two sides presented towards the outer magnets of opposite polarity to them respectively. In the annular space between this central cylinder and the cylindrical poles outside of it is mounted a cylindrical shell of iron, having insulated wire wound round it longitudinally or parallel to its axis in a number of separate coils, each of which is connected to conductors in the manner described above. This cylindrical iron shell being caused to rotate by mechanical force between the outer and inner magnetic poles, currents of electricity are caused to pass along the wires coiled along it successively as each coil passes through one of the magnetic fields, and these currents are transmitted either directly or by commutators as above described to the main poles of the machine.

Instead of employing only two magnetic poles outside the cylindrical shell, four or a greater even number may be spaced round the circumference; and the interior magnet, instead of having its wire coiled only up the one side and down the opposite side, may have it coiled in four or a greater even number of recesses in the cylinder upwards and downwards, so as to give to the inner cylinder as many poles on its periphery as there are poles outside, each pole of the inner cylinder being of opposite polarity to the pole presented to it outside. By this arrangement the successive coils on the cylindrical iron shell are made to pass in each revolution of the shell through more than two magnetic fields, and consequently a more rapid succession of currents is generated by them.

The electro magnets used in the apparatus above described may be rendered active by electricity from any source, and for this purpose the electricity produced by the movement of the apparatus itself may be employed without any extraneous source of electric power.

In apparatus such as have been described the successive coils have to be brought successively into connection with the main circuit by means of conductors or contact makers which the ends of their wires successively pass in their rotation. Such contact makers usually consist of metallic springs or brushes or of metallic rollers mounted on springs which are pressed against insulated pieces of metal connected to the wires of the several coils. As these pieces successively pass the contact-maker, when contact is made and broken suddenly, sparks are produced, whereby the efficiency of the apparatus is impaired, and the contact parts are gradually wasted.

In order to diminish or entirely avoid the production of such sparks, the insulated pieces of metal connected to the wires of the coils are, according to the present invention, made not rigid but elastic so that they can yield a little to the spring, brush or roller under which they pass and thereby remain somewhat longer in contact, or that the one shall not leave contact before the next has come into contact.

The electric currents produced by apparatus such as have been described above may be employed for any purpose to which currents of electricity are ordinarily applied, but they are more particularly applicable to the production of electric light in electric lamps provided

with automatic regulating apparatus such as will presently be described. And as such currents are produced by working the apparatus by mechanical power, so, conversely, by transmitting electric currents through the coils of such apparatus, the inner cylinder or shell will be caused to rotate and thus the apparatus may be employed as an *electromotor*.

In electric lamps as usually constructed where the electrical current is caused to pass through carbon points, the distance of those points is regulated by clockwork, which is influenced by an electro-magnet placed within the electric circuit, so that the points are caused to approach when the current is reduced in strength.

According to the present invention, the carbon points of electric lamps are caused to approach to or recede from one another by the action of the electric current itself, entirely or partly without the intervention of clockwork or other mechanism driven by any extraneous power. And the regulating apparatus is applicable whether the light be produced by alternating reversed currents or by a continuous current in one direction.

For this purpose the lamp is provided with two electro-magnets, the one of which has a coil of few convolutions of thick wire in the direct circuit of the current which passes through the carbon points, offering little resistance to that current. The other electro-magnet has many convolutions of fine wire in a branch circuit or shunt from the main circuit, offering considerable resistance to the passage of a current through the said branch circuit. While the carbon points are so near each other that the current can pass from the one to the other with little resistance the electro-magnet first named is rendered active while the second remains comparatively inert. But when the carbon points are at such distance as to offer a greater resistance to the current, a larger portion of that current has to pass through the shunt circuit, and the second magnet therefore becomes active while the first becomes comparatively inert.

Each of these magnets is provided with an armature which vibrates when its magnet is active so as to work a pawl on a ratchet wheel connected to the stems holding the carbon points by screws or other gearing, in such a manner that when the first magnet is active the carbon points are gradually withdrawn from one another, but when the second is active they are made to approach each other.

Thus the proximity of the carbon points is maintained in constant relation to the strength of the current, which relation is in the first place determined by the adjustment of the armature springs or other portions of the mechanism by which the armatures are connected to the point holders.

In a modified form of this apparatus suitable for a continuous current, one of the magnets may be dispensed with, a weight or spring or the weight of the carbon holder itself being used to produce the movement which that magnet would effect, the magnet which is retained acting in opposition to this movement when the electric resistance calls it into play. In such cases the movement effected by the weight, spring or weight of the carbon holder may be rendered slow and gentle by a fly or other suitable resistance, and the opposing movement of the magnet armature may be rendered independent of such fly by connecting it through a pawl and ratchet wheel.

The automatic regulating apparatus above described may be applied to electric lamps worked by currents of electricity produced by apparatus of any known kind, as well as to those worked by currents produced as hereinbefore described.

Specification in pursuance of the conditions of the Letters Patent filed by the said A. B. in the Great Seal Patent Office on the 4th December, 1873.

A. B. of No. —— —— Street Westminster in the County of Middlesex. "Improvements in Apparatus for producing and regulating Electric Currents, such Apparatus being particularly applicable for Electric Lighting." A communication from abroad by C. D. and E. F. both of Berlin in the German Empire.

This Invention relates to apparatus for producing by mechanical power currents of electricity applicable more particularly to the production of electric lights, and for regulating automatically the currents applied to produce such lights.

The improved apparatus for producing the electric currents is of the following description. Between the poles or polar extensions of one or more magnets or electro-magnets is fixed an iron cylinder leaving a space between its periphery and the faces of the magnetic poles which are hollowed out to a cylindrical form concentric with the said cylinder. In this annular space a cylindrical shell of light metal or other material is caused by mechanical power to revolve round the axis of the cylinder. On this shell is wound insulated wire in a direction parallel to the axis, such wire crossing the ends of the shell from the outer periphery thereof on the one side to the outer periphery on the other side. There may be several such wire coils each covering an arc of the periphery on each side of the shell. The ends of the wires constituting each such coil are connected respectively to pieces of metal, rollers, springs or brushes of conducting material which are insulated from one another but which in their rotation with the shell and coils bear successively against two stationary conductors insulated from each other which constitute the poles of the machine. On causing the shell with its coils to rotate by mechanical force currents of electricity are generated in the coils as they successively pass the fixed magnetic poles and by properly arranging the conductors from these several coils in relation to the poles of the magnet and to the conductors on which they bear in their rotation, these electric currents are transmitted through any conductor connecting the poles of the machine. The currents thus transmitted may be made either continuous or intermittent in one direction or they may be made alternately reversed by suitably arranging the conductors from the several coils in relation to commutators connecting them successively during their rotation with the poles of the machine. The inner iron cylinder may itself be rendered magnetic by coiling on it longitudinally an insulated electric wire in the manner of what is known as Siemens' rotating armature, and in this case the outer magnets might be dispensed with.

Further, the inner iron cylinder, instead of being fixed, might be made to rotate, and in this case the separate shell for receiving the

wire coils might be dispensed with, the wire being coiled longitudinally on the rotating iron cylinder itself. The wire may be coiled on the shell in two layers over an even number of divisions of the periphery of the shell, the two opposite divisions in each case having the same wires, but the ends of those wires being connected successively to insulated conductors, in number equal to that of the divisions of the shell, which conductors revolve with the shell and come successively to bear against two fixed springs, rollers or conducting brushes, forming the poles of the machine. The connections of the several wires to these several conductors may be so arranged that a continuous current is produced by the rotation of the shell.

The apparatus described above may be modified in the following manner. Two magnetic poles hollowed out to a cylindrical form are arranged opposite to each other, and in the centre between them is fixed a cylinder of iron with a wire coiled in longitudinal slots thereon in the manner of a Siemens' armature, so that when a current of electricity is passed through the coil the cylinder becomes magnetic, having its two sides presented towards the outer magnets of opposite polarity to them respectively. In the annular space between this central cylinder and the cylindrical poles outside of it is mounted a cylindrical shell of iron, having insulated wire wound round it longitudinally or parallel to its axis in a number of separate coils, each of which is connected to conductors in the manner described above. This cylindrical iron shell being caused to rotate by mechanical force between the outer and inner magnetic poles, currents of electricity are caused to pass along the wires coiled along it successively as each coil passes through one of the magnetic fields, and these currents are transmitted either directly or by commutators as above described to the main poles of the machine.

Instead of employing only two magnetic poles outside the cylindrical shell, four or a greater even number may be spaced round the circumference; and the interior magnet, instead of having its wire coiled only up the one side and down the opposite side, may have it coiled in four or a greater even number of recesses in the cylinder upwards and downwards so as to give to the inner cylinder as many poles on its periphery as there are poles outside, each pole of the inner cylinder being of opposite polarity to the pole presented to it outside. By this arrangement, the successive coils on the cylindrical iron shell are made to pass in each revolution of the shell through more than two magnetic fields, and consequently a more rapid succession of currents is generated by them.

The electro-magnets used in the apparatus above described may be rendered active by electricity from any source, and for this purpose the electricity produced by the movement of the apparatus itself may be employed without any extraneous source of electric power.

In apparatus such as have been described the successive coils have to be brought successively into connection with the main circuit by means of conductors or contact makers which the ends of their wires successively pass in their rotation.

Such contact makers usually consist of metallic springs or brushes or of metallic rollers mounted on springs which are pressed against insulated pieces of metal connected to the wires of the several coils. As these pieces successively pass the contact maker when contact is

made and broken suddenly, sparks are produced, whereby the efficiency of the apparatus is impaired, and the contact parts are gradually wasted.

In order to diminish or entirely avoid the production of such sparks, the insulated pieces of metal connected to the wires of the coils are, according to the present invention, made not rigid, but elastic, so that they can yield a little to the spring, brush or roller under which they pass, and thereby remain somewhat longer in contact, or that the one shall not leave contact before the next has come into contact.

The electric currents produced by apparatus such as have been described above may be employed for any purpose to which currents of electricity are ordinarily applied, but they are more particularly applicable to the production of electric light in electric lamps provided with automatic regulating apparatus such as will be presently described. And as such currents are produced by working the apparatus by mechanical power, so, conversely, by transmitting electric currents through the coils of such apparatus, the inner cylinder or shell will be caused to rotate, and thus the apparatus may be employed as an electro-motor.

In electric lamps as usually constructed, where the electrical current is caused to pass through carbon points, the distance of those points is regulated by clockwork which is influenced by an electro-magnet placed within the electric circuit, so that the points are caused to approach when the current is reduced in strength.

According to the present invention, the carbon points of electric lamps are caused to approach to or recede from one another by the action of the electric current itself, entirely or partly without the intervention of clockwork or other mechanism driven by any extraneous power. And the regulating apparatus is applicable whether the light be produced by alternating reversed currents or by a continuous current in one direction.

For this purpose the lamp is provided with two electro-magnets, the one of which has a coil of few convolutions of thick wire in the direct circuit of the current which passes through the carbon points, offering little resistance to that current. The other electro-magnet has many convolutions of fine wire in a branch circuit or shunt from the main circuit, offering considerable resistance to the passage of a current through the said branch circuit. While the carbon points are so near each other that the current can pass from the one to the other with little resistance, the electro-magnet first named is rendered active, while the second remains comparatively inert. But when the carbon points are at such distance as to offer a greater resistance to the current, a larger portion of that current has to pass through the shunt circuit and the second magnet therefore becomes active, while the first becomes comparatively inert.

Each of these magnets is provided with an armature which vibrates when its magnet is active so as to work a pawl on a ratchet wheel connected to the stems holding the carbon points by screws or other gearing in such a manner that when the first magnet is active the carbon points are gradually withdrawn from one another, but when the second is active they are made to approach each other. Thus the proximity of the carbon points is maintained in constant relation to the strength of the current, which relation is in the first place determined

by the adjustment of the armature springs or other portions of the mechanism by which the armatures are connected to the point holders.

In a modified form of this apparatus suitable for a continuous current, one of the magnets may be dispensed with, a weight or spring or the weight of the carbon holder itself being used to produce the movement which that magnet would effect, the magnet which is retained acting in opposition to this movement when the electric resistance calls it into play. In such cases, the movement effected by the weight, spring, or weight of the carbon holder may be rendered slow and gentle by a fly or other suitable resistance, and the opposing movement of the magnet armature may be rendered independent of such fly by connecting it through a pawl and ratchet wheel.

The automatic regulating apparatus above described may be applied to electric lamps worked by currents of electricity produced by apparatus of any known kind as well as to those worked by currents produced as hereinbefore described.

Description of the Drawings.

[*As we are unable to give the drawings here, the detailed description is omitted.*]

Having thus described the nature of this invention and in what manner the same is to be performed as communicated to me from my foreign correspondents, I claim,—

Claims.

First, the use of apparatus for producing electric currents by the application of mechanical force, in which apparatus a shell coiled longitudinally with insulated conducting wires on its outside is made to revolve in the annular space between fixed external magnetic poles or polar extensions, and a fixed internal cylinder of iron which may be independently magnetised, substantially as herein described.

Second, the use of apparatus of the kind above referred to, in which the wire, instead of being coiled along a shell, is coiled longitudinally over the external surface of an iron cylinder which is made to revolve within magnetic poles, or polar extensions, substantially as herein described.

Third, in apparatus such as is above referred to, the use of a rotating shell coiled both externally and internally in combination with fixed external and internal magnets, substantially as herein described.

Fourth, the method substantially as herein described in reference to Figs. 4 and 8, Sheet I., of coiling the wires of the shell of apparatus, such as is referred to above, whether such wires are single or in duplicate, and of connecting them to the poles of the apparatus.

Fifth, the use in apparatus such as is referred to above of spring terminals for the wires of the coils, arranged cylindrically or radially so as to be brought by rotation successively in contact with spring rollers, substantially in the manner and for the purpose herein set forth.

Sixth, the use for automatically regulating the distance of the carbon points of electric lamps, of two electro-magnets working a wheel in opposite directions by means of pawls, such magnets being rendered active or inert according as the electrical resistance varies, substantially as herein described in reference to Figs. 15 and 16, Sheet I.

Seventh, the use for automatically regulating the distance of the carbon points of electric lamps of one electro-magnet, working by a pawl a wheel in opposition to a weight or spring, the said magnet being rendered active or inert according as the electrical resistance varies, substantially as herein described in reference to Fig. 17, Sheet I.

In witness whereof I, the said A. B., have hereunto set my hand and seal this second day of December in the year of our Lord one thousand eight hundred and seventy-three.

A. B. (L.S.)

IV.—Rectification of the Register.

Notice of Motion for Rectification of Register of Patents by the Court (*a*).

In the High Court of Justice,
Chancery Division.
Mr. Justice ——

In the Matter of letters patent granted to A. B. for —— bearing date the —— day of —— 18— No. ——

and

In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888.

Take notice that the Court will be moved before his lordship Mr. Justice —— on —— the —— day of —— 18— or so soon thereafter as counsel can be heard by Mr. —— of counsel on behalf of C. D., of —— that the Register of Patents kept under the authority of the above-mentioned Act, may be rectified by expunging the entry relating to the above-mentioned letters patent made in the Register of Patents on the —— day of —— 18— by or on behalf of the said A. B., or that such further and other order may be made for the rectification of the said register as to this Court shall seem just, and that the said A. B. may pay to the applicant his costs of this application to be taxed by the taxing master.

Dated the —— day of —— 18—

(Signed) —— of ——
Solicitor for the above-named C. D.

To Mr. A. B., and to Messrs. —— his solicitors [and the Comptroller-General of Patents, Designs, and Trade-Marks].

(*a*) This notice of motion will be easily varied to meet the other cases which may arise under Act of 1883, s. 90, as amended by Act of 1888, s. 23. See p. 705.

Order Expunging Entry in Register of Patents (*b*).

Upon motion, &c., this Court doth order that the entry relating to the above-mentioned letters patent made in the Register of Patents of the Patent Office on the —— day of —— by or on behalf of the said A. B. be expunged from such register, and it is ordered that A. B. do pay to the applicant his costs of this application, such costs to be taxed by the taxing master, and it is ordered that an office copy of this order be served upon the Comptroller-General of Patents.

Notice to Comptroller.

Order for Rectification of Register refused.

In the Matter of the letters patent granted to P. of —— bearing date the —— day of —— No. —— for the invention of an improved process of treating certain descriptions of auriferous and argentiferous material for the purpose of facilitating the separation of the metals contained therein,

and

In the Matter of the Patents, Designs, and Trade Marks Act, 1883.

North, J. 11th January, 1888. B. 150.

Upon motion this day made unto this Court by counsel for H., of —— that a full and proper entry might be made in the Register of Patents of a document dated the —— of —— and duly signed by the applicant and by the above-named P., relating to and affecting the proprietorship of the above-mentioned letters patent, and that the said P. should be ordered to pay the costs of such motion, and upon hearing counsel for the said P., and for the Comptroller-General of Patents, Designs, and Trade Marks, and upon reading an affidavit of, &c., this Court doth not think fit to make any order upon the said motion, but doth order that H. do pay to the said P., widow, and to the said Comptroller, their costs of the said motion, to be taxed by the taxing master.

(*b*) See Seton, vol. 1, p. 342, for form of order expunging entry in former register of proprietors.

V.—Assignments, &c. (*c*).

Assignment.

THIS INDENTURE, made the —— day of —— 18— between A. B. of ———— of the first part, and C. D. of ———— of the other part.

Recital of patent. WHEREAS the said A. B. obtained the letters patent in Great Britain and Isle of Man, dated the —— day of —— 18— and numbered —— for —— [*Title*].

Consideration. Assignment. NOW THIS INDENTURE WITNESSETH, and in consideration of the sum of £—— paid to the said A. B. (the receipt whereof he doth hereby acknowledge), the said A. B., as beneficial owner, doth hereby assign unto the said C. D., his executors, administrators, and assigns, all those the before-mentioned letters patent, and the liberties, privileges, profits, emoluments, and advantages belonging thereto, to hold the said letters patent unto the said C. D., his executors, administrators, and assigns absolutely: And the said A. B. doth hereby covenant with the said C. D., his executors, administrators, and assigns, that he, the said A. B., hath not at any time done or knowingly been party or privy to any act, deed, or thing whereby he is prevented from assigning the said letters patent in manner aforesaid, or whereby the same is or may be in anywise encumbered. IN WITNESS whereof the said parties to these presents have hereunto set their hands and seals the day and year first above written.

Covenant as to validity.

Form of Assignment of Patent to Inventor by Communicator.

THIS INDENTURE made the —— day of —— 18— BETWEEN ——.

Recital of patent. WHEREAS by letters patent dated the —— day of —— 18— and numbered —— Her present Majesty Queen Victoria did give and grant to the assignor her especial licence, full power, sole privilege and authority that the assignor, his executors, administrators, assigns, by himself, his agents or licensees and no others, might at all times thereafter during the term of fourteen years from the date of the said letters patent, make, use, exercise, and vend within the United Kingdom of Great Britain and Ireland and Isle of Man in such manner as to him or them might seem meet an invention of —— (a communication to him from abroad by the assignee.)

Patent of communication. AND WHEREAS the said letters patent were so obtained as aforesaid by the assignor as agent for and on behalf of the assignee. AND the assignor is possessed of the said invention and letters patent as a trustee for the assignee. AND WHEREAS the assignee requested the assignor to execute such an assignment of the said invention and letters patent as is hereafter contained.

Assignment. NOW THIS INDENTURE WITNESSETH that in pursuance of the said request and in consideration of the premises, the assignor

(*c*) For very full forms of assignments, licences, mortgages, agreements, and other conveyancing matters connected with patents, see Morris's Patents Conveyancing, 1887.

DOTH hereby as trustee assign and convey unto the assignee —— executors, administrators, and assigns, ALL THAT the said invention hereinbefore mentioned: AND the hereinbefore recited letters patent: AND the full and exclusive benefit and advantage thereof respectively and of any extension of the term of the said letters patent: AND all rights, benefits, and advantages whatsoever to the same invention, letters patent, and premises belonging; TO HOLD the same unto the assignee —— executors, administrators, and assigns, during all the residue now unexpired of the said term of fourteen years by the said letters patent granted and during any extension of the said term. IN WITNESS whereof the assignor has hereunto set his hand and seal the day and year first above written.

Signed, sealed and delivered by the above-named —— in the presence of ——.

Assignment by Agent who has taken out Patent as a Communication from Abroad to a Company at request of Inventor.

THIS INDENTURE made the —— day of —— 18— between —— of —— in the City of London, Fellow of the Institute of Patent Agents, of the first part; —— of —— France, Engineer, of the second part; and —— carrying on business at ——, hereinafter called the said company, of the third part. Date. Parties. Recitals.

WHEREAS the said —— is the grantee of letters patent for [*title*], dated the —— day of —— 18— No. ——. Letters patent.

AND WHEREAS the invention, the subject of the said letters patent, was communicated to the said —— by the said —— and the said letters patent were applied for and obtained, and are now held by the said —— on behalf of and as trustee for the said ——. Communication.

AND WHEREAS the said —— has requested the said —— to assign the whole interest in the said letters patent to the said company. Request to assign.

NOW THIS INDENTURE WITNESSETH, that in pursuance of such request, and in consideration of the sum of —— by the said company to the said —— well and truly paid, the receipt whereof is hereby acknowledged, the said —— hereby assigns unto the said company, their successors and assigns, and which assignment the said —— confirms by his signature to, and execution of these presents, ALL THOSE the letters patent and premises respectively hereinbefore mentioned, and the full and exclusive benefit and advantage, and all the right, title, interest, benefit, property, claim, and demand whatsoever of him the said —— into, upon, or in respect of the said letters patent and premises. TO HAVE, hold, use, exercise, and enjoy the said letters patent and premises unto and by the said company, their successors and assigns, for their sole use and benefit. And the said —— doth hereby for himself, his heirs, executors, and administrators, covenant with the said company, their successors and assigns, that he hath not at any time heretofore made, done, committed, or suffered any act, deed, matter, or thing whatsoever whereby or by reason whereof Consideration. Assignment. Covenant as to validity.

the said letters patent and premises, or any of the privileges thereby granted, have been affected, encumbered, or impeached in title, estate, or otherwise whatsoever. IN WITNESS whereof the parties hereto have hereunto set their hands and seals, the day and year first above written.

Agreement as to Purchase of Patents.

Date. Parties.

MEMORANDUM OF AGREEMENT made this —— day of —— 18— BETWEEN —— of —— and —— of —— hereinafter called the vendors of the one part, and —— of —— hereinafter called the purchaser of the other part. WHEREAS it has been agreed between the parties hereto as follows:—

Purchase and consideration.

1. The vendors shall sell and the purchaser shall purchase all and singular the patents and like privileges specified in the schedule hereto, and the respective inventions and processes for which the same were granted, and all the interests of the vendors therein and the full and exclusive benefits and advantages thereof respectively, with the benefit of all renewals of the same and improvements thereon at the price of £—— payable to the vendors other than the said —— as follows, namely: £—— on the completion of this agreement; £—— in nine months from the date hereof; and £—— in fully paid up share in any company which the purchaser may form for acquiring such patents.

Forfeiture of deposit.

2. In the event of the said sum of £—— not being paid, and the said shares not being handed over within the aforesaid space of nine months, the said sum of £—— so paid as aforesaid shall be forfeited and received by the vendors as liquidated damages, and this agreement thereupon be deemed cancelled, and everything herein contained as though the same had never been entered into, and the vendors and purchasers shall not be at liberty to enforce the same in any way whatsoever.

Assignment.

3. Upon payment of the said sum of £—— and delivery of the said shares, the vendors will execute a proper assignment of the said patents, and of any other patents referred to in clause 7 hereof, such assignment to be prepared by and at the expense of the purchaser, but to be executed by the vendors and all other proper parties at the expense of the vendors.

Foreign patents, &c.

4. The vendors will, at the expense of the purchaser, at all times after the completion of this agreement, when requested by the purchaser so to do, do all such acts and things as may be necessary to enable the purchaser to make any application for and obtain such foreign colonial or other patents as the purchaser may require, such patents to belong to the vendors until the completion of this purchase, and also will, if required by the purchaser so to do, for —— months until completion of the purchase concur in granting, or do such acts and things as may be necessary to enable the purchaser to grant

Licences.

licences to any persons as the purchaser may require, provided that in the event of the balance of the purchase-money of £—— not being paid within the time aforesaid, the vendors shall have the full benefit

of such licences, together with any sums which shall have been received by the purchaser in respect thereof. If at any time hereafter the vendors or any of them shall become aware of any improvement or alteration which may prove an improvement in the machine apparatus or process the subject of the patents specified in the schedule hereto, or capable of being applied thereto, they or he will forthwith communicate such improvements or alterations to the purchaser, and, if required by the purchaser so to do, apply for and obtain at the expense of the purchaser such further grant of letters patent or other legal protection, or do all such acts and things at the expense of the purchaser as may be necessary to enable the purchaser to obtain the same, as may be required by the purchaser. Improvements.

5. The vendors hereby agree with the purchaser that they have not done or committed, or been party or privy to, any act, matter, or thing, whereby they are hindered from entering into this agreement, and that they have good right to the same. Covenant as to title.

As witnesseth the hand of the said —— the day and year first above written.

THE SCHEDULE above referred to.

VI.—Action of Infringement.

Indorsement on Writ (*d*).

The plaintiff's claim is for damages for the infringement of the plaintiff's patent.

And for an injunction to restrain the defendant from infringing the plaintiff's patent.

Indorsement on Writ (Another Form).

1. The plaintiffs' claim is for an injunction to restrain the defendants, their servants and agents, from manufacturing, selling, or exposing for sale —— in infringement of the plaintiffs' patent dated the —— day of —— 18— or from making, selling, or exposing for sale, articles in colourable imitation of the articles manufactured by the plaintiffs under their said letters patent. Injunction.

2. Damages, or, at the option of the plaintiffs, an account of the proceeds of sale of all such articles manufactured and sold by the defendants as aforesaid in infringement of the plaintiffs' said patent. Damages.

3. Delivery up to the plaintiffs or destruction of all articles in the possession of the defendants made in infringement of the plaintiffs' said patent. Infringing articles.

4. Costs.

(*d*) R. S. C., 1883, Appendix A., Part III., Sect. IV.

Statement of Claim (*e*).

Infringement. The defendant has infringed the plaintiff's patent, No. 14,084, granted for the term of fourteen years, from the 21st of May, 1880, for certain improvements in the manufacture of iron and steel, whereof the plaintiff was the first inventor.

Injunction and damages. The plaintiff claims an injunction to restrain the defendant from further infringement and 100*l.* damages.

Particulars of breaches are delivered herewith.

Place of trial, Durham.

(Signed)
Delivered

Statement of Claim (Another Form).

188 . B. No. .

In the High Court of Justice,
Chancery Division.
Vice-Chancellor Bacon.

Writ issued ——.

Between—The A. B. Company and The C. D. Company, Limited, - - - - - - Plaintiffs,
and
E. F. and the G. H. Company, Limited - Defendants.

STATEMENT OF CLAIM.

Ownership in patents. 1. The plaintiffs, the C. D. Company, Limited, are the registered legal owners of the letters patent dated the —— day of —— 18— and numbered —— for an invention of improvements in electric lamps, and in the method of manufacturing the same. Such letters patent were duly assigned to the said company by an indenture dated the —— day of —— 18— which was registered in the Great Seal Patent Office on the —— day of —— 18— since which date the said company have remained the sole registered owners of such letters patent.

2. The plaintiffs, the A. B. Company, Limited, are the registered legal owners of the letters patent dated the —— day of —— 18— and numbered —— as amended by disclaimer dated the —— day of —— 18— Such letters patent were duly assigned to the said last-mentioned company by an assignment dated the —— day of —— 18— which was duly registered in the Great Seal Patent Office on the —— day of —— 18— since which date the said company have remained the sole registered owners of such letters patent.

3. The whole legal and beneficial interest in each of the above-mentioned letters patent is vested in the plaintiffs, or one of them, and has been so vested ever since the —— day of —— 18— and the —— day of —— 18— respectively.

4. The said respective letters patent are good and valid, and are and have been ever since the granting thereof of full force and effect.

(*e*) R. S. C., 1883, Appendix C., Form 6.

5. Since the said —— day of —— 18— and prior to the issue of the writ herein, the defendants have infringed the said letters patent numbered —— of 18— and have made, sold, supplied, let on hire, and used incandescent electric lamps manufactured according to the invention in respect of which such letters patent were granted, and they threaten and intend to continue so to do, unless restrained by the order of this honourable Court. Infringement.

6. Since the said —— day of —— 18— and prior to the issue of the writ herein, the defendants have infringed the said letters patent numbered —— of 18— as so amended by disclaimer, and have made, sold, supplied, let on hire, and used incandescent electric lamps, manufactured according to the invention in respect of which the said letters patent, as so amended, were granted, and they threaten and intend to continue so to do, unless restrained by the order of this honourable Court.

The plaintiffs claim as follows:—

1. That the defendants, their servants, agents, and workmen, may be restrained by injunction during the continuance of each of the said letters patent from manufacturing, selling, letting on hire, supplying, or using any electric lamps manufactured according to or in the manner described in the specifications filed in pursuance of such respective letters patent, or according to or in any manner only colourably differing from the same, and generally from infringing the rights of the plaintiffs in respect of such letters patent. Injunction.
2. That the defendants may be ordered to deliver up to the plaintiffs all such electric lamps as aforesaid as are in the possession or power of the defendants. Infringing articles.
3. That an account may be taken of all gains and profits made by the defendants by the manufacture, sale, letting on hire, supply, or user of such electric lamps manufactured, sold, let on hire, supplied, or used by the defendants, or by any person or persons by the order or for the use of the defendants, and that the defendants may be ordered to pay the amount of such gains and profits to the plaintiffs. Account.
4. That the defendants may be ordered to pay damages to the plaintiffs for the infringement of their said patent rights. Damages.
5. That the defendants may be ordered to pay the costs of this action. Costs.
6. The plaintiffs claim their full costs, charges, and expenses as between solicitor and client. In two actions brought by the plaintiffs and others against Messrs. W. and R. and the W. and R. Electric Manufacturing Company, Limited, for infringements of the said respective letters patent, Mr. Justice —— certified that the validity of the said respective letters patent came in question. Costs as between solicitor and client.
7. That the plaintiffs may have such further or other relief as the nature of the case may require.

(Signed) ——

Delivered the —— day of —— 18— by —— of —— in the —— solicitors for the plaintiffs.

Statement of Claim (Another Form).

Infringement

1. The defendants have infringed the plaintiff's patent, No. 9073, granted for the term of fourteen years from the —— day of —— 18— on a communication from abroad by the —— of —— in the United States of America to —— of the firm of —— patent agents —— in the county of —— for certain improvements in the manufacture of bustles or dress improvers whereof the said —— is the first and true inventor.

2. The said letters patent have been duly vested in the plaintiffs.

The plaintiffs claim—

Injunction.

1. An injunction to restrain the defendants, their servants and agents, from manufacturing, selling, or exposing for sale, bustles or dress improvers in infringement of the said patent, or from making, selling, or exposing for sale articles in colourable imitation of the articles manufactured by the plaintiffs under their said letters patent.

Damages or account.

2. Damages, or at the option of the plaintiffs an account of the proceeds of all such articles manufactured and sold by the defendants as aforesaid in infringement of the plaintiffs' said patent.

Infringing articles.

3. Delivery up to the plaintiffs or destruction of all articles in the possession of the defendants made in infringement of the plaintiffs' said patent.

Costs.

4. Costs.

Particulars of breaches are delivered herewith.

Delivered, &c.

Particulars of Breaches.

Delivered the —— day of —— 18— by —— of —— in the —— Solicitors for the Plaintiffs.

First Patent:

The following are particulars of breaches complained of by the plaintiffs in this action, that is to say:—

Infringement by user.

1. The defendant E. F. has, at divers times since the —— day of —— 18— and prior to the issuing of the writ herein, used electric lamps manufactured according to, or in a manner only colourably differing from, the invention comprised in the letters patent dated the —— day of —— 18— and numbered —— In particular the defendant E. F. has used such lamps continuously from the —— day of —— 18— up to the issuing of the writ herein, at the —— in the county of —— and the gardens adjoining the same.

Vending, &c.

2. The defendants, the G. H. Company, Limited, have at divers times since the —— day of —— 18— sold, supplied, let on hire, and used electric lamps manufactured according to, or in a manner only colourably differing from, the invention comprised in the letters patent dated the —— day of —— 18— and numbered —— In particular, the defendants, the G. H. Company, Limited, have sold, supplied, let on

hire, and used such lamps continuously from the —— day of —— 18— up to the issuing of the writ herein, to and for the defendant E. F. at the —— in the county of —— and the gardens adjoining the same.

3. The defendants, the G. H. Company, Limited, have prior and up to the date of the writ herein publicly offered, by advertisement and otherwise, to supply such lamps to the general public, and still continue so to do.

4. The precise number and date of the defendants' infringements, save as hereinbefore mentioned, are not at present known to the plaintiffs, but the plaintiffs will claim to recover full compensation from the defendants in respect of all such infringements.

5. With respect to the letters patent numbered —— of 18— the breaches complained of are infringements of the inventions described and claimed in the first, second, and fourth claiming clauses of the said letters patent. What claims infringed.

6. The defendant E. F. has at divers times since the —— day of —— 18— and prior to the issuing of the writ herein used electric lamps manufactured according to, or in a manner only colourably differing from, the invention comprised in the letters patent dated the —— day of —— 18— and numbered 4847, as amended by disclaimer, allowed the —— day of —— 18—. In particular, the defendant E. F. has used such lamps continuously from the —— day of —— 18— up to the issuing of the writ herein, at the —— in the county of —— and the gardens adjoining the same. *Second Patent:* Infringement by user.

7. The defendants, the G. H. Company, Limited, have at divers times since the —— day of —— 18— and prior to the issuing of the writ herein manufactured, sold, supplied, let on hire, and used, electric lamps manufactured according to or in a manner only colourably differing from the invention comprised in the letters patent dated the —— day of —— 18— and numbered 4847, as amended by disclaimer, allowed the —— day of —— 18— In particular, the defendants, the G. H. Company, Limited, have sold, supplied, let on hire, and used such lamps continuously from the —— day of —— 18— up to the issuing of the writ herein, to and for the defendant E. F., at the —— in the county of —— and the gardens adjoining the same. Vending, &c.

8. The said defendants, the G. H. Company, Limited, have prior and up to the date of the writ herein publicly offered, by advertisement and otherwise, to supply such lamps to the general public, and still continue to do so.

9. The precise number and dates of the defendants' infringements, save as hereinbefore mentioned, are not at present known to the plaintiffs, but the plaintiffs will claim to recover full compensation from the defendants in respect of all such infringements.

10. The breaches complained of are infringements of the inventions described and claimed in the first and second claiming clauses of the said letters patent, as amended by disclaimer as aforesaid. Claims infringed.

Order for further Particulars of Breaches.

Tilghman's Patent Sand Blast Company, Limited v. *Wright.* Pearson, J. 1st May, 1884. B. 582.

Upon the application of the defendants for directions under Order 30, Rule 1 of the Rules of the Supreme Court, 1883, which, upon hearing the solicitors for the applicants and for the plaintiffs, and upon reading the writ of summons issued the —— the statement of claim and particulars hereinafter mentioned delivered the —— and an affirmation of —— was adjourned to be heard accordingly upon hearing counsel for the applicants and for the plaintiffs, and upon reading the said affirmation, an order dated —— made in an action entitled —— an affidavit of —— in the last-mentioned action, and the particulars in writing of the breaches alleged to have been committed by the defendants delivered by the plaintiffs on the —— with their statement of claim. This Court being of opinion that such particulars are insufficient doth order that the plaintiffs do deliver to the defendants further and better particulars in writing of the breaches alleged to have been committed by the defendants upon which the plaintiffs intend to rely on the trial of this action. And it is ordered that the costs of the said application in chambers, and occasioned by the adjournment thereof into Court, be costs in the action.

Defence (*a*).

1. The defendant did not infringe the patent.
2. The invention was not new.
3. The plaintiff was not the first or true inventor.
4. The invention was not useful.
5. [*Denial of any other matter of fact affecting the validity of the patent.*]
6. The patent was not assigned to the plaintiff.

(Signed)
Delivered

Statement of Defence in Action on Two Patents.

Defence as to Letters Patent No. 4576 of 18— granted to ——.

Title denied.

1. The defendants do not admit that the C. D. Company are the registered legal owners of the letters patent No. 4576 of 18— granted to —— or that the same were duly assigned to them.

(*a*) R. S. C., 1883, Appendix D., Sect. XII.

2. The defendants deny that the said letters patent are good or valid or of any force or effect. Patents invalid.

3. The defendants deny that they have infringed the said letters patent. Infringement denied.

4. Particulars of the objections upon which the defendants intend to rely at the trial of this action are delivered herewith.

DEFENCE as to Letters Patent No. 4847 of 18— granted to ——.

1. The defendants do not admit that the A. B. Company, Limited, are the registered legal owners of the letters patent No. 4847 of 18— granted to —— or that the same were duly assigned to them. Title denied.

2. The defendants deny that the said letters patent are good or valid or of any force or effect. Patents invalid.

3. The amendment made on or about the —— day of —— 18— pursuant to the determination of the law officers of the specification filed in pursuance of the said letters patent was not such as could be made by law, and extends the exclusive privileges granted by the said letters patent. Amendment of specification invalid.

4. The defendants deny that they have infringed the said letters patent. Infringement denied.

5. Particulars of the objections upon which the defendants intend to rely at the trial of this action are delivered herewith.

Delivered, &c.

Defence.

The defendants say that:—

1. The defendants have not infringed the plaintiffs' letters patent in the statement of claim mentioned. Infringement denied.

2. —— named in the statement of claim was not the true and first inventor of the alleged invention comprised in the said letters patent. Not true and first inventor.

3. The plaintiffs' letters patent are invalid on the grounds stated in the particulars of objections delivered herewith. Patent invalid.

4. The defendants do not admit that the said letters patent have been duly vested in the plaintiffs. Title denied.

5. The bustles complained of in the statement of claim and particulars of breaches delivered in this action, and which are sold by the defendants, are identical with certain bustles which for several years previously to the date of the plaintiffs' said letters patent were sold in —— by the —— company in the statement of claim named (hereinafter called the —— company) under the name of Health Braided Wire Bustle (hereinafter called the "Health Bustle"). The said Health Bustle was marked by the —— company with the dates of three American patents, viz., —— 18—, —— 18— and —— 18— and the said —— company thereby intended to inform the public as the fact is that the said

Health Bustle was made according to the alleged inventions covered by the three American patents aforesaid. Each of the inventions comprised in the said three American patents was subsequently patented in England in two separate patents, one of which is a patent of —— No. 1235 of 188— and the other of which is a patent No. 10191 of 188— The said patent of —— expired (through non-payment of duty) before the date of the plaintiffs' said letters patent, and the said patent No. 10191 of 188— relates only to pillows, cushions, or similar articles, and does not include bustles. The defendants, therefore, say that if the plaintiffs' said letters patent are valid (which they deny) they can only be valid for a bustle different from the said Health Bustle, and that the defendants by selling a bustle identical with the Health Bustle as aforesaid have not infringed and do not infringe the plaintiffs' said letters patent. The plaintiffs' said letters patent were obtained by —— in the statement of claim named as agent and trustee for the —— company, and the plaintiffs are either purchasers from the —— company of all the last-mentioned company's interest in the said patents, or they are the agents of the last-mentioned company, or connected with the last-mentioned company in some manner unknown to the defendants, and they have in fact always had full knowledge of the several facts aforesaid.

Delivered, &c.

Particulars of Objections.

Delivered on the —— day of —— 18— by —— of —— defendants' solicitors.

First Patent:

The following are the PARTICULARS of the OBJECTIONS upon which the defendants will rely at the trial of this action with respect to the letters patent No. 4,576 of 187— granted to ——

No infringement.

1. That the defendants have not infringed the said letters patent.

Not true and first inventor.

2. That —— was not the true and first inventor of the alleged invention comprised in the said letters patent.

No subject-matter.

3. That the said alleged invention was not the subject-matter of valid letters patent.

No utility.

4. That the said alleged invention was not useful.

Specification insufficient.

5. That the specification filed in pursuance of the said letters patent does not and did not sufficiently describe and ascertain the nature of the said alleged invention and the manner in which the same is to be performed.

Novelty denied.

6. That the said specification does not sufficiently or at all describe or show either in the body of the specification or in any of the claims what it was that the said —— claimed or intended to claim thereby.

Anticipation by prior publication

7. That the said alleged invention was not new at the date of the said letters patent, but was published within this realm before the date

hereof in and by the publication and by the persons at the times and places and in manner following, viz.:—

8. By an extract from —— quoted in the —— vol. —— page ——.

9. By the specification of letters patent, No. —— of 18— granted to —— page —— line —— to page —— line ——

10. By the provisional specification of —— No. —— of 18— the first page.

11. By an article in —— translated by —— 18— Chap. —— pages —— to ——

12. By an article on —— in —— translated by —— vol. —— page ——

13. By the publication of —— third edition, 18— vol. —— page ——

14. By the manufacture of electric lamps by the said —— and —— and by the exhibition thereof to the members of the —— and at the —— in or about the year 18— Exhibition. Manufacture and user.

15. By the exhibition and description of electric incandescence lamps by —— at —— in the latter part of the year 18— and in 18— more particularly on the —— 18— before the —— on the —— of —— 18— in the subscription library at —— on the —— of —— 18— before the —— and on the —— of —— 18— at —— and by the manufacture use and exhibition of incandescence lamps by —— in —— in 18— and 18—

16. By the manufacture use and exhibition of electric incandescence lamps by —— in 18— and 18——

The following are the PARTICULARS of the OBJECTIONS upon which the defendants will rely at the trial of this action with respect to letters patent No. 4,847 of 18— granted to —— *Second Patent:*

1. That the defendants have not infringed the said letters patent. No infringement.

2. That —— was not the true and first inventor of the alleged invention comprised in the said letters patent. Not true and first inventor.

3. That the said alleged invention was not the subject-matter of valid letters patent. No subject-matter.

4. That the said alleged invention was not useful. *No utility.*

5. That the specification filed in pursuance of the said letters patent does not and did not sufficiently describe and ascertain the nature of the said alleged invention and the manner in which the same is to be performed. Specification insufficient.

6. That the amendment made on or about the —— 18— pursuant to the determination of the law officer of the specification filed in pursuance of the said letters patent was not such as could be made by law and extends the exclusive privileges granted by the said letters patent. Illegal amendment.

7. That the said alleged invention was not new at the date of the said letters patent, but was published within this realm before the date thereof in and by the publications and by the persons at the times and places and in the manner following, viz.:— Not new.

[*&c.*]

Particulars of Objections (Another Form).

The defendants, besides denying that they have infringed the letters patent in the statement of claim mentioned, rely in support of their defence to this action on the following objections to the validity of the said letters patent:—

Not true and first inventor.

1. That —— was not the true and first inventor of the alleged invention comprised in the said letters patent.

Not new.

2. That the said alleged invention was not new at the date of the said letters patent.

No subject-matter.

3. That the alleged invention is not the proper subject-matter of letters patent.

Specification insufficient.

4. That the specification No. 9073 of A.D. 18— purporting to be filed by the said —— does not sufficiently describe and ascertain the alleged invention, and in what manner the same is to be performed, and does not sufficiently distinguish which of the matters and things therein described, the said —— claims to be new, or as being included in the said letters patent, and which of the same he does not so claim, and admits to be old. And that in other respects the said specification is insufficient, ambiguous, and framed so as to mislead.

Not useful.

5. That the alleged invention is not of any public utility.

Anticipation by—

6. That the said alleged invention was, previously to the date of the said letters patent, published within this realm in the following specifications left at and filed in the Great Seal Patent Office, as hereinafter mentioned, reference being made to the Queen's printer's copy of the said specifications, and to the drawings therein referred to, and also in the printed books hereinafter mentioned; that is to say,

Prior publication in books.

The specification of —— filed under letters patent dated —— 18—— No. 1235, page —— line —— &c., and the drawings therein respectively referred to.

The following volumes of the annual reports of the commissioners of patents of the United States of America, all such volumes being in the Patent Office Library, London, references being made to the pages hereinafter mentioned of the same volumes and to the descriptions therein of the United States patents hereinafter mentioned; that is to say, &c.

The following volumes of certified copies of American specifications, such volumes being in the Patent Office Library, London, reference being made to the pages hereinafter mentioned of the same volumes.

Manufacture. Sale. User. Exhibition.

7. That the said alleged invention was, previously to the date of the said letters patent, published within this realm by the manufacture or sale, or use, or public exhibition of articles or patterns or drawings of articles made according to the alleged invention by the persons hereinafter named, at the times and places following; that is to say,

By the said —— at his place of business or abode, in and subsequently to the year 18——

By the defendants at their place of business in the —— in the year 18— and subsequent years.

8. That the bustles complained of in the statement of claim and the

particulars of breaches, and which are alleged by the plaintiffs to be made according to the alleged invention comprised in the plaintiffs' said letters patent, are identical with certain bustles which, for some years previously to the date of the plaintiffs' said letters patent, were sold in America by —— Company in the statement of claim named (hereinafter called the —— Company), under the name of Health Braided Wire Bustle (hereinafter called the "Health Bustle"). The said Health Bustle was marked by the —— Company with the dates of three American patents, viz., —— 18— —— 18— and —— 18— and the said —— Company thereby intended to inform the public, as the fact is, that the said Health Bustle was made according to alleged inventions covered by the three American patents aforesaid. Each of the inventions comprised in the said three American patents was subsequently patented in England in two separate patents, one of which is the patent of —— No. 1235 of 18— hereinbefore mentioned, and the other of which is a patent No. 10191 of 18—. The said patent of —— expired through non-payment of stamp duty, before the date of the plaintiffs' letters patent, and the said patent No. 10191 of 18— relates only to pillows, cushions, or similar articles, and does not include bustles. The plaintiffs' said letters patent were obtained by the said —— as agent and trustee for —— Company, and the plaintiffs are either purchasers from the —— Company of all the last-mentioned company's interest in the said patent, or they are the agents of the last-mentioned company, or connected with the last-mentioned company in some manner unknown to the defendants, and they have, in fact, always had full knowledge of the several facts aforesaid. Under the circumstances aforesaid, the plaintiffs' letters patent were an attempt by the —— Company to obtain a new monopoly in this country for an article which they had admitted to be made under a patent which had then expired, and the plaintiffs' letters patent are therefore invalid.

Delivered, &c.

Order for further and better Particulars of Objections.

(INSUFFICIENCY OF SPECIFICATION.)

Crompton and Kapp v. *The Anglo-American Brush Light Corporation, Limited.* Kay, J. 18 Feb. 1887. A. 208.

Insufficiency of specification.

Upon the application of the plaintiffs, and hearing the solicitors, and also counsel for the said plaintiffs, and for the defendants, and upon reading the particulars of the defendants' objections, delivered on the 3rd February, 1887, it is ordered that the defendants do within seven days deliver to the plaintiffs further and better particulars in writing of paragraph 5 of the defendants' particulars of objections, showing how and in what respect the specification filed in pursuance of the letters patent does not sufficiently describe and ascertain the nature of the alleged invention, and in what manner the same is to be performed by reference when necessary to the subject-matter of the said specification. And it is ordered that the plaintiffs' costs of and consequent upon the said application, be his costs in any event.

Costs.

Another Order for Further and better Particulars of Objections.

Boyd v. *Farrar*. Kay, J. 25th July, 1887. A. 1199.

The application of the plaintiff, which, upon hearing, &c., in Chambers, was adjourned to be heard in Court, coming on this day to be heard accordingly, and upon hearing counsel for the plaintiff and defendant, and upon reading the particulars of objections delivered by the defendant with his statement of defence, this Court doth order that the defendant do on or before the —— day of —— 18— deliver to the plaintiff or his solicitors further and better particulars of objections.

Prior user. 1. As to paragraph of the said particulars delivered by giving the times and places of prior users which will be relied on under this paragraph, and by stating with reference to each of such prior users which parts of plaintiff's invention by reference to claiming clauses of the specification are alleged to be anticipated thereby.

Misrepresentations. 2. As to paragraph of the said particulars delivered, by giving particulars of the alleged untruth and misrepresentations.

Variance of provisional and complete specifications. 3. As to paragraphs and , by stating in what respects the invention described in the plaintiff's specification is alleged to differ from that disclosed in or described by the provisional specification.

Prior users. 4. As to paragraphs and , by giving such particulars of each of the articles relied upon as will suffice to identify specifically each of such alleged prior users.

Claims anticipated. 5. As to paragraph , by stating with reference to each specification relied upon which parts of plaintiff's invention, by reference to claiming clauses of the plaintiff's specification, are alleged to be anticipated thereby.

Costs. And the plaintiff's costs of this application, so far as it relates to the said paragraphs , , , , and of the said particulars, and as it relates to paragraphs and , except as hereinafter mentioned, are to be their costs in any event, and the defendant's costs of this application, so far as it relates to paragraphs and , and so much of paragraphs and of the said particulars as is not varied by this order, are to be their costs in any event.

Order for leave to Amend Particulars of Objections.

The American Braided Wire Company v. *Thomson*. Stirling, J. 5th May, 1887. A. 799.

Upon the application of the defendants, and upon hearing, &c.

Objection added. It is ordered that the applicants be at liberty to amend their particulars of objections delivered in this action on the —— day of —— 18— by adding the objection following, that is to say, that the alleged invention was, previously to the date of the said letters patent, published within this realm by the offering for sale by —— now of ——

of bustles made according to the said alleged invention, such offers being made in London in the month of —— 18— to, &c.

And it is ordered that the plaintiffs have six weeks time from the delivery of the amended particulars of objections to elect whether or not they shall continue the action. Elections of plaintiffs.

And it is ordered that if the said plaintiffs elect to discontinue this action, the defendants do pay to the plaintiffs their costs of this action as from the date of the delivery of the original particulars of objections, namely, the ——, such costs to be taxed by the taxing master. Costs.

Notice of Motion for Interlocutory Injunction.

Take notice that this Honourable Court will be moved before his lordship Mr. Justice ——, on the —— day of —— 18—, or so soon thereafter as counsel can be heard, by Mr. —— of counsel on behalf of the above-named plaintiff, that the defendant, his servants, and agents, may be restrained until the trial of this action or until further order during the continuance of the letters patent bearing date the —— day of ——, 18—, and numbered ——, from making, selling, supplying, using or putting in practice any —— [*here describe articles, &c. which are the subject of the patent privilege*] made according to or in the manner described in the specification [*or specifications*] of the invention for which the said letters patent were granted, or according to or in any manner only colourably differing from the same and from in any manner infringing the said letters patent, and that such further order may be made as to this Honourable Court shall seem meet.

Interlocutory Injunction for Infringement refused on Terms.

The Edison and Swan United Electric Light Company v. *Holland.*
Bacon, V.-C. 6th August, 1886.

Upon motion this day made unto this Court by counsel for the plaintiffs that the defendants might be restrained until the trial of this action or until further order during the continuance of the letters patent bearing date respectively the —— day of —— 18— and numbered —— and the —— *day* of —— 18— and No. —— from making, selling, supplying, or using any electric incandescent lamps made according to or in the manner described in the specifications filed in pursuance of the said respective letters patent or either of them, or according to or in any manner only colorably differing from the same, and from in any manner infringing the said letters patent or either of Motion, &c.

them, and upon hearing counsel for the defendants, and upon reading the plaintiffs' statement of claim and particulars of breaches, the following affidavits all filed the —— day of —— 18— namely, &c., and the exhibits therein referred to, an affidavit of, &c., and the defendants respectively by their counsel undertaking until the trial of this action not to buy any more lamps such as those complained of from any persons other than the plaintiffs, and to keep an account of all lamps alleged to be an infringement of the said patents, which they may now be using or may hereafter use, or which they may have used since the —— day of —— 18— the date of the first judgment hereinafter mentioned. This Court doth not think fit to make any order on the said motion other than that the costs thereof be costs in the action. And in the event of the judgment pronounced in an action brought in the Chancery Division of this Court by the plaintiffs and by the Swan United Electric Light Company, Limited, Swan's Electric Light Company, Limited, and G., against Messrs. W. and R., dated the —— day of —— 18— and another judgment pronounced in another action brought in the Chancery Division of this Court by the plaintiffs, The Edison and Swan United Electric Light Company, Limited, against W. and R. and The Woodhouse and Rawson Electric Manufacturing Company, Limited, dated the —— day of —— 18— or either of them being reversed on appeal, the defendants are to be at liberty to apply for the discharge of the undertaking so given by them as aforesaid.

Undertaking by defendants.

No order except as to costs.

If judgment in certain action reversed on appeal, liberty to apply to discharge undertaking.

Order for Inspection.

The Haslam Foundry and Engineering Company, Limited v. *Goodfellow and others.* Kay, J. 5th April, 1887.

Upon motion, &c., and upon reading the writ issued in this action, affidavits, &c., of —— filed in the action of G. *v.* The H. F. E. Co., Ltd., 1887, G. 573, namely, affidavits, &c. And the plaintiffs by their counsel undertaking during the inspection hereinafter directed or until further order not to threaten the defendants, Messieurs G. and M., or their customers, or any other person or persons by circulars, advertisements, or otherwise, with any legal proceedings or liability in respect of the manufacture, use, sale, or purchase of refrigerating engines or machines by the said defendants, or the use, sale, or purchase of such engines or machines sold by or offered for sale by any purchaser from the said defendants. This Court doth order that the plaintiffs be at liberty on giving four days' notice by —— [*experts*] and solicitor to inspect refrigerating machines manufactured and in course of manufacture by the defendants, Messrs. G. and M., for the other defendants or one of them which are referred to in the said affidavit of R. M. in the said action of G. *v.* The H. F. E. Co., Ltd., 1887, G. 573. And it is ordered that the costs of this application be costs in the action.

Undertaking by plaintiffs.

Inspection by experts, &c.

Order for Experiments before Experts during Trial of Action.

Edison and Swan United Electric Light Company, Limited v. *Holland and others.* Kay, J. 1st June, 1888.

This Court being desirous that experiments should be conducted as hereinafter mentioned doth hereby order that experiments confined to the repetition of experiments of which evidence has already been given before this Court on behalf of the plaintiffs and defendants respectively upon the patent of —— dated the —— 18— and No. —— be conducted before one of the following persons in the following rotation :—(1) Professor —— (2) Professor —— &c. And the plaintiffs and defendants respectively are to repeat in the presence of the person before whom such experiments are conducted, and of two experts on each side, any of their said experiments of which evidence has been given as aforesaid which they may think fit with the aid of assistants. Each side to choose the place at which its experiments shall be made. And it is ordered that such one of them the said —— before whom such experiments shall be conducted do report to the Court the nature and result of each experiment made before him.

Order of Reference to an independent Chemist for Report pending Hearing of Action.

Badische Anilin und Soda Fabrik v. *Levinstein*, P. O. R. Vol. II. p. 73.

The Court being desirous of obtaining the opinion of Professor R. upon the questions set forth or referred to in the schedule hereto, doth order that such questions be referred to the said professor for inquiry and report, and that a specification of the patent dated the —— No. —— be supplied to the professor.

SCHEDULE.

Order for Leave to amend Specification during Action.

The Haslam Foundry and Engineering Co., Ltd. v. *Goodfellow and others.* Kay, J. 2nd December, 1887. A. 1727.

Upon motion this day made unto this Court by counsel for the plaintiffs, and upon hearing counsel for the defendants, and upon reading the pleadings in this action, an affidavit of, &c., and ——: It is ordered that the plaintiffs be at liberty to apply at the Patent Office for leave to further amend the specification of their patent No. —— of the

Leave to apply at Patent Office.

year 18— by striking out the second claim thereof and by making such other alterations (if any) as will be rendered necessary thereby. And it is ordered that after such amendment has been made the plaintiffs be at liberty within fourteen days to amend their statement of claim so as to limit this action to the amended specification of the said patent, and in default thereof it is ordered that this action do stand dismissed out of this Court with costs to be taxed by the taxing master, and to be paid by the plaintiffs, The, &c., to the defendants, Messieurs G., &c. And it is ordered that the costs of the defendants, Messieurs G., &c., of this application, and of and occasioned by such last-mentioned amendment, be their costs in any event, and be borne by the said plaintiffs, The, &c. And it is ordered that (in the event of this action proceeding) all other costs be reserved.

Amendment of statement of claim.

Costs.

Order for Leave to amend Specification pending Action.

G., *G.*, and *The N. Co. for the Distribution of Electricity by Secondary Generators, Ltd.* v. *L. & Co., Ltd.*, and *F.* Kekewich, J. 16th December, 1887.

The motion. Upon motion this day made unto this Court by counsel for the plaintiffs G., and G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Ltd., the owners of the letters patent mentioned in the writ in this action, that they might be at liberty to apply at the Patent Office for leave to amend their specifications filed in pursuance of the said letters patent by way of disclaimer, correction, or explanation, and that in the meantime the hearing of this action might be postponed, and that the said specification when so amended as aforesaid might be used in evidence on the hearing of the said action, and upon hearing counsel for the defendants, and upon reading the —— and the defendants by their counsel offering to allow plaintiffs to discontinue this action so far as regards the patent No. —— of —— upon the plaintiffs paying to the defendants their costs of this action, so far as such costs were incurred in connection with that patent; and the plaintiffs by their counsel declining that offer: This Court doth not No order. think fit to make any order upon the said motion. And it is ordered that the plaintiffs do pay to the defendants, L. & Co., Ltd., and F., their costs of the said motion (such costs to be taxed by the taxing master).

Order by Consent on Appeal varying above Order.

G., *G.*, and *The N. Co. for the Distribution of Electricity by Secondary Generators, Ltd.* v. *L. & Co., Ltd.*, and *F.* Court of Appeal. 1st February, 1888.

Consent. Upon motion this day made unto this Court by counsel for the plaintiffs by way of appeal from the refusal of Mr. Justice —— on motion

made to him on the —— to make any order, and upon hearing counsel for the defendants, and upon reading the said order dated the —— and counsel for the defendants consenting: This Court doth order that the said order dated the —— be varied as follows, that is to say, that the plaintiffs be at liberty to apply at the Patent Office for leave to amend their specification filed in pursuance of their letters patent No. —— of —— by way of disclaimer, and that the said specification, when so amended as aforesaid, may be used in evidence on the hearing of this action, the plaintiffs through their counsel waiving all claim for damages or relief in respect of infringements prior to the amendment of the said specification. And it is ordered that the defendants be at liberty within fourteen days after notice of the amendments made in the said specification to amend their defence and particulars of objection. And it is ordered that the plaintiffs, G., G., and The N. Co. for the Distribution of Electricity by Secondary Generators, Ltd., do pay to the defendants, L. & Co., Ltd., and F., their costs (on the lower scale) of this action up to the date of this order, including the costs of the defendants' motion before Mr. Justice —— on the —— and the costs of the said order dated the —— and of this appeal, such costs to be taxed by the taxing master.

Liberty to apply for leave to amend.

Terms.

Costs.

Judgment after Trial of Action.

Morgan & Co., Limited v. *Windover & Co., Limited.* Stirling, J., 11th July, 1887.

This action coming on for trial on the —— days of —— 18— before this Court in the presence of counsel for the plaintiffs and for the defendants, and upon reading the pleadings and the exhibits produced to the several witnesses hereinafter mentioned, and upon hearing the evidence of the several persons named in the 1st column of the schedule hereto upon their examinations taken orally before this Court on the days set opposite their several names in the 2nd column of the said schedule and the exhibits produced to such persons respectively set opposite their respective names in the 3rd column of the said schedule, and what was alleged by counsel for the plaintiffs and defendants. This Court did order that this action should stand for judgment, and the same standing in the paper for judgment this day accordingly in the presence of counsel for the plaintiffs and defendants.

Recital of evidence.

Stand for judgment.

This Court doth order and adjudge that the defendants W. & Co., Limited, their servants and agents, be restrained during the continuance of the letters patent granted to M. dated the —— and numbered —— for —— and any extension of the term thereof from manufacturing, or selling, or disposing of any carriages with springs applied according to the plaintiffs' patented invention or only colourably differing therefrom, or being an infringement of the plaintiffs' said patent, or in any way infringing the plaintiffs' said patent. And this Court doth order that the defendant company, by W. their

Injunction awarded.

Affidavit as to infringing articles.

managing director do within fourteen days after service of this judgment make and file an affidavit stating what carriages of the same construction as the plaintiffs' and infringing the said patent are in their or their agents' possession or power. And the plaintiffs are to be at liberty to inspect the same for the purposes of identification. And

Account. it is ordered that an account be taken of the profits made by the defendant company by making, using, selling, or disposing of carriages constructed as aforesaid in infringement of the plaintiffs' said patent. And it is ordered that the defendants W. & Co., Limited, do within one month after the date of the chief clerk's certificate pay to the plaintiffs M. & Co., Limited, what shall be certified to be the amount of such profits. And it is ordered that the defendants do on or before the —— day of —— 18— upon oath remove from all carriages in their or their agents' possession or power, all springs so fitted by them in

Costs on higher scale. infringement of the plaintiffs' patent. And it is ordered that the defendants W. & Co., Limited, do pay to the plaintiffs M. & Co. their costs of this action, and (by consent) including therein the costs of the motion reserved by the order of the —— of —— 18— (such costs to be taxed by the taxing master on the higher scale).

THE SCHEDULE.

[*Name of Witness.*	*Dates of Examination.*	*Exhibits.*]

Judgment after Trial of Action.

The Edison and Swan United Electric Light Company, Limited, and *The Edison Electric Light Company, Limited* - - - - - - Plaintiffs,

W. H. and *The Jablochkoff and General Electricity Company, Limited* - - - - Defendants,

and

The Anglo-American Brush Electric Light Corporation, Limited - - - - - - Third Parties.

Kay, J. 16th July, 1888.

Pleadings. This action coming on for trial on the —— —— &c., before this Court, in the presence of counsel for the plaintiffs and the defendants and the Anglo-American Brush Electric Light Corporation, Limited, third parties, upon hearing the writ of summons issued in this action on the —— the pleadings in this action, the orders dated —— &c., an order of the Court of Appeal of the —— the particulars of breaches

Particulars. delivered the —— by —— the plaintiffs' solicitors, the amended particulars of objections delivered the —— by —— the defendants' solicitors, and the several specifications and documents therein referred

to, the letters patent granted to T. A. E., dated the 10th November, 1879, and numbered 4576, and the specification filed in pursuance thereof, the letters patent granted to F. J. C., dated 28th November, 1878, and numbered 4847, and the specification filed in pursuance thereof, as amended by disclaimer allowed the 12th November, 1884, the joint answer of the plaintiffs, the Edison and Swan United Electric Light Company, Limited (by S. F. P., their secretary), and of the plaintiffs The Edison Electric Light Company, Limited (by G. S., the liquidator) to the interrogatories delivered by the defendants for the examination of the plaintiffs filed the —— the answer of the defendant W. H., filed the —— and the answers and further answers of the defendants the Jablochkoff and General Electricity Company, Limited, by R. B. R., the secretary of the company then known as "The United Electrical Engineering Company, Limited," to the interrogatories delivered by the plaintiffs for the examination of the defendants, filed respectively the —— and the —— the answer and further answer of the Anglo-American Brush Electric Light Corporation, Limited, by J. M. F., the assistant secretary, to the interrogatories delivered by the plaintiffs for their examination, filed respectively the —— and the —— a notice to admit lamps, dated the —— the admission in writing dated the —— and signed "—— solicitors for the defendants," a notice to admit certain documents as evidence dated the —— and the admission thereof signed "—— plaintiffs' solicitors," dated —— and the several documents therein referred to, a notice to admit certain documents as evidence dated the —— and the admission thereof signed "—— defendants' solicitors," and dated —— and the several documents therein referred to, a notice to admit the publication of certain documents dated the —— and the admission thereof signed "—— plaintiffs' solicitors," dated —— the admissions in writing signed "—— plaintiffs' solicitors," dated —— and the several documents therein referred to, the admissions in writing signed "—— plaintiffs' solicitors," dated —— and the several documents therein referred to, a notice to admit certain documents as evidence dated the —— and the admission thereof signed "—— plaintiffs' solicitors," dated the —— and the several documents therein referred to, the admission in writing signed "—— defendants' solicitors," and the several documents therein referred to, the judgments of Mr. Justice Butt in the action Edison and Swan United Electric Light Company, Limited and others *v.* Woodhouse and Rawson, 1884, E, 89, dated 20th May, 1886, and in the action Edison and Swan United Electric Light Company, Limited *v.* Woodhouse and Rawson and the Woodhouse and Rawson Electric Manufacturing Company, Limited, 1885, E, 315, dated 25th May, 1886, the judgments of the Court of Appeal in the said last-mentioned actions dated respectively the 31st January, 1887, and the 12th February, 1887, the certificates signed by Mr. Justice Butt in the said action, 1884, E, 89, of the validity of the letters patent of the 10th November, 1879, No. 4576, and in the said action 1885, E, 315, of the validity of the letters patent of the 28th November, 1878, numbered 4847, the report of Professor —— dated the 28th June, 1888, pursuant to the order of the 1st June, 1888, table of duration, tests of lamps made during experiments before Professor —— and table of voltages at which the said lamps were run, read, and upon hearing the evidence of the several persons named in the first column of the schedule hereto on their examination taken

Patent.

Interrogatories.

Admissions.

Former judgments.

Former certificates.

Report of experts.

Witnesses in schedule.

orally before this Court upon the several days set opposite their names in the second column of the said schedule, and upon production to the said several persons of the several documents and other exhibits set opposite their names in the third column of the said schedule, and upon hearing what was alleged by counsel for the plaintiffs and defendants and the Anglo-American Brush Electric Light Corporation, Limited, and counsel for all parties admitting that the running on the pumps and flashing, or flashing or running on the pumps, will materially improve the life of the lamps made at Ponder's End before Professor —— and the plaintiffs by their counsel admitting that the conductor in the exhibit —— referred to in the schedule hereto received its present shape before carbonization, and the defendants by their counsel admitting that the said conductor came from France, and that Carré made his carbons and sold them in France, and the plaintiffs by their counsel admitting that so far as they know the said conductor was made according to Lafontainé's description of Carré's mode of manufacture, this Court did order that this action should stand for judgment, and this action standing for judgment this day in the paper in the presence of counsel for the plaintiffs and defendants and for the said Anglo-American Brush Electric Light Corporation, Limited, This Court doth order and adjudge that this action do stand dismissed out of this Court so far as the same relates to the letters patent of T. A. E., dated the 10th November, 1879, and numbered 4576 in the pleadings mentioned, with costs to be taxed by the taxing master as hereinafter provided; And it is ordered that the defendants W. H. and the Jablochkoff and General Electricity Company, Limited, their several agents and workmen, be restrained, during the continuance of the letters patent in the pleadings mentioned, dated the 28th November, 1878, and numbered 4847, granted to F. J. C., as amended by the disclaimer allowed on the 12th November, 1884, and now vested in the plaintiffs, the Edison and Swan United Electric Light Company, Limited, from manufacturing, selling, letting on hire, supplying, or using any incandescent electric lamps having conductors prepared according to or in the manner described in the specification filed in pursuance of such letters patent, as altered by the said disclaimer, or according to or in any manner only colourably differing from the same, and generally from infringing the rights of the plaintiffs in respect of such letters patent. And it is ordered that the defendants, W. H. and the Jablochkoff and General Electricity Company, Limited, do, on or before the 10th day of January, 1889, or subsequently within seven days after service of this order, make and file an affidavit stating what lamps made in infringement of the said last-mentioned letters patent are in the possession or power of the defendants respectively or either of them, and do within the time aforesaid deliver up to the plaintiffs, or break up or otherwise render useless, in the presence of some person to be appointed by the plaintiffs and defendants respectively, and in the presence of their respective solicitors, all such incandescent electric lamps as aforesaid as are respectively in their possession or power. And it is ordered that the following inquiry be made, that is to say, an inquiry what damages the plaintiffs have sustained by reason or in consequence of the manufacture, sale, supplying, letting on hire, or user of any such incandescent electric lamps so manufactured, sold, supplied, let on hire, or used by the defendants respectively, or either of them, or by any

Admissions by counsel.

Action to stand for judgment.

Order.

Action dismissed as to one patent with costs.

Injunction granted as to other patent.

Delivery up on oath of infringing lamps;

or destruction of the same.

Inquiry as to damages.

person or persons to their order or for their use. And it is ordered that the defendants, W. H. and the Jablochkoff and General Electricity Company, Limited, respectively do, within twenty-one days after the date of the chief clerk's certificate to be made in pursuance of this order, pay to the plaintiffs, the Edison and Swan United Electric Light Company, Limited, the respective sums which shall be certified to be the amount of such damages. And it is ordered that a certificate do issue pursuant to the Patents, Designs, and Trade Marks Act, 1883, that the amended particulars of objections delivered by the defendants with respect to the patent numbered 4576 of 1879, were reasonable and proper, and that a like certificate do issue that the plaintiffs have proved their particulars of breaches in this action so far as the same relate to the patent numbered 4847 of 1878, and that the validity of the said patent came into question. And it is hereby referred to the taxing master to tax as between solicitor and client the costs of the plaintiffs, the Edison and Swan United Electric Light Company, Limited, and The Edison Electric Light Company, Limited, of this action so far as the same relate to the said letters patent numbered 4847 of 1878 on the higher scale. And it is hereby referred to the taxing master to tax the costs of the defendants, W. H. and The Jablochkoff and General Electricity Company, Limited, of this action, so far as the same relate to the said patent numbered 4576 of of 1879 on the higher scale. And the taxing master is to set off the said costs of the plaintiffs and of the defendants when so respectively taxed, and certify to which of them the balance after such set-off is due. And it is ordered that such balance be paid by the party from whom to the party to whom the same shall be certified to be due, and any of the parties are to be at liberty to apply as they may be advised.

Order for payment of amount found due.

Certificate that particulars of objections reasonable and proper.

Particulars of breaches proved by plaintiff.

Taxation.

Costs to be set off.

Liberty to apply.

THE SCHEDULE.

[*Witnesses.* *Dates of Examination.* *Exhibits.*]

Form of Certificate of Validity.

I hereby certify, pursuant to the 31st section of the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Vict. c. 57), that upon the trial of this action the validity of the letters patent in the pleadings mentioned, dated the 28th November, 1878, and numbered 4,847, granted to F. J. C., amended by disclaimer allowed 12th November, 1884, and now vested in the Edison and Swan United Electric Light Company, Limited, came into question.

Dated this 16th day of July, 1888.

E. E. KAY.

Judgment varied on Appeal.

The Edison and Swan United Electric Light Company, Limited, and *The Edison Electric Light Company, Limited* - - - - - - Plaintiffs,

W. H. and *The Jablochkoff and General Electricity Company, Limited* - - - - - - Defendants,

and

The Anglo-American Brush Electric Light Corporation, Limited - - - - - - Third Parties.

Upon motion on the, &c., made unto this Court by counsel for the plaintiffs by way of appeal from the judgment of Mr. Justice Kay, dated the —— so far as it relates to the letters patent No. 4576 of 1879, and upon hearing counsel for the defendants and for the above-named third parties, and upon reading the said judgment, this Court did order that the said motion should stand for judgment, and the same standing this day for judgment accordingly in the presence of counsel for all parties: This Court doth reverse so much of the said judgment as directs that this action should stand dismissed out of this Court so far as the same related to the letters patent of Thomas Alva Edison, dated the 10th of November, 1879, and numbered 4576 in the pleadings mentioned, with costs to be taxed by the taxing master as in the said judgment provided. And instead thereof, this Court doth order that the defendants, W. H., and The Jablochkoff and General Electricity Company, Limited, their several agents and workmen, be restrained during the continuance of such letters patent from manufacturing, selling, letting on hire, supplying, or using any incandescent electric lamps manufactured according to or in the manner described in the specification filed in pursuance of such letters patent, or according to or in any manner only colourably differing from the same, and generally from infringing the rights of the plaintiffs in respect of such letters patent.

Motion to stand for judgment.

Part of judgment reversed.

Injunction granted.

And it is ordered that the defendants W. H., and The Jablochkoff and General Electricity Company, Limited, do on or before the 30th day of April, 1889, or subsequently within seven days after service of this order, make and file an affidavit stating what lamps made in infringement of the said letters patent are in the possession or power of the defendants respectively or either of them, and do within the time aforesaid deliver up to the plaintiffs, or break up or otherwise render useless, in the presence of some person to be appointed by the plaintiffs and defendants respectively, and in the presence of their respective solicitors, all such incandescent electric lamps as aforesaid as are respectively in their possession or power. And it is ordered that the following inquiry be made, that is to say, an inquiry what damages the plaintiffs have sustained by reason or in consequence of the manufacture, sale, supplying, letting on hire, or user of any such incandescent electric lamps so manufactured, sold, supplied, let on hire, or used by the defendants respectively or either of them, or by any person or persons by their order or for their use. And it is ordered that the defendants W. H., and The Jablochkoff and General Electricity Company, Limited, respectively, do, within twenty-one days

Delivery up on oath of infringing instruments.

Inquiry as to damages.

Payment of amount found due.

after the date of the chief clerk's certificate to be made in pursuance of this order, pay to the plaintiffs, the Edison and Swan United Electric Light Company, Limited, the respective sums which shall be certified to be the amount of such damages. And it is hereby referred to the taxing master to tax as between solicitor and client the costs of the plaintiffs of this action, so far as the same relate to the said letters patent, on the higher scale, and also to tax as between solicitor and client the costs of the plaintiffs occasioned by this appeal. And it is ordered that so much of the said judgment as relates to the set-off of costs and the payment of the balance be discharged. And instead thereof, it is ordered and adjudged that the plaintiffs recover against the defendants the plaintiffs' costs of this action by the said judgment directed to be taxed, and against the defendants and the said third parties, their costs of the said action and occasioned by this appeal hereby directed to be taxed.

Taxation of costs.

Order as to set-off of costs discharged.

Judgment at Trial for Defendants. Recital of Evidence. Costs.

The American Braided Wire Company, and another v. *Thomson.*
Kekewich, J. 6th July, 1887. A. 1233.

This action coming on for trial on the 2nd and the 5th July, 1887, and this day before this Court in the presence of counsel for the plaintiffs and for the defendants, and upon hearing the pleadings in this action, specification of patent No. 9073, dated the —— day of —— 18— an indenture dated the —— 18— made between —— Manufacturing Company of the one part, and the American Braided Wire Company of the other part, the plaintiffs' particulars of breaches delivered on the —— the defendants' re-amended particulars of objections delivered on the —— and the answers and further answers of the defendants filed respectively the —— and the —— to the interrogatories of the plaintiffs, and the answers of the plaintiffs the American Braided Wire Company, filed the —— to the interrogatories of the defendants, the admission of the defendants dated the —— the letter from —— to the defendants dated the —— the letter from the defendants to —— dated the —— and the further letter from the defendants to —— dated the —— and a specification of patent No. 1235, dated the —— 18— read, and the evidence of the persons named in the schedule hereto on their examination taken orally before this Court upon the several days set opposite to their names in the said schedule, and upon production to such persons of the several exhibits set opposite to their names in the third column of the said schedule, and what was alleged by counsel on both sides, and the re-amended particulars of objections being deemed to be further amended by the addition to the sixth objection of the passage in the specification of —— page —— lines —— of the Queen's Printer's copy thereof, which is admitted by counsel for the plaintiffs and defendants to be correct: This Court doth order that this action do stand dismissed out of this Court. And it is ordered that it be

Evidence, &c.

Action dismissed.

Costs. referred to the taxing master to tax upon the higher scale the costs of the defendants of this action, except so much as relates to the objec-
Particulars of objections. tions numbered 5, 7, and 7a, of the defendants' particulars of objections, and to tax the costs of the plaintiffs of the said objections 5, 7, and 7a. And the taxing master is to deduct the said costs of the plaintiffs from the said costs of the defendants, and is to certify the balance.

And it is ordered that the plaintiffs —— do pay to the defendants —— the amount of such balance to be certified.

THE SCHEDULE.

Witnesses examined in Court.

[*Names of Witnesses.* *Dates of Examination.* *Exhibits.*]

Judgment in default of Defence.

The Wenham Company, Limited v. *Carpenter, Ford, and Company.*
Chitty, J. 29th October, 1887.

Upon motion for judgment this day, &c., and upon reading the plaintiffs' statement of claim, the particulars of breaches delivered the 10th day of March, 1887, and an affidavit of —— filed —— and the
No defence delivered. exhibits therein referred to, and no statement of defence having been delivered: This Court doth order and adjudge that the defendants, ——
Injunction. Company, their several servants, agents, and workmen, be restrained during the continuance of the letters patent hereinafter referred to, from using, or exercising, or causing or permitting to be used or exercised, the invention described in the specification of —— filed under letters patent dated the —— 18— No. 2869, as amended on the —— 18— under the provisions in that behalf of the Patent, Designs, and Trade Marks Act, 1883, and the drawings attached thereto or any part of the same invention, and from manufacturing, selling, or making any profitable use, or permitting the manufacture, sale, or profitable use, of any gas lamps or lanterns not made by the plaintiffs or their licensees, being the same as the gas lamp sold to —— named in the said particulars of breaches, or which as to any part or parts thereof are constructed or arrangod according to the said invention or any part of the invention, or differ therefrom only colourably, or by the substitu-
Account of profit, &c. tion of mere mechanical equivalents. And it is ordered that the following account be taken, that is to say, an account of all gas lamps or lanterns being the same as that sold to the said —— as aforesaid, or otherwise made according to the said invention as described in the said amended specification, in infringement of the said letters patent which have since the amendment of the said specification been manufactured, or sold, or used by, or by the order or for the profits of the defendants, and also of the gains and profits made by the defendants by reason of such manufacture, or sale, or use. And it is ordered that
Payment of what found due. the defendants, —— Company, do pay to the plaintiffs, —— Com-

pany, Limited, what shall be certified to be the amount of such gains and profits within twenty-one days after the filing of the chief clerk's certificate of the result of such account. And it is ordered that the defendants do on or before the 15th day of December, 1887, or subsequently within four days after service upon them of this order, file an affidavit stating whether they have in their possession or power any, and if any, what, gas lamps or lanterns, or parts of gas lamps or lanterns, which gas lamps or lanterns or parts are the same as the lamp sold to —— as aforesaid, or which have otherwise been manufactured or used in infringement, as aforesaid, since the said amendment. And it is ordered that all gas lamps or lanterns, or parts of gas lamps or lanterns, which gas lamps or lanterns or parts shall appear by such affidavit to have been so manufactured or used, and to be in the possession or power of the defendants, be destroyed within fourteen days after the filing of the said affidavit in the presence of some person at Birmingham to be nominated by the plaintiffs. And it is ordered that the defendants, Messieurs Carpenter, Ford, and Company, do pay to the plaintiffs, The Wenham Company, Limited, their costs of this action up to and including this judgment, such costs to be taxed by the taxing master. And this Court doth reserve the subsequent costs of this action. And it is ordered that the plaintiffs and defendants be at liberty to apply to the judge at Chambers as to the said subsequent costs.

Affidavit of infringing articles.

Costs.

Judgment at Trial of Action.

Siddell v. *Vickers.* Kekewich, J. 21st December, 1887.

This action coming on for trial on the —— before this Court in the presence of counsel for the plaintiff and defendants, and upon hearing the writ of summons issued in this action on the —— the pleadings in this action, the letters patent granted to the plaintiff, No. —— of A.D. —— dated the —— specifications to the said letters patent and the particulars of breaches delivered on the —— and upon hearing the evidence of the several persons named in the schedule hereto on their examination taken orally before this Court upon the several days set opposite their names in the said schedule, and upon reading the several exhibits being documents, and examining the other exhibits produced to such persons on their said examination referred to in the third column of the said schedule, and hearing what was alleged by counsel on both sides, this Court did order that the said action should stand for judgment—

Evidence.

And the same standing for judgment this day in the paper in the presence of counsel for the plaintiff and defendants, this Court doth order and adjudge that the defendants —— their agents, servants and workmen, be restrained during the continuance of the said letters patent No. —— of A.D. —— from using or permitting to be used the invention described in the specification and drawings, No. —— of A.D. —— filed by the plaintiff or any part or parts of the same invention and from using and permitting to be used in the manufacture of iron and steel forgings any appliances or means being

Stands for judgment.

Injunction.

the same as the appliances or means now or lately used by the defendants as mentioned in the said particulars of breaches, or which as to any part or parts thereof are arranged or constructed according to the said invention, or any part thereof, or differ therefrom only colorably, and by the substitution of more mechanical equivalents.

Affidavit of infringing articles.

And it is ordered that the defendants —— do within fourteen days after the service of this judgment make and file an affidavit stating what appliances and parts of appliances for working or operating on iron or steel forgings as mentioned in the particulars of breaches, or otherwise manufactured in accordance with the said specification or according to or only colorably differing from the same have been manufactured by or by the order or for the use of the defendants as in the pleadings mentioned, and are in the possession, custody, or power of the said defendants, or their agents, servants, and workmen.

Account.

And it is ordered that the following account be taken:

1. An account of all iron or steel forgings manufactured by the defendants by the use of the plaintiff's said invention or any part or parts of such invention, and also of the profits made by the defendants by reason of such manufacture or use.

Account suspended pending appeal.

And it is ordered that the taking of such account be suspended pending the appeal of the defendants to the Court of Appeal from this judgment.

And it is ordered that the defendants —— do within fourteen days after service upon them of the chief clerk's certificate pay to the plaintiff —— what shall be certified to be the amount of such profits.

Costs.

And it is ordered that the defendants —— do pay to the plaintiff —— (1) his costs of a certain application made by the defendants to the Attorney-General for his authority to present a petition for the revocation of the plaintiff's said letters patent, and (2) his costs of this action up to and including this judgment, except as to the alleged use by the defendants of the automatic action of the plaintiff's apparatus after the —— the day when the plaintiff left the defendant's works, such costs to be taxed by the taxing master on the higher scale.

And this Court doth reserve the subsequent costs of this action.

Certificate of validity.

And it is ordered that a certificate do issue that upon the trial of this action the validity of the plaintiff's patent came in question.

And it is ordered that the plaintiff and defendants be at liberty to apply to the judge at chambers as they may be advised.

The Schedule.

[*Names of Witnesses.*	*Dates of Examination.*	*Exhibits.*]

Judgment on Appeal.

The American Braided Wire Company and another v. *Thomson & Co.*
Court of Appeal. 2nd February, 1888. A. 200.

Evidence.

Upon motion by way of appeal on the —— days of —— 18— and this day made unto this Court by counsel for the plaintiffs against the

judgment of his lordship Mr. Justice —— made in this action on the —— so far as it directs that this action shall stand dismissed out of Court, and so far as it directs the taxation of any costs of the defendants, and payment or allowance to the defendants by the plaintiffs of any costs, and upon hearing counsel for the defendants ..nd the evidence of the following persons taken orally before this Court, on the —— namely, —— and the exhibits —— produced to —— and upon reading the said judgment, the further particulars of objections delivered by the defendants to the plaintiffs on the —— and the specification of —— of —— No. ——

This Court doth order that the said appeal be allowed, and that the said judgment dated the —— be reversed. And it is ordered that the defendants T. & Co., their servants and agents respectively, be hereby perpetually restrained from manufacturing, selling, or exposing for sale bustles or dress improvers in infringement of the plaintiffs' patent dated the —— in the pleadings mentioned, or from making, selling, or exposing for sale articles in colourable imitation of the articles manufactured by the plaintiffs under their said letters patent. Judgment reversed. Injunction.

And it is ordered that the following inquiry be made, that is to say:—

An inquiry what damages have been sustained by the plaintiffs by reason of the said infringement by the said defendants of the plaintiffs' said patent. Inquiry as to damages, &c.

And it is ordered that the defendants, T. & Co., do within twenty-one days after the date of the certificate of the result of the said inquiry, pay to the plaintiffs, The A. B. W. Co., the amount which shall be certified to be due in respect of such damages.

And it is ordered that the defendants, T. & Co., do forthwith deliver up to the plaintiffs, the A. B. W. Co., all articles in their possession made in infringement of the said patent. Delivery up of infringing articles.

And it is ordered that the defendants, T. & Co., do pay to the plaintiffs, The A. B. W. Co. and the W. & W. M. Co., their costs of this appeal and of this action, such costs to be taxed by the taxing-master on the higher scale, and the defendants thereupon by their counsel moving that all further proceedings under this order might be stayed pending an appeal therefrom to the House of Lords, and upon hearing counsel for the plaintiffs, this Court doth not think fit to make any order upon the said application, except that the delivery up of the said articles made in infringement of the said patent be not enforced pending the appeal of the said defendants to the House of Lords, provided notice of the said appeal be given to the plaintiffs' solicitors on or before the —— Messrs. —— and —— the plaintiffs' solicitors, personally undertaking in writing (which is annexed to the registrar's book) to abide by any order this Court shall make as to refunding to the defendants the costs hereby directed to be paid to them by the defendants in the event of this order being reversed or varied on appeal by the House of Lords. Costs. Undertaking as to costs.

Order for Discovery of Names of Customers and Prices of Articles.

The American Braided Wire Company and another v. *Thomson.* Stirling, J. 1st June, 1888. A. 822.

Inspection of books.

Upon, &c. And upon reading the judgment dated the —— an order of the Court of Appeal dated the —— an order dated the —— and an affidavit of the defendants —— this Court doth order that the defendants T. & Co. do within seven days after the service of this order at all seasonable times upon reasonable notice produce at —— for the inspection of the plaintiffs all such parts of the documents as are set out in the second part of the first schedule to the affidavit of the defendants filed the —— as disclose the names of the customers of the firm of T. & Co. to whom any articles made in infringement of the plaintiffs' letters patent in the order of the Court of Appeal of the —— mentioned have been sold by the defendants, and also the prices for which any such articles were respectively sold. And the applicants, their solicitors and agents, are to be at liberty to inspect and peruse the parts of the documents so produced, and to take copies thereof and abstracts thereof, and extracts therefrom, as the applicants shall be advised at their expense. And it is ordered that the defendants do produce the same in this cause as the plaintiffs shall require, and the plaintiffs are to be at liberty to make such further application as to all or any of the documents mentioned in such affidavit as they may be advised. And it is ordered that the defendants T. & Co. do pay to the plaintiffs —— their costs of the application in chambers and occasioned by the adjournment thereof into Court, such costs to be taxed by the taxing master.

Costs.

VII.—Action to Restrain Threats.

Indorsement on Writ.

The plaintiff's claim is:—

Injunction.

1. For an injunction to restrain the defendants from continuing to threaten the plaintiff, or any other person or persons whereby the plaintiff may be aggrieved, by circulars, advertisements, or otherwise, with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of any invention in infringement of the defendant's patent rights (if any).

Damages.

2. For damages for injury accrued to the plaintiff in respect of the said threats.

VIII.—Revocation of Patents.

Petition for Revocation of Patent.

In the Matter of A. & B.'s Patent, No. ——, A.D. 1882

and

In the Matter of the Patents, Designs and Trade Marks Act, 1883.

To her Majesty's High Court of Justice.

The humble petition of C. of ——

Showeth as follows:—

1. Your petitioner is an electrician, and the patentee of many inventions in connection with the production, distribution, and utilization of electric currents, which inventions are now in extensive practical use.

2. Among other methods of distribution, for some time past your petitioner has especially occupied himself with methods of effecting the same by means of secondary generators, by which electrical action is obtained at different points of an electrical circuit by means of electric induction only, without interrupting such circuit or making any connection with the conductor conveying the current.

3. In or about the month of —— your petitioner invented an improved form of secondary generator for the purpose of effecting economically and conveniently the above-mentioned object, and on the —— day of —— your petitioner applied for and obtained a provisional protection No. —— A.D. 1885, for such invention, and has since filed a complete specification for the said invention.

4. Since obtaining the said provisional protection your petitioner has manufactured and used secondary generators constructed according to your petitioner's said invention, and the same have been shown to possess great advantages over other forms, and to be of great practical utility.

5. The sale and user of the said secondary generators made according to your petitioner's invention has recently been interfered with by a limited company named the —— The said company claim to be entitled to restrain any person using any mode of electrical distribution by means of secondary generators of whatever form or construction such generators may be.

6. The said claim of the aforesaid company purports to be based upon letters patent granted to A. & B., and numbered —— A.D. —— The invention in respect of which the said letters patent were granted was in nowise novel at the date of the same, and the said letters patent are and always have been of no force and validity by reason thereof, and of the other matters set forth in the particulars of objections delivered herewith in pursuance of section 26 of the above-named Act.

7. The existence of the above-named letters patent, claiming a wide and general monopoly of the system of distribution by means of secondary generators, which was known to, and the property of, the

public at the date of the said letters patent, has been and is the cause of great injury to the public by preventing the sale of machines made according to your petitioner's invention, as well as those made by other inventors who likewise have made improvements in secondary generators and in the distribution of electricity thereby.

8. That the public are prejudiced by the above-mentioned general claim in the said letters patent because consumers of electricity are not in general acquainted with the science of electricity and the technical application thereof, and are therefore unable to form an opinion as to the invalidity of the said letters patent, whereby the sale and use of improved secondary generators are wholly prevented.

9. The office of —— is the place where the petitioner may be served with any petition, or summons, or notice of any proceedings or order of this Court relating to the matters herein referred to.

Your petitioner therefore humbly prays for the revocation of letters patent No. —— A.D. 18— or that such order may be made in the premises as to this honourable Court may seem meet.

And your petitioner will ever pray, &c.

(Signature of Petitioner.)

It is intended to serve this petition on ——

Fiat of Attorney-General. I hereby authorize the presentation to the High Court of Justice of the above written petition.

Richard E. Webster,
Attorney-General.

Royal Courts of Justice
——18—

Petition for Revocation of Patent (Another Form).

In the Matter of Letters Patent No. —— A.D. 18—

and

In the Matter of the Patents, Designs and Trade Marks Act, 1883.

To her Majesty's High Court of Justice.

The humble Petition of X. of ——

Sheweth as follows:—

1. On the —— day of —— 18— a patent was granted to your petitioner X. by the Commissioners of the United States Patent Office for certain new and useful improvements in apparatus for the manufacture of —— and —— and a specification fully describing the said invention was duly deposited at the said Patent Office and forms part of the said letters patent.

2. On the —— day of —— 18— your petitioner X. gave instructions to one —— and a power of attorney to act as his agent in England in

and about the obtaining the grant of letters patent for the above-named invention.

3. Instead of obtaining letters patent for and on behalf of your petitioner X. as a communication from abroad, the said —— conspired with —— to wrongfully and by fraud obtain from the Crown the grant of letters patent for the said invention to the said —— on behalf of himself as true and first inventor within this realm.

4. The usual declarations and specifications were filed and signed by the patentee —— and his agent —— and letters patent were duly granted on the —— day of —— A.D. 18— and numbered No. —— The said letters patent were obtained in fraud of the rights of your petitioner X.

5. It is claimed that by an agreement dated the —— an interest in the said United States Patent was given the said —— the said —— and to —— residing in the United States of America.

Your petitioner therefore humbly prays that the grant of the said letters patent to —— may be revoked, and for a declaration that your petitioner X. was the true and first inventor of the said invention. Or that such other order may be made in the premises as to this honourable Court shall seem meet.

And your petitioner will ever pray, &c.

Particulars of objections are delivered herewith.

It is intended to serve this petition on ——

Order for Revocation of Patent.

In the Matter of G. & G.'s Patent, No. —— A.D. ——

and

In the Matter of the Patents, Designs, and Trade Marks, Act, 1883.

North, J. 9th July, 1888.

Upon the petition of F. of —— in the —— on the —— preferred unto this Court, and upon hearing counsel for the petitioner, and for the respondents, G., G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Ltd., on the —— and upon reading the petition, the amended particulars of objections delivered by the petitioner, the exhibits produced to the witnesses named in the schedule hereto, and set opposite to their names in the third column of such schedule, and upon hearing the evidence of the witnesses named in the first column of such schedule, upon their examination taken orally before this Court on the days mentioned in such schedule: This Court did order that the petitioner should stand for judgment; and the same standing for judgment this day in the paper in the presence of counsel for the petitioner and the respondents, This Court doth

Petition.

Evidence.

Order revoking patent.

order that the Letters Patent No. —— A.D. —— in the petition mentioned granted to G. and G. be revoked.

And it is ordered that the respondents, G., G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Ltd., pay to the petitioner, F., his costs of the said petition (to be taxed by the taxing master on the higher scale).

Costs. Higher scale.

SCHEDULE.

Order Dismissing Petition for Revocation.

In the Matter of Letters Patent No. 6938, A.D. 1885
and
In the Matter of the Patents, Designs, and Trade Marks Act, 1883.

Stirling, J. 23rd February, 1887. A. 406.

Petition.

Upon the petition of A. of —— on the 24th day of November, 1886, preferred unto this Court that the grant of the above-mentioned letters patent to L. might be revoked, and for a declaration that the petitioner was the true and first inventor of the invention in the said petition mentioned, and upon hearing counsel for the petitioner and for the respondents L. and W., and upon reading the said petition, the affidavit of, &c. And this Court being of opinion that the petitioner has not brought his case within clause (D) of sub-sect. (4) of sect. 26 of the Patents, Designs, and Trade Marks Act, 1883, and that the petitioner has not sufficiently alleged or proved himself to be the true inventor within clause (D) of the same sub-section: Doth order that the said petition be dismissed without prejudice to the right of the petitioner to present another petition for revocation of the said letters patent under the said clause (D). And it is ordered that the petitioner A. do pay to the respondents L. and W., their costs of the said petition to be taxed by the taxing master.

Order dismissing petition.

IX.—Prolongation or Extension.

Advertisement of Intention to Present Petition for Extension.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— of —— and bearing date the —— day of —— 18— and No. ——

Notice is hereby given that it is the intention of —— to present a petition to Her Majesty in Council praying that the term of the said

letters patent may be extended. And notice is hereby further given that on the —— day of —— next, or on such subsequent day as the Judicial Committee of Her Majesty's Privy Council shall appoint for that purpose, application will be made to the said committee that a time may be fixed for hearing the matter of the said petition, and any person or persons desirous of being heard in opposition to the said petition must enter a caveat to that effect in the Privy Council on or before the said —— day of —— next.

Dated this —— day of —— 18—

Solicitors for the petitioner.]

Caveat.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— of —— in the county of —— for —— bearing date the —— No. ——

Caveat issued on behalf of ——

Let nothing be done in reference to the above-mentioned patent without due notice to ——

Dated this —— day of —— 18—

Solicitors for ——

Notice of Day for Hearing Motion to fix date of Hearing.

Council Office, Whitehall,
—— 18—

The registrar of the Privy Council begs to acquaint Messrs. —— that the motion to fix a day for the hearing of the petition of —— for the extension of letters patent granted to —— of —— for —— and bearing date the —— day of —— 18— No. —— will be heard by the Judicial Committee of the Privy Council on —— the —— of —— at half past ten o'clock in the forenoon.

Order fixing Day for Hearing Petition.

At the Council Chamber, Whitehall,
the —— day of —— 18—

By the Judicial Committee of the Privy Council.

Upon a motion this day made by counsel praying that a day may be appointed for hearing the petition of —— for an extension of the term

of certain letters patent, dated the —— day of —— 18—, No. —— granted to —— for the invention of ——

It is ordered by their lordships that the said petition be heard before this committee on —— day, the —— day of —— 18—, at —— o'clock in the forenoon, upon the petitioner forthwith advertising in the *London Gazette*, and two London newspapers, that that day has been fixed by their lordships for such hearing.

Advertisement of Day appointed for Hearing.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— of —— and bearing date the —— day of —— 18— No. ——

Notice is hereby given that their lordships the Judicial Committee of the Privy Council have appointed —— the —— day of —— 18— at half past ten o'clock in the forenoon for hearing the matter of the above petition.

Dated this —— day of —— 18—

Solicitor for petitioner.

Affidavit of Advertisement of Intention to present Petition.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— of —— for —— bearing date the —— day of —— 18— No. ——

I —— of —— make oath and say as follows:—

1. That on the —— day of —— 18— there appeared in the London Gazette an advertisement of which the following is a copy:—

[*Set out advertisement.*]

The said advertisement was repealed in the London Gazette the —— day of —— 18— the —— day of —— 18— and the —— day of —— 18—

2. On the —— day of —— 18— a similar advertisement appeared in the —— newspaper, a paper published in ——

3, 4, &c. [*Set out other advertisements as required pursuant to the Rules.*]

Sworn, &c.

Affidavit of Insertion of Advertisement of Day appointed for Hearing.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— of —— and bearing date the —— day of —— 18— No. ——

I —— of —— make oath and say as follows:—

1. That on the —— day of —— 18— there appeared in the London Gazette an advertisement in the above matter of which the following is a copy:—

[*Set out advertisement here.*]

2. On the —— day of —— 18— a similar advertisement appeared in the —— a paper published in the county of ——

3. (*Similar to* 2.)

Sworn, &c.

Affidavit of Service of Petition on Caveators.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— of —— for —— dated the —— No. ——

I, A. B. of —— make oath and say as follows:—

1. That I did on —— the —— day of —— 18— at —— o'clock in the afternoon serve Messrs. —— of —— the solicitors who have entered a caveat against the petitioners in the above matter with a true copy of the petition of the said —— for a prolongation of the term of the above-mentioned patent by giving such copy to and leaving the same with a clerk of the said —— at their office or place of business at —— aforesaid.

2. *Prove service on other caveators in similar manner.*

3. That I have to-day duly searched at the office of the Privy Council, and have ascertained that up to the period of the closing of the said office on ——day the —— of —— the day fixed by the advertisements in this matter for caveats to be lodged, the said caveats entered by —— are the only caveats entered against the said petition of ——

Sworn, &c.

Form of Petition for Prolongation.

IN THE PRIVY COUNCIL.

Presented the —— day of —— 18—.

To the Queen's most excellent Majesty in Council.

In the matter of letters patent granted to A. formerly of —— now —— in the county of ——, —— for the invention of "A new or improved —— constructed as a ——" dated the —— day of —— 1873, No. ——

The humble petition of the above-named A. formerly of —— now —— in the county of ——

Sheweth :—

Invention. 1. That your petitioner, previously to the grant of the letters patent hereinafter mentioned, invented, after considerable personal application and cost, "A new or improved —— constructed as a ——" (hereinafter called "the said invention"), which invention was and is of great utility, and greatly beneficial to the public.

Grant. 2. That your Majesty was graciously pleased by letters patent under the Great Seal of the United Kingdom of Great Britain bearing date the —— day of —— 1873, to grant unto your petitioner A., his executors, administrators, and assigns, the sole privilege and authority to use the said invention within the said United Kingdom, the Channel Islands and Isle of Man, for the term of fourteen years from the date of the said letters patent.

Specification enrolled. 3. That your petitioner, in compliance with a proviso in the said letters patent contained, duly made and cause to be filed in the Great Seal Patent Office, within six calendar months from the date of the said letters patent, an instrument in writing under his hand and seal, particularly describing and ascertaining the nature of his said invention, and the manner in which the same was to be performed.

Foreign patent rights. 4. That your petitioner has not obtained any letters patent or brevets d'invention for his said invention in any foreign country.

Expenditure, &c. on invention. 5. That your petitioner has expended large sums of money, and devoted great pains and trouble while in health in endeavouring to introduce the said invention to the public, and to bring the same into use.

Delay in presenting petition. 6. That your petitioner met with an accident while travelling on the —— Railway between —— and —— on —— day of —— 1878, and in consequence thereof was confined to his bed until nearly the end of the year 1882.

Reasons for. 7. That your petitioner would have presented this his petition earlier and about the —— day of ——, 1886, when he called at the Privy Council Office for particulars as to presenting same; he was, however [*here set out grounds of inability*].

Insufficient remuneration. 8. That your petitioner has, owing to [*mention circumstances*] failed to receive adequate benefit from his invention.

9. Your petitioner has no doubt that if the term of the said letters patent should be extended the said letters patent will become productive, and your petitioner will be able to obtain a fair reimbursement and remuneration commensurate with the great public value and importance of the said invention.

10. That your petitioner's invention was tried practically and with great success in the month of —— 1883, at ——, when the use of the invention for the —— was most amply demonstrated. Merits of invention.

11. That your petitioner exhibited a model of his invention at the —— Exhibition held in —— in 18— when he was awarded a gold medal; and at the —— Exhibition held at the —— in 18— when he was awarded the first prize of ——

12. That your petitioner humbly submits that under the circumstances of the case an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your petitioner.

13. That your petitioner has given public notice by advertisements caused to be inserted the requisite number of times in the London Gazette, and in other newspapers, pursuant to the statutes in that case made and provided, that it is his intention to apply to your Majesty in Council that the said letters patent may be extended for a further term. Advertisements.

Your petitioner therefore humbly prays that your Majesty will be graciously pleased to take the case of your petitioner into your Royal consideration, and to refer this petition to the Judicial Committee of your Majesty's most honourable Privy Council; and that your petitioner may be heard before such committee by his counsel and witnesses, and that your Majesty will be graciously pleased to grant to your petitioner a prolongation of the term by the said letters patent granted for the additional term of fourteen years, or for such other term as to your Majesty shall seem fit. Prayer.

And your petitioner will ever pray.

Form of Petition for Prolongation (Another Form).

IN THE PRIVY COUNCIL.

Presented the —— day of —— 18—

To the Queen's most excellent Majesty in Council.

In the matter of letters patent granted to A. in —— in the county of Middlesex for the invention of "Improvements in, &c.," dated the ——, No. ——.

The humble petition of the above-named ——, and others.

Sheweth:—

Invention. 1. That your petitioner, the above-named ——, previously to the grant of the letters patent hereinafter mentioned, invented, after considerable personal application and cost, certain "improvements in the means, &c." (hereinafter called "the said invention"), which invention was and is of great utility, and greatly beneficial to the public.

Grant of patent. 2. That your Majesty was graciously pleased, by letters patent under the Great Seal of the United Kingdom of Great Britain, bearing date the —— day of ——, to grant unto your petitioner ——, his executors, administrators and assigns, the sole privilege and authority to use the said invention within the said United Kingdom, the Channel Islands, and Isle of Man, for the term of fourteen years from the date of the said letters patent.

Specification filed. 3. That your petitioner ——, in compliance with a proviso in the said letters patent contained, duly made and caused to be filed in the Great Seal Patent Office, within six calendar months from the date of the said letters patent, an instrument in writing under his hand and seal, particularly describing and ascertaining the nature of his said invention, and the manner in which the same was to be performed.

No foreign patents. 4. That your petitioner —— has not obtained any letters patent, or *Brevets d'Invention* for his said invention in any foreign country.

5. [*Assignment of share of patent.*]

6. [*Agreement for partnership.*]

Agreement to form company. 7. By an indenture, dated the ——, and made between your petitioners —— of the first part, your petitioner —— of the second part, your petitioner —— of the third part, and your petitioner —— of the fourth part, certain arrangements were made between the parties thereto, with a view to the formation of a company for working the said letters patent, and certain other patents relating to the same subject-matter.

Assignments. 8, 9, 10, 11. [*Assignments.*]

12. [*Agreement with trustee for an intended company.*]

Formation of company. 13. The company contemplated by the last-mentioned agreement was duly formed and registered on the —— day of ——, under the name of the ——, and it is hereafter referred to as "the said company."

Adoption of agreement by company. 14. By an agreement dated the ——, and endorsed on the agreement last aforesaid, and made between your petitioners of the first part, —— of the second part, and the said company of the third part, the said company ratified and adopted the agreement last hereinbefore stated.

15, 16, 17. [*Allotment of shares, company wound up.*]

18. Under the circumstances aforesaid, your petitioners are entitled to the said letters patent in the following shares, that is to say:—your petitioner —— to —— parts thereof; your petitioner —— to —— parts thereof; your petitioner —— to —— parts thereof; your petitioner —— to —— parts thereof; and your petitioner —— to —— parts thereof. Interest of petitioners in patent.

19. That the said invention relates to the use of —— and ——, and it has been applied with very great and most marked practical success at ——, and elsewhere. Utility of invention.

20. That your petitioner —— has given much time and labour, and expended considerable sums of money in conducting experiments relating to the subject-matter of this invention. Expenditure, time, money, &c.

21. That your petitioners have expended large sums of money, and devoted great pains and trouble in endeavouring to introduce the said invention to the public, and to bring the same into use.

22. That your petitioners endeavoured to obtain the employment of the said invention by —— companies in London and the neighbourhood, but that owing to the uncertainty which has prevailed since the year —— in regard to proposed legislation ——, the companies have been unwilling to embark new capital in adopting the said invention.

23. That only one licence has ever been granted for the use of the said invention, that is to say, to ——, for the purpose of making and selling domestic ——, which licence was determined in the year ——. Licences.

24. That, as will appear by the accounts, your petitioner ——, notwithstanding the sums which he received from the said company as aforesaid—and even assuming that he had received from the said company the further sums which he has claimed as aforesaid—has not as yet received any adequate return for the capital and labour which he has expended on the said invention; and your petitioners —— and ——, have not received any adequate return for their outlay on the said invention, even assuming that they will receive the full amount of the said claim against the said company. Under the circumstances aforesaid, the said letters patent of the ——, have not been productive of any sufficient reward. No adequate return from invention.

25. That of late years the utility of the said invention has been generally acknowledged, and —— have been introduced into the various Government departments. They are now beginning to be used by railway companies, hospitals and schools, not only in this country, but also by railway and telegraph companies in India, Persia and other foreign countries. Quite recently negotiations have been opened with your petitioner —— on behalf of the new scheme of supplying ——, and it is likely that this may lead to a large business. Another application received quite recently is ——. Taking the three last years the value of the sales effected in the domestic —— department increased in —— about 13 per cent. as compared with ——, and again in —— about 26 per cent. as compared with ——. Prospects of invention.

26. That it is only now, when the letters patent are about to expire, that the use of the said invention is becoming fully established and extending, and your petitioners have no doubt that if the term of the said letters patent should be extended the said letters patent will become productive, and your petitioner —— will be able to obtain a fair reimbursement and remuneration commensurate with the great public value and importance of the said invention.

27. That your petitioners humbly submit that, under the circum- Term asked for.

stances of the case, an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your petitioners.

Advertisements.

28. That your petitioners have given public notice, by advertisements caused to be inserted the requisite number of times in the *London Gazette*, and in Metropolitan and country newspapers, pursuant to the statutes in that case made and provided, that it is their intention to apply to your Majesty in Council that the said letters patent may be extended for a further term.

Prayer of petition.

Your petitioners therefore humbly pray that your Majesty will be graciously pleased to take the case of your petitioners into your royal consideration, and to refer the same to the judicial committee of your Majesty's Most Honourable Privy Council, and that your petitioners may be heard before such committee by their counsel and witnesses, and that your petitioners' letters patent be extended for the further and additional term of fourteen years, or for such other term as to your Majesty shall seem fit.

And your petitioners will ever pray.

IN THE PRIVY COUNCIL.

——'s PATENT (18—, —— ——), No. —, IMPROVEMENTS IN ——.

PETITION FOR PROLONGATION.

ACCOUNT OF EXPENDITURE AND RECEIPTS.

Account of the Expenditure and Receipts of the Petitioner.

FIRST YEAR.

	EXPENDITURE.	£ s. d.	RECEIPTS.
18— Mar. 2nd to Dec. 31st	At and prior to this date Petitioner —— had expended various sums for models and other expenses of which he kept no account and is unable to specify them, but subsequently paid following :		*Nil.*
	Journey to London		
	Models		
	Sundry expenses—trials.....		
	Total Expenditure 18—.....£		

SECOND YEAR.

	EXPENDITURE.	£ s. d.		RECEIPTS.	£ s. d.
18— Jan. 1st to Dec. 31st	To amount paid —— for half share of Patent Petitioner had assigned to him ——		18— Jan. 1st to Dec. 31st	By Amount received from Messrs. —— & —— for right of sole manufacture	
	,, Amount paid above ——'s expenses of taking out patent, trials, &c.....			,, Amount paid by Messrs. —— & —— to Petitioner —— to enable him to devote his time specially to forwarding the invention and to be accepted in lieu of royalty during 18—	
	,, Travelling expenses London and Portsmouth..				
	,, Advertising, printing, &c.			10 [*patented articles*] sold during 18— :	
	,, Cost of models			Total weight of same —— cwts. — qr. — lbs.	
	,, Expenses at trials.....			Total value of [*patented articles*] received by Petitioner and by him paid to the manufacturers Messrs. —— & ——....£	
	,, Legal expenses				
	,, Office furniture				
	,, Rent of offices				
	,, Rates and taxes.....				
	,, Subscription to exchange.....				
	,, Salaries of clerk.....				
	,, Office expenses				
	Total Expenditure for 18—.....£			Total Receipts for 18— .....£	

THIRD YEAR.

Expenditure.	£ s. d.	Receipts.	£ s. d.
18— Jan. 1st to Dec. 31st	To —— Exhibition Expenses	18— Jan. 1st to Dec. 31st	By amount paid by Messrs. —— & —— to Petitioner, ——, to enable him to devote his time specially to forwarding the invention, and to be accepted in lieu of royalty during 18— ....
	,, Travelling expenses		
	,, Advertising and printing		
	,, Cost of models, photographs, frames, &c.		21 [*patented articles*] sold during 18—:
	,, Expenses at trials, &c.		Total weight of same, —cwts. —qrs. —lbs.
	,, Legal expenses		Total value of [*patented articles*] received by Petitioner, and by him paid to the manufacturers, Messrs. —— & —— .... £
	,, Commission paid agents		
	,, Office furniture		
	,, Rent of offices		
	,, Rates and taxes		
	,, Salaries		
	,, Office expenses		
	,, [*Patented article*] not paid for, ——		
	,, Bank commission		
	Total Expenditure for 18— .... £		Total Receipts for 18— ..... £

FOURTH YEAR.

Expenditure.	£ s. d.	£ s. d.	Receipts.	£ s. d.
18— Jan. 1st to Dec. 31st	To travelling expenses as per book		18— Jan. 1st. to Dec. 31st	By amount paid by Messrs. —— & —— to Petitioner. ——, to enable him to devote his time specially to forwarding the invention, and to be accepted in lieu of royalty during 18— ....
	,, Patent duty (3 years) and expenses..			
	,, Advertising and printing			
	,, Cost of models			18 [*patented articles*] sold during 18—:
	,, Expenses at trials, &c.			Total weight of same, —cwts. —qrs. —lbs.
	,, Legal expenses			Total value of [*patented articles*] received by Petitioner, and by him paid to the manufacturers, Messrs. —— & —— .... £
	,, Commission paid agents			
	,, [*Patented articles*] not paid for, No.—			
	General Expenses.			
	,, Rent of offices and wharf			
	,, Rates and taxes			
	,, Salaries			
	,, Travelling and general trade expenses			
	,, Bank interest and commission			
	£			
	½ to Patent Account*			
	Total Expenditure for 18—	£		Total Receipts for 18— ..... £

* At this time the petitioner's patent business took up ½ time of petitioner's assistant.

FIFTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.
Jan. 1st to Dec. 31st	To balance —— Exhibition Expenses..		
	,, Advertising and printing.....		
	,, Expenses at trials, &c.		
	,, Commission paid agents		
	General Expenses.		
	To rent of offices and wharf		
	,, Salaries.....		
	,, Travelling and general trade expenses		
	,, Bank interest and commission		
	£		
	⅓ to Patent Account*		
	Total Expenditure for 18— .....£		

18—	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	By Royalty received during 18—, as per book	
	19 [*patented articles*] sold during 18— :	
	Total weight of same, —cwts. —qrs. —lbs.	
	Total value of [*patented articles*] sold by Petitioner, and by him paid to Messrs. —— & ——, less above royalty, £ ..£	
	Total Receipts for 18— .....£	

* *Memo.*—At this date the Petitioner's general business had increased, and the profits derived from it seemed to demand that a larger share of the expenses should be charged to that business, and therefore from this date Petitioner has only charged to this business one-third of the general expenses.

SIXTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.
Jan. 1st to Dec. 31st	To Travelling expenses to London		
	,, Share of bad debt, ——		
	,, Advertising and printing.....		
	,, Photographs and frames		
	,, Commission paid agents		
	General Expenses.		
	To Rent of offices and wharf and of show room at ——		
	,, Salaries		
	,, Travelling and general trade expenses		
	,, Alterations to show-room at —— ..		
	,, Bank interest and commission.....		
	£		
	⅓ to Patent Account		
	Total Expenditure for 18—.....£		

18—	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	By Royalty received during 18—, as per book	
	10 [*patented articles*] sold during 18— :	
	Total weight of same, —cwts —qrs. —lbs.	
	Total value of [*patented articles*] sold by Petitioner, and by him paid to Messrs. —— & ——, less above royalty, £ ..£	
	Total Receipts for 18— .....£	

PROLONGATION OR EXTENSION.

SEVENTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.	18—	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	To Travelling expenses, —— to ——			Jan. 1st to Dec. 31st	By Royalty received during 18— as per book	
	,, Advertising and printing					
	,, Photographs and frames					
	,, Commission paid agents					
	,, [*Patented articles*] No. —, only part paid for					
	,, Expenses at trials, &c.					
	General Expenses.				42 [*patented articles*] sold during 18— :	
	To Rent of offices and wharf and of show-room at ——				Total weight of same, —cwts. —qrs. —lbs.	
	,, Rates and taxes				Total value of [*patented articles*] sold by Petitioner and by him paid to Messrs. —— & ——	
	,, Salaries				less above royalty, £ ..£	
	,, Travelling and general trade expenses					
	,, Bank interest and commission					
	£					
	½ to Patent Account					
	Total Expenditure for 18— .... £				Total Receipts for 18— ....£	

EIGHTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.	18—	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	To Travelling expenses, Petitioner			Jan. 1st to Dec. 31st	By Royalty received during 18— as per book	
	,, ,, ,, ——					
	,, Advertising and printing					
	,, Photographs and frames					
	,, Legal expenses					
	,, Commission paid to agents					
	,, Patent duty (7th year) and expenses					
	General Expenses.				55 [*patented articles*] sold during 18— :	
	To Rent of offices and wharf and of show-room at ——				Total weight of same, —cwts. —qrs. —lbs.	
	,, Rates and taxes				Total value of [*patented articles*] sold by Petitioner and by him paid to Messrs. —— & ——	
	,, Salaries				less above royalty, £ ..£	
	,, Travelling and general trade expenses					
	,, Bank interest and commission					
	£					
	½ to Patent Account					
	Total Expenditure for 18— ..£				Total Receipts for 18— .....£	

NINTH YEAR.

18—.	Expenditure.	£ s. d.	£ s. d.
Jan. 1st to Dec. 31st	To Travelling expenses, —— to ——		
	,, Advertising and printing.....		
	,, Photographs and frames		
	,, Expenses at trials, &c.....		
	,, Commission paid to agents		
	General Expenses.		
	To Rent of wharf, offices, and show-room at ——		
	,, Rates and taxes.....		
	,, Salaries		
	,, Travelling and general trade expenses		
	,, Bank interest and commission		
	,, Alterations in offices at ——		
	,, Painting at ——		
	,, Plumbing at ——		
		£ /	
	⅓ to Patent Account		
	Total Expenditure for 18— .....£		

18—.	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	By Royalty received during 18—, as per book	
	55 [*patented articles*] sold during 18— :	
	Total weight of same, —cwt. —qrs. —lbs.	
	Total value of [*patented articles*] sold by Petitioner and by him paid to Messrs. —— & ——, less above royalty, £ .... £	
	Total Receipts for 18— .....£	

PROLONGATION OR EXTENSION.

TENTH YEAR.

18—.	Expenditure.	£ s. d.	£ s. d.
Jan. 1st to Dec. 31st	To Share of bad debt (——)		
	,, Advertising and printing.....		
	,, Expenses at trials, &c.....		
	,, Commission paid to agents		
	,, Royalty on No. ——, returned —— & ——		
	General Expenses.		
	To Rent of wharf, offices, and show-room at ——		
	,, Rates and taxes.....		
	,, Salaries		
	,, Travelling and general trade expenses		
	,, Bank interest and commission		
	£		
	⅓ to Patent Account		
	Total Expenditure for 18— .....£		

18—	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	By Royalty received during 18—, as per book	
	37 [*patented articles*] sold during 18— :	
	Total weight of same, —cwts. — qrs. —lbs.	
	Total value of [*patented articles*] sold by Petitioner, and by him paid to Messrs. —— & ——, less above royalty, £ ..... £	
	Total Receipts for 18— .....£	

ELEVENTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	To Travelling expenses to ——			18— Jan. 1st to Dec. 31st By Royalty received during 18—, as per book	
	,, Advertising and printing				
	,, Expenses at trials				
	,, Commission paid to agents				
	,, Share of bad debt (——)				
	,, Legal expenses				
	General Expenses.				
	,, Rent of wharf, offices, and show-room at ——				
	,, Rates and taxes				
	,, Salaries				
	,, Travelling and general trade expenses				
	,, Bank interest and commission				
	£				
	½ to Patent Account			61 [*patented articles*] sold during 18—: Total weight of same, —cwts. —qrs. —lbs. Total value of [*patented articles*] sold by Petitioner, and by him paid to Messrs. —— & ——, less above royalty, £ ..... £	
	Total Expenditure for 18— ..... £			Total Receipts for 18— ..... £	

TWELFTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	To Expenses ——			18— Jan. 1st to Dec. 31st By Royalty received during 18—, as per book	
	,, ,, ——				
	,, Royalty, returned —— & ——				
	,, Advertising and printing				
	,, Cost of models, photographs, and frames				
	,, Expenses at trials, &c.				
	,, Commission paid to agents				
	General Expenses.				
	,, Rent of wharf, offices, and show-room, ——				
	,, Rates and taxes				
	,, Salaries				
	,, Travelling and general trade expenses				
	,, Bank interest and commission				
	£				
	½ to Patent Account			83 [*patented articles*] sold during 18—: Total weight of same, —cwts. —qrs. —lbs. Total value of [*patented articles*] sold by Petitioner, and by him paid to Messrs. —— & ——, less above royalty, £ .....£	
	Total Expenditure for 18— ..... £			Total Receipts for 18— ..... £	

THIRTEENTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.	18—	Receipts.	£ s. d.
Jan. 1st to Dec. 31st	To Royalty —— returned.....			Jan. 1st to Dec. 31st	By Royalty received during 18—, as per book	
	,, Travelling expenses, Petitioner, London					
	,, Advertising and printing					
	,, Photographs and frames					
	,, Expenses at *trials*					
	,, Commission paid to agents					
	,, Legal expenses.....					
	General Expenses.					
	To Rent of wharf, offices and show-rooms at ——					
	,, Rates and taxes.....					
	,, Salaries					
	,, Travelling and general trade expenses					
	,, Bank interest and commission					
	£					
	½ to Patent Account.....					
	Total Expenditure for 18— .....£				Total Receipts for 18— .....£	

87 [*patented articles*] sold during 18—:
Total weight of same, —cwts. —qrs. —lbs.
Total value of [*patented articles*] sold by Petitioner and by him paid to Messrs. —— & —— less above royalty, £ .....£

FOURTEENTH YEAR.

18—	Expenditure.	£ s. d.	£ s. d.	18—	Receipts.	£ s. d.
Jan. 1st to	To Legal and other expenses connected with *infringement*			Jan. 1st to Dec. 31st	By Royalty received during 18—, as per book	
	,, Travelling expenses ——				,, Amount received from —— of Scotland for infringement	
	,, Advertising and printing				,, —— & —— share of *infringement expenses* ..	
	,, Cost of models, photograph, frames, &c.					
	,, Expenses at trials					
	,, Commission paid to agents (say) ..					
	,, Royalty returned ——					
	General Expenses.					
	To Rent of wharf, offices, and show-room at ——					
	,, Rates and taxes.....					
	,, Salaries					
	,, Travelling and general trade expenses					
	,, Bank interest and commission					
	£					
	½ to Patent Account.....					
	Total Expenditure for 18— .....£				Total Receipts for 18— .....£	

86 [*patented articles*] sold during 18—:
Total weight of same, —cwts. —qrs. —lbs.
Total value of [*patented articles*] sold by Petitioner and by him paid to Messrs. —— & —— less above royalty, £ .....£

PROLONGATION OR EXTENSION.

Summary of Petitioner's Accounts.

IN THE PRIVY COUNCIL.

——'s PATENT, *No.* ——, 18—.

IMPROVEMENTS IN ——.

SUMMARY OF PETITIONER'S ACCOUNTS.

Loss. £ s. d.			Profit. £ s. d.
	First year—		
	Receipts	Nil.	
	Expenditure		
	Second year—		
	Receipts		
	Expenditure		
	Third year—		
	Receipts		
	Expenditure		
	Fourth year—		
	Receipts		
	Expenditure		
	Fifth year—		
	Receipts		
	Expenditure		
	Sixth year—		
	Receipts		
	Expenditure		
	Seventh year—		
	Receipts		
	Expenditure		
	Eighth year—		
	Receipts		
	Expenditure		
	Ninth year—		
	Receipts		
	Expenditure		
	Tenth year—		
	Receipts		
	Expenditure		
	Eleventh year—		
	Receipts		
	Expenditure		
	Twelfth year—		
	Receipts		
	Expenditure		
	Thirteenth year—		
	Receipts		
	Expenditure		
	Fourteenth year—		
	Receipts		
	Expenditure		
£		Deduct Loss	£
		Total Profit	

Form of Manufacturer's Accounts.

In the Privy Council.

——'s Patent, [*date*], No. ——, Improvement in ——.

PETITION FOR PROLONGATION.

Manufacturer's Accounts.

Dr. *Profit and Loss Account from* ——, 18— *to* ——, 18—. Cr.

	£	s.	d.
[*Patented articles*] manufactured and sold from —— to ——, 18—:			
10 [*patented articles*] —cwts. —qrs. —lbs.			
Patentee for sole right of manufacture			
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons, —cwts. —qr. —lbs.			
Discounts and commissions			
£			

	£	s.	d.
Sale of [*patented articles*] as per contra—			
10 [*patented articles*] —cwts. —qrs. —lbs.			
£			

Manufacture of —— 's [*patented article*].

Dr. *Profit and Loss Account for the year ending* ——, 18—. Cr.

	£	s.	d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:			
21 [*patented articles*] —cwts. —qrs. —lbs.			
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons, —cwts. —qrs. —lbs.			
Discount and commissions			
£			

	£	s.	d.
Sale of [*patented articles*] as per contra—			
21 [*patented articles*] —cwts. —qrs. —lbs.			
£			

MANUFACTURE OF ——'S [*patented article*].

Profit and Loss Account for the Year ending ——, 18—.

DR. CR.

	£	s.	d.		£	s.	d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:				Sales of [*patented articles*] as per contra—			
18 [*patented articles*], —cwts. —qrs. —lbs.				18 [*patented articles*], —cwts. —qrs. —lbs.			
Royalties							
Railway and other carriages—							
£— per ton on quantity invoiced, viz., —tons, —cwts. —qrs. —lbs.							
Discounts and commissions							
Rent of wharf							
Allowance, &c.							
Exhibition expenses							
	£				£		

MANUFACTURE OF ——'S [*patented article*].

Profit and Loss Account for the Year ending ——, 18—.

DR. CR.

	£	s.	d.		£	s.	d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:				Sales of [*patented articles*] as per contra—			
19 [*patented articles*], —cwts. —qrs. —lbs.				19 [*patented articles*], —cwts. — qrs. —lbs.			
Royalties							
Railway and other carriages—							
£— per ton on quantity invoiced, viz., —tons, —cwts. —qrs. —lbs.							
Discounts and commissions							
Rent of wharf							
Allowances, &c.							
	£				£		

N.B.—The loss on the sale of [*patented articles*] in the years 18—, 18—, 18 -, 18— was owing to the very high prices of materials and labour, also to the fact that it was a new manufacture, and therefore took some years to be properly developed.

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:		Sales of [*patented articles*], as per contra—	
10 [*patented articles*] —cwts. —qrs. —lbs.		10 [*patented articles*], —cwts. —qrs. —lbs.....	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz. —tons —cwts. —qrs. —lbs.....			
Discounts and commissions			
Rent of wharf			
Allowance, &c.			
	£		£

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:		Sales of [*patented articles*] as per contra—	
42 [*patented articles*], —cwts. —qrs. —lbs.		42 [*patented articles*], —cwts. —qrs. —lbs.	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons, —cwts. —qrs. —lbs.....			
Discount— nd commissions			
Rent of wharf			
Allowance, &c.			
Galvanizing [*patented articles*]			
	£		£

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£	s.	d.		£	s.	d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:				Sales of [*patented articles*], as per contra—			
55 [*patented articles*], —cwt. —qrs. —lbs.				55 [*patented articles*], —cwts. — qrs. —lbs.			
Royalties							
Railway and other carriages—							
£— per ton on quantity invoiced, viz., —tons —cwts. —qrs. —lbs.							
Discounts and commissions							
Rent of wharf							
Allowance, &c.							
Galvanizing [*patented articles*]							
£				£			

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£	s.	d.		£	s.	d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:				Sales of [*patented articles*], as per contra—			
55 [*patented articles*], —cwts. — qrs. —lbs.				55 [*patented articles*], —cwts. —qrs. —lbs.			
Royalties							
Railway and other carriages—							
£— per ton on quantity invoiced, viz., —tons —cwts. —qrs. —lbs.							
Discounts and commissions							
Rent of wharf							
Allowance, &c.							
£				£			

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:		Sales of [*patented articles*], as per contra—	
37 [*patented articles*], —cwts. —qrs. —lbs.		37 [*patented articles*], —cwts. —qrs. lbs.	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons —cwts. —qrs. — lbs.			
Discounts and commissions			
Rent of wharf			
Allowance, &c.			

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:		Sales of [*patented articles*], as per contra—	
61 [*patented articles*], —cwts. —qrs. —lbs.		61 [*patented articles*], —cwts. —qrs. —lbs.	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons,— cwts. —qrs. —lbs.			
Discounts and commissions			
Rent of wharf			
Allowance, &c.			

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:		Sales of [*patented articles*], as per contra—	
83 [*patented articles*], —cwts. —qrs. —lbs.		83 [*patented articles*], — cwts. — qrs. — lbs.	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons —cwts. —qrs. —lbs.			
Discounts and commissions			
Rent of wharf			
Allowance, &c.			

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:		Sales of [*patented articles*], as per contra—	
87 [*patented articles*], —cwts. —qrs. —lbs.		87 [*patented articles*], — cwts. —qrs. —lbs.	
Royalties			
Railway and other carriages—			
£— per ton on quantity invoiced, viz., —tons —cwts. —qr. —lbs			
Discounts and commissions			
Rent of wharf			
Allowance, &c.			

MANUFACTURE OF ——'S [*patented article*].

DR. *Profit and Loss Account for the Year ending* ——, 18—. CR.

	£ s. d.	£ s. d.		£ s. d.
[*Patented articles*] manufactured and sold for the year ending ——, 18—:			Sales of [*patented articles*], as per contra—	
86 [*patented articles*], —cwts. —qrs. —lbs...			86 [*patented articles*], —cwts. —qrs. —lbs.	
Royalties paid				
Do. accrued but unpaid				
Railway and other carriages—				
£— per ton on quantity invoiced, viz., —tons, —cwts. —qrs. —lbs.				
Discounts and commissions				
Rent of wharf				
Allowance, &c.....				

PROLONGATION OF EXTENSION.

SUMMARY OF PROFIT AND LOSS ACCOUNT ANNUAL TOTALS

For the Years from ——, 18—, *to* ——, 18—.

DEBITS.	£ s. d.	£ s. d.	CREDITS.	£ s. d.	£ s. d.
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
18—			18—		
			Balance down		
To balance down, being loss on manufacturing, to date..					

Note.—This amount is exclusive of any charge for capital expenditure on machinery, put down exclusively for the manufacture of [*patented articles*], and also for any depreciation or interest on value of [*patented articles*] now in stock which have been made at various periods.

Notice of Objections to Prolongation of Patent.

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to —— and —— both of —— in the county of —— for the invention—"Improvements in machinery or apparatus for ——," bearing date the —— 18— No. ——

and

In the matter of a petition of —— and —— for an extension of the said letters patent.

Grounds of objection by —— of —— to the granting of the prayor of the above mentioned petition.

1. The alleged invention was not new at the date of the said letters patent or useful. Novelty.

2. The alleged invention, if new at the date of the said letters patent, was at most a small improvement on the mode of —— in use prior to the said dato, and in fact varies very little from the inventions described in previous specifications, and particularly those of —— 18— No. —— and of the petitioners of the —— 18— No. —— and —— 18— No. — and is not of great merit. Small merit.

3. The petitioners have already received a full reward adequate to the merit of their alleged invention, and have derived large trade profits from their business, established solely by the monopoly they have enjoyed from their said patents. Full reward already received.

4. If any inadequacy of remuneration has occurred, it has arisen from the acts of the petitioners themselves in not advertising and pushing the said machine. They have refused licences for use of the invention, and have insisted that persons who have desired to work any part of the invention should purchase a complete machine of a costly character, made under all three of the said patents, and sold at an exorbitant price. If reward insufficient due to laches of petitioners.

5. The petitioners have never brought actions to restrain alleged infringements of their patent, though they have continually threatened so to do. Conduct of petitioners.

6. In consequence of the expiry of the patents in —— and ——, the alleged invention can be now freely worked in those countries. Some foreign patents expired.

7. The facts as stated in the said petition are incapable of proof.

Dated this —— day of —— 18—

(Signed) ——
Solicitor for the said ——

Notice of Objections to Prolongation of Patent (Another Form).

IN THE PRIVY COUNCIL.

In the matter of letters patent granted to A., No. —— 18— for the invention of ——

and

In the matter of the petition of the —— for an extension of the term of the said letters patent.

The grounds of objection of —— of —— in the county of ——, ——, and trading there under the style of —— to the granting of the prayer of the above-mentioned petition —— are as follows:—

Merit denied. 1. That the said alleged invention was not and is not of great advantage or benefit to the public.

Adequate remuneration. 2. That the said inventor has already received a full and adequate remuneration for the alleged invention.

Invention not novel. 3. That there is no sufficient merit in the said invention.

4. That the alleged invention comprised in the said letters patent was not new within this realm at the date of the said letters patent, nor was the said A. the true and first inventor in proof whereof leave is craved to refer to a previous patent obtained by —— No. —— 18—.

5. That the object of the alleged invention to —— had been accomplished by the said invention of the said —— previous to the letters patent No. —— granted to A.

6. That the allegations in the petition are incapable of proof.

Dated this —— day of —— 18—

(Signed) ——
Solicitor for ——

Queen's Order in Council for Prolongation of Patent.

At the Court at —— the —— day of —— 189—. Present, The Queen's Most Excellent Majesty, Lord President, ——.

WHEREAS there was this day read at the Board a Report from the Judicial Committee of the P. C., dated &c., in the words following, viz.: "Your Majesty having been pleased by your Order in Council of the —— day of ——, to refer unto this Committee the humble petition of &c., setting forth &c., The Lords of the Committee, in obedience to Your Majesty's said order of reference, have taken the said petition into consideration, and having heard the Petitioners &c., their Lordships do this day agree humbly to report to Your Majesty, &c." Her Majesty having taken the said report into consideration, was pleased, by and with the advice of her P. C., to approve thereof, and to order, as it is hereby ordered, that the Comptroller-General of Patents, upon receipt hereof, do cause new letters patent, according to

the tenor and effect of this order, to be made and sealed &c., provided that application be made to seal such new letters patent within three calendar months from the date of this order; whereof the Comptroller-General of Patents, and all other persons whom it may concern, are to take notice and govern themselves accordingly.

C. L. PEEL (*a*).

Certificate of Registrar.

Council Office, Whitehall,
——18—

Her Majesty has been pleased by her Order in Council of the —— day of —— 18— to direct that new letters patent be granted to —— for the term of —— years in extension of certain letters patent, No. —— for the invention of —— such letters patent having been originally granted to —— for the United Kingdom of Great Britain and Ireland, and the Channel Islands, and bearing date —— 18—

New Letters Patent granted after Order in Council prolonging Term.

No. ——. 1874.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To ALL TO WHOM THESE PRESENTS SHALL COME GREETING. WHEREAS we did by our letters patent under the Great Seal of our United Kingdom of Great Britain and Ireland bearing date the tenth day of September one thousand eight hundred and seventy-four, and numbered ——, grant unto X. *then of —— in the county of ——, North Britain,* civil engineer, his executors, administrators and assigns, Our especial license, full power, sole privilege, and authority that he the said X., his executors, administrators, and assigns, and every of them, should and lawfully might make, use, exercise, and vend an invention for "improvements in —— or ——" within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, in such manner as to him the said X., his executors, administrators and assigns, or any of them, should in his or their discretion seem meet: To have, hold, exercise, and enjoy the said licenses, powers, privileges and advantages therein granted, or mentioned to be granted, unto the said X., his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day

Recitals.

(*a*) Signature of Clerk to Privy Council.

of the date of the said letters patent next and immediately ensuing and fully to be complete and ended according to the statute in such case made and provided as by the said letters patent, relation being thereunto had will more fully and at large appear. AND WHEREAS in pursuance of a proviso in that behalf in the said letters patent contained, the said X. did particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed by an instrument in writing under his hand and seal, and did cause the same to be duly filed in the Great Seal Patent Office. And the other conditions contained in the said letters patent relating to the payment of stamp duties and other matters have all been duly performed. AND WHEREAS the said X. has by his petition humbly represented unto us (amongst other things) that the profits of his said invention had been exceedingly small in comparison with its value, and humbly prayed that we would be pleased to take the case of the petitioner into consideration, and that the petitioner's said letters patent might be extended for the further and additional term of fourteen years, or for such other term as to us should seem fit.

Petition for prolongation.

AND WHEREAS the matter of the said petition having been referred to the Judicial Committee of our Privy Council, their lordships in pursuance of the statute in such case made and provided reported to us that (in case we should so think fit) new letters patent ought to be granted to the said X. for the said invention of "improvements in —— or ——" for which letters patent were granted to the said X., bearing date at Westminster the tenth day of September one thousand eight hundred and seventy-four, No. ——. And that such new letters patent should be granted for a term of *ten years* from and after the expiration of the term of the said original letters patent.

Reference to and report of Privy Council.

New letters patent for ten years.

KNOW YE THEREFORE that we, of our especial grace, certain knowledge and mere motion, do by these presents for us, our heirs and successors, give and grant unto the said X., the original patentee, now of Ipswich in the county of Suffolk, civil engineer, his executors, administrators, and assigns (hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee), our especial license, full power, sole privilege and authority that the said patentee, by himself, his agents or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention for "improvements in —— or ——," as described in the letters patent granted to the said X. on the tenth day of September, one thousand eight hundred and seventy four, and numbered ——, within our United Kingdom of Great Britain and Ireland, the Channel Islands and Isle of Man, in such manner as to him may seem meet. And that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of *ten years* from the date hereunder written of these presents. And to the end that the said patentee may have and enjoy the sole use and exercise, and the full benefit of the said invention. We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, that they do not at any time during the continuance of the said term of ten years, either

Grant,

includes Channel Islands.

directly or indirectly, make use of or put in practice the said invention or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof without the consent, license, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: PROVIDED THAT THESE OUR LETTERS PATENT ARE ON THIS CONDITION, that if at any time during the said term it shall be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention was not, at the date of the said original letters patent, a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, or that the said X. was not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine and be void to all intents and purposes, notwithstanding anything hereinbefore contained: PROVIDED ALSO that if the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then and in any of the said cases these our letters patent, and all privileges and advantages whatever hereby granted, shall determine and become void, notwithstanding anything hereinbefore contained. PROVIDED ALSO that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted. *And lastly, we do by these presents for us, our heirs and successors,* grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. IN WITNESS whereof we have caused these our letters patent to be made patent this tenth day of September, one thousand eight hundred and eighty-eight, and to be sealed as of the said tenth day of September, one thousand eight hundred and eighty-eight.

Provisoes.

By Her Majesty's Order in Council.

(SEAL.)

Council Office Fees (*a*).

On Appeals and Petitions to the Queen in Council.

	£	s.	d.
Lodging Petition of Appeal	*1*	*1*	*0*
Entering	1	1	0
Lodging Case	*1*	*1*	*0*
Entering Appearance	*0*	*10*	*0*
Setting down *Case*	0	10	0

(*a*) The items in italics do not apply to petitions for prolongation.

	£	s.	d.
Summons	0	10	0
Committee Report	1	10	0
Order of Her Majesty in Council	3	2	6
Committee Order	1	12	6
Lodging Affidavit	1	1	0
Do. Petition	1	1	0
Notice to Attend	*0*	*10*	*0*
Searching Books for Information for Parties	0	10	0
Certificate delivered to Parties	*0*	*10*	*0*
Copies of Papers (each side)	*0*	*5*	*0*
Committee References	2	2	0
Lodging Caveat	1	1	0
Subpœna to Witnesses	0	10	0
Fee for Taxation (Appeals)	*3*	*3*	*0*
Do. do. (Petitions)	1	1	0

X.—Confirmation (*a*).

Form of Special Act to Confirm Patent.

(*Potter's Patent Act*, 1887, 50 & 51 *Vict. c. cxxi.*(*b*).)

An Act for rendering valid certain Letters Patent granted to Richard Potter for Improvements in Furnaces for melting Glass. [19th July, 1887.]

Preamble.

Whereas by letters Patent under the Great Seal of Great Britain bearing date the twenty-second day of June one thousand eight hundred and eighty-two being the forty-sixth year of the reign of her present Majesty Queen Victoria and numbered two thousand nine hundred and seventy-one her Majesty did give and grant unto Richard Potter of Dearne Terrace Stairfoot in the county of York his executors administrators and assigns her special licence full power sole privilege and authority that he the said Richard Potter his executors administrators and assigns and every of them by himself and themselves or by their deputies servants or agents or such others as he the said Richard Potter his executors administrators and assigns should at any time agree with and no others from time to time and at all times thereafter during the term of fourteen years from the date of the said letters patent should and lawfully might make use and exercise and vend within the United Kingdom of Great Britain and Ireland the Channel Islands and Isle of Man an invention therein mentioned for "improvements in furnaces for melting glass" in which letters patent is contained a proviso making void the said letters patent if the said Richard Potter his executors and administrators should not particularly describe and ascertain the nature of the said invention and in what manner the same is to be performed by an instrument in writing under their or one of their hands and seals and cause the same to be filed in the Great Seal Patent Office within six calendar months next and immediately after the date of the said recited letters patent and also if the said Richard Potter his executors administrators or assigns should not pay the stamp duty of fifty pounds and produce the said recited letters patent stamped with a proper stamp to that amount at the office of the Commissioners of Patents for inventions before the expiration of three

Grant of patent.

(*a*) For a form of petition to the Privy Council for confirmation, see Hindmarch, pp. 642, 643.

(*b*) See Chap. XIX.

years from the date of the said letters patent which expired on the twenty-second day of June one thousand eight hundred and eighty-five; Specification filed.

And whereas a specification was duly filed by the said Richard Potter in the Great Seal Patent Office within the time limited by the said letters patent whereby the said Richard Potter did particularly describe and ascertain the nature of the said invention and in what manner the same was to be performed;

And whereas by an indenture dated the seventeenth day of February one thousand eight hundred and eighty-three and made between the said Richard Potter of the one part and Hiram Codd and Dan Rylands therein described of the other part and duly registered in the Great Seal Patent Office on the twenty-fifth day of April one thousand eight hundred and eighty-three the said Richard Potter for the considerations therein mentioned assigned transferred and set over to the said Hiram Codd and Dan Rylands the said letters patent upon the terms and conditions therein mentioned; Assignment.

And whereas by indenture bearing date the sixth day of October one thousand eight hundred and eighty-four and made between the said Hiram Codd of the one part and the said Dan Rylands of the other part and duly registered in the Patent Office on the twenty-third day of December one thousand eight hundred and eighty-four the said Hiram Codd did for the considerations therein mentioned grant assign release and confirm unto the said Dan Rylands one equal half part or share or all other the share and interest of the said Hiram Codd of in and to the said letters patent and such letters patent are now vested in and belong to the said Dan Rylands exclusively and he is the registered patentee thereof; Further assignment.

And whereas by the Patents Designs and Trade Marks Act 1883 the time within which the above-mentioned stamp duty or fee of fifty pounds should be paid was extended to the end of the fourth year from the date of the said letters patent which expired on the twenty-second day of June one thousand eight hundred and eighty-six; Non-payment of stamp duty.

And whereas the said Dan Rylands omitted to pay the said stamp duty or fee of fifty pounds and on the first day of October one thousand eight hundred and eighty-six the said letters patent were announced to be void in the official journal published under the provisions of section 40 of the Patents Designs and Trade Marks Act 1883; Patent declared void in consequence.

And whereas the said Dan Rylands discovered the omission to pay the said duty or fee on the fifth day of October one thousand eight hundred and eighty six and immediately offered payment thereof and of any fine that might be imposed for the omission to pay the same to the Comptroller-General of Patents Designs and Trade Marks (hereinafter called the comptroller) but the time prescribed by section 17 of the Patents Designs and Trade Marks Act 1883 during which the comptroller is empowered to enlarge the time for such payment had already expired viz. on the twenty-second day of September one thousand eight hundred and eighty-six; Omission discovered.

And whereas the said Dan Rylands thereupon gave the requisite instructions for an application to Parliament for power to pay the said stamp duty and to renew the said letters patent; Application to Parliament.

And whereas much time has been devoted and considerable sums of money have been expended by the said Dan Rylands in acquiring and developing the said invention for which no adequate and sufficient return has hitherto been received; Merits.

And whereas the omission to pay the said stamp duty or fee of fifty pounds and to apply to the comptroller within the prescribed period for an enlargement of the time for paying the same arose from the serious and continued illness of the said Dan Rylands which sufficiently accounts for the said omissions otherwise than by neglect inadvertence or mistake; Omission to pay duty due to illness of petitioner.

And whereas the said stamp duty or fee of fifty pounds has now been paid and the total amount of fees (including the prescribed fee for enlargement due and to become due upon the said letters patent) has been deposited with the comptroller and certificates of the comptroller to that effect have been lodged in the office of the clerk of the Parliaments; Amount of stamp duty deposited with comptroller.

And whereas it is expedient that the said letters patent should be rendered valid in manner hereinafter mentioned;

And whereas the purposes aforesaid cannot be effected without the authority of Parliament;

May it therefore please your Majesty that it may be enacted and be it enacted by the Queen's most Excellent Majesty by and with the advice and consent of the Lords Spiritual and Temporal and Commons in this present Parliament assembled and by the authority of the same as follows (that is to say):

Letters patent confirmed.

1. Upon the passing of this Act the said letters patent (a true copy of which is set forth in the schedule to this Act annexed) or a duplicate thereof certified by the comptroller for the purposes of this Act shall be considered deemed and taken to be and to have been as good valid and effectual to all intents and purposes as if all the payments prescribed by the Patents Designs and Trade Marks Act 1883 to be made in respect of the said letters patent either before or after the passing of this Act had been duly made or satisfied.

Saving rights of other parties.

2. No action or other proceeding shall be commenced or prosecuted nor any damage recovered:

(1.) In respect of any infringement of the said letters patent which shall have taken place after the first day of October one thousand eight hundred and eighty-six and before the passing of this Act;

(2,) In respect of the use or employment at any time hereafter of any structure process or operation actually made or carried on within the United Kingdom and the Isle of Man or of the use or sale of any article manufactured or made in infringement of the said letters patent after the said first day of October one thousand eight hundred and eighty-six and before the passing of this Act Provided that such use sale or employment is by the person or corporation by or for whom such article was bonâ fide manufactured or made or such structure process or operation was bonâ fide made or carried on his or their executors administrators successors or vendees or his or their assigns respectively;

(3.) In respect of the use or employment at any time hereafter by the person or corporation entitled for the time being under the preceding sub-section to use or employ any structure process or operation of any improved extended or developed structure process or operation or of the use or sale of any article thereby manufactured or made in infringement of the said letters patent Provided that the use or employment of such improved extended or developed structure process or operation shall be limited to the buildings works or premises of the person or corporation by or for whom such structure process or operation was made or carried on within the meaning of the preceding sub-section his or their executors administrators successors or assigns.

If any person shall within one year after the passing of this Act make an application to the Board of Trade for compensation in respect of money time or labour expended by the applicant upon the subject-matter of the said letters patent on a bonâ fide belief that such letters patent had become and continued to be void it shall be lawful for the said Board after hearing the parties concerned or their agents to assess the amount of such compensation if in their opinion the application ought to be granted and to specify the party by whom and the day on which such compensation shall be paid and if default shall be made in payment of the sum awarded then the said letters patent shall by virtue of this Act become void but the sum awarded shall not in that case be recoverable as a debt or damages.

Short title.

3. This Act may be cited as Potter's Patent Act 1887.

SCHEDULE referred to in the foregoing Act.

[*Form of Letters Patent.*]

XI.—Exhibitions.

Certificate of Board of Trade that Exhibition is Industrial or International (*c*).

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

Upon the application of —— of —— made to the Board of Trade, on or about the —— day of —— 18— the Board of Trade do hereby certify that the —— proposed to be held in the year 18— at —— in the county of —— is an Industrial [International] Exhibition.

Signed by order of the Board of Trade this —— day of —— 18—

Assistant Secretary,
Board of Trade.

Order in Council granting temporary Protection to Inventions exhibited at the Paris (*d*) Universal Exhibition, 1889 (*e*).

At the Court at Windsor.

The 17th day of November, 1888.

Present: The Queen's Most Excellent Majesty in Council.

Whereas the Patents, Designs, and Trade Marks Act, 1883, amongst other things, provides, by section 39, that the exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention, or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely:—

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so: and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

And whereas the said Act further provides, by section 57, that the exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period

(*c*) See Act of 1883, sect. 39, at p. 493.
(*d*) This is given as an example.
(*e*) See Act of 1886, sect. 3, at p. 727.

of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with, namely:—

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

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

And whereas her Majesty, by virtue of the authority committed to her by the provisions of the Patents Act, 1886, is empowered by Order in Council from time to time to declare that the provisions of the said Act of 1883 above recited shall apply to any exhibition mentioned in the order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions specified in the said hereinbefore recited sections of the said Act of 1883:

Now therefore her Majesty, by and with the advice of her Privy Council, and by virtue of the authority committed to her by the said Act of 1886, doth declare and it is hereby declared that the provisions of the foregoing sections of the said Act of 1883 shall apply to the Paris Universal Exhibition to be held at Paris in the year 1889; and further, that the exhibitor of an invention, a design, or any article to which a design is applied, shall be relieved from the conditions specified in the said hereinbefore-recited sections of the said Act of 1883 of giving notice as therein required of his intention to exhibit such invention, design, or article to which a design is applied.

C. L. PEEL.

XII.—War Office Memorandum for Inventors (*f*).

WAR OFFICE,

1st January, 1886.

In consequence of the numerous claims for compensation for loss of time, and for expenses incurred by private individuals in working out inventions of various kinds, as well as for rewards in consequence of the use of such inventions, the Secretary of State for War considers it necessary to make known the following Regulations:—

(*a.*) With regard to unpatented inventions—

(1.) Persons who desire to submit any unpatented invention for consideration, should do so by letter addressed to the Under Secretary of State for War. The letter should state the nature of the invention, and whether the person who offers it for consideration desires to make any claim to remuneration in connection with it. In the absence of such a statement, it will be assumed that no such remuneration is expected.

(*f*) See also Act of 1883, sect. 44, at p. 497.

(2.) Expenses incurred before the submission of an unpatented invention, will not be considered to give a claim for repayment. No liability on behalf of the public will be recognised on account of loss of time, or expenses incurred in connection with an invention after such submission, unless authority for such expenses has been previously given by letter signed by one of the Under Secretaries of State, or the Director of Artillery; and the liability will be strictly confined to the limits of expenditure authorized in such letter.

(3.) All claims for reward for unpatented inventions will be examined by a Joint Council of the Admiralty and War Office, to be held at the War Office, and if any payment be recommended by the Council and approved by the Secretary of State for War, the sum will, with the concurrence of the Treasury, be included in the estimates, but it will not be due to the Claimant until after the vote is passed by the House of Commons.

(4.) No claim for reward for an unpatented invention will be held to be established, unless the invention has been adopted into the Service.

(*b.*) With regard to patented inventions—

(5.) By section 27 of the Patents, Designs, and Trade Marks Act, 1883, it is enacted as follows:—

"A Patent shall have to all intents the like effect as against Her Majesty the Queen, Her Heirs, and Successors, as it has against a subject.

"But the Officers or Authorities administering any department of the service of the Crown, may by themselves, their agents, contractors, or others, at any time after the application, use the invention for the service of the Crown, on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those Officers or Authorities and the Patentee, or in default of such agreement, on such terms as may be settled by the Treasury, after hearing all parties interested."

(6.) Persons desiring to submit patented inventions should proceed on all points as laid down in para. 1.

(7.) Should there be a statement to the effect that remuneration is expected in the event of the adoption and use of the invention by the Secretary of State for War, his agents, contractors, or others, and should there be such adoption and use, or an intention to adopt and use it, then in default of an agreement between the Secretary of State for War and the Patentee, or his Agent, as to the terms of remuneration, the Treasury will settle the terms after hearing all parties interested.

RALPH THOMPSON.

XIII.—Old Forms of Letters Patent, &c.

A Form of Letters Patent shortly before the Statute of Monopolies.

ENGRAVING AND PRINTING MAPS, PLANS, &c. (*a*).

A.D. 1617. No. 1.

Rathburne and Burges' Patent.

Style. JAMES, by the grace of God King of England, Scotland, France, and Ireland,
Address. Defender of the Faith, &c., to all justices of peace, mayors, sheriffs, bailiffs, constables, and all officers, ministers, and subjects of us, our heirs and successors, to whom it shall or may appertain, and to every of them, greeting.

Recitals. WHEREAS we are informed that amongst foreign nations there are fair, curious, and artificial descriptions, plots, and maps made and set forth of their principal cities and towns of greatest note, which being exactly drawn out in metal and printed off, are dispersed and sent abroad into all parts, to the great honour and renown of those princes in whose dominions they are, and that of our city of London, being the chief and principal in this our kingdom of England, there hath never been made or taken any true or perfect description, but false and mean draughts cut out in wood, and so dispersed abroad, to the great disparagement and disgrace of so famous and worthy a state: And whereas our loving subject, Aron Rathburne, Gentleman, practitioner in the mathematics, hath a great desire to take a perfect survey as well of the said city of London as of divers other places within this our kingdom of England hereafter mentioned, and to make such exact plots, maps, and descriptions thereof as hath not been hitherto performed by any, and hath humbly besought us that we would be graciously pleased to grant unto him our Royal licence and privilege (the want whereof, as we are informed, hath been the cause that hitherto so curious and laudable a work hath been neglected), as well for the sole making and setting forth of such maps and plots as of such descriptions and books as he shall devise or set forth in way of relation, of any the places hereafter mentioned within this our realm and other our dominions, for some reasonable time, to the end he may reap the fruits of his travel, charges, and expenses, to be sustained in and about the premises.

KNOW YE, that we, graciously affecting and approving the commendable endeavours of the said Aron, and for his better encouragement therein, that he may receive in recompence thereof the profit of his labours, as reason requireth, of our especial grace, certain knowledge, and mere motion, and at the humble request of the said Aron Rathburne, have given and granted,
Grant, and by these presents, for us, our heirs and successors, do give and grant unto the said Aron Rathburne and unto our well-beloved subject Roger Burges, their executors, administrators, and assigns, and their or any of their deputies or assigns having authority from them in that behalf, that they only, and none others, shall and may, from time to time and at all
for twenty-one years. times for and during the term of twenty and one years next ensuing the date hereof, within this our realm of England, or any other our dominions,

(*a*) This is the earliest patent or specification to be seen at the Patent Office. The series printed comprise all patents or specifications of inventions from this one, dated 11th March, 1617, to the present day. It is to be observed that this is to some extent a grant of copyright in maps of certain towns, and scarcely the proper subject-matter of a patent for an invention at the present day. There seems, however, to be nothing objectionable in this grant as there was in so many others made before the Statute of Monopolies.

and every or any of them, at their or any of their will and pleasure, make, describe, carve, and grave, or caused to be made, described, carved, and graven, in copper, brass, or other metal, all such and so many maps, plots, or descriptions of the aforesaid city of London, and of the city of Westminster, and the suburbs and adjacent parts of them or either of them, and of our cities of York, Bristol, Norwich, Canterbury, Bath, the two universities, Oxford and Cambridge, and the town and castle of Windsor, together with the suburbs and adjoining places to them, or any of them, as they or any of them shall think most meet and convenient, and the same so made, described, carved, and graven as aforesaid, to imprint and set forth in paper, parchment, cloth, or other materials, and likewise to imprint or cause to be imprinted and set forth all and all manner of descriptions and books which they or any of them shall devise, make, or set forth, for the better manifesting of or describing the said cities and towns, or any of them, or for better understanding of the said maps, plots, or descriptions; and likewise to erect and set up, in any place or places within our said realms or dominions, any engines or devises, and to use any tools or instruments necessary for the making, graving, carving, imprinting, or setting forth of the said maps, plots, descriptions, and books, or any of them, and the same so made and perfected, as well to utter and put to sale within these our dominions as to transport out of this our realm or any other our dominions into any the parts beyond the seas, or otherwise to dispose of the same at their or any of their free will and pleasure, and to their most benefit and profit during the said term of twenty and one years, without the let, hindrance, or interruption of us, our heirs or successors, or any the officers or ministers of us, our heirs or successors, or any other person or persons whatsoever. Wherefore our will and pleasure is, and we do by these presents, for us, our heirs and successors, straightly charge, prohibit, and forbid all and singular bodies politic and corporate, and all and every person and persons, as well our natural born subjects as aliens, denizens, and strangers whatsoever, other than the said Aron Rathburne and Roger Burges, their executors, administrators, deputies, and assigns, and such as shall by them, or some of them, be set on work, licensed, or authorized, that they, or any of them, do not presume, attempt, or take in hand, during the said term of twenty and one years, to make, grave, carve, describe, imprint, set forth, or counterfeit or sell, utter or dispose of, within this our realm, or any other of our dominions, or export out of the same the said maps, plots, descriptions, or books, or any of them, whereof the sole privilege is hereby granted to the said Aron Rathburne and Roger Burges, their executors, administrators, deputies, and assigns, nor shall import or bring, or cause to be imported or brought into this our realm of England, or any other of our dominions, or any part of any of them, any other the like maps, plots, descriptions, or books, or any of them, during the said term of twenty and one years, other than such as shall be made, graven, printed, perfected, and set forth by the said Aron Rathburne and Roger Burges, their executors, administrators, deputies, or assigns, or some of them; nor shall make, erect, set up, or frame any engines or devises, or counterfeit or use any tools or instruments for the making, graving, carving, or imprinting thereof, upon pain of forfeiture of all such maps, plots, descriptions, and books so to be counterfeited, made, graven, carved, imprinted, sold, uttered, imported, or exported contrary to the true meaning of these presents, and upon pain of forfeiture of all such engines, instruments, tools, and devises to be framed, set up, used, or exercised, contrary to our meaning herein expressed; and further upon pain of our heavy indignation and displeasure, and of such pains, penalties, and imprisonments, as by the laws or statutes of this realm can or may be inflicted upon the offenders for their contempt or disobedience in breaking and contemning our commandment and prerogative royal; and for the better execution of this our grant, privilege, and licence, we do by these presents, for us, our heirs and successors, give and grant full and free licence, power, and authority unto the said Aron Rathburne and Roger Burges, their executors, administrators, and

Exclusive monopoly to make maps, &c., of certain cities.

Prohibition.

Power of entry and search in ships and other places,

assigns, that they, the said Aron Rathburne and Roger Burges, their executors, administrators, and assigns, by themselves, or any of them, or their or any of their deputies, factors, servants, or assigns, shall and may at all times, and from time to time during the said term, with the assistance of a constable or other officer, at convenient times and in convenient and lawful manner, go on board any ship or other vessel, or enter into any place or places where they or any of them shall think good, within this our realm or any other of our dominions, as well within liberties as without, and there by all lawful ways and means to inquire and search for all such plots, maps, descriptions, and books, and for such frames, engines, devises, tools, and instruments, as by any body or bodies politic or corporate, or any other person or persons other than the said Aron Rathburne and Roger Burges, their executors, administrators, deputies, factors, servants, or assigns, shall, within the said term of twenty and one years by these presents granted, be made, graven, carved, imprinted, described, set forth, uttered, sold, imported, exported, framed, erected, set up or used contrary to the tenor and true

and seizure.

meaning of these our letters patent; and also in due manner to seize, take, and carry away all and every such maps, plots, descriptions, books, engines, tools, and instruments, which they or any of them shall find to be made, carved, graven, imprinted, described, set forth, uttered, sold, imported, exported, framed, erected, set up, made, counterfeited, or used contrary to the true meaning hereof, the one moiety thereof to be to the said Aron Rathburne and Roger Burges, their executors, administrators, and assigns, and the other moiety to be reserved to us, our heirs and successors, to have and to hold the said licences, powers, privileges, and authorities aforesaid, unto the said Aron Rathburne and Roger Burges, their executors, administrators, deputies, and assigns, for and during the term of twenty and one years from the day of the date hereof next and immediately following, and

Proviso.

fully to be complete and ended; provided always, and our will and pleasure is, that these presents, or any thing therein contained, shall not extend to the prejudice of any person or persons, bodies politic or corporate, for or concerning any matter or thing which they or any of them, by force of any other letters patent, grant or grants, by us or any of our noble progenitors or predecessors, kings or queens of this realm, granted, or by any just or

Command to all persons to assist patentees.

lawful right ought to have or enjoy. And lastly, we do hereby for us, our heirs and successors, will and command all justices of peace, mayors, sheriffs, bailiffs, constables, and all other the officers, ministers, and subjects of us, our heirs and successors, to whom it shall or may appertain, that they and every of them be from time to time aiding, helping, and assisting to the said Aron Rathburne and Roger Burges, their executors, administrators, assigns, deputies, and servants, in the execution of these our letters patent, according to the purport, tenor, and true meaning of the same, as they tender our indignation and displeasure, and will avoid the same at their uttermost peril, although express mention, &c.

In witness whereof, &c. Witness ourself at Westminster, the eleventh day of March.

By Writ of Privy Seal.

Form of Letters Patent shortly before Act of 1852 (*a*).

VICTORIA, by the grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith. To all to whom these presents

(*a*) See Hindmarch on Law of Patents, published in 1846, pp. 628 *et seq.*

shall come greeting. WHEREAS [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Watch and Chronometer Maker,*] hath by his petition humbly represented unto us that (*b*) he hath invented ["*a certain improvement or certain improvements in the mechanism of Time Keepers,*"] which the petitioner conceives will be of great public utility, that he is the first and true inventor thereof, and that the same hath not been practised or used before in this kingdom by any other person or persons to the best of his knowledge and belief, the petitioner therefore most humbly prayed that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, for the sole use, benefit, and advantage of his (*c*) said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and all our colonies and plantations abroad,] for the term of fourteen years, pursuant to the statute in that case made and provided, and we being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request. KNOW YE THEREFORE, that we of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents for us, our heirs, and successors, do give and grant unto the said [*James Gowland,*] his executors, administrators, and assigns, our *especial licence, full power, sole privilege and authority*, that he the said [*James Gowland,*] his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy and deputies, servants or agents, or such others as he the said [*James Gowland,*] his executors, administrators, and assigns, shall at any time agree with and no others, from time to time, and at all times hereafter, during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend, his (*d*) said invention within that part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad,] in such manner as to him the said [*James Gowland,*] his executors, administrators, and assigns, or any of them, shall in his or their discretions seem meet. And that he the said [*James Gowland,*] his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned. TO HAVE, HOLD, exercise, and enjoy the said licences, powers, privileges, and advantages hereinbefore granted or mentioned to be granted unto the said [*James Gowland*], his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the date of these presents next and immediately ensuing, and fully to be complete and ended according to the statute in such case made and provided. AND to the end that the said [*James Gowland,*] his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention hereinbefore declared, we do by these presents for us, our heirs, and successors, require and strictly command all and every person and persons,

Recital.

Recital in a patent for an imported invention.

Grant.

Sole privilege.

Habendum for 14 years.

Prohibition to all others.

(*b*) If the patent be granted for an imported invention, the recital states the representation in the petition thus, "that, in consequence of a communication from a foreigner residing abroad, he is in possession of an invention of 'improvements in the construction of locks,' which the petitioner conceives will be of great public utility, and that the same is new within this realm, and hath not been practised or used therein by any person or persons whomsoever, to the best of his knowledge and belief; the petitioner, therefore," &c.

(*c*) If invention had been imported it was "*the* said invention."

(*d*) Or if imported "*the* said invention."

bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name or condition soever they be, within the said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad,] that neither they nor any of them at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make use or put in practice the said invention, or any part of the same so attained by the said [*James Gowland*,] as aforesaid, nor in any wise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisers thereof, without the consent, licence, or agreement of the said [*James Gowland*,] his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command; and further be answerable to the said [*James Gowland*,] his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned.

Command to justices, &c., not to molest the patentee.

AND MOREOVER, we do by these presents for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, head-boroughs, and all other officers and ministers whatsoever of us, our heirs and successors for the time being, they or any of them do not nor shall at any time hereafter during the said term hereby granted, in any wise molest, trouble, or hinder the said [*James Gowland*,] his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the said invention or any thing relating thereto.

Proviso, that if grant contrary to law, or invention not new, &c. patent may be revoked.

PROVIDED ALWAYS, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made to appear to us, our heirs, or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial, or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, in(*e*) that said part of our United Kingdom of Great Britain and Ireland called England, our dominion of Wales, and town of Berwick-upon-Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad aforesaid,] or not invented and found out (*f*) by the said [*James Gowland*] as aforesaid; then upon signification or declaration thereof to be made by us, our heirs, or successors under our or their signet or Privy Seal, or by the Lords and others of our or their Privy Council, or any six or more of them under their hands, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, any thing hereinbefore contained to the contrary thereof in anywise notwithstanding:

Patent not to give privilege to use any prior patent invention.

PROVIDED ALSO, that these our letters patent or any thing herein contained, shall not extend or be construed to extend to give privilege unto the said [*James Gowland*], his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever, which hath heretofore been invented or found out by any other of our subjects whatsoever, and publicly used or exercised in that said part of our United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon-Tweed, [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad aforesaid,] unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof; it being our will and pleasure that the said [*James Gowland*], his

All patentees to use their

(*e*) It ought to have been "in this realm." See *Brown* v. *Annandale*, 1841-42, 1 Webs. R. 433.

(*f*) If the invention had been imported, instead of "not invented and found out," the words "not introduced therein" were inserted; but they ought to have been "not introduced into this realm."

executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: PROVIDED LIKEWISE nevertheless, and these our letters patent are upon this express condition, that if at any time heretofore these our letters patent, or the liberties and privileges hereby by us granted, shall become vested in or in trust for more than the number of twelve persons, or their representatives at any one time as partners dividing or entitled to divide the benefits or profits obtained by reason of these our letters patent (reckoning executors and administrators as and for the single person whom they represent as to such interest as they shall be entitled to in right of such their testator or intestate), that then these our letters patent and all liberties and advantages whatsoever hereby granted shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary in anywise notwithstanding: *Provided* that nothing herein contained shall prevent the granting of licences in such manner and for such consideration as they may by law be granted: AND ALSO if the said [*James Gourland*] shall not particularly describe and ascertain the nature of his said invention (*g*), and in what manner the same is to be performed by an instrument in writing under his hand and seal, and cause the same to be enrolled in our High Court of Chancery within [*six*] calendar months next, and immediately after the date of these our letters patent: AND (*h*) ALSO if the said [*James Gourland*], his executors, administrators, or assigns, shall not supply, or cause to be supplied for our service, all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding. AND LASTLY, *we do by these presents for us, our heirs, and successors, grant* unto the said [*James Gourland*], his executors, administrators, and assigns, that these our letters patent, or the enrolment, or exemplification thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said [*James Gourland*], his executors, administrators, and assigns, as well in all our Courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs, and successors, in that part of our said United Kingdom of Great Britain and Ireland, called England, our dominion of Wales, and town of Berwick-upon Tweed [and also in our islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all our colonies and plantations abroad aforesaid], and amongst all and every the subjects of us, our heirs, and successors whatsoever and wheresoever, notwithstanding the not, full, and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and

inventions distinctly.

Proviso that if patent privilege becomes vested in more than twelve persons, patent to be void.

Proviso not to prevent any granting of licences.

Proviso requiring specification of the invention.

Proviso requiring patentee to supply articles for the public service.

Grant that patent shall be good notwithstanding the not full description of invention, &c.

(*g*) Or if imported, "the said invention."

(*h*) It had recently become the practice to insert this reservation in favour of the public service in every patent, instead of the following proviso:—"Provided also that if the said T. G., his executors, administrators and assigns shall not supply or cause to be supplied for our services all such articles of the said invention as he or they shall be required to supply, in such manner, at such times, and upon such reasonable prices and terms as shall be settled for that purpose by the Master-General of our Ordnance or the principal officers of the Ordnance (and by the lords commissioners of our Admiralty, &c.), for the time being, that then, &c.," the patent becomes void. Hindmarch, p. 71.

belonging. IN WITNESS whereof we have caused these our letters to be made patent. WITNESS ourself at Westminster, this [*tenth*] day of [*November*], in the ninth year of our reign.

By Writ of Privy Seal,
[——] (*i*).

Form of Enrolment of Patent.

Patents (*j*) of the [*ninth*] year of the reign of Queen Victoria.
Roll [*twenty-four*].

["JAMES GOWLAND,] Invention." } "VICTORIA, by the grace of God, &c. To all to whom these presents shall come greeting. WHEREAS, *James Gowland, of, &c.*" [*Here the whole of the patent is copied verbatim, except the conclusion, which is abbreviated thus.*] "In witness, &c. witness, &c. the [*tenth*] day of [*November*]."

"By Writ of Privy Seal."

Specification to be Enrolled in pursuance of the Proviso in the Patent.

TO ALL TO WHOM THESE PRESENTS SHALL COME, I [*James Gowland, of Leathersellers Buildings, London Wall, in the city of London, Chronometer Maker*], send greeting. WHEREAS, her most excellent Majesty, Queen Victoria, by her letters patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date at Westminster the [*first*] day of [*January*] in the [*eighth*] year of her reign, did give and grant unto me the said [*James Gowland*], my executors, administrators, and assigns, her especial license, full power, sole privilege, and authority, that I the said [*James Gowland*], my executors, administrators, and assigns, and such others as I the said [*James Gowland*], my executors, administrators, or assigns should at any time agree with, and no others from time to time and at all times thereafter during the term of years therein mentioned, should and lawfully might make, use, exercise, and vend within that part of the United Kingdom of Great Britain and Ireland, called England, her dominion of Wales, and town of Berwick-upon-Tweed [and also in the islands of Jersey, Guernsey, Alderney, Sark, and Man, and in all her colonies and plantations abroad], my invention of ["*improvements in the construction of Chronometers and other Timekeepers,*"] In which said letters patent there is contained a proviso requiring that I the said [*James Gowland*] shall particularly describe and ascertain the nature of my said invention and in what manner the same is to be performed, by an instrument in writing under my hand and seal, to be enrolled in her said Majesty's High Court of Chancery within [*six*] calendar months next, and immediately after the date of the said in part recited letters patent, as reference being thereunto had will more fully and at large appear. NOW KNOW YE, that in compliance with the said proviso, I the said [*James Gowland*] do hereby declare the nature of my invention, and the manner in which the same is to be performed is particularly described and ascertained in and by this present instrument in writing as follows (that is to say), My said invention consists, &c. [*Here describe the nature of the invention, &c., so as to comply with the terms of the proviso in the letters patent.*

(*i*) The clerk of the patents.

(*j*) This was indorsed on the Roll.

If, however, drawings are necessary, the form should be varied, thus], are particularly described and ascertained in and by this present instrument in writing, reference being had to the drawing [*or* several drawings] hereunto annexed [*or* in the margin of these presents], and in which said drawing [*or* several drawings] similar parts are marked and referred to by similar letters or figures (that is to say), My said invention consists, &c. [*Here describe the invention, referring to the drawings so as to explain the description.*]

IN WITNESS whereof, I, the said [*James Gowland*], have hereunto set my hand and seal the [*first*] day of [*January*], in the year of our Lord one thousand eight hundred and forty [*four*].

(Signed) (*k*) [JAMES GOWLAND] L. S.

(*l*) Signed and sealed in the presence of *John Jones.*

Acknowledgment of Specification before a Master in Chancery (*m*).

Taken and acknowledged by the within [*or* above] named [*James Gowland*], at [*the Public Office, Southampton Buildings, in the county of Middlesex*] this [*second*] day of [*January*] in the year of our Lord one thousand eight hundred and forty [*four*].

Before me,
(Signed) [A. H. LYNCH] (*n*).

Form of Enrolment of a Specification.

Making Cables, &c. Improvements in [Smith's] Specification (*o*).

TO ALL TO WHOM THESE PRESENTS SHALL COME. I, [*Andrew Smith*] of [*Princes Street, Leicester Square, in the county of Middlesex, engineer*], send greeting, &c. [*Here the whole of the specification is set out, including the signature and seal at the end, after which comes the following entry if the specification has been acknowledged.*]

Record of Acknowledgment.

AND BE IT REMEMBERED that on the [*twentieth*] day of [*September*] in the [*third*] year of the reign of her Majesty, Queen Victoria, the said [*Andrew Duckworth* (*p*).

(*k*) The instrument must be both signed and sealed.

(*l*) Although sometimes used, an attestation is not necessary.

(*m*) The acknowledgment was before a Master in Chancery, when taken in town; but when taken in the country it might be taken before a Master Extraordinary.

(*n*) It was unusual for a Master to do more than sign his name; but a Master Extraordinary added words, such as, "Master Extraordinary," in order to show his power to take the acknowledgment.

(*o*) The form of this Marginal Abstract was not the same in all offices.

(*p*) This was the name of the Master before whom the acknowledgment was taken.

Smith] came before our said lady the Queen in her Chancery, and acknowledged the instrument aforesaid, and all and everything contained and specified in form above written: AND the instrument aforesaid was stamped according to the tenor of the statute made in the fifty-fifth year of the reign of his late Majesty King George the Third.

Date of enrolment. Enrolled the [*twentieth*] day of [*September*] one thousand eight hundred and thirty [*nine*].

Certificate of Enrolment.

Enrolled in [the office of the Rolls Chapel, *or* the office of the Petty Bag], in her Majesty's High Court of Chancery, the [*first*] day of [*July*] in the year of our Lord one thousand eight hundred and forty [*five*] being first duly stamped according to the tenor of the statute made for that purpose.

(Signed) [A. B.]

XIV.—Register of Patent Agents Rules, 1889 (*g*).

FOR the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888 (*h*), relating to the registration of patent agents, the Board of Trade, by virtue of the provisions of the said Act, hereby make the following rules:—

Register of patent agents (*i*). 1. A register shall be kept by the Institute of Patent Agents, subject to the provisions of these rules and to the orders of the Board of Trade, for the registration of patent agents in pursuance of the Act.

Names, &c., of patent agents to be registered. 2. The register shall contain in one list all patent agents who are registered under the Act and these Rules.

Such list shall be made out alphabetically, according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the council of the institute may consider worthy of mention in the register. The register shall be in the Form 1 in Appendix A., with such variations as may be required.

Printed copy of register to be evidence. 3. The institute shall cause a correct copy of the register to be, once every year, printed, under their direction, and published and placed on sale. Such correct copy shall, in the year 1889, be printed and published at as early a date as is possible, and in every year subsequent to the year 1889, shall be printed and published on the 31st day of January. A copy of the register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act.

Appointment of registrar. 4. The institute shall appoint a registrar (*k*), who shall keep the register in accordance with the provisions of the Act and these rules, and, subject thereto, shall act under the directions of the institute and the Board of Trade.

(*g*) See Act of 1888, s. 1.
(*h*) See Patents Acts, 1885–88, pp. 425—528, and notes thereon.
(*i*) The side notes are the Author's.
(*k*) The Institute has appointed their Secretary, Mr. Howgrave Graham, registrar.

Registration of patent agents practising before Act 1888.

5. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board of Trade a statutory declaration in the Form 2 in Appendix A.; provided that the Board of Trade may in any case in which they shall think fit, require further or other proof that the person had, prior to the passing of the Act, been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration or of such further or other proof to their satisfaction as the case may be, the Board of Trade shall transmit to the registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the registrar shall on the receipt of such certificate cause the name of such person to be entered in the register.

Examinations.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the registrar a certificate under the seal of the institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the institute shall from time to time prescribe (*l*).

Exemptions from preliminary examination.

7. Any person who has been for at least seven consecutive years continuously engaged as a pupil or assistant to one or more registered patent agents, and any person for the time being entitled to practise as a solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding rule. The registrar shall, before registering the name of any such person as a patent agent (in addition to the final examination certificate) require proof satisfactory to the registrar that such person has been for at least seven consecutive years continuously engaged as such pupil or assistant, or is entitled to practise as such solicitor or law agent.

Preliminary examinations.

8. Any person who is not qualified under rule 7 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations mentioned in Appendix B., or such other examination as the institute shall, with the approval of the Board of Trade, by regulation prescribe.

Holding of examinations and regulations.

9. The institute shall hold at least once in the year, commencing with the first day of July, 1889, and in every other succeeding year, a final qualifying examination, which shall be the final qualifying examination required under rules 6 and 7; and the institute shall, subject to these rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say:—

(*a*) The subjects for and the mode of conducting the examination of candidates;

(*b*) The times and places of the examinations, and the notices to be given of examinations;

(*c*) The certificates to be given to persons of their having passed the examinations;

(*d*) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(*e*) Any other matter or thing as to which the institute may think it necessary to make regulations for the purpose of carrying out this rule.

Alteration in name or address.

10. The registrar shall from to time insert in the register any alteration which may come to his knowledge in the name or address of any person registered.

(*l*) This rule gives the Institute practically complete control over the admission of persons to the profession of patent agent.

Names of deceased persons.

11. The registrar shall erase from the register the name of any registered person who is dead.

Names of persons ceasing to practise as patent agents.

12. The registrar may erase from the register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this rule the registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the registrar; and if the registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purposes of this rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Removal of names from register where registration fees unpaid.

13. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the registrar may send to such registered person to his registered address, a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the registrar may erase his name from the register: provided that the name of a person erased from the register under this rule may be restored to the register by direction of the institute or the Board of Trade on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the institute or the Board of Trade (as the case may be) may in each particular case direct.

Evidence.

14. In the execution of his duties the registrar shall, subject to these rules, in each case act on such evidence as appears to him sufficient.

Fraudulent and incorrect entries.

15. The Board of Trade may order the registrar to erase from the register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Removal of names of persons convicted of felony, &c.

16. If any registered person shall be convicted in her Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanour, or after due inquiry is proved to the satisfaction of the Board of Trade to have been guilty of disgraceful professional conduct, or having been entitled to practise as a solicitor or law agent shall have ceased to be so entitled, the Board of Trade may order the registrar to erase from the register the name of such person. Provided that no person shall be adjudged by the Board of Trade to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

Re-entry of names on register.

17. (1.) Where the Board of Trade direct the erasure from the register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the register, except by order of the Board of Trade.

(2.) The Board of Trade may in any case in which they think fit restore to the register any name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board of Trade may from time to time fix, and the registrar shall restore the name accordingly.

(3.) The name of any person erased from the register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board of Trade, be restored to the register by the registrar on his application and on payment of such fee, not exceeding the registration fee, as the institute shall from time to time fix.

Appointment of committee.

18. For the purpose of exercising in any case the powers of erasing from and of restoring to the register the name of a person, or an entry, the Board of Trade may appoint a committee consisting of such persons as they shall think fit. Every application to the Board of Trade for the erasure from, or restoration to, the register of the name of any patent agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board of Trade, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board of Trade.

Appeal to Board of Trade.

19. Any person aggrieved by any order, direction, or refusal of the institute or registrar may appeal to the Board of Trade.

Procedure on appeal.

20. A person who intends to appeal to the Board of Trade under these rules (in these rules referred to as the appellant) shall, within 14 days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the institute a notice in writing signed by him of such his intention.

21. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

22. The appellant shall also immediately after leaving his notice of appeal at the institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed to the secretary of the Board of Trade, 7, Whitehall Gardens, London.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

24. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the institute and the registrar.

25. The appeal may be heard by the president, a secretary, or an assistant secretary of the Board of Trade, and the decision and order thereon of the president, secretary, or assistant secretary, as the case may be, shall be the decision of the Board of Trade on such appeal. On the appeal such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Fees.

26. The fees set forth in Appendix C. to these rules shall be paid in respect of the several matters, and at the times and in the manner therein mentioned. The Board of Trade may from time to time, by orders signed by the secretary of the Board of Trade, alter any of, or add to, the fees payable under these rules.

Alteration of regulations.

27. Any regulation made by the institute under these rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the institute under these rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board of Trade, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board of Trade by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these rules has come into force, the Board of Trade signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Institute to report to Board of Trade.

28. The institute shall once every year in the month of December transmit to the Board of Trade a report stating the number of applications for registration which have been made in the preceding year, the nature and results of the final examinations which have been held, and the amount of fees received by the institute under these rules, and such other matters in relation to the provisions of these rules, as the Board of Trade may from time to time, by notice signed by the secretary of the Board of Trade and addressed to the institute, require.

Definitions.

29. In these rules, unless the context otherwise requires—

"The Act" means the Patents, Designs, and Trade Marks Act, 1888.

"The institute" means the Institute of Patent Agents, acting through the council for the time being.

"The registrar" means the registrar appointed under these rules.

"Registered patent agent" means any agent for obtaining patents in the United Kingdom whose name is registered under the Act and these rules.

Commencement of rules.

30. These rules shall commence and come into operation on the 12th day of June, 1889, but at any time after the making thereof any appointment or regulations may be made and things done for the purpose of bringing these rules into operation on the said day.

Short title.

31. These rules may be cited as the Register of Patent Agents Rules, 1889.

By the Board of Trade,
COURTENAY BOYLE,
Assistant Secretary, Railway Department.

The 11th day of June, 1889.

APPENDIX A.

Form 1.

Form of Register.

Name.	Designation.	Address.	Date of Registration.

Form 2.

Form of Statutory Declaration.

Register of Patent Agents Rules, 1889.

I, *A. B.* [*insert full name, and in the case of a member of a firm add*, "a member of the firm of "], of , in the county of , patent agent, do solemnly and sincerely declare as follows:—

1. That prior to the 24th December, 1888, I had been *bonâ fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents:—

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at .

APPENDIX B.

Particulars of Preliminary Examinations.

1. The Matriculation Examination at any University in England, Scotland, or Ireland.
2. The Oxford or Cambridge Middle Class Senior Local Examinations.
3. The Examinations of the Civil Service Commissioners for admission to the Civil Service.

APPENDIX C.

Fees.

Nature of Fee.	When to be Paid.	To whom to be Paid.	Amount.
			£ s. d.
For registration of name of patent agent who had been *bonâ fide* in practice prior to the passing of the Act.	On application and before registration.	To the registrar at the Institute.	5 5 0
For registration of name of any person other than as above.	Do. do. .	Do. do. .	5 5 0
Annual fee to be paid by every registered patent agent.	On or before November 30 of each year, in respect of the year commencing Jan. 1st following.	Do. do. .	3 3 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do. do. .	2 2 0

APPENDIX

OF

FOREIGN AND COLONIAL PATENT LAWS.

Besides the actual Government fees mentioned, there are in many cases additional charges to law officers, &c., and expenses for advertising applications and specifications.

ARGENTINE REPUBLIC (*Law of 11th October*, 1864).

To whom, and for what patent granted.

The inventor or assignee, including a foreign patentee, if inventor or assignee, may be a patentee.

All new discoveries or inventions in any branch of industry, and inventions patented abroad, are patentable. Improvements may be protected by certificates of addition. Inventions may be protected by provisional patents, which are kept secret, and the effect of which is to defer grants relating to the same subject-matter till notice has been given to the original patentee at his own domicile.

Official examination.

There is an official examination as to novelty and patentability.

Duration and payments.

New inventions are granted for five, ten, or fifteen years, according to merit of invention and wish of applicant, but a patent once granted for a short term cannot be subsequently extended.

Patents of importation are limited to the term of the original patent, and cannot exceed ten years.

Certificates of addition are limited to the residue of the original patent, and cannot exceed ten years, except when half that period has expired, or when the improvement lessens by half at least the cost, time, or risk of production.

Provisional patents last for one year, and are renewable at expiration of each year.

The following payments are required in the case of:—

1. *New inventions.*—80, 200, or 350 piastres, according to the term.
2. *Importations.*—A sum proportionate to the term, according to same scale of fees.
3. *Certificates of addition.*—The original patentee pays one quarter; others than the original patentee pay one half of the fees above-mentioned.
4. *Provisional patents.*—50 piastres.

Working, importation, and marking by patentee.

A patent is void if the invention is not worked within two years after issue, or has, at any time during the term, been discontinued for a similar period, without sufficient excuse.

There are no provisions as to importation and marking.

Assignments.

Assignments can only be made by notarial act, and after payment of the taxes for the full term for which the patent is taken out, and must be registered in the patent office.

AUSTRIA-HUNGARY (*Laws of 15th August*, 1852; *June 27th*, 1878, *extending earlier law to Hungary*; *20th December*, 1879, *extending earlier law to Bosnia and Herzegovina*).

To whom, and for what patent granted.

The inventor or his assignee resident in the empire, and a foreign patentee or assignee, whether resident in the empire or not, may be a patentee.

New products of industry, new means of production, and new methods of production are good subject-matter; importations from abroad are patentable. Improvements can only be protected by new patents.

There is an official examination as to the formal sufficiency of the specification, &c., but not as to the novelty or utility of the invention. — Official examination.

Patents are granted for any number of years, not exceeding fifteen, and are limited in the case of importations and improvements to the residue of the original term. — Duration and payments.

The patent tax is in proportion to the duration of the privilege, and is the same for discoveries, inventions, and improvements, for foreigners or natives, viz.: 100 florins for the first five years; 200 florins for the following five years, and 400 florins for the last: the annual ratio being 20 florins for the first five years, and for the remaining ten years 30, 35, 40, 45, 50, 60, 70, 80, 90, 100 florins respectively, *i.e.*, 700 florins or 70*l.* for the fifteen years. It is usual to apply for a one year's patent and extend from year to year.

The invention must be worked in the empire within one year of the grant, and the working must not be discontinued for any two years during the term. — Working, importation, and marking by patentee.

There are no provisions as to the importation and marking of patented articles.

Assignments must be duly legalised and registered. — Assignments.

BAHAMA ISLANDS (*Colonial Act*, 52 *Vict.* c. 23, 23*rd May*, 1889).

The true and first inventor, whether resident or not, may be a patentee. — To whom, and for what patent granted.

The invention must at the time of the filing of the specification be new as to the public use and exercise thereof in the colony.

Importations from abroad are patentable by the true and first inventor.

The governor, acting with the advice of the executive council, may refuse to issue patent if there is no novelty in the invention, or that the invention is not for other reasons patentable. — Official examination.

The duration of a patent is seven years. Prolongation for two further periods of seven years each may be obtained. — Duration and payments.

The following sums are payable:—3*l.* for the original grant, 10*l.* for the first renewal, and 20*l.* for the second renewal.

The invention must be brought into operation within three years after the filing of the specification. — Working, importation, and marking by patentee.

There are no provisions as to importation or marking.

Assignments must be registered in the office of the Registrar of Records. — Assignments.

BARBADOES (*Act of* 12*th December*, 1883).

The true and first inventor, whether resident or not, may be a patentee. — To whom, and for what patent granted.

There is no official examination except as to the formal sufficiency of the documents filed. — Official examination.

The duration of a patent is seven years. Prolongation for two further periods of seven years each is obtainable. — Duration and payments.

The following sums are payable:—3*l.* 6*s.* 8*d.* for the original patent, 10*l.* for the first, and 20*l.* for the second renewal.

The invention must be worked within seven years after the filing of the specification. There are no provisions as to importation or marking. — Working, importation, and marking by patentee.

Assignment is apparently permitted by the form of the grant. — Assignments.

There are no provisions as to registration.

BELGIUM (*Law of 24th May*, 1854).

To whom, and for what patent granted.

An inventor, or his assignee duly appointed, or any one legally entitled, or an importer from abroad, may be a patentee.

Inventions, improvements, or importations capable of being worked as articles of industry and commerce, are patentable.

Official examination.

There is an examination as to the sufficiency of the documents filed.

Patents are granted without guarantee as to novelty or utility.

Duration and payments.

The duration of patents for new inventions, not patented abroad, is twenty years. Patents of importations and additions are limited to the unexpired residue of the original term; and the duration of such patents is in no case to exceed twenty years.

Patents of invention and patents of importation are subject to an annual and progressive tax, as follows: first year, 10 francs; second year, 20 francs; and so on to the twentieth year, for which the tax is 200 francs.

The tax must be paid in advance, and is in no case returned.

Patents of improvement are subject to no tax when granted to the owner of principal patent.

Working, importation, and marking by patentee.

Assignments.

The invention must be worked in Belgium within one year of its having been practically worked elsewhere, and whilst continuing to be worked abroad must not cease to be worked in Belgium for an entire year at a time, unless the owner can justify his inaction. Where the patent has been taken out after the invention has been practically worked abroad, the invention must be worked within one year from date of patent.

Assignments must be registered.

BOLIVIA (*Law of 8th May*, 1858).

To whom, and for what patent granted.

The true and first inventor, or the importer from abroad of new machinery or methods of manufacture, may be a patentee.

Methods, or means for the improvement of any manufacture or industry, and importations, are patentable.

Secret remedies are not patentable.

Official examination.

The novelty or utility of the patented invention is not guaranteed.

Duration and payments.

Patents of invention are granted for not less than ten nor more than fifteen years.

The term of patents of importation is fixed by the following scale:—If the establishment of the imported invention requires an outlay of 25,000 dollars, the term is three years; if it reaches 50,000 dollars, six years; if 100,000 dollars or more, ten years.

Working, importation, and marking by patentee.

Assignments.

The invention must be put into complete practice within a year and a day from the date of the privilege, unless the omission is excused by justifiable causes according to law.

Assignments must be by public instrument on pain of forfeiture.

BRAZIL (*Law of 14th October*, 1882).

To whom, and for what patent granted.

The true and first inventor may be a patentee, or a foreign patentee can have his rights confirmed in Brazil.

New industrial products, processes, or applications of known processes; improvements on inventions already patented, if facilitating their manufacture or increasing their utility; alimentary, chemical, and pharmaceutical products,—are patentable.

During first year of patent only the inventor, or his successors in interest, can take out a certificate of addition. Third parties can, however, present their petitions within the said period to establish their rights.

Official examination.

Novelty or utility is not guaranteed. In case of alimentary, chemical, or pharmaceutical products, a secret examination is ordered, on the result of which the grant of a patent depends.

The maximum term of patent for invention is fifteen years, limited in case of foreign patents confirmed, or patents of addition, to the unexpired residue of the original term. Duration and payments.

Patents of invention are subject to an annual and progressive tax, commencing at twenty dollars and increasing at the rate of ten dollars per annum. Certificates of addition are exempt from taxes.

The invention must be brought into effective use within three years after the date of the grant, and such use must not be suspended for more than one year, except by reason of *force majeure*, admitted by government to be a sufficient excuse. Working, importation, and marking by patentee.

By use is understood the effective exercise of the patented industry, and the supply of the products in proportion to their employment or consumption.

The fraudulent marking of patented articles is punishable by fine of from 100 to 500 dollars.

Assignments do not take effect till registered in the Bureau of Agriculture, Commerce, and Public Works. Assignments.

BRITISH GUIANA (*Ordinance No.* 13 *of* 1861).

Patents are granted to the true and first inventor within the colony. To whom, and for what patent granted.

Invention means any manner of new manufacture within the meaning of the Statute of Monopolies.

No guarantee as to novelty or utility is given. There is a formal examination by the law officer, who has power to summon expert assistance. Official examination.

Letters patent continue in force within the colony for fourteen years from the date of the grant. Duration and payments.

The duration of the patent is subject to the payment of a tax of 100 dollars before the expiration of the seventh year of the grant.

There are no provisions in the law of this colony as to compulsory working, or as to the importation or marking of patented articles. Working, importation, and marking by patentee.

Assignments and licenses must be entered in the Register of Patents. Assignments.

BRITISH HONDURAS (*Law of* 10*th September*, 1862).

Patents are granted to the true and first inventor within the colony. To whom, and for what patent granted.

Any manner of new manufacture within the meaning of the Statute of Monopolies is patentable.

No examination is made as to novelty or utility. Applications, &c. are referred, as in British Guiana, to the law officer. Official examination.

The patent term is fourteen years from the date of application. Duration and payments.

The continuance of the patent depends on the payment of a fee tax of 50 dollars before the expiration of three years, and a further tax of 100 dollars before the expiration of seven years from the date of the patent.

There are no provisions as to compulsory working or as to the importation or marking of patented articles. Working, importation, and marking by patentee.

Assignments, &c., must be entered in the Register of Proprietors, and till this is done the grantee is deemed to be exclusive proprietor of the patent. Assignments.

BRITISH NORTH BORNEO (*Proclamation No.* 1 *of* 1887).

Straits Settlements Inventions Ordinance of 1871 adopted. *See* STRAITS SETTLEMENTS, *infra*.

CANADA (*Colonial Act of* 1886, c. 61. *The earlier Act of importance was dated 14th June*, 1872, 35 *Vict.* c. 26).

To whom, and for what patent granted.

A patent may be obtained by the true and first inventor of any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement therein, not known or used previously by any other person, and not in public use or on sale for more than one year previous to his Canadian application.

A foreign patentee whose patent has not been in existence for more than twelve months prior to his Canadian application can obtain a patent.

Any new and useful art, machine, manufacture, or composition of matter, and any new or useful improvement therein, are patentable.

Official examination.

There is a preliminary examination at the Patent Office into the novelty of every invention for which a patent is claimed. The Commissioner of Patents may refuse a grant on the ground of want of novelty; but his decision may be appealed against to the Governor in Council.

Duration and payments.

The term limited for the duration of every patent of invention is fifteen years; but at the time of the application therefor it shall be at the option of the applicant to pay the full fee for fifteen years, or the partial fees required for the term of five or ten years respectively. If a partial fee only is paid, the proportion of the fee paid shall be stated in the patent, and the patent ceases at the end of the term for which the partial fee is paid, unless before its expiration the patentee pays the renewal fee.

A Canadian patent expires at the earliest date at which any foreign patent for the same invention expires.

The full fee for fifteen years is sixty dollars. The partial fee for ten years is forty dollars; for five years, twenty dollars; and, in the latter case, for a further term of ten years, forty dollars. The fee for extending a term of ten years to fifteen is twenty dollars.

Working, importation, and marking by patentee.

A patent is forfeited if not worked in Canada within two years from its date, or within such extended time as the Commissioner of Patents, on satisfactory cause shown, may allow. Working means the continuously carrying on in Canada the construction or manufacture of the invention patented in such manner that any person desiring to use it may obtain it, or cause it to be made for him at a reasonable price, at some manufactory or establishment in Canada.

A patent will also be forfeited if after the expiration of one year, or such extended term not exceeding twelve months as the Commissioner may allow on cause shown, the patentee imports, or causes to be imported into Canada, the invention for which the patent is granted.

Every patented article must be marked with the word "Patented," followed by the year in which the patent was granted, under a penalty not exceeding 100 dollars.

Assignments.

Every assignment must be registered in the office of the Commissioner of Patents.

CAPE OF GOOD HOPE (*Act No.* 17 *of* 1860).

To whom, and for what patent granted.

Patents are granted to the true and first inventor or importer of any invention within the meaning of the Statute of Monopolies.

Any invention within the meaning of the Statute of Monopolies is patentable.

Official examination.

There is no preliminary examination as to novelty or utility, but applications, &c., are referred to the Attorney-General, who has power to call in expert assistance for formal examination.

Duration and payments.

The term limited for the duration of a patent is fourteen years.

The duration of a patent is subject to the payment of sums of 10*l.* and 20*l.* before the expiration of the third and seventh years of the term respectively.

There are no provisions as to compulsory working, or as to the importation or marking of patented articles. — Working, importation, and marking by patentee.

Assignments, &c., must be registered in the Register of Proprietors, and until such entries have been made the grantees are deemed to be the sole and exclusive proprietors. — Assignments.

CEYLON (*Ordinance No. 6 of* 1859).

Patents are granted to the true and first inventor, or to the first importer, of an invention not previously known or in public use in Ceylon. The use of an invention in public by the actual inventor, or by his servants or agents, or by any other person with his written consent, is not deemed a public use thereof. — To whom, and for what patent granted.

An English patentee may obtain protection in Ceylon for the full term of fourteen years.

New and useful products, or processes, or improvements are patentable.

No examination is made as to novelty or utility. — Official examination.

The term of a patent of invention is fourteen years.

Every petition for leave to file a specification must be written on paper bearing a stamp of the value of 10*l*. No further payments are required. — Duration and payments.

There are no provisions as to compulsory working, or as to the importation or marking of patented articles. — Working, importation, and marking by patentee.

Assignments, &c., must be registered at the office of the Colonial Secretary. — Assignments.

CHILI (*Law of 9th September*, 1840, *and Decree of 1st August*, 1851, *and Law of 25th July*, 1872).

Patents are granted to the actual author or inventor of an art, manufacture, machine or instrument, preparation of materials, or any improvement therein; also to the introducers of arts, industries, or machines invented elsewhere, and entirely unknown or not established nor employed in Chili. — To whom, and for what patent granted.

New arts or inventions are patentable. See above.

An examination is made by a commission of experts as to the novelty and utility of the invention, its probable effects upon industry or commerce, and the expense and difficulty incurred by the petitioner, in order to regulate the term and conditions of the grant. — Official examination.

The term of every patent commences on the expiration of the time allotted for working it, and in no case exceeds ten years. — Duration and payments.

A fee of fifty dollars is payable upon application, but no further taxes are required.

Every patent must be worked on pain of forfeiture within a period fixed by the President of the Republic, from the expiration of which the patent runs. The working must not be discontinued for more than a year at a time within the patent term. — Working, importation, and marking by patentee.

There are no provisions as to importation or marking.

Assignments, with reasons thereof, must be intimated to the Minister of the Interior. If the reasons are considered sufficient the assignments are entered in the transfer book. — Assignments.

COLOMBIA (*Law No.* 35, *May* 13*th*, 1869).

Patents are granted to the inventor, whether a Colombian or a — To whom, and for what

patent granted.

foreigner, and to a foreign patentee, provided the invention in question has not already been introduced into public use.

The following are patentable:—Any invention or improvement in a machine, mechanical contrivance, combination of materials, or any process useful to industry, arts, or sciences, or any manufacture or industry; invention already patented abroad, if not already introduced into public use in Colombia. A patent will not be granted for the mere importation of natural or manufactured productions from foreign countries.

Official examination.

There is no preliminary examination as to utility or novelty.

Duration and payments.

The term of a patent varies from five to twenty years, at the option of the applicant.

A patent granted for an invention patented abroad expires with the foreign patent.

On receiving the patent, the patentee pays a fee of from five to ten dollars a year for every year of the privilege. An applicant pays a sum of ten dollars, which is forfeited if the patent is refused, and is taken in part payment of the patent fee if the patent is granted.

Working, importation, and marking by patentee.

A patent for a new industry is void when the said industry is not worked for a whole year, unless unavoidable circumstances have intervened.

There are no provisions as to importation or marking.

Assignments.

There is no provision as to the assignment of patent rights.

CONGO (*Law of October 29th*, 1886; *Decree of October 30th*, 1886).

To whom, and for what patent granted.

A patent may be obtained by the inventor or importer of any discovery or improvement capable of being worked as an object of industry or commerce.

Patents are of three kinds—Patents of invention, of importation, and of improvement.

Official examination.

There is no preliminary examination as to utility or novelty; and the patent expressly mentions that the grant is made without guarantee and at the risk and peril of the applicant.

Duration and payments.

The term of a patent of invention is twenty years. A patent of importation expires with the foreign patent. A patent of improvement expires with the original term.

Patents of improvement are not liable to any tax. On other patents, a payment of 100 francs is required. Such payment must be made in advance.

Working, importation, and marking by patentee.

There are no provisions as to compulsory working, importation, or marking.

Assignments.

Assignments must be notified to the Department of Foreign Affairs, and the deeds of assignment are published in the *Bulletin Officiel*, in the same way as grants of patents.

COSTA RICA.

Applications for patents must be made to the constitutional congress.

DENMARK (*Report by Mr. Strachey, Parl. Rep.* 1872, c. 741, p. 72).

To whom, and for what patent granted.

Patents may be granted to the true and first inventor, whether a Dane or a foreigner.

New and useful inventions are patentable.

Official examination.

There is a preliminary examination as to novelty and utility by the professors of the Polytechnic Institute. Generally speaking the applicant's request is granted.

Duration and payments.

Patents run usually for three, four, or five years. Patents granted to foreigners never run for more than five years. Important inventions are protected for ten, and, in special cases, for fifteen years.

The fee charged at the Ministry of the Interior for the whole transaction is 17 dollars.

The patent is forfeited if the patentee does not carry out his invention within the year and continue to employ it. No provisions exist as to importation or marking. — Working, importation, and marking by patentee.

There is no provision as to assignments. — Assignments.

ECUADOR (*Law of 18th October*, 1880).

The Law of Ecuador is identical with that of Bolivia. See above.

FIJI (*Ordinance No. 3 of* 1879).

Patents are granted to the true and first inventor or importer of a patentable invention, his heirs, executors, administrators, or assigns. — To whom, and for what patent granted.

The following are good subject-matter:—Any manner of new manufacture, every new process of manufacture, every new application of known processes, and improvements in any known process. An invention patented abroad or in England is patentable for the residue of the original term.

There is no preliminary examination as to utility and novelty. — Official examination.

The term of a patent of invention is fourteen years. A patent for an invention patented in foreign countries or in England expires with the foreign or English patent. — Duration and payments.

The patent is not subject to any payment after issue. A fee of five guineas is payable on deposit of petition and specification. The fee for provisional protection is three guineas. On obtaining letters patent, the applicant pays ten guineas.

There are no provisions as to working, importation, or marking. — Working, importation, and marking by patentee.

Assignments, &c., must be registered in the office of the Colonial Registrar-General. — Assignments.

FINLAND (*Decree of 30th March*, 1876).

The inventor only is entitled to the patent. — To whom, and for what patent granted.

New inventions relating to handicraft, industry, or art, and improvements upon earlier inventions of the same kind, are patentable. A foreign patentee may obtain a patent in Finland for the residue of his term.

There is no preliminary examination as to utility or novelty. — Official examination.

A patent of invention is granted for at least three, and for not more than twelve years, according to the nature and importance of the invention. A patent for an invention patented abroad expires with the foreign patent. — Duration and payments.

In addition to the customary dues payable to the Senate for the issue of a patent, an import duty of twenty marks is to be paid into the State Treasury of Finland for every year for which the patent right is granted.

Within two years from the date of his patent, the patentee must send in to the *Manufactures-Direction* evidence that he is in full working of the patented invention. This term may be limited to one year, or extended to four years by the Finance Department of the Senate as the scope and nature of the invention merit. The patentee must also in every year of his term furnish evidence that his invention is being continuously worked. — Working, importation, and marking by patentee.

Assignments, &c., must be notified to the *Manufactures-Direction*. — Assignments.

FRANCE AND COLONIES (*Law of 5th July*, 1844; *Decree of 21st October*, 1848).

To whom, and for what patent granted.

Patents are granted to the inventor, whether a citizen or a foreigner, or to his assignee; also to the author of an invention or discovery already patented abroad.

Every new discovery or invention in all departments of industry is patentable. The following are considered to be new inventions or discoveries:—The invention of new industrial products; the invention of new methods, or the new application of known methods, for obtaining an industrial result or product. An invention patented abroad can be patented in France.

Financial schemes and combinations are not patentable.

Improvements can be protected by certificates of addition or by new patents.

Official examination.

There is no official examination as to novelty or utility.

Duration and payments.

The term of a patent of invention is five, ten, or fifteen years.

A certificate of addition expires with the original patent.

A patent for an invention patented abroad expires with the foreign patent.

Every patent is subject to the following tax (payable by annual instalments of 100 francs):—500 francs for a patent of five years, 1,000 francs for a patent of ten years, and 1,500 francs for a patent of fifteen years.

A tax of 20 francs is payable on application for a certificate of addition. Certificates of addition are not subject to annual taxes.

Working, importation, and marking by patentee.

The invention must be worked in France within two years from the date of signature, and the working must not be stopped during any two consecutive years in the term, unless in one case or the other the cause of inaction is justified. It appears that these provisions are directed against only voluntary and calculated inactivity.

The importation of patented articles into France is prohibited under penalty of forfeiture.

A patentee is not obliged to mark patented articles as such, but if he does so the words *Sans garantie du Gouvernement*, or the initial letters of these words—S. G. D. G.—must be added, under liability to a penalty of from 50 francs to 1,000 francs.

Assignments.

Assignments must be registered at the Ministry of Agriculture and Commerce.

GERMANY (*Law of 1st July*, 1877).

To whom, and for what patent granted.

Whoever first applies for a patent of invention is entitled to a grant. The claim of the petitioner to the grant of a patent will not be allowed if the essential contents of his application have, without permission, been taken from the descriptions, &c., of another person, if such person raises opposition on that account.

Patents are granted for new inventions which can be turned to account in trade. An invention is not regarded as new if already described in any printed publication, in any country, or publicly used in Germany at the time of application, in such manner that its employment appears possible by other persons skilled in the particular trade to which it relates.

Patents are not granted for chemical products.

Improvements can be protected by patents of addition.

Official examination.

There is an official examination as to novelty.

Duration and payments.

The term of a patent is fifteen years from the day following the day of application.

A patent of addition expires with the original term.

A patent for an invention patented abroad is not affected by the lapsing of the foreign patent.

For every patent a fee of 20 marks on application, and 30 marks is payable on issue. Except in the case of patents of addition, a further fee must be paid for each patent at the commencement of the second and every subsequent year, amounting the first time to 50 marks, and increasing by 50 marks each succeeding year.

A patentee who proves his poverty may delay the payments for the first and second years until the third, and if the patent lapses in the third year they are entirely remitted.

The invention must be worked, or, at least, everything must be done to insure its being worked, within three years. Working, importation, and marking by patentee.

Compulsory licenses may be obtained.

There are no provisions as to importation or marking.

Assignments must be registered at the Patent Office, in order to be legally valid. Assignments.

GIBRALTAR.

There is no patent law in Gibraltar, but an English patentee may obtain a special ordinance extending his privilege to the dependency for the unexpired residue of his original term.

GREECE.

No special patent law oxists. A private Act is required, which can be introduced by a deputy, and is treated like any other bill.

GRENADA. *See* WINDWARD ISLANDS.

GUATEMALA (*Law of 21st May*, 1886).

Every native of Guatemala, or foreigner domiciled there, who invents or perfects any machine, manufacture, or process capable of useful application in the sciences or arts, can obtain a patent of invention or a patent of improvement, as the case may be. To whom, and for what patent granted.

Patents for inventions already patented abroad may be obtained.

There is no official examination as to novelty or utility. Official examination.

The term of a patent is from five to fifteen years. Duration and payments.

A patent for an invention comprised in a foreign patent expired with the latter.

The grantee of a patent must pay by annuities, in advance, a tax of from five to fifty dollars for each year of the grant.

The invention must be worked within a year, and the working must not be discontinued for more than a year on pain of forfeiture. Working, importation, and marking by patentee.

There are no provisions as to importation or marking.

Under Art. 9 of the decree of 2nd June, 1864, assignments were required to be registered, and reasons given therefor. Assignments.

HAWAIAN KINGDOM (*Civil Code, sects.* 255, 256; *Law of August 29th*, 1884).

Patents are granted to the inventor or improver of any machine, manufacture, or other work of art calculated to promote the interests of science, agriculture, or manufactures. To whom, and for what patent granted.

The foreign patentee of any new and useful invention not introduced into public use in the Hawaian Islands for more than one year prior to his application, may obtain a patent for the same.

There is a preliminary examination as to novelty and utility. Official examination.

The duration of a patent is ten years. The term of a patent for an invention patented abroad is limited to that of the foreign patent, and in no case exceeds ten years. Duration and payments.

On application for a patent five dollars are payable; the Commissioner of Patents receives twenty dollars for his examination; and a fee of five dollars is payable when the patent is issued. No further payments are required.

Working, importation, and marking by patentee.
There are no provisions as to compulsory working, importation, or marking.

Assignments.
There are no provisions as to assignment.

HONG-KONG (*Ordinance No.* 14 *of* 1862).

To whom, and for what patent granted.
The inventor or assignee of any invention patented in England can obtain protection in the colony for the unexpired residue of the term. If the English patent is extended, an extension of the colonial patent may be obtained or a new patent may be issued.

Working, importation, and marking by patentee.
There are no provisions as to compulsory working, importation, or making.

INDIA (*Act No.* 5 *of* 1888).

To whom, and for what patent granted.
Patents are granted to the inventor, *i.e.*, the actual inventor of any new manufacture, whether a British subject or not. Inventor does not include the importer into British India of a new invention unless he is the actual inventor.

Invention includes improvement; manufacture includes any art, process, or manner of producing, preparing, or making an article, and also any article so prepared.

An invention is deemed to be new if it has not before the date of application been publicly used in any part of British India or of the United Kingdom, or been made publicly known in any part of British India or of the United Kingdom by means of a written publication.

Official examination.
Under sect. 6 of the Act of 1888, it seems that a preliminary examination into novelty and utility might be ordered.

Duration and payments.
The term of a patent is fourteen years from the date of filing the specification.

The following taxes are payable: Annual sums of 50 rupees from the fourth to the eighth year, and annual sums of 100 rupees from the eighth to the thirteenth year of the term.

These fees or any part thereof may be paid in advance.

Working, importation, and marking by patentee.
Compulsory licences may be ordered.

There are no provisions as to importation or working.

Assignments.
Assignments must be registered in the address book at the Office of the Secretary to the Government of India.

ITALY (*Law of* 31*st January*, 1864, *extending Sardinian Law of* 30*th October*, 1859, *to the whole kingdom*).

To whom, and for what patent granted.
The author of a new invention or discovery, and in the case of inventions already patented abroad, the author or [illegible] assigns, may be patentees.

The following are patentable:—A product or result relating to industrial pursuits, an instrument, machine tool, or any mechanical arrangement, a process or method of manufacture, a motor, or the application of an known power to industrial purposes, and the technical application of a scientific principle, producing industrial results. In the last case, the patent is limited to the results specified by the inventor. An invention is new when the particulars necessary for putting it into practice were not known before.

Official examination.
There is no official examination as to utility or novelty.

Duration and payments.
The maximum term of a patent is fifteen years.

The term of a patent, the invention comprised in which is patented abroad, is limited to the term of the foreign patent, and in any case to fifteen years.

Patents are subject to a proportionate tax payable at the time of application, and to an annual tax. The former consists of as many times ten lire as there are years in the term applied for. The latter consists of forty lire for the first three years, sixty-five lire for the next three years, ninety lire for the seventh, eighth, and ninth years, 115 lire for the tenth, eleventh, and twelfth years, and 140 lire for the remaining three years.

Certificates of addition are subject only to the payment in advance of twenty lire.

In the case of a patent of importation, whose term ends with that of the foreign patent, every fraction of a year is considered as an entire year with respect to the payment of the tax.

Working, importation, and marking by patentee.

A patent ceases to be valid, in the case of a grant for five years or less, if the invention is not worked within the first year, or has ceased to be worked during a whole year; and in the case of a patent granted for more than five years, if the invention has not been worked before the expiration of the second year, or if the working has been discontinued for two years. The patentee does not forfeit his rights in either case if his inaction arose from causes beyond his own control. Want of pecuniary means is not included in these causes.

There are no provisions as to importation or marking.

Assignments.

Assignments must be registered at the Ministry, and published in the Official Gazette of the kingdom, at the expense of the applicant.

JAMAICA (*Act of* 1857, *c.* 30).

To whom, and for what patent granted.

Patents are granted to the true and first inventor within the island, or to his personal representative, and to the assignee of any person who has taken out a patent for an invention abroad. But letters patent will not be granted to the assignee of an invention made abroad for which no letters patent have been there obtained.

Patents are of three kinds: Patents of invention—invention meaning any manner of new manufacture within the meaning of the Statute of Monopolies, patents of addition, and patents of importation, the inventions comprised in which have already been patented abroad, and are not in public and common use in the colony at the date of application.

Official examination.

There is no official examination as to novelty or utility.

Duration and payments.

A patent of invention is granted for fourteen years. A patent of importation, and a certificate of addition, expire with the original term.

No tax is payable after issue.

Working, importation, and marking by patentee.

The invention must be worked within two years after the date of the patent.

There are no provisions as to importation or marking.

Assignments.

Assignments must be registered in the office of the Colonial Secretary.

JAPAN (*Imperial Proclamation, No.* 7, *April* 18*th*, 1885).

To whom, and for what patent granted.

Patents are granted to the inventors of useful articles or of improvements upon existing patents. Officials concerned in the granting of patents may not be patentees. Inventions deemed necessary for war purposes, or those the general use of which is deemed important, are not patentable; but the Minister of Agriculture and Commerce will compensate inventors in such cases.

The inventor of an improvement in an existing patent, other than the patentee, must secure the consent of the latter; but if that is improperly withheld, special permission to use the invention, together with the improvement, may be granted upon the improver compensating the original patentee.

Official examination.
There is no official examination as to novelty or utility.

Duration and payments.
The maximum term for a patent of invention is fifteen years; a patent of improvement expires with the original term.

The following payments are required:—

For a patent of 5 years, 10 yen.
10 „ 15 yen.
15 „ 20 yen.
Addition 5 yen.

The yen is equivalent to a dollar.

Working, importation, and marking by patentee.
A patent will become void if the invention has not been publicly applied in practice within two years, or its execution has been suspended for two years without any representation of the circumstance to the authorities; or when patented inventions have been imported from abroad and sold.

Patentees must indicate on their invention the date and term of the patents. In the case of articles, the nature of which precludes such indication, the date and term must be marked on the cover, or otherwise.

If these provisions are not complied with no appeal for any claim of damage may be made.

Assignments.
For the assignment of patents, the permission of the Minister of Agriculture and Commerce is necessary.

LEEWARD ISLANDS (*Acts No.* 12 *of* 1876, *and No.* 16 *of* 1878).

To whom, and for what patent granted.
Patents are granted to the true and first inventor of any invention within the meaning of the Statute of Monopolies.

Inventions patented abroad are patentable.

Official examination.
There is no official examination as to novelty or utility.

Duration and payments.
The term of a patent is fourteen years.

A patent for an invention patented abroad expires with the term of the foreign patent.

Fees of 10*l.* and 20*l.* are payable at or before the expiration of the third and seventh years respectively.

Working, importation, and marking by patentee.
There are no provisions as to working, importation, or marking.

Assignments.
Assignments, &c., must be recorded in the Register of Proprietors.

LIBERIA (*Act of* 23*rd December*, 1864).

To whom, and for what patent granted.
Patents are granted to the actual and original inventor, whether citizen or alien, of any new and useful art, machine, process or composition of matter, or of any new and useful application thereof, or improvement therein.

Official examination.
There is a preliminary examination as to novelty.

Duration and payments.
The maximum term of a patent is twenty years.

A sum of twenty-five or fifty dollars is payable on application, according as the applicant is a citizen or an alien.

Working, importation, and marking by patentee.
An invention patented by an alien must be put in practical operation within three years.

There are no provisions as to importation or marking.

Assignments.
Assignments must be registered in the office of the Secretary of State within one year after execution.

LUXEMBURG (*Law of* 30*th June*, 1880).

To whom, and for what patent granted.
The right of obtaining a patent belongs to him who is the first to declare the invention, unless he has taken it fraudulently from another person.

The representatives or assignees of an inventor may receive a grant.
An applicant must elect a domicile in the Grand Duchy.
Improvements can be protected by certificate of addition.
New inventions capable of being worked commercially are patentable.
An invention is not considered new when at the time of application it has been described clearly in public prints, or publicly worked in the Grand Duchy, or in one of the States of the German customs union, so that other experts could work it.

There is no preliminary examination as to novelty or utility. — Official examination.

The term of a patent is fifteen years from the day following the date of declaration. — Duration and payments.
The patent lapses if a patent for the same object is not applied for within three months in the States with which the Grand Duchy may be connected by treaties of customs union, or if such a patent is refused, annulled, or otherwise terminated.
A certificate of addition expires with the original patent.
An annual and progressive tax, commencing at ten francs and increasing by ten francs annually, is payable in advance.
Certificates of addition require only one tax of ten francs.

The invention must be worked to a suitable extent, or, at least, everything must be done to secure this working within three years. — Working, importation, and marking by patentee.
After the expiration of three years compulsory licenses may be obtained.
There are no provisions as to importation or marking.

Assignments, &c., must be brought in an authenticated form to the knowledge of the member of the government having charge of commerce and industry, and are published in the *Memorial*. — Assignments.

MALTA (*Ordinance No.* 13 *of* 1889).

Patents may be granted to the first and true inventor of any mechanical contrivance, process of manufacture, pattern, or design. — To whom, and for what patent granted.
Inventions patented in the United Kingdom, the colonies, or elsewhere, may be protected for the unexpired residue of the original term.

There is no preliminary examination as to novelty or utility. — Official examination.

The maximum term of a patent is fourteen years. — Duration and payments.
A patent for an invention patented abroad expires with the foreign patent.
A fee of 1*l.* sterling is payable on the filing of the application. A further fee is payable every two years of 1*l.* sterling, with five per cent. on such portion of the profits as have arisen from the exclusive manufacture, the amount to be declared by the affidavit of the patentee.

If the invention is not worked within twelve months, or if the working is subsequently suspended for twelve months continuously, the inventor may be required to assign his right, or grant the use thereof for a consideration to be determined by the competent civil court. — Working, importation, and marking by patentee.

There are no provisions as to assignments, &c. — Assignments.

MAURITIUS (*Ordinance No.* 16 *of* 1875).

Patents are granted to the actual inventor, whether native or foreigner, and to the representatives or assigns of the actual inventor. The importer of a new invention cannot obtain a patent therefor unless he is the actual inventor. — To whom, and for what patent granted.
The holder of an English patent may have his invention protected in Mauritius, although previous to the time of his application in Mauritius the invention was known or used there, provided that his application is

made within twelve months of the date of his English patent, and that the invention was not known, or in public use in Mauritius, before the date of the English patent.

Any art, process, or manner of producing, preparing, or making an article, and any article so produced or prepared, are patentable. Invention includes improvement.

Official examination.

No examination is made as to novelty or utility.

Duration and payments.

The term of a patent of invention is fourteen years.

A patent for an invention comprised in a foreign patent expires with the term of such patent.

No taxes are payable after the grant of a patent.

Working, importation, and marking by patentee.

There are no provisions as to working, importation, or marking.

Assignments.

Assignments must be registered and transcribed at the mortgage office.

MEXICO (*Law of May 7th*, 1832. *Decree of September 28th*, 1843).

To whom, and for what patent granted.

Patents are granted to the inventors or improvers, whether native or foreign, of any branch of industry.

A mere importation is not patentable; but the introducer of any branch of industry that is in the opinion of the Government of great importance may obtain an exclusive privilege by applying through government to the general congress.

Official examination.

There is no preliminary examination as to utility.

Duration and payments.

The term of a patent of invention is ten years; the term of a patent of improvement is six years from the date of issue.

The fees for a patent are from 10 to 300 dollars.

Working, importation, and marking by patentee.

The invention must be worked within a period fixed by and stated in the patent.

There are no provisions as to importation or marking.

Assignments.

There is no provision as to assignment.

NATAL (*Law No. 4 of* 1870; *Law No. 5 of* 1871; *Law No. 32 of* 1884).

To whom, and for what patent granted.

Patents are granted to the true and first inventor of any invention within the meaning of the Patent Law Amendment Act, 1852.

Inventions patented abroad are patentable.

Official examination.

There is no preliminary examination as to novelty or utility.

Duration and payments.

The term of a patent is fourteen years.

A patent for an invention patented abroad expires with the foreign patent.

A tax of 5*l.* is payable at or before the expiration of three years, and another tax of 10*l.* at or before the expiration of seven years.

Working, importation, and marking by patentee.

There are no provisions as to working, importation, or marking.

Assignments.

Assignments, &c., must be entered in the Register of Proprietors.

NEWFOUNDLAND (*Consolidated Statutes, Title XV. c. 54, s. 1*).

To whom, and for what patent granted.

The inventor, or the representatives or assigns of the inventor of any new and useful art, machine, manufacture, or composition of matter, or of any improvement therein, can obtain a patent.

Improvements can be protected by certificate of addition. Inventions patented abroad are patentable.

Official examination.

There is no preliminary examination as to utility or novelty.

The term of a patent of invention is fourteen years; that of a certificate of addition or a patent for an invention patented abroad is limited to the original term. Duration and payments.

In addition to the fees of the office, a patentee is required to pay a sum of twenty-five dollars to the Receiver-General.

The invention must be worked within two years from the date of issue. Working, importation, and marking by patentee.

There are no provisions as to importation or marking.

Assignments must be registered in the office of the Colonial Secretary. Assignments.

NEW SOUTH WALES (*Act No.* 24 *of* 6*th December*, 1852; *Act No.* 3 *of* 8*th July*, 1887).

Letters patent may be granted to the author, or the agent, or assignee of the author of any invention or improvement in the arts or manufactures. To whom, and for what patent granted.

Under sects. 2 and 15 of the Act of 1887 it seems that a preliminary examination as to novelty or utility may be ordered. Official examination.

The term of a patent is not less than seven, nor more than fourteen years. Duration and payments.

The grant of a patent is not subject to any payments after it is made.

There are no provisions as to working, importation, or marking. Working, importation, and marking by patentee.

Assignments, &c., are null and void unless and until they are registered in the office of the Examiner of Patents. Assignments.

NEW ZEALAND (*Act No.* 12 *of* 1889).

Any person, whether a British subject or not, may be a patentee. Patents are granted to the same persons as in England. To whom, and for what patent granted.

"Invention" means any invention, the subject-matter of letters patent, within the meaning of the Statute of Monopolies.

There is no preliminary examination as to novelty or utility. Official examination.

The term of a patent is fourteen years.

A tax of 5*l.* is payable at or before the expiration of the fourth year, and another tax of 10*l.* at or before the expiration of the seventh year. Duration and payments.

Compulsory licences may be obtained as in England.

There are no provisions as to working, importation, or marking. Working, importation, and marking by patentee.

Assignments, &c., must be entered in the Register of Patents. Assignments.

NICARAGUA.

Nominally, patents are of three kinds:—viz., of invention, improvement, and importation, can be obtained. To whom, and for what patent granted.

The term of a patent of invention is ten years.
" " improvement is seven years.
" " importation is five years.

The usual practice is, however, to obtain a special Act of Congress. Duration and payments.

NORWAY (*Law of* 16*th June*, 1885).

The right of obtaining a patent belongs to the first inventor, or to a person who has obtained the right from him. To whom, and for what patent granted.

Patents are granted for new inventions which may be beneficial to industry, or improvements thereon.

An invention is not considered new if before the date of application it is so far known that it could be carried out by experts. But publication, in print or by public exhibition, does not for a period of six months

prevent a grant. Processes or apparatus specially designed for manufacturing articles of food, nourishment, or medicine are patentable.

Official examination.

There is a preliminary examination as to novelty.

Duration and payments.

The term of a patent of invention is fifteen years from the date of application. The term of a patent of addition expires with the original grant.

For each patent of invention an annual tax is payable, amounting to ten crowns for the second year, and increasing five crowns each year. This tax is payable at the beginning of the year for which it is due, or within three months thereafter, on an additional payment of one-fifth.

Working, importation, and marking by patentee.

The invention must be worked within three years, and the working must not be discontinued for one year, on pain of forfeiture.

Assignments.

Assignments must be registered at the Patent Office.

ORANGE FREE STATE (*Ordinance No.* 10 *of* 1888).

To whom, and for what patent granted.

Patents are granted to the authors of new industrial inventions, whether citizens or foreigners, and to the representatives of such authors. Corporations and companies have the same rights. The inventor, however, must be one of the members, and must be pointed out in the application.

An invention patented abroad is patentable.

Official examination.

There is no preliminary examination as to novelty or utility.

Duration and payments.

The term of a patent is fourteen years. A patent for an invention patented abroad expires with the foreign patent. The fee for signing and sealing the patent is not less than 10*l.* or more than 50*l.*

Taxes of 5*l.* and 10*l.* are payable before or at the expiration of the third and seventh years respectively.

Working, importation, and marking by patentee.

Compulsory licenses may be obtained. There are no provisions as to importation or marking.

Assignments.

Assignments must be registered.

PERU (*Law of* 28*th January*, 1869).

To whom, and for what patent granted.

New industrial products and new methods, or the new application of known methods for obtaining an industrial result or product, are patentable.

Official examination.

Under Articles 9 and 10 it seems that a preliminary examination may be ordered as to novelty.

Duration and payments.

The duration of a privilege cannot exceed ten years, and the patentee must pay 100 dollars every year to the fund of the public works of the province in which his invention is to be exercised.

Working, importation, and marking by patentee.

The patentee forfeits all his rights who does not work his invention within two years, or the period fixed by the grant, unless he can legally justify the delay; or who imports articles manufactured abroad similar to those protected by the patent, with the exception of models of machinery whose introduction is authorized by the government.

The marking of patented articles is not obligatory.

Assignments.

Assignments are valid; but there is no provision as to registration.

PORTUGAL (*Civil Code, Chap.* 3, *Sects.* 1—7).

To whom, and for what patent granted.

Any manufacture, product, or article of commerce, or improvement thereon is patentable.

An invention, patented abroad, can be protected by a patent in Portugal.

The grant of a patent for an improvement cannot be made during the first year of the original term, save to the original patentee.

There is no preliminary examination as to novelty or utility. — Official examination.

The duration of a patent of invention is fifteen years from the date of grant. A patent of addition, and a patent for an invention, patented abroad, expires with the original term. — Duration and payments.

A tax of 120,000 reis, equivalent to about 26*l.* sterling, is payable on the grant of a patent.

The invention must be worked within two years, and not be interrupted for two years at a stretch on pain of forfeiture, unless the inaction can be justified. — Working, importation, and marking by patentee.

There are no provisions as to importation or marking.

Assignments can only be effected by notarial deed. — Assignments.

QUEENSLAND (*Act No.* 13 *of* 13*th October*, 1884; *Act No.* 5 *of* 4*th September*, 1886).

Patentee means the person for the time being entitled to the benefit of a patent. — To whom, and for what patent granted.

Invention is any manner of new manufacture within the meaning of the Statute of Monopolies.

There is a preliminary examination as to novelty. — Official examination.

The duration of a patent is fourteen years. — Duration and payments.

The following renewal fees are payable:—

Before the end of the 4th year, 5*l.*
" " 8th " 10*l.*

Or in lieu thereof the following annual fees:—

Before the expiration of the	4th	year,	1*l.*	
" " "	5th	"	1*l.*	
" " "	6th	"	1*l.*	
" " "	7th	"	1*l.*	
" " "	8th	"	1*l.*	10*s.*
" " "	9th	"	1*l.*	10*s.*
" " "	10th	"	2*l.*	
" " "	11th	"	2*l.*	
" " "	12th	"	2*l.*	
" " "	13th	"	2*l.*	

Compulsory licenses may be obtained as in England.

There are no provisions as to importation or marking. — Working, importation, and marking by patentee.

Assignments, &c., must be entered in the Register of Patents. — Assignments.

RUSSIA (*Code of Laws, Vol. XI. Part II. sect.* 3).

Patents are granted to inventors, whether subjects or aliens, to improvers, and to the introducers of foreign inventions known abroad, but new in Russia. — To whom, and for what patent granted.

Every discovery or invention of any new and useful art, machine, manufacture, or composition of matter, and every improvement therein, is patentable.

An invention patented abroad is patentable.

Patents are not granted for inventions and improvements relating to implements of war and the defence of the State.

Small firearms and hand weapons can be patented, but such grants are made solely on the condition that the military and naval departments can use the patented articles for the public service.

There is no preliminary examination as to novelty or utility. — Official examination.

The term of a patent of invention or improvement is three, five, or ten years, as the applicant may wish, and according to the discrimination of the government. A patent granted for a short term cannot be subsequently extended. — Duration and payments.

A patent for an invention patented abroad cannot exceed six years, and expires with the term of the foreign patent if shorter than that period.

The following taxes are payable:—

On patents of invention or improvement,

For three years	90 roubles.
For five years	150 ,,
For ten years	450 ,,

On patents of importation,

For one year.	60 roubles.
For two years	120 ,,
For three years	180 ,,
For four years	300 ,,
For six years	360 ,,

Working, importation, and marking by patentee.

The invention must be put into complete execution during the first quarter of the term, and within six months thereafter the patentee must present to the department from which the patent was issued a certificate from the local authorities that this provision has been complied with.

There are no provisions as to importation or marking.

Assignments.

Assignments must be registered. A patentee cannot assign to a joint stock company without special permission from government.

ST. HELENA (*Ordinance No.* 3 *of* 1872).

The grantee of an English patent or his representatives can have his grant extended to the colony. All cases of doubt and difficulty not provided for by the laws of the colony are governed by the law in force in England.

ST. VINCENT. *See* WINDWARD ISLANDS.

SIERRA LEONE.

An Ordinance of 29th May, 1862, enacts that the laws or statutes in force in England on 1st January, 1862, shall be in force in this colony.

SOUTH AFRICAN REPUBLIC (*Law of* 1*st June*, 1887).

Upon the points taken up in this Appendix, the law is the same as that of the Orange Free State. See above.

SOUTH AUSTRALIA (*Act No.* 78 *of* 21*st December*, 1877; *Act No.* 201 *of* 1881, *and Patents Amendment Act*, 1887).

To whom, and for what patent granted.

Patents are granted to the true and first inventor, or his representatives.

Any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereon, is patentable.

An invention patented abroad is patentable.

Official examination.

Under sect. 25 of the Act of 1887, it seems that an examination may be ordered as to novelty.

Duration and payments.

The term of a patent is fourteen years. A patent for an invention patented abroad expires with the foreign patent.

A tax of £2 : 10*s.* is payable before the expiration of three, and again on the expiration of seven, years from the date of the patent.

Working, importation, and marking by patentee.

An invention may be revoked, if not worked to a reasonable extent for the public benefit within three years.

There are no provisions as to importation or marking.

Assignments.

Assignments, &c., must be registered in the Register of Proprietors.

SPAIN (*Law of* 30*th July*, 1878).

To whom, and for what patent granted.

Patents are granted to inventors or importers, whether natives or foreigners. A patent can be granted to a society.

Machinery, apparatus, instruments, processes, or mechanical or chemical operations, being entirely or partly a new and original invention, or never before established or executed in the same way or form in the

Spanish dominions, and new industrial products, or results obtained by new or known means, provided their working tends to establish a new branch of industry in the country, are patentable.

There is no preliminary examination as to novelty or utility. — Official examination.

The duration of a patent for a new and original invention is twenty years; for objects that are not original or not new, five years; and for inventions already patented and published elsewhere, ten years, provided that application is made in Spain within two years from the date of the first foreign patent. — Duration and payments.

For maintaining a patent, an annual and progressive tax, beginning at ten pesetas, and increasing by ten pesetas every year, is payable in advance.

A single tax of twenty-five pesetas is payable on application for a certificate of addition.

The invention must be worked within two years and every year after. There are no provisions as to importation or marking. — Working, importation and marking by patentee.

Assignments must be registered. — Assignments.

STRAITS SETTLEMENTS (*Ordinance No.* 12 *of* 1871).

Patents are granted to the actual inventor or importer, or representative or assigns of the inventor or importer, of any new and useful invention. Invention includes an improvement. An invention is deemed now if not publicly used in the United Kingdom, the colony, or any British possession, prior to the date of application. — To whom, and for what patent granted.

There is no preliminary examination as to novelty or utility. — Official examination.

The term of a patent is fourteen years. — Duration and payments.
No taxes are payable after issue.

There are no provisions as to working, importation, or marking. — Working, importation, and marking by patentee.

Assignments must be entered on the Register of Proprietors. — Assignments.

SWEDEN (*Law of* 16*th May*, 1884).

Inventors, only, Swedish or foreign, or the legal representatives of inventors are entitled to obtain patents. Patents are granted for inventions of industrial productions, or of special methods of manufacturing such productions. — To whom, and for what patent granted.

Processes for the manufacture of provisions, or medicines, are patentable.

There is a preliminary examination as to novelty. — Official examination.

The duration of a patent is fifteen years from the day of filing the application. — Duration and payments.

A certificate of addition expires with the original patent. On each patent granted, other than a certificate of addition, an annual tax is payable of twenty-five crowns a year for the second, third, fourth, and fifth years; fifty crowns for each of the following five years, and seventy-five crowns for each of the remaining five years. The fee must be paid before the commencement of each year, under penalty of an increase of one-fifth, and of forfeiture if the increased fee is not paid within ninety days after the new year.

The patent is forfeited if the invention is not worked within three years, or if working is subsequently discontinued for a year. — Working, importation, and marking by patentee.

There are no provisions as to importation or marking.

Notice of assignments must be given to the patent authorities. — Assignments.

SWITZERLAND (*Law of 15th November*, 1888).

To whom, and for what patent granted.

Patents are granted to the authors, or assigns of the authors, of new inventions applicable to industry, and represented by models. A process is therefore not patentable. Improvements can be protected by patents of addition.

An invention is not new if at the time of application it is sufficiently known in Switzerland to be carried out by a man of the trade.

Official examination.

There is a preliminary examination as to novelty and utility.

Duration and payments.

The term of a patent is fifteen years from the date of application.

For each patent an annual and progressive tax must be paid in advance on the first day of each year of the term, commencing with twenty francs and increasing by ten francs every year.

A patent of addition—expiring with the original term—may be obtained on payment of a single tax of twenty francs.

Working, importation, and marking by patentee.

A patent may be forfeited if the invention is not worked before the expiration of the third year from the date of application, or if the patented article is imported from abroad, and at the same time the proprietor of the patent has refused applications offered on equitable terms for Swiss licenses. Patented articles must be marked with the Federal Cross (✠), followed by the number of the patent.

Assignments.

Assignments and licenses must be registered at the Federal Office of Industrial Property.

TASMANIA (*Act No. 22 of 5th November*, 1858).

To whom, and for what patent granted.

Patents are granted to the true and first inventor of any invention within the meaning of the Statute of Monopolies. An invention patented abroad is patentable.

Official examination.

There is no preliminary examination as to novelty or utility.

Duration and payments.

The term of a patent is fourteen years from the date of the patent.

A patent for an invention patented abroad expires with the foreign patent.

A tax of 15*l.* is payable at or before the expiration of the third year, and another tax of 20*l.* at or before the expiration of the seventh year.

Working, importation, and marking by patentee.

There are no provisions as to working, importation, or marking.

Assignments.

Assignments must be entered in the Register of Proprietors.

TOBAGO. *See* WINDWARD ISLANDS.

TRINIDAD (*Ordinance No. 25 of 2nd September*, 1867).

To whom, and for what patent granted.

Patents are granted to the inventors or the representatives or assigns of the inventors of any new and useful invention.

Official examination.

There is no preliminary examination as to novelty or utility.

Duration and payments.

The term of a patent is fourteen years.

No taxes are payable.

Working, importation, and marking by patentee.

There are no provisions as to working, importation, or marking.

Assignments.

Assignments must be registered.

TUNIS (*Law of 22nd Rabia-et-Tani*, 1306, *26th December*, 1888).

To whom, and for what patent granted.

Patents are granted to the authors of new discoveries or inventions in all departments of industry, or to their representatives or assigns, whether citizens or foreigners.

New industrial products, or new methods, or the new application of known methods for obtaining industrial results, are patentable.

Improvements can be protected by certificates of addition, or by new patents.

Inventions patented abroad can be patented in Tunis.

There is no preliminary examination as to novelty or utility. — Official examination.

The term of a patent of invention is five, ten, or fifteen years.

Certificates of addition, or patents for inventions patented abroad, expire with the original patents. — Duration and payments.

For a patent of five years 500 piastres, ten years 1,000 piastres, fifteen years 1,500 piastres, are payable by annuities of 100 piastres.

For every certificate of addition a tax of 20 piastres must be paid.

The invention must be worked within two years from the date of issue, and this working must not be discontinued for two consecutive years, on pain of forfeiture, unless the patentee justifies his inaction. — Working, importation, and marking by patentee.

A patentee who introduces into the Regency articles manufactured in foreign countries, and similar to those which are protected by his patent, forfeits all his rights. Nevertheless, the introduction may be authorised (1) of models of machines, and (2) of articles made abroad intended for public exhibition or trials made with the consent of the Government.

A patentee mentioning his title of patent without adding the words "without guarantee of the Tunisian Government," is liable to a fine of from 50 to 1,000 piastres.

Assignments, &c., must be entered in the Register of Patents. — Assignments.

TURKEY (*Law of 18th February*, 1879).

Patents are granted to the authors of new discoveries or inventions. — To whom, and for what patent granted.

New industrial products and new processes, or new applications of known processes for obtaining industrial results, are good subject-matter. Improvements can be protected by certificates of addition, or by new patents. An invention patented abroad is patentable.

There is no preliminary examination as to novelty or utility. — Official examination.

The term of a patent is five, ten, or fifteen years.

A certificate of addition and a patent for an invention patented abroad expire with the original patent. — Duration and payments.

The following taxes are payable:—for a patent of five years, ten Turkish pounds; for a period of ten years, twenty Turkish pounds; for a period of fifteen years, thirty Turkish pounds,—in instalments of two Turkish pounds payable at the commencement of each year.

Every application for a certificate of addition requires the payment of one Turkish pound.

The invention must be worked within two years, and working must not be discontinued for any consecutive period of two years on pain of forfeiture, unless the patentee can justify his inaction. — Working, importation, and marking by patentee.

Importation is prohibited under pain of forfeiture. The introduction of models or articles for exhibitions or experiments may, however, be authorized by government. A patentee who mentions his title without adding the words, "without guarantee of Government," is liable to a fine of not less than two nor more than forty-five Turkish pounds.

Assignments must be registered at the office of the Ministry of Commerce and Agriculture at Constantinople, or in the provinces at the office of the local authorities. — Assignments.

UNITED STATES (*Revised Statute*, 1874, *Title XI*).

Patents are granted to the original and first inventor or his assignee, or to the inventor and his assignee jointly. No official of the Patent Office can obtain a patent. — To whom, and for what patent granted.

The following are patentable:—Any new and useful art, machine, manufacture, or composition of matter not known or used by others in the United States, and not patented or described in any printed publication in the United States or any foreign country before the invention or discovery thereof by the applicant, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned.

Any invention patented abroad is patentable, unless it has been introduced into the United States for more than two years prior to the application.

New designs or patterns of manufactured articles can be patented.

Official examination.

There is a searching official examination as to novelty and utility.

Duration and payments.

The term of a patent of invention is seventeen years from the date of issue of the patent.

A patent for an invention patented abroad expires with the foreign patent, and its term can in no case exceed seventeen years. By a recent decision of the Supreme Court it has been decided that the words *expiration of the term* do not include cesser of the term through forfeiture or breach of condition, but mean *expiration by lapse of time.* Therefore the failure to keep up a foreign patent will not avoid the United States patent, but its life will be determined by the life of the foreign patent obtained before the United States patent, which has the shortest term.

On the issue of each original patent a fee of twenty dollars is payable.

No further payments are required.

Working, importation, and marking by patentee.

There is no provision as to compulsory working.

Importation of the patented articles by the patentee is not prohibited.

Patented articles must be marked as such by the word "patented," together with the day and year the patent was granted being fixed to them; or when from the character of the articles this cannot be done, by fixing to each of them, or to the package wherein one or more of them is inclosed, a label containing the like notice. In any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make, use, or vend the article so patented.

Assignments.

An assignment is void as against a subsequent purchaser or mortgagee for value unless registered in the Patent Office within three months after the date thereof.

URUGUAY (*Law of November 12th*, 1885).

To whom, and for what patent granted.

Patents are granted to the authors of inventions or improvements thereon, and to the inventors, or the attorneys, or assigns of the inventors of foreign patents.

No official of the Patent Office can be a patentee.

The following are patentable:—New industrial products, new means and the new application of known means for obtaining an industrial result or product.

Improvements on patents can be protected by certificates of addition.

An invention patented abroad is patentable if application be made within the first year of the privileged working.

Official examination.

There is no preliminary examination as to novelty or utility.

Duration and payments.

The term of a patent of invention is three, six, or nine years, at the option of the applicant.

A certificate of addition is never granted for a longer term than the principal patent.

For the grant of every patent there is payable in advance a tax of twenty-five dollars, annually, so long as the privilege lasts.

The invention must be worked within a period fixed by the executive. An extension of this period in cases of *vis major* may be obtained on petition to the executive, which must be presented at least three months before its expiration. Working, importation, and marking by patentee.

The working must not be discontinued for one year, on pain of forfeiture, unless this period is extended as above on petition presented within one month of its expiration.

There is no obligation on the patentee to mark patented articles.

Assignments must be by public deed, after notice to the Patent Office, without which requisites they are of no effect against third parties. Assignments.

VENEZUELA (*Law of 25th May*, 1882).

Patents are granted to the inventor, including the foreign patentee of an invention not already patented in Venezuela. Any new and useful art, machine, manufacture, or composition of matter, and any new and useful improvement thereof, is patentable. To whom, and for what patent granted.

There is no preliminary examination as to novelty or utility. Official examination.

The term of a patent of invention is five, ten, or fifteen years. Duration and payments.

A patent for an invention patented abroad expires with the foreign patent.

A patent is liable to a tax of eighty bolivars (francs) a year if it is for an invention or discovery, and of sixty bolivars a year if it relates to an improved process.

The invention must be worked within the period fixed in the grant. This period runs from the day of issue. Working, importation, and marking by patentee.

A patent is void when the working of the invention has been discontinued for a whole year, except in cases of fortuitous circumstances or *force majeure*.

There are no provisions in the law of 25th May, 1882, as to the registration of assignments. Assignments.

VICTORIA (*Act No.* 1034 of *25th November*, 1889).

A patent may be granted to the actual inventor or to his assign, or to an importer who has had the invention communicated to him by the inventor. To whom, and for what patent granted.

Patentee means the person for the time being entitled to a patent, and has the same scope as in England.

Invention means any manner of new manufacture the subject-matter of letters patent within the meaning of the Statute of Monopolies.

Patents for foreign inventions may be granted within two years of the date of the foreign patent, notwithstanding prior user in Victoria.

There is a preliminary examination as to novelty. Official examination.

The term of a patent is fourteen years from its date, *i.e.*, the date of application. Duration and payments.

A fee of 2*l.* 10*s.* is payable at or before the expiration of the third, and again at or before the expiration of the seventh, year. Working, importation, and marking by patentee.

There are no provisions as to working, importation, or marking.

Assignments, &c. must be entered in the Register of Patents. Assignments.

WESTERN AUSTRALIA (*Act No. 5 of 26th November*, 1888).

To whom, and for what patent granted.

Any person, whether a British subject or not, and any two or more persons, may make application.

The holder or assignee of foreign or British patents may obtain letters of registration.

Patents appear to be granted for the same inventions as in Great Britain.

Official examination.

There is no preliminary examination as to novelty or utility.

Duration and payments.

The term of a patent is fourteen years from its date.

A fee of 4*l.* is payable before the expiration of the fourth and again before the expiration of the seventh year thereafter.

Letters of registration of a foreign patent cost 15*l.*, and expire with the original term.

Working, importation, and marking by patentee.

Compulsory licenses may be obtained as in England.
There are no provisions as to working, importation, or marking.

Assignments.

Assignments, &c., must be entered in the Register of Patents.

WINDWARD ISLANDS. *See* BARBADOES.

To whom, and for what patent granted.

In the Windward Islands other than Barbadoes,—viz., Grenada, S. Lucia, S. Vincent, and Tobago, the true and first inventor of any new and useful invention or his representatives can obtain an exclusive privilege by special ordinance for fourteen years.

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